

PATENTS, INDUSTRIAL DESIGNS AND TRADEMARKS ACT

Act 25 of 2002 – 6 January 2003

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PATENTS, INDUSTRIAL DESIGNS AND TRADEMARKS ACT

PART I – PRELIMINARY

1. Short title

This Act may be cited as the Patents, Industrial Designs and Trademarks Act.

2. Interpretation

In this Act—

“approved agent” means an agent approved by the Minister;

“competent authority” means the Permanent Secretary of the Ministry;

“Controller” means the Controller of Industrial Property Office referred to in section 3;

“industrial property” includes—

- (a) “geographical indications” as defined under section 2 of the Geographical Indications Act;
- (b) “layout-designs of integrated circuits” as defined under section 2 of the Layout-Designs (Topographies) of Integrated Circuits Act; and
- (c) “patent”, “invention”, “industrial design”, “trade mark”, “trade name”, “service mark” and “collective mark” as defined under sections 11, 27 and 35 of this Act;

“industrial property enactments” means the Patents, Industrial Designs and Trademarks Act, the Geographical Indications Act, the Layout-Designs (Topographies) of Integrated Circuits Act and the Protection against Unfair Practices (Industrial Property Rights) Act;

“International Classification” means—

- (a) as regards industrial designs, the classification according to the Locarno Agreement of October 8, 1968 (as last revised) establishing an International

Classification for Industrial Designs;

- (b) as regards marks, the classification according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957;

“law practitioner” has the same meaning as in the Law Practitioners Act;

“Minister” means the Minister to whom responsibility for the subject of international trade is assigned;

“Ministry” means the Ministry responsible for the subject of international trade;

“Office” means the industrial Property Office referred to in section 3;

“Patent Co-operation Treaty” means the Patent Co-operation Treaty done at Washington on June 19, 1970;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 1883;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“registers” means the registers referred to in section 6 (1);

“Tribunal” means the Tribunal for Industrial Property established under section 9;

“unfair practice” has the same meaning as in the Protection Against Unfair Practices (Industrial Property Rights) Act;

“World Trade Organisation” means the World Trade Organisation established under the Marrakesh Agreement 1994.

PART II – INSTITUTIONAL FRAMEWORK

3. Industrial Property Office

(1) There shall be for the purposes of this Act a department within the Ministry, to be known as the Industrial Property Office.

(2) The Office shall be administered by a Controller who shall be—

- (a) a public officer;
- (b) appointed by the Public Service Commission; and
- (c) responsible for the control, operation and management of the daily business of the department.

(3) The Minister may give such directions of a general character, not inconsistent with this Act, to the Controller for the proper discharge of his functions under the industrial property enactments and for the implementation of such policies as may be determined.

(4) There shall be posted to the Office such officers as may be necessary for the proper discharge of the functions and duties of the Office.

(5) The officers posted to the Office shall be public officers and shall be under the direct administrative control of the Controller.

(6) The Controller may, subject to the approval of the Minister, appoint, on an *ad hoc* basis, such assessors and technical experts on such terms and conditions, as he may consider necessary.

(7) The Controller may, in the discharge of his duties under the industrial property enactments, issue administrative procedures.

4. Functions of Controller

(1) The Controller shall—

- (a) upon an application under any of the industrial property enactments—
 - (i) grant a filing date in respect of such application;
 - (ii) examine such application;
 - (iii) grant the patent, wherever applicable; and
 - (iv) register any mark, industrial design, geographical indication or layout-designs, as the case may be;
- (b) either on his own initiative or upon a complaint made, investigate any allegation of an offence under any of the industrial property enactments; and
- (c) ensure that the policies and procedures of the office comply with any relevant international standards and guidelines concerning industrial property.

(2) Where the Controller has concluded an investigation under subsection (1) (b), he shall refer the matter to the Director of Public Prosecutions for any appropriate action.

5. Powers of Controller

(1) The Controller shall have such powers as may be necessary to carry out the functions of the Office under, and in order to enforce, any of the industrial property enactments, and in particular to—

- (a) require any person whose affairs are being investigated to answer any question or otherwise furnish any information or produce such document as may be relevant to the investigation;
- (b) require any public officer to furnish information or produce any document in his custody;
- (c) apply to a Judge in Chambers for an order to authorise him or any of his officers to enter and search, at all reasonable times, any premise or place of business and remove thereupon any document or material that may provide evidence relevant to an investigation being conducted; and
- (d) detain any document or goods that may be relevant to the investigation.

(2) The Controller may, for the purposes of conducting any investigation under this Act, use the services of any police officer or other public officer designated for that purpose by the Commissioner of Police, or the Head of Civil Service, as the case may be.

(3) The Commissioner of Police shall give such assistance as may be necessary to the Controller to enable him to discharge his functions under this Act.

6. Registers

(1) The Office shall maintain separate registers for patents, industrial designs, marks and collective marks and trade names.

(2) All the entries and recordings provided for in this Act shall be effected in the appropriate register.

(3) Subject to section 48 (1), the registers may be consulted by any person and any person may obtain extracts therefrom, under such conditions as may be prescribed.

(4) The Controller shall cause to be published, all the publications provided for in this Act, in such manner as may be prescribed.

7. Correction of errors

The Controller may, subject to any regulations as may be prescribed, correct any error of translation or transcription, clerical error or mistake, in any application or document filed with the Controller or in any recording effected pursuant to this Act.

8. Extension of time

Where the Controller is satisfied that the circumstances so justify, he may, upon receiving a written request, extend the time for doing any act upon giving notice to the parties concerned and upon such terms as he may direct.

