

BACKGROUND READING MATERIAL  
ON THE  
INTELLECTUAL PROPERTY SYSTEM  
OF  
SRI LANKA



WORLD INTELLECTUAL PROPERTY ORGANIZATION

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION  
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## PREFACE

The World Intellectual Property Organization (WIPO) is a specialized agency within the United Nations system of organizations. It is responsible for the promotion and protection of intellectual property throughout the world.

WIPO is cooperating with the developing countries of Asia and the Pacific in a comprehensive program of activities to facilitate the establishment and strengthening of intellectual property systems in the region. One of the components of this development cooperation program is the preparation and publication of guides, manuals and other training and information aids in the field of intellectual property.

In 1988 WIPO issued, under a development cooperation project funded by the United Nations Development Programme (UNDP) for countries of Asia and the Pacific, a publication entitled "Background Reading Material on Intellectual Property." The publication consisted of a collection of reading materials on various aspects of intellectual property law, administration and practice and was prepared as a reference work for university students, government officials, lawyers and businessmen.

To complement that basic reference work, WIPO has commissioned a number of leading intellectual property scholars in the Asian and Pacific region, each to write a commentary on the intellectual property laws of his country as a "national supplement" to the "Background Reading Material on Intellectual Property."

The author of the present book, entitled *Background Reading Material on the Intellectual Property System of Sri Lanka* is Professor G.L.Peiris, Vice Chancellor of the University of Colombo, who is an eminent author of a number of important writings on the substance and on the teaching of Sri Lankan intellectual property law.

While primarily intended for law students, this book may also be of use as a reference work to government officials, attorneys, and businessmen concerned with Sri Lankan intellectual property law or its administration.

Following a prefatory survey of the Sri Lankan intellectual property system, the topics addressed in this book are: patents; patent Information and documentation; trademarks; industrial designs; copyright; administration of intellectual property; and intellectual property litigation. Reproduced as annexes are selected judicial decisions on intellectual property issues of the courts of Sri Lanka, and the Code of Intellectual Property Act of 1979.

WIPO wishes to record its deep appreciation to Professor Peiris for his contribution which should significantly increase understanding of the working of the Sri Lankan intellectual property system.

The publication of this book has been financed by funds made available to WIPO by the United Nations Development Programme, for which WIPO is grateful, especially to UNDP's Regional Bureau for Asia and the Pacific.

A handwritten signature in black ink, appearing to read 'Arpad Bogsch', with a stylized, flowing script.

Arpad Bogsch  
Director General

World Intellectual Property Organization

Geneva, November 1990

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## CHAPTER 1

# THE SYSTEM OF INTELLECTUAL PROPERTY

### \_SYNOPSIS



- 1.1 The Concept of Intellectual Property
- 1.2 Industrial Property
- 1.3 Copyright
- 1.4 Patents and Related Concepts
- 1.5 Industrial Designs
- 1.6 Trade Marks, Trade Names and Appellations of Origin
- 1.7 Unfair Competition



## 1.1 The Concept of Intellectual Property

Intellectual property is basically a form of property. The essential characteristic of property is that it is an economic asset: in other words, it has monetary value. In primitive systems of law the notion of property was invariably associated with tangible or corporeal objects. These were physical assets which could be touched and handled. Examples would be beasts of burden, agricultural implements, a house, a vehicle and so forth.

However, as society became more sophisticated and its requirements assumed a complex character, the legal connotation of property underwent change so as to accommodate a significant expansion of the ambit of property. Many interests which had an economic dimension began to be embraced within the concept of property. Instances of this extended connotation of property are provided by qualified proprietary interests such as lease, usufruct and mortgage. In the Roman-Dutch system of jurisprudence, these are referred to as *jura in re aliena*. The legal conception of such limited interests is that they detract from *plenum dominum* or *plena proprietas*. Ownership as a jurisprudential concept connotes a bundle of rights. In situations involving servitudes there is necessarily a division of these elements as between the dominant tenement and the servient tenement. A usufruct or a life interest operates as a fetter on the rights available to the person enjoying entitlement to residual ownership. The life interest is not itself a tangible form of property but signifies instead a particular nexus or relationship between a person and an economic interest to which he is entitled. In a developed legal system, such an interest, although not qualifying for inclusion in the category of *res corporales*, is nevertheless legitimately classifiable as an item of property.

Intellectual property represents a further extension of this process of development of the concept of property. Intellectual property has a special relationship with the mind, the intellect and the creative faculty. It pertains to the fruits of intellectual enterprise and endeavour. The underlying notion is that a person is entitled to the benefits derived from works of a technological, artistic or cultural character which are brought into existence by virtue of the exercise of initiative and industry. A novel, a painting, a play or a piece of sculpture is a product of the imagination and creativity of the person who brings the work into existence.

A sophisticated legal regime recognizes the need to protect in a substantial way the relationship between such a person and the work which he produces. The motivating force of the legal system which provides the impetus for the recognition of intellectual property lends itself to cogent justification in terms of policy. Society is enriched by the creative endeavours of its individual members. The sum total of this creativity cannot but enhance the quality of life in the community as a whole. However, a person will have the incentive to produce work of this kind only if his right to exploit to his own advantage the fruits of his labours is

entrenched and preserved by the law. If a novel written by A can with impunity be published by B, so as to obtain without the consent of A royalties accruing from the publication of the work, it is apparent that A would no longer have any incentive to utilize his ingenuity or creative potential to enrich society by the creation of original work. The desire for security in respect of one's possessions is one of the *primaevae* instincts in men. Indeed, John Locke in his exposition of his theory pertaining to the Social Contract, expresses the view that the aspiration to secure sanctity with regard to one's belongings was one of the fundamental reasons why the members of society were prepared to acquiesce in the loss of part of their freedom and to transfer the authority so repudiated to the organized State. This commitment to the integrity and inviolability of possessions transcends the distinction between corporeal and incorporeal property, between physical and intellectual property. In each case the individual looks to the legal system to confer upon him the security which he yearns for in respect of his possessions. The upholding of this security under the aegis of the legal system is a socially desirable objective in so far as it is conducive to the augmenting of productivity in the community. These are the ideological mainsprings from which the legal protection of intellectual property or indeed any form of property is seen to stem.

The concept of intellectual property contains a variety of facets. Chief among these are a moral attribute and an economic dimension. The moral attribute relates to certain inalienable rights which the creator of a work is permitted to assert in relation to his work. The aspect of intellectual property rights has to be disentangled from the economic content of intellectual property. Thus, even after an author has transferred to another the right to exploit his work commercially, the author may yet retain a certain residue of rights in respect of his work which are not eroded by the transfer of the economic rights. Thus, the author may require that due acknowledgement of his authorship should invariably be made. Even where the work is not utilized for any purpose connected with the acquisition of profit, the moral rights are capable of being asserted. While this dichotomy of the concept of intellectual property rights is theoretically supportable, it is nevertheless plain that the pragmatically crucial aspect of intellectual property rights involves the economic component. Intellectual property, like any other form of property, is capable of being applied towards the generation of profit, and it is this potential which accounts principally for the involvement of the legal regime in the safeguarding of intellectual property rights.

The protection made available by intellectual property law takes several forms. The major forms of protection envisaged are:

- (i) absolute monopoly;
- (ii) qualified monopoly;
- (iii) unfair competition;

These concepts may be briefly differentiated.

- (i) An absolute monopoly confers protection in a total form, in that the work is not amenable to exploitation in any way whatever. The method whereby it is sought to be used, and in particular the question whether such method owes anything or not to the initiative of the party claiming the monopoly, is altogether irrelevant. What matters in this category is the end result. The use of the work by any other person in any other circumstance is ruled out *in toto*.
- (ii) A qualified monopoly is a concept which is entirely distinguishable quantitatively. In this case what is precluded is resort to a particular method rather than the achievement of a particular result. The work can be reproduced and exploited by another person so long as no reliance is placed on the work of the person claiming the monopoly. By having recourse to a different *modus operandi* and the same result can be arrived at with impunity. In such an eventuality no legitimate complaint can be made by the person seeking the monopoly.

The distinction between an absolute monopoly and a qualified monopoly can be illustrated by pointing out the difference between a patent and a photograph of the Taj Mahal. In the former case the invention enjoys absolute protection even where another person has made the invention by wholly independent research and ingenuity. He is still not permitted to derive any commercial profit from the use of the invention if the patent had previously been registered in the name of another. The position is entirely different with regard to the photograph of the Taj Mahal. In this case the object photographed is, of course, of general interest and there is no bar against anyone photographing the object. What is protected is a particular photograph made by an individual rather than the subject matter of the photograph. The subject matter certainly lends itself to exploitation in any manner which does not entail the reproduction of the particular photograph.

- (iii) Unfair competition is a nebulous concept. Its jurisprudential origins are diverse. However, so far as the legal regime in Sri Lanka is concerned, unfair competition is a concept which receives explicit statutory recognition. The Code of Intellectual Property Act of 1979 articulates in specific terms the concept of unfair competition. In the light of this legislative provision, unfair competition is not a mere aspiration or ideal but a legally entrenched doctrine which precludes a person from engaging in a particular act or course of action on pain of incurring legal liability if he fails to so desist.

The concept of unfair competition is sustained by a cogent rationale. The intellectual property law regime aims at the orderly structuring of commercial relations. Far from this objective being fostered, there is likely to be commercial anarchy if a standard of fairness in commercial competition is not recognised by the law. While this goal may be plainly identified, it is nevertheless true that the contours of the doctrine are at present in an amorphous condition and need to be worked out with greater precision on an empirical basis as the case law evolves.

While the nurturing of intellectual property as a central aspect of the legal system is catered for by a general rationale, applicable without discrimination to all forms of intellectual property, there are particular types or categories of intellectual property which receive explicit recognition in the law. The major categories warrant enumeration and brief exposition in turn. The major categories are:

- (a) Industrial Property
- (b) Copyright
- (c) Patents and Related Concepts
- (d) Industrial Designs
- (e) Trade Marks, Trade Names and Appellations of Origins
- (f) Unfair Competition

## 1.2 Industrial Property

Industrial property is an expression which embraces within its scope such things as inventions and industrial designs. It also includes trade marks, commercial names and service marks. Industrial property generally consists of signs transmitting information to consumers with regard to products and services available on the market. The Paris Convention enumerates the principal forms of industrial property. These are patents, utility models, industrial designs, trade marks, service marks, trade names, indications of source, appellations of origin and the repression of unfair competition.

## 1.3 Copyright

This is a concept which has a special application to literary works such as novels, plays, biographies, directories, etc. It is important to note, however, that what is protected by copyright is not the idea which is given expression in the work but the form of words used in articulating or discussing the idea. In other words, it is the mode of presentation in the particular form that it sought to be protected under the rubric of copyright.

The effect of copyright is that unauthorised reproduction of the work is prohibited. The author or his representative or agent has the exclusive right of reproduction of the work. The prohibition against reproduction applies to primary as well as to secondary reproduction. Primary reproduction consists of direct or immediate copying. Secondary reproduction envisages copying by an oblique method which may sometimes involve the use of a different medium. For example, a painting may be reproduced indirectly in the form of a statue or vice versa. Copying in such indirect form is precluded by the legal rules established under the copyright regime.

Originality is a prerequisite of the protection conferred by the law in the setting of copyright. It is only an original work which qualifies for protection under the copyright regime. However, originality has a particularly expansive meaning in this context. It does not require any degree of literary or artistic merit. Even a collection of facts or data which may readily be ascertained could well be protected by copyright, provided that it is presented in a particular form. Thus, a calendar, a railway timetable or a list of weights and measures may constitute subject matter appropriate for protection under the law of copyright. The sole element of originality may consist of the mode of arrangement employed. So long as this method is coherent and internally consistent, it would be amenable to protection within the framework of copyright law.

A frequent defence to a copyright action is that the established similarity between two works is not the product of deliberate reproduction but is entirely coincidental. This argument may be used in situations where the plaintiff as well as the defendant had relied upon a primary source. These are contexts in which the plaintiff cannot pursue a legal remedy against the defendant because the plaintiff, no less than the defendant, has drawn upon the work of the third party. This serves to highlight one of the essential features of a copyright action. This feature consists of conscious reproduction rather than the existence of similarity, objectively evaluated. The mere proof of similarity between the work of the plaintiff and that of the defendant, although such similarity may in appropriate circumstances generate an inference, cannot itself be availed of as the basis of an action for infringement of copyright.

#### **1.4 Patents and Related Concepts**

Patent is the primary legal mechanism whereby inventions are protected. The word patent may bear one or two meanings. The first is the document which really furnishes evidence of the right claimed. The second meaning envisages the legal protection itself.



The rationale of creativity is related to the encouragement of initiative and enterprise. Among all living beings, man alone has the potential to feel the need for protection of the fruits of his creativity. The objective of carving out an exclusive domain within which a person is assured of security in respect of what he has nurtured or created is fundamental to the conception of patent.

The legal value of patent may be explained as follows. The patent represents recognition of the owner's exclusive right to exploit the advantages of his creation. The patent document would spell out in detail the nature of the invention and the purposes for which it would be used.

There are several conditions precedent which need to be satisfied before a patent is conceded by the law. The first of these is that the invention in respect of which protection is claimed has a novel character. This is an essential part of the rationale sustaining patents. The need for protection arises because of the applicant's initiative in contributing to the sum total of human ingenuity in a pragmatically useful manner. The essence of a patent is that it seeks to protect a concept or process which had not been conceived of or applied previously in the identical form.

Apart from the requirement of novelty, the work must contain some inventive quality; it must be non-obvious in character. Moreover, the invention must have some degree of practical utility, in that it should be capable of application towards some industrial or commercial purpose. It is this pecuniary dimension of the invention which warrants the conferment of legal protection under the patent regime.

A related concept which calls for brief mention is that of utility models. This notion differs from the typical patent situation in two respects. Firstly, the degree of inventiveness postulated in respect of a utility model is significantly less than that required regarding an invention for which a patent is granted. Utility models are generally associated with mechanical devices. The second way in which a distinction is maintainable relates to time span during which the protection conferred by law subsists. In general, the period within which utility models are protected is appreciably less than the period appropriate to the protection of other forms of inventions.

### **1.5 Industrial Designs**

This is a form of intellectual property protection which is of increasing significance in modern legal systems. The concept of industrial design is closely related to the marketing process. Its essence is visual appeal. It is part of the sophisticated consumer society in which we live today that even a humdrum, everyday article will be much easier to dispose of on the market if it were

buttressed by a special appearance which enhances its attraction. An industrial design therefore serves the basic purpose of enabling identification of a particular object or category of goods offered in the market. The essential elements of an industrial design would consist of such matters as colour, shape, size and configuration.

There is an overlap between the protection of industrial designs under copyright and under industrial property legislation.

### **1.6 Trade Marks, Trade Names and Appellations of Origin**

A trade mark serves the basic purpose of enabling the public to identify the type of goods which they require. The attachment of a particular trade mark to goods was traditionally related to the origin of the goods. In current commercial usage, the function of a trade mark is secondarily linked with an assurance as to quality. The trade mark connotes by implication that the goods satisfy certain standards of quality which are demanded by the consumer. The trade mark may thus serve as a guarantee that the customer's requirements will be fulfilled.

An essential concomitant of a trade mark is its connection with goodwill. The goodwill pertaining to a particular firm or business forms part of the motivation of the customer in making his choice as to what he should purchase.

This element supplies the key to the rationale for legal protection of trade marks. It is inequitable that the goodwill of one firm should be made use of by another firm in such a way as to induce members of the public to purchase the goods of the second firm in the belief that the goods purchased are those of the first firm. If this were allowed, it would be a situation in which the second firm would reap a rich and unwarranted reward from an implied representation that the goods it was selling were those of another firm. Firm X has acquired a reputation for its goods and these are the goods which the customer was minded to purchase. The confusion engendered in the mind of the prospective purchaser results in his buying the goods of firm Y under the mistaken impression that the goods are those of firm X. It is to prevent this result that the law recognizes in firm X a right to the exclusive use of its own trade mark. This is a distinct pecuniary interest belonging to firm X which that firm is entitled to assert and defend.

A trade name is a concept distinguishable from that of a trade mark. The trade mark attaches to a particular product offered on the market, for example, Lux or Blue Brand Margarine. The trade name, by contrast, attaches to the business entity or enterprise which produces the goods. The trade name may then apply to the company which places on the market a variety of goods, each of which has a distinguishable and separate trade mark.

Brief reference must also be made to two related concepts—indication of source and appellations of origin. Indication of source refers to the place of origin. Examples would be handicrafts bearing the legend “Made in Galle, the Southern capital of Sri Lanka.” This denotes the place of origin of goods in explicit terms. Appellations of origin represent a slight variant of this theme. This is a situation in which there is a reference to the place of origin in such a manner as to indicate certain attributes which the goods would possess by virtue of their association with the region of their manufacture or production. An instance of this would be “Dimbulla Teas.” The geographical area within which the tea is produced will impart to it certain qualities relating to strength, texture, aroma, body, etc. These are characteristics which the consumer would consciously prefer (or disdain) with regard to the type of tea he buys.

### 1.7 Unfair Competition

This is a nebulous concept which is not sustained by reliable antecedents in the English Common Law, although it appears to have some degree of conceptual support in Continental legal systems. The Paris Convention of 1883 (as revised) attempts to spell out the elements of unfair competition. The definition embodied therein embraces “an act of competition contrary to honest business practices in industrial or commercial matters.” The Convention proceeds to elaborate upon this definition and isolates some specific instances of unfair competition which are enumerated as follows:

- (a) acts which create confusion with the establishment, the goods or the commercial activities of a competitor;
- (b) false allegations which discredit the establishment, the goods or the commercial activities of a competitor;
- (c) indications or allegations, liable to mislead the public as to the nature, manufacturing process, the characteristics, suitability or quality of goods.

The Roman-Dutch law is the residuary common law of Sri Lanka.

It is of interest to note that the conceptual foundations of the Roman-Dutch law are sufficiently resilient to accommodate the ingredients of liability for unfair competition. Patrimonial loss or *damnum* is catered for in classical Roman-Dutch law by the Aquilian Action. The essence of liability under the *Actio legis Aquilae* was *damnum injura datum*. This denoted pecuniary loss inflicted unlawfully, that it to say either intentionally (*dolo*) or negligently (*culpa*). It was a requirement of the classical law that such damage should be inflicted in an immediate physical sense *corpore corpore*. However, in the course of development of the law, the ambit of liability was expanded by relegation of this requirement. The extension

was effected by means of the *actio utilis* and the *actio in factum*. The principles of the Roman-Dutch law, developed in this manner, lend themselves to adaptation by analogy to cater for the types of situations envisaged by the contemporary doctrine of unfair competition.

However, the contemporary Sri Lankan statute law contains provision with regard to unfair competition on the following lines;

Any act of competition contrary to honest practices in industrial or commercial matters constitute an act of unfair competition.<sup>1</sup>

Acts of unfair competition include the following;

(a) all acts of such a nature as to create confusion by any means whatsoever with the establishment, the goods, services or the industrial or commercial activities of a competitor; (b) a false allegation in the course of trade of such a nature as to discredit the establishment, the goods, services or the industrial or commercial activities of a competitor; (c) any indication of source or appellation of origin the use of which in the course of trade is liable to mislead the public as to the nature, manufacturing process, characteristics, suitability for their purpose or the quantity of goods; (d) making direct or indirect use of a false or deceptive indication of the source of goods or services or of the identity of their producer, manufacturer or supplier; (e) making direct or indirect use of a false or deceptive appellation of origin or imitating an appellation of origin even if the true origin of the product is indicated, or using the appellation in translated form or accompanied by terms such as “kind,” “type,” “mark,” “imitation” or the like.<sup>2</sup>

Any person or association of producers, manufacturers or traders aggrieved by any of the acts referred to above are competent to institute proceedings in Court to prohibit the continuance of such acts.<sup>3</sup>

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<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s.142(1).

<sup>2</sup> *Ibid.*, s.142(2).

<sup>3</sup> *Ibid.*, s.142(3).













## CHAPTER 2

### PATENTS

#### SYNOPSIS

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2.2 Patents and Technological Development

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2.9 Defences to Infringement and Revocation

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## 2.1 Introduction

A patent is a grant by the Government of a monopoly to make, sell and use an invention for a limited period. The patentee may use the patent himself, license it to others, or sell it outright. When the patent relates to a product no one else may make, import, offer for sale, sell or use the product, without the consent of the owner of the patent. Likewise, when the patent relates to a process no one else may use the process, or make use of the product resulting from the process in any of the ways referred to previously, without the consent of the owner of the patent.<sup>1</sup>

The grant by a patent does not and cannot guarantee that the patent will be of commercial value to its proprietor. This will depend on whether the invention is sufficiently useful or has sufficient advantages over other articles or processes that are available. Also a patent granted by the Government of Sri Lanka gives protection only in Sri Lanka. In order to obtain protection in other countries, it is necessary to obtain patents in each of the countries concerned.<sup>2</sup>

The grant of patents for inventions is governed by the Code of Intellectual Property Act, No. 52 of 1979 (Part IV) and the Intellectual Property Regulations, 1980 (Part III) (*Gazette Extraordinary* No. 60/20 of 31-10-1979).

## 2.2 Patents and Technological Development

It has been found necessary, especially in the context of developing nations, to protect initiative and enterprise through such devices as patents if technological advancement is to be fostered.

The objectives of legislation currently in force in Sri Lanka in these areas are persuasively explained by the Honourable Lalith Athulathmudali, then Minister of Trade and Shipping, in the course of his speech on the occasion of the Second reading of the Code of Intellectual Property Bill presented in Parliament in May 1979.

The following extracts typify the professed objectives:

“The Bill governs trade marks, patents, designs, copyrights and the Merchandise Markets Ordinance. This is part of our programme to update all commercial law in this country. There is no point in our talking about improving our economy, having more exports and imports, if our legal structure is as ancient as the hills and does not keep up with modern development... .

“One of the things we started on was trying to reform and bring up to date all commercial law in this country. The next one—which we hope to introduce by the end of this year—is the new Companies Ordinance... .

<sup>1</sup> *Directions issued by the Registry of Patents and Trade Marks on applying for a Patent—Chapter 2.*

<sup>2</sup> *Ibid.*

“We think it is necessary, in the new economic path we have chosen, to bring them all up to date... .

“As regards patents, we are going to avail ourselves of the International Search Report. The law of industrial designs will include handicrafts, and that is one of the things that is going to come after this. This is necessary for our commercial law. But while we went through this we found something very unfortunate: 99 per cent of the patents, industrial designs and trade marks were from abroad.

“But even the one per cent of Sri Lankans who invent something, who work out some new process have great difficulties in registering it. That we have erased completely. Secondly, even after they register it they have no way of marketing it. It is there on the book. We know that a Sri Lankan invented a watchman’s clock in modern times. It is still patented, but how could he develop it? That gentleman, Mr. Rowlands, died a sad man.

“The next stage to this is the government’s proposal to bring in what is called the Inventor’s incentive Law. Whenever any Sri Lankan produces something new either design or patent, we will help him to register it. We will also help him to market it because we want to encourage such people. Sri Lankans have innovative power and imagination and it is our duty not to stand aside but to give them a hand and push them forward. I propose to bring that Bill in about six months’ time. It is already in the draft stage. It may be earlier.

“This Bill is not something that is widely understood, naturally, because it is really a specialist’s field; but it really is revolutionary in terms of this particular class of property so necessary for the commercial development of Sri Lanka.”<sup>3</sup>

The importance of the measure outlined in these remarks is reflected in the enactment by the Parliament of Sri Lanka of the Sri Lanka Inventor’s Incentive Act No. 53 of 1979. The principal purpose of this legislation was the establishment of an authority known as the Sri Lanka Inventors’ Commission.<sup>4</sup> The objectives of the Commission were identified as the following:

- (a) to encourage the making or creation of inventions by citizens of Sri Lanka;
- (b) to give technical, financial and legal assistance to inventors;
- (c) to exercise, discharge and perform all the powers, functions and duties conferred and imposed on the Commission under the Act;

<sup>3</sup> *Hansard of the Parliament of Sri Lanka.*

<sup>4</sup> Sri Lanka Inventor’s Incentive Act, No. 53 of 1979, s.2.

- (d) to do all such other acts or things as may be necessary for or conducive to, the attainment of the above objects.<sup>5</sup>

The Commission is invested with a wide gamut of powers and functions which include the following:

- (a) to give technical assistance to inventors after examination of their inventions to determine their patentability and to help them prepare patent applications, under such terms and conditions as may be specified by the Commission;
- (b) to grant financial aid to inventors to enable them to develop, perfect and produce their patented inventions or those which are pending patent, under such terms and conditions as may be specified by the Commission;
- (c) to render legal assistance to inventors by representing them in filing their patent applications in Sri Lanka and abroad and by protecting their secured patents from infringement in patent cases, under such terms and conditions as may be specified by the Commission;
- (d) to recommend to government lending institutions inventions that are beneficial to Sri Lanka so as to enable such institutions to give long-term loans to inventors to manufacture their inventions, with only their patents, as security, the amount of any such loan to be granted depending upon the importance and market of their inventions as determined by the Commission;
- (e) to help inventors find markets for their inventions in Sri Lanka and abroad;
- (f) to encourage Sri Lankan inventors to make known their inventions by giving annually sizeable cash awards and medals to be known as the "Presidential Awards for Inventions" to patented inventions in Sri Lanka in the fields of agriculture, chemistry, medicine, national defence, pharmacy, physics, public safety and welfare, public works, transportation and such other fields of science and technology. Such awards shall be open to all inventors in Sri Lanka without distinction as to nationality;
- (g) to establish and maintain a public research laboratory and experimental station where authorized inventors and researchers may avail themselves of its facilities and services for carrying out or perfecting their approved inventions and researches;

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<sup>5</sup> *Ibid.*, s.5.

- (h) to promote and encourage inventiveness and creativeness among people in Sri Lanka and to assist them in creating new inventions in those fields of science and technology specified in paragraph (f) through an annual "Creative Research Contest" with cash prizes and medals to the winners chosen by the respective judges of the "Presidential Award for Inventions;"
- (i) to publish and disseminate information about inventions, researches and science in general;
- (j) to hold regular monthly sessions for the exchange of ideas among inventors;
- (k) to help Sri Lanka inventors join international competitions for inventions and researches, or to recommend them to such competitions; and
- (l) to organize creative societies in schools, colleges and universities to promote and encourage creativeness among Sri Lankan youth.<sup>6</sup>

The laboratory facilities and services of the Ceylon Institute of Scientific and Industrial Research are placed at the disposal of inventors and researchers whose needs are recognized by the Sri Lanka Inventors' Commission.<sup>7</sup> However, there are certain conditions under which facilities or services are made available to inventors and researchers. An inventor or researcher is required, by a written agreement before making use of the facilities provided by the Commission, to contract to give the Commission not less than 1/10th of all royalties arising from such invention or research, depending upon the extent of the facilities or services to such inventor or researcher, to maintain the public research laboratory or experimental station.<sup>8</sup>

The law provides for the establishment of a fund called the Sri Lanka Inventors' Fund which is managed, controlled and operated by the Commission in accordance with directions issued by the Minister from time to time.<sup>9</sup>

The moneys paid into the Fund derive from four distinct sources;

- (a) gifts or donations of money made to the Commission by any person or by the government;
- (b) any grant received from the government;
- (c) any income from investments or any other moneys received by the Commission;

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<sup>6</sup> *Ibid.*, s.11(1).

<sup>7</sup> *Ibid.*, s.13.

<sup>8</sup> *Ibid.*, s.12.

<sup>9</sup> *Ibid.*, s.22(1).

(d) any moneys received by way of royalties.<sup>10</sup>

The Government, moreover, has the duty to grant or give on loan to the Commission out of the Consolidated Fund, for the purpose of carrying out the aims and objects of the Commission, such sums as may be voted by Parliament for the purpose.<sup>11</sup>

The Commission enjoys exemption from income tax, wealth tax or other tax payable under the Inland Revenue Act, No. 28 of 1979.<sup>12</sup>

A particularly significant fiscal incentive is made available to inventors. This consists of the exemption of inventors from taxes which are ordinarily payable. Where a patent has been granted to any citizen of Sri Lanka, in respect of any invention approved by the Commission, the income received by the holder of such patent from royalties or otherwise in respect of such patent is not liable to any income tax, wealth tax or other tax payable under the Inland Revenue Act No. 29 of 1979, for a period of five years from the date of the grant of the patent.<sup>13</sup> Furthermore, the holder of the patent is exempt from all licences or permits required to be obtained under any written law.<sup>14</sup>

However, the scope of this exemption is curtailed by two qualifications. The fiscal incentive is available only to the holders of a patent:

- (a) where the paid up capital consequent to the use of such patented invention does not exceed one million rupees; and
- (b) where the manufacture in pursuance of such patented invention is carried out by the inventor himself as a home industry.<sup>15</sup>

## 2.3 Conditions of Patentability

### 2.3.1 Introduction

Patentability attaches to an invention. An “invention” connotes an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.<sup>16</sup> An invention in this context has a wide meaning in that it may be, or may relate to, a product or process.<sup>17</sup> However, for reasons of policy there are types of inventions which notwithstanding that they fall within the purview of the extensive definition embedded in our law, are not regarded as patentable.

<sup>10</sup> *Ibid.*, s.22(2).

<sup>11</sup> *Ibid.*, s.23.

<sup>12</sup> *Ibid.*, s.24(1).

<sup>13</sup> *Ibid.*, s.25(1).

<sup>14</sup> *Ibid.*, s.25(1).

<sup>15</sup> *Ibid.*, s.25(2).

<sup>16</sup> Code of Intellectual Property Act, No. 52 of 1979, s.59(1).

<sup>17</sup> *Ibid.*, s.59(2).



Four such categories are spelt out by the Sri Lankan Code:

- (i) discoveries, scientific theories and mathematic methods;
- (ii) plant or animal varieties or essentially biological processes for the production of plants or animals, other than micro-biological processes and the products or such processes;
- (iii) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (iv) methods for the treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body.<sup>18</sup>

The exception, however, does not embrace the products used in the methods described.<sup>19</sup>

The primary conditions of patentability are:

- (i) the novelty of the invention;
- (ii) an inventive step involved in the invention; and
- (iii) an industrial applicability of the invention.

Each of the attributes may be explained in turn.

### 2.3.2 *Novelty*

The basic definition of novelty in this context is the lack of anticipation by prior art.<sup>20</sup>

Prior art, in turn, consists of:

- (i) everything disclosed to the public, anywhere in the world, by a written publication, in Sri Lanka, by oral disclosure, by use or in any other way prior to filing or, where appropriate, priority date of the patent applications claiming the invention;
- (ii) the contents of a domestic patent application having an earlier filing or, where appropriate, priority date than the patent application referred to at (i) *supra*, to the extent that such contents are included in the patent granted on the basis of the domestic patent application.<sup>21</sup>

### 2.3.3 *Disclosure and Novelty*

A disclosure made under paragraph (i) of the preceding provision is required in Sri Lanka to be disregarded in two contingencies:

<sup>18</sup> *Ibid.*, s.59(3).

<sup>19</sup> *Ibid.*, s.59(3).

<sup>20</sup> *Ibid.*, s.61(1).

<sup>21</sup> *Ibid.*, s.61(2).

- (a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason of or in consequence of acts committed by the applicant or his predecessor in title;
- (b) if such disclosure occurred within six months preceding the date of the patent application and if such disclosure was by reason of or in consequence of any abuse of the rights of the applicant or his predecessor in title.<sup>22</sup>

#### 2.3.4 *Inventive Step*

This, too, is an essential requirement of patentability. An invention is considered as involving an inventive step if, having regard to the prior art relevant to the patent application claiming the invention, such inventive step would not have been obvious to a person having ordinary skill in the art.<sup>23</sup>

#### 2.3.5 *Industrial Applicability*

This is an amorphous concept. An invention is regarded as industrially applicable if it is capable of being made or used in any kind of industry. The expression “industrial application” is given a wide meaning for purposes of this Code and in the present case includes agricultural application.<sup>24</sup>

### 2.4 **Procedure for the Grant of Patents**

Once an application for a patent is made to the Registrar, the Registrar is required to record as the filing date the date of the receipt of the application.<sup>25</sup> This must be done, provided that the application contains:

- (a) the name and address of the applicant;
- (b) the name and address of the inventor and, where the applicant is not the inventor, the statement referred to in section 68(2)(b);
- (c) a description;
- (d) a claim or claims.<sup>26</sup>

It is a mandatory requirement that at the time of receipt of the application, the prescribed fee is to be paid.<sup>27</sup> The prescribed fee at present is Rs. 1,000/-.<sup>28</sup>

<sup>22</sup> *Ibid.*, s.61(3).

<sup>23</sup> *Ibid.*, d s.62.

<sup>24</sup> *Directions issued by the Registry of Patents and Trade Marks on applying for a Patent—* paragraph 4.

<sup>25</sup> Code of Intellectual Property Act, No. 52 of 1979, s.74(1).

<sup>26</sup> *Ibid.*, s.74(1).

<sup>27</sup> *Ibid.*, proviso to s.74(1).

<sup>28</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979—Seventh Schedule.

Where the Registrar finds that at the time of the receipt of the application, the provisions, relating to the contents of the application are not fulfilled, he must request the applicant to file the required correction.<sup>29</sup> Where the applicant complies with this request, the Registrar is required to record as the filing date the date of receipt of the required correction; where the applicant does not so comply, the Registrar must treat the application as null and void.<sup>30</sup> Where the application refers to drawings which in fact are not included in the application, the Registrar is required to request the applicant to furnish the missing drawings.<sup>31</sup> Where the applicant complies with this request, the Registrar must record as the filing date of receipt of the missing drawings; where the applicant does not so comply, the Registrar is required to record as the filing date the date of receipt of the application and must make no reference to the said drawings.<sup>32</sup>

The date of receipt of the application must be recorded as the filing date of such application.<sup>33</sup> If the Registrar finds that, at the time of receipt of the application, the requirements referred to in section 74(1) of the Code were not complied with, he must invite the applicant to file the required correction within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate.<sup>34</sup> If the applicant complies with this invitation, the Registrar must record as the filing date, the date of receipt of the required correction.<sup>35</sup> Where the application refers to drawings, which in fact are not included in the application, the Registrar is required to invite the applicant to furnish the missing drawings within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate. If the applicant complies with this invitation, the Registrar must record as the filing date of the application, the date of the receipt of the missing drawings. Otherwise, the Registrar must record as the filing date of the application the date of the receipt of the application and treat any reference to the drawings as non-existent.<sup>36</sup>

When the required particulars are available in their entirety to the Registrar, the process of examination commences. The Registrar is required to examine the application and satisfy himself that the following conditions are satisfied:

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<sup>29</sup> Code of Intellectual Property Act, No. 52 of 1979, s.74(2).

<sup>30</sup> *Ibid.*, s.74(3).

<sup>31</sup> *Ibid.*, s.74(4).

<sup>32</sup> *Ibid.*, s.74(5).

<sup>33</sup> *Gazette Extraordinary*, *supra* Reg. 52(1).

<sup>34</sup> *Ibid.*, Reg. 52(2).

<sup>35</sup> *Ibid.*, Reg. 52(3).

<sup>36</sup> *Ibid.*, Reg. 52(4).

- (a) where the applicant's ordinary residence or principal place of business is outside Sri Lanka, he is represented by an agent resident in Sri Lanka whose name and address are given in the application, and the application is accompanied by a power-of-attorney granted to such agent by the applicant;
- (b) the request contains a petition that the patent be granted, the title of the inventions and the name, address and description and any other prescribed information concerning the applicant, the inventor and the agent, if any;
- (c) where the applicant is not the inventor, the request is required to be accompanied by a statement justifying the applicant's right to the patent;
- (d) the description, the claims and, where applicable, the drawing comply with the prescribed requirements;
- (e) the application contains an abstract;
- (f) a proper search report has been submitted.<sup>37</sup>

Where the Registrar finds that these conditions are not fulfilled, he must request the applicant to file the required correction; where the applicant does not so comply, the application must be rejected.<sup>38</sup> Where no abstract is provided in response to a request, the Registrar is required on payment of the prescribed fee within the prescribed period—a period of three months from the date of the request made by the Registrar<sup>39</sup>—to prepare the abstract. Where the prescribed fee is not paid within the prescribed period the application must be rejected.<sup>40</sup>

The Registrar must notify the applicant of his decision and any decision rejecting the application must be in writing and state the reasons for such rejection.<sup>41</sup>

The grant of a patent is not refused and a patent is not invalidated on the ground that the performance of any act in respect of the claimed invention is prohibited by any law or regulation, except where the performance of that act would be contrary to public order.<sup>42</sup> Where the Registrar is satisfied that the application complies with mandatory legal requirements<sup>43</sup> he must grant the

<sup>37</sup> Code of Intellectual Property Act, No. 52 of 1979, s.75(1).

<sup>38</sup> *Ibid.*, s.75(2).

<sup>39</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 55.

<sup>40</sup> Code of Intellectual Property Act, *supra* s.75(3).

<sup>41</sup> *Ibid.*, s.75(4).

<sup>42</sup> *Ibid.*, s.76(1).

<sup>43</sup> *Ibid.*, s.75(1) see text at n.37 *supra*.

patent, and must forthwith issue to the applicant a certificate of the grant of the patent and a copy of the patent together with a copy of the search report and he must record the patent in the register.<sup>44</sup> As soon as possible thereafter, the Registrar is required to cause to be published in the *Gazette* a reference to the grant of the patent and make available to the public, on payment of the prescribed fee, copies of the patent together with copies of the search report.<sup>45</sup> The patent is deemed to be granted on the date that the Registrar performs these acts.<sup>46</sup>

## 2.5 The Patent Application

### 2.5.1 Introduction

Any person may make an application for a patent, but a patent may only be granted to the inventor himself, to someone who has acquired rights in the invention, e.g. by buying the invention, or to some other person who is entitled by law to be granted the patent (such as, for example, an employer when the invention has been made by an employee in the course of his employment). The application may be made by two or more applicants acting together.<sup>47</sup>

Although any person may make an application for a patent, an applicant who is not the inventor will be required to file a statement indicating how he has derived the right to the invention, and should he fail to do so, the application will be treated as withdrawn. The Registrar will send a copy of the statement to the inventor.<sup>48</sup>

In order to make an application, an applicant should first obtain a copy of FORM P1 from the Registry and complete each section of the form giving the information required. The applicant must also prepare a specification which must be filed in duplicate when making the application. In addition, the applicant must prepare an abstract or request the Registrar to prepare an abstract on payment of the prescribed fee (Rs. 100/-).<sup>49</sup>

The application form (FORM P1), specification (in duplicate), and prescribed filing fee (Rs. 1,000/-) must be filed at the Registry on making the application.<sup>50</sup>

An essential component of the application is a specification contemplated by the law. The specification must contain a full description of the invention, one or

<sup>44</sup> Code of Intellectual Property Act, *supra* s.76(2).

