



## **TUNISIA**

### **Design Law no. 12 of 2001**

#### **Law no. 12 of 2001 for the Protection of Industrial Designs**

##### **Chapter I: General**

##### **Chapter II: Deposit Procedures**

##### **Chapter III: Appeals**

##### **Chapter IV: Infringements and Penalties**

##### **Chapter V: Border Measures**

##### **Chapter VI: Miscellaneous**

##### **Chapter I: General**

1. The aim of this Law is to establish the rules relating to the protection of industrial designs.

2. The provisions of this Law shall apply to any new design, any new three-dimensional form, or any industrial product which differs from those similar to it, either in terms of a distinct and recognizable configuration conferring on it a character of novelty, or by one or more external effects providing it with a specific and novel appearance.

However, even if the same subject matter has been considered to be a novel industrial design and a patentable invention, and the components of the novelty of the design cannot be separated from those of the invention, said subject matter can be protected only in accordance with the provisions of the Law on Patents.

3. The deposit of an industrial design shall be declared void by means of a court decision where the depositor is not the author of the design.

An action for annulment of the deposit shall be brought by any interested party during the period of protection of the industrial design.

Where a deposit has been declared void by means of a court decision which has acquired the force of *res judicata*, a copy of this decision shall be communicated to the body responsible for industrial property by the interested party.

The decision to annul the deposit of an industrial design shall have absolute effect.

4. Any creator of an industrial design or his beneficiaries shall have the exclusive right to use or sell this design, without prejudice to such rights as they may have from other legal provisions, in particular the legislation relating to literary and artistic property.

Third parties shall be prohibited, without the consent of the owner of an industrial design or his beneficiaries, from manufacturing, selling or importing merchandise comprising an industrial design which is, either in full or in part, a copy of the protected design, where these acts are undertaken for commercial purposes.

5. The provisions of this Law shall apply to the industrial designs whose authors or their beneficiaries are Tunisian or are domiciled in Tunisia, or in fact own serious industrial or commercial establishments in Tunisia, or who, by means of their nationality, domicile or industrial or commercial establishments, are nationals of a State which, through its domestic legislation or under the international agreements to which it is a party, guarantees for Tunisian industrial designs the same rights as those granted to its nationals.

6. The right of priority provided for by the Paris Convention for the Protection of Industrial Property shall extend in Tunisia to any industrial design previously deposited in a member country of the Paris Union or member State of the World Trade Organization.

The claim of priority shall be subject to the payment of a fee, the amount of which shall be fixed by decree.

## **Chapter II: Deposit Procedures**

7. Industrial designs shall enjoy legal protection only where they are deposited in accordance with this Law.

8. Ownership of an industrial design shall belong to the person who has created it or to his beneficiaries. The first depositor of said industrial design shall be assumed, unless proven otherwise, to be the creator of the design.

9. An industrial design should be deposited with the body responsible for industrial property in return for the payment of fees, the amounts of which shall be fixed by decree.

Where the depositor is represented by an agent, a written power of attorney shall be attached to the declaration of deposit.

A depositor domiciled overseas shall appoint an agent registered in Tunisia.

The agent's power of attorney shall specify the scope of representation. Unless stated otherwise, this power shall extend to all the acts affecting the industrial design, including the notifications provided for by this Law.

The renunciation of the deposit of an industrial design shall require a special power of attorney.

10. The duration of the protection of an industrial design provided for by this Law shall, at the depositor's choosing, be five, ten or a maximum of 15 years, in return for the payment of a fee, the amount of which shall be fixed by decree.

The depositor or his beneficiaries may, with the requisite declaration, extend the deposit where it has been made only for a period of five or ten years, without exceeding the maximum period of protection set at 15 years.

The declaration shall, subject to inadmissibility, be:

- made using a form established by the body responsible for industrial property and which shall necessarily include the identification of the holder of the deposit, for which an extension is requested;

- submitted within the last six months preceding the expiry of the first period of protection, by the interested party or his agent, who shall attach the power of attorney to the declaration;

- accompanied by proof of payment of the prescribed fee.

It may be specified that the extension is valid only for certain protected industrial designs.

11. The body responsible for industrial property shall keep a register known as the National Register of Industrial Designs. The procedures for entry in the Register shall be fixed by decree.

