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The Procedure for Obtaining European Patent Validations in Malta

By Dr. Antoine Camilleri and Dr. Claude Micallef-Grimaud

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“European Patent applications filed on or after 1st March 2007 at the EPO may include also the designation of Malta.”

GENERAL

The European Patent Convention (EPC) of 1973¹ is a regional treaty that grants applicants the possibility of obtaining a series of national patents in contracting states to the EPC by filing an application to this effect at the European Patent Office (EPO).

Once the EPO (acting as the examination authority) grants a European Patent (EP), all the national patent offices in the contracting states may subsequently grant a national patent in accordance with domestic procedures relating to EP validations.

The Government of the Republic of Malta deposited its instrument of accession to the EPC² on 1st December 2006 and

the Treaty subsequently entered into force for Malta on 1st March 2007³. Consequently, European Patent applications filed on or after 1st March 2007 at the EPO may include also the designation of Malta (being a Contracting State). It is not possible to designate Malta retroactively in applications filed before 1st March 2007.

MALTESE PROCEDURE FOR EP VALIDATIONS

Once a European Patent is granted by the EPO, the Maltese Industrial Property Office (IPO) would only require a notification from the EPO (or an extract from the European Patent Bulletin) indicating that Malta is designated as a Contracting State in which protection for the invention in question is sought.

If the application filed at the European level is in English (the official language prescribed by Malta in terms of Article 65 of the EPC), there would actually be no official costs involved at the local level except for annual renewal costs as explained below. However, if the proceedings before the EPO were carried out in any other language (with the exception of the English language) and the patent in question has been filed in such other language, the owner of the patent is obliged by Maltese law (Regulation 7(2) of the local 'European Patent Convention Regulations'⁴ hereby referred to as 'the Regulations') to furnish a translation into English to the IPO within three months after the date on which the mention of the grant is published in the European Patent Bulletin (as required by Article 65 of the EPC).

DOCUMENTATION REQUIRED

In order to be in a position to prepare and file the required application form with the Malta Industrial Property Office to obtain the validation of a European patent, local legal representative(s) will require the following information and documents:

1) The full name, address and

postcode of the applicant of the European Patent.

2) The full name, address and postcode of each and every inventor mentioned in the European Patent.

3) If the applicant and the inventor/s are different, an indication in whose name the national Maltese patent is to be issued would also be required (i.e. either in the name of the applicant or of the inventor/s).

4) The number of the European Patent, filing date of the European Patent, date of publication of the grant of the European Patent, and title of the invention of the European Patent.

5) A copy of the decision to grant the European Patent as issued by the EPO OR a copy of the front page of the published European Patent (if already available).

6) An English language version of the European Patent documentation (a Maltese language translation is NOT required). If the patent documentation that was filed at the European level was not in the English language, a certified English language translation of the patent documentation will be required. This document (i.e. the English language version or

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English language translation) of the European Patent, together with the application to request the validation in Malta, must be filed with the Malta Industrial Property Office within three (3) months after the date on which the mention of the grant is published in the European Patent Bulletin (as required by Article 65 of the European Patent Convention). In the application form requesting the validation in Malta, an extension of not more than two (2) months may be requested to provide the English language version/translation of the European Patent⁵.

7) A Power of Attorney will also be required which is to be issued and drawn in favour of the local legal representative(s) by the proprietor of the European Patent. This document needs to be simply signed and no notarization or legalization is required.

ANNUAL RENEWAL COSTS

The obligation to pay renewal fees for the patent application in question shall terminate in the year when the mention of the grant of the European Patent in question is published in the European Patent Bulletin, (as per Article 86 of the EPC). Following that year, renewal

fees for the European Patent in question would have to be paid (as per Article 141 of the EPC). These renewal fees would not be paid to the EPO (as in the case of renewal fees for the patent application) but would have to be paid to the relative national Offices in all the designated Contracting States in which protection for the invention in question is sought. In the case of Malta, regulation 9 of the Regulations provides that annual fees for European Patents shall be paid to the IPO for each year following that in which the mention of the grant of the European Patent is published by the EPO.

At present, these fees are identical to the annual fees that are paid in respect of national patent registrations.

Mamo TCV Advocates is in a position to assist with all the formalities described above – particularly, with the preparation and filing of the application form with the Malta Industrial Property Office for the validation of a European Patent as well as liaising with the IPO on various other matters including annual renewals. For a complete rundown of the fees and costs involved kindly send an email to info@mamotcv.com.

¹ Which entered into force in October 1977.

“...annual fees for European Patents shall be paid to the IPO for each year following that in which the mention of the grant of the European Patent is published by the EPO.”

² And to the Act revising the EPC of 29 November 2000 (Revision Act).

³ Along with the Patent Cooperation Treaty which also came into effect on this date.

⁴ Subsidiary Legislation 417.05 (Legal Notice 99 of 2007).

⁵ Regulation 7(2)(b) of Legal Notice 99 of 2007.



Mamo TCV Advocates
Palazzo Pietro Stiges
90, Strait Street
Valletta VLT1436
Malta

Telephone: (+356) 21232271
(+356) 21231345

Fax: (+356) 21244291
(+356) 21231298

E-Mail: info@mamotcv.com

To contact directly the IP Department of the firm please send an email to:

Dr. David Tonna - Partner
david.tonna@mamotcv.com

Dr. Antoine Camilleri – Senior Associate
antoine.camilleri@mamotcv.com

Dr. Claude Micallef-Grimaud - Associate
claudio.micallefgrimaud@mamotcv.com

www.mamotcv.com

MAMO TCV Advocates is one of the largest legal practices in Malta. Operating from offices in the capital Valletta, MAMO TCV offers an impressive depth and breadth of expertise which enables the firm to handle a variety of different legal areas, and provide, in essence a 'one-stop' service to clients.

The IP Department of the firm offers legal advice and services in all areas of intellectual property law, including national trademark, Community trade mark, patent and designs searches and registrations; prosecutions; licensing, distributorship and franchising negotiations, agreements and related advice; and litigation. The said IP Department is also engaged in anti-counterfeiting and brand protection actions on behalf of a number of its clients in the pharmaceutical, sports, fashion wear, domestic goods, tobacco, and telecommunications sectors.

For the past years MAMO TCV has been top ranked by Legal 500, IFLR 100, Martindale-Hubell, Chambers Global and Chambers Europe. In the 2008 edition, Chamber Europe describes MAMO TCV as a “sophisticated and impressive outfit” and “thanks to several key lawyers, the team really stands out and attracts many of the most important clients.” In the 2009 edition, the Legal 500 refers to MAMO TCV as having a “strong track record of acting on transactions for prominent clients, both local and international.”

A list of the partners and associates and their qualifications is available on the firm’s website.

This document is a basic summary of legal issues. It should not be relied upon as an authoritative statement of the law and one should always seek detailed legal advice before taking any action. Prior results do not necessarily guarantee a similar outcome in all cases.

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