

# IPR Customs Enforcement

A Brief Look at the Legal Procedure in Malta

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A D V O C A T E S

2<sup>nd</sup> March 2017

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# Applicable Legislation

## Customs Enforcement Legislation:

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

## 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 [www.maltacustoms.gov.mt](http://www.maltacustoms.gov.mt)
- 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.

## 2. Customs Intervention

- 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

## 2. Customs Intervention

### 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).

## 2. Customs Intervention

### 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.



## 4. The Court Proceedings



- 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).



## 5. Post Judgment Stage

- 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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