

Law No. 36 dated 17/4/2001 on Trademarks

Chapter One General Provisions

Article 1 This law regulates the rules related to trademarks and service marks.

Article 2 A trademark or a service mark is an apparent sign, which makes it possible to distinguish the goods presented or the services provided by a natural or a juridical person.

In particular this sign may consist of:

All forms of designations such as: Words, groups of words, surnames, geographical names, pseudonyms, letters, numbers and symbols.

Graphic signs such as: Drawings, holograms and shapes in particular those related to the product, its method of presentation, or those which distinguish the services, the arrangements of colors, the mixings of colors or the separation of the grades of colors.

Phonic signs such as musical tunes and sentences.

Article 3

The distinguishing characteristic of a sign which is to be used as a mark is evaluated with respect to the goods or services which the sign is to denote.

The following signs and designations do not contain a distinguishing characteristic:

Signs or designations, which are, used in the regular or professional language by necessity to denote generically or regularly the goods or services.

Signs or designations, which can be used to denote any quality or attribute of the goods or services in particular the type, quality, quantity, purpose, geographical origin, or the time period in which the product was produced or the service was provided.

Signs whose forms in particular are necessitated by the nature or function of the product or which give this product its essential value.

However signs and designations may acquire a distinguishing characteristic by usage except the signs stipulated in item (C) of the second paragraph of this article.

Article 4 A sign shall not be accepted as a mark or a part of a mark if it is:

A reproduction or an imitation of official slogans, flags, other slogans, logos, designations or abbreviated designations of any country or an international organization which is governmental or established by an international agreement unless they are used under an authorization from the competent governmental authority or organization.

A reproduction or an imitation of official symbols or stamps sanctioned by a country for quality and assurance unless their use is authorized by the competent authority of this country.

In violation of public order or good morals or if its use is prohibited by law.

Likely to mislead the public specially as concerns the nature, quality or geographical origin of the product or service.

Article 5 A sign shall not be approved as a mark if its represents an infringement of a prior right especially:

A prior registered mark or a well-know mark.

A designation or a company name which may lead to the confusion of the public.

A commercial name or a distinguished signboard which is known in the whole of Tunisia in case there is a possibility of confusion to the public.

A protected appellation of source.

A copyright.

Rights stemming from a protected industrial drawing or design.

Rights associated with the essence of others especially their surnames, pseudonyms or pictures.

The name or picture of a local group.

Chapter Two Gaining The Rights Associate With A Mark

Article 6 The right of ownership of a mark is obtained through registration. Ownership may be gained collectively.

The effects of registration shall take effect as from the filing date of the application for a period of ten years. This period of protection may be renewed endlessly.

Article 7 The application for the registration of the mark shall be filed at the industrial property authority in return for payment of fees to be determined by a ruling.

The application shall be accompanied by a power of attorney if an agent represents the applicant.

The applicant whose residence is outside Tunisia must hire an agent residing in Tunisia.

The power of attorney shall determine the extent of the agency and unless stating otherwise the power of attorney shall cover all action associated with the mark including all the procedures stipulated in this law excluding the two cases of withdrawing the application or abandoning it which require a special power of attorney.

In case of multiplicity of applicants for the same application, a common agent must be appointed.

Article 8 Every application for the registration of a mark shall be filed according to procedures to be determined by a ruling.

At each filing the industrial property authority shall verify that:

- It was filed according to the procedures stipulated in the first paragraph of this article. - That the sign qualifies as a mark according to articles 2, 3 and 4 of this law.

The industrial property authority shall provide the applicant with a receipt at the time of filing.

If the application for registration does not satisfy the requirements of the second paragraph of this article, the industrial property authority shall notify the applicant by a justified notification and give him a grace period of one month starting from the notification date to amend the application for registration or to contest the objections of the competent authority.

In case the amendment is not effected and no observations are submitted which lead to the elimination of the objections, the application for registration shall be rejected.

If the reasons for rejection concern only a part of the application for registration, only this part shall be rejected.

The rejection decision shall be justified.

The amendment effected according to the requirements of this article shall not lead to the expansion of the scope of registration.

