IPR Customs Enforcement

A Brief Look at the Legal Procedure in Malta

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Customs Enforcement Legislation:

- EU Regulation 608/2013- concerning customs enforcement of IPRs
- IPRs (Cross-Border Measures) Act Cap.414 of the laws of Malta

Applicable Legislation

Main Substantive Maltese IP laws:

Copyright Act: Cap. 415 of the Laws of Malta

Patents and Designs Act: Cap. 417 of the Laws of Malta

Trademarks Act: Cap. 416 of the Laws of Malta

Additional Criminal Law Provisions:

 Criminal Code (Art. 298 + 298B of Cap. 9 of the Laws of Malta)



Overview

- 1. The Application Process
- 2. Customs Intervention
- 3. The 'ex officio' action
- 4. Court Proceedings
- 5. Post Judgment Stage



1. The Application Process

- An 'application for action' needs to be filed with Malta Customs in accordance with the Regulation;
 - Available at <u>www.maltacustoms.gov.mt</u>
- The application should cover the most important IPRs & provide as much information about them as possible;
- The application must be renewed/extended annually and updated whenever necessary;
- Urgent and specific information as well as 'recent trends' should also be notified to Malta Customs by using the appropriate forms.





- When Malta Customs intercepts goods suspected of infringing an IPR covered by a customs application, Customs shall suspend the release of the goods or detain them.
- A notification is sent to the parties;
- The right-holder is entitled to obtain certain information from Malta Customs concerning the interception;

Procedure to be followed depends on the scenario in question:

1. Local Consignments

2. Goods in Transit





Scenario 1:

Local Consignments

Standard procedure is observed (Article 23 of EU Regulation 608/2013):

- Right holder has 10 working days from notification to confirm that non-perishable goods are infringing AND that right holder agrees to destruction thereof.
- 10 working days can be extended (if justified)
- If holder/owner of the goods agrees to the destruction of the goods, these will be destroyed under Customs control.
- If right holder agrees but owner of the goods does not confirm or oppose destruction, goods may still be destroyed at Malta Customs' discretion.
- If right holder fails to confirm within the time period above that goods are infringing AND that goods can be destroyed, Malta Customs will release the goods (unless judicial proceedings are to be commenced).





Scenario 2:

Goods in Transit

- Time limits are same as in Scenario 1
- Malta Customs will in all probability decide not to destroy goods unless owner of the goods confirms this in writing.
- Therefore, under Scenario 2, right holder has two options:
 - Attempt to reach an agreement with the holder of the goods for an out-of-court settlement (including destruction of the goods);

OR (in default)

- Commence judicial proceedings (Art. 23(3) of the Regulation)
- Time-frames of the EU Regulation must be complied with as otherwise, the goods will be released.



3. The 'Ex Officio' Action

Article 18 of EU Regulation 608/2013

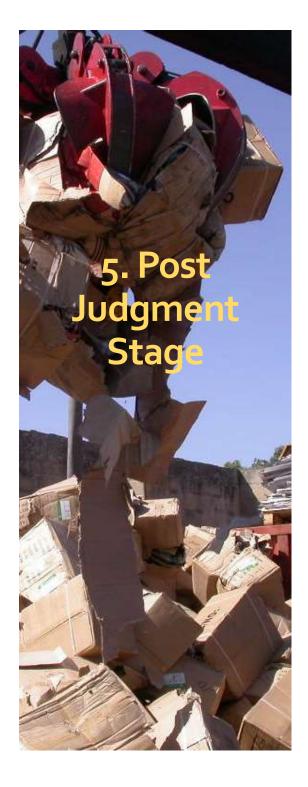
- Where no application is in place, Malta Customs will try to identify the right holder and if successful send a notification about interception;
- Time frames are very short Right-holder has 4 working days after receiving the notification to file a national customs application for action.
- Once the application for action is filed, the procedure as previously explained continues with its course.
- NB the 4 working days are not in addition to the 10 working days (+ 10 days extension) described earlier.





- Judicial proceedings commence with the filing of a sworn court application in the First Hall Civil Court;
- All available documentary evidence (such as affidavits, powers of attorney etc.) must be submitted together with the application;
- Curators are usually appointed by the Court to represent absent/unknown/untraceable defendants;
- The Maltese Courts usually decide these cases with speed and efficiency;
- As part of the remedies granted to the right-holders in case of a favourable judgment, the Court usually imposes a short time frame by when the infringing goods must be destroyed;
- First Instance judgments may be appealed (by both parties).





- The appeal term must be allowed to lapse before the infringing goods can be destroyed;
- Once this period elapses, the right holder must co-ordinate with Malta Customs for the destruction process;
- The destruction process is supervised by Malta Customs officials (right holders may also attend).



Thank You for Your Attention



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