

# MADAGASCAR

## Ordinance No. 89-019 Establishing Arrangements for the Protection of Industrial Property in Madagascar

(of July 31, 1989)\*

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1. There shall be established in the Democratic Republic of Madagascar industrial property arrangements for protection by means of patents and inventors' certificates, marks, industrial designs, trade names and for the repression of unfair competition.

2. Industrial property in Madagascar shall be administered by an industrial property agency referred to hereinafter as "the Agency."

## **Title I** **Provisions on Patents and Inventors' Certificates**

### *Section 1* *General Provisions*

3. At the request of the applicant and at his discretion, the Agency shall issue patents or inventors' certificates for patentable inventions.

4.—(1) In all types of industry, any new invention resulting from an inventive activity and that is capable of at least one industrial application shall be patentable.

(2) Notwithstanding any protection subsisting in a patented invention, an improvement thereto satisfying the requirements of paragraph (1) shall also be patentable independently or in the form of a certificate of addition.

5.—(1) An invention shall be new if it does not form part of the state of the art, whereby the state of the art shall comprise everything made available to the public, at any place or at any time, by means of a written or oral description, by use or in any other way, before the date of filing of the patent application or the date of any priority validly claimed for the invention.

(2) Novelty shall not be destroyed by disclosure of the invention at an officially recognized exhibition either on the national territory or in the member countries of the Paris Convention, within the six months preceding filing of a patent application or a validly claimed priority date for the invention, subject to production of a recognized certificate attesting to participation of the inventor or his successors in title at such exhibition during which the public could obtain knowledge of the object incorporating the patentable invention.

(3) Novelty shall not be destroyed if disclosure results from obvious abuse in relation to the applicant or his legal predecessor.

6. To involve an inventive step, an invention may not derive obviously from either the state of the art or the normal skill of a man of the art, whether in its means, its application, the combination of means or the product that is the object thereof, or in the industrial result obtained thereby.

7. An invention shall be considered as susceptible of industrial application if it is capable of manufacture or use in any type of industry.

8.—(1) Subject to the specific regulations in respect of the subject matters listed below, applications for patents or inventors' certificates shall not be admissible or shall be rejected where they concern:

(i) inventions contrary to public policy or morality;

(ii) plant or animal varieties or essentially biological processes for the production of plants or animals;

(iii) software;

(iv) methods, systems, schemes, discoveries and scientific theories as also abstractions of pure form that do not solve a material problem or do not provide a tangible technical solution, notwithstanding the protection of practical applications that incorporate them to meet the requirements of Article 4;

(v) pharmaceutical, veterinary, cosmetic and food products.

(2) Patents and inventors' certificates obtained contrary to paragraph (1) shall be null and void.

**9.** The President of the Republic may decree the exclusion from patentability, either provisionally or definitively, of certain categories of invention where required by the vital interests of education or teaching, public health, the economy or national defense.

**10.** The protection afforded to a patent or an inventor's certificate shall be 15 years as from the filing date of the application. However, if the national interest so demands and the invention is worked in the country in a serious and satisfactory manner, an additional term of five years may be afforded to the patentee or licensee or to the holder of the inventor's certificate, at such person's request.

**11.** A certificate of addition shall terminate together with the patent or inventor's certificate.

## *Section 2*

### *Right to a Patent or an Inventor's Certificate*

**12.**—(1) Subject to Article 16 and Article 28(1), the right to a patent or an inventor's certificate shall belong to the inventor or his successor in title.

(2) The person who first files an application for a patent or an inventor's certificate or who first validly claims priority in respect of an application for a patent or an inventor's certificate concerning the same invention shall be considered, subject to Articles 14, 15 and 16, the inventor or his successor in title.

**13.** Where an invention is the result of collaboration between a number of persons, the right to the patent or the inventor's certificate shall belong collectively to those persons or their successors in title. However, a person who has simply given his assistance in the execution of the invention without contributing a decisive inventive activity shall not be considered an inventor or joint inventor.

**14.** If essential elements of an application for a patent or inventor's certificate or of a patent or inventor's certificate have been taken by the applicant from the results of work or research by some other person without the consent of that latter person, with respect either to the borrowing or to the filing of the corresponding application, the person injured by such unlawful usurpation may institute legal proceedings to obtain transfer to himself of the application or the patent or the inventor's certificate.

**15.**—(1) The true inventor shall have the right to be mentioned as such in the patent or inventor's certificate.

(2) The provision under paragraph (1) may not be modified by contract.

**16.**—(1) Subject to the legal or statutory provisions, the right to a patent with respect to an invention made in execution of an employment contract or service regulations shall belong to the employer.

(2) The same provision shall apply in those cases where the employee is not required by his employment contract or service regulations to engage in inventive activity, but has made the invention by using data or means available to him through his employment.

(3) The principle and conditions of the material or moral counterpart resulting therefrom for the employee-inventor shall be determined by the parties involved themselves.

*Section 3*  
*Grant of Patents and Inventors' Certificates*

**17.** Applications for a patent or inventor's certificate shall satisfy the following requirements:

(1) Applications shall be drawn up on the form prescribed in the implementing decree and shall contain all the required information.

(2) Applications shall be accompanied by:

(i) a description followed by one or more claims;

(ii) where appropriate, one or more drawings;

(iii) a descriptive abstract.

(3) Applications shall be drafted in one of the following languages:

(i) Malagasy;

(ii) French;

(iii) the Agency shall be entitled to request a translation into the other language.

**18.**—(1) The description shall set out the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art without him being obliged to himself undertake an inventive activity. It shall describe the best manner of carrying out the invention to the knowledge of the applicant.

(2) The claims shall define the matter for which protection is sought. The claims shall be clear and concise. They shall be entirely supported by the description.

**19.**—(1) Drawings shall be required in each case where they are necessary for the understanding of the invention.

(2) If the invention is such that it may be illustrated by drawings, even if they are not necessary for its understanding:

(i) the application may include such drawings on filing;

(ii) the Agency may require the applicant to provide such drawings within the period of time prescribed, notwithstanding the provisions of paragraph (1).

**20.** The descriptive abstract shall merely serve the purpose of technical information and may not be taken into account for any other purpose.

**21.**—(1) An application may concern only one invention.

(2) An application comprising more than one invention shall be divided into two or more independent applications.

(3) Notwithstanding paragraphs (1) and (2), applications may include in their claims:

(i) where the subject matter of the application is one or more products, the manufacturing process or processes and the application or applications of such product or products;

(ii) where the subject matter of the application is one or more processes, the means of carrying out the processes or the product or products deriving from the carrying out of the process or processes.

**22.**—(1) Any person wishing to avail himself of the priority of an earlier filing in accordance with the Paris Convention shall be required to attach to his application or to submit within a period of six months as from the filing of the application, on pain of inadmissibility:

(i) a written declaration giving the date and number of such earlier filing, the country in which it was made and the name of the applicant;

(ii) an official copy of such earlier filing issued by the country of origin of the priority, accompanied by a translation in the French language;

(iii) a written, legalized authorization from the applicant or his successors in title empowering such person to avail himself of the priority if such person is not the person who made the initial filing.

(2) The provisions of paragraph (1) shall remain valid for a group of priorities claimed by the applicant.

**23.**—(1) Admissibility of the application shall be conditional on payment of the prescribed application fee.

(2) Payment shall only be effective on receipt of the payment voucher enabling a receipt to be drawn up in due form. The receipt shall be valid only if it bears the authenticating stamp of the Agency.

(3) The Agency shall give a filing date which shall be the date of receipt of the application on condition that, at the time of receipt, the application fee has been paid and the application, drawn up in compliance with Article 17(1) and (3), contains the elements referred to in paragraph (2)(i) and (ii) of that Article. The implementing decree shall lay down the details of these requirements.

