

# **Industrial Property Act of Seychelles**

**(Draft)**

Recognizing the role adequate protection and enforcement of industrial property plays in encouraging local inventive and innovative activities, stimulating transfer of foreign technology, promoting foreign direct investment, creating a competitive business environment and discouraging unfair practices [enhancing free and fair trade practice] thereby fostering socio economic development;

The President and the National Assembly of the Republic of Seychelles here by enacted as follows:

## **Part I**

### **PRELIMINARY**

#### **1. Short title and commencement**

(1) This Act may be cited as the “Industrial Property Act of Seychelles No.../2012”.

(2) This Act shall enter into force on [date to be determined] or [the date of its publication in an official gazette].

#### **2. Repealed laws**

This Act Repeals the Patent Act [Chapter 56], which was enacted in 1901 and revised in 1925, 1933, 1958, 1960, 1967, 1975 and 197 and mark decree [Chapter 239] that was promulgated in 1978 and amended in 1991.

#### **3. Interpretation**

For the purpose of this Law, the following terms have the following meaning:

- (1) "Authorised officer" means a police officer or any officer or class or description of officers appointed by the Minister to exercise the powers and perform the duties conferred and imposed on an authorised officer by this Act.
- (2) "Certification Mark" means a sign or combination of signs capable of designating any specific characteristic, including quality, origin or methods of production, of goods and services and which are used by other persons under the control of the owner of the mark.
- (3) "Convention country" means a country or territory, other than Seychelles, which is a party to the Paris Convention or the Patent Cooperation Treaty or an intellectual property agreement to which Seychelles is a party;
- (4) "Collective mark" means any visible sign [mark] designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality of goods or services of different enterprise which use the sign under the control [supervision] of the registered owner of the collective mark ;
- (5) "Counterfeit goods" means any goods, including packaging, bearing without authorization a mark or a geographical indication which is identical to the mark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a mark or geographical indication, and which thereby infringes the rights protected under this Act.
- (6) "Court" means the court that has jurisdiction to deal with matters governed under this Act.
- (7) "Director General" means the Director General of the Seychelles Intellectual Property Institute;
- (8) "Exportation" means the act of taking any goods out of Seychelles.
- (9) "Foreigner" means a person who is not domiciled or has no registered business in Seychelles ;
- (10) "Geographical indication" means a sign that identifies a good as originating in the territory of a country; or a region or locality in that territory, where a given quality, reputation or other characteristics of the good is essentially attributable to its place of origin;
- (11) "Goods Infringing Industrial Property Rights" means any goods which are made, reproduced, put into circulation or otherwise used in breach of the industrial property Act and without the consent of the right holder or a person duly authorised to do so by the right holder.
- (12) "Importation" means the act of bringing or causing any goods to be brought into Seychelles.
- (13) "Industrial design" means any composition of lines or colours or any three dimensional form whether or not associated with lines or colours, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.
- (14) "Industrial Property Rights" means rights related to patents, utility models, industrial designs, certification mark, collective mark, mark, lay out designs, and geographical indications protected under this Act.
- (15) "Infringement of Industrial Property Rights" means performance of any of the act, which is exclusively reserved for the rights holder under the relevant provisions of this Act.
- (16) "Integrated circuit" means a product in its final form or intermediate form, in which the elements, at least one of which is an active element, and some or all of the inter-connections are integrally formed in and/or on a piece of material and which is intended to perform an electronic function;
- (17) "Institute" means Seychelles Intellectual Property Institute;
- (18) "Invention" means an idea of an inventor, which permits in practice the solution to a specific problem in the field of technology.
- (19) "Layout design" means the three dimensional disposition, however expressed, of the elements of an integrated circuit, at least one of which element is active, and some or all the interconnections of an

integrated circuit, or such a three dimensional disposition prepared for an integrated circuit intended for manufacture ;

(20) “Mark’ means any visible sign capable of distinguishing goods (“trademark”) or services (“service mark”) of one enterprise from those of other enterprises.

(21) “Minister” means the Minister of Ministry of ... who is empowered to issue implementing regulations under this Act.

(22) “Non voluntary license” means an authorization given by the competent authority to a person to exploit a technology that is protected by a patent or a utility model, a registered industrial design or layout-design of an integrated circuit in Seychelles without the approval of the right holder

(23) “Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979.

(24) “Patent” means the title granted to protect an invention, which may relate to a product or a process.

(25) “Patentee” means the owner of a patent;

(26) “Person” means physical or juridical person;

(27) “Priority date” means the date of filing of an earlier foreign application that serves as the basis for claiming right of priority;

(28) “Right Holder” means the owner of a protected industrial property right or his successors in title.

(29) “Regulation” means the regulations that will be issued to implement this Act by the Minister.

(30) “Trade name” means the name or designation identifying and distinguishing an enterprise.

(31) “Utility Model Certificate” means a title granted to protect a minor invention, which may not meet the stringent requirements of patentability of inventions.

## **4. Treatment of Foreigners**

(1) Any person who is a national or is domiciled or has real and effective industrial or commercial establishment in a country which is a party to the Paris Convention or any other treaty that embodies the principle of national treatment to which Seychelles may be a party shall be treated in the same way as Seychellois except requirements that may be explicitly provided for purposes of administrative and judicial procedures.

(2) Any other foreign person that may not be covered under sub section (1) shall be treated in accordance with the provisions of a treaty between Seychelles and the country of the foreign person and in the absence of such an agreement based on the principle of reciprocity.

## **5. Transfer of right and application**

(1) Any patent, utility model certificate, industrial design registration certificate, registered mark, certification mark, collective mark, trade name and layout design ( here in after referred to as “

industrial property title”) or application for an Industrial Property title may be transferred by sale or inheritance or any other means in accordance with this Act and relevant laws.

(2) Such transfer shall be recorded with the institute, upon payment of fees prescribed in the regulations.

## **6. Application of International Treaties**

The provisions of any international treaties in respect of industrial property to which the republic of Seychelles is a party shall apply to matters dealt with by this Act, and in case of conflict with provisions of this Act, shall prevail over the later.

# **Part II**

## **Patents**

### **Chapter 1- General Provisions**

#### **7. Patentable inventions**

(1) An invention is patentable if it is new, involves an inventive step and is industrially applicable.

(2) An invention, shall be considered new if it is not anticipated by prior art. Prior art shall consist of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filling or, where appropriate, the priority date of the application claiming the invention.

(3) Notwithstanding the provisions of sub-section (2) the disclosure to the public of the invention shall not be taken into consideration if it occurred within 12 months preceding the filling date or, where applicable, the priority date, of the application, and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or an abuse committed by a third party in relation to the applicant or his predecessor in title.

(4) An invention shall be deemed as involving an inventive step if having regard to the prior art relevant to the application and as defined in sub-section (2) herein above, it would not have been obvious to a person having ordinary skill in the art.

(5) An invention shall be considered as industrially applicable where it can be made or used in handicraft, agriculture, fishery, social services and any other sectors.

## **8. Matters excluded from patent protection**

(1) The following shall not be patentable:

- (a) Inventions contrary to public order or morality;
- (b) Plant or animal varieties<sup>1</sup> or essentially biological processes for the production of plants or animals other than microbiological processes and the products of such processes;
- (c) Schemes, rules or methods for doing business, for performing purely mental acts or for playing games;
- (d) Discoveries, scientific theories and mathematical methods;
- (e) Methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body.

(2) The provision of sub-section (1) (e) shall not apply to products for use in any of the methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body.

## ***Chapter 2-Right to a Patent and Naming of Inventor***

### **9. Right to a Patent**

(1) The right to a patent shall belong to the inventor.

(2) If two or more persons have jointly made an invention the right to the patent shall belong to them jointly.

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<sup>1</sup> It should be noted that article 27 (3) (b) of the TRIPs agreement requires member countries to accord for protection of plant varieties using patents or a *suigenris* protection system or both. This requirement will be met by the plant variety protection law that is envisaged by the draft national IP policy.

(3) Where an invention is made in the execution of a contract of employment, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer. [Provided that where the invention is of exceptional importance the employee shall have a right to equitable remuneration taking into consideration his salary and the benefit derived by the employer from the said invention.]<sup>2</sup>

(4) where an employment contract does not require an employee to exercise any inventive activity but an invention resulted from both the personal contribution of the employee and using the resources, data, means, materials or equipment of the employer the right to the patent, in the absence of an express term to the contrary, shall belong to both the employer and the employee and the patent shall be owned jointly in equal shares.<sup>3</sup>

## **10. The First to File Rule**

When two or more persons have made the invention separately and independently of each other, the right to the patent shall belong to the person who filed an application for such invention, or where two or more applications are filed for the same invention, to the applicant who has the earliest filing date or, the earliest priority date.

## **11. Naming of Inventor**

The inventor shall be named as such in the application and the patent, unless in a special written declaration addressed to the Institute he indicates that he wishes not to be named. Any promise or undertaking by the inventor made to any person to the effect that he will make such declaration shall be without legal effect.

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<sup>2</sup> Some laws provide for right to remuneration while others do not. The decision to include the bracketed provision to or not to be incorporated is left for the stakeholders.

<sup>3</sup> This provision adopts a balanced approach compared to some laws such as Kenyan Industrial property law which gives the right to a patent to the employer and entitles the employee with the right for remuneration ( see section 32(2)) and other laws such as Philippine IP law that grants the right to the employee. ( see article 30(2) (a) of the Intellectual Property code of Philippines.

## ***Chapter 3-Application, Examination and Granting of Patents***

### **12. Application**

(1) The person having the right to a patent for an invention in accordance with Section 9 may, upon payment of the prescribed fees, apply to the Institute for the grant of a patent for that invention.

(2) Application for a patent shall be made in writing using the form prescribed in the regulation and shall contain a request, a description, one or more claims, an abstract, and where required, one or more drawings.

(3) In accordance with sub-section (2):-

(a) The request shall contain a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention. Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent;

(b) The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate at least one mode known to the applicant for carrying out the invention. Where an invention involves use of genetic or biological resources collected from the territory of Seychelles, the description shall clearly identify the origin of the resource.<sup>4</sup> The description of an invention may be used to interpret the claims;

(c) The claim or claims shall define clearly and concisely the matter for which protection is sought. The claim or claims shall be fully supported by the description.