9. Industrial Property Tribunal

(1) There is established, for the purposes of the industrial property enactments, an Industrial Property Tribunal, which shall consist of—

- (a) a Chairperson, who shall be a law practitioner of not less than 5 years' standing, having experience in industrial property; and
- (b) such other members, being not more than 5 in number, 2 of whom shall have experience in the field of finance and business or public administration,

to be appointed by the Minister after consultation with the Prime Minister.

(2) For the purposes of hearing and determining an appeal under any of the industrial property enactments, the Tribunal shall consist of the Chairperson and 2 members.

(3) The Minister may designate such public officers as he thinks fit, including a Registrar, to assist in the conduct of the business of the Tribunal.

(4) The members of the Tribunal shall be appointed on such terms and conditions, and be paid such fees, as the Minister may approve.

10. Jurisdiction of Tribunal

(1) The Tribunal shall have jurisdiction to hear and determine an—

- (a) appeal by any person who feels aggrieved by any decision taken by the Controller, under any of the industrial property enactments, other than a decision under section 4 (1) (b);
- (b) application by a person to the Tribunal for a ruling on the interpretation of any provision of any of the industrial property enactments; and
- (c) application under section 23 (1) (b) of this Act.

(2) Any appeal to the Tribunal, under subsection (1) (a) shall be made within 28 days of the decision of the Controller.

(3) The Tribunal shall sit at such time and place as the Chairperson may determine.

(4) The Tribunal shall, subject to such regulations as may be prescribed, regulate its own proceedings and may—

- (a) make such orders for requiring the attendance of persons and the production of articles or documents, as it thinks necessary for the conduct of its business; and
- (b) take evidence on oath.

(5) On the hearing of an appeal, the Tribunal may confirm, amend or cancel a decision made by the Controller or give such determination as it considers appropriate.

(6) On the hearing of an appeal under subsection (1) (a) or an application under subsection (1) (c), the Tribunal shall, if necessary, hear the parties and shall make an order determining whether, and subject to what conditions or limitations as to the mode or place of use or otherwise, the grant of patent or registration of mark or industrial design, is to be permitted.

(7) In proceedings under subsection (1) (a), no grounds of opposition to the registration or grant of an industrial property, other than those stated by the party in his notice of opposition, shall, except by leave of the Tribunal, be allowed to be taken by the party giving notice of opposition or the Controller.

(8) Where, after the Tribunal has allowed any further ground of opposition, under subsection (7), the respondent decides to withdraw his application, he shall give notice to the Tribunal and any other party to the appeal accordingly within one month of the leave being granted, and no costs shall be awarded against him.

(9) In any appeal under this section, the Tribunal may, after hearing the parties to the appeal, order that any industrial property proposed to be registered or granted, be modified in any manner not substantially affecting its identity.

(10) Any trademark modified under subsection (9) shall be advertised by the applicant in the *Government Gazette* and in 2 daily newspapers, one of which shall be approved by the Controller, before being registered.

(11) Where any party who has given notice of opposition or of appeal does not reside or carry on business, and does not possess property, in Mauritius, the Tribunal may require him to give security for costs of the proceedings before it relating to the opposition or appeal, and, in default of such security being given, may treat the opposition or appeal as abandoned.

PART III –PATENTS

11. Definitions

(1) For the purposes of this Part—

“invention” means an idea of an inventor which provides the solution to a specific problem in the field of technology;

“patent” means the title granted to protect an invention.

(2) For the purposes of subsection (1), an invention may be, or may relate to, a product or a process.

(3) The following, even if they are inventions within the meaning of subsection (1), shall be excluded from patent protection—

- (a) discoveries, scientific theories and mathematical methods;
- (b) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (c) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body;
- (d) plants;
- (e) animals;
- (f) essentially biological processes for the production of plants and animals;
- (g) plant varieties; and
- (h) literary, dramatic, musical or artistic works or any other aesthetic creation whatsoever.

(4) Notwithstanding subsection (3), any product used in any of the methods referred to in subsection (3) (c), shall not be excluded from protection.

12. Patentable inventions

(1) An invention shall be patentable under this Act where it—

- (i) is new;
 - (ii) involves an inventive step;
 - (iii) is capable of industrial application.
- (2) An invention is new where it is not anticipated by prior art.
- (3) For the purposes of subsection (2), prior art shall consist of anything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where applicable, the priority date, of the application claiming the invention.
- (4) For the purposes of subsection (3), disclosure to the public of the invention shall not be taken into consideration where—
- (a) it occurred within 12 months preceding the filing date or, where applicable, the priority date of the application; and
 - (b) it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.
- (5) An invention shall be considered as involving an inventive step where, having regard to the prior art relevant to the application claiming the invention, it would not have been obvious to a person having ordinary skill in the art.
- (6) An invention shall be considered industrially applicable where it can be made or used in any kind of industry.
- (7) For the purposes of subsection (6), the term “industry” shall be construed in its broadest sense and shall also cover handicraft, agriculture, fishery and services.
- (8) Any commercial exploitation of an invention, which is contrary to public order or morality, shall not be patentable.

13. Right to patent

- (1) The right to a patent shall belong to the inventor.
- (2) Where 2 or more persons have jointly made an invention, the right to the patent shall belong to them jointly.
- (3) Where 2 or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date shall have the right to the patent, as long as the said application is not withdrawn, abandoned or rejected.
- (4) Any right to a patent may be assigned or may be transferred by succession.
- (5) Where an invention is made in the execution of, or under, an employment contract, the right to the patent shall belong, in the absence of any express provisions to the contrary, to the employer.
- (6) Every patent shall contain the name of the inventor unless he in a special written declaration signed by him and addressed to the Controller, indicates that he wishes not to be named.
- (7) Any promise or undertaking by the inventor made to any person to the effect that he will make a declaration under subsection (6) shall be without effect.