<sup>45</sup> *Ibid.*, s.76(3).

<sup>46</sup> *Ibid.*, s.76(4).

<sup>47</sup> *Directions issued by the Registry of Patents and Trade Marks on applying for a Patent*—paragraph 3.

<sup>48</sup> *Ibid.*, paragraph 3.

<sup>49</sup> *Ibid.*, paragraph 5.

<sup>50</sup> *Ibid.*, paragraph 5.

more claims defining the scope of the monopoly that the applicant seeks to protect and one or more drawings where they are necessary to enable the invention to be readily understood.<sup>51</sup>

In general, the description should contain the following details in the order specified;

- (i) the title of the invention as appearing in Form P1;
- (ii) the technical field to which the invention relates;
- (iii) the background art, so far as it is known to the applicant and so far as it can be considered useful for an understanding of the invention;
- (iv) a description of the invention in terms that can be understood; and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art;
- (v) a statement of the advantageous effects, if any, of the invention with reference to the background art;
- (vi) a brief description of the figures of the drawings, if any;
- (vii) the best method known to the applicant for carrying out the invention (this is best done by describing examples of the invention with reference to the drawings, if any); and
- (viii) an explicit indication, when it is not obvious from the description of the invention, of the way in which the invention is industrially applicable and the way in which it can be made and/or used.<sup>52</sup>

It is not usually necessary to give detailed dimensions in the description, although there may be instances where the dimensions are necessary to an understanding of the invention.<sup>53</sup>

The function of the claims is to define with precision the scope of the monopoly which the applicant wishes his patent to protect; regarded somewhat differently, a claim may be thought of as a concise statement of what the applicant regards as the invention. It is helpful, when attempting to draft claims, to think of what you would consider to be an infringement of your invention and then try to put into words a statement expressing this in the most general way possible. You may wish to have more than one claim, e.g. to take up a reserve position in case the invention specified by you first claim is found not to be new or inventive. You should be careful to ensure that all your claims may be regarded as embraced by a

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<sup>51</sup> *Ibid.*, paragraph 6.

<sup>52</sup> *Ibid.*, paragraph 6.

<sup>53</sup> *Ibid.*, paragraph 6.

single concept; the best way to make sure of this is to make all subsequent claims appendant to the first.<sup>54</sup>

All the claims should be numbered and each should be supported by the description, i.e. every feature of each claim should be mentioned in the description. Claims should not be made for the efficiency, advantages or economic benefits of the invention.<sup>55</sup>

### 2.5.2 *Contents of a Patent Application*

An application for the grant of a patent must be made to the Registrar in the prescribed form and is required to contain:

- (i) a request for the grant of the patent;
- (ii) a description;
- (iii) a claim or claims;
- (iv) a drawing or drawings, where required;
- (v) an abstract.<sup>56</sup>

Where the applicant's ordinary residence or principal place of business is outside Sri Lanka, he must be represented by an agent resident in Sri Lanka whose name and address is given in the application, and the application must be accompanied by a power of attorney granted to such agent by the applicant.<sup>57</sup>

The proviso is added that legalization or certification of the applicant's signature is not necessary.<sup>58</sup>

The application may be accompanied by a declaration signed by the inventor, giving his name and address and requesting that he be named as such in the patent.<sup>59</sup>

The request must contain (i) a petition that the patent be granted, (ii) the title of the invention, (iii) the name, address, description and any other prescribed information concerning the applicant, the inventor and the agent, if any. Where the applicant is not the inventor, the request must be accompanied by a statement justifying the applicant's right to the patent. The Registrar is obliged to send a copy of the statement to the inventor who has the right to inspect the application and to receive, on payment of the prescribed fee, a copy thereof.<sup>60</sup>

The description must disclose the invention in a manner sufficiently clear and complete for the invention to be evaluated, and to be carried out by a person

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<sup>54</sup> *Ibid.*, paragraph 6.

<sup>55</sup> *Ibid.*, paragraph 6.

<sup>56</sup> Code of Intellectual Property Act, No. 52 of 1979, s.68(1)(a).

<sup>57</sup> *Ibid.*, s.68(1)(b).

<sup>58</sup> *Ibid.*, proviso to s.68(1)(b).

<sup>59</sup> *Ibid.*, s.68(1)(c).

<sup>60</sup> *Ibid.*, s.68(2).

having ordinary skill in the art, and must, in particular, indicate the best mode known to the applicant for carrying out the invention.<sup>61</sup>

The claim or claims must be clear, concise and supported by the description.<sup>62</sup>

Drawings are required when they are necessary for the understanding of the invention.<sup>63</sup>

The terms of the claim or claims determine the scope and extent of the protection afforded by the patent, and the description and drawings may be used to interpret the claim or claims.<sup>64</sup>

The abstract serves the purpose of technical confirmation and must not be used for the purpose of determining or interpreting the scope and extent of the protection afforded by the patent.<sup>65</sup>

An application for the grant of a patent in terms of the Code of Intellectual Property Act is to be made on Form P1 set out in the Sixth Schedule attached to the Regulations, and must be signed by the applicant or his authorized agent.<sup>66</sup>

Where the inventor or the person having title to the invention is dead, the legal representative of such inventor or such person having title to the invention may apply for and obtain the patent.<sup>67</sup> Where the applicant dies during the time intervening between the filing of his application and the granting of a patent thereon, the patent may be granted to the legal representative upon proper intervention by him.<sup>68</sup>

Where the inventor or the person having title to the invention is insane or otherwise legally incapacitated, the legal representative of such inventor or person may apply for and obtain the patent.<sup>69</sup> In these cases, proof of the power or authority of the legal representative must be filed with the Registrar. The Registrar may, before the grant of the patent, call for such further evidence as he may require.<sup>70</sup> Where an invention has been assigned, the assignee is required to make an application for the grant of a patent, and the application must be accompanied by a statement specifying the basis of the applicant's right to the patent.<sup>71</sup> Where two or more persons have jointly made an invention the application for the grant

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<sup>61</sup> *Ibid.*, s.68(3).

<sup>62</sup> *Ibid.*, s.68(4).

<sup>63</sup> *Ibid.*, s.68(5).

<sup>64</sup> *Ibid.*, s.68(6).

<sup>65</sup> *Ibid.*, s.68(7).

<sup>66</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 36.

<sup>67</sup> *Ibid.*, Reg. 37(a).

<sup>68</sup> *Ibid.*, Reg. 37(b).

<sup>69</sup> *Ibid.*, Reg. 37(c).

<sup>70</sup> *Ibid.*, Reg. 37(d).

<sup>71</sup> *Ibid.*, Reg. 38.



of a patent must, subject to regulation 37,<sup>72</sup> be made by them jointly. Form P1, *mutatis mutandis*, is used for making such application.<sup>73</sup> The inventor may address the declaration to the Registrar at any time before the grant of the patent.<sup>74</sup>

Detailed provision is made in regard to claims. The number of the claims must be reasonable in consideration of the nature of the invention.<sup>75</sup> If there are several claims, they are to be numbered consecutively in arabic numerals.<sup>76</sup> Any claim submitted after the filing date of the application and which is not identified with the claims previously appearing in the application must, at the choice of the applicant, be submitted either as an amended claim, in which case it must bear the same number as the previous claim it amends, or as a new claim, in which case it must bear the next number after the highest previously numbered claim.<sup>77</sup>

The deletion of any claim previously appearing in the application must be made by indicating the number of the previous claim followed by the word “cancelled.”<sup>78</sup>

Where the application contains drawings, the technical features mentioned in the claims must preferably be followed by the reference signs relating to such features. When used, the reference signs must preferably be placed between parentheses. If inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made.<sup>79</sup>

The definition of the invention must be in terms of the technical features of the invention. Whenever appropriate, claims must contain (i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art; (ii) a characterizing portion—preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect—stating concisely the technical features which, in combination, with the features stated under (i), it is desired to protect.<sup>80</sup>

Any claim which includes all the features of one or more other claims (“dependent claim”) must do so by a reference, if possible at the beginning, to the other claim or claims and must then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) must refer to such claims in the alternative only. Multiple dependent

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<sup>72</sup> See text at notes 69 and 70 *supra*.

<sup>73</sup> *Gazette Extraordinary*, *supra* Reg. 39.

<sup>74</sup> *Ibid.*, Reg. 40.

<sup>75</sup> *Ibid.*, Reg. 42(1).

<sup>76</sup> *Ibid.*, Reg. 42(2).

<sup>77</sup> *Ibid.*, Reg. 42(3).

<sup>78</sup> *Ibid.*, Reg. 42(4).

<sup>79</sup> *Ibid.*, Reg. 42(5).

<sup>80</sup> *Ibid.*, Reg. 42(6).

claims<sup>81</sup> cannot serve as a basis for any other multiple dependent claim. Any dependent claim must be construed as including all the limitations contained in the claims to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.<sup>82</sup> All dependent claims referring back to a single previous claim as well as all dependent claims referring back to several previous claims are to be grouped together to the extent and in the most practical way possible.<sup>83</sup>

An application for the grant of a patent is not entertained unless the prescribed fee has been paid to the Registrar.<sup>84</sup> The prescribed fees as enumerated in Column II of the Seventh Schedule<sup>85</sup> to the Regulations are set out below:

## SEVENTH SCHEDULE PATENTS

### Fees

Column I Subject Matter	Column II Fees
1. On application for the grant of a patent	Rs.* 1,500.00
2. On inspection by the inventor of the application and to obtain copy thereof by the inventor	Rs. 20.00 per page subject to a minimum fee of Rs. 50.00
3. On request to refer an application to a local examiner	Rs. 450.00
4. For the preparation by the Registrar of an abstract	Rs. 200.00
5. For a copy of the patent together with the search report	Rs. 200.00
6. For a certified extract of the Register of Patents	Rs. 50.00
7. On application for the assignment of transmission of a patent application or patent	Rs. 750.00

\* US\$1 is equal to Rupees 40 (UN rate, October 1990).

<sup>81</sup> *Ibid.*, Reg. 42(7)(a).

<sup>82</sup> *Ibid.*, Reg. 42(7)(b).

<sup>83</sup> *Ibid.*, Reg. 42(7)(c).

<sup>84</sup> Code of Intellectual Property Act, No. 52 of 1979, s.69.

<sup>85</sup> *Gazette Extraordinary*, No. 597 of 1990.

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| 8.  | On a request for recording particulars of (a) a licence contract or of any assignment, transmission, sub-licence, amendment, renewal                                     | Rs. 550.00  |
|     | (b) expiration or termination thereof  | Rs. 100.00  |
| 9.  | For an amendment of the application and for each divisional application  | Rs. 150.00  |
| 10. | (i) For inspection of the Register of patents in respect of each patent  | Rs. 20.00   |
|     | (ii) For inspection of the Classified Abstracts in respect of each patent  | Rs. 20.00   |
| 11. | For inspection of the file relating to the patent or with the permission of the applicant  | Rs. 20.00   |
| 12. | For obtaining certified extracts of the file relating to the patent after the grant of the patent or with the permission of the applicant before the grant of the patent | Rs. 20.00 per page<br>subject to a minimum<br>fee of<br>Rs. 50.00 |
| 13. | For divulging permissible information before the grant of the patent by the Registrar  | Rs. 20.00   |
| 14. | In order to keep the patent in force   |   |
|     | (a) For the 1st extension  | Rs. 2,000.00  |
|     | (b) For the 2nd extension  | Rs. 2,000.00  |
|     | (c) For the 3rd extension  | Rs. 3,000.00  |
|     | (d) For the 4th extension  | Rs. 3,000.00  |
|     | (e) For the 5th extension  | Rs. 3,500.00  |
|     | (f) For the 6th extension  | Rs. 3,500.00  |
|     | (g) For the 7th extension  | Rs. 3,500.00  |
|     | (h) For the 8th extension  | Rs. 7,000.00  |
|     | (i) For the 9th extension  | Rs. 7,000.00  |
|     | (j) For the 10th extension   | Rs. 7,000.00  |
|     | (k) For the 11th extension   | Rs. 7,000.00  |
|     | (l) For the 12th extension   | Rs. 7,000.00  |
|     | (m) For the 13th extension   | Rs. 7,000.00  |
| 15. | Surcharge on late applications for extension—10 per cent of the fee due.   |   |

Any fee payable under these regulations is required to be paid in cash or by cheque or money order or postal order drawn in favour of the Registrar.<sup>86</sup> Where any person liable to pay fees under these regulations is not resident in Sri Lanka, such person is required to pay the relevant fee by way of a bank draft drawn in favour of the Registrar.<sup>87</sup>

A search report is necessary in respect of each application for a patent. Every applicant is under a duty to furnish within the stipulated period a report, which if not in English, should be accompanied by a translation thereof in English, of an international-type search as may be prescribed.<sup>88</sup>

An application must necessarily relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.<sup>89</sup> This provision embodies the fundamental requirement relating to the unity of the invention in respect of which patent protection is sought.

The notion relating to the unity of an invention is construed as permitting, in particular, either of two possibilities: (a) in addition to an independent claim for a given product, the inclusion in the application of one independent claim for one process specially adapted for the manufacture of the product, and the inclusion in the same applicaiton of one independent claim for one use of the product: or (b) in addition to an independent claim for a given process, the inclusion in the application of one independent claim for one apparatus or means specifically designed for carrying out the process.<sup>90</sup> It is permitted to include in the same application two or more independent claims of the same category which cannot readily be covered by a single generic claim.<sup>91</sup> There is also no objection to including in the same application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.<sup>92</sup>

The Sri Lankan statutory regime contains specific provisions in regard to amendment and division of the application.

An applicant may amend the application so long as the amendment does not go beyond the disclosure in the initial application.<sup>93</sup> An applicant may divide the application into two or more applications (“divisional applications”) provided that

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<sup>86</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979 Reg. 62(1).

<sup>87</sup> *Ibid.*, Reg. 62(2).

<sup>88</sup> Code of Intellectual Property Act, No. 52 of 1979, s.70(1).

<sup>89</sup> *Ibid.*, s.71.

<sup>90</sup> *Gazette Extraordinary, supra*, Reg. 45(1).

<sup>91</sup> *Ibid.*, Reg. 45(2).

<sup>92</sup> *Ibid.*, Reg. 45(3).

<sup>93</sup> Code of Intellectual Property Act, No. 52 of 1979, s.72(1).

each divisional application does not go beyond the disclosure in the initial application. Each divisional application is entitled to the filing or, where applicable, priority date of the initial application.<sup>94</sup>

Any divisional application must contain reference to the initial application.<sup>95</sup> If the applicant wishes a divisional application to benefit from any priority claimed for the initial application, the divisional application shall contain a request to that effect. In such a case, the declaration of priority and the documents furnished for the initial application are deemed to relate also to the divisional application.<sup>96</sup> Where the priorities of two or more earlier applications are claimed for the initial application, a divisional application may benefit only from the priority or priorities that are applicable to it.<sup>97</sup>

A crucial advantage in regard to patent applications is the right of priority. This provided for *in extenso* by legislative provision. An application may contain a declaration claiming the priority, pursuant to the Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any State party to the said Convention.<sup>98</sup>

The specific elements to be contained in the declaration of priority are spelt out by regulation. It is a legal requirement that the declaration of priority must indicate: (a) the date of each earlier application; (b) the number of each earlier application; (c) the symbol, if any, of the International Patent Classification which has been allocated to each earlier application; (d) the name of the State in which each earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which it is filed;<sup>99</sup> (e) where the earlier application is a regional or an international application, the office with which it was filed. Where at the time of filing the declaration the number of any earlier application is not known, the number must be furnished within three months from the date on which the application containing the declaration was filed.<sup>100</sup> Where a symbol of the International Patent Classification has not been allocated to the earlier application, or had not yet been allocated at the time of filing the declaration,<sup>101</sup> the applicant must state this fact in his declaration. Where the priorities of two or more earlier applications are claimed, the indication relating to those earlier applications may be included in a single

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<sup>94</sup> *Ibid.*, s.72(2).

<sup>95</sup> *Gazette Extraordinary, supra* Reg. 46(1).

<sup>96</sup> *Ibid.*, Reg. 46(2).

<sup>97</sup> *Ibid.*, Reg. 46(3).

<sup>98</sup> Code of Intellectual Property Act, *supra* s.72(1).

<sup>99</sup> *Gazette Extraordinary, supra*, Reg. 48(1).

<sup>100</sup> *Ibid.*, Reg. 48(2).

<sup>101</sup> *Ibid.*, Reg. 48(3).

declaration.<sup>102</sup> The applicant may, at any time before the grant of the patent, amend the contents of the declaration.<sup>103</sup>

Where the application contains a declaration of this nature, the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application, certified as correct by the Office with which it was filed or, where the earlier application is an international application filed under the Patent Cooperation Treaty, by the International Bureau of the World Intellectual Property Organization (WIPO).<sup>104</sup>

Matters relating to the copy and translation of earlier applications are provided for by regulation. With regard to the time frame, the period for furnishing the certified copy of each earlier application must be three months from the date of the Registrar's request.<sup>105</sup>

Where the copy has already been furnished for another application, the applicant may respond to the Registrar by making a reference to that other application.<sup>106</sup> Where the earlier application is in a language other than the language of the application for grant of a patent in Sri Lanka, the Registrar may require the applicant to furnish him, within three months, with a translation of the earlier application in the language of the application for the grant of such patent in Sri Lanka. The Registrar may extend the time limit for such period as he deems appropriate.<sup>107</sup>

The effect of the declaration claiming priority is provided in the Convention.<sup>108</sup> However, where mandatory requirements stipulated by principal legislation or by regulations are not complied with the declaration claiming priority is deemed null and void.<sup>109</sup>

If the Registrar finds that these requirements have not been complied with, he must invite the applicant to file the correction within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate. If the applicant does not comply with this invitation, the declaration claiming priority is deemed null and void.<sup>110</sup>

An application for a patent may be withdrawn in accordance with the procedure spelt out by regulations.

<sup>102</sup> *Ibid.*, Reg. 48(4).

<sup>103</sup> *Ibid.*, Reg. 48(5).

<sup>104</sup> Code of Intellectual Property Act, No. 52 of 1979, s.73(2).

<sup>105</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 49(1).

<sup>106</sup> *Ibid.*, Reg. 49(2).

<sup>107</sup> *Ibid.*, Reg. 49(3).

<sup>108</sup> Code of Intellectual Property Act, No. 52 of 1979, s.73(3).

<sup>109</sup> *Ibid.*, s.73(4).

<sup>110</sup> *Gazette Extraordinary*, *supra* Reg. 50.

The applicant or his authorized agent, if so authorized in that behalf by the applicant, may withdraw the application at any time during its pendency.<sup>111</sup> The withdrawal of the application is effected by a written declaration addressed to the Registrar. In the case of several applicants, the declaration must be signed by all the applicants.<sup>112</sup>

## 2.6 Scope of Exclusive Rights

The right to a patent belongs exclusively to the inventor.<sup>113</sup> This is a species of the concept of sovereign domain which precludes exploitation of the right by others without the consent of the inventor. Where two or more persons have jointly made an invention, the right to the patent belongs to them jointly.<sup>114</sup>

Judicial assignment of a patent application or patent attendant upon proof of usurpation is specifically provided for.

Where the essential elements of the invention claimed in a patent application or patent for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him.<sup>115</sup> The proviso is, however, applicable that where, after a patent application has been filed, the person to whom the right to the patent belongs gives his consent to the filing of the patent application, such consent, for all purposes, be deemed to have been effective from the date of filing of such application.<sup>116</sup> In any event, the Court does not entertain an application for the assignment of a patent after five years from the date of grant of the patent.<sup>117</sup>

Inventions made by an employee or pursuant to a commission granted by an employer constitute the subject matter of distinct provision. In the absence of any provision to the contrary in any contract of employment or for the execution of a work, the right to a patent for an invention made in the performance of such contract of employment or in the execution of such work be deemed to accrue to the employer, or the person who commissioned the work, as the case may be.<sup>118</sup>

A necessary limitation, however, is that where the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment or for the execution of work, as

<sup>111</sup> *Ibid.*, Reg. 51(1).

<sup>112</sup> *Ibid.*, Reg. 51(2).

<sup>113</sup> Code of Intellectual Property Act, No. 52 of 1979, s.64(1).

<sup>114</sup> *Ibid.*, s.64(2).

<sup>115</sup> *Ibid.*, s.65.

<sup>116</sup> *Ibid.*, proviso to s.65.

<sup>117</sup> *Ibid.*, proviso to s.65.

<sup>118</sup> *Ibid.*, s.66(1).

the case may be, the inventor is entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.<sup>119</sup>

Where the employee whose contract of employment does not require him to engage in any inventive activity makes, in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment.<sup>120</sup>

However, the employee is entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the invention, and any benefit derived from it by the employer.<sup>121</sup>

The rights conferred on the inventor under these provisions cannot be restricted by contract.<sup>122</sup>

The naming of the inventor is in general an imperative requirement. The inventor is required to be named as such in the patent, unless by a declaration in writing signed by him or on his behalf and submitted to the Registrar he indicates that he does not wish to be so named.<sup>123</sup> This provision too cannot be modified by the terms of any contract.<sup>124</sup>

The rights of the owner of a patent receive sweeping definitions. Thus the owner of a patent shall have exclusive rights in relation to the patent (*a*) to exploit the patent (*b*) to assign or transmit the patent; (*c*) to conclude licence contracts.<sup>125</sup> No person may do any of these acts without the consent of the owner of the patent.<sup>126</sup> For this purpose "exploitation" of a patented invention is declared to mean any of the following acts in relation to a patent: (*a*) when the patent has been granted in respect of product, making, importing, offering for sale, selling and using the product; or stocking such product for the purpose of offering for sale, selling or using; (*b*) when the patent has been granted in respect of process using the process; or making, importing, offering for sale, selling and using the product obtained directly by means of the process.<sup>127</sup>

The owner of the patent has the right not only to exploit but also to dispose of his exclusive right. Consequently a patent application may be assigned or trans-

<sup>119</sup> *Ibid.*, proviso to s.66(1).

<sup>120</sup> *Ibid.*, s.66(2).

<sup>121</sup> *Ibid.*, proviso to s.66(2).

<sup>122</sup> *Ibid.*, s.66(3).

<sup>123</sup> *Ibid.*, s.67(1).

<sup>124</sup> *Ibid.*, s.67(2).

<sup>125</sup> *Ibid.*, s.81(1).

<sup>126</sup> *Ibid.*, s.81(2).

<sup>127</sup> *Ibid.*, s.81(3).



mitted.<sup>128</sup> Any person becoming entitled by assignment or transmission to a patent application or patent may apply to the Registrar in the prescribed manner or have such assignment or transmission recorded in the Register.<sup>129</sup> No such assignment or transmission may be recorded in the register unless the prescribed fee has been paid to the Registrar; and in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.<sup>130</sup> No such assignment or transmission has effect against third parties unless so recorded in the register.<sup>131</sup>

Any application made to the Registrar, requesting him to record in the Register of Patents the assignment or transmission of an application for the grant of a patent or the grant of a patent, is required to be made on Form P2 set out in the Sixth Schedule to the Regulations and must be forwarded to the Registrar together with the fee.<sup>132</sup> Where this provision has been complied with, the Registrar must record such assignment or transmission in the Register of Patents.<sup>133</sup>

Explicit provision is made in respect of joint ownerships of patent applications or patents.

In the absence of any agreement to the contrary between the parties, joint owners of a patent application or patent may separately assign or transmit their rights in the patent application or patent, exploit the patented invention and take action against any person exploiting the patented invention without their consent, but may only jointly withdraw the patent application, surrender the patent or conclude a licence contract.<sup>134</sup>

## 2.7 Duration of Patent

Patent protection does not endure in perpetuity, but only for a term of years stipulated by the law. The general principle is that a patent expires 15 years after the date of its grant.<sup>135</sup>

Where a patentee intends at the expiration of the second year from the date of grant of the patent to keep the same in force he must, 12 months before the date of expiration of the second and each succeeding year during the term of the patent, pay the prescribed annual fee.<sup>136</sup> However, a period of grace of six months is

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<sup>128</sup> *Ibid.*, s.84(1).

<sup>129</sup> *Ibid.*, s.84(2).

<sup>130</sup> *Ibid.*, s.84(3).

<sup>131</sup> *Ibid.*, s.84(4).

<sup>132</sup> *Gazette Extraordinary, supra* Reg. 59(1).

<sup>133</sup> *Ibid.*, Reg. 59(2).

<sup>134</sup> Code of Intellectual Property Act, No. 52 of 1979, s.85.

<sup>135</sup> *Ibid.*, s.80(1).

<sup>136</sup> *Ibid.*, s.80(2).

allowed after the date of such expiration, upon payment of such surcharge as may be prescribed.<sup>137</sup> There is however the proviso that the patentee may pay in advance the whole or any portion of the aggregate of the prescribed annual fees.<sup>138</sup>

## 2.8 Infringement

Two types of infringement require separate treatment. The first relates to the infringement of the rights of the patent holder. The second situation envisages infringement of statutory provisions governing patents.

With regard to the first category, the statute contains provision that any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.<sup>139</sup>

An important feature of this provision is its penal character. The liability imposed for the infringement of a patent under this provision is specifically penal in complexion.

By contrast there can be situations in which civil liability arises for infringement of the rights of an owner of a patent. Since a patent involves exclusive rights to exploit the patent invention to assign or transmit the patent and to conclude licence contracts.<sup>140</sup> The isolation of any of these rights can entail liability under the civil law. In Sri Lanka where the corner-stone for recoupment of pecuniary loss wrongfully caused in the Aquilian Action, the concept of *damnum injuria datum* is sufficiently amorphous in scope to cater for the intentional violation of an economic right of an intangible character. The requirement relating to a breach of duty caused by a wrongful act committed intentionally or with *dolus* is readily demonstrable in these circumstances. Consequently, from the standpoint of principle there should be no difficulty in demonstrating the elements of liability postulated by the *actio legis aquiliae*.

The second major category of infringement pertains to the contravention of statutory provisions relating to patents. These provisions themselves occur in the Code under two heads. The first contemplates false representations with regard to

<sup>137</sup> *Ibid.*, proviso to s.80(2).

<sup>138</sup> *Ibid.*, further proviso to s.80(2).

<sup>139</sup> *Ibid.*, s.147.

<sup>140</sup> *Ibid.*, s.81(1).

patents.<sup>141</sup> The second concerns unlawful disclosure of information in respect of patents.<sup>142</sup>

False representations concerning patents is the subject matter of an offence of wide scope. Any person who, for industrial or commercial purposes, makes a representation (a) with respect to a patent not being a registered patent to the effect that it is a registered patent; (b) to the effect that a registered patent is registered in respect of any product or process in respect of which it is not registered; or (c) to the effect that the registration of a patent gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right, is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.<sup>143</sup>

For the purpose of this provision, a person is deemed to represent that a patent is registered if he uses in connection with the patent the word "registered," or any word or words expressing or implying that registration has been obtained for the patent.<sup>144</sup>

Unlawful disclosure of information relating to patents is the theme of a distinct offence. There is explicit provision in the law that any person who being or having been employed in or at the Registry, communicates any information relating to patents or matters connected therewith obtained by him during the course of his employment in or at the Registry to any person not entitled or authorized to receive such information, or discloses such information to the public or makes any other unlawful use of such information is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding 12 months or to both such fine and such imprisonment.<sup>145</sup>

Provision is also made for injunctive relief in circumstances where rights accruing to the holder of a patent are infringed.

Where the registered owner of an industrial design, patent or mark proves that any person is threatening to infringe or has infringed the said industrial design, patent or mark, as the case may be, or is performing acts which make it likely that infringement will occur, the Court may grant an injunction restraining any such person from committing or continuing such infringement or performing

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<sup>141</sup> *Ibid.*, s.148.

<sup>142</sup> *Ibid.*, s.149.

<sup>143</sup> *Ibid.*, s.148(1).

<sup>144</sup> *Ibid.*, s.148(2).

<sup>145</sup> *Ibid.*, s.149.

such acts and may award damages and such other relief as to the Court appears just and appropriate. In these same proceedings, however, the defendant may request the Court to declare the registration of the said industrial design, patent or mark, as the case may be, or any part of it, null and void.<sup>146</sup>

## 2.9 Defences to Infringement and Revocation

The primary ground of exoneration in respect of a criminal action hinges on the lack of *mens rea*. A particular state of mind on the part of the defendant is an essential component element of criminal liability. The relevant provision is that “any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent shall be guilty of an offence.”<sup>147</sup> The defendant therefore is clearly able to secure relief from criminal liability by adducing proof that the infringement was not made wilfully.

There are other grounds which, in keeping with the statutory provisions applicable, may be relied upon in support of exculpation from criminal responsibility for infringement of rights devolving upon the owner of a patent. Thus it is clear law that liability for infringement extends only to acts done for industrial or commercial purposes and in particular does not embrace acts done only for scientific research.<sup>148</sup> Moreover the penal provisions controlling infringement do not preclude a person enjoying rights emanating by virtue of prior manufacture or use or a licensee, from exploiting the patented invention.<sup>149</sup> Also these provisions do not extend to the presence or use of products on foreign vessels, aircraft, space craft or land vehicles which temporarily or accidentally enter the waters, airspace or territory of Sri Lanka.<sup>150</sup>

An elaborate provision recognizes an exception from criminal liability in the case of rights derived from prior manufacture or use. Where a person at the filing or, where applicable the priority date of the patent application (*a*) was in good faith in Sri Lanka making the product or using the process which is the subject of the invention claimed in such application (*b*) had in good faith in Sri Lanka made serious preparations towards the making of the product or using the process has the right, despite the grant of the patent exploit the patented invention.<sup>151</sup> The proviso is added, however, that the product in question is used by the said person in Sri Lanka.<sup>152</sup>

<sup>146</sup> *Ibid.*, s.179.

<sup>147</sup> *Ibid.*, s.147.

<sup>148</sup> *Ibid.*, s.82(1).

<sup>149</sup> *Ibid.*, s.82(2).

<sup>150</sup> *Ibid.*, s.82(3).

<sup>151</sup> *Ibid.*, s.83(1).

<sup>152</sup> *Ibid.*, proviso to s.83(1).

Surrender and nullity of patents is separately provided for. The registered owner of a patent may surrender the patent by a declaration in writing signed by him or on his behalf and submitted to the Registrar.<sup>153</sup> The surrender may be limited to one or more claims of the patent.<sup>154</sup> The Registrar on receipt of the said declaration is required to record it in the Register and cause such record to be published in the *Gazette*.<sup>155</sup> The surrender takes effect from the date that the Registrar receives this declaration.<sup>156</sup> Where a licence contract in respect of a patent is recorded in the Register, the Registrar is not entitled in the absence of provision to the contrary in such licence contract to accept or record the surrender except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the surrender unless the requirement of his consent is expressly waived in the licence contract.<sup>157</sup>

Nullity of a patent may be applied for by a specified category of persons upon a variety of grounds. The Court may, on the application of any person showing a legitimate interest or of any competent authority including the Registrar to which the owner of the patent and every assignee, licensee or sub-licensee on record is made a party, declare the patent null and void on any one or more of the specified grounds:

- (a) that what is claimed as an invention in the patent is not an invention within the meaning of the relevant provision<sup>158</sup> of the law or is excluded from protection for reasons of policy recognized by the law<sup>159</sup> or is not patentable for failure of compliance with mandatory legal requirements;<sup>160</sup>
- (b) that the description or the claims do not comply with the requirements that apply in that regard; (c) that any drawings which are necessary for the understanding of the claimed invention have not been furnished<sup>161</sup> or (d) that the right to the patent does not belong to the person to whom the patent was granted, on condition that the patent has not been assigned to the person to whom the right to the patent belongs.<sup>162</sup> Where these provisions apply only to some of the claims or some parts of a claim, such claims or parts of a claim may be declared null and

<sup>153</sup> *Ibid.*, s.94(1).

<sup>154</sup> *Ibid.*, s.94(2).

<sup>155</sup> *Ibid.*, s.94(3).

<sup>156</sup> *Ibid.*, s.94(4).

<sup>157</sup> *Ibid.*, s.94(5).

<sup>158</sup> *Ibid.*, s.59(1).

<sup>159</sup> *Ibid.*, s.59(3) and s.76(1).

<sup>160</sup> *Ibid.*, s.60 to 63.

<sup>161</sup> *Ibid.*, s.68(3) and (4).

<sup>162</sup> *Ibid.*, s.95(1).

void by the Court.<sup>163</sup> The nullity of part of a claim is declared in the form of a corresponding limitation of the claim in question.<sup>164</sup> An assignee, licensee or sub-licensee, as the case, may be who has been made party to the application is entitled to join in the proceedings in the absence of any provision to the contrary in any contract or agreement with the owner of the patent.<sup>165</sup>

Upon a final decision of the Court declaring total or partial nullity of a patent, the patent is deemed to have been null and void totally or partially, as the case may be, from the date of the grant of the patent.<sup>166</sup> When a declaration of nullity becomes final the Registrar of the Court must notify the Registrar who must record the declaration in the Register and cause it to be published in the *Gazette*.<sup>167</sup>

## 2.10 Licensing

A licence contract receives a statutory definition in our law. In one sense, any contract by which the owner of a patent (“the licensor”) grants to another person or enterprise (“the licensee”) a licence to exploit, assign or transmit any or all other rights envisaged by the patent.<sup>168</sup>

The form and record of a licence contract constitute the subject matter of explicit stipulation by the legislative provisions applicable.

A licence contract must be in writing signed by or on behalf of the contracting parties.<sup>169</sup> Upon a request in writing signed by or on behalf of the contracting parties, the Registrar must on payment of the prescribed fee, record in the Register such particulars relating to the contract as the parties thereto might wish to have recorded.<sup>170</sup> The parties, however, are not required to disclose or have recorded any other particulars relating to the said contract.<sup>171</sup>

The rights of the licensee and of the licensor are defined comprehensively. With regard to the former, in the absence of any provision to the contrary in the licence contract, the licensee is entitled to (a) exploit the patent within the whole geographical area of Sri Lanka, without limitation as to time and through any

<sup>163</sup> *Ibid.*, s.95(2)(a).

<sup>164</sup> *Ibid.*, s.95(2)(b).

<sup>165</sup> *Ibid.*, s.95(3)(a).

<sup>166</sup> *Ibid.*, s.96(1).

<sup>167</sup> *Ibid.*, s.96(2).

<sup>168</sup> *Ibid.*, s.86.

<sup>169</sup> *Ibid.*, s.87(1).

<sup>170</sup> *Ibid.*, s.87(2).

<sup>171</sup> *Ibid.*, proviso to s.87(2).

application of the patented invention; (b) to assign or transmit his rights under the licence contract or grant sub-licences to third parties.<sup>172</sup> These provisions apply, *mutatis mutandis*, to assignments and sub-licences.<sup>173</sup>

So far as the rights of the latter are concerned, in the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same patent or himself exploit, assign or transmit the rights subsumed in the patent.<sup>174</sup> Where the licence contract provides that the licensee is exclusive, and unless it is expressly provided otherwise in such contract, the licensor is not entitled to grant further licences to third parties in respect of the same patent or himself exploit, assign or transmit the rights subsumed in the patent.<sup>175</sup>

Certain types of clauses in licence contracts are declared null and void for reasons of policy. Thus any clause or condition in a licence contract is null and void in so far as it imposes upon the licensee, in the industrial or commercial field, restrictions not derived from the rights conferred on the owner of the patent or unnecessary for the safeguarding of such rights.<sup>176</sup>

The proviso is, however, operative that (a) restrictions concerning the scope, extent or duration of exploitation of the patented invention, or the geographical area in or the quality or quantity of the products in connection with which the patented invention may be exploited; and (b) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the patent, are not deemed to constitute such restrictions.<sup>177</sup>

Explicit provision is made with regard to the effect of a patent application not being granted or a patent being declared null and void. Where, before the expiration of the licence contract, any of the following events occur in respect of the patent application or patent referred to in such contract (a) the patent application is withdrawn; (b) the patent application is finally rejected; (c) the patent is surrendered; (d) the patent is declared null and void; or (e) the registration of the licence contract is invalidated, the licensee is no longer required to make any payment to the licensor under the licence contract, and is entitled to repayment of the payments already made.<sup>178</sup> However, the licensor is not required to make any repayment, or is required to make repayment only in part, to the extent that he can

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<sup>172</sup> *Ibid.*, s.88(1).

<sup>173</sup> *Ibid.*, s.88(2).

<sup>174</sup> *Ibid.*, s.89(1).

<sup>175</sup> *Ibid.*, s.89(2).

<sup>176</sup> *Ibid.*, s.90.

<sup>177</sup> *Ibid.*, proviso to s.90.

<sup>178</sup> *Ibid.*, s.91.

prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.<sup>179</sup>

Expiry, termination or invalidation of a licence contract form the subject of a separate provision. The Registrar must if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the register upon a request in writing to that effect signed by or on behalf of the parties thereto.<sup>180</sup>

Special reference is made to licence contracts involving payments abroad. Where the Registrar has reasonable cause to believe that any licence contract or any amendment thereof (*a*) which involves the payment of royalties abroad; or (*b*) which by reason of other circumstances relating to such licence contract, is detrimental to the economic development of Sri Lanka, he must communicate in writing such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.<sup>181</sup> Where the Governor of the Central Bank on receipt of any communication informs the Registrar in writing that the licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka, the Registrar is under a duty to cancel and invalidate the record of such contract in the Register.<sup>182</sup>

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<sup>179</sup> *Ibid.*, proviso to s.91.