Any industrial design, lawfully deposited, shall be entered by the body responsible for industrial property in the Register, without prior examination of the rights of the depositor, or of the novelty of the deposited subject matter.

Any act amending or transferring the rights attached to a deposited industrial design may be effective against third parties only if it has been entered in the National Register.

Any entry made in the National Register shall be reported in the official gazette of the body responsible for industrial property.

The entries made in the National Register shall be subject to the payment of fees, the amounts of which shall be fixed by decree.

Any person may consult the National Register of Industrial Designs and obtain a reproduction of the entries made in said Register in return for the payment of a fee, the amount of which shall be fixed by decree.

12. A deposit may be made at any time. The publicity given to an industrial design, prior to its sale, through an offer for sale or by any other means, shall not lead to the loss either of the right of ownership or of the protection granted by this Law.

13. The application for the deposit of any industrial design shall be submitted in accordance with procedures which shall be fixed by decree.

For each deposit, the body responsible for industrial property shall verify that:

- the deposit is made subject to the requirements of the first subparagraph of this article;
- its publication is not likely, according to the opinion of the authorities concerned, to infringe the moral code or public order.

Subject to loss of his deposit right in the case of non-compliance of the deposit with the provisions of subparagraph two of this article, appropriate reasoned notification shall be given to the depositor and a period of three months starting from the date of the notification shall be given for the depositor to correct the deposit or to answer the objections raised by the body responsible.

In the case of failure to correct the deposit or submit observations allowing the objections to be overcome, the deposit shall be rejected.

Reasons shall be given for the decision to reject a deposit.

The corrections made in accordance with the provisions of this Article may not lead to the scope of the deposit being extended.

14. A depositor who has not respected the deadline laid down in Article 13 of this Law may, where he has a legitimate excuse, be exempt from the losses which he may have incurred, on submission of a request to the legal representative of the body responsible for industrial property.

The body responsible for industrial property shall declare as inadmissible any application:

- not preceded by the completion of the procedure omitted;
- submitted more than two months after the prohibiting factor has ceased to exist;
- relating to a deadline which has expired more than six months previously;
- not accompanied by proof of payment of the prescribed fee.

The decision to reject a deposit shall be accompanied by the reasons therefore, be notified to the depositor by registered mail with acknowledgement of receipt, and entered immediately in the National Register of Industrial Designs.

15. Any deposit recognized as admissible shall be published in the official gazette of the body responsible for industrial property, within a period not exceeding nine months.

At the time of deposit, the depositor may request that the publication of the reproductions of the design be postponed by twelve months starting from the day following the deposit date, in return for the payment of a fee, the amount of which shall be fixed by decree.

16. The owner of a deposit of an industrial design may at any time surrender the deposit in return for the payment of a fee, the amount of which shall be fixed by decree. The surrender may be limited to one part of the deposit.

The surrender of a deposit shall be made by means of a written statement submitted to the body responsible for industrial property. The statement shall be drafted by the owner or by his agent, who shall have a special power of attorney.

A statement of surrender may refer to one deposit only.

The statement of surrender shall indicate whether rights of use or pledge have been granted. If so, the statement shall be accompanied by the written consent of the beneficiary of the right of use or of the pledgee.

In cases where there is more than one depositor, the surrender may be made only if the statement is submitted by all the depositors.

The surrender shall not prevent the publication of the deposit in the official gazette of the body responsible for industrial property.

### **Chapter III: Appeals**

17. The appeals made against the decisions of the legal representative of the body responsible for industrial property in relation to the deposit, withdrawal or maintenance of the protection of industrial designs shall be lodged with the competent courts.

18. The period for appeals lodged with the courts against the decisions cited in Article 17 of this Law shall be one month from the date of notification of the disputed decision.

19. Appeals shall be lodged in the form of a written request submitted to the registry of the competent court.

Subject to non-admissibility declared ex officio, the request shall contain the following details:

— whether the requestor is a natural person: his first name, surname, profession, domicile, nationality, and date and place of birth;

— whether the requestor is a legal person: his legal status, name, registered office, and the first name and surname of his legal representative;

— the date and subject matter of the decision challenged;

— first name, surname and address of the owner of the industrial design.