**24.**—(1) The administrative examination of the application shall consist in checking that the prescribed fee has been paid and that the main elements of the filing are correct:

(i) drawing up of the application;

(ii) correct presentation of the description and claims;

(iii) presence of the drawings and their correct execution for reproduction purposes; where appropriate:

(iv) the powers of the representative or agent;

(v) the required translations;

(vi) the documents concerning assignment of priority and any other justifying document concerning the rights of the true inventor.

(2) The administrative examination of the application shall likewise consist in entering the prescribed classes thereon and identifying any plurality in place of the prescribed unity of invention.

**25.**—(1) Each application filed for a patent or an inventor's certificate shall be subject to a state-of-the-art search report and a patentability examination.

(2) The search reports referred to in paragraph (1), drawn up as prescribed by the implementing decree, shall either be provided by the applicant or be drawn up as laid down in the implementing decree.

(3) The patentability examination shall be carried out on the basis of the search report relating to the application. Its purpose is to determine:

(i) whether the subject matter of the application is patentable under Articles 4 to 8;

(ii) whether the description of the invention and the claims contained in the application satisfy the requirements of Article 18.

(4) The President of the Republic may decree that application of paragraphs (1) to (3) be suspended, in whole or in part, either for all categories of inventions or for specific categories.

**26.**—(1) If the application meets the requirements of Articles 7, 23 and 24, the Agency shall register the patent or, subject to paragraph (2), the inventor's certificate.

(2) The State may refuse to grant an inventor's certificate. Where such is the case, the Agency shall issue a patent in place of the inventor's certificate.

(3) Patents or inventors' certificates in respect of which an application has been properly constituted shall be issued at the responsibility of the applicant or applicants and without Government warranty as to the existence of novelty or to the correctness or exactness of the description.

(4) Following issue and registration of a patent or an inventor's certificate, the Agency shall proceed with its publication in the Official Gazette of Industrial Property.

(5) If the Agency refuses grant, the applicant may, within one year from the date of notification of refusal, enter an appeal before the competent court.

#### *Section 4*

#### *Rights Deriving from a Patent or an Inventor's Certificate*

**27.** Subject to the legislation in force, a patent shall afford to its holder the right to prohibit others from carrying out the following acts:

(a) Where the patent has been awarded for a product:

(i) manufacturing, importing, offering for sale, selling or using the product;

(ii) holding the product for the purposes of offering for sale, selling or using;

(b) Where the patent has been granted for a process:

(i) using the process;

(ii) carrying out the acts referred to above with respect to the product as resulting directly from use of the process, subject to Article 8.

**28.**—(1) Until grant of an inventor's certificate, the rights deriving from the application shall belong to the applicant and the obligations shall be incumbent on him.

(2) Once an inventor's certificate has been granted, the right to carry out the acts referred to in Article 27 shall belong to the State unless the State decides otherwise.

(3) The working of an invention covered by an inventor's certificate shall be effected at the initiative of the State that assumes the rights of the inventor. On the advice of the Agency, based on data supplied by the inventor, the State shall undertake to afford to the owner of the inventor's certificate adequate remuneration and/or other corresponding advantages.

(4) The detailed conditions of transfer of the rights and remuneration therefor shall be laid down in the implementing decree, supplemented by other regulatory texts where necessary.

**29.**—(1) The extent of protection afforded by a patent or inventor's certificate shall be determined by the content of the claims in the wording finally accepted.

(2) The description and drawings contained in the application shall serve to interpret the claims.

**30.**—(1) The rights deriving from a patent or an inventor's certificate shall extend only to acts carried out for industrial and commercial purposes.

(2) The rights deriving from a patent or an inventor's certificate shall not extend to acts carried out with respect to the product covered by the patent or inventor's certificate once the product has been lawfully sold within the country.

(3) The rights deriving from a patent or an inventor's certificate shall not extend to the presence or use of products on board foreign vessels, space vehicles, aircraft or land vehicles that temporarily or accidentally enter the waters, air space or land of the country.

**31.** Anyone who, on the national territory, at the filing date of the application for a patent or an inventor's certificate by another person, or at the date of priority validly claimed for such application, was, in good faith, manufacturing the product or using the process, shall have the right, despite the patent or inventor's certificate, to continue carrying out such acts and, with regard to the products thus manufactured, carrying out the other acts referred to in Article 27.

**32.**—(1) The maintenance in force of an application for a patent or inventor's certificate, a patent or an inventor's certificate shall be dependent upon payment of a renewal fee due on the anniversary date of the filing of the application.

(2) A six-month period of grace, subject to a surcharge for late payment, shall be afforded for the payment of each annual fee.

(3) Failure to comply with the provisions of the preceding paragraphs shall automatically lead to lapse of the patent or inventor's certificate or of any certificate of addition under either of those titles. Failure to comply, with respect to an application, shall amount to a tacit statement of withdrawal of the application.

**33.**—(1) Any person who, for reasons of force majeure, has been unable to comply with the time limits laid down by law for carrying out an act and who, for that reason, loses any right deriving from an application for a patent or an inventor's certificate or from a patent

or inventor's certificate that has been granted, may request restoration of such right if he furnishes proof relating to his failure to comply.

(2) Examination of the request shall be subject to prior payment of the fee before the Agency acts and takes a decision.

(3) An appeal shall lie from refusal by the Agency to restore lost rights to the court competent for the headquarters of the Agency.

*Section 5*  
*Assignment and Transfer of Rights, Licenses*

**34.**—(1) A patent application or a patent may be assigned *inter vivos* or transferred on death.

(2) Any transfer of rights, in part or in whole, whether temporarily or definitively, deriving from a patent application or a patent shall be recorded in writing and bear the legalized signature of the parties concerned.

(3) Notwithstanding the provisions of the Code of Registration and Stamps, any document drawn up in accordance with paragraph (2) may only be invoked against others if it has been recorded with the Agency.

(4) The contract shall enter into force only after an examination of advisability leading to a favorable decision by the competent authority.

**35.**—(1) The applicant or patentee may, by contract, grant a license to work his invention to another person or enterprise.

(2) Should the national market be insufficiently supplied or certain external outlets arise for exploitation of the invention, the licensor may, unless he has granted an exclusive license, sign a number of contracts, that will be examined in accordance with the provisions of Article 34(4).

(3) The licensee shall be entitled to work the invention during the period of time stipulated in the contract. Should he be prevented from so doing, he shall inform the authority thereof, giving reasons for his incapability.

(4) The licensee may not grant sublicenses. Subcontracting under his direct responsibility may not be interpreted as a sublicensing agreement.

**36.**—(1) Any interested natural or legal person may request, on the expiry of a period of four years as from the filing date of the patent application or three years as from the date of grant of the patent, the period of time that expires last being applied, from the competent court the grant of a compulsory license, against fair and equitable remuneration, on one or more of the following grounds:

(i) the patented invention has not been worked or has been insufficiently worked within the country;

(ii) the patentee refuses to grant licenses under reasonable conditions;

(iii) working of the patented invention within the country does not satisfy, under reasonable conditions, demand for the product.



(2) When applying paragraph (1), a compulsory license shall be granted only if the patentee is unable to give legitimate grounds for the lack of working or insufficient working within the country.

(3) The compulsory license shall be non-exclusive and may only be transferred, even in the form of the granting of a sublicense, together with the establishment of the beneficiary of the license or with that part of the establishment within which the patented invention is being worked.

(4) A compulsory license may only be withdrawn as the result of a court decision.