<sup>180</sup> *Ibid.*, s.92.

<sup>181</sup> *Ibid.*, s.93(1).

<sup>182</sup> *Ibid.*, s.93(2).













## CHAPTER 3

# PATENT INFORMATION AND DOCUMENTATION

### SYNOPSIS

3.1 Range of Patent Documentation

3.2 Content of Patent Documents

3.2.1 The Patent Application

3.2.2 Search Reports

3.2.3 The Patent Itself as Granted

3.2.4 Register of Patents

3.3 Patent Documents as a Source of Technological Information



### 3.1 Range of Patent Documentation

There are several categories of documents which are crucial in this regard:

- (i) The application for the patent: this must contain a variety of elements which are explicitly described in the law.
- (ii) A search report which is compulsorily required to be furnished by each applicant.
- (iii) The patent itself as granted.
- (iv) The Register of Patents and the files which are required to be maintained by the Registrar of Patents.

### 3.2 Content of Patent Documents

#### 3.2.1. *The Patent Application*

An application for the grant of a patent, which must be made to the Registrar in the prescribed form, is required to contain the following:

- (i) a request for the grant of the patent;
- (ii) a description;
- (iii) a claim or claims;
- (iv) a drawing or drawings where required;
- (v) an abstract.<sup>1</sup>

Each of these elements is elaborated upon by the regulations.

As regards (i), an application for the grant of a patent is required to be made in Form P1 set out in the Sixth Schedule to the Regulations, and must be signed by the applicant or his authorized agent.<sup>2</sup>

With regard to (ii), the description of invention is required to state the title of the invention as appearing in the request and must moreover, (a) specify the technical field to which the invention relates, (b) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and preferably, cite the documents reflecting such art; (c) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state the advantageous effects, if any, of the invention with reference to the background art; (d) briefly describe the figures in the drawings, if any; (e) set forth at least the best mode contemplated by the applicant for carrying out the invention (this shall be done in terms of examples, where appropriate, and with

<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s. 68(1)(a).

<sup>2</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 36.



reference to the drawings, if any); (f) indicate explicitly, when it is not obvious from the description of nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used, or, if it can only be used, the way in which it can be used.<sup>3</sup>

This manner and order must be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economical presentation.<sup>4</sup>

The content of element (iii)—namely, the nature of a claim or claims—has already been dealt with.<sup>5</sup> As for (iv), drawings are required when they are necessary for the understanding of the invention.<sup>6</sup> Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings (a) the application may include drawings in the application when filed; (b) the Registrar may require that the applicant file such drawings with him and within a time limit specified by him.<sup>7</sup> Where drawings are supplied, a reduction of the most illustrative drawing must be furnished by the applicant in the size and within the time limit specified by the Registrar.<sup>8</sup>

Flow sheets and diagrams are considered drawings.<sup>9</sup>

Finally, as for (v) the abstract consists of the following (a) a summary of the disclosure as contained in the description, the claims and any drawing; the summary must indicate the technical field to which the invention pertains and is to be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention; (b) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.<sup>10</sup> The abstract must be as concise as the disclosure permits (preferably 50 to 150 words).<sup>11</sup> The abstract must not contain statements on the alleged merits or value of the invention or on its speculative application.<sup>12</sup> Each main technical feature mentioned in the abstract and illustrated by a drawing in the application must be followed by a reference sign placed between parentheses.<sup>13</sup> The abstract is

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<sup>3</sup> *Ibid.*, Reg. 44(1).

<sup>4</sup> *Ibid.*, Reg. 44(2).

<sup>5</sup> See text at notes 75 to 79 *supra*.

<sup>6</sup> *Gazette Extraordinary*, *supra* Reg. 43(1)(a).

<sup>7</sup> *Ibid.*, Reg. 43(1)(b).

<sup>8</sup> *Ibid.*, Reg. 43(2).

<sup>9</sup> *Ibid.*, Reg. 43(2).

<sup>10</sup> *Ibid.*, Reg. 44(2).

<sup>12</sup> *Ibid.*, Reg. 44(4).

<sup>13</sup> *Ibid.*, Reg. 44(3).

required to be accompanied by the most illustrative of any drawings furnished by the applicant.<sup>14</sup>

The prescribed period for payment to the Registrar to prepare the abstract is a period of three months from the date of the request made by the Registrar.<sup>15</sup>

### 3.2.2 *Search Reports*

Every applicant is required to furnish, within the prescribed period, a report which, if not in English, shall be accompanied by a translation thereof in English of an international-type search as may be prescribed.<sup>16</sup> Other requirements relating to the international-type search specified are contained in the Regulations. The applicant must furnish to the Registrar within three months from the date of issue of the international-type search report referred to in the section, two copies of that report.<sup>17</sup> The international-type search report must be a report issued by any national industrial property office or any intergovernmental organization appointed as an International Searching Authority under the Patent Cooperation Treaty.<sup>18</sup>

The translation in the English language of the international-type search report must extend to the text of that report as such, but need not include the text of any document cited in that report unless the Registrar, after an examination of the translation accompanying that report, requires that the applicant furnish a translation of the text of any given document so cited or of any portion of that document.<sup>19</sup> The prescribed period for the furnishing by the local examiner of his report on examination as to relevant prior art must be not later than three months from the date of reference to him by the Registrar.<sup>20</sup>

### 3.2.3 *Patent itself as Granted*

Once the Registrar is satisfied that the application complies with mandatory legal requirements, he is under a duty to grant the patent and to issue to the applicant a certificate of the grant of the patent and a copy of the patent, together with a copy of the search report. He must also record the patent in the Register.<sup>21</sup>

The detailed contents of the document constituting the grant of the patent are provided for by regulations. The patent granted must in addition to containing a copy of the description, the claims, all the drawings, if any, and the abstract, include the following particulars: (i) the name and address of the inventor, except

<sup>14</sup> *Ibid.*, Reg. 44(5).

<sup>15</sup> *Ibid.*, Reg. 53(2).

<sup>16</sup> Code of Intellectual Property Act, No. 52 of 1979, s.70(1).

<sup>17</sup> *Gazette Extraordinary, supra* Reg. 53(1).

<sup>18</sup> *Ibid.*, Reg. 53(2).

<sup>19</sup> *Ibid.*, Reg. 53(3).

<sup>20</sup> *Ibid.*, Reg. 53(4).

<sup>21</sup> Code of Intellectual Property Act, No. 52 of 1979, s.76(2).

where the inventor has indicated that he wishes not to be named in the patent;(ii) the name and address of the agent, if any; (iii) the title of the invention; (iv)the symbol of the International Patent Classification; (v)the date and, if any, the number of the international-type search report and the name of the institution issuing the report.<sup>22</sup>

The certificate of grant of a patent, shall, *inter alia*, contain the number of the patent, the name and address of the owner of the patent, the filing date and the priority date, if any, of the application, the date of the grant of the patent and the title of the invention. The certificate of the grant of the patent shall be signed by the Registrar.<sup>23</sup>

Moreover the Registrar is required in respect of each patent, to record in the Register of Patents the particulars required by the law.<sup>24</sup>

#### 3.2.4. *Register of Patents*

The maintenance of these documents is provided for by the law. Details relating thereto are discussed in the next section.

### 3.3 **Patent Documents as a Source of Technological Information**

The primary documents envisaged here are:

- (i) the register of patents; and
- (ii) connected files.

The Statute law imposes upon the Registrar the duty of keeping and maintaining a register called the Register of Patents wherein all patents be recorded, in the order of their grant, specifying the number of the patent, the name and address of the grantee and, if the grantee is resident outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and grant; any change in the ownership of a patent application or patent; the amendment or division of a patent application; the assignment or transmission of a patent application or patent; any valid claim to priority; the surrender or revocation of a patent and such other matters relating to patents as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.<sup>25</sup>

A variety of particulars which the Registrar is required to record in the Register of Patents in respect of each patent is set out in the regulations.<sup>26</sup> The Registrar may also record in the Register of Patents, the lapse of a patent.<sup>27</sup>

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<sup>22</sup> *Gazette Extraordinary, supra* Reg. 57.

<sup>23</sup> *Ibid.*, Reg. 56.

<sup>24</sup> *Ibid.*, Reg 58.

<sup>25</sup> Code of Intellectual Property Act, No. 52 of 1979, s.77.

<sup>26</sup> *Gazette Extraordinary, supra* Reg. 58.

<sup>27</sup> *Ibid.*, Reg. 60.

Ready access to the Register is available to the public, thus provision is made that any person may examine the Register and may obtain certified extracts therefrom on payment of the prescribed fee.<sup>28</sup>

Moreover any person may, after the grant of a patent inspect the file relating to the patent and, the file relating to any patent application and may obtain certified extracts therefrom on payment of the prescribed fee.<sup>29</sup> The file relating to a patent application may however, be inspected before the grant of the patent only with the written permission of the applicant.<sup>30</sup> The proviso is operative that before the grant of the patent the Registrar may divulge the following information to any person: (a) the name, address and description of the applicant and the name and address of the agent, if any; (b) the number of the application and, if priority is claimed, the priority date, the number of the earlier application and the name of the State in which the earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which and the Office with which it was filed; (d) the title of the invention; (e) any change in the ownership of the application and any reference to a licence contract appearing in the file relating to the application.<sup>31</sup>

There are necessary restrictions with regard to persons employed at the Registry. Our law provides in express terms that no person employed in or at the Registry may make a patent application or be granted a patent or acquire or hold in any manner whatsoever any rights relating to a patent during the period of his employment in or at the Registry and for one year after the termination of such employment.<sup>32</sup>

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<sup>28</sup> *Code of Intellectual Property Act*, No. 52 of 1979, s.78.

<sup>29</sup> *Ibid.*, s.79(1).

<sup>30</sup> *Ibid.*, s.79(2).

<sup>31</sup> *Ibid.*, proviso to s.79(2).

<sup>32</sup> *Ibid.*, s.79(3).













## CHAPTER 4

# TRADE MARKS

### SYNOPSIS

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## 4.10 Licensing

## 4.11 Collective Marks

### 4.11.1 Introduction

### 4.11.2 Special Provisions Relating to Collective Marks

## 4.12 Trade Names

## 4.1 Introduction

The basic concepts receive definition in the Sri Lankan statute law. A trade mark is defined as any visible sign serving to distinguish the goods of one enterprise from those of other enterprises;<sup>1</sup> and a trade mark needs to be distinguished from a service mark. The latter definition denotes a visible sign serving to distinguish the services of one enterprise from those of other enterprises.<sup>2</sup>

The basic idea underlying the two concepts is the same, in so far as the product or service is associated with a sign which makes identification easy.

Collective marks are a type of trade mark. "Collective mark" is declared to mean any visible sign designated as such and serving to distinguish the origin or any other common characteristic of goods or services of different enterprises which use the mark under the control of the registered owner.<sup>3</sup>

A related concept which finds expression in the law of Sri Lanka is appellation of origin. This relates to the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.<sup>4</sup>

Finally, a trade name is defined as the name or designation identifying the enterprise of a natural or legal person.<sup>5</sup>

It must be noted that the Sri Lankan statutory regime makes no distinction between the provisions applicable to trade marks and the provisions applicable to service marks. The applicable provisions relate to marks. A mark is defined as "a trade mark or service mark."<sup>6</sup> There, are however, special provisions which are applicable to collective marks and trade names.

## 4.2 Scope of Trade Mark Law

### 4.2.1 *Admissibility of Marks*

The basic provision is that the exclusive right to a mark is acquired by registration.<sup>7</sup>

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<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s.97.

<sup>2</sup> *Ibid.*

<sup>3</sup> *Ibid.*

<sup>4</sup> *Ibid.*

<sup>5</sup> *Ibid.*

<sup>6</sup> *Ibid.*

<sup>7</sup> *Ibid.*, s.98(1).

Registration of a mark may be granted only to the person who has first fulfilled the conditions for valid application or who is the first validly to claim the earliest priority for his application.<sup>8</sup>

Subject to some closely defined exceptions<sup>9</sup> marks may consist, in particular, of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedges, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.<sup>10</sup>

#### 4.2.2 *Marks Inadmissible on Objective Grounds*

The Code of Intellectual Property Act sets out *in extenso* categories of marks which are declared to be inadmissible. Thus, Sri Lankan law does not permit a mark to be registered

- (a) which consists of shapes or forms imposed by the inherent nature of the goods or services or by their industrial function;
- (b) which consists exclusively of a sign or indication which may serve, in the course of trade to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production, or of supply, of the goods or services concerned;
- (c) which consists exclusively of a sign or indication which has become, in the current language or in the bona fide and established practices of the trade of Sri Lanka, a customary designation of the goods or services concerned;
- (d) which, for other reasons, is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (e) which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious or racial susceptibilities of any community;
- (f) which is likely to mislead trade circles or the public as to the nature, the source, the manufacturing process, the characteristics, or the suitability for their purpose, of the goods or services concerned;
- (g) which does not represent in a special or particular manner the name of an individual or enterprise;
- (h) which is, according to its ordinary signification, a geographical name or surname;

<sup>8</sup> *Ibid.*, s.98(2).

<sup>9</sup> For marks that cannot be registered see sections 99 and 100 of the Code of Intellectual Property Act, *supra*.

<sup>10</sup> *Ibid.*, s.98(3).

- (i) which reproduces or imitates armorial bearings, flags or other emblems, initials, names or abbreviated names of any State or any intergovernmental international organization or any organization created by international convention, unless authorized by the competent authority of that State or international organization;
- (j) which reproduces or imitates official signs or hallmarks of a State, unless authorized by the competent authority of that State;
- (k) which resembles in such a way as to be likely to mislead the public, a mark or a collective mark the registration of which has expired and has not been renewed or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding the filing of the mark in question.<sup>11</sup>

Provision is also made that a mark shall not be registered which consists of any words or definitions as may be prescribed.<sup>12</sup> Accordingly, by regulation it is provided that the Registrar shall not register any application for a mark or collective mark where words or definitions such as “President,” “Prime Minister,” “Minister,” “State,” “Government” or any words of similar meaning which are likely to mislead the public into believing that such mark or collective mark has state patronage or authorization.<sup>13</sup>

In applying these provisions,<sup>14</sup> the Registrar is required to have regard to all the factual circumstances and, in particular, the length of time the mark has been in use in Sri Lanka or in other countries and the fact that the mark is held to be distinctive in other countries or in trade circles.<sup>15</sup>

#### 4.2.3 *Marks Inadmissible by Reason of Third Party Rights*

This is a separate ground on which marks are considered inadmissible in Sri Lanka. Thus a mark cannot be registered

- (a) which resembles, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a third party, or subsequently filed by a person validly claiming priority in respect of the same goods or services or of other goods or services in connection with which use of such mark may be likely to mislead the public;
- (b) which resembles, in such a way as to be likely to mislead the public, an unregistered mark used earlier in Sri Lanka by a third party in connec-

<sup>11</sup> *Ibid.*, s.99(a) to (k).

<sup>12</sup> *Ibid.*, s.99(1).

<sup>13</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 26.

<sup>14</sup> Code of Intellectual Property Act, *supra* s.98(1)(b), (c), (d), (f), (g) and (h).

<sup>15</sup> *Ibid.*, s.99(2).

- tion with identical or similar goods or services, if the applicant is aware, or could not have been unaware, of such use;
- (c) which resembles, in such a way as to be likely to mislead the public, a trade name already used in Sri Lanka by a third party, if the applicant is aware, or could not have been unaware, of such use;
  - (d) which constitutes a reproduction in whole or in part, an imitation, translation or transcription, likely to mislead the public, of a mark or trade name which is well known in Sri Lanka and belongs to a third party;
  - (e) which infringes other party rights or is contrary to mandatory provisions relating to the prevention of unfair competition;
  - (f) which is filed by the agent or representative of a third party who is the owner of such mark in another country, without the authorization of such owner, unless the agent or representative justifies his action.<sup>16</sup>

In applying these provisions<sup>17</sup> the Registrar is required to have regard to the fact that the third parties referred to therein have consented to the registration of such mark.<sup>18</sup>

Sri Lankan law does not permit the entering in the Register of notice of any trust express or implied, or constructive, nor is any such notice receivable by the Registrar.<sup>19</sup>

### 4.3 Registration Procedure

#### 4.3.1 Application for Registration

An application for registration of a mark must be made to the Registrar in the prescribed form and must contain:

- (a) a request for the registration of the mark;
- (b) the name, address and description of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka;
- (c) four copies of a representation of the mark;
- (d) a clear and complete list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification, as may be prescribed.<sup>20</sup>

<sup>16</sup> Code of Intellectual Property Act, No. 52 of 1979, s.100(1).

<sup>17</sup> *Ibid.*, s.100(a) to (e).

<sup>18</sup> *Ibid.*, s.100(2).

<sup>19</sup> *Ibid.*, s.101.

<sup>20</sup> *Ibid.*, s.102(1).

The application must be made in Form MI set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of October 31st, 1979.<sup>21</sup>

Detailed provision is made by regulations as to the nature of the particulars to be provided by the applicant.

Where the mark consists of letters, words, numerals or punctuation signs and no special graphic features are claimed, the said elements may be reproduced by typewriter in the appropriate space in the form. One copy of the representation of any other two-dimensional mark shall be affixed to the appropriate space in the form.<sup>22</sup>

Where the mark is three-dimensional, the application shall contain an indication to that effect and the representation must comprise at least two aspects of the mark sufficient to illustrate the shape and features of the mark. One copy of the representation must be affixed to the appropriate space in the form.<sup>23</sup>

Where the copy of the representation to be affixed to the appropriate space in the form is larger than that space, it can be affixed on a separate sheet of paper of A4 size and appended to the form.<sup>24</sup>

The representation of the mark or collective mark must not exceed 10 centimeters by 10 centimeters.<sup>25</sup>

The application may relate to goods or services in one class of the International Classification set out in the Fourth Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979.<sup>26</sup>

The Code makes special provision with regard to an application filed by an agent. The applicable law is that where the application is filed through an agent, it must be accompanied by a power of attorney granted to such agent by the applicant. Legalization or certification of the applicant's signature is, however, not necessary.<sup>27</sup>

The right of priority is separately provided for. An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in a Convention country must, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in

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<sup>21</sup> *Gazette Extraordinary, supra* Reg. 15.

<sup>22</sup> *Ibid.*, Reg. 16.

<sup>23</sup> *Ibid.*, Reg. 17.

<sup>24</sup> *Ibid.*, Reg. 18.

<sup>25</sup> *Ibid.*, Reg. 19.

<sup>26</sup> *Ibid.*, Reg. 20.

<sup>27</sup> Code of Intellectual Property Act, No. 52 of 1979, s.102(2).



which he or his predecessor in title filed such application and must, within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.<sup>28</sup> Where the earlier application is in a language other than the language of the application for the registration of the mark or collective mark in Sri Lanka, the Registrar may require the applicant to furnish him within three months with a translation of the earlier application in the language of the application for the registration of such mark in Sri Lanka.<sup>29</sup>

The date of the application shall be the date of its receipt in the Registry, provided that where the fee in respect of such application is received on a date later than the date of receipt of the application, then that later date shall be deemed to be the date of the application.<sup>30</sup>

The registration of a mark cannot be entertained unless the prescribed fee has been paid.<sup>31</sup> The schedule of fees applicable to various matters in relation to marks is provided for by regulations.

The fees specified in Column II of the Fifth Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979 are payable in respect of matters specified in the corresponding entry in Column I of that Schedule.<sup>32</sup>

#### 4.3.2 Examination as to Form

The Registrar is under a duty to examine whether the application for registration complies with the applicable law.<sup>33</sup> Where the application does not comply with the relevant provisions,<sup>34</sup> the Registrar must refuse registration of the mark.<sup>35</sup> In this event, however, the Registrar must first notify the applicant of any defect in the application and must afford him an opportunity to remedy such defect within three months from the date of receipt of such notification.<sup>36</sup> Where the application does not comply with the requirements of the law the Registrar must not, in connection with the registration of the mark, make any reference to the priority claimed.<sup>37</sup> Where the application is legally well founded, the Registrar must in connection with the registration of the mark record the priority claimed or

<sup>28</sup> *Ibid.*, s.103.

<sup>29</sup> *Gazette Extraordinary, supra* Reg. 22.

<sup>30</sup> *Gazette Extraordinary, supra* Reg. 21.

<sup>31</sup> Code of Intellectual Property Act, *supra* s.105.

<sup>32</sup> *Gazette Extraordinary, supra* Reg. 35.

<sup>33</sup> Code of Intellectual Property Act, *supra* s.106(1).

<sup>34</sup> *Ibid.*, ss.102 and 105.

<sup>35</sup> *Ibid.*, s.106(2).

<sup>36</sup> *Ibid.*, proviso to s.106(2).

<sup>37</sup> *Ibid.*, s.103 or 104.

the date of the certified use of the mark at an international exhibition.<sup>38</sup> Where the Registrar refuses to register a mark he must, if required by the applicant, state in writing the grounds of his decision.<sup>39</sup>

#### 4.3.3 *Examination as to Substance*

Where the application complies with the applicable provisions, the Registrar must examine the mark to ascertain whether it is debarred from registration for the reason that it is inadmissible on objective grounds set out in section 99 or inadmissible by reason of third-party rights set out in section 100.<sup>41</sup>

Where the mark is inadmissible under section 99 or 100, the Registrar must notify the applicant accordingly, stating in writing the grounds on which registration of the mark is refused.<sup>42</sup> Where the applicant is dissatisfied with all or any of the grounds stated by the Registrar in the notification he may, within a period of one month from the date of such notification, make his submissions in writing to the Registrar against such refusal.<sup>43</sup> On receipt of any such submissions the Registrar may grant the applicant a hearing and inform him of the date and time of such hearing.<sup>44</sup>

The Registrar may, after such inquiry as he thinks fit, refuse to accept the application for registration of the mark, or may accept it absolutely or subject to conditions, amendments or modifications, or to such limitations, if any, as to the mode or place of user or otherwise as he may think fit to impose.<sup>45</sup> In case of any refusal or conditional acceptance of an application for registration of a mark, the Registrar must if required by the applicant, state in writing the grounds of his decision.<sup>46</sup> Where the Registrar is of the opinion that the mark is admissible he may request the applicant to pay within a period of two months the prescribed fee for publication of the application.<sup>47</sup>

Where the fee for publication of the application is not paid within the prescribed period, registration of the mark may be refused.<sup>48</sup> If the fee for publication is paid within the prescribed period, the Registrar must proceed to publish the application setting out the date of application, the representation of the mark, the goods or services in respect of which registration of the mark is

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<sup>38</sup> *Ibid.*, s.106(3).

<sup>39</sup> *Ibid.*, s.106(4).

<sup>40</sup> *Ibid.*, s.106(5).

<sup>41</sup> Code of Intellectual Property Act, No. 52 of 1979, s.107(1).

<sup>42</sup> *Ibid.*, s.107(2).

<sup>43</sup> *Ibid.*, s.107(3).

<sup>44</sup> *Ibid.*, s.107(4).

<sup>45</sup> *Ibid.*, s.107(5).

<sup>46</sup> *Ibid.*, s.107(6).

<sup>47</sup> *Ibid.*, s.107(7).

<sup>48</sup> *Ibid.*, s.107(8).

requested with an indication of the corresponding classes, the name and address of the applicant and, if the applicant is resident outside Sri Lanka, a postal address for service in Sri Lanka, the priority claimed, if any, or the date of certified use of the mark at an international exhibition.<sup>49</sup>

#### 4.3.4 *Opposition*

Where any person considers that the mark is inadmissible on one or more of the grounds referred to in the relevant provisions he may, within a period of three months from the date of publication of the application, give to the Registrar in the prescribed form, and together with the prescribed fee, notice of opposition to such registration stating his grounds of opposition.<sup>50</sup> Where notice of opposition has not been received by the Registrar within the specified period, the Registrar shall register the mark.<sup>51</sup>

The notice of opposition must be made in Form M2 set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of 1979 and must be signed by the opposing party or his authorized agent.<sup>52</sup>

Where, within the period specified, notice of opposition in the prescribed form is received by the Registrar, together with the prescribed fee, he must serve a copy of such grounds of opposition on the applicant and must request him to present his observations on those grounds in writing within a period of three months.<sup>53</sup> On receipt of the observations of the applicant the Registrar must after hearing the parties, if he considers such hearing necessary, decide, as expeditiously as possible, whether or not the mark may be registered. If he decides that the mark is registrable, he must accordingly register such mark.<sup>54</sup>

The Registrar may allow a reasonable extension of the prescribed period within which any act has to be done or any fee has to be paid.<sup>55</sup>

#### 4.3.5 *Registration and Publication*

The Registrar is required to keep and maintain a register called the Register of Marks wherein must be recorded, in the order of their registration, all registered marks and such other matters relating to marks as are authorized or directed by law to be so recorded or may from time to time be prescribed.<sup>56</sup>

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<sup>49</sup> *Ibid.*, s.107(9).

<sup>50</sup> *Ibid.*, s.107(10).

<sup>51</sup> *Ibid.*, s.107(11).

<sup>52</sup> *Gazette Extraordinary*, *supra* Regulation 24.

<sup>53</sup> Code of Intellectual Property Act, No. 52 of 1979 s.107(12).

<sup>54</sup> *Ibid.*, s.107(13).

<sup>55</sup> *Ibid.*, s.107(14).

<sup>56</sup> *Ibid.*, s.109(1).

The registration of a mark must include a representation of the mark and must specify its number, the name and address of the registered owner and, if the registered owner's address is outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and registration; if priority is validly claimed, an indication of that fact and the number, date and country of the application on the basis of which the priority is claimed; if a valid certificate has been filed relating to the use of a mark at an international exhibition, the contents of such certificate; the list of goods and services in respect of which registration of the mark has been granted with an indication of the corresponding class or classes.<sup>57</sup>

In addition to the particulars referred to above, the following particulars must also be recorded in the Register of Marks in respect of each registered mark or collective mark:

- (a) the number of the application;
- (b) the name and address of any authorized agent or the owner of the registration;
- (c) the reference to the date and number of the *Gazette* in which the registration was published;
- (d) any change in the name of the address of the registered owner of the registration.<sup>58</sup>

Upon the registration of a mark the Registrar must issue to the registered owner thereof a certificate of registration and must, at the request of the registered owner, send such certificate to him by registered post at his last recorded postal address in Sri Lanka or, if he is resident outside Sri Lanka, at his last recorded postal address for service in Sri Lanka.<sup>59</sup>

The Registrar must cause to be published in the *Gazette*, in the prescribed form, all registered marks in the order of their registration, including in respect of each mark so published reference to such particulars as may be prescribed.<sup>60</sup>

Provision is made by regulation that the publication must be in Form M4 set out in the Third Schedule of *Gazette Extraordinary* No.60/20 of 31-10-1979.<sup>61</sup>

An applicant who does not diligently pursue his application is liable to have it rejected. Provision is made that where, by reason or default on the part of the applicant, registration of a mark is not completed within 12 months from the date of receipt by the Registrar of the application, the Registrar may, after giving notice of non-completion to the applicant in writing in the prescribed form, treat

<sup>57</sup> *Ibid.*, s.109(2).

<sup>58</sup> *Gazette Extraordinary*, *supra* Reg. 27.

<sup>59</sup> Code of Intellectual Property Act, *supra* s.109(3).

<sup>60</sup> *Ibid.*, s.110.

<sup>61</sup> *Gazette Extraordinary*, *supra* Reg. 28.

the application as abandoned, unless it is completed within the time specified in that behalf in such notice.<sup>62</sup>

Any notice of non-completion of registration must be made in Form M3 set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979. The time specified for the completion of the registration is three months from the date of issue of the notice.<sup>63</sup>

#### 4.4 Miscellaneous Provisions

##### 4.4.1 *Temporary Protection of a Mark Exhibited at an International Exhibition*

An applicant for registration of a mark who has exhibited goods bearing the mark or rendered services under the mark at an official or officially recognized international exhibition and who applies for registration of the mark within six months from the date on which the goods bearing the mark or the services rendered under the mark were first exhibited or rendered at such exhibition must on request be deemed to have applied for registration of that mark on the date on which the goods bearing the mark or the services rendered under the mark were first exhibited or rendered at such exhibition.<sup>64</sup>

Evidence of the exhibition of the goods bearing the mark or the services rendered under the mark must be by a certificate issued by the competent authority of the exhibition stating the date on which the mark was first used at such exhibition in connection with such goods or services.<sup>65</sup> Where the certificate is in a language other the language of the application, the Registrar may require the applicant to furnish him within three months, with a translation of that certificate in the language of the application.<sup>66</sup>

These provisions, however, cannot have the effect of extending any other period of priority claimed by the applicant.<sup>67</sup>

##### 4.4.2 *Examination of Register*

Any person may examine the Register and may obtain certified extracts therefrom on payment of the prescribed fee.<sup>68</sup>

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<sup>62</sup> Code of Intellectual Property Act, *supra* s.108.

<sup>63</sup> *Gazette Extraordinary*, *supra* Reg. 25.

<sup>64</sup> Code of Intellectual Property Act, No. 52 of 1979, s.104(1).

<sup>65</sup> *Ibid.*, s.104(2).

<sup>66</sup> *Gazette Extraordinary*, *supra* Reg. 23.

<sup>67</sup> Code of Intellectual Property Act, *supra* s.104(3).

<sup>68</sup> *Ibid.*, s.111.

#### 4.4.3 *Associated Marks, Their Assignment and User*

Where application is made for the registration of a mark identical with or so closely resembling a mark of the applicant already on the register for the same goods or description of goods as to be likely to mislead or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that such marks shall be entered on the register as associated marks.<sup>69</sup>

Associated marks are assignable or transmissible only as a whole and not separately, but they must for all other purposes be deemed to have been registered as separate marks.<sup>70</sup> However, where under the provisions of the law the user of a registered mark is required to be proved for any purpose, the Registrar may, if and so far as is considered right, accept user of an associated registered mark, or of the mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.<sup>71</sup>

#### 4.4.4 *Alteration of Registered Mark*

The registered owner of any mark may apply in the prescribed manner to the Registrar for leave to add to or alter such mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of user as he may think fit. If leave be granted, the mark as altered must be published in the prescribed manner.<sup>72</sup>

The prescribed manner of application for alteration and the manner of publication of alteration if leave for alteration is granted are provided for by regulations.

Any application for alteration of a registered mark must be made in Form M6 set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979, signed by the applicant or his authorized agent and accompanied by the appropriate fee.<sup>73</sup>

Where the Registrar grants leave that registered mark or collective mark be added to or altered, the publication of such mark as altered must include a representation of the mark as added to or altered, the registration number, the name and address of the registered owner, the date of the registration, the date of the grant of the leave, the list of the goods or services in respect of which the mark has been registered with an indication of the corresponding class and the reference to the publication of the registration in the *Gazette*.<sup>74</sup>

<sup>69</sup> *Ibid.*, s.112.

<sup>70</sup> *Ibid.*, s.113.

<sup>71</sup> *Ibid.*, proviso to s.113.

<sup>72</sup> *Ibid.*, s.116.

<sup>73</sup> *Gazette Extraordinary*, *supra* Reg. 31.

<sup>74</sup> *Ibid.*, Reg. 32.

## 4.5 Duration of Registration

The general principle is that registration of a mark shall expire 10 years after the date of registration.<sup>75</sup>

A mark when registered must be registered as of the date of receipt by the Registrar of the application for registration and such date is deemed for the purposes of the law to be the date of registration.<sup>76</sup>

## 4.6 Renewal

Registration of a mark may be renewed for consecutive periods of 10 years each on payment of the prescribed fee. Renewal of registration of a mark is not subject to any further examination of the mark by the Registrar or to opposition by any person. The renewal fee must be paid within the 12 months preceding the date of expiration of the period of registration. However, a period of grace of six months is allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed. The Registrar must record in the register and cause to be published in the *Gazette* in the prescribed form all renewals of registration stating any elimination from the lists of goods or services. Where the renewal fee has not been paid within such period or such extended period, the Registrar is required to remove the mark from the register.<sup>77</sup>

It is, however, provided by regulation that the renewal of registration of a mark or collective mark can be made by the Registrar only upon a written request made in that behalf by the registered owner or his authorized agent and on payment of the prescribed fee.<sup>78</sup>

It is further provided that every renewal of registration of a mark or collective mark must be published in the *Gazette* in Form M5 set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979.<sup>79</sup>

## 4.7 Termination

### 4.7.1 Surrender

The registered owner of a mark may renounce the registration, either wholly or in respect of part of the goods or services for which the mark is registered, by a declaration in writing signed by him or on his behalf and submitted to the

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<sup>75</sup> Code of Intellectual Property Act, No. 52 of 1979, s.114(1).

<sup>76</sup> *Ibid.*, s.114(2).

<sup>77</sup> *Ibid.*, s.115.

<sup>78</sup> *Gazette Extraordinary*, *supra* Reg. 29.

<sup>79</sup> *Ibid.*, Reg. 30.

Registrar.<sup>80</sup> The Registrar must on receipt of the said declaration, record it in the Register and cause such record to be published in the *Gazette*.<sup>81</sup> The renunciation takes effect from the date that the Registrar receives the said declaration.<sup>82</sup>

Where a licence contract in respect of a mark is recorded in the Register, the Registrar cannot in the absence of a provision to the contrary in such licence contract, accept or record the said renunciation except upon receipt of a signed declaration by which any assignee, licensee or sub-licensee on record consents to the renunciation, unless his consent is expressly waived in the licence contract.<sup>83</sup>

#### 4.7.2 *Invalidation*

The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record is made a party, declare the registration of the mark null and void if its registration is precluded under the applicable provisions of law.<sup>84</sup> However, grounds of nullity which do not exist at the date of the application to Court are not taken into account.<sup>85</sup>

Where the grounds for nullity of registration of the mark exist in respect of only part of the goods or services for which the mark is registered, nullity of the registration is declared for that part only of such goods or services.<sup>86</sup> An application for a declaration of nullity based on any of the grounds specified by law must be made within five years from the date of registration of the mark.<sup>87</sup> Upon a final decision of the Court declaring total or partial nullity of registration of a mark, the registration is deemed to have been null and void totally or partially, as the case may be, from the date of such registration.<sup>88</sup> When a declaration of nullity becomes final, the Registrar of the Court must notify the Registrar who is required to record the declaration in the Register and cause it to be published in the *Gazette*.<sup>89</sup>

#### 4.7.3 *Removal*

There is explicit provision that the Court may on the application of any person showing a legitimate interest, or of any competent authority including the

<sup>80</sup> Code of Intellectual Property Act, No. 52 of 1979, s.129(1).

<sup>81</sup> *Ibid.*, s.129(2).

<sup>82</sup> *Ibid.*, s.129(3).

<sup>83</sup> *Ibid.*, s.129(4).

<sup>84</sup> See text at ff. 11, 12 and 16.

<sup>85</sup> Code of Intellectual Property Act No. 52 of 1979, s.130(1).

<sup>86</sup> *Ibid.*, s.130(2).

<sup>87</sup> *Ibid.*, s.130(3).

<sup>88</sup> *Ibid.*, s.131(1).

<sup>89</sup> *Ibid.*, s.131(2).



Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record is made a party, remove any registered mark from the Register:

- (a) if the registered owner has, without valid grounds, failed to use the mark within Sri Lanka or cause it to be used within Sri Lanka by virtue of a licence, during five consecutive years immediately preceding the date of the application to Court;
- (b) if the registered owner has caused, provoked or tolerated the transformation of the mark into a generic name for one or more of the goods or services in respect of which the mark is registered so that in trade circles and in the eyes of the public its significance as a mark has been lost.<sup>90</sup>

In any such application the Court may take into account the fact that non-use of the mark was due to circumstances beyond the control of the registered owner. The Court is not empowered to take into account the lack of funds of the registered owner as a ground for non-use of the mark.<sup>91</sup>

There is further provision that the use of a mark:

- (a) in a form differing, in elements which do not alter the distinctive character of the mark, from the form in which it was registered is not a ground for removal of the mark;
- (b) in connection with one or more of the goods or services belonging to any given class in respect of which the mark is registered, will suffice to prevent the removal of the mark in respect of all the other goods or services of the same class.<sup>92</sup>

Finally, upon a final decision of the Court removing any registered mark from the Register:

- (1) the Court may, taking into account the date of events and other circumstances which occasion the removal of the mark, determine the date on which the registration of the mark is deemed to have ceased to have any legal effect;
- (2) the Registrar of the Court must communicate the decision of the Court to the Registrar who will, if the Court decides that the mark be removed, enter in the Register a record of such removal cause the decision of the Court to be published in the *Gazette*.<sup>93</sup>

<sup>90</sup> *Ibid.*, s.132(1).

<sup>91</sup> *Ibid.*, s.132(2).

<sup>92</sup> *Ibid.*, s.132(3).

<sup>93</sup> *Ibid.*, s.133.

## 4.8 Scope of Protection

### (a) *Rights of the Registered Owner*

The general principle is that the registered owner of a mark has the following exclusive rights in relation to the mark: (a) to use the mark; (b) to assign or transmit the registration of the mark; (c) to conclude licence contracts.<sup>94</sup>

Without the consent of the registered owner of the mark, third parties are precluded from the following acts:

- (a) any use of the mark, or of a sign resembling it, in such a way as to be likely to mislead the public, for goods or services in respect of which the mark is registered, or for other goods or services in connection with which the use of the mark or sign is likely to mislead the public; and
- (b) any other use of the mark, or of a sign or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interests of the registered owner of the mark.<sup>95</sup>

### (b) *Limitation of the Registered Owner's Rights*

The registration of the mark does not confer on its registered owner the right to preclude third parties:

- (a) from using bona fide their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production or of supply of their goods and 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 public as to the source of the goods or services;
- (b) from using the mark in relation to goods lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka under that mark, provided that such goods have not undergone any change.<sup>96</sup>

## 4.9 Assignment and Transmission of Application and Registration

An application for registration or the registration of a mark may be assigned or transmitted independently of the transfer of all or part of the enterprise using the mark, in respect of all or part of the goods or services for which the application was filed or the mark registered.<sup>97</sup>

<sup>94</sup> Code of Intellectual Property Act, No. 52 of 1979, s.117(1).