Article 9 Every filing which has been legally accepted shall be published in the official publication of

the industrial property authority within a period not exceeding twelve months from the filing date.

Article 10 The applicant may starting from the filing date and until the date of the publication of the mark according to article 9 of this law correct material errors contained in the filing documents pursuant to submitting a justified request and payment of fees to be determined by a ruling.

Article 11 The application for registration may be opposed by:

- The owner of a mark which, was previously registered or filed or which enjoys the priority right stipulated in article 18 of this law with respect to the registration of the mark. - The owner of a previous well-known mark. - The holder of an exclusive license provided that the contract does not stridulate otherwise.

The opposition shall be submitted to the legal representative of the industrial property authority within the two months following the publication date of the application for registration according to the procedures to be determined by a ruling.

Every opposition filed after the deadline, by a person not entitled to file it or not satisfying the formal requirements shall be rejected.

Article 12 If the opposition satisfies the conditions stipulated in article 11 of this law, the industrial property authority shall try to reconcile the parties according to procedures to be determined by a ruling.

Article 13 The industrial property authority shall establish a register to be called "the national register of marks". The means of recording in this register shall be determines by a ruling.

Each mark which, has been legally registered by the industrial property authority shall be recorded in the register unless the application for registration has been rejected on withdrawn.

The applicant shall be given a certificate of registration of the mark in return for the payment of a fee to be determined by a ruling.

The registration shall be published in the official publication of the industrial property authority at a date not exceeding twelve months from the registration date.

Others may not contest any text changing or assigning the rights associated with a mark unless it is recorded in the register.

Recordal in the register is made subject to payment of a fee to be determined by a ruling.

Every recording in the national register of marks shall be listed in the official publications of the industrial property authority.

Article 14 Any person may inspect the national register of marks. He may also, in return for payment of a fee to be determined by a ruling, obtain the following documents:

- A certificate which includes the mark and the particulars related to filing and registration. - A copy of the recordings in the register related to a mark. - A certificate testifying that there is no recording.

Article 15 If the application for registration was done in a manner which represents an infringement of the rights of others or a breach of a legal or contractual contract, the person who feels that he has a right in the mark may demand its ownership through judicial authorities.

The legal proceedings for the demand of ownership shall prescribe in three years starting from the date of the publication of the registration unless the applicant of the registered mark has acted in bad faith.

Article 16 The trademark or service mark may be renewed for a period of ten years pursuant to a written request as long as this renewal does not involve a change in the mark or an expansion in the list of goods or services.

The request shall be accepted unless:

- If it is filed within the last six months of the validity of the registration by the owner of the mark or his agent who has to accompany the request with a special power of attorney. - It contains the identity of the owner and the mark whose renewal is sought. - It is accompanied with what proves that the due fees have been paid.

If the request does not satisfy the requirements of the second paragraph of this article, the industrial property authority shall notify the applicant with a justified notification sent via registered mail with a proof of receipt slip granting him a one month grace period as from the date of receipt of the notification to either rectify the request or contest the objections of the industrial property authority.

If the request was not rectified and no observations were filed which led to the elimination of objections, the requests will be rejected.

The renewal of the registration shall not be subjected to verifying its fulfillment of the requirements of articles 2, 3 and 4 of this law or the opposition procedures stipulated in article 11 of this law.

The new ten years period shall be calculated as from the end of the previous protection period.

Any change in the mark or any expansion in the list of goods or services must be made through a new filing.

Article 17 Taking into consideration the requirements of the international agreements signed by the republic of Tunisia, the foreigner who is not a national and not a resident of Tunisia shall benefit by the provisions of this law provided that the submits proof that he legally filed or registered the mark in his country of residence or citizenship and that the said country offers reciprocal treatment with respect to the protection of Tunisian marks.

Article 18 The said priority right in the international agreements ratified by the Republic of Tunisia shall cover all marks filed in a foreign country.

Taking into consideration the requirements of the international agreements ratified by the Republic of Tunisia, the priority right is conditional on reciprocal treatment offered to filed Tunisian marks by the said country.

Article 19 Claiming priority associated with a prior foreign filing shall require filing an authenticated true copy issued by the industrial property authority in the country where filing took place and where applicable submitting justification for the right to claiming priority to the industrial property authority within three months following the filing date in Tunisia.