14. Application

- (1) An application for a patent shall be—
 - (a) made in the prescribed form;
 - (b) filed with the Controller in such manner as may be prescribed under this Act;

and

- (c) subject to payment of the prescribed fee.
- (2) An application for a patent shall contain—
- (a) a request which includes—
 - (i) a petition to the effect that a patent be granted;
 - (ii) the name of and other prescribed data concerning the applicant, the inventor and the agent, if any;
 - (iii) the title of the invention;
 - (b) a description of the invention, any claim and any drawing and an abstract;
 - (c) where the applicant is not the inventor, a statement justifying the applicant's right to the patent; and
 - (d) where the applicant's ordinary residence or principal place of business is outside Mauritius, an address within Mauritius for service of any document.

(3) Any description referred to in subsection (2) (b) shall disclose the invention in a manner which is sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate at least one mode known to the applicant for carrying out the invention.

(4) Any claim shall—

- (a) define the matter for which protection is sought;
- (b) be clear and concise and fully supported by the description.

(5) The description and the drawings in respect of any patent may be used to interpret any claim under subsection (4).

(6) Any abstract referred to in subsection (2) (b) shall be used for technical information only and shall not be taken into account for the purpose of interpreting the scope of the protection.

(7) Any applicant may, before the application is granted, withdraw the application on payment of a prescribed fee.

15. Unity of invention

(1) Any application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(2) An applicant may, at any time before the application is granted, amend the application, provided that the amendment shall not go beyond the disclosure in the initial application.

(3) The applicant may, at any time before the application is granted, divide the application into 2 or more applications, provided that each divisional application shall not go beyond the disclosure in the initial application.

(4) Every divisional application shall be entitled to a filing date and, where applicable, the priority date of the initial application.

(5) Where a patent has been granted following an application that did not comply with the requirement of unity of invention under subsection (1), such failure to comply with subsection (1) shall not be a ground for the invalidation of the patent.

16. Right of priority

(1) An application may contain a declaration claiming the priority, as provided for in the Paris Convention, of one or more earlier national, regional or international

applications filed by the applicant or his predecessor in title in or for any State party to the said Convention or any member of the World Trade Organisation.

(2) Where the application contains a declaration under subsection (1), the Controller may require the applicant to furnish, within the prescribed time limit, a copy of the earlier application certified as correct by the office with which it was filed.

(3) The effect of the said declaration shall be as provided in the Paris Convention.

(4) Where the Controller finds that the requirements under this section have not been fulfilled, the said declaration shall be considered not to have been made.

17. Information concerning corresponding foreign applications and patents

(1) An applicant shall, where requested to do so by the Controller, furnish him with the date and number of any application for a patent filed by him abroad relating to the same or essentially the same invention as that claimed in the application filed with the Controller.

(2) An applicant shall, where requested to do so by the Controller, furnish him with the following documents relating to one of the foreign applications referred to in subsection (1)—

- (a) a copy of any communication received by the applicant concerning the results of any search and examination carried out in respect of the foreign application;
- (b) a copy of the patent granted on the basis of the foreign application;
- (c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.

(3) An applicant shall, where requested to do so by the Controller, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in subsection (2).

18. Filing date

(1) The Controller shall accord as the filing date, the date of receipt of the application, provided that, at the time of receipt, the application contains—

- (a) an express or implicit indication that the granting of a patent is sought;
- (b) indications allowing the identity of the applicant to be established;
- (c) a part which, on the face of it, appears to be a description of an invention.

(2) Where the Controller finds that the application did not, at the time of receipt, fulfil the requirements referred to in subsection (1), he shall invite the applicant to file the required correction and shall accord as the filing date, the date of receipt of the required correction.

(3) Where no correction is made, the application shall be treated as if it has not been filed.

(4) Where the application refers to drawings which are not included in the application, the Controller may request the applicant to furnish the missing drawings.

(5) Where the applicant complies with a request under subsection (4), the Controller shall accord as the filing date, the date of receipt of the missing drawings.

(6) Where the applicant fails to comply with a request under subsection (4), the Controller shall accord as the filing date, the date of receipt of the application and shall treat any reference to the said drawings as non-existent.

19. Examination

- (1) The Controller shall, after according a filing date, examine—
 - (a) whether the application complies with section 14 and any other provisions of this Act; and
 - (b) whether any information requested under sections 16 and 17 has been provided.
- (2) For the purposes of subsection (1), the Controller shall take into account—
 - (a) the results of any international search reports, and any international preliminary reports, made in relation to the application;
 - (b) any search and examination report submitted under section 17 (2) (a); and
 - (c) any final decision submitted under section 17 (2) (c).

20. Grant of patent

(1) Where the Controller finds that the conditions referred to in section 19 (1) have been fulfilled, he shall grant the patent.

(2) Where an application fails to comply with the conditions referred to in section 19 (1), the Controller shall reject the application and notify the applicant of his decision.

- (3) Where the Controller grants a patent, he shall—
 - (a) cause to be published a reference to the grant of the patent, in such manner as may be prescribed;
 - (b) issue to the applicant a certificate of the grant of the patent and a copy of the patent;
 - (c) record the patent; and
 - (d) make available copies of the patent to the public, on payment of the prescribed fee.