(d) The abstract, which must be concise and precise, shall merely serve the purpose of technical information and shall not be taken into account for the purpose of interpreting the scope of protection.

(4) Drawings shall be required when they are deemed necessary for the understanding of the invention.

(5) An applicant may withdraw the patent application at any time before a patent is granted.

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<sup>4</sup> This provision is incorporated in line with the draft national IP policy to complement the objectives of the law that is being developed to regulate access to genetic resources and facilitate sharing of benefits arising from the use of genetic and biological resources of Seychelles.

(6) An applicant who is not domiciled or who has no established business in Seychelles shall appoint an agent who is domiciled in Seychelles.

(7) Application shall be accompanied by power of attorney when it is made by an agent.

### **13. Unity of invention and division of application**

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

(2) The applicant may, up to the time when the application is in order for grant, divide the application into two or more applications (“divisional applications”), provided that each divisional application shall not go beyond the disclosure in the initial application.

(3) Where an application is divided, each divisional application shall be entitled to the filing date or, where applicable, the priority date of the initial application.

(4) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under sub section (1) shall not be a ground for the invalidation of the patent.

### **14. Amendment of application**

The applicant may, up to the time when the application is in order for grant, amend the application, provided that the amendment shall not go beyond the disclosure in the initial application.

### **15. Right of Priority**

(1) The application may contain a declaration claiming a right of priority as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or of any state party to the said Convention.

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

(3) The period of claiming right of priority, under sub section (1) is twelve months beginning from the first filing date of the invention in a foreign country.

(4) When the application is made within the period of priority, the filing in Seychelles of that application before the expiration of the period of priority shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, and such acts cannot give rise to any third-party right or any right of personal possession

(5) Where the Institute finds that the requirements under this section and the regulations pertaining thereto have not been fulfilled, the said declaration shall be considered not to have been made.

## **16. Information Concerning Corresponding Foreign Application for Patents**

(1) The applicant shall, at the request of the Institute, furnish it with the date and number of any application for a patent filed by him abroad relating to the same or essentially the same inventions as that claimed with the Institute.

(2) The applicant shall, at the request of the Institute, furnish it with the following documents relating to the foreign applications referred to in sub-section (1):

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

(3) The applicant shall, at the request of the Institute, furnish it with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in sub-section (2).

## **17. Filing Date**

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

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

(2) If the Institute finds that the application did not, at the time of receipt, fulfil the requirements referred to in sub-section (1), it shall invite the applicant to file the required correction and shall accord

as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

(3) Where the application refers to drawings, which in fact are not included in the application, the Institute shall invite the applicant to furnish the missing drawings. If the applicant complies with the said invitation, the Institute shall accord as the filing date the date of receipt of the missing drawings. Otherwise, the Institute shall accord as the filing date the date of receipt of the application and shall treat any reference to the said drawings as non-existent.

## **18. Examination of Application**

(1) The Institute, after according a filing date, shall examine whether the application complies with the requirements of section 12 (2) and (3) of this Act and the Regulations pertaining thereto and those requirements of this Act and the Regulations.

(2) When, upon formal examination, the application is not in conformity with the requirements laid down in this Act and in the Regulation, the Institute shall call upon the applicant to amend the application. If the applicant fails to amend as required within a period of two month, the application shall be considered withdrawn.

## ***Chapter 4-Grant of a patent, Duration of a patent and Annual Fees***

## **19. Grant of a Patent and Changes in a Patent**

(1)A patent shall be granted, where the Institute finds that the conditions referred to in section 18 (1) are fulfilled.<sup>5</sup> Otherwise it shall refuse the application and notify the applicant of that decision.

(2) When a patent is granted the Institute shall:

- (a) publish a reference to the grant of the patent in an official Gazette,
- (b) issue the applicant a certificate of the grant of the patent and a copy of the

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<sup>5</sup> It is proposed that the office grant a patent upon fulfilment of a formal examination. Different approaches, which may be categorized into three, are employed by different countries regarding examination of patent applications. The first category consists of countries that grant a patent upon fulfilment of formal examination. The countries that fall into the second category perform substantive examination to determine whether or not an application fulfils substantive requirements in addition to meeting formal requirements prior to granting a patent. The third category of countries includes those which follow a deferred examination system, namely providing substantive examination upon request. Substantive examination requires qualified professionals in different fields and adequate facilities including patent documents, scientific and technical literature. It is felt that the approach adopted in the draft law is in line with the specific position and needs of the country. The merits and demerits of each of the approaches will be explained to the stakeholders during the validation meeting.

- patent,
  - (c) record the patent, and
  - (d) make available copies of the patent to any person on payment of the prescribed fee.
- (3) The Institute shall upon request of the patentee, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change may not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

## **20. Rights conferred by patent**

- (1) The patent shall confer on a patentee the exclusive right to exploit the patented invention in Seychelles. The exploitation of the patented invention in Seychelles by persons other than the patentee shall require the latter's agreement.
- (2) For the purposes of this Act, "exploitation" of a patented invention means any of the following acts:
- (a) when the patent has been granted in respect of a product :
    - (i) making, importing, offering for sale, selling and using the product;
    - (ii) stocking such product for the purposes of offering for sale, selling or using;
  - (b) when the patent has been granted in respect of a process:
    - (i) using the process;
    - (ii) doing any of the acts referred to in subsection (2) (a) in respect of a product obtained directly by means of the process.
- (3) The patentee shall, in addition to any other rights, remedies or actions available to him, have the right, except under circumstances provided under Sections 21, 22 and 27 of this Act, to institute court proceedings against any person who infringes the patent by performing, without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

## **21. Limitations of right**

The rights of the patentee shall not extend to:

- (a) acts done only for experimental purposes relating to a patented invention; or
- (b) acts in respect of patented articles which have been put on the market in and outside of Seychelles, by the Patentee or with his consent; or
- (c) the use of patented Sections on aircraft, land vehicles or vessels of other

countries which temporarily or accidentally enter the air space, territory , or waters of Seychelles.

## **22. Right of a prior user**

(1) Any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted, was using the invention or was making effective and serious preparations for such use in Seychelles, has a personal right to continue such use or to use the invention as envisaged in such preparations.

(2) The right of prior users referred to in sub section (1) may be transferred only together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been made.

## **23. Duration of a Patent**

A patent shall be granted for a period of twenty years commencing from the filling date of the application for protection.

## **24. Annual Fees**

(1) In order to maintain the patent or patent application, an annual fee shall be paid in advance to the Institute for each year, starting one year after the filling date of the application for grant of the patent. A period of grace of six months shall be allowed for the late payment of the annual fee on payment of the prescribed surcharge.

(2) If an annual fee is not paid in accordance with the provision of sub-section (1), the patent application shall be deemed to have been withdrawn or the patent shall lapse.

## ***Chapter 5- Non-Voluntary licences***

### **25. Grounds for issuance of a Non voluntary license**

A non voluntary license for the exploitation of a patented invention may be issued where:

- (1) the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy requires the exploitation of a patented invention;
- (2) the patented invention is not or insufficiently exploited in Seychelles by the patentee or a person authorized by him without legitimate reason, after a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever periods expires last;
- (3) the court has determined that the manner of exploitation by the patentee or his licensee is anti-competitive;
- (4) A judicial or administrative body has deemed that the way in which the patentee or his licensee are exploiting the invention is abusive, anti-competitive or fails to meet reasonable conditions of demand for the protected product in sufficient quality and quantity ; or
- (5) an invention protected in a subsequent patent cannot be effectively exploited in Seychelles without infringing an earlier patent provided that the invention claimed in the second patent involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent.

### **26. Application for non voluntary license**

- (1) An application for grant of non voluntary license should be made to the institute upon payment of the prescribed fee.
- (2) The application shall be accompanied by proof that the applicant was unable to obtain a license on reasonable terms and conditions within a reasonable period of time and that he is capable of working the patented invention in Seychelles.
- (3) The requirement for evidence of a prior attempt to obtain a voluntary license under sub section (1) shall not apply, where the request for non voluntary license is based on the grounds provided in Section 25 (1) (3) and (4).

## **27. Grant of Non-voluntary license**

- (1) Where the Institute finds the application to be satisfactory, it shall decide to grant a non-voluntary license.
- (2) Where a decision is made to grant a non-voluntary license, it shall be registered and announced in the official gazette.
- (3) The grant of the non-voluntary licence shall not exclude:
  - (a) the exploitation of the patented invention or conclusion of licence contracts  
by the patentee; or
  - (b) the grant of other non-voluntary licences.
- (4) Where a non voluntary license is granted based on an application under Section 25(5) the owner of the earlier patent or his licensee shall be entitled to a cross- license on reasonable terms to use the invention claimed in the subsequent patent.

## **28. Rights and obligations of beneficiary of non-voluntary Licence**

- (1) Any person who is granted non-voluntary license shall have the right to exploit the patented invention in Seychelles to meet the needs of the domestic market according to the terms set down in the decision granting the licence.
- (2) The person who is granted a non voluntary licence may only transfer the right under sub section (1) together with the enterprise or part of the enterprise within which the patented invention is exploited.
- (3) A person who is granted a non-voluntary licence for the exploitation of a patented invention shall have the duty to:
  - (a) commence exploitation of the patented invention in Seychelles within the time limit fixed in the decision granting non voluntary license and, thereafter, shall exploit the patented invention sufficiently in Seychelles in accordance with the terms and conditions set by the institute, and
  - (b) pay the patentee a reasonable exploitation fee, the amount of which shall be fixed by agreement of both parties.
- (4) Where the parties could not agree on the amount of the fee under sub section (3) (b), it shall be fixed by the Institute. The decision of the Institute with regard to the remuneration may be subject to appeal before the court.