If this condition is not satisfied, the claim for priority shall be considered as null and void.

Article 20 Any applicant who did not abide by the deadlines stipulated in articles 16 and 19 of this law, if he proves that he has a legitimate excuse may be exempted from the lapse of the right which he was liable to be subjected to, by submitting a request to the legal representative of the industrial property authority.

The request shall not be accepted if:

- It is not preceded by carrying out the procedures, which has been ignored. - It is filed after two months as of the termination of the impediment. - It is not accompanied by proof of payment of the due fees.

Chapter Three Rights Conferred By Registration

Article 21 The registration of the mark shall confer on its holder the right to own this mark with respect the goods or services indicated at the time of filing.

Article 22 Without the consent of the owner, others are prohibited from:

Reproduction, usage or placing of a mark even with the addition of such words as "composition, style, system, imitation, type or method" as well as usage of a reproduced mark with respect to products or service similar to those indicated in the registration.

Deletion or alteration of a mark which was legally placed.

Article 23 In case there is a possibility of confusion to the public, it is prohibited without a license from the owner to:

Reproduction, usage or placing a mark as well as usage of a reproduced mark on goods or services similar to those indicated in the registration.

Counterfeit of a mark and using a counterfeit mark on goods or services identical or similar to those listed in the registration.

Article 24 The user of a well-known mark with respect to goods or services which are not similar to those listed in the registration shall be held liable for civil responsibility if this results in damage to the owner of the mark or if this use represents an unjustifiable exploitation of this mark.

The provisions of the first paragraph of the article shall apply to the use of well-known marks according to the international agreement ratified by the Republic of Tunisia.

Article 25 The registration of mark does not prohibit the use of the same or similar sign:

As a designation of a company, a commercial name, a shop name if this usage was done prior to the registration or if others used it as their surnames in good faith.

As a necessary reference to indicate the way of usage of a product or a service specially as being a secondary piece or a spare part provided that there is no confusion as to the source of the product or service.

However, if this usage will cause damage to the rights of the holder of the registration, the said holder may file a memorandum to the competent court requesting the prohibition or limiting of this usage.

Chapter Four Transfer And Loss Of The Rights Associated With The Mark

Article 26 Every assignment or change of the rights associated with a mark recorded in the national register of the marks must be recorded so that it becomes binding against others.

Article 27 The rights associated with a mark may be assigned totally or partially and may be subject to lien.

The assignment even if partial may not be limited by location. The assignment or lien must be in a written form, otherwise it will be null and void.

Article 28 The rights associated with a mark may be subject to an exclusive or a non-exclusive license.

Article 29 The applicant for the registration or the owner of the mark may obtain withdrawal of the license to exploit the mark, if the beneficiary violates the provisions of the contract, based on a request to be submitted the competent court.

Article 30 The applicant for registration of a mark may withdraw his application totally or partially prior to the grant of the mark with respect to the goods or services covered in the application.

The withdrawal must be pursuant to a written request by the applicant or his agent.

If the application for registration was filed by several persons, the said application may not be withdrawn except by all the applicants or by a person who has a legal power of attorney from all the applicants.

If there has been a grant of exploitation rights or a lien the withdrawal request must be accompanied by a written consent from the beneficiary of the license or the holder of the lien.

The withdrawal shall not prevent the publication of the application for registration in the official publication of the industrial property authority.

Article 31 The owner of a registered mark may abandon, totally or partially, the effects of the registration with respect to the goods or services covered by the mark.

Article 32 The cancellation action has to be filed at the competent court.

The cancellation of a mark shall be based on a judicial judgment if the registration does not conform to the provisions of articles 2, 3, 4 and 5 of this law.

The judgment for cancellation shall have absolute effect.

Article 33: The representative of the public prosecution may directly request the cancellation of a mark in the cases stipulated in articles 2, 3 and 4 of this law.

The owner of a prior right may, excluding others, file a cancellation action according to article 5 of this law. However his action shall be rejected if the mark has been filed in good faith and has been allowed to be used for five years.