(4) The Controller may, upon a request of the owner of the patent, make any change in the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

(5) Any request under subsection (4) shall be accompanied by the prescribed fee.

(6) The Controller shall, whenever possible, reach a final decision on the application not later than 2 years after the commencement of the examination referred to in section 19 (1).

21. Rights conferred by patent

(1) Any exploitation of the patented invention in Mauritius by any person other than the owner of the patent shall require the latter's agreement.

- (2) For the purposes of this Act, the "exploitation" of a patented invention means—
 - (a) where the patent has been granted in respect of a product—
 - (i) the making, importing, offering for sale, selling and using of the product;
 - (ii) stocking such product for the purposes of offering for sale, selling or using;
 - (b) where the patent has been granted in respect of a process—
 - (i) the use of the process;

- (ii) the performance of any of the acts referred to in paragraph (a) in respect of a product obtained directly by means of the process.

(3) Any owner of a patent shall, in addition to any other rights, remedies or actions available to him, have the right, subject to subsection (4) and section 22, to institute civil proceedings in damages against any person who infringes the patent by performing, without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that an infringement will occur.

(4) Any right under the patent shall not extend—

- (a) to acts in respect of articles which have been put on the market in Mauritius or in any other country by the owner of the patent or with his consent, or by any other authorised party;
- (b) in respect of articles which have been put on the market in Mauritius or in any other country or imported into Mauritius;
- (c) to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Mauritius; or
- (d) to acts done only for research and experimental purposes relating to a patented invention;
- (e) to acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted and in Mauritius, was using the invention or was making effective and serious preparations for such use.

(5) The right of any prior use referred to in subsection (4) may only be transferred to or devolve upon the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been made.

22. Duration

(1) Subject to subsection (2), a patent shall expire 20 years after the filing date of the application for the patent.

(2) In order to maintain the patent or patent application, such annual fee as may be prescribed shall be payable to the Controller for each year, following the year of the filing date.

(3) If the annual maintenance fee is not paid in accordance with the provisions of subsection (2), the patent application shall be deemed to have been withdrawn and the patent shall lapse.

23. Exploitation by Government or person thereby authorised

(1) Where the competent authority—

- (a) is satisfied that the public interest, including national security, nutrition, health or the development of other vital sectors of the national economy, so requires; or
- (b) has, on the application of any party, determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive and that it is necessary to remedy such anti-competitive practice,

it may, upon a request being made, authorise, even without the agreement of the owner of the patent, a Government agency or a third person to exploit the patented invention.

(2) The exploitation of the patented invention shall be limited to the purpose for which it was authorised and shall be subject to the payment, to the owner, of an adequate compensation.

(3) For the purposes of a decision under subsection (1), the competent authority shall take—

- (a) into account the economic value of the authorisation, as determined in the said decision, and where a decision has been taken under subsection (1) (b), the need to correct anti-competitive practices; and
- (b) his decision after hearing the owner of the patent and any interested person, whenever necessary.

(4) A request for the authorisation under subsection (1) shall be accompanied by evidence that the owner of the patent has received, from the person seeking the authorisation, a request for a contractual licence, but that the latter has been unable to obtain such a licence on reasonable commercial terms and conditions and within a reasonable time.

(5) Subsection (4) shall not apply in cases of—

- (a) national emergency or other circumstances of extreme urgency provided, however, that in such cases the owner of the patent shall be notified of the competent authority's decision as soon as reasonably practicable;
- (b) public non-commercial use; and
- (c) anti-competitive practices determined as such by the competent authority in accordance with subsection (1) (b).

(6) The exploitation of a patented invention in the field of semi-conductor technology by a person other than the owner, shall only be authorised—

- (a) where the competent authority has determined that the manner of exploitation of the patented invention, by the owner of the patent or his licensee, is anti-competitive and is satisfied that the issuance of the non-voluntary licence would remedy such practice; or
- (b) for public non-commercial use.

(7) The authorisation shall not exclude—

- (a) the conclusion of licence contracts by the owner of the patent;
- (b) the continued exercise by the owner of the patent of his rights under section 21; or
- (c) the issuance of a non-voluntary licence under section 24.

(8) Where a third person has been authorised by the competent authority, the authorisation may only be transferred with the enterprise or business of that person or with the part of the enterprise or business within which the patented invention is being exploited.

(9) Upon a request of the owner of the patent, or the Government agency or of the third person authorised to exploit the patented invention, the competent authority may, after hearing the parties, whenever necessary, vary the terms of the decision authorising the exploitation of the patented invention to the extent that any change in circumstances justifies such variation.

(10) Upon the request of the owner of the patent, the competent authority shall terminate the authorisation if he is satisfied, after hearing the parties, whenever necessary, that the circumstances which led to the decision have ceased to exist and are unlikely to recur or that the Government agency or third person authorised has failed to comply with the terms of the decision.

(11) Notwithstanding subsection (10), the competent authority shall not terminate the authorisation where he is satisfied that the need for adequate protection of the legitimate interests of the Government agency or third person authorised, justifies the maintenance of the decision.

(12) The decision of the competent authority under this section shall be subject to review by the Supreme Court.

24. Non-voluntary licences

(1) Upon request made to the Controller after the expiration of a period of 4 years from the date of filing of the patent application or 3 years from the date of the grant of the patent, whichever period expires last, the Controller may issue a non-voluntary licence if he is satisfied that the patented invention is not exploited or is insufficiently exploited, by working the invention locally or by importation, in Mauritius.