## **29. Termination of Non voluntary license**

The Institute shall terminate the non voluntary licence, at the patentee's request, where:

- (1) the reasons for granting non voluntary license have ceased to exist; or
- (2) the beneficiary of the non voluntary licence failed to respect the terms and conditions set by the institute when deciding to grant the non voluntary licence.

## ***Chapter 6- Termination, Surrender and Invalidation of a Patent***

### **30. Termination of a Patent**

A patent shall terminate if:

- (1) The patentee surrenders it by a written declaration to the Institute; or
- (2) The annual fee is not paid in due time.

### **31. Surrender of a Patent**

Surrender of a patent:

- (1) may be limited to one or more claims of the patent,
- (2) shall be immediately registered and published by the Institute, and
- (3) which has been subjected to a license shall only take effect upon submission of a declaration by which the registered licensee consents to the surrender.

### **32. Invalidation of a Patent**

- (1) Any interested person may request the court to invalidate a patent.
- (2) The court shall invalidate the patent in whole or in part if the person requesting the invalidation proves that the:

- (a) subject matter of the patent is not an invention within the meaning of section 3(18)  
or does not meet the requirements of patentability or excluded from patent  
protection according to Sections 7 and 8 of this Act;
  - (b) description does not disclose the invention in a manner sufficiently clear and  
complete for it to be carried out by a person skilled in the art; or
  - (c) owner of the patent is not the inventor or the employer of the inventor or his  
successor in title.
- (3) Any invalidated patent, or claim or part of a claim, shall be regarded null and void from  
the date of grant of the patent.
- (4) The final decision of the court shall be notified to the Institute, which shall record it and  
publish a reference thereto as soon as possible.

### **33. Transfer of patent**

In the event a dispute over the rights relating to the patent arises, the interested person who won the case may ask the court to transfer the title to him instead of invalidating it under section 31.

## **Part III**

### **Utility Models Certificates**

#### **34. Protection of Minor Inventions**

- (1) A minor invention that possesses novelty and industrial applicability shall give rise to a right to protection.
- (2) The right shall be evidenced by a utility model certificate issued by the Institute.

### **35. Non-existence of novelty**

(1) A minor invention shall not be considered new if, at the time of filing of the application, it has already been described in printed publications, made available to the public or has already been publicly used in Seychelles.

(2) Any description or use, within six months prior to the filing of the application, shall not destroy novelty if it is based on the work of the applicant.

### **36. Non-protectable Subject matters**

The following shall not be protected by utility model certificate:

(1) Changes in the shape, proportions or material of a patented object or of one that forms part of the public domain, except where such a change alters the qualities or functions or the object thereby producing an improvement in its use or the effects of its intended functions;

(2) The mere replacement of elements in a known combinations by other known elements having an equivalent function, which does not thereby produce an improvement in its use or the effect of its intended functions; or

(3) A minor invention that is contrary to public order or morality.

### **37. Examination**

The Institute shall, after according a filing date, undertake a formal examination of the application and decide to allow or refuse the grant of utility model certificate.

### **38. Issuance of Utility Model Certificate**

(1) Where the Institute decides to grant utility model certificate it shall issue a utility model certificate to the application.

(2) The grant of the certificate shall confer the exclusive right to exploit the minor invention and prevent third parties from exploiting the minor invention without the authorization of the right holder.

### **39. Conversion of Patent Applications to Applications for Utility Model Certificates and Vice-Versa.**

(1) At any time before the grant or refusal of a patent an applicant for a patent may, upon payment of the prescribed fee, convert his application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.

(2) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee convert his application into a patent application, which shall be accorded the filing date of the initial application.

(3) An application may not be converted more than once under sub-sections (1) and (2).

### **40. Duration of Utility Model Certificate**

(1) A utility model certificate is granted , without the possibility of renewal, for a period of ten years<sup>6</sup> beginning from the filing date of the corresponding application

(2) Application for renewal of the certificate shall be filed, with the Institute within 90 days prior to the expiration of the period of protection upon payment of the prescribed fees.

### **41. Application of rules on patents**

The relevant provisions of Part II of this Act shall apply *mutatis mutandis* to utility models certificates.

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<sup>6</sup> Different laws provide different duration of protection of utility models. There are laws that Egypt IP code provides for protection of utility models for a non renewable period of seven years beginning from the date of filing this include Egypt and the Gambia ( see article 30 Law on protection of Intellectual Property Rights and section 17 (3) (a) industrial property Act of Egypt and the Gambia respectively), the laws that provides for a period of ten years beginning from date of filing include Burundi ( Article 145). Rwanda (article 83, law on the protection of Intellectual property, and Kenyan Industrial Property Acts ( section 82). However, the Kenyan law provides that the date of protection commences form the date of grant of title not from the date of filing an application. The stakeholders may decide which of the approach to adopt.

***Part IV***  
***Industrial Designs***

**42. Protection of Industrial Designs**

- (1) An Industrial Design shall be protected under this Act if it is new.
- (2) An industrial design shall be considered new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.
- (3) Notwithstanding the provisions of sub-section (2), the disclosure to the public of the industrial design shall not be taken into consideration if it occurred within six months preceding the filing date or, where applicable, the priority date, of the application, and if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or an abuse committed by a third party in relation to the applicant or his predecessor in title.<sup>7</sup>
- (4) An industrial design shall not be considered new solely by reason of the fact that it differs from an earlier industrial design in minor respects or that it concerns a type of product different from a product embodying an earlier industrial design known in and outside of Seychelles.

**43. Un protectable Industrial design**

An industrial design shall not be registered and protected under this Act where:

- (1) it is contrary to public order or morality, or
- (2) the design is functional and serves solely to obtain a technical result.

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<sup>7</sup> This is broad compared to some laws such as the Sri Lanka Intellectual Property Code, which limits the exception to a display made at an official or officially recognized, international exhibition. Stake holders may decide on which of the approaches to adopt.

## **44. Ownership of Industrial design**

- (1) An industrial design shall be owned by the person who has created it or his successors in title.
- (2) Where two or more persons have jointly created an industrial design, the right to the design shall belong to them jointly.
- (3) Where the industrial design has been created by an employee in the execution of a contract of employment, the right to the industrial design shall belong to the employer, unless the contract stipulates otherwise. [Provided that where the industrial design acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment, the creator shall be entitled to equitable remuneration which may be fixed by the Court on an application made by the creator to Court in the absence of an agreement between the parties.]<sup>8</sup>
- (4) where an employment contract does not require an employee to exercise any creative activity but an industrial design resulted from both the personal contribution of the employee and using the resources, data, means, materials or equipment of the employer the right to the industrial design, in the absence of an express term to the contrary, shall belong to both the employer and the employee and the industrial design shall be owned jointly in equal shares.<sup>9</sup>
- (5) When two or more persons have created the same industrial design independently, the right to the industrial design shall belong to the person who first filed an application for registration or who has the earliest priority date.

## **45. Naming of creator**

The Creator shall be named as such in the application and the industrial design registration certificate; unless in a special written declaration addressed to the Institute he indicates that he wishes not to be named. Any promise or undertaking by the creator made to any person to the effect that he will make such declaration shall be without legal effect.

## **46. Application**

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<sup>8</sup> Some laws require the right to remuneration to the employee, when the industrial design brought in a higher financial or economic gain, while others are silent on the issue. The decision to include or not the bracketed provision is left for the decision of the stakeholders.

<sup>9</sup> See the explanation given to a similar provision under Part II.

(1) An application for registration of an industrial design shall be made in the prescribed form and filed with the Institute upon payment of the prescribed application fee.

(2) The application for the registration of an industrial design shall contain a request, drawings, photographs or other adequate graphic representation of the design embodying the industrial design and an indication of the kind of products for which the industrial design is to be used. It may be accompanied by a specimen of the article embodying the industrial design.

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

(3) The application may relate to two or more designs incorporated in products belonging to the same class in the international classification or refer to the same set or assortment of designs.

(4) The applicant may withdraw the industrial design registration application at any time before the registration of the industrial design.

(5) An applicant may claim a right of priority in his application. In such a case Section 15 shall apply *mutatis mutandis* except that the period determined in section 15 (3) will be six months.

(6) An applicant who is not domiciled or who has no established business in Seychelles shall appoint an agent who is domiciled in Seychelles.

(7) Application shall be accompanied by power of attorney when it is made by an agent.

## **47. Examination, Registration and Publication of industrial designs**

(1) The Institute shall accord as the filing date the date of receipt of the application, provided that, at the time of receipt, the application fee is paid and the application contains the name of the applicant and a graphic representation of the article embodying the industrial design.

(2) Where the application does not meet the requirements of sub section (1), the institute may require the applicant to amend the application. In such a case the provision of Section 17 (2) (b) shall apply *mutatis mutandis*.

(3) The institute shall, after according a filing date, examine whether the application complies with the requirements of section 3 (13) and 46 of this Act and the regulations pertaining thereto.

(4) When the Institute finds that the conditions referred to in sub section (3) are fulfilled, it shall register the industrial design, publish a reference to the registration in an official Gazette and issue a certificate of registration of an industrial design upon payment of the prescribed fee; otherwise, it shall refuse the application.

## **48. Rights Conferred by Registration**

(1) The registration of industrial design confers an exclusive right on the owner to:

- (a) reproduce and embody such industrial design in making a product ;
- (b) import, offer for sale, sell and use a product embodying the industrial design ;
- (c) stock for the purpose of offering for sale, selling or using, a product embodying the industrial design.

(2) No person shall do any of the acts referred to in subsection (1) without the consent of the registered owner of the industrial design.

(3) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design right by performing, without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

## **49. Limitation of rights**

The rights conferred by the registration of an industrial design shall:

- (1) extend only to acts done for industrial or commercial purposes;
- (2) not extend to acts in respect of a product embodying the protected industrial design after the product has been put on the market by the owner of the industrial design or with his consent.

## **50. Duration of Industrial Design Protection**

- (1) The registration and protection of an industrial design shall be valid for a period of five years from the filing date of the application for registration.<sup>10</sup> Such period may be extended for two further consecutive periods of five years through the payment of the prescribed fee. A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.
- (2) Application for renewal of protection shall be filed with the Institute within 90 days prior to the expiration of the period of protection upon payment of the prescribed fees.