**37.**—(1) Any owner of a patent who is not prevented by the conditions of an earlier license may request the Agency to enter in the special register, with respect to his patent, the notice “license of right.” Such notice shall afford to any interested person the right to obtain a license to work that patent under conditions which, failing agreement between the parties, shall be laid down by the competent court.

(2) The State may obtain *ex officio*, at any time for reasons of public interest, a license to work an invention that is covered by a patent application or a patent whether such exploitation be carried out by the State itself or on its behalf. The royalties due under an *ex officio* license shall be determined by agreement between the State and the applicant or owner of the patent or the successor in title of the applicant or owner. Failing amicable agreement, the royalties shall be laid down by the competent court within the meaning of Article 135.

#### *Section 6* *Special Register*

**38.** There shall be instituted a special register of patents and inventors’ certificates in which shall be entered:

(i) the following operations involving a change of any kind in the application for a patent or an inventor’s certificate or in the patent or inventor’s certificate:

- change of applicant;
- change of owner;
- change of applicant’s or owner’s address;
- change of applicant’s or owner’s name;
- withdrawal of the application;
- relinquishment of the application;
- cancellation of the patent or inventor’s certificate;

(ii) acts concerning licenses of all kinds and assignments;

(iii) court decisions.

**39.**—(1) The special register, numbered and initialed, shall be set up and kept in compliance with the implementing decree.

(2) No entry shall be made in the special register without prior payment of the required fee.

**40.** The register may be consulted by the public. Copies may be obtained of all information, except that covered by Article 37(2). The conditions for consulting the register or obtaining information shall be laid down in the implementing decree.

*Section 7*  
*Infringement of Rights and Legal Action*

**41.**—(1) Any infringement of the rights under a patent or an inventor's certificate shall constitute an offense punishable by imprisonment of between six months and three years and a fine of between MGF 500,000 and 10,000,000 or one of those penalties only.

(2) In the event of a repeated offense, the penalty shall be doubled.

**42.**—(1) On a request supported by presentation of his title, the owner of a patent or inventor's certificate may, by virtue of an order issued by the presiding judge of the civil court of the place of infringement, direct any bailiffs or any law officers, assisted where necessary by an expert, to proceed with the identification and detailed description, with or without seizure, of the allegedly infringing articles.

(2) In the event of seizure, the petitioner shall be required to provide a guarantee beforehand.

(3) Copies of the record of the articles described or seized by virtue of an order and of the instrument recording deposit of the guarantee shall be handed to the author of the alleged infringement, on pain of nullity and of damages against the bailiff or law officer.

(4) Without prejudice to the damages that may be claimed and on pain of nullity, the petitioner shall institute proceedings before the court within one month of the seizure or of the record of description.

**43.**—(1) Confiscation of articles acknowledged to be infringing and, where appropriate, the means that have served for their manufacture may be ordered.

(2) The confiscated articles and equipment shall be handed to the owner of the patent or inventor's certificate, without prejudice to damages, posting or publication of the decision.

**44.**—(1) The beneficiary of a registered license may, by registered mail with acknowledgment of receipt, require the owner of the patent to institute proceedings with regard to any infringement of the patent that he has notified to him.

(2) If the owner of the patent refuses or fails to institute such proceedings within three months of notification, the licensee may act in his own name where not otherwise stipulated in the contract.

**45.**—(1) The competent court may annul a patent or inventor's certificate subsequent to a request by the public prosecutor and any other person concerned.

(2) A patent or inventor's certificate that has been annulled shall be deemed to have been without effect as from the date on which it was granted.

*Section 8*  
*International Applications*

**46.** The procedures relating to international applications for patents or inventors' certificates within the meaning of the Patent Cooperation Treaty of June 19, 1970, (hereinafter referred to as "the PCT") shall be governed by the provisions of the PCT, its Regulations and

Administrative Instructions, together with the provisions of this Ordinance. In the event of divergence, the provisions of the PCT, its Regulations and Administrative Instructions shall prevail.

**47.**—(1) The Agency shall act as a receiving Office under Article 2 of the PCT with regard to international applications filed by natural or legal persons domiciled on the territory of the Democratic Republic of Madagascar or who are Malagasy nationals.

(2) In addition to the fees laid down by the PCT, the international application shall be subject to payment of a transmission fee to be laid down by the implementing decree referred to in Article 139 of this Ordinance.

(3) The President of the Republic may decree that the duties of receiving Office be transferred to another national office or to an intergovernmental organization.

**48.**—(1) The Agency shall act as a designated Office under Article 2 of the PCT for international applications seeking protection for the invention in the Democratic Republic of Madagascar.

(2) Once it has been allocated a filing date, any international application for which the Agency acts as the designated Office shall produce on the national territory the same effects as an application filed in due form with the Agency.

(3) Where the international search has not been carried out for all claims, the Agency shall levy, in accordance with Article 17(3)(b) of the PCT, a fee for drawing up a supplementary state-of-the-art search report.

**49.** The Agency shall constitute an elected Office where the applicant has mentioned the Democratic Republic of Madagascar as a designated contracting State in which he wishes to use the results of the international preliminary search under Article 2(xiv) and Chapter II of the PCT.

**50.** Even where the initial application has been filed with the Agency, the priority right under Article 22 of this Ordinance may be claimed for an international application.

**51.**—(1) An international-type search under Article 15(5) of the PCT may be requested by the applicant with respect to a Malagasy patent application.

(2) The request shall be filed with the Agency within six months following the filing date. The international search fee shall be paid at the same time.

(3) The Agency shall not verify whether the patent application and, where appropriate, the translation meet the other requirements laid down by the PCT, particularly the formal requirements valid for international applications.

(4) Where the requirements of paragraphs (1) and (2) have been met, the Agency shall transmit the required documents to the competent office responsible for the international search.

**52.** The international search report referred to in Article 18 of the PCT, the international-type search report referred to in Article 51 of this Ordinance and the preliminary international search report referred to in Article 35 of the PCT shall replace the search report referred to in Article 25 of this Ordinance.

**53.** The time limits laid down in Article 22(1) and Article 39(1) of the PCT may be extended by decree.

**54.** The provisions of this Ordinance shall apply to international applications filed prior to the entry into force of this Ordinance.

## **Title II**

### **Provisions on Trademarks**

#### *Section 1*

#### *General Provisions*

**55.**—(1) For the purposes of this Ordinance:

(i) “mark” shall mean any visible sign intended and capable of distinguishing the goods or services of one enterprise from those of other enterprises;

(ii) “collective mark” shall mean any visible sign designated as a collective mark at the time of filing that is intended and capable of identifying the origin, quality or any other common characteristic of goods or services of various enterprises which use the collective mark under the control of the owner;

(iii) “enterprise” shall mean any natural or legal person carrying on an industrial, agricultural, craft or commercial activity.

(2) Shall be considered as marks under paragraph (1), surnames as such or in a distinctive form, special, arbitrary or fancy denominations, the characteristic form of a product or of its wrapped presentation, labels, envelopes, emblems, prints, stamps, seals, colors, designs, reliefs, letters, devices, slogans, pseudonyms and, in general, any materialized signs that are sufficiently distinctive for the use for which they are intended.

(3) The use of a generic term as a mark may not be subject to individual appropriation. Recourse to a generic term for use in a completely different field shall be permitted unless it may constitute a source of error or confusion for the local consumer.

**56.** The use of a mark shall be optional except in those fields expressly defined by other legislative or regulatory provisions.

**57.**—(1) Signs the use of which is contrary to public policy or morality and which, in particular, are liable to deceive trade circles or the public as to the nature, the source, the manufacturing process, the characteristics or the suitability for their purpose, of the goods or services concerned, may not constitute a mark or form part of a mark and shall not be registered.