(2) Notwithstanding subsection (1), a non-voluntary licence shall not be issued if the owner of the patent satisfies the Controller that circumstances exist which justify the non-exploitation or insufficient exploitation of the patented invention in Mauritius.

(3) The decision issuing the non-voluntary licence shall fix—

- (a) the scope and the function of the licence;
- (b) the time limit within which the licensee must begin to exploit the patented invention; and
- (c) the amount of the adequate remuneration to be paid to the owner of the patent and the conditions of payment.

(4) The holder of the non-voluntary licence shall—

- (a) have the right to exploit the patented invention in Mauritius according to the terms set out in the decision issuing the licence;
- (b) commence the exploitation of the patented invention within the time limit fixed in the said decision; and
- (c) thereafter, exploit the patented invention sufficiently.

(5) Where—

- (a) the invention claimed in a patent (“later patent”) cannot be exploited in the country without infringing a patent granted on the basis of an application benefiting from an earlier filing or, where appropriate, priority date (“earlier patent”); and
- (b) the invention claimed in the later patent involves an important technical advance of considerable economic importance in relation to the invention claimed in the earlier patent,

the Controller, upon the request of the owner of the later patent, may issue a non-voluntary licence to the extent necessary to avoid infringement of the earlier patent.

(6) Where a non-voluntary licence is issued under subsection (5), the Controller, upon the request of the owner of the earlier patent, shall issue a non-voluntary licence in respect of the later patent.

(7) In the case of a request for the issuance of a non-voluntary licence under subsections (5) and (6), subsection (3) shall apply *mutatis mutandis* with the proviso that no time limit needs to be fixed.

(8) In the case of a non-voluntary licence issued under subsection (5), the transfer may be made only with the later patent, or, in the case of a non-voluntary licence issued under subsection (6), only with the earlier patent.

(9) The request for the issuance of a non-voluntary licence shall be subject to payment of a prescribed fee.

(10) Section 23 (2) to 23 (12) shall apply *mutatis mutandis* to a non-voluntary licence issued under this section.

25. Invalidation

- (1) Any interested person may request the Tribunal to invalidate a patent.
- (2) The Tribunal may invalidate the patent where the person requesting the invalidation proves that any of the requirements of sections 11, 12 and 14 have not been fulfilled or where the owner of the patent is not the inventor nor his successor in title.
- (3) Any invalidated patent or claim or part of a claim shall be regarded as null and void from the date of the grant of the patent.
- (4) The final decision of the Tribunal shall be notified to the Controller who shall record it and publish a reference thereto as soon as possible.

26. Patent Co-operation Treaty

(1) For the purposes of this section, “designate”, “designated office”, “elect”, “elected office”, “international application”, “international filing date”, “international preliminary examination” and “receiving office” have the same meaning as in the Patent Co-operation Treaty.

(2) An international application designating Mauritius shall, subject to this section, be treated as an application for a patent filed under this Act having as its filing date the international filing date accorded under the Patent Co-operation Treaty.

(3) The Controller shall, unless any agreement is in force under subsection (4), act as a receiving Office in respect of any international application filed with it by a resident or national of Mauritius.

(4) The Controller may, with the consent of the Minister, make an agreement of the kind referred to in Rule 19.1 (b) of the Regulations made under the Patent Co-operation Treaty whereby an inter-governmental organisation or the national industrial property office of another Contracting State of the Patent Co-operation Treaty shall act instead of the Controller as receiving office for applicants who are residents or nationals of Mauritius.

(5) The Controller shall act as a designated office in respect of an international application in which Mauritius is designated for the purposes of obtaining a patent under this Act.

(6) The Controller shall act as an elected office in respect of an international application in which Mauritius is designated under subsection (5) if the applicant elects Mauritius for the purposes of international preliminary examination under Chapter II of the Patent Co-operation Treaty.

(7) The Controller as designated office or elected office shall not commence processing of an international application designating Mauritius before the expiration of the time limit referred to in subsection (8) except if the applicant complies with the requirements of that subsection and files with the Controller an express request for early commencement of such processing.

(8) The applicant shall, in respect of an international application designating Mauritius, before the expiration of the time limit applicable under Article 22 or 39 of the Patent Co-operation Treaty or of such later time limit as may be prescribed—

- (a) pay the prescribed fee to the Controller; and
- (b) if the international application was not filed in English, and has not been published under the Patent Co-operation Treaty in English, file with the Controller a translation of the international application, containing the prescribed contents, into English.

(9) Where the applicant does not comply with the requirements of subsection (8) within the time limit referred to in that subsection, the international application shall be considered withdrawn.

(10) The Controller shall process international applications in accordance with the provisions of the Patent Co-operation Treaty, the regulations established thereunder and the Administrative Instructions under those regulations and with the provisions of this Act and the regulations made under this Act.

(11) For the purposes of subsection (10), in the event of conflict, the provisions of the Patent Co-operation Treaty, any regulation made thereunder and the Administrative Instructions under those regulations shall prevail.

(12) Any regulations under this Act may provide for the—

- (a) processing of international applications;
- (b) functions of the Controller in connection with the Patent Co-operation Treaty, including fees payable, time limits, prescribed languages and other requirements in relation to international applications.

PART IV – INDUSTRIAL DESIGNS

27. Definitions

(1) For the purposes of this Part, any composition of lines or colours or any 3-dimensional form, or any material, whether or not associated with lines or colours, shall be deemed to be an industrial design, provided that such composition, form or material—

- (a) gives a special appearance to a product of industry or handicraft;
- (b) can serve as a pattern for a product of industry or handicraft; and
- (c) appeals to and is judged by the eye.

