

# GUIDE TO INTELLECTUAL PROPERTY IN MAURITIUS

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## PREFACE

This Guide is concerned primarily at providing general information for parties wishing to understand the basic tenets of the Mauritian Intellectual Property law.

The Guide is designed as a starting point for a more detailed and comprehensive discussion of the issues involved in the legal framework underpinning Intellectual Property Rights in Mauritius.

We recognise that this Guide will not completely answer detailed questions which clients and their advisers may have; it is not intended to be comprehensive. If any such questions arise in relation to the contents, they may be addressed to any member of the team, using the [contact information](#) provided at the end of this Guide.

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## 1. INTRODUCTION

The framework established for the protection of intellectual property rights in Mauritius consists of five pieces of legislation, namely the Patent, Industrial Designs and Trademark Act 2002 (**PIDTA**); the Protection Against Unfair Practice Act 2002 (**PAUP**); the Layout Designs (Topographies) of Integrated Circuit Act 2002 (**Layout Designs Act**); the Geographical Indications Act 2002 (**GI Act**); and the Copyright Act 2014 (**Copyright Act**).

The Parliamentary debates in relation to the introduction of the PIDTA, the PAUP, the Layout Designs Act and the GI Act reveal that they were introduced as part of the international obligations of the Republic of Mauritius, as a signatory of the Trade Related Intellectual Property Agreement (the **TRIPS Agreement**). These pieces of legislation were introduced in an endeavour to ensure that the laws of Mauritius on industrial property conformed with the international norms laid down by the TRIPS agreement.

The PIDTA and the PAUP came into force on 06 January 2003. However, neither the Layout Designs Act nor the GI Act has yet been proclaimed and even though they received the assent of the President of the Republic of Mauritius on 06 August 2002.

The Copyright Act repealed the Copyright Act 1997 and came into force on 31 July 2014 pursuant to Proclamation No. 37 of 2014. It reflects the international commitment of the Republic of Mauritius with the WIPO Copyright Treaty, WIPO Performances and Phonogram Treaty.

We understand that legislation on industrial property in Mauritius is presently under review. The Government of Mauritius ambitions to enhance a legal environment that keeps abreast with international trends that are constantly evolving. That will project the Mauritian territory as a platform armed with a sound legal framework to protect the intellectual property rights of, amongst others, brands that are well known and famous within the global village.

## 2. THE SUBSTANTIVE LAW

### 2.1 The Types of Intellectual Property Rights that are Protected

The laws of Mauritius protect copyright, patents, industrial designs, marks (i.e. trade marks, trade names, service marks, collective marks), layout-designs of integrated circuits and, geographical indications.

### 2.2 Scope of Protection - Definitions

#### (a) THE COPYRIGHT ACT

The Copyright Act defines “copyright” as “the economic and moral right subsisting in a work” (section 2). This marks a significant change to the repealed Copyright Act 1997 as moral rights are now captured within the definition of “copyright”. Moral rights are defined as the right to claim authorship of a piece of work and the right to prevent any act to be done that would be prejudicial to the honour and reputation of a copyright owner.

Furthermore, the scope of copyright protection now extends to “folklore” and “traditional cultural expressions”. In this regard, folklore includes among others, folk tales, folk poetry, instrumental folk music, folk dances and plays, artistic forms or rituals and production of folk art. As to “traditional cultural expressions” it includes any form of artistic and literary expression in which traditional culture and knowledge are embodied and which is intergenerational. It is transferable as moveable property and grants an exclusive right to the copyright owner in relation to well-defined activities (sections 6 & 7).

The Copyright Act protects “work” which it defines as “artistic, literary or scientific work, or a derivative work” which is protected in accordance with sections 3 and 4. It sets out an

exhaustive list of items that fall within the scope of artistic, literary or scientific work (section 2) as well as a comprehensive list that falls outside the scope of both derivative and artistic, literary and scientific work (section 5).

As an improvement on the repealed Copyright Act 1997, the Copyright Act now comprises a special provision relating to the protection of “related rights” by which the following are now expressly protected namely:

- performance taking place in Mauritius;
- performance incorporated in phonograms protected under the Copyright Act; and
- performance fixed in phonograms and is included in broadcast protected under the Copyright Act.

However it is to be noted that the pre-condition for a phonogram to be protected under the Copyright Act is that it must have either been produced, first fixed or first published in Mauritius.