## **51. Surrender of industrial design registration certificate**

Section 31 shall apply mutatis mutandis to surrender of industrial design registration certificate.

## **52. Invalidation**

- (1) Any interested person may request the court to invalidate the registration of an industrial design.
- (2) The court shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of sections 3 (13), 42 and 43 is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title. Where the registered owner is found not to be the creator or his successor in title, the creator or his successor may request the court to order the transfer of the title to him instead of invalidating it.
- (3) Any invalidated industrial design shall be regarded as null and void from the date of its registration.
- (4) The final decision of the court shall be notified to the Institute which shall record it and publish a reference thereto as soon as possible.

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<sup>10</sup> The duration of protection of industrial designs is not uniform. Some laws such as Egypt IP law accord an initial protection of ten years that will be renewed for additional period of five years while other laws such as the Industrial Property law of Burundi accords protection for five years, which may be renewed for two consecutive periods of five years each. Mozambique accords protection for an initial period of five years which can be renewed up to 25 Years. In the draft law the duration of the WIPO model law, which was adopted in a number of African countries is included. However, stakeholders may decide to adopt the approach of other countries.

### **53. Non Voluntary licenses**

The provisions of Sections 25 to 29 shall apply *mutatis mutandis* to industrial designs.

## **Part V**

### **Layout-Designs of Integrated Circuits**

#### ***Chapter One- Requirements for Protection***

### **54. Subject Matter of Protection**

- (1) The lay out designs of integrated circuits may be protected under this Act only when it is original within the meaning of Section 55.
- (2) A registration of the layout design may only be requested if it has not yet been commercially exploited, or has been commercially exploited for not more than two years, anywhere in the world.

### **55. Originality**

- (1) A layout design shall be considered original if it is the result of the intellectual effort of its creator and if, at the time of its creation, it is not known among the creators of layout designs and manufacturers of integrated circuits.
- (2) A layout-design, which consists of a combination of elements and interconnections that are common, shall be protected only if the combination, taken as a whole, is original within the meaning of subsection (1).

### **56. Right to Protection**

- (1) The right to layout-design protection shall belong to the creator of the layout-design.
- (2) Where several persons have jointly created a layout-design, the right shall belong to them jointly.
- (3) Where the layout-design has been made or created in the performance of a contract of

employment or in the execution of a work, the right to protection shall belong, unless otherwise stated in the contract, to the employer or the person who commissioned the work.

## ***Chapter Two- Application, Examination, Registration and Scope of Protection***

### **57. Application Requirements**

(1) Applications for the registration of layout-designs shall be in writing and shall be filed with the Institute. A separate application shall be filed for each layout-design.

(2) The application shall:

(a) contain a request for registration of the layout-design in the Register of Layout-Designs and a brief and accurate description of the layout design;

(b) indicate the name, address, nationality and, if different from the address, the habitual residence of the applicant;

(c) be accompanied by the power of attorney granted to the agent by the applicant, where the application is made through an agent.

(d) specify the date of first commercial exploitation of the layout-design anywhere in the world or indicate that such exploitation has not yet commenced ; and

(e) provide information establishing the right to protection under Section 56.

(3) The application shall be accompanied by a copy or drawing of the layout-design and where the integrated circuit has been used commercially, by a sample of the integrated circuit, as well as information defining the electronic function that the integrated circuit is designed to perform. However, the applicant may exclude from the copy or the drawing the parts, which relate to the manner in which the integrated circuit is manufactured, provided that the parts included are sufficient to allow the identification of the layout-design;

(4) Where the application does not duly comply with the requirements of subsections (2) and

(3), the Institute shall notify the applicant of the defects and invite him to correct them

within two (2) months.

(a) If the defects are corrected within the time limit, the Institute shall accord as the filing date the date of receipt of the application, provided that, at the time of receipt, the application contained an express or implicit indication that the registration of a layout-design is requested and indications allowing the identity of the applicant to be established and was accompanied by a copy or drawing of the layout-design'

(b) Where the applicant fails to submit drawings of a layout design with the original application, but corrects the application for the registration of the layout design within the period specified the date of receipt of the corrections shall be deemed to be the date of filing of the application.

(c) Where the applicant fails, after communication by the Institute, to correct the application within the period specified, the application shall be deemed not to have been filed.

(5) Each application for protection of a layout-design shall be subject to the payment of the prescribed fee. If the fee is not paid, the Institute shall notify the applicant that the application will be deemed not to have been filed unless payment is made within two months from the date of the notification. If the application fee is not paid within that time limit, the application shall be deemed not to have been filed.

## **58. Registration and Publication**

(1) Where the application complies with the requirements of Section 57, the Institute shall register the layout-design in the Register of Layout-Designs without examination of the originality of the layout-design, the right of the applicant to protection or the accuracy of the facts detailed in the application ;

(2) The Register of Layout-Designs shall contain the number, title, filing date and, where indicated in the application under Section 57 (2) (d), the date of first commercial exploitation, anywhere in the world, of the layout-design as well as the name and address of the right holder and other prescribed particulars.

(3) Any person may consult the Register of Layout-Designs and obtain extracts there from, subject to the payment of the prescribed fee.

(4) The registration of a layout-design shall be published in the Official Gazette.

## **59. Scope of protection and Rights granted**

(1) The protection afforded to a layout design under this Act shall not be dependent on the integrated circuit which incorporates such layout design being incorporated in an article.

(2) The right holder shall have the exclusive right to do or authorize others to do any of the following:

(a) reproducing, 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 referred to in Section 55.

(b) importing, selling or otherwise distributing 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.

(3) The right holder shall, in addition to any other rights, remedies or actions available to him, have the right, except under sections 60 and 62 of this Act, to institute court proceedings against any person who infringes his right, by performing, without any agreement, any of the acts referred to in sub section (1) or who performs acts which make it likely that infringement will occur.

## **60. Limitation of Right**

The scope of protection and the rights granted under section 59 shall not extend to:

- (a) the reproduction of the protected layout design for the purpose of evaluation, analysis, research or non profit teaching or education ;
- (b) the incorporation in an integrated circuit of a layout design, created on the basis of such analysis, evaluation or research referred to in subsection (a), if such layout design is itself original within the meaning of subsection 55, or for the performance of any of the acts referred to in subsection 59 (2) (b) in respect of such layout design ;
- (c) the performance of any of the acts referred to in subsection 59 (2) (b) , where the act is performed in respect of a protected layout design, or in respect of an integrated circuit in which such layout design is incorporated, and such layout design or integrated circuit has been put on the market by, or with the consent of, the right holder; or
- (d) the performance of any act referred to in subsection 59 (2)(b) in respect of an integrated circuit incorporating an unlawfully reproduced layout design or any article incorporating such an integrated circuit, where the person performing or ordering such an act unknowingly performs or orders such an act and has no reasonable grounds of knowing at the time of acquiring the integrated circuit or the article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout design : Provided however, where the person performing or ordering any act under this subsection, is notified that such layout design is an unlawful reproduction, then such person may, perform or order any act only with respect to the stock in hand or ordered before he was so notified and shall be liable to pay to the right holder a sum equivalent to a reasonable royalty such as would be payable under a freely negotiated licence in respect of such layout design.

## **61. Commencement and Duration of Protection**

(1) The Protection granted to a layout-design under this Act shall commence:

- (a) on the date of the first commercial exploitation, anywhere in the world, of the layout-design by the right holder or with his consent , provided an application for protection is filed by the right holder with the Institute within the time limit referred to in Section 54 (2), or
- (b) on the filing date accorded to the application for the registration of the layout-design filed by the right holder, if the layout-design has not been previously exploited commercially anywhere in the world.

(2) The protection granted to a layout-design under this Act shall terminate at the end of the tenth calendar year from the date of commencement of such protection.

## **62. Non voluntary licenses**

(1) Subject to Subsection (2), the provisions of Sections 25 to 29 shall *mutatis mutandis* apply to registered layout-designs of integrated circuits.

(2) Non voluntary licenses of registered layout-designs shall be granted only for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive.

## **63. Invalidation**

(1) Any interested person may request that the registration of a layout-design be invalidated on the grounds that:

- (a) the layout-design is not protectable under sections 3(19), 54 and 55;
  - (b) the right holder is not entitled to protection under Section 56; or
  - (c) where the layout-design has been commercially exploited, anywhere in the world, before the filing of the application for registration of the layout-design, the said application was not filed within the time limit referred to in Sections 54 (2).
- (2) Where the grounds for invalidation are established with respect only to a part of the layout-design, only the corresponding part of the registration shall be invalidated.
- (3) A request for invalidation of the registration of the layout-design shall be filed with the Court. The request shall state the grounds on which it is based.
- (4) In the event of a dispute over the right to the layout-design registration, the interested person may ask the Court to transfer the title to him instead of invalidating it.
- (5) Any invalidated layout-design registration, or part thereof, shall be regarded as null and void from the date of the commencement of protection.
- (6) The final decision of the Court shall be notified to the Institute which shall record it and publish a reference thereto in accordance with the Regulations.

## **Part VI**

### **Mark, Certification mark, Collective mark, Trade name and Geographical indications**

## ***Chapter 1-Acquisition of exclusive rights in a trade mark and its registration***

### **64. Acquisition of Rights**

The exclusive rights in a mark shall be acquired by registration in accordance with the provisions this Act.

### **65. A Mark Eligible for Registration**

A mark that is capable of clearly distinguishing goods or services of a person from those of other persons and meets the requirements of this Act and the regulations pertaining thereto shall be eligible for registration.