(2) The protection under this Act does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

28. Registrable industrial design

(1) An industrial design shall be registrable under this Act where it is new.

(2) An industrial design is new where it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Section 12 (4) shall apply, *mutatis mutandis*, to applications for the registration of industrial designs.

(4) Any industrial design that is contrary to public order or morality shall not be registrable.

29. Right to industrial design

(1) The right to an industrial design shall belong to the creator.

(2) Where 2 or more persons have jointly created an industrial design, the right to the industrial design shall belong to them jointly.

(3) Where 2 or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, where priority is claimed, the earliest validly claimed priority date shall have the right to the industrial design, as long as the said application is not withdrawn, abandoned or rejected.

(4) The right to an industrial design may be assigned or may be transferred by succession.

(5) Where an industrial design is made in execution of an employment contract, the right to the industrial design shall belong, in the absence of express provisions to the

contrary, to the employer.

(6) The creator shall be named as such in the industrial design unless, in a written statement signed by him and addressed to the Controller, he indicates that he wishes not to be named.

(7) Any promise or undertaking by the creator made to any person to the effect that he will make such a statement shall be without legal effect.

30. Application

(1) Any application for the registration of an industrial design shall—

- (a) be filed with the Controller;
- (b) contain the necessary drawings, photographs or other adequate graphic representations of the industrial design;
- (c) contain an indication of the article or articles which constitute the industrial design or in relation to which the industrial design is to be used;
- (d) be accompanied by a specimen of the article embodying the industrial design where the industrial design is 2-dimensional; and
- (e) be subject to the payment of an application fee as may be prescribed.

(2) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to registration of the industrial design.

(3) The application may contain a declaration claiming priority, as provided for in the Paris Convention, of one or more earlier national or regional applications or international deposits filed by the applicant or his predecessor in title in or for any State party to that Convention or any member of the World Trade Organisation.

(4) Where the application contains a declaration referred to in subsection (3), the Controller may require the applicant to furnish, within the prescribed time limit, a copy of the earlier application or international deposit, certified as correct by the office with which it was filed, and the effect of that declaration shall be as provided for in the Paris Convention.

(5) Where the Controller finds that the requirements under this section and any regulations made under this Act pertaining to a declaration, are not fulfilled, the declaration shall be considered not to have been made.

(6) Two or more industrial designs may be the subject of the same application where they relate to the same class of the International Classification or to the same set or composition of articles.

(7) Any application may, at the time of filing, contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding 12 months from the date of filing, or where priority is claimed, from the date of priority, of the application.

(8) The applicant may, at any time before an industrial design is registered, withdraw the application subject to the payment of a prescribed fee.

31. Registration

(1) The Controller shall accord the date of receipt of the application as the filing date provided that, at the time of receipt, the application contains—

- (a) indications allowing the identity of the applicant to be established; and
- (b) the required graphic representations of the industrial design.

(2) Where the Controller finds that the application did not, at the time of receipt, fulfil the requirements referred to in subsection (1), he shall invite the applicant to file the

required correction and shall accord the date of receipt of the required correction as the filing date, and where no correction is made, the application shall be deemed not to have been filed.

(3) The Controller shall, after according a filing date, examine whether—

- (a) the application complies with the requirements of section 30 and any regulations made under this Act;
- (b) the application fee has been paid; and
- (c) the industrial design complies with the requirements of sections 27 and 28 and the regulations pertaining thereto.

(4) (a) Where the Controller finds that the conditions referred to in subsection (3) have been fulfilled, he shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design upon payment of a registration fee as may be prescribed.

(b) Where an application does not satisfy the requirements of subsection (3), the Controller shall reject the application.

(5) Notwithstanding subsection (4), where an application contains a request for the deferment of publication under section 30 (7), the Controller shall, upon registration of the industrial design—

- (a) ensure that neither the representation of the design nor any file relating to the application shall be open to public inspection; and
- (b) publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner, and indicating the filing date of the application, the length of the period for which deferment has been requested and any other prescribed particulars.

(6) At the expiry of the period of deferment, the Controller shall publish the registered industrial design.

(7) Any legal proceedings commenced during the period of deferment of publication on the basis of a registered industrial design shall give rise to the presumption that the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

32. Rights conferred by registration

(1) The exploitation of a registered industrial design in Mauritius by any person, other than the registered owner, shall require the agreement of the latter.

(2) For the purposes of this Act, “exploitation” of a registered industrial design means the making, selling or importation of articles bearing or embodying a design which is a copy, or substantially a copy, of the registered industrial design.

(3) Any right under a registered industrial design shall not extend to act in respect of articles which have been put on the market in Mauritius by the registered owner or with his consent.

(4) Any registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute Court proceedings against any person who infringes the industrial design by performing, without his agreement, any act referred to in subsection (2) or who performs any act which is likely to amount to infringement.

33. Duration and renewal

(1) The registration of any industrial design shall be for a period of 5 years from the filing date of the application for registration and renewable for another period of 5 years.

(2) The registration of any industrial design may be renewed for 2 further consecutive periods of 5 years upon—

- (a) payment of a renewable fee; and
- (b) compliance with any condition as may be prescribed.

34. Invalidation

(1) Any person may apply to the Tribunal for an order invalidating the registration of an industrial design.

(2) The Tribunal may invalidate the registration where the person requesting the invalidation proves that any of the requirements of sections 27 and 28 has not been fulfilled or where the registered owner of the industrial design is not the creator or his successor in title.

(3) Any invalidated registration of an industrial design shall be regarded as null and void from the date of the registration.