Furthermore, in order that broadcast fall within the protection of the Copyright Act the following conditions must be satisfied namely:

- they must emanate from a broadcasting organisation or the headquarters of which are situated in Mauritius; and
- the transmitters for such broadcast must be situated in Mauritius.

Finally, the extent of protection for performers, broadcasting organisations and performers of phonograms extends to those who are entitled to protection by reason of the membership of Mauritius to any international convention or international agreement on these matters or, as may be prescribed.

The obligations undertaken by the Republic of Mauritius pursuant to the Paris Convention for the Protection of Industrial Property of 1883 are expressly provided for by the Copyright Act that recites that the ambit of its protection extends to “a work whose author is a citizen of, or has his habitual residence in, Mauritius or another country party to the Berne Convention” (i.e. the Convention for the Protection of Literary and Artistic Works signed in Berne) (section 31(1)). However, the Copyright Act goes a step further inasmuch as the basis for protection extends to works that are eligible to protection in Mauritius pursuant to any international convention or other international agreement to which Mauritius is a party and as may be prescribed.

The Copyright Act has not captured the system of registration that prevails under the PIDTA. It was the legislator’s intent that “the protection of an author’s work” would rather it provides that every work shall be protected where it is fixed in some material form and irrespective of its mode or form of expression. However, the Copyright Act has maintained the statutory presumption that existed under the repealed Copyright Act 1997 during proceedings founded on the Copyright Act (see below at 3 **Securing Protection – Registration**).

(i) **Setting up of Technological Protection Measures**

The Copyright Act sets up a methodology known as “technological protection measures” by which acts in relation to works or objects of related rights that have not been authorised by a copyright owner are effectively protected.

(i) **The New Prohibitions and Offences**

An important feature of the Copyright Act is that, as part of the obligations of Mauritius under the WIPO Copyright Treaty is it formally introduces provisions on anti-circumvention and rights management information.

**(ii) Anti-Circumvention**

Thus the Copyright Act makes it an offence to circumvent effective technological measures in the comprehensive list of activities contemplated by the Copyright Act. In this regard the legislator has ensured that the phrase “effective technological measures” is defined namely the situation wherein use of a work or related right is controlled by the right holder through a copy control mechanism, an access control or protection process such as encryption, scrambling or other transformation of the work or subject-matter.

**(iii) Rights Management Information**

“Management Information” has been defined and refers to a system by which the author, work, performer and performance of the performer, producer of the phonogram, the phonogram, the broadcaster, the rights of an owner under the Copyright Act is identified or information about the use of work, performance, the phonogram or the broadcast are identified or any number code by which these are identified.

The Copyright Act creates two offences in relation to rights management information:

- First, it is an offence to remove or alter an electronic rights management information without the consent of the right holder;
- Secondly, it is an offence to distribute, import for distribution, broadcast or communicate to the public works or subject-matter protected under the Copyright Act from which the electronic copyright management information has been removed without the consent of the right owner and where such activity will induce, enable, facilitate or conceal an infringement of any right protected under the Copyright Act.

**(iv) The Re-definition of the Functions of the MASA**

The scope of functions of the MASA has been the subject of much controversy during the recent years. In proposing the Copyright Act to the National Assembly, it is clear that the Government of Mauritius has endeavoured to resolve what has been perceived as an uncomfortable and undesirable situation and bring certainty to the issue.

Thus, the Copyright Act now establishes a Mauritius Rights Society, to be known as the “Society” that in effect takes over the role of the MASA as it prevailed under the Copyright Act 1986 and the Copyright Act 1997.

Inasmuch as the Copyright Act extends to performers and phonogram producers, likewise, membership of the Society extends to this new category of authors. The Copyright Act expressly provides that the management of copyright and related rights does not rest exclusively with the Society.

Of interest, the Copyright Act has reviewed the composition of the Society and does not require anymore that one of the members must be a member of the Society and who shall be an author or composer of a work with wide experience and knowledge in copyright matters. On the issue of the functions of the Society, the Copyright Act extends the scope of the Society known under the former copyright legislation as MASA.

Thus, over and above taking over the role and attributions of the MASA, the Society has been vested with an additional function that is comprehensively set out in the Copyright Act. In brief, the additional attribution resides in the function of the Society to manage the rights of authors, including the owners of copyright and related rights.

**(b) THE PIDTA**

The PIDTA protects patents, industrial designs and marks (i.e. trademarks, trade names, service marks, collective marks). As a general proposition the exclusive right to patents, industrial

designs and marks is achieved by registration with the Controller of Industrial Property Office (**Controller**).