A copy of the decision challenged shall be attached to the request.

If the request does not contain a statement of the means relied on, the requestor shall submit such a statement to the court registry at least seven days before the first court hearing.

20. A copy of the request shall be sent by the requestor to the body responsible for industrial property through a bailiff-lawyer.

The body responsible for industrial property shall forward to the court registry the file containing the decision challenged, within one month of the date of receipt of the copy of the request.

21. Where an appeal is lodged by a person other than the owner of the deposit of an industrial design, the owner shall be cited and summoned by the requestor through a bailiff-lawyer.

22. The requestor may be represented in court by an agent.

23. The court ruling shall be notified to the other parties by the most diligent party and entered immediately in the National Register of Industrial Designs.

#### **Chapter IV: Infringements and Penalties**

24. Any infringement of the rights of the owner of an industrial design, as defined by Article 4 of this Law, shall constitute the crime of infringement, and shall incur the civil and criminal liability of the person committing the infringement.

Any person who has knowingly infringed these rights shall be punished with a fine of five to fifty thousand dinars.

In addition, the court may order, at the expense of the guilty party, that the ruling be displayed in such public places as it considers appropriate and that the ruling be published, in full or in part, in the newspapers it designates.

A fine of one to five thousand dinars may be imposed on any person who has included, in his commercial documentation, advertisements or goods, a reference creating the belief that an industrial design has been deposited under this Law, whereas the deposit has not taken place or it has been annulled, or that the period for which it has been carried out has ended.

A criminal case may be brought by the Public Prosecutor's Office only on a complaint by the injured party.

25. In the case of a repeat offence, a prison sentence of one to six months may be handed down in addition to the fine which is doubled.

26. In the case of a conviction, the court may order that the instruments used to manufacture the incriminating items be confiscated.

27. The events prior to the deposit shall not give rise to any action under this Law.

No criminal or civil case may be brought under Article 24 of this Law, before the deposit has been published.

The events subsequent to the deposit, but prior to it being made public, may, under Article 24 of this Law, give rise to a case (even in civil law) only provided that the injured party establishes the bad faith of the guilty party.

Where the events are subsequent to the deposit being made public, the persons responsible may plead their good faith, provided that they supply appropriate proof.

28. The injured party may provide, through a bailiff-lawyer, a detailed description, with or without seizure, of the incriminating objects or instruments, subject to an order issued by the president of the competent court, on submission of a request and production of proof of the deposit.

The president of the court may demand from the requestor a security which the requestor shall be obliged to pay before undertaking the operation referred to in the first subparagraph of this article.

Before making a seizure, the bailiff-lawyer shall give a copy of the order and the record of seizure to those in possession of the objects described and, where necessary, of the act recording the security deposit, subject to the proceedings being declared void and damages against the bailiff-lawyer being paid.

Where the requestor does not initiate court proceedings within a period of fifteen days, the description or seizure shall be declared void ipso jure, without prejudice to the damages.

The period of fifteen days shall begin from the day on which the seizure or description has taken place.

29. The infringement cases provided for by this Law shall be time-barred within a period of three years from the time of the infringing events which are the cause of the cases brought.

30. The provisions contained in this chapter shall not prevent recourse to arbitration, subject to the requirements of the Code of Arbitration.

## **Chapter V: Border Measures**

31. The owner of a protected industrial design or his beneficiaries may, where he has serious reasons to suspect that imports are taking place of goods containing infringed industrial designs, submit a written request to the customs authorities demanding suspension of the customs clearance for the import of these goods.

The requesting party shall inform the customs authorities in cases where his right no longer appears to have valid registration or appears to have expired.

32. The request provided for in Article 31 of this Law shall contain:

- The first name and surname or business name of the requestor, his domicile or head office;
- Formal proof establishing that the requestor is the holder of a right in the goods which are the subject of the dispute;
- A description of the goods sufficiently precise as to allow the customs authorities to recognize them.
- In addition, the requestor shall provide all the other useful information he has available to allow the customs authorities to take a fully informed decision, without, however, the submission of this information representing a requirement for the admissibility of the request.