### **66. Mark Inadmissible for Registration**

(1) A trade mark shall not be admissible for registration if it:

- (a) is incapable of distinguishing the goods or services of one person from those of other persons;
- (b) is contrary to public order or morality;
- (c) is likely to mislead the public or business circles, in particular as regards to the geographical origin of the goods or services, or their nature or characteristics;
- (d) consists exclusively of signs or indications which have become customary in the current language use in relation to such goods or services for which the registration of a mark is applied for, or which have become customary in economic and business activities;
- (f) is identical with, or confusingly similar to, or constitutes a translation of a mark, trade name which is well known in Seychelles for identical or similar goods or services of another person; or if it is well-known and registered in Seychelles for goods or services which are not identical or similar to those for which registration of the mark is requested, provided that the use of this mark in relation to those products or services indicates a link between those goods or services and the owner of the well-known mark, and that such use is likely to damage the interests of the owner of the well-known mark;
- (g) reproduces, imitates or contains among its features a coat of arms or armorial bearing, flags or other emblems, a name, abbreviation, or initials of the name of, or official sign or hallmark and guarantee of any state, intergovernmental organization, or other organization created by an international convention, unless authorized by a competent authority of the concerned state or organization;
- (h) is identical with or similar to a mark belonging to another proprietor and which is already registered, or with an earlier filing or priority date, in respect of identical or similar goods or services or closely related goods or services, or if it so nearly resembles such a mark as

to be likely to deceive or cause confusion. In the case of use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(2) For the purposes of Subsection (1) (f), in determining whether a mark is well known, consideration shall be given to the degree of recognition of the mark in the relevant sector of the public in Seychelles, including the degree of recognition arising from the advertising of the mark in Seychelles.

(3) Notwithstanding the provisions of sub section (1), the Institute or the court may decide that a mark has acquired secondary meaning or distinctiveness through continued use. In such a case, the mark shall be registered.

## **67. Right of Prior User**

The prior user of a mark whose name does not appear in the Register or who does not have an application pending under subsection 66 (1) (h), may oppose an application for registration of a similar or identical mark by another person for similar or identical goods, provided he:

- (a) proves that he has used that mark in good faith for at least six months prior to the filing date or, as the case may be, the date of priority
- (b) proves that he has acquired clientele and that this clientele attaches a certain reputation to the mark; and
- (c) he files an application for registration of his own mark before lodging a statement of opposition with the Institute .

## ***Chapter 2-Procedures for Registration of Mark***

### **68. Application for Registration**

- (1) The application for registration of a mark shall be filed with Institute and shall:
  - (a) contain a request, a reproduction of the mark and a list of goods or services for which registration of the mark is requested, listed in the order of the relevant classes of international classification.
  - (b) be accompanied by the payment of the prescribed application fee.

- (2) When the mark consists of a sign that is not visually perceptible, the application shall contain a graphical reproduction of the mark. Such reproduction shall be specific and may not consist merely of a general description of the sign.
- (3) Where the applicant wishes to claim colour as a distinctive feature of the mark, he shall submit a statement to that effect as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour.
- (4) Where the applicant wishes to apply for a three-dimensional mark, he shall submit a statement to that effect.
- (5) The application shall be accompanied by power of attorney when it is made by an agent.
- (6) An applicant who is a foreigner shall appoint an agent who is domiciled in Seychelles.
- (7) The applicant may at any time withdraw the application or reduce the list of goods or services covered in the application.

## **69. Right of Priority**

- (1) The application may contain a declaration claiming a right of priority as provided for in the Paris Convention or a treaty to which the Republic of Seychelles is a party, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in any state party to the said Convention. [The declaration claiming priority shall indicate the date and number of the previous application as well as the State(s) where it has been filed.]<sup>11</sup>
- (2) Where the application contains a declaration under subsection (1), the Institute may request the applicant to furnish, within the prescribed time limit, a copy of the earlier application certified as correct by the office with which it was filed.
- (3) The period of claiming right of priority, under sub section (1) is six months beginning from the first filing date of the mark in a foreign country.
- (4) When the application is made within the period of priority, the filing in Seychelles of that application before the expiration of the period of priority shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the mark, and such acts cannot give rise to any third-party right or any right of personal possession of the mark.
- (5) Where the Institute finds that the requirements under this section and the regulations pertaining thereto have not been fulfilled, the said declaration shall be considered not to have been made.

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<sup>11</sup> Some laws such as the Intellectual Property Act of Rwanda include the bracketed phrase. Other laws deal with such detailed requirements in the implementing regulations. Which approach to take will be decided during the approval process?

## **70. Filing date**

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

(a) an express or implicit indication that registration of the mark is requested;

(b) information allowing the applicant's identity to be established;

(c) indications sufficient to contact the applicant or his representative if any,

(d) a reproduction of the mark;

(e) the list of goods or services for which registration of the mark is requested.

(2) If the Institute finds that the application did not, at the time of receipt, fulfil the requirements referred to in sub-section (1), it shall invite the applicant to file the required correction and shall accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

(3) Notwithstanding to the provisions of sub sections (1) and (2), no filing date shall be accorded before the required fee is paid.

## **71. Examination**

(1) The Institute shall examine and determine whether the application meets the requirements of Section 3 (20), 65 and 66 of this Act and related provisions of the regulations.

(2) Where the Institute finds that the requirements referred to in subsection (1) have not been satisfied, it shall invite the applicant to make the required corrections; if the applicant does not comply with the invitation, the application shall be considered withdrawn;

(3) When the Institute finds that the application is acceptable after its examination, it shall publish a notice inviting opposition against the registration of the mark in the official Gazette at the cost of the applicant.

## **72. Opposition**

(1) Any person may, within the period of thirty days and in the manner prescribed by the Regulations and upon payment of the prescribed fee, lodge an opposition against the registration of the mark with the Institute on grounds that one or more of the requirements of sections 3(20), 65 and 66 of this Act, and the regulations pertaining thereto are not fulfilled.

(2) The Institute shall immediately send a copy of the opposition to the applicant. The applicant shall send to the Institute a counter-statement stating the grounds on which he relies for his application within one month after receipt of the opposition or such further time not exceeding three months in

all, as the Institute may allow. If the applicant does not do so, he shall be deemed to have abandoned his application.

(3) If the applicant sends a counter-statement, the Institute shall furnish a copy of the counter statement of the applicant to the person who made opposition and after hearing the parties and examining the merits of the case, it shall decide to whether or not to proceed with the registration of the mark.

(4) The Institute shall furnish copies of its decision under subsection (3) to the applicant and the person who logged the opposition within the period prescribed by the Regulations.

### **73. Pending Cases**

(1) After an application is published and until the registration of the mark, the applicant shall enjoy the same privileges and rights as he would have, if the mark had been registered; provided, however, that it shall be valid defence to an action brought in respect of an act done after the application was published, if the defendant establishes that the mark could not have been validly registered at the time the act was done.

(2) Infringement proceedings may not be initiated before the date on which the mark is in fact registered

### **74. Registration of the Marks and Issuance of Certificate**

(1) The Institute shall register a mark and issue to the applicant a certificate of registration upon payment of the fee prescribed by the regulations where it finds that:

(a) the conditions referred to in this Act and the Regulations are fulfilled; and  
(b) the request for registration of the mark has not been opposed; or it has been opposed and the opposition has been rejected.

(2) Where the Institute finds that the conditions referred to in subsection (1) are fulfilled, it shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration.

(3) Where the Institute finds that the conditions referred to in subsection (1) are not fulfilled, it shall refuse the application and notify its decision to the applicant in writing explaining the reasons for its decision.

## **75. Right to Appeal**

- (1) Any person aggrieved by the final decision of the Institute on the registration of a mark shall have the right to appeal to the court.
- (2) An appeal pursuant to subsection (1) shall be submitted to the court within 60 days from the date of notification of the decision to the person concerned.

## ***Chapter 3-Rights conferred by Registration; Duration and Renewal of Registration***

### **76. Rights conferred by Registration**

- (1) A registered mark shall confer on the owner the exclusive right of use of the mark for all goods or services for which it is registered. The use of a registered mark, in relation to any goods or services for which it has been registered; by any person shall require the agreement of registered owner.
- (2) The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the trade mark by using, without his agreement, the mark as aforesaid or who performs acts which make it likely that infringement will occur. The right shall extend to the use of a sign similar to the registered mark and use in relation to goods or services similar to those for which the mark has been registered, where confusion may arise in the public.

### **77. Limitation of Rights**

- (1) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in and outside of Seychelles by the registered owner or with his consent.
- (2) Registration of a mark shall not confer upon its owner the right to preclude third parties from using the registered mark for information purposes, such as sales promotion or comparative advertising, provided that such use is not of such a nature as to deceive the public or does not constitute unfair competition.

(3) Registration of a mark shall not confer upon its owner the right to preclude third parties from bona fide use of their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, time of production or supply of their goods or services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

## **78. Duration of Registration**

Without prejudice to the provisions of sections 80, 81 and 82 of this Act, the registration of a mark shall be for a period of seven years<sup>12</sup> from the filing date of the application for registration.

## **79. Renewal of registration**

(1) Registration of a mark may, upon request of the owner and payment of renewal fee prescribed by the regulations, be renewed for consecutive periods of seven years each.

(2) At the time of the renewal, no change may be made in the mark or in the list of goods or services in respect of which the mark is registered, except that certain goods or services may be eliminated from the list.

(3) Renewal of the registration of a mark shall be made within three months after the expiry of the registration period; provided, however, that after the expiry of the three months period, the registration may be renewed within the next six months, by paying in addition to the regular renewal fee, a penalty prescribed by the Regulations.

(4) The Institute shall record renewal of the registration and notify same in an official gazette.

(5) A mark not renewed within the time limit stated in subsection (3) shall be considered to have been abandoned or cancelled.

(6) The Institute shall remove the mark from the register when it is not renewed in accordance with the provisions of this Section.

(7) Nothing under Sub-Sections (5) and (6) may prohibit any person including the former owner from seeking a registration for a mark that has been abandoned or cancelled provided that the application is filed after a period of at least three years has passed from the date on which notice of the termination of the mark was published in the Official Gazette.

## ***Chapter 4-Renunciation, Removal and Invalidation of a Registered Mark***

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<sup>12</sup> This provision accords the minimum period of protection required under the TRIPS agreement. It is also in line with the existing trademark decree except that the decree provides for a possibility of renewal after 14 years (section 17(2)). There are laws that accords ten years period of protection- examples include the laws of Burundi, Rwanda, and Uganda. Stakeholders may consider the different approaches adopted regarding the term of protection of a registered mark and make a decision.