The PIDTA defines a patent as “the title granted to protect an invention”, which is in turn defined as “an idea of an inventor which provides the solution to a specific problem in the field of technology” (section 11(1)).

The PIDTA defines the phrase “industrial design” as “any composition of lines or colours or any three-dimensional form, or any material, whether or not associated with lines or colours ..... 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 judged by the eye” (section 27(1)).

The PIDTA sets out an exhaustive definition for marks, collective marks and trade names; the common denominator is that they must be capable of distinguishing the goods and/or services of one enterprise from another (section 35). It also sets out factors that will disqualify an application to register a mark, collective mark and trade name (sections 36(2), (3), (4)).

(c) **THE LAYOUT DESIGNS ACT**

The Layout Designs Act protects “integrated circuit” and “layout-design”.

A “layout-design” is defined as being “synonymous with topography and means the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and some or all of the inter-connections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture”.

As regards an “integrated circuit” it is defined as “a product, in its final form or an intermediate form in which the elements, at least one of which is an active element, and some or all of the interconnections of which are integrally formed on a piece of material and which is intended to perform an electronic function” (section 2).

(d) **THE GI ACT**

The GI Act protects “geographical indication” which it defines as “an indication which identifies a product as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin” (section 2).

(e) **THE PAUP**

As an enabling piece of legislation, the PAUP creates the offence of “unfair practice”. Insofar as the scope of its protection is concerned, it recites that “any of the industrial property enactments” falls within its purview (section 3).

The PAUP has left undefined the phrase “industrial property enactment”. However, as will be seen below, a review of its definition of “unfair practice” reveals that it captures the PIDTA, the Layout-Designs Act and the GI Act.

The PAUP defines the phrase “unfair practice” as an act committed during the course of an industrial or commercial practice and that is contrary to “honest commercial practice”. The PAUP has gone a step further in providing particulars of “unfair practice” in relation to specific pieces of legislation such as the PIDTA, Layout-Designs and the GI Act. Thus, unfair practice also means (a) the “exploitation” (as defined in the PAUP) by any person not being the owner of a registered patent or a registered industrial design without the agreement of the registered owner and, (b) the use of a registered mark by a person other than the registered owner without the agreement of the registered owner.

It is to be noted that the PAUP has left undefined the phrase “honest commercial practice”. However, it has outlined the scope of activities that fall within the ambit of “contrary to honest commercial practice”. These are set out below:

- breach of contract;
- breach of confidence;
- inducement to breach;
- “acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know that any such practice was involved in the acquisition;”
- causing confusion with respect to another’s enterprise or activities in the course of an industrial or commercial activity;
- damaging another’s goodwill or reputation in the course of an industrial or commercial activity;
- misleading the public in the course of an industrial or commercial activity;
- discrediting another’s enterprise or activities in the course of industrial or commercial activities; and
- unfair competition in respect of secret information in the course of industrial or commercial activities

### 3. SECURING PROTECTION - REGISTRATION

#### 3.1 THE COPYRIGHT ACT

As it was indicated at the outset of this Guide, the Copyright Act has not established any similar mechanism for registration of copyright as is the case with the PIDTA.

Instead, the Copyright Act has created a statutory presumption that is applied during legal proceedings based on the Copyright Act namely:

- (a) the plaintiff is presumed to be the owner of the copyright in dispute;
- (b) copyright is presumed to exist in the work to which it relates; and
- (c) the person whose name is indicated on an audiovisual work in the usual manner as producer is the producer of the work

(section 54 (a)(i)(ii)(iii))

However, it is apposite to mention that the aforesaid presumption ceases to operate once the defendant makes ownership of the copyright become a live issue during legal proceedings.

Insofar as the duration of the protection of copyright is concerned, it lasts during the lifetime of an author and for a period of 50 years thereafter. Where copyright is jointly owned, the duration of the protection lasts the lifetime of the last surviving author and for a period of 50 years thereafter. As to an audiovisual work, the economic and moral rights shall be protected for 50 years from the date on which the work was made or first made available to the public by publication, or by any other means, whichever date is the latest. (section 15(1)(2)(3)).