(2) In compliance with Article 6ter of the Paris Convention, signs which reproduce or imitate the armorial bearings, flags and other emblems, official signs or hallmarks adopted by a State, initials, names or abbreviations of names of any State or of any intergovernmental international organization shall be excluded from any application for protection and may not be registered in the form of a mark, unless authorized by the competent authority of such State or organization.

(3) The following shall not be protected or registered as a mark:

(a) A sign which is incapable of distinguishing the goods or services of one enterprise from those of other enterprises, particularly where:

(i) the sign consists of the shape of the goods concerned or of their packaging and such form is imposed by the inherent nature or function of such goods or of their packaging;

(ii) the sign consists exclusively of an indication which may serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, time of production or of supply or other characteristics of the goods or services concerned;

(iii) the sign consists exclusively of an indication which has become, in the current language or in the bona fide and established practices of local trade, a customary designation of the goods or services concerned.

When assessing whether a sign is incapable of distinguishing the goods or services of one enterprise from those of other enterprises, account shall be taken of all factual circumstances, particularly any use of the sign as a mark prior to the time of the decision on registration.

(b) A sign that consists exclusively or in part of a geographical indication liable to mislead as to the geographical origin of the goods and services concerned or which, if it were registered as a mark, would unduly interfere with use of the geographical indication by those persons, other than the owner of the registration, that are entitled to use such indication.

(4)(a) A sign that conflicts with a prior right shall not be protected nor registered as a mark.

(b) Subject to subparagraph (c), where the mark belonging to an enterprise or a collective mark is the subject of a registration or of a pending application for registration and a further enterprise files an application for registration as a mark, for identical or similar goods or services, a sign that is identical or similar to the extent of probable confusion, the latter sign shall be deemed to conflict with a prior right.

(c) Subparagraph (b) shall also apply where the mark has ceased to be registered one year at the most before the date on which the application has been filed by the other enterprise or where the collective mark has ceased to be registered five years at most before such date.

(d) For the purposes of subparagraphs (b) and (c), account shall be taken of all other claimed priorities for the pending application for registration and for the application filed by the other enterprise.

## *Section 2*

### *Right to a Mark*

**58.**—(1) Subject to Article 133(4), a mark shall belong to the person who was the first to file an application with the Agency.

(2) No person may claim an exclusive right in a mark unless he has validly filed an application.

(3) Where a registered mark has been used publicly and continuously on the national territory for at least three years without having given rise to legal action that has been upheld, property in the mark shall belong to the owner of the registration without possible opposition on the grounds of prior use by another person unless it be proved that at the time of filing the applicant could not have been unaware of such other person's mark.

(4) Use of the mark may only be proved by written matter, printed matter or documents contemporary with the use that they claim to prove.

**59.**—(1) Anyone wishing to claim the priority of an earlier filing of a mark carried out in a country party to the Paris Convention shall be required to attach to his application or to file at the latest within three months of the filing of the application, on pain of inadmissibility:

(i) a written declaration giving the date and number of such earlier filing, the country in which it was filed and the name of the applicant in such country;

(ii) an official copy of such earlier filing issued by the country of origin and accompanied by an authorized translation in the French language;

(iii) a written, legalized authorization from the first applicant or his successors in title empowering the applicant to claim such priority, if he is not the person who made the first filing.

(2) Paragraph (1) shall remain applicable where a group of priorities have been claimed by the applicant.

(3)(a) Nationals of countries of the Paris Union for the Protection of Industrial Property who present goods bearing a mark or services sold under such mark at an official or officially recognized international exhibition held on the national territory shall enjoy, within six months of the day on which such goods or services have been shown for the first time under that mark, a priority right with respect to an application for the mark filed with the Agency.

(b) The right afforded by subparagraph (a) shall not extend any time limit for a priority claimed under paragraph (1) of this Article.

### *Section 3 Procedure*

**60.** Applications for the registration of a mark filed with the Agency shall comply with the following requirements:

(1) The application shall be drawn up on the form prescribed by the implementing decree and shall contain the required information.

(2) Subject to Article 79, the application shall be accompanied by:

(i) a reproduction, in the format laid down in the prescribed form, of the mark in the form of a label in black and white and, where appropriate, in color;

(ii) a list of the goods or services for which the mark is to be used, classified in accordance with the classification annexed to the implementing decree;

(iii) evidence of payment of the fees;

(iv) the claim to priority, where appropriate;

(v) a printing block of the mark.

(3) The application shall be drafted in one of the following languages:

(i) Malagasy, accompanied by a translation in the French language;

(ii) French.

**61.—**(1) Admissibility of the application shall be conditional on payment of the prescribed application fee.

(2) Payment shall only be effective on receipt of the payment voucher enabling a receipt to be drawn up in due form. The receipt shall be valid only if it bears the authenticating stamp of the Agency.

(3) The Agency shall give a filing date which shall be the date of receipt of the application on condition that, at the time of receipt, the application fee has been paid and the application, drawn up in compliance with Article 60(1), contains the elements referred to in paragraph (2)(i) and (ii) of that Article. The implementing decree shall lay down the details of these requirements.

**62.**—(1) Prior to registration, the mark shall be subjected to an administrative examination and a substantive examination.

(2) In the event of legal proceedings and if the mark has not yet been registered, the applicant may request, on submission of grounds, an emergency examination procedure with the Agency.

**63.**—(1) Administrative examination of the application shall consist in ascertaining that the prescribed fee has been paid and that the main elements of the filing are correct:

- (i) drafting of the application;
- (ii) presence of the reproduction of the mark and its correct execution for reproduction purposes;
- (iii) presence of the list of goods or services; where appropriate:
- (iv) presence of the regulations referred to in Article 79 in the case of a collective mark;
- (v) powers of the representative or agent;
- (vi) the requested translations;
- (vii) any documents relating to assignment of priority;
- (viii) the printing block of the mark.

(2) The administrative examination of the application shall likewise consist in checking and/or entering the prescribed classes.

(3) Where the application does not comply, the applicant or his successor in title shall be invited to make the necessary corrections in accordance with the conditions laid down in the implementing decree.

**64.**—(1) Applications for registration of a mark that satisfy the requirements of Article 63 shall be subject to a substantive examination to ascertain whether or not they conflict with Article 57.

(2) If the Agency ascertains that the mark meets the requirements of paragraph (1), it shall carry out the registration of the mark and publish it in the Official Gazette of Industrial Property.

(3) Where the Agency refuses registration, the applicant may enter an appeal, within the prescribed time limit, before the competent court.

(4) A registered mark may be consulted free of charge at the Agency and a copy thereof may be issued at the cost of the person requesting the copy.

(5) By decree of the President of the Republic, the Agency may suspend, in whole or in part, application of the requirements laid down in paragraph (1).

**65.** A certificate identifying the mark may be issued to the applicant or his successor in title. The certificate identifying the mark shall bear an indelible stamp “examined” or

“non-examined” and, in the former case, refusal of protection for part or all of a certain class of goods.

*Section 4*  
*Rights Deriving from Registration*

**66.** Registration of a mark shall afford to its owner the right to prohibit others from carrying out the following acts:

(a) any commercial use of the mark or sign or of a trade name resembling it in such a way as to mislead the public, for goods or services for which the mark is registered or for other goods or services for which use of the mark or sign could mislead the public;

(b) any other use of the mark or of a sign or a trade name resembling it, without just cause and under conditions likely to be prejudicial to the owner of the mark.

**67.** Registration of a mark shall not afford to its owner the right to prohibit others from using in good faith their names, addresses, pseudonyms, geographical names, or exact statements on the type, quality, quantity, purpose, value, standards, place, origin or period of production of their goods or the provision of their services on condition that it concern a use limited to the purposes of simple identification or information and may not mislead the public as to the source of the goods or services.