(4) The final decision of the Tribunal shall be notified to the Controller who shall record it and publish a reference thereto as soon as possible.

PART V – MARKS, COLLECTIVE MARKS, TRADE NAMES

35. Definitions

For the purposes of this Part—

“collective mark” means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality of goods or services, of different enterprises which use the sign under the control of the registered owner of the collective mark;

“mark” means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise from those of other enterprises; and

“trade name” means the name or designation identifying and distinguishing an enterprise.

36. Acquisition of exclusive right to a mark

(1) The exclusive right to any mark shall be acquired by registration in accordance with the provisions of this Act.

(2) No mark shall be registered, where it—

- (a) is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) is contrary to public order or morality;
- (c) is likely to mislead any person, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (d) is identical with, or an imitation of, or contains, as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, inter-governmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation;
- (e) is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Mauritius for identical or similar goods or services of another enterprise;

- (f) is registered in Mauritius for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use; and
- (g) is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or where it so nearly resembles such a mark as to be likely to deceive or cause confusion.

(3) The Controller may refuse to accept an application for the registration of a mark on which appears—

- (a) the word “patent”, “patented”, “registered”, “registered design” or “copyright”, or an abbreviation of any these words; or
- (b) any representation of the State, or any colourable imitation of these representations.

(4) No mark which contains either—

- (a) a representation of the flag of Mauritius;
- (b) a representation of the Arms or Seal of Mauritius;
- (c) anything resembling any of the representations specified in paragraph (a) or (b);
- (d) the word “Mauritius”;
- (e) the word “standard”; or
- (f) any word or representation, not specified in paragraphs (a) to (e), likely to lead people to believe that the person claiming to be the proprietor of the mark has or recently had authorisation of the Government,

shall be registered except with the authority of the Minister.

37. Application for registration

(1) Any application for the registration of a mark shall be filed with the Controller and shall contain a request, a reproduction of the mark and a list of the goods or services, listed under the applicable class or classes of the International Classification for which registration of the mark is requested.

(2) An application under subsection (1) shall be subject to the payment of the prescribed application fee.

(3) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title in, or for any State party, to that Convention or any member of the World Trade Organisation.

(4) Where an application contains a declaration in accordance with subsection (3), the Controller may require the applicant to furnish, within the prescribed time limit, a copy of the earlier application, certified as correct by the office with which it was filed.

(5) The effect of a declaration under subsection (3) shall be as provided in the Paris Convention.

(6) Where the Controller finds that the requirements under subsection (3) and the regulations pertaining thereto have not been fulfilled, the declaration shall be considered not to have been made.

(7) The applicant may withdraw the application at any time before registration.

(8) The applicant may, at any time before the mark is registered, withdraw the application, subject to the payment of a prescribed fee.

38. Examination and opposition

(1) The Controller shall examine—

- (a) whether the application complies with the requirements of section 37 and any regulations made under this Act; and
- (b) whether the mark is a mark as defined in section 35 (b) and is registrable under section 36 (2).

(2) Where the Controller is satisfied that the conditions referred to in subsection (1) have been fulfilled, he shall forthwith accept the application and cause it to be published in the prescribed manner.

(3) Any person may, within the prescribed period and in the prescribed manner, lodge with the Controller an opposition to the registration of the mark.

(4) Any opposition lodged under subsection (3) shall be by way of notice and shall state the grounds of opposition.

(5) The applicant may, within the prescribed period and in the prescribed manner, send a copy of any counter-statement to the opposition together with the grounds on which he relies for his application to the Controller and the opponent.

(6) Where the applicant does not send a counter-statement under subsection (5), he shall be deemed to have abandoned the application.

(7) Where the applicant sends a counter-statement under subsection (5), the Controller shall, after hearing the parties if so required, decide whether the mark should be registered.

(8) After an application is published and until the registration of the mark, the applicant shall have the same privileges and rights as he would have where the mark had been registered.

(9) Notwithstanding subsection (8), it shall be a valid defence to an action brought under the subsection in respect of an act done after the application was published, where the defendant establishes that the mark could not validly have been registered at the time the act was done.

39. Registration of mark

Where the Controller finds that the conditions referred to in section 38 (1) are fulfilled, and either—

- (a) the registration of the mark has not been opposed within the prescribed time limit; or
- (b) the registration of the mark has been opposed and the opposition has been decided in the applicant's favour,

he shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration.

40. Rights conferred by registration

(1) Any interested person, other than the registered owner, who intends to use a registered mark, in relation to any goods or services for which it has been registered, shall require the agreement of the owner.

(2) Any registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute Court proceedings against any person

who infringes the mark by using, without his agreement, the mark as aforesaid or who performs any act likely to cause an infringement.

(3) Any registered owner may, where the use of any sign similar to the registered mark or in relation to goods and services similar to those for which the mark has been registered, is likely to cause confusion in the public, institute Court proceedings in accordance with subsection (2).

(4) The provision of section 36 (2) shall apply, *mutatis mutandis*, in any action instituted by the owner of a well known mark against any person in respect of the unlawful use of the well known mark.

(5) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Mauritius by the registered owner or with his consent.

41. Duration

(1) The registration of a mark shall be for a period of 10 years from the filing date of the application for registration.

(2) The registration of any mark may be renewed for consecutive periods of 10 years upon payment of—

- (a) a renewal fee; and
- (b) any condition as may be prescribed.

42. Invalidation

(1) Any interested person may apply to the Tribunal for an order invalidating the registration of a mark.

(2) The Tribunal may invalidate the registration where the person requesting the invalidation proves that any of the requirements of sections 35 and 36 has not been fulfilled.