## 3.2 THE PIDTA

### (a) Patents

In order to achieve the exclusive right to a patent an application is to be lodged with the Controller as follows:

- (i) an application form in the English language and in the form set out at either of the Second, Ninth or Fourteenth Schedule of the Patents, Industrial Designs and Trademarks Regulations 2004, as the case may be (**PIDTA Regulations**);
- (ii) documents in support of the application together with translations in the English language where the documents in support are in a foreign language;
- (iii) an original Power-of-Attorney duly registered with the Registrar General of Mauritius where the applicant appoints an approved agent to submit its application; and
- (iv) the relevant fee set out in the First Schedule.

(section 10 of the PIDTA Regulations)

Upon receipt of an application to register a patent the Controller must earmark a filing date to the application (section 18(1)). Further, the Controller must examine whether (a) the application meets the aforementioned requirements and (b) any information concerning the right of priority and foreign application and patents have been furnished (section 19(1)). The PIDTA does not cast any positive duty on the Controller to call for opposition. However, it casts a duty on the Controller to grant a patent where he is satisfied that the requirements of the PIDTA have been fulfilled and, within a period of two years that the Controller has begun to examine the application (sections 6 & 20(1)).

Where the Controller determines that the application does not meet the requirements of the PIDTA he must reject the application and inform the applicant accordingly. The PIDTA has not conferred the Controller with any discretion to provide a conditional acceptance on the proviso that the applicant furnishes the missing elements to the application (section 20(2)).

Once registered, a patent is valid for a period of 20 years from the filing date. The validity of a registered patent during this period is conditional upon the payment of an annual fee to the Controller of Industrial Property Office. The PIDTA expressly declares that a failure to pay the annual registration fee will mean that "the patent application [has] been withdrawn and the patent shall lapse" (section 22(3)).

### (b) Industrial Design

The exclusive right to an Industrial Design in Mauritius is acquired by registration with the Controller.

Two conditions of precedent for the registration of an industrial design under the PIDTA namely:

- First, it must not be contrary to public order or morality (section 18(4)); and
- Secondly, it must be "new". Under the PIDTA in order that an industrial is "new", it must not "have been disclosed to the public, anywhere in the world, by publication in tangible form or by use or by any other way, prior to the filing date or, where applicable, the priority date of the application for registration" (section 28(2)).

Under the PIDTA an application to register an industrial design is made to the Controller as follows:

- (i) the form prescribed by the Ninth Schedule of the PIDTA Regulations duly filled and signed by the applicant or all the applicants where it is a joint application;



- (ii) the application must be supported by four copies of the necessary drawings, photographs or other adequate graphic representations of the industrial design;
- (iii) the application must 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;
- (iv) the application must be accompanied by a specimen of the article embodying the industrial design where the industrial design is two-dimensional and in the size specified; and
- (v) the fee specified in the First Schedule must be paid.

(sections 34 & 35 PIDTA Regulations)

Under the PIDTA, an applicant may insert a declaration claiming priority contemplated under the Paris Convention (section 30(3)).

A registered industrial design is valid for an initial period of period of five years from the filing date of the application. Thereafter, it may be renewed for a maximum of three consecutive periods of five years. The continued registration of a registered industrial design is conditional however upon (a) the application for renewal being made six months before the expiry of the validity period (b) payment of the renewal fees and, (c) compliance with any other conditions that may be prescribed under the PIDTA.

(c) **Marks (i.e. Trademarks, Collective Marks, Service Marks and Trade Names)**

The exclusive right to a mark in Mauritius is gained through registration with the Controller.

Under the PIDTA an application to register a trademark, collective mark or trade name is submitted to the Controller together with the following:

- (i) the prescribed fee;
- (ii) a reproduction of the trademark, collective mark or trade name, as the case may be;
- (iii) the list of classes of goods and services in respect of which the application is made in conformity with the international classification of the same as contemplated under the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks of 15 June 1957 (**Nice Classification**).

The PIDTA authorises an applicant to claim priority as contemplated under the Paris Convention for the Protection of Industrial Property 1883 (**Paris Convention**).

A registered trademark, collective mark or trade name is valid for a period of ten years from the filing date of the application (section 41(1)). At the expiry of the registered period, a registered owner may apply for the renewal of the registration for consecutive periods of ten years provided (a) the renewal fee is paid and (b) any conditions as may be prescribed by the PIDTA are fulfilled (section 41(2)).

### 3.3 THE LAYOUT-DESIGNS ACT

As stated earlier, the Layout Designs Act has not yet come into force in the Republic of Mauritius even though the President of the Republic of Mauritius granted his assent on 08 August 2002.