<sup>95</sup> *Ibid.*, s.117(2).

<sup>96</sup> *Ibid.*, s.118.

<sup>97</sup> *Ibid.*, s.119(1).

Such assignment or transmission is invalid if the purpose or effect thereof is to mislead the public, in particular in respect of the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark is applied.<sup>98</sup>

Any person becoming entitled by assignment or transmission to an application for registration or the registration of a mark may apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the Register.<sup>99</sup>

Any application to the Registrar requesting him to record in the Register of Marks the assignment or transmission of an application for registration, or the registration of a mark or collective mark shall be made in Form M7 set out in the Third Schedule of the *Gazette Extraordinary* No.60/20 of 13-10-1979. It shall be signed by the assignee or transferee and must be forwarded to the Registrar together with the fee. The Registrar must then record such assignment or transmission in the Register of Marks.<sup>100</sup>

No such assignment or transmission can be recorded in the Register unless (a) the prescribed fee has been paid to the Registrar; (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.<sup>101</sup>

No such assignment or transmission has effect against third parties unless so recorded in the Register.<sup>102</sup>

#### 4.10 Licensing

A licence contract in this context is declared to mean any contract by which the registered owner of a mark (“the licensor”) grants to another person or enterprise (“the licensee”) a licence to use the mark for all or part of the goods or services in respect of which the mark is registered.<sup>103</sup>

Use of the mark by the licensee is deemed to be use of the mark by the registered owner.<sup>104</sup>

With regard to the form and record of the licence contract the governing provision is that a licence contract must be in writing signed by or on behalf of the contracting parties.<sup>105</sup>

<sup>98</sup> *Ibid.*, s.119(2).

<sup>99</sup> *Ibid.*, s.119(3).

<sup>100</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg. 33.

<sup>101</sup> Code of Intellectual Property Act, *supra* s.119(4).

<sup>102</sup> *Ibid.*, s.119(5).

<sup>103</sup> *Ibid.*, s.120(1).

<sup>104</sup> *Ibid.*, s.120(2).

<sup>105</sup> *Ibid.*, s.121(1).

Upon a request in writing signed by or on behalf of the contracting parties, the Registrar must, on payment of the prescribed fee, record in the Register such particulars relating to the contract as the parties thereto might wish to have recorded.<sup>106</sup> However, the parties are not required to disclose or have recorded any other particulars relating to the said contract.<sup>107</sup>

The rights of the licensee are next provided for. In the absence of any provision to the contrary in the licence contract, the licensee must (a) be entitled to use the mark within the whole geographical area of Sri Lanka, during the whole period of registration of the mark, including renewals, in respect of all the goods or services for which the mark is registered; (b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.<sup>108</sup> These provisions apply, *mutatis mutandis*, to assignments and sub-licences.<sup>109</sup>

The rights of the licensor are reciprocally defined. In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same mark or himself use the mark.<sup>110</sup> Where the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor cannot grant further licences to third parties in respect of the same mark or himself use the mark.<sup>111</sup>

A licence contract is null and void in the absence of stipulations ensuring effective control by the licensor of the quality of the goods or services in respect of which the mark may be used.<sup>112</sup> Any clause or condition in a licence contract is declared to be null and void in so far as it imposes upon the licensee restrictions not derived from the rights conferred by the law on the registered owner of the mark, or unnecessary for the safeguarding of such rights.<sup>113</sup>

It is expressly declared, however, that (a) restrictions concerning the scope, extent, duration of use of the mark or the geographical area in or the quality or quantity of the goods or services in connection with which the mark may be used; (b) restrictions justified by the above stipulations; and (c) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the mark, are not deemed to constitute such restrictions.<sup>114</sup>

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<sup>106</sup> *Ibid.*, s.121(2).

<sup>107</sup> *Ibid.*, proviso to s.121(2).

<sup>108</sup> *Ibid.*, s.122(1).

<sup>109</sup> *Ibid.*, s.122(2).

<sup>110</sup> *Ibid.*, s.123(1).

<sup>111</sup> *Ibid.*, s.123(2).

<sup>112</sup> *Ibid.*, s.124(1).

<sup>113</sup> *Ibid.*, s.124(2).

<sup>114</sup> *Ibid.*, proviso to s.124(2).

Cancellation of licence contracts is the subject of separate provision in keeping with our law. The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, annul and cancel the said contract if (a) the licensor has lost effective control over the quality of the goods or services in respect of which the mark is used; (b) the licensee has used the mark in such a way as to mislead or confuse the public.<sup>115</sup>

There is also provision with regard to licence contracts involving payments abroad. The provision here is to the effect that where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof (a) which involves the payment of royalties abroad; or (b) which by reason of other circumstances relating to such licence contract, is detrimental to the economic development of Sri Lanka, he shall, in writing, communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.<sup>116</sup>

Moreover, where the Governor of the Central Bank, on receipt of any such communication, informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka, the Registrar must cancel and invalidate the record of such contract in the Register.<sup>117</sup>

The effect of nullity of registration on a licence contract is the subject of a separate provision. Where, before the expiration of the licence contract, the registration is declared null and void the licensee can no longer be required to make any payment to the licensor under the licence contract, and is entitled to repayment of the payments already made.<sup>118</sup> However, the licensor is not required to make any repayment, or is required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.<sup>119</sup>

On the subject of expiry, termination or invalidation of licence contracts, our law provides that the Registrar must

- (a) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the Register upon a request in writing to that effect signed by or on behalf of the parties thereto;

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<sup>115</sup> *Ibid.*, s.125.

<sup>116</sup> *Ibid.*, s.126(1).

<sup>117</sup> *Ibid.*, s.126(2).

<sup>118</sup> *Ibid.*, s. 127(1).

<sup>119</sup> *Ibid.*, proviso to s.127(1).

- (b) record in the Register the expiry, termination, annulment or invalidation of a licence contract under any provision of the law.<sup>120</sup>

## 4.11 Collective Marks

### 4.11.1 Introduction

The Code of Intellectual Property Act provides that a number of provisions relating to marks<sup>121</sup> are to apply without any change to collective marks while some others are to apply *mutatis mutandis* to collective marks.<sup>122</sup> Into the former category fall provisions relating to requirements of application,<sup>123</sup> alteration of registered mark,<sup>124</sup> limitation placed on a registered owner's rights,<sup>125</sup> assignment and transmission of applications and registrations,<sup>126</sup> renunciation and nullity of registration<sup>127</sup> and removal of a mark.<sup>128</sup> Into the latter category fall provisions relating to rights of a registered owner of a mark,<sup>129</sup> licence contracts.<sup>130</sup>

A few provisions of the Code deal exclusively with collective marks.<sup>131</sup>

### 4.11.2 Special Provisions Relating to Collective Marks

#### (a) Application and Registration

An application for registration of a collective mark cannot be filed unless in the application the mark is designated as a collective mark and unless the application is accompanied by a copy of the conditions governing the use of the mark duly certified by the applicant.<sup>132</sup> The conditions must define the common characteristics or quality of the goods or services which the collective mark designates and the conditions in which and the person by whom it may be used. They must also provide for the exercise of effective control of the use of the mark and must specify proper sanctions for the use of the mark contrary to the conditions.<sup>133</sup>

<sup>120</sup> *Ibid.*, s.128.

<sup>121</sup> *Ibid.*, s.133.

<sup>122</sup> *Ibid.*, s.138.

<sup>123</sup> *Ibid.*, s.102, see text at f.n. 20 to 27.

<sup>124</sup> *Ibid.*, s.116, see text at f.n. 72.

<sup>125</sup> *Ibid.*, s.118, see text at f.n. 96.

<sup>126</sup> *Ibid.*, s.119, see text at f.n. 97 to 102.

<sup>127</sup> *Ibid.*, Chapter XXVI, see text at f.n. 80 to 89.

<sup>128</sup> *Ibid.*, Chapter XXVII, see text at f.n. 90 to 93.

<sup>129</sup> *Ibid.*, Chapter XXIII, see text at f.n. 94 to 96.

<sup>130</sup> *Ibid.*, Chapter XXV, see text at f.n. 103 to 120.

<sup>131</sup> *Ibid.*, s.135 to s.137.

<sup>132</sup> *Ibid.*, s.135(1).

<sup>133</sup> *Ibid.*, s.135(2).

The publication of an application for a collective mark in accordance with the applicable law<sup>134</sup> must include a summary of the conditions to be appended to the registration.<sup>135</sup>

Registration of a collective mark must be in such part of the Register as the

Registrar may decide and a copy of the conditions governing the use of the mark must be appended to the registration.<sup>136</sup> Once so registered, it is deemed in all respects to be a registered mark.<sup>137</sup>

*(b) Changes in Conditions Governing Use of Collective Marks*

The registered owner of a collective mark must notify the Registrar in Form M8 set out in the Third Schedule to the *Gazette Extraordinary* No. 60/20 of 31-10-1979 of any changes effected in the conditions governing the use of the mark.<sup>138</sup> Any notification of such change must be recorded in the Register on payment of the prescribed fee. Any change in the conditions will be effectual only if they have been so recorded.<sup>139</sup> The Registrar must cause to be published in the *Gazette* a summary of the changes so recorded in the Register.<sup>140</sup>

## 4.12 Trade Names

*(a) Protection of Trade Names*

Notwithstanding the provisions of any written law providing for the registration of a trade name, such name will be protected, even prior to or without registration, against any unlawful act committed by a third party.<sup>141</sup> Any subsequent use of a trade name, trade mark, service mark or collective mark likely to mislead the public is deemed unlawful.<sup>142</sup> It must be noted, however, that the limitations applicable to the rights of a registered owner<sup>143</sup> of a mark apply to trade names as well.<sup>144</sup>

*(b) Prohibited Trade Names*

A name or designation is not admissible as a trade name if, by reason of its nature or the uses to which it may be put, it is contrary to morality or public order or is likely to offend the religious or racial susceptibilities of any community or is

<sup>134</sup> *Ibid.*, s.107(9), see text at f.n. 49.

<sup>135</sup> *Ibid.*, s.136(2).

<sup>136</sup> *Ibid.*, s.136(1).

<sup>137</sup> *Ibid.*, s.136(3).

<sup>138</sup> *Ibid.*, s.137(1) read with Regulation 34 of *Gazette Extraordinary*, *supra*.

<sup>139</sup> Code of Intellectual Property Act, *supra* s.137(1).

<sup>140</sup> *Ibid.*, s.137(2).

<sup>141</sup> *Ibid.*, s.140(1).

<sup>142</sup> *Ibid.*, s.140(2).

<sup>143</sup> *Ibid.*, s.118, see text at f.n. 96.

<sup>144</sup> *Ibid.*, s. 140(3).

likely to mislead trade circles or the public as to the nature of the enterprise identified by that name.<sup>145</sup>

(c) *Assignment and Transmission of Trade Names*

A trade name may be assigned or transmitted together with the assignment or transmission of the enterprise or part of the enterprise identified by that name. The provisions relating to assignment and transmission of applications and registrations of marks<sup>146</sup> apply *mutatis mutandis* to trade names.<sup>147</sup>

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<sup>145</sup> *Ibid.*, s.139.

<sup>146</sup> *Ibid.*, s.119, see text at f.n. 97 to 102.

<sup>147</sup> *Ibid.*, s.141.













## CHAPTER 5

# INDUSTRIAL DESIGNS

### SYNOPSIS

5.1 Introduction

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5.3 Conditions for Protection

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## 5.1 Introduction

The gist of an industrial design is the importing of some element of beauty to an every-day article. In the era prior to the use of conveyor-belt systems in industry articles were produced industrially so that the attractiveness and appeal of the article to the user was as much an element of the manufacturer's pre-occupation as the practical utility of the article produced. This began to change when appreciably enhanced sophistication in techniques of industry and manufacture made necessary the production of much larger numbers of industrial goods, quite often by mechanical processes. In such an environment the usual attractiveness of the goods was recognized as a factor which had an important bearing on profitability. Accordingly, manufacturers today are eager to ensure that the goods they produce appeal to the consuming public so that the demand for the goods would be optimal. Industrial design, therefore, is of great importance today in relation to the attractiveness of goods to the consumer.

## 5.2 The Nature of Industrial Designs

An industrial design is concerned with the ornamental or aesthetic aspect of an article designed for pragmatic use. The ornamental aspect is one which must be judged by reference to usual appeal. This would consist of such elements as shape, configuration and colour but does not include a method or principle of construction.

The statute law of Sri Lanka contains an explicit definition of "industrial design." Any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, that gives a special appearance to a product of industry or handicraft and is capable of serving as a pattern for a product of industry or handicraft is deemed to be an industrial design. However, anything in an industrial design which serves solely to obtain a technical result does not qualify for protection under the law of industrial design.<sup>1</sup> There may be features of an article which bear no relationship to the utility of an article at all, but which are intended to add to its attractiveness. Examples would be ornamental work done on furniture or glassware. On the other hand, there may be often features of articles which, while increasing the functional utility of the article, also serve the purpose of rendering the article more attractive to the public.

In either of these cases the law of industrial design could legitimately provide a measure of protection. On the other hand, if the feature pertains entirely to the practical utility of the article, the law of industrial designs is altogether irrelevant as a vehicle of protection.

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<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s. 27.



A salient feature of the protection conferred by industrial designs is that this protection supplements and does not derogate from other protection provided under any other written law.<sup>2</sup>

The basic essentials of protection are stipulated as follows:

- (i) The protective legal regime applies only to new industrial designs.<sup>3</sup>
- (ii) The protection conferred by law is available only within limits demarcated by public policy. Thus, the protection does not apply to an industrial design which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious or racial susceptibilities of any community.<sup>4</sup>

### 5.3 Conditions for Protection

The precondition for the protection of an industrial design is that it be novel. In other words, that it has not been previously disclosed and that it is not similar to previous designs.

Novelty is an essential part of the rationale of protection offered by the law of industrial design. A new industrial design is declared to mean an industrial design which had not been made available to the public anywhere and at any time whatsoever through description, use or in any other manner before the date of an application for registration of such industrial design or before the priority date alidly claimed in respect thereof.<sup>5</sup>

On the subject of prior disclosures, the law of Sri Lanka contains clear provision that an industrial design is not deemed to have been made available to the public solely by reason of the fact that, within the period of six months preceding the filing of an application for registration, it had appeared in an official or officially recognized international exhibition.<sup>6</sup>

Similarity to previous designs is also dealt with specifically. An industrial design is not considered a new industrial design 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.<sup>7</sup>

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<sup>2</sup> *Ibid.*, s.25.

<sup>3</sup> *Ibid.*, s.26(1).

<sup>4</sup> *Ibid.*, s.26(2).

<sup>5</sup> *Ibid.*, s.28(1).

<sup>6</sup> *Ibid.*, s.28(2).

<sup>7</sup> *Ibid.*, s.28(3).

## 5.4 Registration of Industrial Designs

### 5.4.1 Rights to Legal Protection

The right to obtain protection of an industrial design belongs to its owner.<sup>8</sup> The owner of an industrial design is in general its creator or his successor in title.<sup>9</sup>

Where two or more persons have jointly created an industrial design, the right to obtain protection belongs to them jointly. A person who has merely assisted in the creation of an industrial design but has made no contribution of a creative nature is not deemed to be the creator or a co-creator of such industrial design.<sup>10</sup> The person who makes the first application for the registration of an industrial design or the person who first validly claims the earliest priority for his application is deemed to be the creator of such industrial design.<sup>11</sup>

In circumstances involving usurpation, judicial assignment of the application or registration is provided for. Where the essential elements of an industrial design, the subject of an application or registration, have been unlawfully derived from an industrial design for which the right to protection belongs to another person, such other person may apply to Court for an order that the application or registration be assigned to him.<sup>12</sup> Where, however, after an application for the registration of an industrial design has been filed, the person to whom the right to protection belongs gives his consent to the filing of the application, such consent, for all purposes, is deemed to have been effective from the date of filing of such application.<sup>13</sup>

Special provision is made in respect of an industrial design created by an employee or pursuant to a commission.

In the absence of any provision to the contrary in any contract of employment or for the execution of work, the ownership of an industrial design created in the performance of such contract or in the execution of such work is deemed to accrue to the employer, or the person who commissioned the work, as the case may be.<sup>14</sup> However, 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 or for the execution of work, as the case may be, the creator is entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.<sup>15</sup>

<sup>8</sup> *Ibid.*, s.29(1).

<sup>9</sup> *Ibid.*, s.29(2).

<sup>10</sup> *Ibid.*, s.29(3).

<sup>11</sup> Code of Intellectual Property Act, No. 52 of 1979, s.29(4).

<sup>12</sup> *Ibid.*, s.30.

<sup>13</sup> *Ibid.*, proviso to s.30.

<sup>14</sup> *Ibid.*, s.31(1).

<sup>15</sup> *Ibid.*, proviso to s.31(1).

Where an employee whose contract of employment does not require him to engage in any creative activity creates, in the field of activities of his employer, an industrial design using data or means placed at his disposal by his employer, the ownership of such industrial design accrues to the employer in the absence of any provision to the contrary in the contract of employment.<sup>16</sup> However, the employee is entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the industrial design and any benefit derived from it by the employer.<sup>17</sup>

The rights conferred on the creator of an industrial design by these provisions cannot be restricted by contract.<sup>18</sup>

The naming of the creator of an industrial design is the subject of separate provision.

The creator of an industrial design is named as such in the registration, unless by a declaration in writing signed by him or on his behalf and submitted to the Registrar, he indicates that he does not wish to be so named.<sup>19</sup> This principle cannot be modified by the terms of any contract.<sup>20</sup>

#### 5.4.2 *Registration Procedure*

##### (a) *Applications*

The requirements of an application and the procedure for registration are provided for in detail. An application for registration of an industrial design must be made to the Registrar in the prescribed form and is required to contain:

- (a) a request for registration of the industrial design;
- (b) the name, address and description of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka;
- (c) a specimen of the article embodying the industrial design or copies of a photographic or graphic representation of the industrial design, in colour where it is in colour, or drawings and tracings of the design;
- (d) an indication of the kind of products for which the industrial design is to be used and, where the regulations make provision for classification, an indication of the class or classes in which such products are included;
- (e) a declaration by the applicant that the industrial design is new to the best of his knowledge.<sup>21</sup>

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<sup>16</sup> *Ibid.*, s. 31(2).

<sup>17</sup> *Ibid.*, proviso to s.31(2).

<sup>18</sup> *Ibid.*, s.31(3).

<sup>19</sup> *Ibid.*, s.32(1).

<sup>20</sup> *Ibid.*, s.32(2).

<sup>21</sup> Code of Intellectual Property Act, No. 52 of 1979, s.35.

The application for registration may be accompanied by a declaration signed by the creator of the industrial design, giving his name and address and requesting that he be mentioned as such in the registration.<sup>22</sup> Where the applicant is not the creator of the industrial design, the application must be accompanied by a statement justifying the applicant's right to obtain registration.<sup>23</sup> The Registrar is under a duty to send a copy of this statement to the creator of the industrial design who has the right to inspect the application and to receive, on payment of the prescribed fee, a copy thereof.<sup>24</sup> Where the application is filed through an agent, it be accompanied by a power of attorney granted to such agent by the applicant.<sup>25</sup> Legalization or certification of the applicant's signature is, however, not necessary.<sup>26</sup> An application may be made for the registration of any number of industrial designs not exceeding 50, provided that they are of the same class or kind.<sup>27</sup>

Details pertaining to the applications for registration are provided for by the regulations.

The application or the registration of one or more industrial designs is required to be made in Form DI set out in the First Schedule of *Gazette Extraordinary* No.60/20 of 31-10-1979 and must be signed by the applicant or his authorized agent.<sup>28</sup>

The application must be accompanied in respect of each industrial design by either one specimen or by the following:

- (i) If the industrial design is two-dimensional, by one photograph, graphic or photographic representation or one drawing or tracing:
- (ii). If the industrial design is three-dimensional, by two photographic representations or two drawings or tracings, each showing a different aspect of the industrial design.<sup>29</sup>

Each specimen must be of a size not exceeding 20 centimeters × 20 centimeters.<sup>30</sup> No photographic or graphic representation, drawing or tracing of the industrial design shall exceed 10 centimeters × 20 centimeters. Where there are one or two of such representations, drawings or tracings, they may be affixed on one sheet of paper of A4 size. Photographic and graphic representations may be in colour. Drawings and tracings must be in black ink.<sup>31</sup>

<sup>22</sup> *Ibid.*, s.23(2).

<sup>23</sup> *Ibid.*, s.33(3).

<sup>24</sup> *Ibid.*, s.33(4).

<sup>25</sup> *Ibid.*, s.33(5).

<sup>26</sup> *Ibid.*, proviso to s.33(5).

<sup>27</sup> *Ibid.*, s.33(6).

<sup>28</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Intellectual Property Reg. No. 2.

<sup>29</sup> *Gazette Extraordinary*, *supra* Reg. 3.

<sup>30</sup> *Ibid.*, Reg. 4.

<sup>31</sup> *Ibid.*, Reg. 5.

The indication of the kind of products for which industrial designs are to be used must be the same for all the industrial designs to which the application relates.<sup>32</sup>

The date of the application is the date of its receipt in the Registry, provided that where the fee in respect of such application is received on a date later than the date of receipt of the application, then that later date is deemed to be the date of the application.<sup>33</sup>

The right of priority is provided for by express legislative provisions.

The applicant for registration of an industrial design who wishes to avail himself of the priority of an earlier application filed in a convention country must, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in which he or his predecessor in title had made such application and must within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.<sup>34</sup>

The regulations cater for matters connected with the translation of earlier applications. Where the earlier application referred to in the declaration claiming priority is in a language other than the language of the application for the registration of the industrial design in Sri Lanka, the Registrar may require the applicant to furnish him within three months with a translation of the earlier application in the language of the application for the registration of the industrial design in Sri Lanka.<sup>35</sup>

With regard to the application fee, an application for registration of an industrial design is not entertained unless the prescribed fee has been paid to the Registrar.<sup>36</sup> The fees specified in Column II of the Second Schedule of *Gazette Extraordinary* No. 60/20 of 1979 are payable in respect of the matters specified in the corresponding entry in Column I of that Schedule.<sup>37</sup>

#### (b) Examination

Examination of the application by the Registrar is separately provided for. The Registrar is required to examine whether the application for registration

<sup>32</sup> *Ibid.*, Reg. 6.

<sup>33</sup> *Ibid.*, Reg. 7.

<sup>34</sup> Code of Intellectual Property Act, *supra* s.34.

<sup>35</sup> *Gazette Extraordinary*, *supra* Reg. 8.

<sup>36</sup> Code of Intellectual Property Act, *supra* s.35.

<sup>37</sup> *Gazette Extraordinary*, *supra* Reg. 14.

complies with the mandatory requirements<sup>38</sup> of the law.<sup>39</sup> If the application does not comply with these requisites,<sup>40</sup> the Registrar must refuse registration of the industrial design.<sup>41</sup> However, the Registrar must first notify the applicant of any defect in the application and must afford him an opportunity to remedy such defect within three months from the date of receipt of such notification.<sup>42</sup> Where the application does not comply with the law<sup>43</sup> the Registrar must not, in connection with the registration of the industrial design, make any reference to the priority claimed.<sup>44</sup> Where the application complies substantially with applicable law,<sup>45</sup> the Registrar must in connection with the registration of the industrial design, record the priority claimed.<sup>46</sup> Where the Registrar refuses to register an industrial design, he must, if required by the applicant, state in writing the grounds of his decision.<sup>47</sup>

(c) *Registration*

Upon the registration of an industrial design, the Registrar must issue to the registered owner a certificate of registration and must, at the request of the registered owner, send such certificate to him by registered post at his last recorded postal address in Sri Lanka or, if he is resident outside Sri Lanka, to his last recorded postal address for service in Sri Lanka.<sup>48</sup>

The Registrar must keep and maintain a register called the Register of Industrial Designs wherein shall be recorded in the order of their registration, all registered industrial designs and such other particulars relating to industrial designs as are authorized or directed to be so recorded or may from time to time be prescribed.<sup>49</sup>

The registration of an industrial design is required to include a representation of the industrial design and must specify its number, the name and address of the registered owner and, if the registered owner is resident outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and registration; if priority is validly claimed, an indication of that fact and the number, date and

<sup>38</sup> Code of Intellectual Property Act, ss.26(2), 33, 34 (where applicable) and 35. For these provisions, see text at fn. 4, 21 to 26, 34 and 36, respectively.

<sup>39</sup> *Ibid.*, s.36(1).

<sup>40</sup> See note 38 *supra*.

<sup>41</sup> Code of Intellectual Property Act, *supra* s.36(2).

<sup>42</sup> *Ibid.*, proviso to s.36(2).

<sup>43</sup> *Ibid.*, s.34, see text at note 34.

<sup>44</sup> *Ibid.*, s.36(3).

<sup>45</sup> See text at note 43.

<sup>46</sup> *Ibid.*, *supra* s. 36(4).

<sup>47</sup> *Ibid.*, s.36(5).

<sup>48</sup> *Ibid.*, s.38.

<sup>49</sup> *Ibid.*, s.39(1).

country of the application on the basis of which the priority is claimed; the kinds and classes of products and the name and address of the creator of the industrial design, if he has requested that he be mentioned as such in the registration.<sup>50</sup>

Further requirements relating to the Register of Industrial Designs are contained in the Regulations. In addition to the particulars referred to or specified, the following particulars must also be recorded in respect of each registered industrial design; (a) the number of the application; (b) the name and address of any authorized date and number of the *Gazette* in which the registration was published; (c) any change in the address of the registered owner of the registration.<sup>51</sup>

The principle relating to access on the part of the public to the Register and to the certified copies receives emphasis. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.<sup>52</sup>

Publication of registered industrial designs is a mandatory requirement. The Registrar must cause to be published in the *Gazette*, in the prescribed form, all registered industrial designs in the order of their registration, including in respect of each industrial design so published, a reference to such particulars as may be prescribed.<sup>53</sup>

## 5.5 Scope of Exclusive Rights

Subject and without prejudice to other provisions of the law, the registered owner of an industrial design has the following exclusive rights in relation to the industrial design: to reproduce and embody such industrial design in making a product; to import, offer for sale, sell or use a product embodying such industrial design, to stock, for the purpose of offering for sale, selling or using, a product embodying such industrial design, to assign or transmit the registration of the industrial design, to conclude licence contracts.<sup>54</sup> No person is permitted to do any of the acts referred to above without the consent of the registered owner of the industrial design.<sup>55</sup>

These acts, if done by any unauthorized person, will not be lawful solely by reason of the fact that the reproduction of the registered industrial design differs from the registered industrial design in minor respects or that the reproduction of the registered industrial design is embodied in a type of product different from a product embodying the registered industrial design.<sup>56</sup>

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<sup>50</sup> *Ibid.*, s.39(2).

<sup>51</sup> *Gazette Extraordinary*, *supra* Reg. 9.

<sup>52</sup> Code of Intellectual Property Act *supra* s. 40.

<sup>53</sup> *Ibid.*, s.41.

<sup>54</sup> *Ibid.*, s.44(1).

<sup>55</sup> *Ibid.*, s.44(2).

<sup>56</sup> *Ibid.*, s.44(3).

## 5.6 Duration of Protection

Without prejudice to other provisions of the law, registration of an industrial design expires five years after the date of receipt of the application for registration.<sup>57</sup>

Renewal is the subject of a separate provision. Registration of an industrial design may be renewed for two consecutive periods of five years each on payment of the prescribed fee.<sup>58</sup> The renewal fee must be paid within the 12 months preceding the date of expiration of the period of registration.<sup>59</sup> However, a period of grace of six months is allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed.<sup>60</sup>

The registration of an industrial design may be renewed by the Registrar upon a written request made in that behalf by the registered owner or his authorized agent on payment of the prescribed fee.<sup>61</sup>

Every renewal of a registration of an industrial design must be published in the *Gazette* in Form D2 set out in the First Schedule of the *Gazette Extraordinary* No. 60/20 of 31-10-1979.<sup>62</sup>

The Registrar must record in the register and cause to be published in the *Gazette* in the prescribed form all renewals of registration.<sup>63</sup> Where the renewal fee has not been paid within such period or such extended period, the Registrar must remove the registration of the industrial design from the Register.<sup>64</sup>

## 5.7 Rights Conferred by Registration

The major protection conferred is, of course, protection against infringement of the registered industrial design. The Sri Lankan Code contains provision that any person who wilfully infringes the rights of any registered owner, assignee or licensee of an industrial design is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.<sup>65</sup>

<sup>57</sup> *Ibid.*, s.42.

<sup>58</sup> *Ibid.*, s.43(1).

<sup>59</sup> *Ibid.*, s.43(2).

<sup>60</sup> *Ibid.*, proviso to s.43(2).

<sup>61</sup> *Gazette Extraordinary, supra* Reg. 11.

<sup>62</sup> *Ibid.*, Reg. 12.

<sup>63</sup> Code of Intellectual Property Act, No. 52 of 1979 s.43(3).

<sup>64</sup> *Ibid.*, s.43(4).

<sup>65</sup> *Ibid.*, s.145.



False representations regarding industrial designs also attract penal provisions. Any person who, for industrial or commercial purposes, makes a representation with respect to an industrial design to the effect that it is a registered industrial design; to the effect that a registered industrial design is registered in respect of any products in respect of which it is not registered; or to the effect that the registration of an industrial design gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the Register, the registration does not give that right, is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.<sup>66</sup>

A person is deemed to represent that an industrial design is registered if he uses in connection with the industrial design the word “registered,” or any word or words expressing or implying that registration has been obtained for the industrial design.<sup>67</sup>

Limitation of the rights accruing to the registered owner is the subject of a separate provision. The legal provisions recognizing exclusive rights in relation to industrial designs extend only to acts done for industrial or commercial purposes, and do not preclude third parties from doing any of the acts referred to therein in respect of a product embodying the registered industrial design after the said product has been lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka.<sup>68</sup>

## 5.8 Assignment

An application for registration of an industrial design is capable of being assigned or transmitted.<sup>69</sup>

The format in which an application for assignment or transmission is required to be made is governed by regulations. Any application under the Code to the Registrar requesting him to record in the Register of Industrial Designs the assignment or transmission of an application for registration, or the registration of any industrial design or designs must be made in Form D3 set out in the First Schedule of the *Gazette Extraordinary* No. 60/20 of 31-10-1979. It must be signed by the assignee or transferee and must be forwarded to the Registrar together with the fee. Where these provisions have been complied with, the Registrar must record such assignment or transmission in the Register of Industrial Designs.<sup>70</sup>

<sup>66</sup> *Ibid.*, s.146(1).

<sup>67</sup> *Ibid.*, s.146(2).

<sup>68</sup> *Ibid.*, s.45.

<sup>69</sup> *Ibid.*, s.46(1).

<sup>70</sup> *Gazette Extraordinary* No. 60/20 of 31-10-1979, Reg.

Any person becoming entitled by assignment or transmission to an application for registration or the registration of an industrial design is entitled to apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the Register.<sup>71</sup>

The conditions subject to which assignment or transmission is legally permissible are specified by statutory provision.

No such assignment or transmission can be recorded in the register unless (a) the prescribed fee has been paid to the Registrar; (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.<sup>72</sup>

With regard to the impact of such assignment or transmission on the rights of third parties, there is explicit provision that no assignment or transmission has effect against third parties unless it is recorded in the Register.<sup>73</sup>

Separate provision is made in respect of joint ownership of applications and registration. In the absence of any agreement to the contrary between the parties, joint owners of an application for registration or the registration of an industrial design may, separately, assign or transmit their rights in the application or registration, use the industrial design and exercise the relevant exclusive rights but may only jointly withdraw the application, renounce the registration or conclude a licence contract.<sup>74</sup>

## 5.9 Licensing

A licence contract in this context is referred to as meaning any contract by which the registered owner of an industrial design (“the licensor”) grants to another person or enterprise (“the licensee”) a licence to exercise exclusive rights.<sup>75</sup>

Provision is made in regard to the form and record of a licence contract.

A licence contract must be in writing signed by or on behalf of the contracting parties.<sup>76</sup> Upon a request in writing signed by or on behalf of the contracting parties, the Registrar must, on payment of the prescribed fee, record in the Register such particulars relating to the contract as the parties thereto might wish to have recorded.<sup>77</sup> There is, however, the proviso that the parties are not

<sup>71</sup> Code of Intellectual Property Act, *supra* s.46(2).

<sup>72</sup> *Ibid.*, s.46(3).

<sup>73</sup> *Ibid.*, s.46(4).

<sup>74</sup> *Ibid.*, s.47.

<sup>75</sup> *Ibid.*, s.48.

<sup>76</sup> *Ibid.*, s.49(1).

<sup>77</sup> *Ibid.*, s.49(2).

required to disclose or have recorded any other particulars relating to the licence contract.<sup>78</sup>

The rights of the licensor and of the licensee are next provided for.

With regard to the former, the provision applicable is the following: In the absence of any provision to the contrary in the licence contract, the licensee is (a) entitled to exercise exclusive rights within the whole geographical area of Sri Lanka, during the whole period of registration of the industrial design, including renewals, and through any application of the industrial design; (b) not entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.<sup>79</sup> The provisions of this Chapter of the Act apply, *mutatis mutandis*, to assignments and sub-licences.<sup>80</sup>

As for the rights of the licensor, it is declared that in the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same industrial design or himself exercise exclusive rights.<sup>81</sup> Where the licence contract provides that the licence is exclusive, and unless it is expressly provided that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor is not empowered to grant further licences to third parties in respect of the same industrial design or himself exercise exclusive rights.<sup>82</sup>

Invalid clauses in a licence contract is the subject of explicit statutory provision. Any clause or condition in a licence contract is declared to be null and void in so far as it imposes upon the licensee, in the industrial or commercial field, restrictions not derived from the rights conferred by legislation on the registered owner of an industrial design, or are unnecessary for the safeguarding of such rights.<sup>83</sup> The proviso is added that (a) restrictions concerning the scope, extent, or duration of use of the industrial design, or the geographical area in or the quality or quantity of the products in connection with which the industrial design may be used, and (b) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the industrial design shall not be deemed to constitute such restrictions.<sup>84</sup>

There follows a provision with regard to the effect of nullity of registration of a licence contract. Where, before the expiration of the licence contract, the registration is declared null and void the licensee is no longer required to

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<sup>78</sup> *Ibid.*, proviso to s.49(2).

<sup>79</sup> *Ibid.*, s.50(1).

<sup>80</sup> *Ibid.*, s.50(2).

<sup>81</sup> *Ibid.*, s.51(1).

<sup>82</sup> *Ibid.*, s.51(2).

<sup>83</sup> *Ibid.*, s.52

<sup>84</sup> *Ibid.*, proviso to s.52.

make any payment to the licensor under the licence contract and is entitled to repayment of the payments already made.<sup>85</sup> However, the licensor is not required to make any repayment, or is required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular, if the licensee has effectively profited from the licence.<sup>86</sup>

On the subject of expiry, termination or invalidation of a licence contract, it is provided that the Registrar must (1) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the Register upon a request in writing to that effect signed by or on behalf of the parties thereto;<sup>87</sup> (2) record in the Register the expiry, termination or invalidation of a licence contract under any provision of the statute law.<sup>88</sup>

There is special provision with regard to licence contracts involving payments abroad. Where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof—(a) which involves the payment of royalties abroad; or (b) which by reason of other circumstances relating to such licence contract, is detrimental to the economic development of Sri Lanka, he must in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.<sup>89</sup> Where the Governor of the Central Bank on receipt of such a communication informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka, the Registrar must cancel and invalidate the record of such contract in the Register.<sup>90</sup>

## 5.10 Renunciation and Nullity of Registration

### 5.10.1 *Renunciation*

The registered owner of an industrial design may renounce the registration by a declaration in writing signed by him or on his behalf and submitted to the Registrar.<sup>91</sup> The Registrar must on receipt of the said declaration, record it in the Register and cause such record to be published in the *Gazette*.<sup>92</sup> The renunciation takes effect from the date the Registrar receives the declaration.<sup>93</sup>

<sup>85</sup> *Ibid.*, s.53.

<sup>86</sup> *Ibid.*, proviso to s.53.

<sup>87</sup> *Ibid.*, s.54(1).

<sup>88</sup> *Ibid.*, s.54(2).

<sup>89</sup> *Ibid.*, s.55(1).

<sup>90</sup> *Ibid.*, s.55(2).

<sup>91</sup> *Ibid.*, s.56(1).

<sup>92</sup> *Ibid.*, s.56(2).

<sup>93</sup> *Ibid.*, s.56(3).

Where a licence contract in respect of an industrial design is recorded in the Register, the Registrar has no power, in the absence of a provision to the contrary in such licence contract, to accept or record the said renunciation except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the said renunciation, unless the requirement of his consent is expressly waived in the licence contract.<sup>94</sup>

### 5.10.2 Nullity

The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the industrial design and every assignee, licensee or sub-licensee on record shall be made a party, declare the registration of the industrial design null and void on any one or more of the following grounds:

- (a) that the mandatory legal provisions have not been complied with (grounds of nullity, however, cannot be taken into account if they did not exist at the date of the application to Court);
- (b) that the identical industrial design has been previously registered upon a prior application or has been conferred earlier priority by virtue of an application in that behalf upon the ground of prior registration in another country;
- (c) that the essential elements of the registered industrial design have been unlawfully derived from the creation of another person.<sup>95</sup>

Where an application for nullity of registration relates to several industrial designs, included in the registration and the ground or grounds for nullity apply to some but not to all such industrial designs, the Court must declare such registration null and void in so far as it relates to the industrial design in respect of which the ground or grounds for nullity apply.<sup>96</sup>

The date and effect of nullity are separately provided for. Upon a final decision of the Court declaring total or partial nullity of the registration of an industrial design, the registration is deemed to have been null and void totally or partially, as the case may be, from the date of such registration.<sup>97</sup> When a declaration of nullity becomes final, the Registrar of the Court must notify the Registrar who in turn will record the declaration in the Register and cause it to be published in the *Gazette*.<sup>98</sup>

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<sup>94</sup> *Ibid.*, s.56(4).

<sup>95</sup> *Ibid.*, s.57(1).

<sup>96</sup> *Ibid.*, s.57(2).