## **80. Renunciation of Right**

- (1) The owner of a registered mark, who wishes to renounce the registration either wholly or in respect of part of the goods or services, for which the mark is registered, may submit his application to the Institute for the abandonment of the registration of the mark.
- (2) When a registered mark has been subject to a license contract, the request for the renunciation of the right shall be accepted only upon submission of a written declaration by which the licensee consents to the renunciation.
- (3) The Institute, upon receiving the application submitted pursuant to subsection (1), shall cause the publication of such renunciation in an official gazette.
- (4) Renunciation of registration shall be effective only after the decision for cancellation has been entered into the register.

## **81. Removal on Grounds of non use**

- (1) Any interested person may request the court <sup>13</sup> to order the removal of a mark from the register in respect of any of the goods or services for which it is registered on the ground that the mark has not been used by the registered owner or a licensee for uninterrupted period of three years or more.
- (2) A mark shall not be removed if it is proved that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon it in respect of those goods or services.

## **82. Invalidation of Registration**

- (1) Any interested person may request the court to invalidate the registration of a mark.
- (2) The court shall invalidate the registration, if the person requesting the invalidation proves that any of the requirements of sections 3(20), 65 and 66 is not fulfilled;
- (3) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published in an official gazette.

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<sup>13</sup> Some laws such as Ethiopian trade mark law and the Rwandan IP law give such a power to the IP office. Stake holders may decide the body that will be competent to deal with cases of removal of a registered mark due to failure of use.

## ***Chapter 5-Collective marks, Certification marks and trade names***

### **83. Collective marks**

- (1) Subject to the subsections (2) (3), and (4), the provisions of the sections of the chapter dealing with marks, shall apply to collective marks.
- (2) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.
- (3) The registered owner of a collective mark shall notify the institute of any changes made in respect of the regulations referred to in subsection (2).
- (4) In addition to the grounds provided in section 82 (2), the court shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in subsection (2) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

### **84. Certification mark**

- (1) Subject to Sub Sections (2), (3), (4) and (5) the provisions of the sections of the chapter dealing with marks, shall apply to certification marks.
- (2) The application for the registration of a certification mark must designate the sign as a certification mark and shall be accompanied by the Rules governing its use.
- (3) The owner of a certification mark may not use the sign to identify or certify his own goods or services.
- (4) Anyone who has proved that he satisfies the technical standards and other conditions of the regulations referred to in sub section (2) may not be refused the right to use the certification mark in the same conditions fixed by those regulations.
- (5) In addition to the grounds provided in Section 82(2), the Court shall, upon request of any interested person, invalidate the registration of a certification mark if the person requesting the invalidation proves that the owner of the certification mark uses it, or allows its use in contravention of the Rules referred to in subsection (2) or that he allows its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

## **85. Trade name**

(1) A name or designation may not be used as a trade name if, by its nature or through use that can be made of it, it is contrary to public order or morality and in particular, is likely to deceive business circles or the public as to the nature of the enterprise designated by the name.

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

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

## ***Chapter 6-Special provisions relating to licenses and assignments of Marks***

### **86. Assignment of a mark**

(1) The owner of a registered mark shall have the right to assign it without the transfer of the business to which the mark belongs.

(2) The provision of sub section (1) shall not apply to certification marks.

### **87. Licensing of marks and collective marks**

(1) Any licensing contract relating to a registered mark or an application there for, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used ,where such control is appropriate or necessary. If the license contract does not provide for such quality control or if such quality control is not effectively exercised, the license contract shall not be valid, and the Court may declare the mark as abandoned by its owner. Abandonment may be invoked as a means of defense in proceedings for infringement of a mark.

(2) The abandonment of a mark shall be deemed to have been effective as of the date on which the license contract has become effective, and it shall be recorded and a reference thereto published in the Official Gazette.

(3) A registered collective mark or an application for the registration of a collective mark may not be the subject of a license contract.

## ***Chapter 7-Geographical Indications***

### **88. Availability of Protection**

Protection under this Act shall be available-

(1) against the use of a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory;

(2) against a geographical indication that is identical or similar to a well-known mark, for related goods or services, if the use of that geographical indication is likely to cause confusion, or to cause mistake, or to deceive or risk associating the geographical indication with the owner of the well-known mark, or constitutes unfair exploitation of the reputation of the mark;

(3) against the use of a geographical indication which, even if identifying goods truly originating in the place designated by that geographical indication, designates goods that do not contain or present the quality, reputation or other characteristic that is essentially attributed to the goods in reason of their geographical origin;

(4) against any use of a geographical indication that constitutes an act of unfair competition within the meaning of Section 10bis of the Paris Convention.

### **89. Homonyms of geographical indications for wines**

(1) In the case of homonyms of geographical indications for wines, protection shall be granted for each indication, subject to the provisions of subsection 88(2).

(2) Where the parallel use of these indications is authorized, the Institute shall determine the practical procedures under which the homonymous indications in question will be differentiated from each other, taking into account the need to provide equitable treatment for the producers concerned and to ensure that consumers are not misled.

## **90. Geographical indications excluded from protection**

The following geographical indications shall be excluded from protection:

- (1) geographical indications which do not fit to the definition of section 3(10);
- (2) geographical indications which are contrary to public order and morality;
- (3) geographical indications which are not protected in their country of origin or cease to be protected in their country of origin, or which have fallen into disuse in this country ;
- (4) indications for goods which are identical to the term commonly used in current language  
as the common name for these goods in Seychelles.

## **91. Right to file application**

(1) The following shall have the right to file an application for protection of geographical indications:

- (a) natural persons or legal entities carrying on an activity as a producer in the geographical area specified in the application, with respect to the goods specified in the application, as well as groups of such persons; or
- (b) a government body.

(2) A government body on its own initiative or upon request of any of the persons designated in Subsection (1) (a), file for, obtain and enforce the registration of geographical indications with respect to goods where the producers of those goods are not formally organized and may not apply for, obtain and enforce the registration of geographical indications. The government body shall be the custodian of those geographical indications until it or the Court is satisfied that the persons or entities entitled to own and enforce rights in geographical indications are organized under the applicable laws or regulations.

## **92. Application for registration of geographical indication**

- (1) An application for registration of a geographical indication shall be filed with the Institute.
- (2) The application shall contain:

- (a) the name, address and nationality of the natural or legal person filing the application and the capacity in which the applicant is applying for registration;
  - (b) the geographical indication for which registration is requested;
  - (c) the geographical area to which the registration of the indication shall apply;
  - (d) the goods for which the geographical indication shall apply;
  - (e) the quality, reputation or other characteristics of the goods for which the geographical indication is used.
- (2) The application shall be subject to payment of the prescribed fee.

### **93. Examination of application**

- (1) The Institute shall examine the application and verify that it complies with the conditions set out in Sections 3(10), 90, 92 and with the relevant provisions of the regulations.
- (2) When the Institute finds that the application is acceptable after its examination, it shall cause the application, as accepted, to be published in the prescribed manner.

### **94. Opposition**

- (1) Any interested person may, within the periods set and in the prescribed forms, lodge an opposition to the registration of a geographical indication with the Institute, on the grounds that one or more of the conditions set out in 3(10), 90, 92 has not been met.
- (2) The Institute shall send a copy of the opposition to the applicant. The applicant shall send to the Institute a counter-statement stating the grounds on which he relies for his application within one month after receipt of the opposition or such further time not exceeding three months in all, as the Institute may allow. If the applicant does not do so, he shall be deemed to have abandoned his application.
- (3) If the applicant sends a counter-statement, the Institute shall furnish a copy of the counter statement of the applicant to the person who made opposition and after hearing the parties and examining the merits of the case, it shall decide to whether or not to proceed with the registration of the geographical indication.
- (4) The Institute shall furnish copies of its decision under Subsection (3) to the applicant and the person who lodged the opposition within the period prescribed by the Regulations.

## **95. Registration**

(1) The Institute shall register a geographical indication and issue to the applicant a certificate of registration upon payment of the fee prescribed by the regulations where it finds that:

- (a) the conditions referred to in this Act and the Regulations are fulfilled; and
- (b) the request for registration of the geographical indication has not been opposed; or it has been opposed and the opposition has been rejected.

(2) Where the Institute finds that the conditions referred to in subsection (1) are fulfilled, it shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration. Otherwise it shall refuse the application and notify its decision to the applicant in writing explaining the reasons for its decision.

## **96. Rights conferred**

(1) Producers engaged in production in the geographical area specified in the register shall have the right to use, for commercial purposes, a registered geographical indication for the goods indicated in the register and prevent all third parties from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the geographical indication is registered.

(2) Any interested person or group of producers or consumers may institute proceedings with the court to prevent, in relation to geographical indications, :

- (a) the use, in the designation or presentation of goods, of any means indicating or suggesting that the goods in question come from a geographical region other than the true place of origin in a way which misleads the public as to the geographical origin of the goods;
- (b) any use which constitutes an act of unfair competition within the meaning of this Act;
- (c) the use of a geographical indication to identify goods which do not come from the place designated by the geographical indication in question, or are used to identify spirits for those which are not from the place designated by that indication even in cases where the true origin of the goods is indicated or in those where the geographical indication is used in translation or is accompanied by expressions such as kind, type, style, imitation or others.

## **97. Duration of protection**

(1) Subject to sub-section (2) the term of a registered geographical indication shall be indefinite.

(2) A registered geographical indication shall be protected as long as the specific characteristics, quality or reputation which have been the basis of the grant of the protection still exist.

## **98. Misleading marks**

The registration of a mark which contains a geographical indication, or consists of such an indication, relating to goods which do not originate from the territory shall be refused or invalidated by the Institute or court, at the request of an interested party, if the use of this indication in the mark for such products in Seychelles is such as to mislead the public as to the true place of origin.