It is worth mentioning that under the Layout Designs Act there are two conditions of precedent for the registration of an integrated circuit and layout-design namely:

- first, the layout-design must be “original” within the meaning of the Layout-Designs Act and;
- secondly, the layout-design must neither have been commercially exploited nor commercially exploited for more than two years “anywhere in the world”. (sections 3(1)(a)(b) & 4).

In relation to an application to register an integrated circuit and layout-design, the application is lodged with the Controller in the “prescribed” manner namely, as set out at section 8, the contents of which will not be reproduced here.

### 3.4 THE GI ACT

As stated earlier, the GI Act has not yet come into force in the Republic of Mauritius even though the President of the Republic of Mauritius granted his assent on 08 August 2002. However, in order to provide a broad overview of the registration framework of industrial property in the Mauritian territory, the requirements for registration will nevertheless be set out below.

It is apposite to mention that under the GI Act, it is not mandatory that a geographical indication is registered in order that the protection of the GI Act is invoked (section 4).

An application to register a geographical indication under the GI Act is made to the Controller and must comprise the following elements:

- prescribed fee;
- the name, address and nationality of the person filing the application, and the capacity in which the applicant is applying for registration;
- the geographical indication for which registration is sought;
- the geographical areas to which the geographical indication applies;
- the products for which the geographical indication applies; and
- the quality, reputation or other characteristic of the products for which the geographical indication is used

(sections 8 & 9(1)(2))

Upon receipt of an application to register a geographical indication the Controller has a duty to examine whether the application meets the requirements of the GI Act. The Controller must publish the application in the “prescribed manner” where he is satisfied that an application complies with the requirements of the GI Act (section 10((2)).

Any “interested person”, which term has remained undefined, has the right to oppose the application “within the prescribed period and in the prescribed manner” by way of notice and must demonstrate that any one of the requirements of sections 6, 8 and 9 of the GI Act have not been satisfied (section 10(3)). The applicant has a period of once month to send a counter statement stating the grounds on which he relies for his application for registration, failing which the application shall be deemed to have lapsed (section 10(4)(5)). In the event that the applicant sends a counter-statement within the one-month period, the Controller has a duty to hear the parties and thereafter determine whether the geographical indication in question is to be registered (section 10(6)).

## 4. PROCEDURAL LAW – SEEKING RELIEF

### 4.1 COPYRIGHT ACT

As an enabling piece of legislation, the Copyright Act lays down the activities that are tantamount to an offence under its ambit. These are exhaustively set out at section 56. In brief, an offence under the Copyright Act attracts both civil and criminal liability. As a significant departure from the repealed Copyright Act 1997, the Copyright Act declares that notwithstanding “any other enactment, the Magistrate of the Intermediate Court shall have exclusive jurisdiction to try any person at first instance charged with an offence under [the Copyright Act]”. Also, the Copyright Act expressly provides for what has been termed as special remedies.

Insofar as criminal liability under the Copyright Act is concerned, the penalty for a first conviction is a fine not exceeding MUR300,000 [USD11,111] and imprisonment for a term not exceeding two years. In the event of a second conviction, the quantum for the fine is for a maximum of MUR500, 000 [USD18,519] and to imprisonment for a maximum term of eight years.

The Copyright Act has expressly removed the provision in the repealed Copyright Act 1997 dealing with civil remedies. Thus, while the jurisdiction of the Judge of the Supreme Court sitting as a Judge-in-Chambers of the Supreme Court has been preserved, it is now not mandatory anymore that an action for copyright infringement to be lodged by way of *Plaint With Summons* before the Supreme Court such that a copyright owner or author may apply to a Judge in Chambers of the Supreme Court for an injunction or order for a *mesure conservatoire* as is appropriate in the circumstances, for the protection against infringement of his rights under the Copyright Act. Such an order may include (i) (a) the forfeiture or seizure of any infringing copy or any apparatus, article or thing used for the making of the infringing copy (ii) handing over to the copyright owner or author any infringing copy. As mentioned above, exclusive jurisdiction has been conferred to the Intermediate Court. An action may be commenced either by the copyright owner or the "right holder" (section 53).

On the issue of liability, it must be pointed out that as a general proposition and, subject to specific provisions of the Copyright Act, the protection that it affords may not be invoked where a work is reproduced for personal purposes (section 16)).

As indicated at the outset of this Guide, there is no similar mechanism of registration under Copyright Act as under the PIDTA.