The cancellation action which is allowed to be filed by the owner of a well-known mark shall prescribe after a period of five years starting from the registration date unless the application for registration was carried out in bad faith.

Article 34 The rights of the owner of the mark may lapse if he, without an excuse, did not seriously use the mark for at least five consecutive years on one of the goods or services listed in the registration.

The following shall specially be considered as serious use of the mark:

Placing the mark on the goods or their packaging for the purpose of marketing.

Using the mark in a differing form which does not make it lose its distinctive nature.

Using the mark with the consent of its owner or by a person qualified to use a collective mark.

The cancellation of the right may be not claimed if the serious use of the mark or the resumption of this use took in the period between the end of the five years period referred to in the first paragraph of the article and the time of the submission of the request for the cancellation of the right.

However, this serious use shall not prevent the lapse of the right if it is carried out during the three months preceding the filing of the cancellation request and after the mark owner has known of the possibility of filing the cancellation request.

The burden of the proof of exploitation rests with the owner of the mark subject to the lapse of the right. Exploitation may be proven by all means.

Article 35 Any interested party may file a cancellation case before the courts.

If the claim for cancellation covers only a part of the goods or services listed in the registration, then the lapse of the right shall cover only the said goods or services.

The lapse of the right shall take effect as from the end of the five years period stipulated in article 34 of this law. The lapse of the right shall have absolute effect.

Article 36 The rights of the owner of the mark may lapse if:

The mark became the generic name of the product or service due to an action taken by the mark owner.

The mark became a source of confusion to the public as to the nature, quality or geographical origin of the product or service due to the use by the mark owner or by his consent.

Chapter Five Appeals

Article 37 The decisions issued by the legal representative of the industrial property authority may be appealed in front of the competent courts.

Article 38 The term for appealing the decisions stipulated in article 38 of this law is one month starting from the notification date of the disputed decision.

Article 39 The appeal is to be filed in a written memorandum to be directed or presented to the court.

The memorandum shall not be accepted unless it necessarily include the following particulars:

When the appellant is a natural person: his name, surname, profession, address, nationality and date and place of birth.

When the appellant is a juridical person: legal form, designation, social address and the name and surname of his legal representative.

The date and subject of the appealed decision.

The name and surname of the owner of the mark or the applicant of the mark if the appellant is neither of these.

The memorandum of appeal shall include a copy of the appealed decision.

If the memorandum does not include the evidence for the case, the claimant must present this evidence in writing to the court within seven days before holding the session.

Article 40 The claimant shall direct to the industrial property authority a copy of the memorandum of appeal through an executing judicial clerk.

The industrial property authority shall forward the file of the appealed decision to the court clerk within one month from the notification of the copy of the memorandum.

Article 41 If the appeal is filed by a person other than the owner of the mark or the owner of the application for registration, this person must summon such owner through an executing judicial clerk.

Article 42 The appellant may appoint an agent representing him in front of the court.

Article 43 The more interested party shall notify the rest of the parties of the ruling of the court.

Chapter Six Counterfeit and Penalties

Article 44 Every infringement of the rights of the owner of the mark shall be considered as counterfeit making its perpetrator liable for both civil and criminal responsibility.

The violation of the provisions stipulated in the articles 22 and 23 of this law shall be considered as infringement of the rights associated with mark.

Article 45 The actions preceding the publication about the application for registration shall not be considered as infringement of the rights associated with this mark.

However if the applicant notified the alleged infringer by a copy of the application for registration, he may examine and follow up the subsequent actions.

The competent court shall postpone adjudging the case until the publication of the registration.

Article 46 The civil lawsuits shall be filed in front of the competent court.

Article 47 The provisions of article 46 of this law shall not bar the resorting to arbitration according to the conditions stipulated in the arbitration publication.

Article 48 The owner of mark shall file the civil counterfeit lawsuit.

It may also be filed by the applicant for registration according to the conditions stridulated in article 45 of this law.

However if the license contract does not contain a provision to the country, the beneficiary of an exclusive right on the exploitation of a mark may file the counterfeit lawsuit if the owner of the mark did not file such lawsuit despite being alerted.

The intervention of any party to the license contract may be accepted in the counterfeit lawsuit filed by another party for claiming compensation for incurred damages.