**68.**—(1) Registration of a mark shall not afford the owner the right to prohibit others from using the mark in relation to goods lawfully sold in the country under that mark, providing that such goods have not undergone any change.

(2) Registration of a mark shall not afford the owner the right to prohibit the publication of specific studies or of comparative tests of goods or services of various brands for the use of consumers.

**69.**—(1) The term of protection for a registered mark shall be 10 years as from the filing date.

(2) The owner of a mark may, within the 12 months preceding expiry of the term of the registration, request renewal of his mark on simple payment of the prescribed fee. Nevertheless, a six-month period of grace shall be afforded for payment of the fee following expiry, on payment of a surcharge laid down in the implementing decree. Failure to renew within the prescribed time limit shall lead automatically to lapse of the mark.

**70.**—(1) Any person who has allowed his mark to fall into the public domain or become everyday language without having taken measures to prevent abuse, such as counterfeiting, imitation or usurping of his mark, shall forego his rights in that mark.

(2) Any person who, for reasons of force majeure, has not been able to comply with the time limits laid down by law for carrying out an act and who, for that reason, loses any right deriving from an application for registration of a mark or to a registered mark may request restoration of such right if he furnishes proof relating to his failure to comply.

(3) Examination of the request shall be subject to prior payment of a fee before the Agency acts and takes a decision.



*Section 5*  
*Transfer of Marks, Licenses*

**71.**—(1) The rights attaching to a mark that has been applied for or registered may, independently of the transfer of all or part of the enterprise using the mark, be assigned or transferred with regard to all or part of the goods or services for which the mark is intended.

(2) The assignment or transfer of the rights may not be effected for the purpose of evading the law or of misleading the public in any way whatsoever.

(3) Acts relating to rights deriving from a mark involving transfer of ownership or the granting of a right of exploitation or cession of such right or pledge or release of pledge, shall be recorded in writing, on pain of nullity.

(4) Notwithstanding the provisions of the Code of Registration and Stamps, any document drawn up in accordance with paragraph (3) must be recorded with the Agency in the Special Register of Marks in order to be invocable against third parties.

(5) The contract shall enter into force only once its advisability has been examined and the competent authority has given a favorable decision.

**72.**—(1) For the purposes of this Ordinance, “licensing contract” shall mean any contract by which one party (the licensor) gives his agreement to the other party (the licensee) for the carrying out by such other party, with respect to the registered mark, of the acts referred to in Article 71.

(2) Paragraph (1) shall also apply where the licensing contract concerns a mark that is the subject of an application for registration.

**73.**—(1) A mark licensing contract must be in written form and must be signed by the parties, failing which it shall be null and void.

(2) A mark licensing contract that has already been concluded may be recorded in compliance with the implementing decree on payment of the prescribed fee. No person may rely on the fact that he did not have knowledge of a recorded licensing contract.

**74.** A licensing contract must provide for an effective guarantee given by the licensor to the licensee with respect to the goods or services for which the mark is used.

**75.** Unless otherwise stipulated in the licensing contract or during the term of validity of the contract, the licensee shall be entitled to carry out, with respect to the registered mark, all the acts referred to in Article 66 during the whole term of the registration, taking into account any renewals on the whole national territory and for all goods or services for which the mark has been registered.

**76.**—(1) Unless otherwise stipulated in the licensing contract, no agreement given by the licensee to a third party for carrying out the acts referred to in Article 66 shall be valid.

(2) A licensing contract may not permit the assignment of the license or the granting of sublicenses unless an effective guarantee is provided, by the owner of the registration of the mark, of the quality of the goods or services of any assignee or any sublicensee, for which the mark is used.

**77.**—(1) All acts concerning a mark, including those referred to in Article 71(3), must be entered in the special register of marks kept for that purpose at the Agency.

(2) The special register of marks may be consulted by the public. Copies of all information contained in the register may be obtained. The conditions for consultation or for obtaining information shall be laid down in the implementing decree.

*Section 6*  
*Collective Marks*

**78.** Subject to the provisions of this Article, the provisions of this chapter that are common to all marks shall remain of application to collective marks.

**79.—(1)** The filing of a collective mark shall be valid only if:

(a) it is accompanied by the regulations that govern the use of the mark, duly certified by the applicant or applicants;

(b) those regulations lay down:

(i) the common characteristics or qualities of the goods or services to be designated by the mark;

(ii) the conditions under which the mark may be used;

(iii) the conditions under which persons are authorized to use the mark;

(iv) the conditions for verifying the use of the mark;

(v) the sanctions foreseen for incorrect use of the mark in accordance with the regulations as filed.

(2) The filing of a collective mark shall identify:

(a) either a member chosen by the totality of applicants to represent them and to assume all relations with the Agency;

(b) or a representative designated in compliance with the requirements of Article 132.

**80.** The examination, registration and publication of a collective mark shall take into consideration the regulations as defined in Article 79.

**81.—(1)** Any change affecting the use of a collective mark shall have effect only after recording with the Agency, on payment of a fee laid down in the implementing decree.

(2) Such change shall be published in accordance with Article 80.

**82.—(1)** The competent court may, at the request of any competent authority or of any person proving a legitimate interest, and after having given the owner the opportunity to be heard, declare null and void the registration of a collective mark:

(i) if the mark does not meet the requirements of Articles 55, 57 and 59;

(ii) if the owner permits, tolerates or is unaware of, for lack of adequate verification, the use of the mark in a way that is contrary to the regulations or is likely to mislead the public or trade circles.

(2) Where the grounds for nullity are given only for one class of goods or services or for certain goods or services within a certain class, the registration shall be null and void only for that part of the goods or services.

*Section 7*  
*Cancellation and Lapse of Registrations*

**83.**—(1) The competent court may, at the request of a competent authority or of any person proving a legitimate interest, and after having given the owner an opportunity to be heard, declare null and void the registration of a mark with effect from the date of registration if:

(a) the mark does not meet the requirements of Articles 55 and 57;

(b) the mark conflicts with a prior right in respect of the same goods or the same services.

(2) Where the grounds of nullity are given for only one class of goods or services or certain goods within a certain class, nullity of the registration shall be declared for that part of the goods or services only.

(3) The property right in a mark shall lapse:

(a) on renunciation by a written declaration from the owner;

(b) on expiry of the period referred to in Article 69(1) if renewal of the registration has not been requested within the time limits set out in paragraph (2) of that Article;

(c) as the result of a final decision by the competent court declaring the registration to be null and void or ordering its removal.

(4) The property right in a mark shall also lapse for failure to use the mark within a period of three years as from the date of registration unless the owner of the mark is able to produce legitimate reasons for his failure to act.

*Section 8*  
*Infringement of Rights and Legal Proceedings*

**84.**—(1) Any infringement of the rights under a mark shall constitute an offense punishable by imprisonment of between six months and three years and a fine of between MGF 500,000 and 10,000,000 or one of those two penalties only.

(2) In the event of a repeated offense, the penalty shall be doubled.

**85.**—(1) On a simple request supported by presentation of his registration certificate, the owner of a registered mark may, by virtue of an order issued by the presiding judge of the civil court of the place of infringement, direct any bailiffs or any law officers, assisted where necessary by an expert, to proceed with the identification and detailed description, with or without seizure, of the articles bearing the allegedly infringing mark.

(2) In the event of seizure, the petitioner shall be required to provide a guarantee beforehand.

(3) Copies of the record of the articles described or seized by virtue of an order and the instrument recording deposit of the guarantee shall be handed to the author of the alleged infringement, on pain of nullity and of damages against the bailiff or law officer.