However, the Copyright Act has established a statutory presumption that is applied during proceedings based on the Copyright Act namely, (a) copyright subsists in the work to which the action relates (b) the plaintiff is the owner of the copyright in dispute and, (c) the person whose name is indicated on an audiovisual work in the usual manner as producer is the producer of the work (section 42(a)(i)(ii)(iii)).

#### 4.2 PAUP

Under the terms of the PAUP, "unfair practice" attracts both criminal and civil liability. As regards criminal liability, the penalty is a fine of MUR250,000 [USD9,260] and a term of imprisonment not exceeding five years (section 11).

In relation to legal proceedings instituted under the terms of PAUP related to "unfair practice", it is observed that the Supreme Court has been vested with additional powers. Thus the Supreme Court may (a) grant an injunction (b) award damages and (c) "grant any other remedy provided by the law" (section 11).

It is further observed that in relation to proceedings for unfair practice founded on the PAUP, there is a statutory presumption that subsists namely (a) the rights subsists in the work to which the action relates and (b) the plaintiff is the owner of the industrial property in dispute. It is to be noted however that the presumption cease to apply where the defendant in the proceedings disputes the ownership of the industrial property in dispute. The aforesaid statutory presumption ceases once the defendant in legal proceedings for unfair practice makes the ownership of the industrial property a live issue during the proceedings (section 11(3) PAUP).

### 4.3 PIDTA

#### (a) Patents

##### (i) Supreme Court

The PIDTA identifies acts that constitute infringement of a patent and declares that an infringement of a patent attracts civil liability and entitles the owner of a patent to claim damages before the Supreme Court of Mauritius (section 21(3)).

Under the terms of the PAUP, the offence of unfair practice in relation to patents is constituted where a person exploits a patented invention in Mauritius without the agreement of the patent owner (section 52).

Pursuant to the terms of the PIDTA, legal proceedings for unfair practice in relation to patents are to be brought in accordance with the PAUP (i.e. before the Supreme Court), that states that acts of unfair practice attract both criminal and civil liability (section 52(2)).

Under the terms of the PAUP, criminal liability entails a fine of MUR250,000 [USD9,259] and a maximum term of imprisonment of five years.

As regards civil liability under the PAUP, the Supreme Court has been given wide powers inasmuch as it has been vested with the power to (a) grant an injunction (b) award damages (c) grant any other remedy provided for in law (section 11 PAUP). Furthermore, the PAUP has created a statutory presumption that applies during legal proceedings for unfair practice namely (a) the rights subsists in the work to which the action relates and (b) the plaintiff is the owner of the mark. It is to be noted however that the presumption ceases to apply where the defendant in the proceedings disputes the ownership of the mark (section 11(3) PAUP).

##### (ii) Industrial Property Tribunal

The PIDTA provides for further forms of relief namely (a) an appeal under section 10 and, (b) an application for an Order of Invalidation under section 25. Both forms of relief are applied for before the Industrial Property Tribunal set up under the PIDTA (section 10). Also, that neither of the two applications entitles the appellant or applicant, as the case may be, to an award of damages. It is to be noted that the PIDTA Regulations provide for the mode of application for each application namely the forms prescribed at the First and Third Schedules respectively of the Patents, Industrial Designs and Trademarks (Tribunal Rules of Procedure) Regulations 2008 (the **PIDTA Procedural Rules**).

Insofar as an appeal under the PIDTA is concerned, the Industrial Property Tribunal has jurisdiction to hear and determine an appeal from “any person who feels aggrieved by any decision taken by the Controller, other than a decision under section 4(1)(b)[of the PIDTA]” provided that the appeal is lodged within 28 days of the decision of the Controller of Industrial Property Office (sections 10(1)(a), 10(2)). It is apposite to mention that in an appeal under the PIDTA, the Industrial Property Tribunal has a discretion to “take evidence on oath” (section 10(4)(b)).

In relation an application for an Order of Invalidation, the Tribunal may entertain an application from “any interested person”. Insofar as the time-frame for lodging an application for an order of Invalidation is concerned, the Act has not prescribed any deadline for lodging the same before the Industrial Property Tribunal. Further, when considering an application for an Order of Invalidation of a patent, the Tribunal must address the issue of whether the applicant has established that “the requirements of sections 11, 12 and 14 [of the PIDTA] have not been fulfilled or where the owner of the patent is not the inventor nor his successor in title” (section 25(2)). Finally, the PIDTA

has not conferred any statutory discretion on the Industrial Property Tribunal to take evidence on oath when entertaining an application for an Order of Invalidation.