## **99. Marks Conflicting With a Geographical Indication for Wines and Spirits**

(1) The registration of a mark which contains a geographical indication used to identify wines or which consists of such an indication, or the registration of a mark which contains a geographical indication used to identify wines and spirits and which consists of such an indication shall be refused or invalidated by the Institute or the court at the request of an interested party, with regard to wines or spirits which do not have this origin.

(2) Where the registration of a mark has been requested in good faith, or the rights over the mark have been acquired by use in good faith prior to the date of entry into force of this Act, or before the geographical indication is protected in its country of origin, this Act shall not prevent the possibility of registering the mark or impede the validity of the registration of the mark, or the right to use the mark, for the reason that this mark is identical or similar to a geographical indication.

## **100. Invalidation or amendment of registration**

(1) Any interested person may request the court to order:

(a) invalidation of the registration of a geographical indication on the grounds that it does not meet the criteria for protection;

(b) amendment of the registration of a geographical indication on the grounds that the geographical area indicated in the register does not correspond to the geographical indication, or the reference to the goods for which the geographical indication is used, or the reference to the quality, reputation or other feature of these goods is missing or is unjustified.

(2) In any proceedings instituted under this section, notice of the request for invalidation or amendment shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and shall be communicated to all persons entitled to use the geographical indication, under sub section 90(1).

(3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Court in the said notice, apply to join in the proceedings.

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

## **Part VII**

### **Unfair Competition and Undisclosed Information**

#### **101. General Principles**

(1) Any act or practice carried out or engaged in, in the course of industrial or a commercial activity, which is contrary to honest practices, shall constitute an act of unfair competition.

(2) An act or practice that is contrary to honest practices, for the purposes of this part, shall mean practices that include:

(a) breach of contract,

(b) breach of confidence and inducement to breach confidence or contract,

(c) the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition;

(d) any violation of a legal obligation in general with a view to obtaining unlawful advantages over competitors or which lead to such advantages being obtained, such as the breach of environmental or labor law.

(3) Any person damaged or likely to be damaged by an act of unfair competition shall be entitled to the remedies referred to in Part VIII.

(4) The provisions of this Part shall apply independently of, and in addition to, any legislative provision protecting inventions, utility models, industrial designs, layout-designs, distinctive signs, literary and artistic works and other intellectual property subject matters.

#### **102. Confusion with another's enterprise or its activities**

(1) Any act or practice, which, in the course of industrial or commercial activities, creates or is likely to create confusion with another's enterprise or its activities, in particular with the goods or services offered by such enterprise, shall constitute an act of unfair competition.

(2) The confusion may relate in particular to:

- (a) a mark, whether registered or not;
- (b) a trade name;
- (c) any distinctive sign other than a mark or a trade name;
- (d) a product's external appearance;
- (e) the presentation of goods or services ;
- (f) a famous person or a well-known fictional character.

### **103. Damaging Another's Goodwill or Reputation**

(1) Any act or practice, in the course of industrial or commercial activities, that damages, or is likely to damage, the goodwill or reputation of another's enterprise shall constitute an act of unfair competition, whether or not this act or practice creates confusion

(2) The damage to another's goodwill or reputation may, in particular, result from the dilution of the goodwill or reputation attached to

- (a) a mark, whether registered or not;
- (b) a trade name;
- (c) any distinctive sign other than a mark or a trade name;
- (d) a product's external appearance;
- (e) the presentation of goods or services;
- (f) a famous person or a well-known fictional character.

(3) The lessening of the distinctive nature or advertising value of a mark, trade name or any other distinctive business sign , a product's external appearance or the presentation of goods or services or of a famous person or well-known fictional character shall constitute "dilution of goodwill or reputation" for the purposes of subsection (2).

### **104. Misleading the Public**

(1) Any act or practice, in the course of industrial or commercial activities, that misleads, or is likely to mislead the public with respect to an enterprise or its activities, in particular, the goods or services offered by such enterprise, shall constitute an act of unfair competition.

(2) The public may be misled by advertising or promotional activities, in particular, with

respect to the:

- (a) manufacturing process of a product;
- (b) suitability of goods or services for a specific use [purpose];
- (c) quality or quantity or other characteristics of goods or services;
- (d) geographical origin of goods or services;
- (e) conditions on which goods or services are offered or supplied;
- (f) price of goods or services or the mode of calculation.

### **105. Discrediting another's Enterprise or Its Activities**

(1) Any false or abusive allegation which, in the course of industrial or commercial activities, discredits or is likely to discredit another's enterprise or its activities, in particular the goods or services offered by such enterprise, shall constitute an act of unfair competition

(2) Discrediting may arise out of advertising or promotion and may, in particular, occur with respect to the:

- (a) manufacturing process for goods;
- (b) suitability of goods or services for a specific use [purpose];
- (c) quality or quantity or other characteristics of goods or services;
- (d) conditions on which products or services are offered or supplied;
- (e) price of goods or services or the mode of calculation.

### **106. Unfair Competition concerning Undisclosed Information**

(1) Any act or practice which, in the course of industrial or commercial activities, that results in the disclosure, acquisition or use by others, of undisclosed information without the consent of the person lawfully in control of that information, (hereinafter referred to as "the rightful holder") and in a manner contrary to honest business practices shall constitute an act of unfair competition.

(2) The disclosure, acquisition or use of confidential information by others without the consent of the rightful holder may, in particular, result from:

- (a) industrial or commercial espionage;
- (b) breach of contract;
- (c) breach of confidence;
- (d) inducement to commit industrial or commercial espionage, breach of

confidence or contract;  
(e) acquisition of confidential information by a third party who knew or was grossly negligent in failing to know that this acquisition entailed one of the foregoing acts.

(3) For the purposes of this Section, information shall be considered “undisclosed information” if:

- (a) it is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
- (b) it has commercial value because it is secret; and
- (c) its legitimate holder has taken reasonable steps, under the circumstances, to keep it secret.

(3) Any act or practice, in the course of industrial or commercial activities, shall be considered an act of unfair competition if it consists or results in

(a) an unfair commercial use of secret test or other data, the origination of which involves considerable effort and which have been submitted to appropriate authority for the purposes of obtaining approval of the marketing of pharmaceutical or agricultural or chemical products which utilize new chemical entities; or

(b) the disclosure of such data, except where necessary to protect the public, or unless measures have been taken to ensure that the data are protected against unfair commercial use.

## **Part VIII**

### **Industrial Property Rights enforcement**

#### ***Chapter 1-General Provisions***

##### **107. General Principles**

The general principles of enforcement of industrial property rights shall include the following:

- (1) The procedures concerning the enforcement of intellectual property rights shall be fair and equitable;
- (2) The procedures shall not impose overly burdensome requirements concerning mandatory personal appearances;
- (3) Parties to a legal proceeding shall be allowed to be represented by independent legal counsel;
- (4) Infringement claims shall be substantiated with relevant evidence, and
- (5) Measures or remedies against infringement shall be effective to prevent and deter infringement and adequate to redress the harm done.

## **108. Remedies against Infringements of Rights**

(1) The remedies against infringement of industrial property rights, made available under this Act include:

- (a) Provisional Measures,
- (b) Civil Remedies, and
- (c) Criminal remedies.

(2) The industrial property rights holder or the person authorized by him may seek for any or more or all of the above remedies.

(3) The Court may order cumulative remedies as it deems appropriate.

## **109. Reversal of Burden of Proof**

(1) For the purposes of civil proceedings in respect of the infringement of rights of the patentee, if the subject matter of a patent is a process for obtaining a product, the Court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.

(2) Any identical product when produced without the consent of the patentee shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process if:

(a) the product obtained by the patented process is new; or

(b) there is a substantial likelihood that the identical product was made by the process and the patentee has been unable through reasonable efforts to determine the process actually used.

(3) In ordering the production of evidence to the contrary, the Court shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

## **110. Evidence**

- (1) The Court may, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of the claims which lies in the control of the opposing party, order that this evidence be produced by the opposing party, subject, in appropriate cases, to conditions which ensure the protection of confidential information.
- (2) Where infringement is committed in a commercial scale, the Court may, upon request of a party or when found appropriate, order the production of communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.
- (3) In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, the Court may make preliminary and final determinations, affirmative or negative, on the basis of the information presented to it, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.

## ***Chapter 2-Provisional Measures and Civil Remedies***

## **111. Provisional Measures**

- (1) The court shall order prompt and effective provisional measures to:
  - (a) prevent an infringement of a right from occurring, in particular to prevent the entry into channels of commerce import and export goods after completing customs formalities.
  - (b) preserve relevant evidence in regard to the alleged infringement.
- (2) The court shall order provisional measures, without giving the other party an opportunity of being heard, where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.
- (3) The Court may, before making a decision under sub section (2), require the applicant to provide any reasonably available evidence in order to satisfy it with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.
- (4) Where provisional measures have been ordered without giving the other party an opportunity of being heard, the defendant may file a request for review with the Court within two weeks from the

notification of the decision. In the review proceedings, the Court shall give the parties concerned an opportunity of being heard and shall confirm, modify or revoke the decision within a reasonable period after the notification of the decision.

(5) The applicant may be required to supply other information necessary for the identification of the goods concerned by the authority that will execute the provisional measures.

(6) Where the applicant does not initiate court proceedings leading to a decision on the merits of the case within twenty working days or thirty one calendar days, whichever is longer, from the notification of the decision ordering provisional measures or within any other reasonable period determined by the Court in the decision, the Court shall revoke the provisional measures upon request of the defendant.

(7) Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an industrial property right, the court shall order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.

## **112. Damages**

(1) The court shall order the infringer, who knowingly, or with reasonable grounds to know, engaged in infringing activity, to pay damages adequate to compensate for the injury the right holder has suffered because of an infringement of his industrial property right. In determining the amount of damages awarded to the right holder, the Court may consider:

(a) the value of the infringed-on good or service, measured by the suggested retail price or other legitimate measure of value submitted by the right holder;

(b) the loss of earnings incurred by the right holder;

(c) the unfair profits made by the infringer,

(d) the expenses incurred by the right holder;

(e) the royalties or fees which would have been due if the infringer had requested authorization to use the industrial property right in question; and

(f) where appropriate, any moral damages caused to the right holder.

