

Madagascar from 1989 to Date: Commendable Sustained Efforts in Industrial Property Field

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Madagascar is a beautiful island located in the Indian Ocean, famous for its welcoming people and its marvellous scenery. It has a population of around 20 millions essentially composed by young people. The country is governed by laws of a Democratic Republic.

In the 60's, when the country regained independence, the government decided to rejoin French Speaking African countries having the same status as Madagascar to create together the African and Malagasy Industrial Property Office/OAMPI.

Within this period, Madagascar has also adhered to international basic Intellectual Property regulations which are the Paris Convention for the Protection of Industrial Property in 1963 and the Berne Convention for the Protection of Literary and Artistic Works in 1966.

Few years later, in 1974, Madagascar chose to quit the OAMPI with the aim of founding its own Industrial Property (IP) Office. In the end of 90's, the Malagasy government could finalize first the enforcement of Industrial Property legislation in the country.

The Malagasy Industrial Property Office/OMAPI became functional only in 1994 and was in charge of implementing the IP texts which are the Ordinance n°89-019 dated on July 31, 1989 establishing Arrangement for the Protection of Industrial Property rights in Madagascar and its Decree n°92-993 dated on December 2, 1992 as amended by Decree n°95-057 dated on January 17, 1995.

In addition to the above legal texts which constitute the current Malagasy IP law, there are some WIPO-Administrated Treaties and IP-related multilateral Treaties to which Madagascar recently adhered. Among these are the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks entering into force in Madagascar in 2008 and applying the 10th edition of Nice Classification of goods and services since January 2012 and the TRIPS Agreement effective since 2006.

It is not denied that Malagasy IP law is seriously obsolete and a major revision must be undertaken. Since 2006, the National Office began drafting works of an updated new law fulfilling all loopholes of the law in force.

For now, the organization of IP protection in Madagascar is quite satisfactory compared with other foreign countries legislations.

The law provides that trademark protection is obtained by registration.

It deems as registrable trademark all distinctive and graphically representable signs, such as words, names, arbitrary or fancy denominations, the characteristic form of a product or its packaging,

labels, envelopes, emblems, prints, stamps, seals, colours, designs, reliefs, letters, devices, colours, slogans, pseudonyms and any materialised signs that are sufficiently distinctive for the use for which they are intended. In addition, the types of registrable mark are trade marks, service marks and collective marks.

The law allows multiple classes application. The registration procedure includes a formal and a substantial examination which consists of a distinctiveness examination, a compliance with public order, morals and ethics, and an absence of interest conflicts with prior registered or pending trademarks.

The approximate time frame for completing the registration procedure of a trademark at OMAPI is ten months from the filing application date. Notification of grant is published in the Official Gazette of Industrial Property/GOPI.

A trademark registration in Madagascar is valid for ten years from the filing application date. The registration is renewable for like periods. A late renewal is allowed within a grace period of six months subject to the payment of a penalty fee.

Within the protection period, the owner of a registered trademark must comply with use requirements. Indeed, trademark registration shall lapse if the trademark has not been used within three years from the date of registration.

The Malagasy IP law provides the possibility to apply for an international registration before the Malagasy Office. Any local native or resident of a member state of the Union of Madrid, or any industrial or commercial concern has to comply with residence condition.

In any case, foreign applicants need a domestic trademark registration. For the purpose, they must appoint a local IP representative or counsel duly authorized by OMAPI in order to file application in their name and on their behalf. A notarized power of attorney is required for such appointment.

Considering the constant evolution of the IP field in the world and the age of the Malagasy IP law, applicants and all practitioners in Madagascar have to face loopholes, generally remediable, related to the implementation of the law. A brief outline can be drafted in the following paragraphs.

At current time, scents, sounds, jingles and sole colour represented without any graphical layout cannot be considered as registrable as a trademark.

Besides, although Madagascar is a member of the Paris Convention and a member of TRIPS Agreement, Malagasy IP law does not provide any reference to well known or notorious trademarks. Maintaining the principle of territoriality, Madagascar does not grant practically protection to well known trademarks. Two interesting cases illustrate this trend. The first case, "CONFORAMA France vs CONFORAMA Madagascar" – *Judgment of Antananarivo Court of Appeal n°21, dated on May 28, 1998 – Revue de Droit et de Jurisprudence de Madagascar n°1, page 98*, confirms the Courts position on the basic principle that only a filing application or a registration can generate some rights on a trademark to the applicant's benefit in Madagascar. The other case relates to the registration of the trademark CATERPILLAR considered as "well known" in vehicles building sector, granted by OMAPI to a local firm under all classes of goods and services – *GOPI n°43, page 25*.