(b) **Industrial Design**

(i) **Supreme Court**

The PIDTA makes it an offence, actionable before the courts, to infringe an industrial design (section 32(4)). The term “infringement” is defined as the “making, selling or [importing] articles bearing or embodying a design which is a copy, or substantially a copy, of the registered industrial design” without the agreement of the registered owner(s) of the industrial design (section 32(2)). The scope of the definition extends to the performance of “an act which is likely to amount to infringement” (section 32(2)).

The PIDTA declares that the offence of unfair practice in relation to an industrial design is constituted where a person “exploits”, as that term is defined there under), an industrial design in Mauritius without the agreement of the registered owner (section 32(1)).

The PIDTA declares that unfair practice attracts both criminal and civil liability and that legal proceedings for the offence of unfair practice are to be brought in the manner prescribed by the PAUP i.e. the Supreme Court. Insofar as criminal liability is concerned, the penalty is a fine not exceeding MUR250,000 [USD9,259] and to a term of imprisonment not exceeding five years (section 51(2)). As regards civil liability, the PIDTA has prescribed any parameters save for reciting that “unfair practice may give rise to a claim in damages” (section 52(1)).

It is observed that in an action for unfair practice founded on the terms of the PAUP, the Supreme Court has been given wide powers inasmuch as it has been vested with the power to (a) grant an injunction (b) award damages (c) grant any other remedy provided for in law (section 11 PAUP).

It is further observed that during legal proceedings for unfair practice for an industrial design, the PAUP has created a statutory presumption that applies namely (a) the right subsists in the industrial design in dispute and (b) the plaintiff is the owner of the industrial design in dispute. It is to be noted however that the presumption ceases to apply where the defendant in the proceedings disputes the ownership of the industrial design (section 11(3) PAUP).

(ii) **Industrial Property Tribunal**

The PIDTA has empowered the Industrial Property Tribunal to entertain two specific applications namely (a) an appeal against the decision of the Controller of Industrial Property Office and (b) an application for an Order of Invalidation of a registered industrial design (sections 10(1)(a) & 34(1)). These applications do not give rise to an award of damages to the appellant or applicant, as the case may be. Also, whilst there is a delay of 28 days to appeal against the decision of the Controller of Industrial Property Office, there is none as regards an application for an Order of Invalidation.

(c) **Mark (i.e. Trademark, Collective Mark, Service Mark)**

(i) **Supreme Court**

The PIDTA entitles the registered owner of a mark or collective mark to apply to the “courts”, as that term is defined under the PIDTA in specific circumstances. First, where there has been an infringement or there is likely to be an infringement, as that term is defined by the PIDTA (section 40(2)). Secondly, where a mark similar to his registered mark is being used and there is the likelihood that the use of the other mark will cause “confusion in the public” (section 40(3)).

The PIDTA declares that the offence of “unfair practice” in relation to a mark (i.e. trademark, collective mark, service mark) is constituted where a person uses a registered mark in Mauritius without the agreement of the registered owner of the mark (section 40(1)). Unfair practice founded on the PIDTA attracts both criminal and civil liability (section 51). Insofar as criminal liability is concerned, the penalty is a fine not exceeding MUR250,000 [USD9,259] and to a term of imprisonment not exceeding five years (section 51(2)). As regards civil liability, the PIDTA has prescribed any parameters save for reciting that “unfair practice may give rise to a claim in damages” (section 52(1)).

Under the terms of the PAUP, it is observed that the Supreme Court has been given wide powers inasmuch as it has been vested with the power to (a) grant an injunction (b) award damages (c) grant any other remedy provided for in law (section 11 PAUP).

It is further observed that during legal proceedings for unfair practice for a mark, the PAUP has created a statutory presumption that applies namely (a) the right subsists in the mark in dispute and (b) the plaintiff is the owner of the mark in dispute. It is to be noted however that the presumption ceases to apply where the defendant in the proceedings disputes the ownership of the mark (section 11(3) PAUP).

(ii) **Industrial Property Tribunal**

The PIDTA authorises “any person” to apply to the Tribunal for an Order invalidating the registration of a mark or collective mark (section 42(1), 44(4)). However, it is to be noted that the Tribunal is not empowered to make any award of damages when granting an Order of Invalidation.