<sup>97</sup> *Ibid.*, s.58(1).

<sup>98</sup> *Ibid.*, s.58(2).











## CHAPTER 6

### **COPYRIGHT**

#### SYNOPSIS

6.1 Introduction

6.2 Copyright Protection

6.3 Subject Matter of Copyright Protection

6.4 Rights Comprised in Copyright

6.5 Ownership of Copyright

6.6 Works of Sri Lankan Folklore

6.7 Limitation of Copyright Protection

6.8 Piracy and Infringement

6.9 Scope of Copyright Protection in Sri Lanka



## 6.1 Introduction

Copyright exists to protect the product of intelligent endeavour and is essential to the cultural aspects of our society. Copyright assumes great importance in the cultural and economic development of Sri Lanka mainly due to its civilisation of 2,500 years and the high literacy rate amongst its inhabitants.<sup>1</sup>

Sri Lanka enacted her own copyright legislation for the first time in the year 1979. Until then Sri Lanka was dependent on the United Kingdom Law of Copyright. The U.K. Copyright Act of 1911 by an agreement in our Independence Order-in-Council of 1947 applied to Sri Lanka. It had not been specially adopted in this country by our Parliament and even continued to be in force in Sri Lanka after it had been revised in the U.K. in 1956. This Colonial legislative link was finally severed with the passing of the Code of Intellectual Property Act presented to Parliament on the 25th of May, 1976 by the then Minister of Trade and Shipping, Hon. Lalith Athulathmudali. The “Code” as this Act is now popularly called, contains, *inter alia*, the current Copyright Law of Sri Lanka. This Law is based, *inter alia*, on the copyright model law drafted for developing countries by the Secretariat of the World Intellectual Property Organization (WIPO) and adapted to suit local requirements by a Committee of Sri Lankan experts appointed by Minister Lalith Athulathmudali.<sup>2</sup>

## 6.2 Copyright Protection

### *Concept of Copyright*

Copyright is a type of property founded on skill and labour. It is designed to prevent the appropriation of the work of an author by others. Copyright is not a tangible thing, it is, in essence, the exclusive right to do certain things with an original work including the right to copy and publicly perform the work. A clear distinction exists, for example, between a book (as an object) and the written work it contains. Copyright does not protect ideas themselves but only the original expression of ideas. The creation of a work in which copyright subsists confers a monopoly not over the work itself, but only over reproduction of it. If another person independently creates a similar work, copyright in the first work is not infringed. The basic concept of copyright law is to grant writers, composers, artists and other creators of work of the mind certain time—limited exclusive rights in respect of the utilisation of their “work”—a comprehensive word which includes original literary, artistic and scientific works.<sup>3</sup> Protection in Sri Lanka is automatic. If, for instance, a person writes a play, the exclusive rights in that play

<sup>1</sup> K. Jayasinghe, *Sri Lanka's Copyright Law embodied in the Code of Intellectual Property Act*, p. 1.

<sup>2</sup> *Ibid.*, p. 1.

<sup>3</sup> *Ibid.*, pp. 1-2.

belong to the author from the moment of its creation without having to comply with any formalities whatsoever. It has been considered that requirement of formalities was likely to entail administrative complications and render the protection more difficult to enforce. The best protection for copyright owners is to regard their copyright as an item of property and to deal with it in a businesslike way. They should always keep dated copies of manuscripts and of any letters submitting their work to others. No document dealing with copyright should be signed unless its contents are fully understood. It may be noted, however, that in order to benefit from the legal systems of some countries which do provide for compliance with formalities as a condition for the protection of author's rights, the requirement of formalities would be satisfied if, when first published, all the copies of the work bear the symbol "C", accompanied by the name of the copyright proprietor and the year of first publication.<sup>4</sup>

### 6.3 Subject Matter of Copyright Protection

#### (a) Works Protected

Authors of original, literary artistic and scientific works are entitled to protection of their work under Sri Lankan law.<sup>5</sup>

The ambit of this protection is extensive. In accordance with the definition applicable in Sri Lankan law, literary, artistic and scientific works include in particular:

- (a) books, pamphlets and other writings;
- (b) lectures, addresses, sermons and other works of the same nature;
- (c) dramatic and dramatico-musical works;
- (d) musical works, whether or not they are in written form and whether or not they include accompanying words;
- (e) choreographic works and pantomimes;
- (f) cinematographic, radiophonic and audiovisual works;
- (g) works of drawing, painting, architecture, sculpture, engraving, lithography and tapestry;
- (h) photographic works, including works expressed by processes analogous to photography;
- (i) works of applied art, whether handicraft or produced on an industrial scale;

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<sup>4</sup> *Ibid.*, p 3.

<sup>5</sup> Code of Intellectual Property Act, No. 52 of 1979, s.7(1).

- (j) illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.<sup>6</sup>

Quality and purpose do not constitute an integral part of the criteria sustaining the rationale of copyright protection. Thus statutory provisions in force in Sri Lanka contain explicit provision that “Works shall be protected irrespective of their quality and the purpose for which they were created.”<sup>7</sup>

The attribute of originality has a special meaning in the context of copyright law. The content of this requirement is far from exacting. Thus, the law of Sri Lanka provides that the following are entitled to protection as original works;

- (a) translations, adaptations, arrangements and other transformations of literary, artistic or scientific works;
- (b) collections of literary, artistic or scientific works, such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations; and
- (c) works derived from Sri Lanka folklore.<sup>8</sup>

The protection so conferred on works of this nature is declared to be without prejudice to any protection of a pre-existing work utilized for the making of such work.<sup>9</sup>

(b) *Works not Protected*

Copyright protection does not extend in Sri Lanka to the following;

- (a) laws and decisions of courts and administrative bodies, as well as official translations thereof; and
- (b) news of the day published, broadcast or publicly communicated by any other means.<sup>10</sup>

## 6.4 Rights Comprised in Copyright

There are two basic categories of rights which are subsumed in copyright:

- (a) Economic Rights,
  - (b) Moral Rights.
- (a) *Economic Rights*

Under the rubric of economic rights, the author of a protected work has the exclusive right to do or authorize any other person to do the following acts in relation to the whole work or a part thereof:

<sup>6</sup> *Ibid.*, s.7(2).

<sup>7</sup> *Ibid.*, s.7(3).

<sup>8</sup> *Ibid.*, s.8(1).

<sup>9</sup> *Ibid.*, s.8(2).

<sup>10</sup> *Ibid.*, s.9.

- (a) reproduce the work;
- (b) make a translation, adaptation, arrangement, or other transformation of the work;
- (c) communicate the work to the public by performance, broadcasting, television or any other means.<sup>11</sup>

Several of these terms form the subject matter of explicit definition. "Reproduction," for instance, is declared to mean the making of one or more copies of a literary, artistic or scientific work, in any material form including any sound or visual recording.<sup>12</sup>

"Broadcasting" envisages the transmitting, for reception by the general public, by wireless or by means of wire, of sounds or of images and sounds.<sup>13</sup>

Performance means a public performance or delivery of a work by any means whatsoever.<sup>14</sup>

(b) *Moral rights*

Under this category of rights the author of a protected work has the right:

- (a) to claim authorship of his work, in particular, that his authorship be indicated, except when the work is included incidentally or accidentally when reporting current events by means of broadcasting or television;
- (b) to object to, and to seek relief in connection with, any distortion, mutilation or other modification of, and any other derogatory action in relation to, his work, where such action would be or is prejudicial to his honour or reputation.<sup>15</sup>

These rights subsist for the life of the author and 50 years thereafter. After his death these rights devolve upon and are exercisable by his heirs.<sup>16</sup>

The moral rights entrenched in the law are exercisable even where the author or his heirs do not have the economic rights recognized by the law.<sup>17</sup>

The moral rights, unlike the economic component of copyright, are not transferable.<sup>18</sup>

<sup>11</sup> *Ibid.*, s.10.

<sup>12</sup> *Ibid.*, s.6.

<sup>13</sup> *Ibid.*, s.6.

<sup>14</sup> *Ibid.*, s.6.

<sup>15</sup> *Ibid.*, s.11(1).

<sup>16</sup> *Ibid.*, s.11(2).

<sup>17</sup> *Ibid.*, s.11(3).

<sup>18</sup> *Ibid.*, s.11(4).

## 6.5 Ownership of Copyright

Copyright as recognized by the law of Sri Lanka is owned in the first instance by the author or authors who created the work. The authors of a work of joint authorship are co-owners of these rights.<sup>19</sup>

A work of joint authorship is defined as a work created by two or more authors in collaboration, in which the individual contributions are indistinguishable from each other.<sup>20</sup>

In the absence of proof to the contrary, the author of a work is the person under whose name the work is disclosed.<sup>21</sup>

In the case of a work created by an author for any person or body of persons corporate or unincorporated in the course of his employment under a contract of service, or of a work commissioned from the author by such person or body of persons, the economic rights subsumed in copyright are deemed, in the absence of contractual provisions to the contrary, to be transferred to the employer or to the person commissioning the work.<sup>22</sup>

Ownership of copyright includes the right to transfer copyright. The economic rights attaching to copyright are transferable in whole or in part.<sup>23</sup> Any transfer, other than by operation of law, of an economic right must be in writing signed by the transferor.<sup>24</sup> A transfer, in whole or in part, of any economic right does not include or be deemed to include the transfer of any other rights referred to therein.<sup>25</sup> When a contract provides for the total transfer of one of the economic rights, the scope of such contract is limited to the exercise of such rights as are provided for in the contract.<sup>26</sup> The transfer of ownership of the only copy or of one of several copies of a work does not imply, and is not deemed to imply, the transfer of the copyright in the work.<sup>27</sup>

There is a particular provision governing the duration of economic rights. In the absence of explicit provisions to the contrary, economic rights forming part and parcel of copyright are protected during the life of the author and for 50 years after his death.<sup>28</sup> In the case of a work of joint authorship, economic rights

<sup>19</sup> *Ibid.*, s.17(1).

<sup>20</sup> *Ibid.*, s.6.

<sup>21</sup> *Ibid.*, s.17(2).

<sup>22</sup> *Ibid.*, s.17(3).

<sup>23</sup> *Ibid.*, s.18(1).

<sup>24</sup> *Ibid.*, s.18(2).

<sup>25</sup> *Ibid.*, s.18(3).

<sup>26</sup> *Ibid.*, s.18(4).

<sup>26</sup> *Ibid.*, s.18(4).

<sup>27</sup> *Ibid.*, s.18(5).

<sup>28</sup> *Ibid.*, s.19(1).



are protected during the life of the last surviving author and for 50 years after his death.<sup>29</sup>

In the case of a work published anonymously or under a pseudonym, economic rights are protected until the expiration of 50 years from the date on which such work was first lawfully published.<sup>30</sup>

“Works first published” is a phrase which is declared to mean works first published in Sri Lanka, or works first published abroad but also published in Sri Lanka within 30 days from the earlier publication.<sup>31</sup>

The phrase “published works” also receives definition. This phrase contemplates works published in any manner whatsoever with the consent of their authors, provided that the number of copies so published is sufficient to satisfy the reasonable requirements of the public, having regard to the nature of the work.<sup>32</sup>

There is a provision in Sri Lankan law that where, before the expiration of a period of 50 years from the date on which such work was lawfully first published, the author or the author’s identity is revealed or is no longer in doubt, the period of protection is that stipulated in general by the law—namely, the life of the author and 50 years after his death.<sup>33</sup>

In the case of a cinematographic, radiophonic or audiovisual work, economic rights are protected until the expiration of 50 years from the making of the work or, if the work is made available to the public during such period with the consent of the author, 50 years from the date of its communication to the public.<sup>34</sup>

In the case of a photographic work or a work of applied art, economic rights are protected until the expiration of 25 years from the making of the work.<sup>35</sup>

Every period contemplated by statutory provision is declared to run to the end of the calendar year in which it would otherwise expire.<sup>36</sup>

The lawful maker of any sound recording has for a period of 50 years from the first publication of the sound recording the exclusive right to reproduce or authorize the reproduction of the sound recording.<sup>37</sup>

<sup>29</sup> *Ibid.*, s.19(2).

<sup>30</sup> *Ibid.*, s.19(3).

<sup>31</sup> *Ibid.*, s.6.

<sup>32</sup> *Ibid.*, s.6.

<sup>33</sup> *Ibid.*, proviso to s.19(3).

<sup>34</sup> *Ibid.*, s.19(4).

<sup>35</sup> *Ibid.*, s.19(5).

<sup>36</sup> *Ibid.*, s.19(6).

<sup>37</sup> *Ibid.*, s.20(1).

## 6.6 Works of Sri Lankan Folklore

In the case of works of Sri Lankan folklore, copyright is vested in the Minister for Cultural Affairs.<sup>38</sup> The extensive nature of the protection conferred is reflected in the provision that works of Sri Lankan folklore are protected without limitation in time.<sup>39</sup> Moreover, copies of works of Sri Lankan folklore made abroad and copies of translations, adaptations, arrangements or other transformations of works of Sri Lankan folklore made abroad, without the Minister's authorization, can neither be imported nor distributed.<sup>40</sup>

## 6.7 Limitation on Copyright Protection

The primary limitation is that contemplated by the concept of fair use.

The following uses of a protected work, either in the original languages or in translation, are permissible without the author's consent:

- (a) in the case of any work that has been lawfully published:
  - (i) the reproduction, translation, adaptation, arrangement or other transformation of such work exclusively for the user's own personal and private use;
  - (ii) the inclusion, subject to mention of the source and the name of the author, of quotations from such work in another work, provided that such quotations are compatible with fair practice and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries;
  - (iii) the utilization of the work by way of illustration in publications, broadcasts or sound or visual recordings for teaching to the extent justified by the purpose, or the communication for teaching purposes of the work broadcast or televised for use in schools, educational institutions, universities and professional training.<sup>41</sup>

However, the use is required to be compatible with fair practice and the source and the name of the author must be mentioned in the publication, broadcast, television broadcast or recording:<sup>42</sup>

- (b) in the case of any article published in newspapers or periodicals on current economic, political or religious topics, and in the case of any broadcast or televised work of the same character, the reproduction of such article or such

<sup>38</sup> *Ibid.*, s.12(1).

<sup>39</sup> *Ibid.*, s.12(2).

<sup>40</sup> *Ibid.*, s.12(3).

<sup>41</sup> *Ibid.*, s.13(a).

<sup>42</sup> *Ibid.*, proviso to s.13(a)(i).

work in the press, or the communication of it to the public, unless the article when first published, or the broadcast or televised work when broadcast or televised, was accompanied by an express condition prohibiting such use, and that the source of the work when used in the said manner is clearly indicated;<sup>43</sup>

- (c) for the purposes of reporting on a current event by means of photography, cinematography or communication to the public, the reproduction or making available to the public, to the extent justified by the informatory purpose of any work that can be seen or heard in the course of the current event;<sup>44</sup>
- (d) the reproduction of works of art and of architecture in a film or television broadcast, and the communication to the public of the works so reproduced, if the works are permanently located in a place where they can be viewed by the public or are included in the film or television broadcast only by way of background or as incidental to the essential matters represented;<sup>45</sup>
- (e) the reproduction, by sound recording, photographic or similar process, by public libraries, non-commercial documentation centres, scientific institutions and educational establishments, of literary, artistic or scientific works which have already been lawfully made available to the public.<sup>46</sup>

However, the reproduction and the number of copies made must be limited to the needs of their activities, and is required not to conflict with the normal exploitation of the work and must not unreasonably prejudice the legitimate interests of the author.<sup>47</sup>

(f) the reproduction in the press of—

- (i) any political speech delivered in public or any speech delivered during legal proceedings, or
- (ii). any lecture, address, sermon or other work of the same delivered in public, provided that the use is exclusively for the purposes of current information, the author retaining the right to publish a collection of such works.<sup>48</sup>

Special provision is made in regard to ephemeral recordings. Any broadcasting or television organization may make, for the purpose of its own broadcasts or television broadcasts and by means of its own facilities, an ephemeral recording, in one or several copies, of any work which it is authorized to broadcast or

<sup>43</sup> *Ibid.*, s.13(b).

<sup>44</sup> *Ibid.*, s.13(c).

<sup>45</sup> *Ibid.*, s.13(d).

<sup>46</sup> *Ibid.*, s.13(e).

<sup>47</sup> *Ibid.*, proviso to s.13(e).

<sup>48</sup> *Ibid.*, s.13(f).

televise. However, all copies of such recording must be destroyed within six months of the making thereof or within any longer period agreed to by the author.<sup>49</sup>

There is a significant limitation with regard to the right of translation. Where any work has not been published in Sinhala or Tamil within 10 years from its having been published for the first time in its original language, it is lawful to translate the said work into Sinhala or Tamil, as the case may be and to publish such translation, even without the authorization of, and without any payment to, the owner of the copyright of the work.<sup>50</sup>

This provision embodies an important principle. Its objective is to stimulate and encourage the production of a corpus of indigenous literature. Where a work is published in English or other language but is not translated into Sinhala or Tamil for a decade since its original publication, no restriction attaches to its publication in the two national languages. The author of the original work is not entitled to prevent its publication in Sinhala or Tamil, nor can he appropriate for himself any part of the profits derived from such publication. This provision, therefore, gives the person producing the work in the national languages the incentive which he requires.

A further circumscribing factor embedded in the Sri Lankan Copyright Law consists of a limitation of the right of sound recording and broadcasting. Our law contains provision that where the owner of the copyright in a musical work has already authorized a person to make a sound recording of the performance of the work, any other person may, if he cannot agree with the owner to make a sound recording of a performance of the same work, make a new sound recording of a performance of the work without the authorization of the owner, provided that such other person pays to the owner an equitable remuneration which is to be fixed by the Secretary to the Ministry of the Minister in charge of the subject of Culture. This provision applies also to any words accompanying the music.<sup>51</sup>

Where any public broadcasting or television organization operating in and from Sri Lanka cannot agree with the owner of the copyright in any work which it wishes to transmit by broadcasting or television on the conditions on which the work may be broadcast or televised, it is entitled to proceed to such broadcasting or television even without the authorization of the owner, provided that it pays to the owner an equitable remuneration in an amount fixed by the Secretary to the Ministry of the Minister in charge of the subject of Culture.<sup>52</sup>

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<sup>49</sup> Code of Intellectual Property Act, No. 52 of 1979, s.14.

<sup>50</sup> *Ibid.*, s.15.

<sup>51</sup> *Ibid.*, s.16(1).

<sup>52</sup> *Ibid.*, s.16(2).

## 6.8. Piracy and Infringement

The major remedy catered for by the law of Sri Lanka is injunctive relief coupled with compensatory damages. Sri Lankan law provides that any person who infringes copyright entrenched in our law may be prohibited by injunction from continuing such infringement and may also be liable in damage.<sup>53</sup>

There are also criminal sanctions attendant upon infringement of copyright. Any person who wilfully infringes the rights granted to a copyright holder is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.<sup>54</sup>

While imposing such a sentence it is open to the Magistrate to make incidental orders with regard to the destruction of property used for the infringement. Thus, the Magistrate may, whether the alleged offender is convicted or not, order that all copies of the work and all implements used for the infringement, or all plates in the possession of the alleged offender, which appear to him to be infringing copies or plates for the purpose of making infringing copies, shall be destroyed or delivered up to the owner of the copyright, or otherwise dealt with as the Magistrate may think fit.<sup>55</sup>

## 6.9 Scope of Copyright Protection in Sri Lanka

The ambit of this protection is strikingly extensive in Sri Lanka. Thus, copyright protection extends to:

- (a) works of authors who are nationals of, or have their habitual residence in Sri Lanka; and
- (b) works first published in Sri Lanka, irrespective of the nationality or residence of their authors; and
- (c) all works which, by virtue of treaties entered into by Sri Lanka, are to be protected, as well as works of Sri Lanka folklore.<sup>56</sup>

However, it must be noted that no copyright, or right in the nature of copyright, subsists in Sri Lanka otherwise than by virtue of any statutory enactment.<sup>57</sup> This provision is tantamount to abrogation of common law principles

<sup>53</sup> *Ibid.*, s.21 (1).

<sup>54</sup> *Ibid.*, s.144 (2).

<sup>55</sup> *Ibid.*, s.144(2).

<sup>56</sup> *Ibid.*, s.22.

<sup>57</sup> *Ibid.*, s.23.

pertaining to copyright. An applicable qualification, however, is that this abrogation does not affect pre-existing rights acquired under the common law or any other law.<sup>58</sup>

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<sup>58</sup> *Ibid.*, s.24.













## CHAPTER 7

# ADMINISTRATION OF INTELLECTUAL PROPERTY

### SYNOPSIS

7.1 Introduction

7.2 Administrative Structure in the Industrial Property Office

7.3 Patents Branch

7.4 Trade Marks Branch

7.5 Industrial Designs

7.6 Cost of Maintaining the System

7.7 Government Support of Inventive Activity

7.8 Intergovernmental Cooperation



## 7.1 Introduction

The industrial property office in Sri Lanka is called the “Registry of Patents and Trade Marks” and functions under the Ministry of Trade and Shipping and is charged with the administration of the laws of Patents, Trade Marks and Industrial Designs contained in the “Code of Intellectual Property Act, No. 52 of 1979.”

## 7.2 Administrative Structure in the Industrial Property Office

The office is at present staffed by the Registrar, two Assistant Registrars and a supporting staff of clerical officers, typists and others. The Registrar and the Assistants are lawyers and are part of a non-transferable service. The clerical and minor staff come from the combined services and are subject to periodical transfers. The Registry also engages on contract a Panel of Examiners of technical competence who examine the Patent applications submitted to them for necessary search as to the relevant prior art and report to the Registrar.

The Registry is judicially autonomous, in that it acts quasi-judicially in deciding on the applications filed and such decisions are subject to appeal to the District Court of Colombo and further to the Court of Appeal, if necessary. The Ministry of Trade and Shipping exercises administrative supervision over the Registry.

So far as the general administration is concerned, the principal legislation, in force in Sri Lanka, makes provision for the appointment of the Registrar and also Deputy Registrars and Assistant Registrars.

The applicable provisions are the following:

There may be appointed a person to be or to act as Registrar of Patents and Trade Marks of Sri Lanka.<sup>1</sup> In default of such appointment, the Registrar of Companies or any person for the time being acting as such shall discharge the duties of the Registrar under the Code.<sup>2</sup> The Registrar is, subject to the directions of the Minister, who is vested with the general control and superintendence of the registration of industrial designs, patents and marks under the provisions of the Code and of all persons appointed for or engaged in the carrying out of the provisions of the Code.<sup>3</sup>

There may, from time to time, be appointed a Deputy Registrar of Patents and Trade Marks and other Assistant Registrars as the Minister may consider necessary.<sup>4</sup> Any person so appointed may perform any function expressly con-

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<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s.2(1).

<sup>2</sup> *Ibid.*, s.2(2).

<sup>3</sup> *Ibid.*, s.2(3).

<sup>4</sup> *Ibid.*, s.3(1).

ferred or imposed upon the Deputy Registrar or Assistant Registrar, as the case may be, and may, subject to the directions of the Minister and under the authority of the Registrar, exercise or perform any functions conferred or imposed upon the Registrar.<sup>5</sup>

If no such appointment is made the Deputy Registrar of Companies or an Assistant Registrar of Companies, is empowered to discharge the duties of the Deputy Registrar of Patents and Trade Marks or an Assistant Registrar of Patents and Trade Marks.<sup>6</sup>

There is incidental provision governing the Registry and the maintenance of registers. The Minister may by notification in the *Gazette* establish an office called the Registry of Patents and Trade Marks, which shall be the only office in Sri Lanka for the registration of industrial designs, patents and marks.<sup>7</sup> All registers required to be kept and maintained under the provisions of the Code must be kept and maintained under the supervision of the Registrar at the Registry and the registers are the only legally recognized registers for the registration of industrial designs, patents and marks in Sri Lanka.<sup>8</sup>

Provision is also made that every Registrar, Deputy Registrar and Assistant Registrar for the time being is, as long as he holds his office, deemed to be a public servant within the meaning of the Penal Code.<sup>9</sup>

### 7.3 Patents Branch

The Patent Office receives both local and foreign applications on prescribed forms and in the specified manner along with the prescribed application fee and grants patents for inventions and keeps them in force on due payment of the renewal fees up to the fifteenth year.

Patent applications in Sri Lanka are generally prepared and handled by patent attorneys who are normally lawyers. The Registry checks on the requisite formalities of the application and follows the Documentary Report System in the granting of the patent. Under this procedure, the patent application is subject to a search on novelty and inventive step, the results of which are contained in the "search report." Although the Registrar is not required to make a determination on patentability yet the search report requires the Examiner to report on the patentability of the application. The notification procedure adopted by the Regis-

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<sup>5</sup> *Ibid.*, s.2(2).

<sup>6</sup> *Ibid.*, 3(3).

<sup>7</sup> *Ibid.*, s.4(1).

<sup>8</sup> *Ibid.*, s.4(2).

<sup>9</sup> *Ibid.*, s.5.

try gives an opportunity to the applicant to focus his attention and remedy any adverse comments made by the examiner regarding prior art in the search report. If the applicant responds to the comments on the search report served on him, his observations are referred back to the examiner for his further comments and a patent is granted under Section 76(2)(a) of the Code of Intellectual Property Act.

The question of patentability is left to the Courts alone which are better equipped for inquiries than the Registrar to determine fully this question if it arose after grant, thereby eliminating the delay and expense that would otherwise be involved in contentious proceedings before grant which would act as a deterrent to applicants.

A reference to the grant of the patent is published in the *Government Gazette* after grant.

#### **7.4 Trade Marks Branch**

The Trade Marks Branch of the Registry deals with applications for the registration of trade and service marks, their renewal, amendment, etc.

Application is made on the prescribed form with the prescribed fee. The application is subjected to both a formal and a substantive examination and search as to registrability. To qualify for registration, a mark should not be disqualified under the provisions of sections 99, 100 and 142 of the Code. The procedure followed in the examination and registration of an application is set out in sections 106 and 107 of the Code in detail.

Foreign applicants are required to give a local address for purposes of communication if no local agent has been appointed.

The registration of a mark is valid up to 10 years and could be renewed for unlimited periods of 10 years at a time.

#### **7.5 Industrial Designs**

The number of applications received for the registration of industrial designs in Sri Lanka is not very large. This work is attended to by the Trade Marks Branch of the Registry and is governed by Part III of the Code.

#### **7.6 Cost of Maintaining the System**

The cost of maintaining the industrial property system in Sri Lanka is partly borne by the Treasury and partly by the Fund created by section 185 of the Code.



### 7.7 Government Support of Inventive Activity

In order to promote and encourage inventiveness the Government enacted, in 1979, the Sri Lanka Inventors Incentives Act, No. 53 of 1979 which provides for the establishment of a public authority called the Sri Lanka Inventors' Commission.

The objects and the powers, functions and duties of the Commission are set out in sections 10 and 11 respectively of the Act.

### 7.8 Intergovernmental Cooperation

The Registry has organised annually since 1984 a training course on intellectual property for developing countries of Asia and the Pacific in collaboration with the World Intellectual Property Organization and UNDP. About 20 countries have participated each year for the last five years, with each country sending two participants. The lecturers have been from both the industrialized and the developing countries.

Sri Lanka has also provided WIPO with assistance in certain other ways, such as :

- (a) The Sri Lanka Registrar was a lecturer at a National Training Course in Industrial Property in Dacca, Bangladesh in 1983.
- (b) In 1986 the Sri Lanka Registrar was appointed leader of joint UNDP/ WIPO mission to five sample countries—(1) to evaluate the 1982-86 WIPO project titled "Establishing and Strengthening of Industrial Property in Asia and the Pacific" and (2) to formulate a project document for the fourth intercountry program (1987-1991). This project document has been accepted by WIPO and UNDP *in toto* and the training and other programmes of WIPO in the field of intellectual property up to 1991 in Asia and the Pacific are based on the recommendations of that report.
- (c) The services of the Sri Lanka Registrar of Patents and Trade Marks were retained by WIPO as a Consultant for its Evaluation and Planning Meeting held in Geneva in November 1987.









## CHAPTER 8

# INTELLECTUAL PROPERTY LITIGATION

### SYNOPSIS

#### 8.1 Introduction

#### 8.2 Review of Industrial Property Office Decisions

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## 8.1 Introduction

It is usual in any intellectual property system to provide for a procedure relating to internal appeals. These are of an administrative nature and are handled within the department. The objectives of simplicity of procedure, informal disposal of the matter at issue, and comparative speed and inexpensiveness are sought to be achieved by the internal appeals procedure. If no satisfactory solution can be reached in this manner, the parties will have recourse to the Courts.

## 8.2 Review of Industrial Property Office Decisions

### 8.2.1 *Proceedings before Registrar*

A wide range of discretionary powers devolves upon the Registrar in several contexts. There are mandatory provisions which govern the exercise of discretion by the Registrar in each of these situations. The fundamental provision governing the exercise of discretionary power by the Registrar revolves round the rules of natural justice. The Sri Lankan Code contains explicit provision that where any discretionary or other power is given to the Registrar by this Code or by regulations made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered owner of an industrial design, patent or mark without (if duly required so to do within the prescribed time) giving such applicant or registered owner an opportunity of being heard.<sup>1</sup>

The specific settings in which the principle relating to a fair hearing set out above may be involved legitimately are enumerated in a series of provisions. These may be conveniently considered in relation to the subject matter with which they deal.

#### (a) *Industrial Designs*

The Registrar has a statutory duty to ascertain whether an application for registration of an industrial design complies with mandatory requirements stipulated by law.<sup>2</sup> Where these requisites are breached, the application for registration must be refused.<sup>3</sup> Where there is substantial compliance with the applicable requisites, the Registrar must record the priority claimed.<sup>4</sup> A further instance of the exercise of a discretionary power by the Registrar concerns the renewal of the registration of an industrial design.<sup>5</sup> Where the prescribed renewal fee has not been paid within the stipulated period, the Registrar is required to remove the

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<sup>1</sup> Code of Intellectual Property Act, No. 52 of 1979, s.177.

<sup>2</sup> *Ibid.*, s.36(1).

<sup>3</sup> *Ibid.*, s.36(2).

<sup>4</sup> *Ibid.*, s.36(4).

<sup>5</sup> *Ibid.*, s.43(3).



registration of the industrial design from the register.<sup>6</sup> The assignment and transmission of applications and registrations are subject to conditions spelt out in the statutory provisions, including payment of the prescribed fee, and, in the case of an assignment, the expression of concurrence in writing by or on behalf of the contracting parties.<sup>7</sup> The determination whether these conditions have been complied with is a matter which falls within the purview of the Registrar's responsibility.<sup>8</sup> Another discretionary power devolving upon the Registrar has its setting in relation to the form and record of a licence contract. Upon a request in writing being made in the manner required by the law, by the contracting parties and also subject to the payment of the prescribed fee, the Registrar is under a duty to register particulars relating to the contract according to the wish of the contracting party.<sup>9</sup> There are other duties imposed upon the Registrar with regard to expiry, termination or invalidation of a licence contract.<sup>10</sup> With regard to licence contracts involving payments abroad, the Registrar is burdened with the duty of communicating with the Central Bank in situations where he has reasonable cause to believe that the contract is detrimental to the economic development of Sri Lanka.<sup>11</sup>

Other duties entailing an element of discretion attach to the Registrar with regard to renunciation and nullity of registration.<sup>12</sup>

(b) *Patents*

A duty is assigned to the Registrar with regard to the grant of a patent if the application is accompanied by a prescribed fee and the other requirements are satisfied.<sup>13</sup> The recording of the filing date is the function of the Registrar which is required to be discharged upon the satisfaction of certain conditions in regard to which the discretion vested in the Registrar is the operative criterion.<sup>14</sup> The examination of the application with a view to deciding whether the conditions precedent are fulfilled is the responsibility of the Registrar.<sup>15</sup> The assignment and transmission of patent applications and patents is also a matter falling within the ambit of the Registrar's functions, provided that particular conditions are complied with.<sup>16</sup> With regard to the form and record of the licence contract, the Registrar has essential duties to discharge upon payment of a prescribed fee and

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<sup>6</sup> *Ibid.*, s.43(4).

<sup>7</sup> *Ibid.*, s.46(3).

<sup>8</sup> *Ibid.*, s.46(3).

<sup>9</sup> *Ibid.*, s.49(2).

<sup>10</sup> *Ibid.*, s.54.

<sup>11</sup> *Ibid.*, s.55(1).

<sup>12</sup> *Ibid.*, s.56(4).

<sup>13</sup> *Ibid.*, s.69.

<sup>14</sup> *Ibid.*, s.74.

<sup>15</sup> *Ibid.*, s.75(1).

<sup>16</sup> *Ibid.*, s.84(3).

the fulfilment of specific conditions.<sup>17</sup> There are similar obligations ascribed to the Registrar with regard to expiry, termination and invalidation of a licence contract.<sup>18</sup> As in the case of industrial designs, the Registrar is required to convey to the Governor of the Central Bank reservations which he may have reasonably entertained in respect of licence contracts which may involve payments overseas.<sup>19</sup> Finally, the Registrar has discretionary powers to exercise with regard to the surrender of patents.<sup>20</sup>

(c) *Trademarks*

The law assigns to the Registrar duties connected with the registration of a trademark after examination and publication of the mark.<sup>21</sup> The alteration of a registered mark, as well, is a matter in respect of which the Registrar is required to exercise a discretion.<sup>22</sup> Also is the assignment and transmission of applications and registrations.<sup>23</sup> Provisions comparable in scope with those governing industrial designs and patents impose upon the Registrar in relation to trademarks, obligations pertaining to the form and record of licence contracts.<sup>24</sup> Just as in the two former areas, the Registrar's duty to bring to the notice of the Central Bank authorities detrimental aspects of licence contracts which entail payments abroad, receives statutory recognition with regard to trademarks.<sup>25</sup> Similarly, the expiration, termination and invalidation of licence contracts in the area of trademarks are matters with regard to which discretionary powers devolve upon the Registrar<sup>26</sup> just as they do with regard to the renunciation of registration of trademarks.<sup>27</sup>

Similar duties containing a discretionary component are statutorily required to be discharged by the Registrar vis-a-vis collective marks.<sup>28</sup> There are specific powers which the Registrar is required to discharge with regard to changes in regard to conditions governing the use of collective marks.<sup>29</sup>

8.2.2 *Proceedings before Court*

In any of the matters referred to in the preceding provisions, a person who is dissatisfied with the decision of the Registrar is entitled to seek a judicial

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<sup>17</sup> *Ibid.*, s.87(2).

<sup>18</sup> *Ibid.*, s.92.

<sup>19</sup> *Ibid.*, s.93(1).

<sup>20</sup> *Ibid.*, s.94(5).

<sup>21</sup> *Ibid.*, s.107.

<sup>22</sup> *Ibid.*, s.116.

<sup>23</sup> *Ibid.*, s.119.

<sup>24</sup> *Ibid.*, s.121(2).

<sup>25</sup> *Ibid.*, s.126(1).

<sup>26</sup> *Ibid.*, s.128.

<sup>27</sup> *Ibid.*, s.129(1).

<sup>28</sup> *Ibid.*, s.134.

<sup>29</sup> *Ibid.*, s.137.

remedy. There is then a gradation of appeals provided for within the judicial hierarchy.

Any person aggrieved by any decision or order made by the Registrar in any of the contexts dealt with above has the competence to appeal from the ruling of the Registrar to the District Court of Colombo.<sup>30</sup> In any such appeal, the District Court has the same discretionary powers as are conferred by the provisions of the Code of Intellectual Property Act upon the Registrar.<sup>31</sup> However, every judgement or order of the District Court of Colombo in these matters is subject to an appeal to the Court of Appeal.<sup>32</sup> Such an appeal is subject to the rules applicable to interlocutory appeals from the District Court.<sup>33</sup>

There are special provisions made by the Code of Intellectual Property Act in respect of correction and rectification of the Register. This function of correction and rectification may be discharged by the Registrar as well as by the District Court.

So far as the Registrar is concerned, the Registrar may, on application in the prescribed manner by or on behalf of the registered owner of an industrial design, patent or mark, correct any error or enter any change (a) in the name, address or description of the registered owner of any industrial design, patent or mark; or (b) concerning any other particulars relating to the registration of an industrial design, patent or mark as may be permitted by regulations.<sup>34</sup>

On the other hand, the jurisdiction of the District Court of Colombo with regard to the correction and rectification of the Register is separately dealt with. Subject and without prejudice to other provisions of the Code, (a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from any register, or any entry, or by any entry made in any register without sufficient cause, or by any entry wrongly remaining on any register, or by any error or defect in any entry in any register, make such order for making, expunging, or varying such entry, as it may think fit; (b) the Court may in any proceeding in this regard decide any question that it may be necessary or expedient to decide in connection with the rectification of any register; (c) in case of fraud in the registration, assignment or transmission of any registered industrial design, patent or mark, the Registrar may himself apply to the Court.<sup>35</sup>

The Registrar's duty to appear in proceedings before the District Court of Colombo is specifically recognized. In any proceedings under the Code in which

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<sup>30</sup> Code of Intellectual Property Act, No.52 of 1979, s.182(1) read with s.186.

<sup>31</sup> *Ibid.*, s.182.

<sup>32</sup> *Ibid.*, s.182(3).

<sup>33</sup> *Ibid.*, s.182(3).

<sup>34</sup> *Ibid.*, s.172(1).

<sup>35</sup> *Ibid.*, s.172(2).

the relief sought includes correction, alteration or rectification of any register, the Registrar has the right to appear and be heard, and must appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issue, and within his knowledge as such Registrar, as he thinks fit, and such statement is deemed to form part of the evidence in the proceedings.<sup>36</sup>

The District Court of Colombo has extensive powers of review vis-a-vis the Registrar's decision. The Court, in dealing with any question of the correction alteration or rectification of any register, has power to review any decision of the Registrar relating to the entry in question or the correction, alteration or rectification sought to be made.<sup>37</sup>

### 8.2.3 *Procedural and Ancillary Provisions*

Evidentiary matters pertaining to proceedings in this regard represent the subject matter of explicit provision.