(4) Without prejudice to the damages that may be claimed and on pain of nullity, the petitioner shall institute proceedings before the court within one month of the seizure or of the record of description.

**86.**—(1) Confiscation of articles bearing the mark acknowledged to be infringing may be ordered.

(2) The confiscated articles shall be handed to the owner of the mark, without prejudice to damages, posting or publication of the decision.

**87.**—(1) The beneficiary of a registered license may, by registered mail with acknowledgment of receipt, require the owner of the mark to institute proceedings with regard to any infringement of the mark that he has notified to him.

(2) If the owner of the mark refuses or fails to institute such proceedings within three months of notification, the licensee may act in his own name where not otherwise stipulated in the contract.

### **Title III** **Provisions on Industrial Designs**

#### *Section 1* *General Provisions*

**88.** Industrial designs shall enjoy protection under this Ordinance on condition that the prescribed formalities are completed and without prejudice to rights deriving from other statutory or regulatory provisions.

**89.** Any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors, shall be deemed to be an industrial design. Such composition or form shall be required to give a special appearance to a product of industry or handicraft and be able to serve as a pattern for a product of industry or handicraft.

**90.**—(1) The protection afforded by this Ordinance shall be available only to those industrial designs that differ from other similar designs either by their distinct and recognizable configuration that affords them a novel nature or by one or more superficial effects that give them an individual new appearance.

(2) If those elements that constitute the novelty of the design are inseparable from those that serve solely to obtain a technical result capable of leading to an invention that is patentable in itself, the design concerned may not enjoy the protection afforded by this Ordinance.

(3) All industrial designs contrary to public policy or morality shall be excluded from the protection afforded by this Ordinance.

**91.**—(1) A regular application for registration of an industrial design shall raise a presumption that the design was original and new at the time of the application.

(2) Notwithstanding paragraph (1), publicity given to a design on the national territory during the six months preceding filing of the application, by means of offering for sale or any other means, shall not cause either the priority right or the special protection afforded by this Ordinance to lapse.

(3) An industrial design shall not be deemed to be new solely because it comprises differences of secondary importance in relation to earlier designs or because it applies to goods of a type that differ from such designs.

*Section 2*  
*Right to Protection*

**92.** Subject to the application of Articles 95 and 96, an industrial design shall belong to the person who has created it or to his successors in title. The first applicant for such design shall be deemed, unless proved otherwise, its creator, taking into account the earliest priority claimed.

**93.** If the essential elements of an industrial design for which protection is sought have been borrowed from the creation of another person without the rightful owner having consented to such borrowing or to the application, such rightful owner may require the application or the registration to be transferred to him at any time and with retroactive effect to the date of the application.

**94.—(1)** The ownership of an industrial design created under service regulations or an employment contract shall belong to the employer.

(2) Paragraph (1) shall likewise apply where the employee is not required by his service regulations or his employment contract to exercise any creative activity, but has created the design using data or means that his employer has put at his disposal. In such cases, he shall be entitled to remuneration that takes into account his salary or the importance of the design created. Such remuneration shall be determined by common accord between the parties.

(3) An employee who creates an industrial design, outside the scope of his employment contract, without having recourse to the means or data of the enterprise, shall remain the sole owner of the design he has created. However, in the event of transfer of the rights, other than by inheritance, the employer may assert his right of preemption, particularly if the transfer is liable to constitute a serious prejudice to his enterprise.

**95.** If an industrial design has been created collectively by two or more persons, the right to statutory protection shall belong collectively to such persons or their successors in title; however, a person who has simply assisted in the material execution of the design, without making a creative contribution, shall not be deemed a creator or joint creator.

**96.—(1)** The creator of an industrial design shall be entitled to be mentioned as such in the registration.

(2) This provision may not be modified by contract.

*Section 3*  
*Registration Procedure*

**97.—(1)** Applications for registration of industrial designs shall be filed with the Agency, using the prescribed form and complying with the provisions on presentation and dimensions laid down in the implementing decree.

(2) In addition to the conditions laid down in paragraph (1), an application for an industrial design may be accompanied by a specimen in color, in relief or in three dimensions, in two identical copies.

(3) Where appropriate, the application for registration shall be accompanied by a written statement by the creator in accordance with Article 96, by which he requests to be mentioned as such in the registration or authorizes the applicant or his successor in title to apply for registration without such mention.

(4) An application may contain only one industrial design.

(5) The admissibility of the application shall be conditional on the payment of the prescribed fees.

**98.**—(1) Any person who wishes to claim the priority of an earlier application under the Paris Convention shall be required to attach to his application for an industrial design or to file within a period of three months as from filing the application, on pain of inadmissibility:

(i) a declaration stating the date and number of the earlier application, the country in which it was filed and the name of the applicant;

(ii) an official copy issued by the country of origin of priority accompanied by a translation in French;

(iii) a written and legalized authorization by the applicant or his successors in title empowering him to claim that priority if he was not the person who filed the first application.

(2) The provisions of paragraph (1) shall remain valid for a group of priorities claimed by the applicant.

**99.**—(1) The Agency shall examine from an administrative point of view whether the application for the industrial design complies with the conditions laid down by this Ordinance and its implementing decree.

(2) Where the application for the industrial design does not satisfy the conditions referred to in paragraph (1), the Agency shall refuse registration or shall propose that the applicant regularize his application, whereby such act shall not have the effect of creating a new right or reinstating a lapsed right. Regularization shall be subject to payment of the prescribed fee.

**100.**—(1) The Agency shall carry out registration of the industrial design in accordance with the conditions laid down in this Ordinance and its implementing decree.

(2) In the event of the Agency refusing registration, the applicant may, within the prescribed time limit, enter an appeal before the competent court.

**101.** On payment of the prescribed fee, the applicant may request that an official copy of his application be issued, comprising the photographic reproduction of the design.

**102.**—(1) Registered designs shall be published in the Official Gazette of Industrial Property.

(2) Registered designs may be consulted by the public and any person may obtain a copy thereof at his own expense.

**103.** Any competent authority or any person proving a legitimate interest may appeal to the competent court against any final decision by the Agency with regard to an industrial design.

#### *Section 4*

#### *Rights Afforded by Registration of an Industrial Design*

**104.**—(1) Registration of an industrial design affords to its owner or his successor in title the right to prohibit others from carrying out the following acts:

(i) the slavish reproduction or fraudulent imitation of the design in the manufacture of a product;

(ii) importing, offering for sale or selling a product reproducing the protected design;

(iii) the holding or concealment of such product for the purposes of offering it for sale or selling it.

(2) The acts referred to in paragraph (1) shall not be rendered lawful solely by reason of the fact that the reproduction differs from the protected design in minor respects or that it concerns a type of product different from that of the design.

**105.**—(1) Reproduction intended for personal or domestic use that may not be assimilated to acts carried out for industrial or commercial purposes shall not infringe the rights conferred by registration of an industrial design.

(2) The rights conferred by registration of a design shall not extend to acts in respect of a product embodying the protected design after the product has been lawfully imported or offered for sale on the national territory.

**106.** Registration of an industrial design shall have effect for five years as from the filing date, save for earlier termination resulting, in particular, from relinquishment, renunciation or cancellation.

**107.**—(1) The registration of an industrial design may be renewed for two further periods of five years each on simple payment of a renewal fee.

(2) The time limit for renewal shall expire six months after the date of the fifth or tenth anniversary of the application.

(3) The design renewal fee shall be paid within the 12 months preceding expiry of the current term of protection. However, the six-month period of grace referred to in paragraph (2) shall be afforded for payment of the fee after expiry, on payment of the surcharge laid down in the implementing decree.

**108.** The rights conferred by registration under this Ordinance shall terminate after each five-year period unless renewed in accordance with Article 107.