#### 4.4 LAYOUT DESIGNS ACT

The Layout Designs Act makes it an offence of unfair practice to do the following without the authorisation of the person who owns the rights under the Layout Designs Act (section 15(1):

- (a) to “[reproduce], whether by incorporation in an integrated circuit or otherwise, the protected layout-design in its entirety or any part thereof, except the act of reproducing any part that does not comply with the requirement of originality” (as defined under section 4); and
- (b) to “[import, sell] or otherwise [distribute] for commercial purposes the protected layout-design, an integrated circuit in which the protected layout-design is incorporated, or an article incorporating such an integrated circuit in so far as it continues to contain an unlawfully reproduced layout-design”

(section 6(2))

The Layout Designs Act further recites that an act of unfair practice attracts both criminal and civil liability. Insofar as criminal liability is concerned, the penalty is a fine of the order of MUR250,000 [USD9,259] and to a term of imprisonment not exceeding five years. In relation to civil liability, unfair practice gives rise to an action for damages (section 15(1)).

(c) **Supreme Court**

The procedure for lodging proceedings under the Layout Designs Act, they are those prescribed by the PAUP i.e. before the Supreme Court.

The Supreme Court has been given wide powers inasmuch as it has been vested with the power to (a) grant an injunction to prevent an act of unfair practice (b) award damages (c) grant any other remedy that it thinks fit and, (d) order the seizure, forfeiture and destruction of the layout designs, integrated circuits or articles used in connection of the offence (sections 15(2) & 16).

It is further observed that during legal proceedings for unfair practice for a layout design or an integrated circuit, the PAUP has created a statutory presumption that applies namely (a) the right subsists in the layout design or an integrated circuit in dispute and (b) the plaintiff is the owner of the layout design or an integrated circuit in dispute. It is to be noted however that the presumption ceases to apply where the defendant in the proceedings disputes the ownership of the layout design or an integrated circuit (section 11(3) PAUP).

(d) **Industrial Property Tribunal**

The Layout Designs Act declares that the Industrial Property Tribunal has the same jurisdiction as those set out under the PIDTA namely (a) hear appeals (b) entertain an application for an Order of Invalidation (c) issue a ruling on the interpretation of the Layout Designs Act and, (d) authorise an application to exploit a layout design or integrated circuit.

#### 4.5 **GI ACT**

The GI Act makes it an offence of unfair practice to do the specific acts referred to at section 3. It further declares that unfair practice attracts both criminal and civil liability (sections 3(2) & 7). Insofar as criminal liability is concerned, the penalty is a fine of the order of MUR250,000 [USD9,259] and to a term of imprisonment not exceeding five years. In relation to civil liability, unfair practice gives rise to an action for damages (sections 3(2)(4)).

(a) **Supreme Court**

It is apposite to mention that the GI Act creates a statutory presumption that applies during proceedings founded on it namely, that it is presumed that the geographical indication in dispute falls within the definition of a geographical indication set out at section 2 (section 4(2)).

Insofar as legal proceedings under the GI Act are concerned, they are to be brought in accordance with the provisions of the PAUP i.e. before the Supreme Court (section 3(3)).

In this regard, the Supreme Court has been given wide powers inasmuch as it has been vested with the power to (a) grant an injunction (b) award damages (c) grant any other remedy that it thinks fit and (d) "order the forfeiture of any article or thing that were used or gave rise to an act of unfair practice" (sections 3(4) of GI & 52(3) of PIDTA).

Furthermore, the GI Act has created a statutory presumption that applies during legal proceedings brought under it namely (a) that the right subsists in the geographical design in dispute and, (b) the plaintiff is the owner of the geographical design in dispute. The aforesaid presumption ceases once the defendant in proceedings disputes the ownership of the geographical design (section 11(3)).

(b) **Industrial Property Tribunal**

The GI Act declares that the Industrial Property Tribunal has the same jurisdiction as those set out under the PIDTA namely (a) hear appeals (b) entertain an application for an Order of Invalidation (c) issue a ruling on the interpretation of the GI Act and, (d) authorise an application to exploit a geographical indication (section 17).

It is observed that the GI Act has further vested the Industrial Property Tribunal with the power to entertain applications for the cancellation of a geographical indication and for the rectification of the register of geographical designs maintained by the Controller.

Finally, as stated previously in the Guide, the Industrial Property Tribunal does not have the power to make any award for damages as would have been the case before the Supreme Court.

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