In other respects, the Malagasy IP law does not consider explicitly the use of a trademark as it does not provide either that public recognition would involve rights towards the user except in the case of insincerity evidence.

Another crucial difficulty related to registration procedure in Madagascar is the absence of opposition procedure before the National Office. This lack relates to opposition against a national trademark application just as well as opposition against designation of international trademark registration. At current time, proceeding with a preliminary search before filing remains the sole solution to prevent from introducing a legal action before Courts in case of a refusal of protection by OMAPI.

Finally, another major loophole of Malagasy IP law consists of the limitation of the National Office's powers. OMAPI acts as a receiving office and its powers are restricted by law notably to the receipt of filing applications, the implementation of Industrial Property law provisions and the promotion of Industrial Property matter in Madagascar. As consequence, applicants and trademark owners have no possibility on due time, to rely on the Office's help when third parties undermine their rights. The Office is not legally allowed to alert the owner in case it is discovered a counterfeit of a trademark, as it is not allowed to give a hand in identifying counterfeited products, to track infringers or at least, to bring a civil suit for damages simultaneously with the trademark's owner.

In spite of those difficulties, there are some efforts highly commendable provided by all local practitioners in promoting the IP domain in Madagascar.

On one hand, it may be noted the IP representatives and counsels dynamism, gathered for the most experienced, in the Association of IP Representatives/ARPI and that Cabinet Hanna Keyserlingk is a member since its creation. This association works deeply linked with OMAPI in order to obtain the latest news relative to IP field, to have work sessions with it when the need arises, to submit suggestions or to denounce irregularities.

On the other hand, since many years, OMAPI undertook sustained progress such as the weekly IP information programme on radio, regular information campaigns through all the territory, work sessions organization convening international experts in IP field and IP representatives and the regular trainings of OMAPI's agents abroad.

In addition, it has been put into place a regime of trademark protection against infringement acts. Indeed, since 2000, the Customs, through its Service of Fight against Customs Fraud ("Service de la Lutte contre la fraude douanière"), actively contributes to this aim, on the basis of the Financial Act of 2000 which added to the Customs Code, some provisions related to counterfeit and piracy. These improvements relate, among others, to measures taken towards importers of goods who are not able to justify property or license agreement on imported goods and to prohibition of importation of counterfeited goods for personal use, even in small quantities.

Apart from that, a service has been especially created and is linked to the Investigations and Customs Supervision Department ("Direction des Enquêtes et de la Surveillance douanière") with particular tasks in the assistance of infringed rights victims and in advice providing.

Finally, a National Comity relative to Counterfeit Fight is in preparation and gathers several administrative representatives and private entities notably the Customs, OMAPI, OMDA (Copyright National Office), the Justice Ministry (Public Prosecutor), the National Police Force, the Trade Ministry, the Malagasy Medicine Agency, the Malagasy Standards Office, the economic operators... This Comity may be in charge of drafting the policy relative to counterfeit fight, informing and exchanging information between the traders and the consumers at a local, regional and international level, reviewing and harmonizing regulations related to counterfeit and piracy and conjunction of measures taken by all entities.

As a conclusion, taken into account the exceptional location of the country at the crossroads between Asian and African countries, Madagascar remains strategically interesting for international traders. In accordance with a global attractive investment policy initialized several years ago, many improvements have been undertaken in IP field since 1989 and are in the process of being completed. Everyone keeps faith in seeing an increasing trend towards proposed and adopted measures aiming the IP promotion and undeniably, IP domain in Madagascar may get promising future.

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Small biography of the Associate Partner:

Hanna KEYSERLINGK, a dual citizen of France and Germany, was the founder in 1985 of the first corporate and fiscal service law firm in Madagascar, named "CABINET HANNA KEYSERLINGK". She has 20 years of experience representing international clients in corporate and taxation matters, privatization issues, real estate and other business transactions. She is one of the first IP representatives duly authorized by OMAPI and figured among the most experienced IP representatives in the association "ARPI". In 2000, she founded "HK-FIDAFRICA", a legal services firm associated with the legal arm of PricewaterhouseCoopers in Africa. In October 2006, Hanna KEYSERLINGK opened her current office "HK-JURIFISC". The firm has ten associates and nine administratives. It remains one of the most famous law firms in Madagascar.