The counterfeit lawsuit prescribe after three years from the date of committing the counterfeit actions.

No counterfeit lawsuit related to a subsequent registered mark which was allowed to be used for a period of five years shall be accepted unless it was filed in bad faith, however the non-acceptance of the lawsuit is limited to the goods and service upon which the mark was allowed to be used.

Article 49 The president of the court competent for the counterfeit lawsuit who is to issue a summary judgment may order the halt of the counterfeit action temporarily together with the payment of a fine or he may make its continuation conditional on the deposit of a collateral to guarantee the compensation of the owner of the mark or the beneficiary of an exclusive exploitation right.

The request for the halt or the deposit of a collateral shall not be accepted unless the lawsuit seems initially to be serious and was filed within a month starting from the day the owner of the mark or the beneficiary of an exclusive exploitation right knew of the counterfeit action.

The president of the court may make the halt conditional on the requester placing a collateral to guarantee the compensation of the defendant for possible damages if the ruling is issued for the non-validity of the counterfeit case.

Article 50 Any person who files a counterfeit lawsuit according to the provisions of article 48 of this law has the right to seek and obtain a permission from the president of the competent court to appoint an executing judicial clerk assisted by an expert to carry out an expert description with or without taking samples or with the seizure of the goods or services alleged to have a

mark put on them and which are displayed for sale or which have been delivered or supplied to others causing damage to him or infringing his rights.

The seizure of the goods, when authorized, shall be limited to making the samples necessary to prove the counterfeit available to the system of justice.

The seizure of the goods may be made by the president of the court conditional of the requester submitting collateral to guarantee the compensation of the defendant for the damage that he may incur if a ruling is issued for the non-validity of the counterfeit case.

The seizure shall be considered null and void if the complainer did not file a court case within 15 days regardless of the damages. The 15 days term shall be calculated starting from the day of carrying out the seizure or the description.

Article 51 Taking into consideration the penalties stridulated in special provisions, a fine between five thousand and fifty thousand Dinars shall be imposed on:

Any person who reproduces, counterfeits, uses, places, removes, alters a mark and by doing so infringes the rights granted by the registration of the mark and the restrains based on the registration.

Any person who supplies or exports goods bearing a counterfeit mark.

Article 52 Taking into consideration the penalties stipulated in special provisions, the penalty stipulated in article 51 of this law shall be imposed on every person who illegally posses goods which he knows are carrying a counterfeit mark, willfully sells goods or services which bears this mark, displays them for sale, supply them to others or offers to supply them to others.

Article 53 In case of recidivism with respect to the violations stipulated in articles 51 and 52 of this law a judgment for imprisonment for a period from one to six month may be issued regardless of the judgement of the fine which is doubled.

Article 54 In all cases the court may permit the publication of the full text of the ruling or a part thereof in the newspapers which it specifies, as well as posting it in the locations it specifies specially on the main entrances of the laboratories or factories of the convicted and on the facade of his shops at the expense of the convicted.

Article 55 In the text of the ruling dealing with the violation of the provisions of article 51, 52 and 53 of this law the court may rule for the seizure of the products and instruments used in committing the crime.

The court may also authorize the destruction of these products.

Chapter Seven Border Arrangements

Article 56 The owner of a protected mark or any holder of a right thereof once in a possession of serious proofs of an activity of supplying products bearing a counterfeit mark, may submit a written request to the government authorities requesting the halting of the government procedures related to the supply of the said goods.

The requester shall inform the government authorities if his rights are not legally registered or if they have lapsed.

Article 57 The written request stipulated article 56 of this law shall include: - The name, surname or known name of the requester and his place of business. - Proof that the requester has a right with respect to the goods subject of the dispute. - An accurate description of the goods to enable the authorities to identify them.

The requester should provide all relevant advice to enable the authorities to make an enlightened decision, without the provision of this advice being a condition of accepting the request.

This advice shall specially include: - The location where the goods are present or to which it will be sent. - Particulars which make it possible to identify the shipped goods or packages. - The specified date for arrival of the goods or the shipping date. - The means of transportation. - The particulars which make it possible to identify the supplier, source, or holder of the goods.