This information relates, inter alia, to the:

- place where the goods are located or the planned destination,
- identification of the dispatch or packages,
- date of arrival or planned deposit of the goods,
- means of transport used,
- identification of the importer, exporter or person in possession of the goods.

The request shall also contain the undertaking of the requestor to assume responsibility in relation to the importer, if it is formally proved that the goods held by the customs authorities do not constitute an infringement of the protected industrial design.

33. The customs authorities to which a request, established in accordance with Article 32 of this Law, has been referred, shall examine the request and immediately inform the requestor in writing of the decision taken. Appropriate reasons shall be given for this decision.

The customs authorities may require from the requestor, where his request has been accepted or where intervention measures have been taken pursuant to Article 34 of this Law, the payment of a security intended to cover the costs incurred as a result of the goods being kept under customs supervision.

34. Where the customs authorities observe, in the appropriate case following consultations with the requestor, that goods correspond to those indicated in the request, they shall withhold the goods.



The customs authorities shall immediately inform the requestor and the importer that the goods have been withheld, and shall grant them the opportunity to examine the goods which have been withheld and to take samples therefrom as required for the analyses and tests for establishing whether an infringement has actually occurred, in accordance with the provisions of the Customs Code and without harming the principle of confidentiality of information.

For the purposes of an order made by the president of the court and of initiating court proceedings, the customs authorities shall inform the requestor of the first names, surnames and addresses of the exporter, importer and recipient of the goods, if they are known to the authorities, and also of the goods which are the subject of the request.

35. Provided that all the customs procedures have been completed, the measure to withhold the goods shall be lifted ipso jure, failing which the requestor shall, within a period of ten working days starting from the notification of the withholding of the goods, provide the customs authorities with proof that he has lodged a civil or criminal appeal and that precautionary measures have been decided by the competent court and that he has paid a sufficiently large security to cover his liability toward the persons concerned.

The amount of the security shall be fixed by the court.

In appropriate cases, this period may be extended by a maximum of ten working days.

The owner, importer or recipient of the goods shall be entitled to obtain the lifting of the withholding of the goods in question, in return for the payment of a security, the amount of which shall be fixed by the court and which shall be sufficient to protect the requestor's interests, provided that all the customs procedures have been completed.

The owner, importer, recipient and requestor shall be informed immediately by the customs authorities of the lifting of the withholding of the goods.

36. If, pursuant to a ruling having acquired the force of *res judicata*, it transpires that the goods are counterfeit, the court shall decide on the action to be taken in relation to the goods:

- Either the goods shall be destroyed under supervision by the customs authorities;
- Or the goods shall be taken out of commercial circulation, provided that the rights of the owner of the industrial design are not infringed.

37. The customs authorities may, at their own initiative, suspend the customs clearance of the goods containing a counterfeit industrial design.

In this case:

- The customs authorities shall immediately inform the owner of an industrial design or his beneficiaries who shall submit a request in accordance with Article 31 of this

Law, within a period of three days from the date of notification given to him by the customs authorities and the provisions of this chapter shall apply ipso jure.

— The measure to withhold the goods, taken in accordance with the provisions of this article, shall be lifted ipso jure, if the owner of an industrial design, or his beneficiaries, does not submit the request in accordance with Article 31 of this Law, within three days of the notification given to him by the customs authorities.

38. The liability of the customs authorities may not be incurred, if they do not succeed in recognizing the goods presumed to be counterfeit.

39. The provisions of this chapter shall not apply to goods of a non-commercial nature contained in travelers' personal luggage, within the limits of the amounts set by the laws and regulations in force.

40. The procedures for applying the provisions of this chapter shall be established by order of the Minister of Finance.

## **Chapter VI : Miscellaneous**

41. All contrary provisions, in particular the Decree of February 25, 1911 on the Protection of Industrial Designs and the texts which have amended or completed it, shall be repealed once this Law has entered into force.

42. Notwithstanding the repeal of the Decree of February 25, 1911 on the Protection of Industrial Designs, the industrial designs protected subject to the provisions of this Decree and the texts which have amended or completed it, shall remain valid and shall be considered to have been deposited pursuant to this Law.

This Law shall be published in the Official Gazette of the Republic of Tunisia and enforced as State law.

***Source: International Bureau of WIPO***