(4) The court shall order the infringer to pay the right holder expenses, which may include the court costs and appropriate attorney's fees.

(5) The court may, where appropriate, order recovery of profits and/or payment of pre-established damages where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

### **113. Other Remedies**

(1) The court may, upon the request of the plaintiff [applicant], order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements. In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

(2) The Court may, whenever this is considered adequate under the circumstances to create an effective deterrent to further infringement, taking due account of the need for proportionality between the seriousness of the infringement and the remedies as well as the legitimate interest of third parties, order the:

(a) seizure and forfeiture of the infringing goods and any of the materials or implements the predominant use of which has been in the commission of the act of infringement;

(b) goods, materials or implements be destroyed, or be disposed of outside the channels of commerce, without compensation of any sort, in such a manner as to avoid any harm caused to the right holder.

(3) In respect of counterfeit goods, the simple removal of the mark or geographical indication unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.

(4) The Court shall also, wherever this is considered adequate, taking due account of the conditions set out in sub section (1), order that materials or implements the predominant use of which has been the creation of infringing goods be disposed of outside the channels of commerce without compensation of any sort in such a manner as to minimize the risks of further infringement.

### **114. Information to the Right holder**

The Court shall order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution unless this would be out of proportion to the seriousness of the infringement.

### **115. Indemnification of Defendant**

(1) The Court shall order an applicant, at whose request measures were taken and who has abused enforcement procedures, to provide to a defendant wrongfully enjoined or restrained adequate compensation for the injury suffered because of such abuse.

(2) The court shall order the applicant to pay the defendant expenses, which may include appropriate attorney's fees.

(3) Public authorities and officials shall be exempted from liability to appropriate remedial measures where actions were taken or intended in good faith in the course of the administration of any law pertaining to the protection or enforcement of industrial property rights.

## **116. Appeals**

(1) Any decision by the Court in infringement proceedings shall be subject to an appeal to the Supreme Court<sup>14</sup>.

(2) The appeal shall be filed within sixty (60) days from the notification of the decision.

## **117. Time Limits**

Civil proceedings shall be initiated within five years from the date on which the right holder knew or had reasons to know the infringing acts, except in case of infringing use of distinctive signs in bad faith or for unfair competition purposes, for which there will be no time limits to initiate the proceedings.

## ***Chapter 3-Criminal Procedures and Remedies***

## **118. Criminal Offence**

(1) Any person who, except under limited justifiable circumstances provided under this Act, without the consent of a patent or utility model right holder:

(a) manufactures the product that is protected by a patent or utility model;

(b) uses a process invention or minor invention that is patented or protected by utility model certificate,

(c) exports, sells, displays or offers for sale, has in stock, conceals or receives, a

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<sup>14</sup> The appellate court will be determined based on the court that will serve as a first instance court. For the purpose of this draft the High court is taken as the first instance court.

product manufactured using a patented invention or minor invention protected by utility model, or a product obtained by a patented process invention; or

(d) imports a product that is the object of an invention or minor invention protected by patent or utility model, or obtained by a process invention patented into Seychelles that has not been placed on the foreign market directly by the right holder or by a person authorized by the right holder shall commit an offence.

(2) Any person who, except under limited justifiable circumstances provided under this Act, without the authorization of a registered industrial design right holder,:

- (a) manufactures a product that incorporates a registered industrial design, or a substantial imitation that may cause confusion or likelihood of confusion ,
- (b) exports, sells, displays or offers for sale, has in stock, conceals or receives, with a view to use for economic purposes, an object that illegally incorporates a registered industrial design, or a substantial imitation that may cause confusion or likelihood of confusion ; or
- (c) imports a product that incorporates an industrial design registered in Seychelles or a substantial imitation that may induce to error or confusion, and that has not been placed on the foreign market directly by the right holder or with his consent; shall commit an offence.

(3) Any person who, without the authorization of registered mark right holder:

- (a) reproduces a registered mark, in whole or in part, or imitates it in a way that may create likelihood of confusion;
- (b) alters the registered mark already affixed on a product placed on the market;
- (c) imports, exports, sells, offers or displays for sale, conceals or has in stock a product bearing a mark illegally reproduced or imitated, in whole or in part ; or a product of his own industry or commerce, contained in a vessel, container or package that contains the registered trade mark ; shall commit an offence.

(4) Any person who, without the authorization of a protected geographical indications right holder,:

- (a) Manufactures, imports, exports, sells, displays or offers for sale, or has

in stock a product that bears a false geographical indication; or

- (b) Uses, on a product, container, wrapping, ribbon, label, invoice, circular, poster, or any other means of divulcation or advertising, modifiers such as “type”, “species”, “genus”, “system”, “similar”, “substitute”, “identical”, or equivalent terms, that do not safeguard the true source of the product, shall commit an offence.

(5) Any person who, without the authorization of a registered layout designs right holder:

- (a) reproduces, 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 referred to in Section 55 of this Act; or  
(b) imports, sells or otherwise distributes 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, shall commit an offence.

## **119. Criminal Sanctions/Penalties<sup>15</sup>**

(1) Unless otherwise heavier penalty is provided for under the criminal law, whoever intentionally violates an industrial property right protected in Seychelles and commits any one of the offences under section 118, shall be punished with rigorous imprisonment of a term not less than 1 year and not more than 5 years.<sup>16</sup>

(2) Unless otherwise heavier penalty is provided for under the criminal law, whoever by negligence violates a right protected under the Industrial Property Act shall be punished with rigorous imprisonment of a term not less than 6 months and not more than 3 years.

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<sup>15</sup> Considering the adverse impact of counterfeits and products that infringe industrial property rights as well as the need for deterring potential infringers' severe penalties are proposed. A minimum penalty is provided to deal with the problem associated with unrestricted discretionary power. In order to help the court impose different penalties depending on the gravity of the offence, a wide range of imprisonment and fine are included and examples of factors that may be taken into account in determining the penalties are incorporated in the provision.

<sup>16</sup> The duration of penalty vary from laws to laws. The laws of Ethiopia and Rwanda provide a penalty of ten years for intentional infringement of an offence. The copyright law of Seychelles imposes five years of imprisonment and 30,000 SR as fine ( see article 21 (6). Stake holders may take note of this and decided a heavier penalty.

(3) The court may in addition to imprisonment impose fine a minimum of 50,000 up to a maximum of 500,000 rupees depending on the gravity of the offence and the harm caused on the right holder, the consumers, the general public and the country at large.

(4) In determining the penalties under sub sections (1) to (3), the Court shall take into account the:

- (a) severity of the harm done on the right holder, consumers, the general public and the country;
- (b) the value of the infringing products;
- (c) degree and scope of the infringing activity and the size of the infringing products;
- (d) frequency of the offence committed by the infringer, and
- (e) other relevant matters such as sufficiency of the penalty to provide a deterrent to future infringements.

(5) The penalty, where appropriate, shall include the seizure, forfeiture and destruction of infringing goods and of any materials and implements used in the commission of the offence. Such seizure, forfeiture and destruction shall occur without compensation of any kind to the offender.

## **120. Powers of entry, search and seizure**

(1) A police officer may arrest without warrant any person who, in any street or public place

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- (a) sells, exposes or offers for sale or hire; or
- (b) has, or is reasonably suspected of having, in his possession for the purpose of selling or letting for hire, any product that infringes industrial property rights protected in Seychelles.

(2) Any authorised officer may, at any time, without a warrant -

- (a) stop, search and board, whether forcibly or otherwise, any conveyance in which he reasonably suspects that there is any infringing product; and
- (b) seize, remove or detain such infringing product and anything which appears to him to be or to contain; or to be likely to contain, evidence of an offence under this Act.

(3) In the exercise of his power under sub section (2), an authorised officer may order the person in charge of a vehicle -

- (a) to stop and not to proceed until so authorised; or
- (b) to bring the vehicle to any police station.

## **Part IX**

### **Miscellaneous Provisions**

## **121. Registers**

- (1) SIPI shall maintain separate registers for patents, industrial designs, layout designs, marks, certification or collective marks and geographical indications
- (2) All the recordings provided for in this Act shall be entered into the said registers.
- (3) The Registers may be consulted by any person, who may obtain extracts there from, under the conditions prescribed in the Regulations.

## **122. Correction of errors**

The Institute may, subject to any provision in the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with it or in any recording entered into pursuant to this Act or the regulations

## **123. Extension of Time**

If the Institute is satisfied that the circumstances justify it, it may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the regulations issued there under, upon notice to the parties concerned and upon such terms as it may direct. The extension may be granted though the time for doing the act or taking the proceeding has expired.

## **124. Competence of Court and Appeal**

- (1) The High Court<sup>17</sup> shall have jurisdiction in disputes relating to the application of this Act and the regulations and in matters which under this Act are referred to the court.

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<sup>17</sup> The court that will have jurisdiction to deal with industrial property cases will be determined by the stakeholders. Some countries considering the complexity involved in industrial property cases and the involvement of foreigners give the jurisdiction to the high court.

(2) Any decision taken by the Institute under this Act, in particular the grant of a patent, a utility model certificate, the registration an industrial design, a layout design, the registration of a mark, collective mark, certification sign or geographical indication, or the rejection of an application for grant or registration of such title, may be subject of an appeal by an interested

party before the High court and such appeal shall be filled within two months of the date of decision.

## **125. Transitional provisions**

(1) The provisions of this Act shall apply to any applications pending on the date of their entry into force.

(2) Patents granted and marks registered under the Laws referred to in section 2 , at the entry into force of this Act, shall subject to subsections (2) and (3) , remain valid and shall be considered to have been granted or registered under this Act.

(3) Patents shall remain valid for the remaining period of the duration of the protection accorded under the previous Patent Act provided that annual maintenance fee is paid in accordance with the relevant provision of this Act and the regulations thereto.

(4) The registrations of marks made according to the provisions of the previous trade mark decree shall be renewed upon expiry of the period of registration in accordance with the relevant provisions of this Act and the regulations thereto.

## **126. Issuance of Regulations**

The Minister shall issue regulations for the implementation of this Act.