**109.**—(1) Any person who, for reasons of force majeure, has not been able to comply with the time limits laid down by law for carrying out an act and who, for that reason, loses any right deriving from an application for registration of an industrial design or from a registered design, may request restoration of such right if he furnishes proof relative to his failure to comply.

(2) Examination of the request shall be subject to prior payment of a fee before the Agency acts and takes a decision.

#### *Section 5* *Assignment and Licensing of Industrial Designs*

**110.**—(1) The rights attaching to an industrial design that has been applied for or registered may be transferred in whole or in part.

(2) Acts involving transfer of ownership, the granting of a right of exploitation or the cession of such right, a pledge or release of pledge, shall be recorded in writing, on pain of nullity.

(3) Notwithstanding the provisions of the Code of Registration and Stamps, any document drawn up in accordance with the preceding paragraphs must be recorded with the Agency in the special register of industrial designs in order to be invocable against third parties.

(4) The contract shall enter into force only once its advisability has been examined and the competent authority has given a favorable decision.

**111.**—(1) Applications for or registrations of designs may be assigned *inter vivos* or transferred on death.

(2) The moral right of the creator of the design shall be inalienable even subsequent to the term of protection afforded by this Ordinance.

**112.**—(1) The owner of a design may grant a license, by contract, to another person to exploit the design.

(2) Clauses in license contracts shall be null and void insofar as they impose, in the industrial or commercial field, restrictions not deriving from the rights conferred by the design or unnecessary for the safeguarding of those rights.

(3) Limitations concerning the extent, scope, territory or duration of exploitation of the design, or the quality of the products in connection with which the industrial design may be exploited shall not be deemed to constitute limitations prohibited by paragraph (2).

(4) A clause imposing the obligation on the licensee to refrain from any act capable of prejudicing the validity of the registration of the design shall remain lawful.

(5) Unless explicitly provided in the contract, the licensee may not assign his license or grant sublicenses. He shall nevertheless be entitled to carry out all acts referred to in Articles 104 and 107.

(6) The licensor shall maintain his right to exploit his design or to grant other licenses unless he has granted an exclusive license.

#### *Section 6* *Infringement of Rights and Legal Proceedings*

**113.**—(1) Any infringement of the rights under an industrial design shall constitute an offense punishable by imprisonment of between six months and three years and a fine of between MGF 500,000 and 10,000,000 or one of those two penalties only.

(2) In the event of a repeated offense, the penalty shall be doubled.

**114.**—(1) On a simple request, supported by presentation of his registration certificate, the owner of a registered design may, by virtue of an order given by the presiding judge of the civil court of the place of infringement, direct any bailiffs or any law officers, assisted where necessary by an expert, to proceed with the identification and detailed description, with or without seizure, of the allegedly infringing design.

(2) In the event of seizure, the petitioner shall be required to provide a guarantee beforehand.

(3) Copies of the record of the articles described or seized by virtue of an order and of the instrument recording deposit of the guarantee shall be handed to the author of the alleged infringement, on pain of nullity and of damages against the bailiff or law officer.

(4) Without prejudice to the damages that may be claimed and on pain of nullity, the petitioner shall institute proceedings before the court within one month of the seizure or of the record of description.

**115.**—(1) Confiscation of articles acknowledged to be infringing may be ordered.



(2) The confiscated articles shall be handed to the owner of the design, without prejudice to damages, posting or publication of the decision.

**116.**—(1) The beneficiary of a registered license may, by registered mail with acknowledgment of receipt, require the owner of the design to institute proceedings with regard to any infringement of the design that he has notified to him.

(2) If the owner of the design refuses or fails to institute such proceedings within three months of notification, the licensee may act in his own name where not otherwise stipulated in the contract.

## **Title IV** **Provisions on Trade Names and Unfair Competition**

### *Section 1* *Trade Names*

**117.** For the purposes of this Ordinance, a trade name shall constitute the designation under which an enterprise or commercial, industrial, handicraft or agricultural establishment belonging to any natural or legal person is known and conducted.

**118.** A name or designation may not constitute a trade name if, by reason of its nature or the use to which it may be put, it is contrary to morality or public policy and if, in particular, it is liable to mislead trade circles or the public as to the nature of the commercial, industrial, handicraft or agricultural establishment or the enterprise identified by that name.

**119.**—(1) Subject to the provisions that follow, a trade name shall belong to the person who was first to use it or has obtained a registration for it.

(2) The use of a trade name can be proved only by written matter, printed matter or documents that are contemporary with the use they are claimed to prove.

(3) Where a registered trade name has been used publicly and continuously on the national territory for at least five years without having given rise to legal action that has been upheld, property in the trade name shall belong to the owner of the registration without possible opposition on the grounds of prior use by another person unless it be proved that at the time of filing the applicant could not have been unaware of such other person's trade name.

**120.**—(1) It shall be unlawful to use on the national territory a trade name registered for the same commercial, industrial, handicraft or agricultural activity as that of the owner of the registered trade name if such use is liable to cause confusion between the enterprises concerned or to mislead the public.

(2) However, the owner of a trade name may not prohibit others from using in good faith their own names, addresses, pseudonyms, geographical names or precise statements relating to the kind, quality, quantity, purpose, value, place of origin or time of production of their goods or the furnishing of their services on condition that such use be limited to purposes of simple identification or information and is not liable to mislead the public as to the origin of such goods or services.

(3) A person who bears a surname or a forename that is similar to a registered trade name shall, if his rights in the trade name used for his establishment are subsequent to those attaching to the registered trade name, take all steps to distinguish such trade name from the registered trade name.

**121.**—(1) Any enterprise or owner of a commercial, industrial, handicraft or agricultural establishment located on the national territory wishing to obtain registration for the trade name attaching to his enterprise or establishment, shall file or address, by registered mail with acknowledgment of receipt, to the Agency:

- (a) an application for registration in four copies containing the following particulars:
  - (i) surname, forenames, address and nationality of the applicant,
  - (ii) the trade name for which registration is sought, accompanied, where appropriate, by the label, in four copies, of the trade name as in use,
  - (iii) the place where the establishment or enterprise concerned is located together with its field of activity;
- (b) proof of payment to the Agency of the prescribed application fee and publication fee;
- (c) powers, where the petitioner is represented by a agent or representative, in accordance with Article 132.

(2) The effective date applied for postal filing of a trade name shall be determined in the implementing decree.

**122.**—(1) The owner mentioned in Article 121 may file his application with the registry of the court of his main place of business. In such case;

- (i) a record drawn up by the registrar shall confirm each filing by stating the day and time of receipt of the elements referred to in Article 121(1)(a);
- (ii) a copy of the record shall be handed to the applicant;
- (iii) immediately after entry of the application in the register and within five days from the date of filing, the registrar shall transmit to the Agency the four copies of the application referred to in Article 121(1)(a), a certified copy of the record of filing, the document proving payment of the fees and, where appropriate, the powers referred to in Article 121(1)(c).

(2) The Agency shall open and enter applications transmitted by court registries in the order of their receipt.

**123.**—(1) After having verified that the trade name is not contrary to Article 118, that the application is regular and that the fees have been paid for publication, the Agency shall proceed with registration of the trade name.

- (2) The registration shall have effect retroactively to the date of filing.
- (3) The Agency shall return to the applicant a copy of the label of the trade name, bearing the registration notice.
- (4) Any application that does not satisfy the requirements of Article 118 shall be rejected.
- (5) In the event of a material defect, a period of two months shall be given to the applicant to correct his application. This period may be extended by three further months at the request of the applicant giving reasons. If regularization is not effected within the prescribed period of time, the application shall be rejected. Regularization may be subject to the payment of a fee.