The requester must also enclose with the request a pledge regarding fulfilling his possible responsibility towards the supplier if it is proven without a doubt that the goods subject to detention by the authorities do not represent an infringement of the protected mark.

Article 58 The authorities shall examine the request submitted according to the provisions of article 56 of this law and shall notify the requester immediately and in writing of its decision. This decision must be justified.

If the authorities accept the request or take action to intervene according to the provisions of article 65 of law, the authorities may obligate the requester to submit a financial collateral to be assigned to cover the expenses which may be incurred due to keeping the goods under the supervision of the authorities.

Article 59 The authorities shall detain the goods if it becomes evident after inspection that they are identical to what is included in the request and, where necessary after interviewing the requester.

The authorities shall advise the requester and the supplier immediately of the detention and shall permit them to examine the detained goods and to take samples thereof to carry out the needed tests and analysis to establish whether the goods are counterfeit in accordance with the government regulations and without prejudice to the principle of the secrecy of information.

In order to enable the requester to file a lawsuit, the authorities shall advise him of the names and addresses of the exporter, the supplier and the recipient if known to them as well as the quantity of the goods subject of the request. The permission shall be granted as a response to a memorandum.

Article 60 The detention of the goods shall be lifted, provided that all the government procedures are completed, if the requester does not submit proof to the authorities within ten days starting from the notification date of the detention that he has filed a civil or a criminal lawsuit at the competent court, has requested and obtained permission for effecting the legal precautionary procedures and has submitted sufficient collateral to cover his responsibilities towards the concerned persons.

The amount of the collateral shall be determined by the court.

The ten days term stipulated in the first paragraph of this article may be extended for at most ten other days in the cases which may require much extension.

The owner, the supplier, or the recipient may obtain permission to lift the detention on the goods subject of the dispute in return for the payment of a financial collateral whose amount shall be determined by the court and which shall be sufficient to cover the interests of the requester provided all the governmental procedures are completed.

The authorities shall at once notify the owner, the supplier, the recipient and the requester of the lift of the detention of the goods.

Article 61 If in virtue of a self-executing judgment the goods are proven to be counterfeit, the judicial authorities shall decide the fate of the goods by:

- Either destroying them under the supervision of authorities. - Or by excluding them from the commercial circulation provided that this does not damage the interests of the owner of the mark.

Article 62 The authorities may under their own initiative suspend the governmental procedures regarding

the supply of goods bearing counterfeit good. In this case: - The authorities shall at once advise the owner of the mark or any one who obtain a right thereof, who has to submit the request referred to in article 56 of this law within three days from his notification date by the authorities. The provisions of the articles of this chapter shall be obligatorily applied. - The detention of the goods shall obligatorily be lifted according to the provisions of this article if the owner of the mark or any one who obtains a right thereof did not file the request referred to in article 56 of this law within three days from the date of his notification by the authorities.

Article 63 The authorities shall under no circumstances be held responsible if they could not identify the goods supposed to bear a counterfeit mark.

Article 64 The provisions of the articles of this chapter shall not apply to the goods which do not have a commercial nature and which are found among the personal luggage of the passengers provided that they are within the quantities defined by the applicable regulations and arrangements.

Article 65 The executive regulations of this chapter shall be issued by a decree from the minister of finance.

Chapter Eight Collective Marks

Article 66 A mark shall be considered collective if it can be used by any person who abides by its system of usage, which is established by the owner of the registration.

The collective mark may be granted by a non-exclusive license.

Article 67 The articles of this law shall be applied to collective marks.

Chapter Nine Miscellaneous Provisions

Article 68 As from the date this law takes effect all conflicting provisions shall be invalidated specially

the decree dated June 3, 1889 regarding the marks of factories and commercial establishments and its complementing and amending provisions.

Article 69 The marks registered according to the decree dated June 3, 1889 regarding the marks of factories and commercial establishments and its complementary and amending provisions shall remain valid regardless of the cancellation of the decree and shall be considered as registered pursuant to the provisions of this law.

The term which upon its termination the rights of the owner of a mark may lapse according to article 34 of this law with respect to the marks which were registered before the issuance of this law shall be five years starting from the issuance date of this law.