The certificate of the Registrar is deemed to be evidence. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorized by the Code, or regulations made thereunder to make or do is treated as *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.<sup>38</sup>

Moreover, certified copies are receivable as evidence. Printed, mechanically produced, typed or written copies or extracts, purporting to be certified by the Registrar, of or from any document, register or other book filed or kept under the Code in the Registry is declared to be admissible in evidence in all Courts in Sri Lanka, and in all proceedings, without further proof or production of the originals.<sup>39</sup>

The method of giving evidence is specifically catered for. In any proceeding under the Code before the Registrar or the Court, the evidence is required to be given by affidavit in the absence of directions to the contrary. But, in any case in which the Registrar or the Court thinks it right so to do, the Registrar or the Court may take evidence *viva voce* in lieu of or in addition to evidence by affidavit.<sup>40</sup>

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<sup>36</sup> *Ibid.*, s.172(2).

<sup>37</sup> *Ibid.*, s.172(3).

<sup>38</sup> *Ibid.*, s.174.

<sup>39</sup> *Ibid.*, s.175.

<sup>40</sup> *Ibid.*, s.176(1).

With regard to costs of proceedings before the Registrar, the position is that Particular provision is made in respect of oral evidence. In case any part of the evidence is taken *viva voce*, the Registrar may exercise the powers conferred on a commission appointed under the provisions of the Commissions of Inquiry Act<sup>41</sup> for compelling the attendance of witnesses and the production of documents and for administering oaths to all persons who shall be examined before him.<sup>42</sup>

Provision is also made for the Registrar to take directions in appropriate cases from law officers. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Code, apply to the Attorney-General or Solicitor General for directions in the matter.<sup>43</sup>

The Registrar has power to award any party such costs as he may consider reasonable, and to direct to whom and to what parties they are to be paid, and such order may be filed in Court, and thereupon such order may be enforced as if it were an order of the Court.<sup>44</sup>

As for proceedings before a Court under the Code of Intellectual Property Act, the costs of the Registrar are in the discretion of the Court, but the Registrar cannot be ordered to pay the costs of any other of the parties.<sup>45</sup>

The final provision in this area concerns stamp duty. The minimum stamp duties chargeable in the District Court in civil proceedings and in the Court of Appeal<sup>46</sup> under the provisions of the enactment for the time being in force relating to stamps must, so far as the same may be applicable and except as otherwise provided, be charged in all proceedings under the Code in the District Court and in the Court of Appeal. The proviso, however, is added that in no case must the Registrar be required to use any stamp or be charged any stamp duty.<sup>47</sup>

## 8.3 Infringement Actions

### 8.3.1 *Passing Off and Trade Mark Infringement*

#### (a) *Passing Off*

Passing off is an economic tort which is intended to protect legitimate business interests. A commits a tort against B if he passes off his goods or business as those of B. The underlying assumption is that A would gain an unfair

<sup>41</sup> No. 17 of 1948 as amended.

<sup>42</sup> Code of Intellectual Property Act, No. 52 of 1979, s.176(2).

<sup>43</sup> *Ibid.*, s.178.

<sup>44</sup> *Ibid.*, s.183(1).

<sup>45</sup> *Ibid.*, s.183(2).

<sup>46</sup> *Ibid.*, s.184.

<sup>47</sup> *Ibid.*, proviso to s.184.

advantage from the representation, express or tacit, that the goods which he offers for sale are those of B. B's goods may have acquired a reputation which the public regards as sound and well established. The public may, therefore, be readily prevailed upon to buy the goods of B as goods which are exceedingly reliable or are to be greatly desired. A, in passing off to the public his own goods in a situation where the public confuses A's goods with those of B, may well benefit from a reputation which his own goods, objectively considered, do not possess.

Viewed from this standpoint, the essence of liability in the action for passing-off is associated with the confusion which is likely to arise in the public mind. This confusion relates to the identity of the goods in question. A deceitful intent on the part of the defendant is no element of the *facta probanda* of the delictual action for passing off. It is not necessary for the plaintiff to establish, as a prerequisite of his action for compensation, that the defendant had the deliberate intention of confusing the public. It is adequate to show that, in the circumstances of the case, the deception was probable.

The most usual form of the delict consists of imitating the get-up or appearance of the plaintiff's goods or selling them under the same or similar name. The action for passing off is entrenched in the legal system of Sri Lanka and has been resorted to quite frequently. The action has been invoked with regard to consumer goods for which there is an extensive demand in the country, including tea, soap and liquor. Among the leading cases in which the ingredients of the action for passing off have received authoritative judicial exposition are *Kapadiya v. Mohamad*,<sup>48</sup> *Subbiah Nadar v. Sokkalal Ram Sait*;<sup>49</sup> *Hollandia And Anglo Swiss Condensed Milk Co. v. Nestle and Anglo Swiss Condensed Milk Co.*;<sup>50</sup> *Lever Brothers v. R.M. Renganathan Pillai*.<sup>51</sup>

#### (b) *Trademark Infringement*

The Sri Lankan statute contains a variety of penal provisions governing infringement of marks. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a mark is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.<sup>52</sup>

<sup>48</sup> (1918) 20 NLR 314.

<sup>49</sup> (1949) 47 NLR 241(P.C.).

<sup>50</sup> (1923) 24 NLR 396.

<sup>51</sup> (1937) 39 NLR 332.

<sup>52</sup> Code of Intellectual Property Act, No. 52 of 1979, s.150.

False representations regarding marks constitute the subject matter of a separate offence. Any person who, for industrial or commercial purposes, makes a representation (a) with respect to a mark not being a registered mark to the effect that it is a registered mark; (b) to the effect that a registered mark is registered in respect of any goods or services in respect of which it is not registered; or (c) to the effect that the registration of a mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitation recorded in the register, the registration does not give that right, is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.<sup>53</sup>

With regard to the interpretation of this provision, the principle is enunciated that a person is deemed to represent that a mark is registered if he uses in connection with the mark the word "registered," or any word or words expressing or implying that registration has been obtained for the mark.<sup>54</sup>

There are several other offences recognized by Sri Lankan law in respect of marks and trade descriptions.

Thus, any person who (a) forges any mark; or (b) falsely applies to goods any marks or marks so nearly resembling a registered mark as to be likely to mislead; or (c) makes a dye, block, machine, or other instrument for the purpose of forging, or being used for forging, a mark; or (d) applies any false trade description to goods; or (e) disposes of, or had in his possession, any dye, block, machine, or other instrument for the purpose of forging a mark; or (f) cause to be done any of the things referred to above in this subsection, is, unless he proves that he acted without intent to defraud, guilty of an offence.<sup>55</sup>

Moreover, any person who sells or exposes for, or has in his possession for, sale, or any purpose of trade of manufacture, any goods or things to which any forged mark or false trade description is applied, or to which any mark so nearly resembling a registered mark as to be likely to mislead, is falsely applied, as the case may be, is, unless he proves (a) that having taken all reasonable precautions against committing an offence he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, or trade description; and (b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or (c) that otherwise he had acted innocently, guilty of an offence.<sup>56</sup>

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<sup>53</sup> *Ibid.*, s.151(1).

<sup>54</sup> *Ibid.*, s.151(2).

<sup>55</sup> *Ibid.*, s.152(1).

<sup>56</sup> *Ibid.*, s.152(2).

Any person who imports any piece-goods ordinarily sold by length or by the piece, manufactured beyond the limits of Sri Lanka, or who sells or exposes for, or has in his possession for, sale, or any purpose of trade, any piece goods ordinarily sold as aforesaid, whether manufactured within or beyond the limits of Sri Lanka, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres, or in standard metres and a fraction of such a metre, according to the real length of a piece, is guilty of an offence.<sup>57</sup> This, however, is subject to the proviso that nothing in this subsection shall apply to any piece-goods manufactured within the limits of Sri Lanka by hand labour only.<sup>58</sup>

Any person who contravenes these provisions is liable to trial before a Magistrate's Court and is liable on conviction to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding two years or to both such fine and such imprisonment, and in the case of a second or subsequent conviction, the above fine or term of imprisonment or both may be doubled.<sup>59</sup>

In these contexts there is a wide range of orders which a Magistrate is empowered to make even in circumstances where the defendant is exonerated from criminal liability. Thus the Magistrate may, whether the alleged offender is convicted or not, order that every chattel, article, instrument or thing by means of or in relation to which the offence has or might have been committed shall be destroyed or declared forfeit to the State or otherwise dealt with as he may think fit.<sup>60</sup>

There is further elaboration with regard to false trade description. Statutory provisions respecting the application of a false trade description to goods or respecting goods to which a false trade description is applied extend to the application to goods:

- (a) of any such figures, words, marks or arrangement or combination thereof, whether including a registered mark or not, as are likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are;<sup>61</sup>
- (b) of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purposes of this provision, the expression "false name or initials" means, as applied to any goods, any name or initials of a person which—(i) are not a mark, or part of a

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<sup>57</sup> *Ibid.*, s.152(3).

<sup>58</sup> *Ibid.*, proviso to s.152(3).

<sup>59</sup> *Ibid.*, s.152(4).

<sup>60</sup> *Ibid.*, s.152(5).

<sup>61</sup> *Ibid.*, s.155(1)(a).



mark; and (ii) are identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials; and (iii) are either those of a fictitious person or of some person not bona fide carrying on business in connection with such goods.<sup>62</sup>

By way of explanation, the statutory provision adds that a trade description which denotes or implies that there are contained in any goods to which it is applied more metres or standard metres than there are contained therein, is a false trade description.<sup>63</sup>

The forging of marks constitutes a distinct offence. A person is deemed to forge a mark who either (a) without the assent of the owner of the mark makes that mark, or a mark so nearly resembling that mark as to be likely to mislead; or (b) falsifies any genuine mark, whether by alteration, addition, effacement of otherwise, and any mark so made or falsified is referred to as a forged mark.<sup>64</sup>

The proviso, however, applies that in any prosecution for forging a mark the burden of proving the assent of the owner lies on the accused.<sup>65</sup>

Further provision is made with regard to applying marks and descriptions. A person is deemed to apply a mark or trade description to goods who (a) applies it to the goods themselves; or (b) applies it to any covering label, reel or other thing in or with which the goods are sold or exposed, or had in his possession for any purpose of sale, trade, or manufacture; or (c) places, encloses, or annexes any goods which are sold or exposed, or had in his possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a mark or trade description has been applied; or (d) uses a mark, or trade description in any manner likely to lead to the belief that the goods in connection with which it is used are designated or described by that mark, or trade description.<sup>66</sup>

A series of explanatory observations are attached to this provision. Thus the expression "covering" is declared to include any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket.<sup>67</sup>

A mark, or trade description is deemed to be applied whether it is woven, impressed, stamped, branded, or otherwise worked into or annexed, or affixed to the goods, or any covering, label, reel, or other thing.<sup>68</sup>

<sup>62</sup> *Ibid.*, s.155(1)(b).

<sup>63</sup> *Ibid.*, s.155(2).

<sup>64</sup> *Ibid.*, s.156.

<sup>65</sup> *Ibid.*, proviso to s.156.

<sup>66</sup> *Ibid.*, s.157(1).

<sup>67</sup> *Ibid.*, s.157(2).

<sup>68</sup> *Ibid.*, s.157(3).

A person is deemed to falsely apply to goods a mark who, without the assent of the owner of a mark, applies such mark or any mark so nearly resembling it as to be likely to mislead, but in any prosecution for falsely applying a mark to goods, the burden of proving the assent of the owner lies on the accused.<sup>69</sup>

### 8.3.2 *Infringement of Copyright*

Any person who wilfully infringes copyright attracts a criminal sanction in so far as he is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction, the above fine or term of imprisonment or both may be doubled.<sup>70</sup>

In this connection, the Magistrate is clothed with power to issue a variety of orders intended to nullify the effects of breach of copyright. Thus, the Magistrate may, whether the alleged offender is convicted or not, order that all copies of the work and all implements used for the infringement, or all plates in the possession of the alleged offender, which appear to him to be infringing copies or plates for the purpose of making infringing copies, shall be destroyed or delivered up to the owner of the copyright, or otherwise dealt with as the Magistrate may think fit.<sup>71</sup>

### 8.3.3 *Patent Infringement*

Similar provision is made with regard to infringement of patents.

Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction, the above fine or term of imprisonment or both may be doubled.<sup>72</sup>

The making of false representations for industrial or commercial purposes with regard to patents is separately provided for. Any person who, for industrial or commercial purposes, makes a representation (a) with respect to a patent not being a registered patent to the effect that it is a registered patent; (b) to the effect that a registered patent is registered in respect of any product or process in respect of which it is not registered; or (c) to the effect that the registration of a patent gives an exclusive right to the use thereof in any circumstances in which, having regard

<sup>69</sup> *Ibid.*, s.157(4).

<sup>70</sup> *Ibid.*, s.144(1).

<sup>71</sup> *Ibid.*, s.144(2).

<sup>72</sup> *Ibid.*, s.147.

to the limitations recorded in the register, the registration does not give that right, is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.<sup>73</sup>

The amplification is attached that a person is deemed to represent that a patent is registered if he uses in connection with the patent the word “registered,” or any word or words expressing or implying that registration has been obtained for the patent.<sup>74</sup>

The unlawful disclosure of information in respect of patents represents the subject matter of distinct penal provision. Any person who, being or having been employed in or at the Registry, communicates any information relating to patents or matters connected therewith obtained by him during the course of his employment in or at the Registry to any person not entitled or authorized to receive such information, or discloses such information to the public or makes any other unlawful use of such information is guilty of an offence, and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding 12 months or to both such fine and such imprisonment.<sup>75</sup>

#### 8.3.4 *Industrial Designs Infringement*

Penal provisions are separately stipulated in respect of the infringement of industrial designs. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of an industrial design is guilty of an offence and is liable on conviction after trial before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction, the above fine or term of imprisonment or both may be doubled.<sup>76</sup>

False representations with regard to industrial designs entail criminal responsibility. Thus any person who, for industrial or commercial purposes, makes a representation (a) with respect to an industrial design not being a registered industrial design to the effect that it is a registered industrial design; (b) to the effect that a registered industrial design is registered in respect of any products in respect of which it is not registered; or (c) to the effect that the registration of an industrial design gives an exclusive right to the use thereof in any circumstances in which, having regard to the limitations recorded in the register, the registration does not give that right is guilty of an offence and is liable on conviction after trial

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<sup>73</sup> *Ibid.*, s.148(1).

<sup>74</sup> *Ibid.*, s.148(2).

<sup>75</sup> *Ibid.*, s.149.

<sup>76</sup> *Ibid.*, 145.

before a Magistrate to a fine not exceeding 20,000 rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.<sup>77</sup>

A person is deemed to represent that an industrial design is registered if he uses in connection with the industrial design the word “registered,” or any word or words expressing or implying that registration has been obtained for the industrial design.<sup>78</sup>

### 8.3.5 *Miscellaneous Provisions*

Encompassed in this category is a group of provisions which are very specific in content and apply to particular situations.

#### (a) *Falsification of Entries in any Register*

Any person who makes or causes to be made a false entry in any of the registers kept under this Code, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false is declared to be guilty of an offence and is liable on conviction after trial to imprisonment for a term not exceeding seven years.<sup>79</sup>

#### (b) *Offences by Bodies Corporate*

Where an offence under the Code has been committed by a body corporate, every person who at the time of the commission of the offence was a director, general manager, secretary or other similar officer of that body or was obliged to act in any such capacity, is deemed to be guilty of such offence, unless he proves that the offence was committed without his consent or connivance and that he exercised all due diligence to prevent the commission of the offence, having regard to the nature of his functions in that capacity and to all the circumstances.<sup>80</sup>

#### (c) *Punishment of Accessories*

Any person who, being within Sri Lanka, abets the commission, outside Sri Lanka, of any act which, if committed within Sri Lanka, would be an offence, is deemed guilty of that offence, and is liable to be indicted, proceeded against, tried and convicted in any district or place in Sri Lanka in which he may be, as if the offence had been there committed.<sup>81</sup>

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<sup>77</sup> *Ibid.*, s.146(1).

<sup>78</sup> *Ibid.*, s.148(2).

<sup>79</sup> *Ibid.*, s.143.

<sup>80</sup> *Ibid.*, s.153.

<sup>81</sup> *Ibid.*, s.162.

(d) *Exemption of Certain Persons Employed in the Ordinary Course of Business*

Where a person is charged with making any dye, block, machine, or other instrument for the purpose of forging, or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves (a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dyes, blocks, machines, or other instruments for making, or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the case which is the subject of the charge he was so employed by some person resident in Sri Lanka, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and (b) that he took reasonable precautions against committing the offence charged; and (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or trade description; and (d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the mark or description was applied, he is required to be discharged from the prosecution, but is liable to pay the costs incurred by the prosecutor unless he has given due notice to him that he will rely on the above defence.<sup>82</sup>

(e) *Special Provisions Regarding "Watches"*

Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks are, *prima facie*, deemed to be a description of that country within the meaning of the statute applicable, and the provisions with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for, sale, or any purpose of trade or manufacture, goods with a false trade description apply accordingly, and for the purposes of the relevant provisions, the expression "watch" means all that portion of a watch which is not the watch case.<sup>83</sup>

(f) *Goods Which May Not Be Lawfully Imported*

All goods which, if sold, are liable to forfeiture, and also all goods made or produced beyond the limits of Sri Lanka, and having applied thereto any name or mark being or purporting to be, or being a colourable imitation of, the name or mark of any manufacturer, dealer, or trader in Sri Lanka, unless such name or

<sup>82</sup> *Ibid.*, s.158.

<sup>83</sup> *Ibid.*, s.159.

mark is accompanied by a definite indication, indicated in letters as large and conspicuous as any letter in the name or mark, of the place and country in which the goods were made or produced, and also all piece-goods such as are ordinarily sold by the length or by the piece, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres and a fraction of such a metre according to the real length of the piece, are prohibited to be imported into Sri Lanka, and are included among goods prohibited to be imported as if they were referred to in section 43 of the Customs Ordinance, and included in Schedule B to that Ordinance.<sup>84</sup>

Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the customs, the Principal Collector of Customs, or other officer specially appointed in that behalf by the Minister in charge of the subject of Finance may require the relevant regulations, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the goods are such as are prohibited to be imported.<sup>85</sup>

The Principal Collector of Customs may, from time to time, with the sanction of the Minister in charge of the subject of Finance, make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited and the conditions, if any, to be fulfilled before such detention and forfeiture, and may, by such regulations, determine the information, notice, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of giving such evidence.<sup>86</sup>

Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in Sri Lanka, that name, unless accompanied in equally large and conspicuous letters by the name of the country in which such place is situated, must be treated as if it were the name of a place in Sri Lanka.<sup>87</sup>

Such regulations may apply to all goods the importation of which is prohibited, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.<sup>88</sup>

(g) *Implied Warranty on Sale of Marked Goods*

On the sale, or in the contract for the sale, of any goods to which a mark, or trade description has been applied, the vendor is deemed to warrant that the mark

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<sup>84</sup> *Ibid.*, s.166(1).

<sup>85</sup> *Ibid.*, s.166(2).

<sup>86</sup> *Ibid.*, s.166(3).

<sup>87</sup> *Ibid.*, s.166(4).

<sup>88</sup> *Ibid.*, s.166(5).

is a genuine mark, and not forged or falsely applied, or that the trade description is not a false trade description unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to, and accepted by, the vendee.<sup>89</sup>

*(h) Inapplicability of Provisions as to False Description in Particular Circumstances*

Where on the commencement of the Code of Intellectual Property Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method of manufacture of such goods, the relevant provisions with respect to false trade descriptions are not applicable to such trade description when so applied.<sup>90</sup>

The proviso is added, however, that where such trade description includes the name of a place or country, and is likely to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, the body of the provision does not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.<sup>91</sup>

*(i) Saving Provisions*

There is provision that Part VI of the Code of Intellectual Property Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of that part, be brought against him.<sup>92</sup> Nothing in this part shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action,<sup>93</sup> but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence under this part.<sup>94</sup> Nothing in this part shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in Sri Lanka who bona fide acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.<sup>95</sup>

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<sup>89</sup> Code of Intellectual Property Act, No. 52 of 1979, s.167.

<sup>90</sup> *Ibid.*, s.168.

<sup>91</sup> *Ibid.*, proviso to s.168.

<sup>92</sup> Code of Intellectual Property Act, No. 52 of 1979.

<sup>93</sup> *Ibid.*, s.169(1).

<sup>94</sup> *Ibid.*, s.169(2).

<sup>95</sup> *Ibid.*, s.169(3).

(j) *Cognizable and Bailable Offences*

All offences under Part VI of the Act are declared to be “cognizable” and “bailable,” within the meaning of those terms as defined in the Code of Criminal Procedure Act, No. 15 of 1979.<sup>96</sup>

8.3.6 *Evidentiary and Procedural Provisions*

There are several provisions which pertain to procedural and evidentiary matters.

(a) *Description of a Mark in Pleadings*

In any indictment, charge, proceeding, or document in which any mark or forged mark is intended to be mentioned, it is sufficient, without further description and without any copy or facsimile, to state that mark or forged mark to be a mark or forged mark.<sup>97</sup>

(b) *Rules on Giving of Evidence*

In any prosecution for an offence under Part VI of the Code of Intellectual Property Act<sup>98</sup> (a) an accused, and his wife or her husband, as the case may be, may, if the accused thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness; (b) in the case of imported goods evidence of part of the shipment shall be prima facie evidence of the place or country in which the goods were made or produced.<sup>99</sup>

(c) *Issue of Search Warrant and Disposal of Goods seized*

Where, upon information of an offence under Part VI of the Code of Intellectual Property Act, a Magistrate has issued either a summons requiring the person charged by such information to appear to answer to the same, or a warrant for the arrest of such person, and either that Magistrate on or after issuing the summons or warrant, or any other Magistrate, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to, which such offence has been committed are in any house or premises of the person charged by such information, or otherwise in his possession or under his control, in any place, such Magistrate may issue a warrant under his hand, by virtue of which it shall be lawful for any police officer, or other person named or referred to in the warrant, to enter that house, premises, or place at any reasonable time by day, and to search therefor and seize and take away the goods or things; and any goods or things seized under any such warrant must be brought before a

<sup>96</sup> *Ibid.*, s.170.

<sup>97</sup> *Ibid.*, s.160.

<sup>98</sup> Code of Intellectual Property Act, No. 52 of 1979.

<sup>99</sup> *Ibid.*, 161.



Magistrate's Court for the purpose of its being determined whether the same are or are not liable to forfeiture under the law.<sup>100</sup>

If the owner of any goods or things which, if the owner had been convicted, would be liable to forfeiture under the relevant law, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a Magistrate's Court may cause notice to be advertised stating that unless cause is shown to the contrary at the time and place named in the notice, the goods or things will be forfeited, and at that time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows sufficient cause to the contrary, may order the goods or things or any of them to be forfeited, and every such order shall be subject to appeal.<sup>101</sup>

Any goods or things forfeited under section 163 or under any other provisions of Part VI of the Act, may be destroyed or be disposed of in such manner as the Court by which the same are forfeited may direct, and such Court may, out of any proceeds which may be realized by the disposal of such goods after all marks and trade descriptions have been obliterated, award to any innocent party any loss he may have innocently sustained in dealing with these goods.<sup>102</sup>

*(d) Costs of Actions*

In any prosecution under the Code of Intellectual Property Act, the Court is empowered to order costs to be paid to the accused by the prosecutor or to the prosecutor by the accused, having regard to the information given by, and the conduct of the parties to the actions and the sum so awarded as costs can be received as if it were a fine.<sup>103</sup>

*(e) Period of Limitation*

A prosecution in terms of the Code of Intellectual Property Act,<sup>104</sup> and not be instituted after three years have lapsed since the commission of the offence or one year after the discovery by the prosecutor of the offence, whichever occurs first.<sup>105</sup>

## 8.4 Remedies

The provision governing remedies fall into three major categories:

- (a) infringement proceedings by the registered owner of the industrial design, patent or mark;

<sup>100</sup> *Ibid.*, s.163(1).

<sup>101</sup> *Ibid.*, s.163(2).

<sup>102</sup> *Ibid.*, s.163(3).

<sup>103</sup> *Ibid.*, s.164.

<sup>104</sup> No. 52 of 1979.

<sup>105</sup> Code of Intellectual Property Act, No. 52 of 1979, s.165.

- (b) infringement proceedings by or at the request of a licensee; and
- (c) declaration of non-infringement.

The provisions applicable in each category are the following:

(a) *Infringement Proceeding by the Registered Owner*

Where the registered owner of an industrial design, patent or mark proves that any person is threatening to infringe or has infringed the said industrial design, patent or mark, as the case may be, or is performing acts which make it likely that infringement will occur, the Court may grant an injunction restraining any such person from committing or continuing such infringement or performing such acts and may award damages and such other relief as to the Court appears just and appropriate.<sup>106</sup> In these same proceedings, however, the defendant may request the Court to declare the registration of the said industrial design, patent or mark, as the case may be, or any part of it, null and void.<sup>107</sup>

(b) *Infringement Proceedings by or at the Request of the Licensee*

In the absence of any provision to the contrary in a licence contract relating to an industrial design, patent or mark, the licensee may in respect of the threatened infringement, infringement or acts referred to in (a) above request the registered owner of the industrial design, patent or mark to apply for an injunction. However, the licensee shall indicate the threatened infringement, infringement or acts being performed, and specify the relief desired; and (b) if the registered owner of the industrial design, patent or mark refuses or fails to apply for an injunction within three months from receipt of the request, apply for an injunction in his own name, with notice to the registered owner who may join in the proceedings. However, the Court may, on the application of the licensee, even before the expiry of the period of three months, grant an injunction if he proves that immediate action is necessary to avoid substantial damage.<sup>108</sup>

(c) *Declaration of Non-infringement*

The Court may on the application of any person showing legitimate interest to which the registered owner of the industrial design, patent or mark, as the case may be, must be made a party, declare that the threatened performance or performance of a specific act does not constitute a threatened infringement or infringement of the said industrial design, patent or mark.<sup>109</sup>

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<sup>106</sup> *Ibid.*, s.179.

<sup>107</sup> *Ibid.*, proviso to s.179.

<sup>108</sup> *Ibid.*, s.180.

<sup>109</sup> *Ibid.*, s.181(1).

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The registered owner of the industrial design, patent or mark, as the case may be, must give notice of the application to any assignee or licensee, who is entitled to join in the proceedings in the absence of any provision to the contrary in any agreement with the registered owner.<sup>110</sup>

Proceedings for a declaration of non-infringement can be instituted concurrently with proceedings to declare the registration of an industrial design, patent or mark null and void.<sup>111</sup> However, this is possible only if the matters in issue in the proceedings for a declaration of non-infringement are not already the subject of infringement proceedings.<sup>112</sup>

It is specially provided that the Judicature Act, No. 2 of 1978, and the Civil Procedure Code<sup>113</sup> is to apply to every application for an injunction made to the Court under this Code.<sup>114</sup>

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<sup>110</sup> *Ibid.*, s.181(2).

<sup>111</sup> *Ibid.*, s.181(3).

<sup>112</sup> *Ibid.*, proviso to s.181(3).

<sup>113</sup> No. of 1977 as amended.

<sup>114</sup> Code of Intellectual Property Act, No. 52 of 1979, s.181(4).









**ANNEX I**

**SELECTED JUDICIAL DECISIONS OF  
THE COURTS OF SRI LANKA**







## JOHN GOSWELL &amp; CO. LTD.

v.

SIVAPRAKASAM (1910) 15 NLR 33

The plaintiff's toilet soap had a registered trade mark, the essential particulars of which were the word "Famora" and the device of a lady with a mirror. The defendant sold a toilet soap called "Farina." The device on the plaintiff's boxes was different to that on the defendant's. Held: that the defendant had infringed the plaintiff's trade mark, as the use of the word "Farina" was calculated to cause defendant's soaps to be taken by ordinary purchasers for the soaps of the plaintiff.

The law relating to infringement of trade marks may be stated in a few propositions.

- (1) It is unlawful for a trader to pass off his goods as the goods of another.
- (2) Even if this is done innocently it will be restrained.
- (3) A fortiori, if done designedly, this is fraud.
- (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal.

"It is not sufficient to satisfy imitation to show that the inscription is ambiguous and capable of being understood in different ways or that a person who carefully examined and studies it might not be misled."

Middleton J at p. 35

The District Judge's order that there was infringement was upheld by the Supreme Court.

## LUKMANJEE v. AKTIEBALAGE (1911) 14 NLR 414

In considering the question whether a trade mark sought to be registered has such a resemblance to the opponent's registered trade mark as to be calculated to deceive, the court must not merely look at the marks as they stand side by side, but at the appearance they would present in actual use when fairly and honestly used.

When the essential particulars consist partly of words in the English language, regard may be had to the fact that the article may be sold in a market where the purchasers cannot read English characters. But the most important principle is that the mark must be looked at as a whole and regard must be had for what has been termed "the net impression." A person applying for registration of a trade mark must disclaim in the application itself any right to the exclusive use of any part of his device. A disclaimer cannot be made to the court during inquiry.

The application was for registration of “Three Cups” safety matches. The opponent had “Three Stars.” Whilst the applicant’s device had three cups depicted, the opponent’s device depicted three stars. In all other details such as colour, lines and design, both were similar.

The District Court disallowed the application to direct the Registrar to register the mark. The Supreme Court upheld the position of the District Judge.

### KAPADIYA v. MOHAMAD (1918) 20 NLR 314

The plaintiff imported flour from Jumna Mills in bags which were marked with two green crossed keys. This device was not registered in Ceylon as a trade mark. The defendant imported flour from another mill marked with one green key. The plaintiff alleged that the defendant had been “passing off” his flour as the plaintiff’s, and prayed for an injunction restraining him from selling bags of flour marked with a green key.

Held that although “passing off” actions are not specifically reserved in our Trade Marks Ordinance, such an action can be maintained under our law. In such an action it is not necessary to prove actual fraud; all that is necessary is to show that the defendant has represented his goods to be the goods of the plaintiff.

Shaw J.— “The courts of this colony are courts of equity as well as of law, and I see no reason why our law should not be sufficiently elastic to expand with the times, and restrain a wrong committed by one trader against another, such as the English Courts of equity found necessary to restrain.”

Held further that as the mark was not the plaintiff’s mark, but of the Jumna Flour Mill Company, plaintiff cannot maintain this action. An importer has no right to the trade mark of the manufacturers, nor can he restrain persons from using it, or register the mark as his own.

On facts, the plaintiff had no assignment of the registered trade mark owners rights and therefore the action failed.

“In a series of English cases, it has been held that the English Acts 1875 to 1883, did not affect the jurisdiction of the courts of equity in ‘passing off’ actions, notwithstanding the prohibition, apparently because that jurisdiction was based on the fundamental rule that no person was at liberty to represent his goods (pass them off) as goods of another, eg. *Mitchell v. Henry* (1880 15 Ch. Div. 181), *Reddaway v. Banham* (1896 AC 199).”

per Ennis J at p. 315

“The cases show that if the get-up of the article is that of the importer or if the mark is put upon it to signify that the article has been selected or imported by the importer, then he can prevent any other person from imitating the get-up or mark so as to induce purchasers to believe that the goods are those selected and imported by him. If, however, it is merely the get-up or the mark of the manufacturer, then the importer acquires no rights to it from the fact of his importation, neither can he register the mark as his own.”

per Shaw J at p. 317

HOLLANDIA AND ANGLO-SWISS CONDENSED MILK CO.

v.

THE WESTERN AND ANGLO SWISS CONDENSED MILK CO.

(1923) 24 NLR 396

The applicants and respondents were manufacturers of condensed milk. The respondent's trade mark, registered in 1893, was the figure of a maid with a pail on her head and another in the hand, and their condensed milk was known as the "Milkmaid Brand." The applicants sought to register their mark, which consisted of a female figure carrying a bunch of flowers in one hand and a sword in the other enclosed in an oval with five medals above the figure, and the words "Guarantee" in thick letters across it and the word "Hollandia," displayed beneath. The District Judge refused the application, on the ground that the use of a female figure by the applicants, though it may not mislead an intelligent and cautious purchaser who knew English, might deceive an unwary purchaser in Ceylon.

Held: that the applicant's mark is in itself not calculated to deceive and there is no evidence whatever that the applicants have any design to facilitate the passing-off of their goods as the goods of the respondents.

“The deception is not in the use of the mark, but in passing off of the goods of one person as those of another by the trader. The remedy in such a case is an action for damages against the trader and the mere possibility of deception by passing off is not a good ground for refusing registration of the mark.”

Held: that the applicant was entitled to register his mark. Emphasis was placed in argument on the leading characteristics or the "dominating portion" or "a material and substantial" part of the opponent's trade mark.

The condensed milk of the opponent was referred to as Nona Kiri (Sinhalese for lady milk) and Nona Pal (Tamil for lady milk) and it was claimed that though it may not mislead an intelligent and cautious purchaser who knew English, it might deceive the unwary purchaser in Ceylon.

Though the District Judge upheld the opponent's position, on appeal the Supreme Court set his order aside.

The Supreme Court held that merely because a trader might result to passing off by supplying applicant's goods when "Nona Kiri" or "Nona Pal" is asked for, this does not necessary justify the conclusion that the mark is similar or calculated to deceive.

Though the central feature may be the same, the Court held that the two trade marks were not by themselves capable of being confused. The Court also did state that the purchasers of Ceylon possessed a great degree of shrewdness, and it was unlikely that they would be confused by the two trade marks.

CHEESE BOROUGH MANUFACTURING CO. v.  
KUDHOOS (1928) 30 NLR 161

In an application to expunge a trade mark from the register the applicant must prove that the two marks so resemble each other as to deceive purchasers of ordinary caution.

Such a proceeding is in the nature of an action for infringement, and the applicant is not entitled to rely on additional matters which are connected with the trade or goods and relevant in an action for passing off.

Note: This case discusses the distinction between passing off and trade mark infringement. The matters to be considered are different and to rely on get-up, bottle shapes, etc. which have nothing to do with the trade mark is not permissible in trade mark infringement proceedings.

SAHIB v. MUDALIYAR (1929) 31 NLR 288

When a person uses in Ceylon the word "Registered" in connection with a trade mark which is not registered in terms of the Trade Marks Ordinance No. 15 of 1925, he is guilty on offence under section 64(1) of the Ordinance, even though the mark may have been registered in another country and even though goods may be imported.

JAMES v. SOPER (1930) 31 NLR 1930

A party opposing on application for the registration of a trade mark is not entitled to raise at the hearing of an appeal from the decision of the Registrar a ground of objection which he did not take before the registration but which was known to him at the time.

ABDUL CADER v.  
THE MADRAS PALAYAKAT COMPANY LTD. (1933) 35 NLR 48

Where an application for registration of a trade mark is opposed on the ground that the applicant's trade mark so nearly resembles the opponent's as to be calculated to deceive, and it is established that they resemble each other.

Held: that the burden of proving that there is no reasonable probability of deception is on the applicant.

The question whether the two trade marks so nearly resemble each other as to be calculated to deceive must be determined by considering what is the leading characteristic of each, and whether the main impression which would remain with any person seeing them at different times is the same.

The fact that a registered trade mark has certain features to which exclusive rights have been disclaimed by the owner does not preclude the Registrar from looking at these features in infringement proceedings. Registration was disallowed, as the marks resembled each other closely.

LIPTON v. RAWTHER et al (1933) 35 NLR 129

The applicants applied for the registration of a trade mark in respect of tea consisting of the device of a man-of-war of the cruiser type with the words "ENTERPRISE BRAND" below. The application was opposed by the respondents on the ground that the device sought to be registered so nearly resembled their own registered device as to be calculated to deceive. The respondent's trade mark was registered in respect of the same goods and the essential particulars of the mark were, the device of a steamship with the words "STEAMSHIP BRAND." It was established that the respondent's tea had become known as "ship brand" tea.

Held that the applicants were not entitled to register their trade mark.

Note: Though the devices were not identical and the types of ships depicted varied, yet the court held that there was the likelihood of confusion and deception, and therefore disallowed registration, although the registry had allowed registration.

VEERAVAGATHPILLAI v. SAIBO (1934) 36 NLR 317

The applicant applied for the registration of a trade mark, in respect of flour, called the Hanuman Brand, considering of the figure of a monkey in a standing position.

The respondents had registered a trade mark in 1913, also in respect of flour, called Pahlwan, consisting of a strong man in a standing position holding up a pair of dumb bells. The respondent's trade mark was known in the trade as the man mark.

Held: that the trade mark proposed by the applicant so nearly resembled the respondents' as to be calculated to deceive the public.

Held, further: that in the circumstances, the burden was on the applicant to satisfy the court affirmatively that his mark was not calculated to deceive.

This case emphasizes that the test is not a side by side comparison of the two marks but whether a consumer would suppose that the mark is that of another so as to be misled.

Registration was not allowed.

LEVER BROTHERS v.  
R.Pl. RANGANATHAN PILLAI (1937) 39 NLR 332

The plaintiff was the proprietor of a trade mark in respect of perfumed toilet soap. The trade mark consisted of a label having printed thereon the word "LUX" and certain designs within a facing border.

The cake of soap had on one side the word "LUX" cut into it, below it a floral design followed by the words "toilet soap," on the other side were cut the words "Lever Brothers."

The soap imported by the defendants was contained in a wrapper, the prominent feature of which was the word "Rex" smaller in size than the letters forming the word "Lux" and of a different shade.

To the left of the word "Rex" and below it was the picture of a man on a camel and some palm trees and pyramids in the distance, on one side of the cake appeared the word "Rex" and a floral design similar to the design on the plaintiff's soap, followed by the words "Made in Japan."

Held: that the mark of the wrapper on the soap imported by the defendants was calculated to deceive and amounted to an infringement of the plaintiff's trade mark.

Held also, by Hearne J. that the fact that the soap imported by the defendant had been detained at the customs and had not reached the Ceylon market did not preclude the plaintiff from bringing the action.

"The salient feature on the cakes of soap sold by the plaintiffs and imported by the defendants is, in my opinion, the two words of three letters both of which end in the letter X. Both of them are Latin words and the letter E of the word 'Rex'

can be given the sound of the letter U, so that the work 'Rex' can have a sound similar to the word 'Lux'. The defendant's mark of 'Rex' and the floral design below it placed on a cake of soap of exactly the same size and shape as the soap sold by the plaintiffs is, in my judgement, calculated to deceive. The two soaps are also similar in smell, which would add to the possibility of deception."