(6) Rejection shall be decided by the Agency and notified to the applicant.

(7) Within a period of one month as from the date of notification of rejection, the applicant may enter an appeal before the competent court.

**124.** The registered trade name shall be published in the Official Gazette of Industrial Property.

**125.—**(1) Registration of a trade name shall have effect for 10 years only as from the date of filing; however, protection of a trade name may be extended without limitation as to term by successive renewals of the registration.

(2) Renewal of a registration may be obtained on simple payment of the prescribed fee, made three months after expiry of the preceding term of validity of the registration, at the latest.

**126.** The owner of a registered trade name may, at any time, renounce such trade name by means of a written declaration addressed to the Agency. Renunciation shall take effect on the date of its entry in the special register of trade names.

**127.—**(1) The cancellation of the effects on the national territory of the registration of a trade name shall be decided by the competent court at the request of either the public prosecutor or any natural or legal person concerned.

(2) At the request of the petitioners referred to in paragraph (1) or of the Agency, the court may declare the registration of a trade name to be null and void should it not comply with the provisions of Articles 118, 121 and 123 or conflict with a prior right; in the latter event, cancellation may be ordered only at the request of the owner of the prior right.

(3) Once the decision declaring the registration to be null and void has become final, it shall be communicated to the Agency which shall enter a notice in the special register of trade names.

(4) Nullity shall be published in the form laid down by the implementing decree.

**128.—**(1) A trade name may be assigned or transferred only with the enterprise or commercial, industrial, handicraft or agricultural establishment or that part of the enterprise or establishment identified by such name.

(2) The assignment of a trade name shall be recorded in writing. Transfer as the result of a merger or the acquisition of commercial or industrial establishments or any other form of succession may be effected by any other instrument capable of unequivocally proving the transfer.

(3) The acts referred to in paragraph (1) may only be invoked against others if, within a period of six months as from the date on which they were performed, they have been entered in the special register of trade names kept by the Agency. A copy of such acts shall be maintained by the Agency, at which any person concerned may consult or obtain a copy at his own cost.

**129.—**(1) Where the rights deriving from a trade name are under threat of infringement, the owner of such rights may prohibit continuation and apply for payment of damages or the application of any other sanction laid down by the legislation in force.

(2) Without prejudice to damages, where appropriate, anyone who affixes or causes to appear by removal or any other alteration whatsoever, on manufactured articles, the name of a manufacturer or craftsman other than that of the maker, or the registered name of a commercial establishment or enterprise other than that in which the articles have been

manufactured shall be liable to imprisonment of between six months and three years and a fine of between MGF 500,000 and 10,000,000 or one of those two penalties only.

(3) Anyone who knowingly sells, shows for sale or places on the market in any manner whatsoever articles bearing names that are overwritten or altered shall be liable to the same penalties as laid down in paragraph (2), above.

**130.** The provisions of this text shall be applicable to any enterprise or any commercial, industrial, handicraft or agricultural establishment, subject to the special provisions applicable to socialist enterprises.

## *Section 2*

### *Repression of Unfair Competition*

**131.**—(1) Any act of competition contrary to honest practices in industrial, commercial, handicraft or agricultural matters shall be unlawful.

(2) In compliance with that definition, the following, in particular, shall be unlawful:

(a) the direct or indirect use of a false or deceptive statement concerning the source of goods or services or the identity of their producer, manufacturer or supplier;

(b) any act whatsoever liable to cause confusion or to deceive by any means whatsoever in relation to the trade name, whether registered or not, of the establishment, the goods, services or industrial or commercial activity of a competitor;

(c) false allegations, in the course of trade, of a nature such as to discredit the establishment, goods, services or industrial or commercial activity of a competitor;

(d) statements or allegations the use of which in the course of trade is likely to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose or the quality of goods or services.

## **Title V**

### **Miscellaneous and Transitional Provisions**

**132.**—(1) Applicants having their domicile or headquarters abroad shall be required to appoint an agent or representative domiciled on the national territory to represent them before the Agency.

(2) No one may exercise the function of industrial property agent or representative unless he has been approved by the Agency for that purpose; the approval procedure shall be defined in the implementing decree.

(3) Where necessary and until such time as natural or legal persons have been authorized to exercise the profession of industrial property agent or representative, those enterprises governed by Law No. 78-052 of December 5, 1978, revising the Charter of Socialist Enterprises, may be authorized by regulation or administrative action on the part of the competent authority to serve as intermediaries between the applicants and the Agency.

**133.**—(1) Patents issued and marks and designs registered up to and including December 31, 1976, with effect on the territory of the Democratic Republic of Madagascar shall continue to be protected on that territory, up to the date of entry into force of this Ordinance, by the legislation under which they have been issued or registered, including the provisions that have amended that legislation.

(2) Paragraph (1) shall also apply to patents issued or marks and designs registered after December 31, 1976, and before the date of entry into force of this Ordinance, on condition that the applications filed for the issue of such patents, marks and designs were filed by December 31, 1976, with effect for the territory of the Democratic Republic of Madagascar.

(3) Paragraphs (1) and (2) shall only apply if the owner of the patent or of the mark or design registration:

(i) hands to the Agency a declaration of maintenance in force of his titles together with the proofs required by the implementing decree and

(ii) pays the prescribed fees to the Agency,

within a period of one year as from the date of entry into force of this Ordinance.

(4) The person who, prior to entry into force of this Ordinance, was the first to publicly use a mark continuously shall enjoy, by reason of that use, a priority in relation to the right of the first applicant on condition that he files his mark within three years of such entry into force. The filing must contain a declaration stating that the mark has already been used prior to entry into force of this Ordinance, together with proof of continuous public use in accordance with Article 58(3) of this Ordinance.

(5) Following entry into force of this Ordinance, the titles referred to in paragraphs (1) to (3) shall be governed by this Ordinance.

**134.** In addition to the issuing or registration of the titles of protection referred to in this Ordinance, the Agency shall be responsible for the promotion of inventive activities of nationals of the country and the provision to the public of an industrial property information service, particularly with respect to patents.

**135.** Notwithstanding the provisions of Articles 33(3), 42, 85 and 114, above, and the rules on competence in penal matters, any dispute arising from application of this Ordinance shall be heard by the civil court of the domicile of the holder of the patent or inventor's certificate, the owner of the mark, industrial design or trade name or, if they are domiciled abroad, the civil court of the place of the headquarters of the Agency.

Decisions by the court shall be appealable in accordance with the general rules of procedure.

**136.** Notwithstanding the provisions of Articles 17, 60 and 97, the application may be filed provisionally using modern telecommunication means, subject to the filing of an original application, the conditions of which shall be laid down by decree.

**137.** Notwithstanding the application of Article 8, certain subject matters not governed by public policy may enjoy specific protection by decree.

**138.** All earlier provisions that are contrary to this Ordinance are repealed.

**139.** Where necessary, regulatory instruments shall lay down the conditions for implementing this Ordinance, particularly as regards the applicable fees and the classifications to be used for inventions, marks and designs.

**140.** The legal arrangements instituted by this Ordinance for the protection of industrial property may be the subject of revision.

**141.** The date of entry into force of this Ordinance shall be determined by decree.

**142.** This Ordinance shall be published in the Official Gazette of the Republic.

It shall be executed as a law of the State.

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\* *Official French title:* Ordonnance n° 89-019 instituant un régime pour la protection de la propriété industrielle à Madagascar.

*Entry into force:* December 2, 1992.

*Source:* *Journal officiel de la République de Madagascar*, No. 1950, of August 14, 1989.

*Note:* Translation by the International Bureau of WIPO.

\*\* Added by the International Bureau of WIPO.