(3) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published as soon as possible.

43. Removal on grounds of non-use

(1) Any interested person may request the Controller to remove from the register, a mark in respect of any goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request, the mark had, after its registration, not been in use by the registered owner or a licensee during a continuous period of not less than 3 years.

(2) Notwithstanding subsection (1), no mark shall be removed from the register, unless the Controller is satisfied that there were reasonable circumstances that prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

44. Collective marks

(1) Subject to subsections (2) to (4), sections 36 to 42 shall apply to collective marks, except that references to section 35 (b) shall be read as 35 (a).

(2) Any application for registration of a collective mark shall designate the mark as a collective mark and be accompanied by a copy of the terms of the agreement governing the use of the collective mark.

(3) Any registered owner of a collective mark shall notify the Controller of any

changes made in respect of the terms of the agreement referred to in subsection (2).

(4) The Tribunal shall invalidate the registration of a collective mark where any interested person requesting the invalidation proves that the—

- (a) mark is being used exclusively by the registered owner;
- (b) registered owner is using or permitting its use in contravention of the terms of the agreement referred to in subsection (2);
- (c) registered owner is using or is permitting its use in a manner liable to deceive any person as to the origin or any other common characteristics of the goods or services concerned.

45. Licensing of marks

(1) Any licence in relation to a registered mark shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used.

(2) Where the licence does not provide for such quality control or where such quality control is not effectively carried out, the licence shall not be valid.

(3) The registration of a collective mark, or an application thereof, shall not be the subject matter of a licence.

46. Trade names

(1) No name or designation shall be used as a trade name where—

- (a) by its nature or the use to which it may be put, it is contrary to public order or morality; or
- (b) it is liable to deceive any person as to the nature of the enterprise identified by that name.

(2) Notwithstanding any enactment providing for an obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(3) For the purposes of subsection (2), any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be unlawful.

PART VI – GENERAL PROVISIONS

47. Changes in ownership

(1) Any application by an interested party for a change in the—

- (a) ownership of a patent;
- (b) registration of an industrial design;
- (c) registration of a mark or collective mark;
- (d) ownership of an application thereof; or
- (e) ownership of a trade name,

shall be made in writing to the Controller and shall be entered in the appropriate register.

(2) Subject to subsection (4), where the Controller accepts a change referred to in subsection (1), he shall enter the change in the appropriate register and cause it to be published.

(3) Any change effected under subsection (1) shall have no effect against third parties

until an entry has been made under subsection (2).

(4) Any change in the ownership of a trade name shall be made at the time the transfer of the enterprise or part thereof identified by that name takes place and be in writing.

(5) Where any change in the ownership of the registration of a mark or a collective mark is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used, it shall be invalid.

48. Licence

(1) Any licence concerning a patent, a registered industrial design or a registered mark, or an application thereof, shall be submitted to the Controller, who shall record it and publish a reference thereto, while keeping its contents confidential.

(2) The licence shall have no effect against third parties until such recording is effected.

49. Agents

Where an applicant's residence or principal place of business is outside Mauritius, he shall be represented by a law practitioner resident and practising in Mauritius or an approved agent.

50. Appeal to Supreme Court

(1) Any person who is dissatisfied with the determination of the Tribunal as being erroneous in law may appeal to the Supreme Court by way of case stated.

(2) An appeal under this section shall be prosecuted in the manner provided by the rules made by the Supreme Court.

(3) No person shall appeal to the Supreme Court under this section unless he has exhausted the remedy available under section 10.

(4) Any appeal to the Supreme Court shall be made within 28 days of the determination of the Tribunal.

(5) The Supreme Court may make rules for ensuring the prosecution of appeals under the Act.

(6) On the hearing of an appeal under this section, any person may, by special leave of the Supreme Court, bring forward further material for the consideration of the appeal by the Supreme Court.

51. Offences

(1) The performance of any act referred to in sections 21, 32 and 40 in Mauritius by any person other than the owner of the title of protection or the licensee and without the agreement of the owner, shall be unlawful.

(2) Any person who knowingly performs any act in breach of subsection (1) shall commit an offence and shall, on conviction, be liable to a fine not exceeding 250,000 rupees and to imprisonment for a term not exceeding 5 years.

52. Unfair practice

(1) Any act in breach of section 21, 32 or 40 shall amount to an act of unfair practice and may give rise to a claim in damages.

(2) Any claim arising out of an unfair practice shall be prosecuted in accordance with

the Protection against Unfair Practices (Industrial Property Rights) Act.

(3) In any action under subsection (1), the Court may, notwithstanding any other enactment, order the forfeiture of any article or thing that were used in or gave rise to an act of unfair practice, as the Court thinks fit.

53. Regulations

(1) The Minister may make regulations generally for the purpose of this Act.

(2) The regulations may, in particular, but without prejudice to subsection (1), provide—

- (a) for the payment of fees; and
- (b) for the procedure for the registration of industrial designs, marks and collective marks and matters related thereto.

54. —

55. Transitional provisions

(1) —

(2) The Controller shall—

- (a) perform all the functions of and exercise all the powers conferred in relation to patents under the Patents Act; and
- (b) be the custodian of the register of patents kept under the Patents Act and of the patents granted under that Act together with the certificates of interim protection and other relevant records.

(3) – (7) —

(8) The Controller shall—

- (a) perform all the functions of and exercise all the powers conferred on the Authority, in relation to trade marks under the Trademarks Act;
- (b) be the custodian of the register of trademarks kept under the Trademarks Act and of any relevant records.

56. —