As the goods had been stopped at the customs and no actual loss occurred, plaintiff was held entitled only to nominal damages.

#### ABDUL AZIZ v. MOHAMED BUHARY (1937) 39 NLR 364

When a person registered under the trade marks Ordinance a Trade Mark in respect of silver medals, consisting of two spade-shaped shields on one of which was displayed the device of a pagoda and on the other a Swastika and five weapons known as Panchayuda (five weapons).

Held that the sale of medals with the device of a dagoba on one side and the panchayuda on the other did not constitute an infringement of the trade mark, as the device was not used qua trade mark but as part of the medals.

A trade mark registered in respect of silver medals does not extend to medals made of any other medals.

Note: The medals were believed to have a curative value as charms because of the symbols used on them. Hence it was held that the purchase was not because of identification with manufacturer/producer but due to professed "magic" in the symbols.

#### CADER SAIBO & CO. v. MOWLANA (1937) 39 NLR 370

The complainants, a firm of merchants dealing in fabrics, registered in respect of it a trade mark consisting of the word "Moulana" in block capitals. At the same time they obtained registration in respect of goods of another class consisting of paper bags, wrappers and containers, the trade mark "Moulana" written abliquely across the bag in cursive writing terminating with a flourish.

The accused who was a dealer in drapery and oilmans stores and whose name was Moulana used the word on paper bags, printed in the same style as the word figuring in the complainants' bags, in order to indicate that the goods which were enclosed in them were purchased at the shop at which he traded.

Held, that the use of the paper bags for the purpose indicated did not amount to an infringement of the complainants' trade mark.

"The word has clearly been applied to indicate that the goods enclosed in the bags were purchased at a shop owned by a proprietor whose actual name was



Moulana and who traded under the name of MOWLANA, and whether that proprietor was represented in any way as being connected with another firm is, I am satisfied, certainly not to the purpose.”

per Abrahams C.J. at p. 374

OHAMED ET AL v. MOHAMED UVAINS (1942) 43 NLR 176

Where, in an action for the infringement of a trade mark, the label used by the defendants on their goods was distinct and incapable of being mistaken or confused with the label of the plaintiff, the burden is upon the latter to establish by evidence that their goods are known by some name or descriptions of such a nature that the use of the defendant's label would cause people to think that the goods having that label were the goods of the plaintiff.

Held: that there was no infringement as the labels were distinct in every detail.

ABDUL CAFFOR v. AHAMED (1942) 43 NLR 460

In an application for the registration of a trade mark it is within the discretion of the Registrar acting on material that has been disclosed before him to refuse registration of a trade mark if, on such material, another ground of opposition could properly have been taken by those who opposed the registration.

In the event of an appeal to the District Court, the judge of that court is entitled to examine only the grounds of opposition originally taken by the opponents unless, at the instance of the Registrar, leave is obtained to argue the appeal before the district court on a ground which was not included in the grounds of opposition on which the Registrar was originally invited to refuse the application.

SUBBIAH NADAR v.

SOKKALAL RAM SAIT (1946) 47 NLR 241 (Privy Council)

The plaintiff who was the proprietor of two trade marks registered in the years 1930 and 1934 alleged that he had exclusively used the said trade mark on packets of beedies manufactured and sold by him since the years 1912 and 1934 respectively; that by reason of this user the plaintiff's beedies had been known to purchasers and intending purchasers as "Photo Mark Beedies," "Ram Sait Beedies" and "Sokkalal Beedies" meant the beedies made and sold by the plaintiff; that the defendants had infringed the plaintiff's trade marks and had advertised and sold in Colombo beedies not of the plaintiff's manufacture as "Photo Mark Beedies." The plaintiff claimed an injunction to restrain such infringement and passing-off.

The defendants in their answers denied infringement and passing-off and further pleaded that they had used the marks complained of by the plaintiff in connection with their trade in beedies from a time anterior to that of user in the date of registration of the marks of the plaintiff. They also raised the issue of honest concurrent user.

In 1915 the defendants registered their trade mark with the Chamber of Commerce in Madras and in 1917 this plaintiff registered his trade mark with the Chamber of Commerce. The evidence on record established the fact that the defendants copied the design of the plaintiff.

- Held
- (i) that the question of infringement should be considered in relation to the plaintiff's trade mark as a whole and not to particular parts of them.
  - (ii) that on the issue of anterior user, the fact that the defendants had registered their mark in Madras in the year 1915 was not of importance and did not prove user of the mark. Even if the defendant's mark was first used in Ceylon in 1916, there was no evidence of continuous user between that date and about 1930.
  - (iii) that the fact that the defendant's originally copied the trade mark of the plaintiff cast a heavy burden on the defendants to show that any concurrent user on their part was honest. Evidence of long concurrent user to the knowledge of the plaintiff in such circumstances that the plaintiff must be deemed to have acquiesced in such user and waived any right to object to it might suffice, but there was no such evidence.
  - (iv) that the plaintiff was entitled to an injunction to restrain infringement of his two trade marks but, in the absence of proof that the description "photo" or "photomark" beedies had come to be regarded in Ceylon as denoting exclusively the beedies of the plaintiff, he was not entitled to an injunction to restrain passing off.

CEYLON INSURANCE CO. LTD.

v.

UNITED CEYLON INSURANCE CO. LTD. (1947) 48 NLR 451

Plaintiff, the Ceylon Insurance Company, brought an action to restrain the defendant from using the name "United Ceylon Insurance Company" on the ground that it so nearly resembled the name of the plaintiff as to be calculated to deceive.

Held that the plaintiffs had no exclusive right to the use of the word "Insurance" which was merely a description of the business carried on by both parties and that the addition of the word "United" sufficiently distinguished the defendant.

**MOHIDEEN ET AL v. REGISTRAR OF TRADE MARKS (1955) 57 NLR 535**

When considering whether a Trade Mark which is proposed to be registered, so nearly resembles an already registered Trade Mark as to be "calculated to deceive," within the meaning of the Trade Marks Ordinance, the test to apply is not whether if a person is looking at the two trade marks side by side there would be a possibility of confusion, but whether the average person who sees the proposed trade mark in the absence of the registered trade mark would mistake the proposed trade mark for the registered trade mark.

The applicant had sought registration of the following:-

The opponent's registered mark was:

"No standard test of what is likely to deceive the purchaser can be laid down. The tests laid down in the decided cases are rarely capable of extension to other cases. In the circumstances of this case we think the test to apply is not whether if a person is looking at the two trade marks side by side there would be a possibility of confusion; but whether the average person who sees the applicant's trade mark in the absence of the registered trade mark and has only a general recollection of the registered trade mark would mistake the applicant's trade mark for the registered trade mark.

With all these marked differences no customer is likely to mistake the applicant's trade mark for the registered trade mark. The applicants have not taken into their trade mark any distinctive feature of the registered trade mark."

per Basnayake A.C.J. at p. 37

The words "calculated to deceive" do not imply intention to deceive but likelihood of deceiving.

**S. WIJESINGHA MAHANAMAHEWA AND ANOTHER**

v.

**AUSTIN CANTER (1986) 1 CALR 620**

The Plaintiff-Respondent instituted action in the District Court alleging infringement of a system of Sinhala shorthand devised by him from the Gregg System and evidenced by certain works published between 1952 and 1964. The

Defendant-Appellant averred that he himself had evolved a system of Sinhala shorthand based on the Gregg System. Though both parties had based themselves on the Gregg System evidence revealed that the Defendant's system had used some symbols which had been adapted by the Plaintiff-Respondent, whilst containing much created by the Defendant himself. The trial judge gave judgement for the Plaintiff-Respondent whereupon the Defendant-Appellant appealed to the Court of Appeal.

Held—The Court of Appeal allowing the appeal held—

1. A literary work is one expressed in print or writing irrespective of the question whether the quality or style is high.
2. The Plaintiff's shorthand was entitled to copyright even though based on Gregg System as it was a literary work revealing originality or novelty in expressing (not merely in thought) by considerable use of knowledge, labour, judgement and skill of the Plaintiff.
3. Whether reproduction which amounts to infringement of copyright is substantial has to be considered from the aspect of quality rather than quantity.
4. Both the Defendant and the Plaintiff had adopted the entire Gregg System and to this extent the Plaintiff's work lacked originality.
5. The Defendant-Appellant having copied only a few of the symbols used by the Plaintiff-Respondent cannot be deemed to have substantially reproduced the Plaintiff-Respondent's work.
6. Reproduction of the Plaintiff-Respondent's work not being substantial in extent, there was no infringement of the Plaintiff-Respondent's copyright.

M.S. HEBTULABHOY AND COMPANY v.  
STASSEN EXPORTS LTD & WICKRAMANAYAKE

Palandikar J.

M.S. Hebtulabhoy and company the petitioner-appellant Company are for many years exporting tea to foreign buyers. They have registered a trade mark "Rabea" in use and valid from 06-10-1969 till 06-10-1993. The certificate of Registration bears the number 31953. It is stated in that certificate (P1) that a translation of the word "Rabea" cannot be used. The word "Rabea" is Arabic, means spring-one of the four seasons. Thus the word spring or its equivalent in any other language will not have the protection as a Trade Mark. It is to be noted that the visual mark "Rabea" is in Roman letters.

In September, 1981 the Petitioner appellant became aware that the 1st Defendant-Respondent Company (referred hitherto as Respondent) was doing acts which he complained were in violation or rights of ownership of the Trade Mark "Rabea." The Respondent was exporting tea with the label "Chai el Rabea" to

Egypt. When the attention of the Respondent was drawn to this matter by the appellant the respondent gave an undertaking that he would desist from doing so and would not indulge in unfair trade practice.

However in July, 1983 the appellant became aware that Respondent was exporting tea to Egypt in packages bearing the name "Chai el Rabea" in Arabic.

The Petitioner moved the District Court, Colombo and obtained an interim injunction restraining the Defendant from shipping a consignment of tea bearing the labels chai el Rabea.

The Respondent sought to have this ex parte order suspended but the Court refused the application. The Court of appeal suspended the operation of the injunction in respect of that shipment only by order dated 27-09-1983 but upheld the order refusing to suspend the injunction.

The Supreme Court issued a stay order of the Court of Appeal order of 27-09-1983, but the shipment we are informed left the country with the labels having availed of the order of the Appeal Court of 27-09-1983. The Supreme Court further directed that the petitioner's application for a permanent injunction restraining the use of the Defendant-Respondents label be heard and concluded by order dated 28-05-1984.

The learned trial Judge went to trial on twenty-two issues. He has found that the appellant cannot maintain this action for an injunction and awarded compensation to the respondent in a sum of eight million rupees. The appellant has averred in his plaint that the Respondent is acting in a manner calculated to mislead purchasers and others into the belief that tea that is offered for sale exported and/or sold by the defendants is the tea of the plaintiffs firm known as "Rabea."

At the argument in appeal, learned Queens Counsel for the appellant cited numerous authorities to show that the learned trial Judge had answered the issues relating to the infringement for the Trade Mark rights of the appellant erroneously by holding that there was no violation of the rights.

Learned President's Counsel for the respondents objected strenuously to the reference to this aspect relating to the state of law as being prior to the Code of Intellectual Property Act No. 52 of 1979.

He relied on the views expressed by Lord Halsbury in the *Bank of England v. Vagliano Brothers* case (House of Lords 1891 at page 108) in regard to codified statutes. He said that "construing the statute by adding to it words which are neither found therein nor for which authority could be found in the languages of the statute itself is to sign against one of the most familiar rules of construction." He further said that he was wholly unable to adopt the view that where a statute is expressly said to codify the law you are at liberty to go outside the code so created because before the existence of that code another law prevailed.

Lord Herschell too supported this view and stated that appeal to earlier decisions can be justified only on some special ground.

In *Budget Cooper v. Adams* 1894 (L.R. Ch.Div.) Vol. III 562—Chitty, J. said that in a consolidating and amending Act but not in an act that codifies the existing law it would be legitimate to refer to the previous state of the law for the purpose of ascertaining the intention of the legislature.

We would agree with counsel for the appellant that the word “code” in act number 52 of 1979 is a more cliché, but in reality it is an amending and consolidating act embodied in the form of a code as set out in the long title to the Act. Thus the stringent views referred to earlier cannot be held to govern the approach to the proper examination of the Rights of the Registered owner of a trade mark as laid down in Section 117 of the act.

The relevant section of the Act would be Section 117, Subsection (2)(a) which precludes any use of the mark, or of a sign resembling it in such a way as to be likely to mislead the public for goods or services in respect of which the mark is registered or for other goods or services in connection with which the use of the mark or sign is likely to mislead the public by a third party without the consent of the Registered owner.

We were invited to place a stringent construction on the words “use of a mark or of a sign resembling it” thereby precluding the recourse to manner in which deceptive similarity by resemblance has been viewed, interpreted and evaluated in all legal systems where the proprietary right in a trade mark has been recognised. On a review of all the relevant authorities cited on this matter, it would be cardinal sin if one were to turn a blind eye to the development of the law on this subject and merely examine the conflicting mark in the light of visual similarity also as the argument seems to imply. The negative answers to issues 5(a) and 5(b) without any analysis of the reasons given thereto seem to reveal that the trial Judge has fallen into grievous error of looking at this problem on the basis of visual similarity alone, although we find it difficult to reconsider his finding of fact expressed in the judgement that there should be confusion of goods if exported to the same market. Such a confusion which he conceded can only arise from an analysis of the Registered mark and the mark used by the Respondent. The learned trial Judge held that the Respondent’s mark “chai el Rabea” is a transliteration of the Registered mark Rabea in Arabic characters. The translation would be “spring”. The law does not protect any use of “spring” by the appellant.

In deciding whether “RABEA” in Roman characters and “Chai el Rabea” in Arabic are deceptively similar the decision is a matter for decision by the Judge who looking at documents and evidence before him comes to his own conclusion. This rule was expressed by Lord Parker in *Spalding v. Gamage* 32 R.P.C. 286. Justice Rodrigo in *Suby v. Suby* 2 Sri Lanka Law Reports (1980) 65 agreeing with

this view states that the Court in exercising its own mind has to look at it from a business, and common sense, point of view.

Examined in this manner, Rabea the mark of the appellant and Rabea in the mark of the respondent are identical phonetically speaking. There was no evidence that these words are pronounced in different ways. The phonetic similarity seems to be the basis of the trial Judge's conclusion that there would be confusion. Both from a business and a common sense point of view, no other conclusion is possible.

I would at this stage refer to the case of *Electrolux Ltd. v. Electrix Ltd.* 71 R.P.C. 23 "Electrix" was the mark registered for vacuum cleaners. Though no instance of confusion with the mark Electrix was proved, their similarity made the latter mark an infringement of the former mark. The question whether there is confusing similarity is primarily one for the Judges. Lord Evershed said that the Judge must make up his mind and not abdicate the decision in that matter to witnesses before him.

In the *Dewhurst's* application for a Trade Mark 13 R.P.C. 238 Lindley L.J. held that registration of letter "Golden Fan" in Burmese characters while there was already registered a mark "Golden Fan" in English was an obvious deception. "You cannot have another mark 'Golden Fan' in any language or any heiroglyphics."

The same learned Judge in the case of the Trade Mark of *La Societe Anonyme Des Verriers De l'Etoile* 11 R.P.C. 142 in considering whether the words "Red Star Brand" was an infringement of a device of a star on window glass has held the latter as being calculated to deceive by appealing to the eye or the ear.

Lawrence, J in *Freia Chocolate Fabriks* (41 R.P.C. 653) considered whether "Freia" would infringe on the Trade Mark "Fry" used on chocolates and held that the words would sound the same to the ordinary purchaser. The crux of the matter is the confusion to the ear of the ordinary purchaser. Viscount Simmonds with Lindley M.R. agreeing in *Electrix v. Electrolux* (1959) 3 A.E.R. 170 held that if a word could not be registered for any reason than its phonetic equivalent would also be unregistrable.

"Berlei" and "Bali" were considered in *Berlei U.K. Ltd. v. Bali Brasiere Co. Incorporated* (1967) A.M.R. oral confusion possible. The attempted use of the trade mark would have been calculated to deceive. Lord Guest with whom Ungood Thomas, L.J. and Diplock L.J. agreed said that the visual similarity is negligible. The likelihood of substantial confusion arising from the pronunciation of words seems to be obvious. On this phonetic aspect, it was held that there was great possibility of confusion. In the *Erven Warnick Besloten Verootschap and another v. Townsend* (H.L. 1979—A.C. 731).

The plaintiff produced and sold a distinct and recognisable species of beverage called "Advocaat." The defendant sought to sell a beverage called Keelings Old English Advocaat.

Lord Diplock said that the facts seem to disclose a case of unfair not to say dishonest trading of a kind for which a rational system of law ought to provide a remedy to other traders whose business or goodwill is injured by it.

In the Madras case of *Chinne Krishna Chettiar v. Sri Ambal Co.* 1979 A.I.R. Vol. 57 page 146 the plaintiff sold snuff with the registered name "Ambal." The defendant seeking to register "Andal" was not permitted to do so, having regard to this striking similarity and phonetic resemblance of the two names. Bachawat, J held that even if there is no visual resemblance that does not matter where there is close affinity of sound.

Jagadisan, J said in the Madras High Court, that nobody can abstract the name or use a phonetical equivalent and escape the charge of piracy pleading that the visual aspect is different from the mark of the opponent. The resemblance between the two marks have to be considered with reference to the ear as well as to the eye.

Ramamurti, J in *Balaji Chettiar v. Hindustan Lever Ltd*, Bombay A.I.R. Madras 1967 at page 148 dealing with the plaintiffs registered name Sunlight and the mark Surian with representation of Sun in Tamil used on soap held that confusion would be caused. A lack of knowledge of English can make the confusion even more unavoidable and imminent. Middleton, J in *John Gosvel v. Sivaprakasam* 15 N.L.R. 33 held that "Farina" soap was an infringement on "Famora" soap. Quoting Kerly (Trade Mark) he said that it is not sufficient to show that a person who carefully examines and studies might not be misled.

Dalton, A.C.J. in *Lipton Ltd. v. Rawther* 35 N.L.R. 129 interpreting the words "calculated to deceive" used in Section 19 of the Trade Marks Ordinance said that a customer can only contrast the mark on the goods offered to him with his recollection of the mark as seen and remembered in the articles and not necessarily in the form as they appear in the register. Considering the names, "Man of War Enterprise Brand Tea" and "Steamship Brand Tea" it was held that device of "ship" was a prominent feature in both marks and that confusion will result and deception would follow.

In *Veeragathipillai v. Saibo* 36 N.L.R. 317 Akbar, J considering the choice of monkey similar to man mark "phalwan" mark for flour said that the figure of a standing monkey was chosen from an infinite number of designs to select. It was a choice calculated to deceive.

Martinez, J in *Lever Brothers v. R.Pl. Renganatha Pillai* 37 N.L.R. 332 said that the name "Rex" on soap was calculated to deceive the plaintiff soap bearing



Trade Mark “Lux.” Considering further the size and shape of the commodity it was held that there was possibility of deception.

In the light of the views expressed by Judicial authority in both local and foreign cases considered above, one has to consider the comments in Callman’s treatise on unfair competition 4th Edition Vol. 3 on motives for the selection of Trade Marks. “A boundless choice of words, phrases and symbols is available to one who wishes to mark to distinguish his product or service from others. When a defendant selects from this practicably unlimited field a trade mark confusingly similar to the mark publicly associated with the plaintiffs product, then it would appear that the defendant makes the particular choice in order to trade upon the plaintiffs established reputation. If there is no reasonable explanation for the defendants choice of such a mark though the field of his selection was so broad the inference is inevitable that it was chosen deliberately to deceive.”

The evidence shows that the Respondent has no explanation to offer for the choice of Chai el Rabea as his trade mark. He has stated that his buyer Enany from Egypt wanted this mark put and he did so. The evidence further discloses that this mark was put on labels and fixed to boxes and covered by gunny bags and packed for shipment. The mark is produced as ID26. It was pointed out from the documents produced that the invoices do not show Chai el Rabea but words “yellow Spring.” It was also established beyond doubt that the labels were pasted in Colombo. This fact was in fact found to be so by the learned trial Judge who says “the packetting of tea under this trade name by the 1st defendant has taken place in Colombo. If there is an infringement at all it commences with the packetting of tea which has taken place in Colombo.” One need not comment further on this factual assessment in consonance with the law for the law can only protect the owners rights in this country.

The vital question is therefore whether there was an infringement at all. The selection of the name Chai El Rabea by the respondent lent itself to suspicion of fraudulent motive to trade upon the appellants reputation. The test applied by Fernan, J in *Converse Rubber Corporation v. Universal Rubber Products — Phillipines S.C.* 1987—G.R.N. 27976 who expressed the views referred to on the selection of the name was that there was the likely effect of deception. It implied that no proof of actual deception was necessary. The words in our statute it would be apposite to observe at this stage are “likely to mislead the public”. Pertinent to this aspect of the discussion the view expressed by Phillip, J in *Standard Oil Co. of New Mexico v. Standard Oil Co. of California* 56 Fed. Rep. 2nd Edition 973 with regard to the choice of the Standard Oil Co. by the defendant identified one objective in doing so by the defendants namely to improperly obtain advantage of the goodwill associated with the name standard oil of the plaintiffs.

The Respondent must extricate himself from his situation by purging his choice of name of a capacity to deceive. The respondents statement that his Egyptian buyer Enany wanted this name pasted in Colombo gives the clue to his motivations. The Respondent was made to use the name deliberately with a view to obtaining some advantage from plaintiffs investment in promotion and established goodwill of his trade mark. In this case where the facts show a sale to a middleman as distinct from an ultimate buyer—the consumer, the tort is really complete when the attending goods are sold to him. (*Draper v. Trist and others* 1969(3) A.E.R. 513). Manton, J in *Hecker H.O. Co. Inc. v. Holland Food Corporation* 36 Fed. Rep. 767 held that when the defendant affixed “H.O. Food” labels to his goods packaged and exported, it is sufficient for decision to hold that there was a violation of the plaintiff’s H.O. trade mark. Somewhat identical facts transpire in the instant case. The respondent has affixed the labels in Colombo prior to export and committed an infringement of the Appellants rights as a Registered owner of the trade mark.

The learned Trial Judge gave his reasons for holding that there was no infringement. In considering the phrase “likely to mislead the public” in Section 117 of the code, he held that the evidence shows that the plaintiff exported only to Saudi Arabia and there was no possibility of misleading the public as they were in two different places. He applied what may be called a destination formula to decide the question.

The word “public” it was strenuously contended was the public at large and not the public of any particular destination. The public was not merely the consumer public but the members of the business community as well. We do not think that it is in accord or harmony with the concept of trade mark law to take a restrictive view of the public and contain them in geographically defined areas, or political divisions or countries. At the trial, it was pointed out that Saudi Arabia is a unique country in the Middle East as a centre of Muslim pilgrimage. Muslims go to Mecca in Saudi Arabia from all over the world not to mention Egypt alone, on more than one occasion every year. In such a centre it hardly need be laboured that the word Rabea associated with the plaintiff’s tea has assumed a degree of popularity and goodwill large enough for Enany to want to pirate it to Egypt under his own mark although preserving the lace of its origin from Sri Lanka by affixing the labels in Colombo itself.

In the case of *Arthur Guinness Son and Company v. Oscar Von Bermuta Incorporated* 14 Fed. Supp. page 210. Having considered the confusion of the names used in the complainants brew and the defendants malt extract it was held that it would be injurious and unfair even if the complainant’s products are not sold in this country now, it can be sold in the future.

The consumer public of a future prospective class is also protected by the policy of the law against infringement.

In the case of *Brookes Brothers v. Brookes Clothing of California* 60 Fed. Supplement 442 it was held by Yenwick, J that even if goods are not in competition the law protects the plaintiff in his interests in other goods services or business used by the plaintiff are likely to be regarded by prospective producers, is associated with the source identified with the same name. One can easily be attracted to the argument that the respective products reach different destinations but as the learned trial Judge himself observed the infringement if any took place in Colombo. It is the interests of the Registered owner that is protected by the law.

Kiley, J in *Tisch Hotels Incorporated v. Americana Inn Incorporated* 350 Fed. Rep. 2nd Series page 609 said that even if the parties are not directly in competition geographically, in size, or in cost of service, it does not preclude the relief sought by the plaintiff. Even though the customers of the plaintiffs hotels were in Mexico city and the defendants would be in Chicago, one would conclude that there is likelihood of confusion in the minds of the prospective purchaser.

The Counsel for the Respondent did not refer us to any considered view already expressed on what may be termed the destination formula postulated by the trial Judge. In our view, it is an unwarranted and narrow view of the term "public" and not reflective of the meaning that it intended to be attributed to it in its statutory context. The public is very properly the public present, prospective local and foreign. A buyer who belongs to the public at large, not excluding the consumer in Sri Lanka itself.

If the trial Judge's view on the destination is correct then one might expect a statutory requirement that the registered owner should declare his destination too in his application for a Trade mark.

Therefore, the answers to issues raised by the defendants numbered 10 to 20 are erroneous. The learned trial Judge also held that Middle East referred to by the appellant is restrictive only to Saudi Arabia. But Saudi Arabia is one of the States in the Middle East and the appellant has been regarded as an exported to the Middle East of which Saudi Arabia is one country. The appellants tea reaches it soultled to Basham the importer in Saudi Arabia but the consumer public cannot be restricted to the public of Saudi Arabia alone. There is no proof that there is such a restrictive sale to Saudi Arabian consumers only. In a country which includes a pilgrim traffic on a very large scale to Mecca such a restriction on the identity of the consumer would be very artificial or unrealistic.

We therefore hold that the first Respondent infringed the rights of the appellant the owner of the Trade Mark Rabea. The appellant is therefore entitled to an injunctive remedy against the first Respondent.

We accordingly set aside the judgement of the learned trial Judge and grant the permanent injunction as prayed for by the petitioner-appellant with costs fixed at fifteen thousand rupees.(Rs. 15,000/-).

The order for compensation is also set aside as the injunction asked for it hereby granted.

P.R.P. Perera, J.

I agree

S.N. Silva, J.

I agree.













ANNEX II

**CODE OF INTELLECTUAL PROPERTY ACT,  
No. 52 of 1979 (as amended)**

**CODE OF INTELLECTUAL PROPERTY REGULATIONS  
of 1980**





PARLIAMENT OF THE DEMOCRATIC  
SOCIALIST REPUBLIC OF  
SRI LANKA

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CODE OF INTELLECTUAL PROPERTY  
ACT, No. 52 OF 1979

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[Certified on 8th August, 1979]

*Printed on the Orders of Government*

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*Code of Intellectual Property Act, No. 52 of 1979*

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*Code of Intellectual Property  
Act, No. 52 of 1979*

[Certified on 8th August, 1979]

L. D.—O. 53/78.

AN ACT TO REVISE, CONSOLIDATE, AMEND AND EMBODY IN THE FORM OF A CODE THE LAW RELATING TO COPYRIGHT INDUSTRIAL DESIGNS, PATENTS, MARKS, TRADE NAMES AND UNFAIR COMPETITION AND PROVIDE FOR THE BETTER REGISTRATION, CONTROL AND ADMINISTRATION THEREOF AND FOR MATTERS CONNECTED THEREWITH OR INCIDENTAL THERETO.

BE it enacted by the Parliament of the Democratic Socialist Republic of Sri Lanka as follows :—

1. This Act may be cited as the Code of Intellectual Property Act, No. 52 of 1979, (hereinafter referred to as the "Code") and shall come into operation on such date as the Minister may appoint by Order published in the *Gazette* (in this Code referred to as the "appointed date").

Short  
title  
and  
date of  
operation.

PART I

ADMINISTRATION

CHAPTER I

2, (1) There may be appointed a person to be or to act as Registrar of Patents and Trade Marks of Sri Lanka (hereinafter referred to as the "Registrar").

Appoint-  
ment of  
Registrar  
and his  
duties.

(2) In default of such appointment the Registrar of Companies or any person for the time being acting as such shall discharge the duties of the Registrar under this Code.

(3) The Registrar shall, subject to the directions of the Minister, be vested with the general control and superintendence of the registration of industrial designs, patents and marks under the provisions of this Code and of all persons appointed for or engaged in the carrying out of the provisions of this Code.

3. (1) There may from time to time be appointed a fit and proper person, or each of two or more such persons, to be or to act as a Deputy Registrar of Patents and Trade Marks and such other Assistant Registrars as the Minister may consider necessary.

Deputy  
Registrars  
and  
Assistant  
Registrars.

(2) Any person so appointed may exercise, perform or discharge any power, duty or function expressly conferred or imposed upon the Deputy Registrar or Assistant Registrar, as the case may be, and may, subject to the directions

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Act, No. 52 of 1979*

of the Minister and under the authority and control of the Registrar, exercise, perform or discharge any power, duty or function conferred or imposed upon the Registrar by or under this Code.

(3) In default of any such appointment the Deputy Registrar of Companies or an Assistant Registrar of Companies, as the case may be, shall discharge the duties of the Deputy Registrar of Patents and Trade Marks or an Assistant Registrar of Patents and Trade Marks.

Registry  
and  
maintenance  
of  
registers.

4. (1) The Minister may by notification in the Gazette establish an office called the Registry of Patents and Trade Marks (hereinafter referred to as the "Registry") which shall be the only office in Sri Lanka for the registration of industrial designs, patents and marks.

(2) All registers required to be kept and maintained under the provisions of this Code shall be kept and maintained under the supervision of the Registrar at the Registry and such registers shall be the only legally recognized registers for the registration of industrial designs, patents and marks in Sri Lanka.

Registrars  
deemed  
to be  
public  
servants.

5. Every Registrar, Deputy Registrar and Assistant Registrar for the time being shall, as long as they hold office, be deemed to be public servants within the meaning of the Penal Code.

PART II

COPYRIGHT

CHAPTER II

Inter-  
pretation.

6. For the purposes of this Part—

"broadcasting" means the transmitting, for reception by the general public, by wireless or by means of wire, of sounds or of images and sounds;

"folklore" means all literary and artistic works created in Sri Lanka by various communities, passed on from generation to generation and constituting one of the basic elements of the traditional cultural heritage;

"performance" means a public performance or delivery of a work by any means whatsoever;

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*Act, No. 52 of 1979*

“published works” means works published in any manner whatsoever with the consent of their authors provided that the number of copies so published are sufficient to satisfy the reasonable requirements of the public, having regard to the nature of the work ;

“reproduction” means the making of one or more copies of a literary, artistic or scientific work, in any material form including any sound or visual recording ;

“works first published” means works first published in Sri Lanka, or works first published abroad but also published in Sri Lanka within thirty days from the earlier publication ;

“work of joint authorship” means a work created by two or more authors in collaboration, in which the individual contributions are indistinguishable from each other.

7. (1) Authors of original literary, artistic and scientific works shall be entitled to protection of their works under this Part.

**Works  
protected.**

(2) Literary, artistic and scientific works shall include in particular—

- (a) books, pamphlets and other writings ;
- (b) lectures, addresses, sermons and other works of the same nature ;
- (c) dramatic and dramatico-musical works ;
- (d) musical works, whether or not they are in written form and whether or not they include accompanying words ;
- (e) choreographic works and pantomimes ;
- (f) cinematographic, radiophonic and audio-visual works ;
- (g) works of drawing, painting, architecture, sculpture, engraving, lithography and tapestry ;
- (h) photographic works, including works expressed by processes analogous to photography ;
- (i) works of applied art, whether handicraft or produced on an industrial scale ;
- (j) illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.



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Act, No. 52 of 1979*

(3) Works shall be protected irrespective of their quality and the purpose for which they were created.

**Derivative works.**

8. (1) The following shall also be protected as original works—

- (a) translations, adaptations, arrangements and other transformations of literary, artistic or scientific works ;
- (b) collections of literary, artistic or scientific works, such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations ; and
- (c) works derived from Sri Lanka folklore.

(2) The protection of any work referred to in subsection (1) shall be without prejudice to any protection of a pre-existing work utilized for the making of such work.

**Works not protected.**

9. Notwithstanding the provisions of sections 7 and 8, protection shall not extend to—

- (a) laws and decisions of courts and administrative bodies, as well as to official translations thereof ; and
- (b) news of the day published, broadcast or publicly communicated by any other means.

**Economic rights.**

10. Subject to the provisions of sections 12 to 16 the author of a protected work shall have the exclusive right to do or authorize any other person to do the following acts in relation to the whole work or a part thereof—

- (a) reproduce the work ;
- (b) make a translation, adaptation, arrangement, or other transformation of the work ;
- (c) communicate the work to the public by performance, broadcasting, television or any other means.

**Moral rights.**

11. (1) The author of a protected work shall have the right—

- (a) to claim authorship of his work, in particular that his authorship be indicated in connection with any of the acts referred to in section 10, except when the work is included incidentally or accidentally when reporting current events by means of broadcasting or television ;

*Code of Intellectual Property  
Act, No. 52 of 1979*

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(b) to object to, and to seek relief in connection with, any distortion, mutilation or other modification of, and any other derogatory action in relation to, his work, where such action would be or is prejudicial to his honour or reputation.

(2) The rights referred to in subsection (1) shall subsist for the life of the author and fifty years thereafter. After his death, the said rights shall be exercisable by his heirs.

(3) The rights referred to in subsection (1) shall be exercisable even where the author or his heirs do not have the rights referred to in section 10.

(4) The rights referred to in subsection (1) shall not be transferable.

12. (1) In the case of works of Sri Lanka folklore, the rights referred to in sections 10 and 11 (1) shall be exercised by the Minister in charge of the subject of Culture.

Works of  
Sri Lanka  
folklore.

(2) Works of Sri Lanka folklore shall be protected by all means available under this Part, without limitation in time.

(3) Copies of works of Sri Lanka folklore made abroad and copies of translations, adaptations, arrangements, or other transformations of works of Sri Lanka folklore made abroad, without the authorization of the Minister in charge of the subject of Culture, shall be neither imported nor distributed.

13. Notwithstanding the provisions of section 10, the following uses of a protected work, either in the original languages or in translation, shall be permissible without the author's consent—

Fair use.

(a) in the case of any work that has been lawfully published—

(i) the reproduction, translation, adaptation, arrangement or other transformation of such work exclusively for the user's own personal and private use ;

(ii) the inclusion, subject to mention of the source and the name of the author, of quotations from such work in another work, provided that such quotations are compatible with fair practice and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries ;

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Act, No. 52 of 1979*

(iii) the utilization of the work by way of illustration in publications, broadcasts or sound or visual recordings for teaching to the extent justified by the purpose, or the communication for teaching purposes of the work broadcast or televised for use in schools, education, universities and professional training :

Provided that such use is compatible with fair practice and that the source and the name of the author are mentioned in the publication, broadcast, television broadcast or recording ;

- (b) in the case of any article published in newspapers or periodicals on current economic, political or religious topics, and in the case of any broadcast or televised work of the same character, the reproduction of such article or such work in the press, or the communication of it to the public, unless the said article when first published, or the said broadcast or televised work when broadcast or televised, was accompanied by an express condition prohibiting such use, and that the source of the work when used in the said manner is clearly indicated ;
- (c) for the purposes of reporting on a current event by means of photography, cinematography or communication to the public, the reproduction or making available to the public, to the extent justified by the informatory purpose of any work that can be seen or heard in the course of the said current event ;
- (d) the reproduction of works of art and of architecture in a film or television broadcast, and the communication to the public of the works so reproduced, if the said works are permanently located in a place where they can be viewed by the public or are included in the film or television broadcast only by way of background or as incidental to the essential matters represented ;
- (e) the reproduction, by sound recording, photographic or similar process, by public libraries, non-commercial documentation centres, scientific insti-

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*Act, No. 52 of 1979*

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tutions and educational establishments, of literary, artistic or scientific works which have already been lawfully made available to the public :

Provided that such reproduction and the number of copies made are limited to the needs of their activities, do not conflict with the normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author ;

(f) the reproduction in the press of—

- (i) any political speech delivered in public or any speech delivered during legal proceedings, or
- (ii) any lecture, address, sermon or other work of the same nature delivered in public, provided that the use is exclusively for the purposes of current information,

the author retaining the right to publish a collection of such works.

14. Notwithstanding the provisions of section 10, any broadcasting or television organization may make, for the purpose of its own broadcasts or television broadcasts and by means of its own facilities, an ephemeral recording, in one or several copies, of any work which it is authorized to broadcast or televise. All copies of such recording shall be destroyed within six months of the making thereof or within any longer period agreed to by the author :

**Ephemeral recordings.**

Provided, however, that where such recording has an exceptional documentary character, one copy of it may be preserved in official archives, without prejudice to the application of the provisions of section 11.

15. Where any work has not been published in Sinhala or Tamil within ten years from its having been published for the first time in its original language, it shall be lawful to translate the said work into Sinhala or Tamil, as the case may be, and to publish such translation, even without the authorization of, and without any payment to, the owner of the copyright of the work, without prejudice to the application of the provisions of section 11.

**Limitation of right of translation.**

16. (1) Where the owner of the copyright in a musical work has already authorized a person to make a sound recording of the performance of the work, any other person may, if he cannot agree with the owner to make a sound recording of a performance of the same work, make a new sound recording of a performance of the said work without

**Limitation of right of sound recording and broadcasting.**

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the authorization of the owner, provided that such other person pays to the owner an equitable remuneration which amount shall be fixed by the Secretary to the Ministry of the Minister in charge of the subject of Culture. The foregoing provisions shall apply also to any words accompanying the music.

(2) Where any public broadcasting or television organization operating in and from Sri Lanka cannot agree with the owner of the copyright in any work which it wishes to transmit by broadcasting or television on the conditions on which the work may be broadcast or televised, it shall be entitled to proceed to such broadcasting or television even without the authorization of the owner, provided that it pays to the owner an equitable remuneration which amount shall be fixed by the Secretary to the Ministry of the Minister in charge of the subject of Culture.

(3) The provisions of subsections (1) and (2) shall be without prejudice to the application of the provisions of section 11.

(4) The mode and manner of the assessment and payment of remuneration under subsections (1) and (2) shall be as prescribed.

**Ownership of  
copyright.**

17. (1) The rights protected under this Part shall be owned in the first instance by the author or authors who created the work. The authors of a work of joint authorship shall be co-owners of the said rights.

(2) In the absence of proof to the contrary, the author of a work is the person under whose name the work is disclosed.

(3) In the case of a work created by an author for any person or body of persons corporate or unincorporate in the course of his employment under a contract of service, or of a work commissioned from the author by such person or body of persons, the rights mentioned in section 10 shall, in the absence of contractual provisions to the contrary, be deemed to be transferred to the employer or to the person commissioning the work.

**Transfer of  
copyright.**

18. (1) The rights referred to in section 10 shall be transferable in whole or in part.

(2) Any transfer, other than by operation of law, of a right referred to in section 10 shall be in writing signed by the transferor.

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(3) A transfer, in whole or in part of any right referred to in section 10, shall not include or be deemed to include the transfer of any other rights referred to therein.

(4) When a contract provides for the total transfer of one of the rights referred to in section 10, the scope of such contract shall be limited to the exercise of such rights as are provided for in the contract.

(5) The transfer of ownership of the only copy or of one or several copies of a work shall not imply or be deemed to imply the transfer of the copyright in the work.

19. (1) Unless expressly provided otherwise in this Part, the rights referred to in section 10 shall be protected during the life of the author and for fifty years after his death.

Duration of  
economic  
rights.

(2) In the case of a work of joint authorship the rights referred to in section 10 shall be protected during the life of the last surviving author and for fifty years after his death.

(3) In the case of a work published anonymously or under a pseudonym, the rights referred to in section 10 shall be protected until the expiration of fifty years from the date on which such work was first lawfully published :

Provided that where, before the expiration of the said period, the author or the author's identity is revealed or is no longer in doubt, the provisions of subsection (1) or subsection (2) shall apply as the case may be.

(4) In the case of a cinematographic, radiophonic or audiovisual work, the rights referred to in section 10 shall be protected until the expiration of fifty years from the making of the work or, if the work is made available to the public during such period with the consent of the author, fifty years from the date of its communication to the public.

(5) In the case of a photographic work or a work of applied art, the rights referred to in section 10 shall be protected until the expiration of twenty-five years from the making of the work.

(6) Every period under the preceding provisions of this section shall run to the end of the calendar year in which it would otherwise expire.

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Sound recording.

20. (1) The lawful maker of any sound recording shall, for a period of fifty years from the first publication of the sound recording, have the exclusive right to reproduce or authorize the reproduction of the sound recording.

(2) The provisions of sections 14, 18, 19 (6), and 21 shall apply to sound recordings.

Infringements and sanctions.

21. (1) Any person who infringes any of the rights protected under this Part may be prohibited by injunction from continuing such infringement and may also be liable in damages.

(2) The provisions of Chapter XXXII relating to infringements shall apply, *mutatis mutandis*, to the rights protected under this Part.

Fields of application.

22. This Part shall apply to—

- (a) works of authors who are nationals of, or have their habitual residence in, Sri Lanka ; and
- (b) works first published in Sri Lanka, irrespective of the nationality or residence of their authors ; and
- (c) all works which, by virtue of treaties entered into by Sri Lanka, are to be protected, as well as to works of Sri Lanka folklore.

Abrogation of common law rights.

23. No copyright, or right in the nature of copyright, shall subsist otherwise than by virtue of this Part or of any other enactment made in that behalf.

Rights under other laws.

24. The provisions of this Part shall not affect any rights hereinbefore acquired under the common law or any other law.

### PART III

#### INDUSTRIAL DESIGNS

#### CHAPTER III

##### *Scope of this Part and Definitions*

Scope of this Part.

25. The protection of industrial designs provided under this Part shall be in addition to and not in derogation of any other protection provided under any other written law, in particular under Part II of this Code.

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26. The protection provided under this Part shall—

- (1) apply only to new industrial designs ;
- (2) not apply to an industrial design which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious or racial susceptibilities of any community.

Conditions  
for  
protection.

27. For the purposes of this Part any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, that gives a special appearance to a product of industry or handicraft and is capable of serving as a pattern for a product of industry or handicraft shall be deemed to be an industrial design :

Definition  
of  
industrial  
design.

Provided that anything in an industrial design which serves solely to obtain a technical result shall not be protected under this Part.

28. (1) For the purposes of this Part a new industrial design shall mean an industrial design which had not been made available to the public anywhere and at any time whatsoever through description, use or in any other manner before the date of an application for registration of such industrial design or before the priority date validly claimed in respect thereof.

Definition  
of novelty.

(2) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that, within the period of six months preceding the filing of an application for registration, it had appeared in an official or officially recognized international exhibition.

(3) An industrial design shall not be considered a new industrial design 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.

#### CHAPTER IV

##### *Right to protection of industrial design*

29. (1) The right to obtain protection of an industrial design belongs to its owner.

(2) Subject to section 31 the owner of an industrial

Ownership  
and right  
to protection  
of industrial  
design.



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(3) Where two or more persons have jointly created an industrial design, the right to obtain protection shall belong to them jointly :

Provided that a person who has merely assisted in the creation of an industrial design but has made no contribution of a creative nature shall not be deemed to be the creator or a co-creator of such industrial design.

(4) Subject to sections 30 and 31 the person who makes the first application for the registration of an industrial design or the person who first validly claims the earliest priority for his application shall be deemed to be the creator of such industrial design.

Usurpation :  
Judicial  
assignment of  
application  
or  
registration.

30. Where the essential elements of an industrial design, the subject of an application for registration, have been unlawfully derived from an industrial design for which the right to protection belongs to another person, such other person may apply to Court for an order that the said application or registration be assigned to him :

Provided that where, after an application for the registration of an industrial design has been filed, the person to whom the right to protection belongs gives his consent to the filing of the said application, such consent shall, for all purposes, be deemed to have been effective from the date of filing of such application.

Industrial  
design  
created by  
an employee  
or pursuant  
to a  
commission.

31. (1) In the absence of any provision to the contrary in any contract of employment or for the execution of work, the ownership of an industrial design created in the performance of such contract or in the execution of such work shall be deemed to accrue to the employer, or the person who commissioned the work, as the case may be :

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 or for the execution of work, as the case may be, the creator shall be entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.

(2) Where an employee whose contract of employment does not require him to engage in any creative activity creates, in the field of activities of his employer, an industrial design using data or means placed at his disposal by his employer, the ownership of such industrial design shall be deemed to accrue to the employer in the absence of any provision to the contrary in the contract of employment.

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Provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the industrial design and any benefit derived from it by the employer.

(3) The rights conferred on the creator of an industrial design by subsections (1) and (2) shall not be restricted by contract.

32. (1) The creator of an industrial design shall be named as such in the registration, unless by a declaration in writing signed by him or on his behalf and submitted to the Registrar he indicates that he does not wish to be so named.

Naming of creator of an industrial design.

(2) The provisions of subsection (1) shall not be modified by the terms of any contract.

## CHAPTER V

### *Requirements of application and procedure for registration*

33. (1) An application for registration of an industrial design shall be made to the Registrar in the prescribed form and shall contain—

Requirements of application.

- (a) a request for registration of the industrial design;
- (b) the name, address and description of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka;
- (c) a specimen of the article embodying the industrial design or copies of a photographic or graphic representation of the industrial design, in colour where it is in colour, or drawings and tracings of the design;
- (d) an indication of the kind of products for which the industrial design is to be used and, where the regulations make provision for classification, an indication of the class or classes in which such products are included;
- (e) a declaration by the applicant that the industrial design is new to the best of his knowledge.

(2) The application for registration may be accompanied by a declaration signed by the creator of the industrial

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design, giving his name and address and requesting that he be mentioned as such in the registration.

(3) Where the applicant is not the creator of the industrial design the application shall be accompanied by a statement justifying the applicant's right to obtain registration.

(4) The Registrar shall send a copy of the statement referred to in subsection (3) to the creator of the industrial design who shall have the right to inspect the application and to receive, on payment of the prescribed fee, a copy thereof.

(5) Where the application is filed through an agent, it shall be accompanied by a power of attorney granted to such agent by the applicant :

Provided that legalization or certification of the applicant's signature shall not be necessary.

(6) An application may be made for the registration of any number of industrial designs not exceeding fifty provided that they are of the same class or kind.

**Right of  
priority.**

34. The applicant for registration of an industrial design who wishes to avail himself of the priority of an earlier application filed in a convention country shall, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in which he or his predecessor in title filed such application and shall, within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.

**Application  
fee.**

35. An application for registration of an industrial design shall not be entertained unless the prescribed fee has been paid to the Registrar.

**Examination  
of  
application.**

36. (1) The Registrar shall examine whether the application for registration complies with sections 26 (2), 33, 34 (where applicable) and 35.

(2) Where the application does not comply with sections 26 (2), 33 and 35, the Registrar shall refuse registration of the industrial design :

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Provided that the Registrar shall first notify the applicant of any defect in the application and shall afford him an opportunity to remedy such defect within three months from the date of receipt of such notification.

(3) Where the application does not comply with section 34, the Registrar shall not, in connection with the registration of the industrial design, make any reference to the priority claimed.

(4) Where the application complies with section 34, the Registrar shall, in connection with the registration of the industrial design, record the priority claimed.

(5) Where the Registrar refuses to register an industrial design he shall, if required by the applicant, state in writing the grounds of his decision.

37. Where the application complies with sections 26(2), 33 and 35, the industrial design shall, notwithstanding the provisions of section 26 (1), be registered without further examination.

Registration.

38. Upon the registration of an industrial design, the Registrar shall issue to the registered owner thereof a certificate of registration and shall, at the request of the registered owner, send such certificate to him by registered post at his last recorded postal address in Sri Lanka or, if he is resident outside Sri Lanka, to his last recorded postal address for service in Sri Lanka.

Issue of  
certificate  
of  
registration.

39. (1) The Registrar shall keep and maintain a register called the Register of Industrial Designs wherein shall be recorded, in the order of their registration, all registered industrial designs and such other particulars relating to industrial designs as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.

Register of  
Industrial  
Designs.

(2) The registration of an industrial design shall include a representation of the industrial design and shall specify its number, the name and address of the registered owner and, if the registered owner is resident outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and registration; if priority is validly claimed, an indication of that fact and the number, date and country of the application on the basis of which the priority is claimed; the kinds and classes of products referred to in

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section 33 (1) (d), and the name and address of the creator of the industrial design, if he has requested that he be mentioned as such in the registration.

Examination  
of register  
and  
certified  
copies.

40. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

Publication  
of  
registered  
industrial  
designs.

41. The Registrar shall cause to be published in the *Gazette*, in the prescribed form, all registered industrial designs in the order of their registration, including in respect of each industrial design so published reference to such particulars as may be prescribed.

## CHAPTER VI

### *Duration of registration*

Duration of  
registration.

42. Subject and without prejudice to other provisions of this Part, registration of an industrial design shall expire five years after the date of receipt of the application for registration.

Renewal.

43. (1) Registration of an industrial design may be renewed for two consecutive periods of five years each on payment of the prescribed fee.

(2) The renewal fee shall be paid within the twelve months preceding the date of expiration of the period of registration :

Provided, however, that a period of grace of six months shall be allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed.

(3) The Registrar shall record in the register and cause to be published in the *Gazette* in the prescribed form all renewals of registration.

(4) Where the renewal fee has not been paid within such period or such extended period specified in subsection (2), the Registrar shall remove the registration of the industrial design from the register.

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**CHAPTER VII**

*Rights of registered owner of industrial design*

44. (1) Subject and without prejudice to other provisions of this Part, the registered owner of an industrial design shall have the following exclusive rights in relation to the industrial design :—

**Rights of registered owner of industrial design.**

- (a) to reproduce and embody such industrial design in making a product ;
- (b) to import, offer for sale, sell or use a product embodying such industrial design ;
- (c) to stock, for the purpose of offering for sale, selling or using, a product embodying such industrial design ;
- (d) to assign or transmit the registration of the industrial design ;
- (e) to conclude licence contracts.

(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 acts referred to in subsection (1), if done by any unauthorized person, shall not be lawful solely by reason of the fact that the reproduction of the registered industrial design differs from the registered industrial design in minor respects or that the reproduction of the registered industrial design is embodied in a type of product different from a product embodying the registered industrial design.

45. The provisions of section 44(1) shall—

- (1) extend only to acts done for industrial or commercial purposes ;
- (2) not preclude third parties from doing any of the acts referred to therein in respect of a product embodying the registered industrial design after the said product has been lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka.

**Limitation of registered owner's rights.**

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CHAPTER VIII

*Assignment and transmission of applications and  
registrations*

**Assignment  
and  
transmission  
of  
applications  
and  
registrations.**

46. (1) An application for registration or the registration of an industrial design may be assigned or transmitted.

(2) Any person becoming entitled by assignment or transmission to an application for registration or the registration of an industrial design may apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the register.

(3) No such assignment or transmission shall be recorded in the register unless—

- (a) the prescribed fee has been paid to the Registrar ;
- (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.

(4) No such assignment or transmission shall have effect against third parties unless so recorded in the register.

**Joint  
ownership  
of  
applications  
and  
registration.**

47. In the absence of any agreement to the contrary between the parties, joint owners of an application for registration or the registration of an industrial design may, separately, assign or transmit their rights in the application or registration, use the industrial design and exercise the exclusive rights referred to in section 44 (1) (a) to (c), but may only jointly withdraw the application, renounce the registration or conclude a licence contract.

CHAPTER IX

*Licence Contracts*

**Interpre-  
tation.**

48. For the purposes of this Part licence contract means any contract by which the registered owner of an industrial design ("the licensor") grants to another person or enterprise ("the licensee") a licence to do any or all of the acts referred to in section 44 (1) (a) to (c).

**Form and  
record of  
licence  
contract.**

49. (1) A licence contract shall be in writing signed by or on behalf of the contracting parties.

(2) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall on payment of the prescribed fee, record in the register such particulars relating to the contract as the parties thereto might wish to have recorded :

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Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

**50.** (1) In the absence of any provision to the contrary in the licence contract, the licensee shall— **Rights of licensee.**

(a) be entitled to do any or all of the acts referred to in section 44 (1) (a) to (c) within the whole geographical area of Sri Lanka, during the whole period of registration of the industrial design, including renewals, and through any application of the industrial design ;

(b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licenses to third parties.

(2) The provisions of this Chapter shall apply, *mutatis mutandis*, to assignments and sub-licenses.

**51.** (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same industrial design or himself do any or all of the acts referred to in section 44 (1) (a) to (c). **Rights of licensor.**

(2) Where the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor shall not grant further licences to third parties in respect of the same industrial design or himself do any of the acts referred to in section 44 (1) (a) to (c).

**52.** Any clause or condition in a licence contract shall be null and void in so far as it imposes upon the licensee, in the industrial or commercial field, restrictions not derived from the rights conferred by this Part on the registered owner of an industrial design, or unnecessary for the safeguarding of such rights : **Invalid clauses in licence contracts.**

Provided that—

(a) restrictions concerning the scope, extent, or duration of use of the industrial design, or the geographical area in or the quality or quantity of the products in connection with which the industrial design may be used, and

(b) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the industrial design.

shall not be deemed to constitute such restrictions.



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**Effect of nullity of registration of licence contract.**

53. Where, before the expiration of the licence contract, the registration is declared null and void the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payments already made :

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.

**Expiry, termination or invalidation of licence contract.**

54. The Registrar shall—

- (1) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the register upon a request in writing to that effect signed by or on behalf of the parties thereto ;
- (2) record in the register the expiry, termination or invalidation of a licence contract under any provision of this Part.

**Licence contracts involving payments abroad.**

55. (1) Where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof—

- (a) which involves the payment of royalties abroad ; or
- (b) which by reason of other circumstances relating to such licence contract,

is detrimental to the economic development of Sri Lanka he shall in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.

(2) Where the Governor of the Central Bank on receipt of any communication under subsection (1) informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka the Registrar shall cancel and invalidate the record of such contract in the register.

## CHAPTER X

### *Renunciation and nullity of registration*

**Renunciation of registration.**

56. (1) The registered owner of an industrial design may renounce the registration by a declaration in writing signed by him or on his behalf and submitted to the Registrar.

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(2) The Registrar shall, on receipt of the said declaration, record it in the register and cause such record to be published in the *Gazette*.

(3) The renunciation shall take effect from the date that the Registrar receives the said declaration.

(4) Where a licence contract in respect of an industrial design is recorded in the register the Registrar shall not, in the absence of provision to the contrary in such licence contract, accept or record the said renunciation except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the said renunciation, unless the requirement of his consent is expressly waived in the licence contract.

57. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the industrial design and every assignee, licensee or sub-licensee on record shall be made party, declare the registration of the industrial design null and void on any one or more of the following grounds:—

Nullity of registration

- (a) that the provisions of sections 26, 27 and 28 have not been satisfied :

Provided, however, that the grounds of nullity referred to in section 26 (2) shall not be taken into account if they do not exist at the date of the application to Court ;

- (b) that the identical industrial design has been previously registered upon a prior application or has been conferred earlier priority by virtue of an application in that behalf upon the ground of prior registration in another country ;
- (c) that the essential elements of the registered industrial design have been unlawfully derived from the creation of another person within the meaning of section 30.

(2) Where an application under subsection (1) relates to several industrial designs, included in the registration and the ground or grounds for nullity apply to some but not to all such industrial designs, the Court shall declare such registration null and void in so far as it relates to the industrial design in respect of which the ground or grounds for nullity apply.

Date and  
effect of  
nullity.

58. (1) Upon a final decision of the Court declaring total or partial nullity of the registration of an industrial design, the registration shall be deemed to have been null and void totally or partially, as the case may be, from the date of such registration.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Registrar who shall record the said declaration in the register and cause it to be published in the *Gazette*.

## PART IV

### PATENTS

#### CHAPTER XI

##### *Definitions*

Definition  
of  
invention.

59. (1) For the purposes of this Part, "invention" means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

(2) An invention may be, or may relate to, a product or process.

(3) The following, notwithstanding they are inventions within the meaning of subsection (1), shall not be patentable—

- (a) discoveries, scientific theories and mathematical methods ;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than micro-biological processes and the products or such processes ;
- (c) schemes, rules, or methods for doing business, performing purely mental acts or playing games ;
- (d) methods for the treatment of the human or animal body by surgery or therapy, and diagnostic methods practised on the human or animal body :

Provided, however, that this paragraph shall not apply to the products used in any such methods.

Patentable  
inventions.

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

Novelty.

61. (1) An invention is new if it is not anticipated by prior art.

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- (2) Prior art shall consist of—
- (a) everything disclosed to the public, anywhere in the world, by written publication or, in Sri Lanka, by oral disclosure, by use or in any other way, prior to the filing or, where appropriate, priority date of the patent application claiming the invention ;
- (b) the contents of a domestic patent application having an earlier filing or, where appropriate, priority date than the patent application referred to in paragraph (a), to the extent that such contents are included in the patent granted on the basis of the said domestic patent application.
- (3) A disclosure made under subsection (2) (a) shall be disregarded—
- (a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title ;
- (b) if such disclosure occurred within six months preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title.

**62.** An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the patent application claiming the invention, such inventive step would not have been obvious to a person having ordinary skill in the art.

**Inventions  
step.**

**63.** An invention shall be considered industrially applicable if it can be made or used in any kind of industry.

**Industrial  
application.**

## CHAPTER XII

### *Right to a Patent*

**64.** (1) Subject to section 65 the right to a patent shall belong to the inventor.

**Right  
to a  
patent.**

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

**65.** Where the essential elements of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right

**Usurpation :  
Judicial  
assignment  
of patent  
application  
or patent.**

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to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him :

Provided that where, after a patent application has been filed, the person to whom the right to the patent belongs gives his consent to the filing of the said patent application, such consent shall, for all purposes, be deemed to have been effective from the date of filing of such application :

Provided also that the Court shall not entertain an application for the assignment of a patent after five years from the date of grant of the patent.

**Inventions  
made  
by an  
employee  
or  
pursuant  
to a  
commission.**

66. (1) In the absence of any provision to the contrary in any contract of employment or for the execution of work, the right to a patent for an invention made in the performance of such contract of employment or in the execution of such work shall be deemed to accrue to the employer, or the person who commissioned the work, as the case may be :

Provided that where the invention acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment or for the execution of work, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.

(2) Where an employee whose contract of employment does not require him to engage in any inventive activity makes, in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment :

Provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the invention and any benefit derived from it by the employer.

(3) The rights conferred on the inventor under subsections (1) and (2) shall not be restricted by contract.

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67. (1) The inventor shall be named as such in the patent, unless by a declaration in writing signed by him or on his behalf and submitted to the Registrar he indicates that he does not wish to be so named.

Naming of  
inventor.

(2) The provisions of subsection (1) shall not be modified by the terms of any contract.

*CHAPTER XIII*

*Requirements of Application and Procedure for Grant*

68. (1) (a) An application for the grant of a patent shall be made to the Registrar in the prescribed form and shall contain—

Require-  
ments of  
application.

- (i) a request for the grant of the patent ;
- (ii) a description ;
- (iii) a claim or claims ;
- (iv) a drawing or drawings, where required ;
- (v) an abstract.

(b) Where the applicant's ordinary residence or principal place of business is outside Sri Lanka, he shall be represented by an agent resident in Sri Lanka whose name and address shall be given in the application, and the application shall be accompanied by a power of attorney granted to such agent by the applicant :

Provided that legalization or certification of the applicant's signature shall not be necessary.

(c) The application may be accompanied by a declaration signed by the inventor, giving his name and address and requesting that he be named as such in the patent.

- (2) (a) The request shall contain—
- (i) a petition that the patent be granted ;
  - (ii) the title of the invention ;
  - (iii) the name, address, description and any other prescribed information concerning the applicant, the inventor and the agent, if any.

(b) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.

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(c) The Registrar shall send a copy of the statement referred to in paragraph (b) to the inventor who shall have the right to inspect the application and to receive, on payment of the prescribed fee, a copy thereof.

(3) The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be evaluated, and to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate the best mode known to the applicant for carrying out the invention.

(4) The claim or claims shall be clear, concise and supported by the description.

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

(6) The terms of the claim or claims shall determine the scope and extent of the protection afforded by the patent, and the description and drawings may be used to interpret the claim or claims.

(7) The abstract shall serve the purpose of technical information and shall not be used for the purpose of determining or interpreting the scope and extent of the protection afforded by the patent.

**Application  
fee.**

69. An application for the grant of a patent shall not be entertained unless the prescribed fee has been paid to the Registrar.

**Search  
report.**

70. (1) Every applicant shall furnish, within the prescribed period, a report, which if not in English shall be accompanied by a translation thereof in English, of an international-type search as may be prescribed :

Provided, however, that in lieu of the said international-type search an applicant may request the Registrar to refer the application to a local examiner who shall examine the application on the basis of the claim or claims, with due regard to the description and the drawings, if any, and furnish a report to the Registrar, within the prescribed period, on the relevant prior art, after endeavouring to discover as much of the relevant prior art as facilities permit ; and for this purpose the local examiner shall in any case consult all documentation on prior art available to him.

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(2) The applicant shall, in the event of his requesting the Registrar to refer his application to a local examiner, forward the prescribed fee to the Registrar.

(3) In this section "local examiner" means any skilled person or persons to whom the Registrar may refer questions concerning patents.

71. An application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Unity of  
invention.

72. (1) An applicant may amend the application provided that the amendment shall not go beyond the disclosure in the initial application.

Amendment  
and  
division  
of  
application.

(2) (a) An applicant may 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.

(b) Each divisional application shall be entitled to the filing or, where applicable, priority date of the initial application.

73. (1) An application may contain a declaration claiming the priority, pursuant to the Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any State party to the said Convention.

Right of  
priority.

(2) Where the application contains a declaration under subsection (1), the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application, certified as correct by the Office with which it was filed or, where the earlier application is an international application filed under the Patent Co-operation Treaty, by the International Bureau of the World Intellectual Property Organization.

(3) The effect of the declaration referred to in subsection (1) shall be as provided in the Convention referred to therein.

(4) Where any of the requirements of this section or any regulations pertaining thereto have not been complied with the declaration referred to in subsection (1) shall be deemed to be null and void.



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**Filing date.**

74. (1) The Registrar shall record as the filing date the date of receipt of the application :

Provided that the application contains—

- (a) the name and address of the applicant ;
- (b) the name and address of the inventor and, where the applicant is not the inventor, the statement referred to in section 68 (2) (b) ;
- (c) a description ;
- (d) a claim or claims :

Provided also that at the time of receipt of the application the prescribed fee has been paid.

(2) Where the Registrar finds that, at the time of receipt of the application, the provisions of subsection (1) are not fulfilled, he shall request the applicant to file the required correction.

(3) Where the applicant complies with the request referred to in subsection (2), the Registrar shall record as the filing date the date of receipt of the required correction ; where the applicant does not so comply the Registrar shall treat the application as null and void.

(4) Where the application refers to drawings which in fact are not included in the application, the Registrar shall request the applicant to furnish the missing drawings.

(5) Where the applicant complies with the request referred to in subsection (4), the Registrar shall record as the filing date the date of receipt of the missing drawings ; where the applicant does not so comply the Registrar shall record as the filing date the date of receipt of the application and shall make no reference to the said drawings.

**Examination.**

75. (1) The Registrar shall examine the application and shall be satisfied that the following conditions are fulfilled—

- (a) where applicable, the requirements of section 68 (1) (b) ;
- (b) the request complies with the requirements of section 68 (2) (a) ;
- (c) where applicable, the requirements of section 68 (2) (b) ;

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- (d) the description, the claims and, where applicable, the drawings comply with the prescribed requirements ;
- (e) the application contains an abstract ;
- (f) the search report referred to in section 70 has been submitted.

(2) Where the Registrar finds that the conditions referred to in subsection (1) are not fulfilled he shall request the applicant to file the required correction ; where the applicant does not so comply the application shall, subject to the provisions of subsection (3), be rejected.

(3) Where no abstract is provided in response to a request under subsection (2), the Registrar shall, on payment of the prescribed fee within the prescribed period, prepare the abstract ; where the prescribed fee is not paid within the prescribed period the application shall be rejected.

(4) The Registrar shall notify the applicant of any decision under subsections (2) and (3), and any decision rejecting the application shall be in writing and state the reasons for such rejection.

76. (1) The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the performance of any act in respect of the claimed invention is prohibited by any law or regulation, except where the performance of that act would be contrary to public order.

**Grant of  
patent.**

(2) Where the Registrar is satisfied that the application complies with section 75 (1) he shall grant the patent, and shall forthwith—

- (a) issue to the applicant a certificate of the grant of the patent and a copy of the patent together with a copy of the search report ; and
  - (b) record the patent in the register.
- (3) As soon as possible thereafter the Registrar shall--
- (a) cause to be published in the *Gazette* a reference to the grant of the patent ;
  - (b) make available to the public, on payment of the prescribed fee, copies of the patent together with copies of the search report.

(4) The patent shall be deemed to be granted on the date that the Registrar performs the acts referred to in subsection (2).

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**Register of patents.**

77. The Registrar shall keep and maintain a register called the Register of Patents wherein all patents shall be recorded, in the order of their grant, specifying the number of the patent, the name and address of the grantee and, if the grantee is resident outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and grant; any change in the ownership of a patent application or patent; the amendment or division of a patent application; the assignment or transmission of a patent application or patent; any valid claim to priority; the surrender or revocation of a patent and such other matters relating to patents as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.

**Examination of register and certified copies.**

78. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

**Inspection of files.**

79. (1) Any person may, after the grant of a patent, inspect the file relating to the patent and, subject to subsection (2), the file relating to any patent application, and may obtain certified extracts therefrom on payment of the prescribed fee.

(2) The file relating to a patent application may be inspected before the grant of the patent only with the written permission of the applicant:

Provided that before the grant of the patent the Registrar may divulge the following information to any person:—

- (a) the name, address and description of the applicant and the name and address of the agent, if any;
- (b) the number of the application;
- (c) the filing date of the application and, if priority is claimed, the priority date, the number of the earlier application and the name of the State in which the earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which and the Office with which it was filed;
- (d) the title of the invention;
- (e) any change in the ownership of the application and any reference to a licence contract appearing in the file relating to the application.

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(3) No person employed in or at the Registry may make a patent application or be granted a patent or acquire or hold in any manner whatsoever any rights relating to a patent during the period of his employment in or at the Registry and for one year after the termination of such employment.

CHAPTER XIV

*Duration of Patent*

80. (1) Subject and without prejudice to other provisions of this Part a patent shall expire fifteen years after the date of its grant.

Duration of  
patent.

(2) Where a patentee intends at the expiration of the second year from the date of grant of the patent to keep the same in force he shall, twelve months before the date of expiration of the second and each succeeding year during the term of the patent, pay the prescribed annual fee :

Provided, however, that a period of grace of six months shall be allowed after the date of such expiration, upon payment of such surcharge as may be prescribed :

Provided also that the patentee may pay in advance the whole or any portion of the aggregate of the prescribed annual fees.

CHAPTER XV

*Rights of Owner of Patent*

81. (1) Subject and without prejudice to other provisions of this Part, the owner of a patent shall have the following exclusive rights in relation to the patented—

Rights of  
owner of  
patent.

- (a) to exploit the patent invention ;
- (b) to assign or transmit the patent ;
- (c) to conclude licence contracts.

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

(3) For the purposes of this Part "exploitation" of a patented invention means any of the following acts in relation to a patent:—

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- (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 purpose 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 paragraph (a), in respect of a product obtained directly by means of the process.

**Limitation of owner's rights.**

82. The provisions of section 81 shall—
- (1) extend only to acts done for industrial or commercial purposes and in particular not to acts done only for scientific research ;
  - (2) not preclude a person having the rights referred to in section 83 or a licensee from exploiting the patented invention ;
  - (3) not extend to the presence or use of products on foreign vessels, aircraft, spacecraft, or land vehicles which temporarily or accidentally enter the waters, airspace or territory of Sri Lanka.

**Rights derived from prior manufacture or use.**

83. (1) Where a person at the filing or, where applicable, the priority date of the patent application—
- (a) was in good faith in Sri Lanka making the product or using the process which is the subject of the invention claimed in such application ;
  - (b) had in good faith in Sri Lanka made serious preparations toward the making of the product or using the process referred to in paragraph (a),

he shall have the right, despite the grant of the patent, to exploit the patented invention :

Provided that the product in question is made, or the process in question is used by the said person in Sri Lanka :

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Provided further than he can prove, if the invention was disclosed under the circumstances referred to in section 61 (3) (a) or (b), that his knowledge of the invention was not a result of such disclosure.

(2) The right referred to in subsection (1) shall not be assigned or transmitted except as part of the business of the person concerned.

**CHAPTER XVI**

*Assignment and transmission of patent applications and patents*

84. (1) A patent application or patent may be assigned or transmitted.

**Assignment and transmission of patent applications and patents.**

(2) Any person becoming entitled by assignment or transmission to a patent application or patent may apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the register.

(3) No such assignment or transmission shall be recorded in the register unless—

- (a) the prescribed fee has been paid to the Registrar ;
- (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.

(4) No such assignment or transmission shall have effect against third parties unless so recorded in the register.

85. In the absence of any agreement to the contrary between the parties, joint owners of a patent application or patent may, separately, assign or transmit their rights in the patent application or patent, exploit the patented invention and take action against any person exploiting the patented invention without their consent, but may only jointly withdraw the patent application, surrender the patent or conclude a licence contract.

**Joint ownership of patent applications or patents.**

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**CHAPTER XVII**

*Licence Contracts*

**Interpre-  
tation.**

86. For the purposes of this Part licence contract means any contract by which the owner of a patent ("the licensor") grants to another person or enterprise ("the licensee") a licence to do any or all of the acts referred to in section 81 (1) (a) and (3).

**Form and  
record of  
licence  
contract.**

87. (1) A licence contract shall be in writing signed by or on behalf of the contracting parties.

(2) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall, on payment of the prescribed fee, record in the register such particulars relating to the contract as the parties thereto might wish to have recorded :

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

**Rights of  
licensee.**

88. (1) In the absence of any provision to the contrary in the licence contract, the licensee shall—

(a) be entitled to do any or all of the acts referred to in section 81 (1) (a) and (3) within the whole geographical area of Sri Lanka, without limitation as to time and through any application of the patented invention ;

(b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.

(2) The provisions of this Chapter shall apply, *mutatis mutandis*, to assignments and sub-licences.

**Rights of the  
licensor.**

89. (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same patent or himself do any or all of the acts referred to in section 81 (1) (a) and (3).

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(2) Where the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor shall not grant further licences to third parties in respect of the same patent or himself do any of the acts referred to in section 81 (1) (a) and (3).

90. Any clause or condition in a licence contract shall be null and void in so far as it imposes upon the licensee, in the industrial or commercial field, restrictions not derived from the rights conferred by this Part on the owner of the patent, or unnecessary for the safeguarding of such rights :

Invalid  
clauses in  
licence  
contracts.

Provided that—

- (a) restrictions concerning the scope, extent or duration of exploitation of the patented invention, or the geographical area in or the quality or quantity of the products in connection with which the patented invention may be exploited ; and
- (b) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the patent,

shall not be deemed to constitute such restrictions.

91. Where, before the expiration of the licence contract, any of the following events occur in respect of the patent application or patent referred to in such contract—

Effect of  
patent  
application  
not being  
granted or  
patent being  
declared  
null and void.

- (a) the patent application is withdrawn ;
- (b) the patent application is finally rejected ;
- (c) the patent is surrendered ;
- (d) the patent is declared null and void ; or
- (e) the registration of the licence contract is invalidated,

the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payments already made :

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.



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Expiry  
termination,  
or invalida-  
tion of  
licence  
contract.

**92. The Registrar shall—**

- (a) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the register upon a request in writing to that effect signed by or on behalf of the parties thereto ;
- (b) record in the register the expiry, termination or invalidation of a licence contract under any provision of this Part.

Licence  
contracts  
involving  
payments  
abroad.

**93. (1) Where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof—**

- (a) which involves the payment of royalties abroad ; or
- (b) which by reason of other circumstances relating to such licence contract,

is detrimental to the economic development of Sri Lanka, he shall in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.

(2) Where the Governor of the Central Bank on receipt of any communication under subsection (1) informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka the Registrar shall cancel and invalidate the record of such contract in the register.

*CHAPTER XVIII*

*Surrender and Nullity of Patent*

Surrender  
of patent.

**94. (1) The registered owner of a patent may surrender the patent by a declaration in writing signed by him or on his behalf and submitted to the Registrar.**

(2) The surrender may be limited to one or more claims of the patent.

(3) The Registrar shall, on receipt of the said declaration record it in the register and cause such record to be published in the *Gazette*.

(4) The surrender shall take effect from the date that the Registrar receives the said declaration.

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(5) Where a licence contract in respect of a patent is recorded in the register, the Registrar shall not, in the absence of provision to the contrary in such licence contract, accept or record the said surrender except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the said surrender, unless the requirement of his consent is expressly waived in the licence contract.

95. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the owner of the patent and every assignee, licensee or sub-licensee on record shall be made party, declare the patent null and void on any one or more of the following grounds:—

Nullity of  
patent.

- (a) that what is claimed as an invention in the patent is not an invention within the meaning of section 59 (1), or is excluded from protection under section 59 (3) or section 76 (1) or is not patentable because it does not comply with the requirements of sections 60 to 63 ; or
- (b) that the description or the claims do not comply with the requirements of section 68 (3) and (4) ; or
- (c) that any drawings which are necessary for the understanding of the claimed invention have not been furnished ; or
- (d) that the right to the patent does not belong to the person to whom the patent was granted :  
Provided that the patent has not been assigned to the person to whom the right to the patent belongs.

(2) (a) Where the provisions of subsection (1) apply only to some of the claims or some parts of a claim, such claims or parts of a claim may be declared null and void by the court.

(b) The nullity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

(3) (a) An assignee, licensee or sub-licensee, as the case may be, who has been made party to the application under subsection (1) shall be entitled to join in the proceedings in the absence of any provision to the contrary in any contract or agreement with the owner of the patent.

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(b) Where the application to Court is on the ground referred to in subsection (1) (d), the applicant shall give notice of the application to the person to whom the right to the patent is alleged to belong.

**Date and  
effect of  
nullity.**

96. (1) Upon a final decision of the Court declaring total or partial nullity of a patent, the patent shall be deemed to have been null and void totally or partially, as the case may be, from the date of the grant of the patent.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Registrar who shall record the said declaration in the register and cause it to be published in the *Gazette*.

PART V

MARKS, TRADE NAMES AND UNFAIR COMPETITION

CHAPTER XIX

*Definitions*

**Definitions.**

97. For the purposes of this Part, unless the context otherwise requires—

“appellation of origin” means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors ;

“collective mark” means any visible sign designated as such and serving to distinguish the origin or any other common characteristic of goods or services of different enterprises which use the mark under the control of the registered owner ;

“enterprise” means any business, industry or other activity carried on by an individual, partnership, company, or co-operative society wherever registered or incorporated and whether registered or not under any law for the time being in force relating to companies, co-operative societies or businesses engaged in or proposing to engage in any business and includes any business undertaking of the Government or any State corporation whether carrying on business in Sri Lanka or otherwise ;

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- “false trade description” means a trade description which is false or misleading in a material respect as regards the goods or services to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false or misleading in a material respect, and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Part ;
- “goods” means anything which is the subject of trade, manufacture or merchandise and includes services ;
- “indication of source” means any expression or sign used to indicate that a product or service originates in a given country or group of countries, region, or locality ;
- “mark” means a trade mark or service mark ;
- “name” includes any abbreviation of a name ;
- “person”, “manufacturer, dealer, or trader”, and “owner” include any body of persons corporate or unincorporate ;
- “service mark” means any visible sign serving to distinguish the services of one enterprise from those of other enterprises ;
- “trade description” means any description, statement or other indication, direct or indirect—
- (a) as to the number, quantity, measure, gauge, or weight of any goods ; or
  - (b) as to the place or country in which any goods were made or produced ; or
  - (c) as to the mode of manufacturing or producing any goods ; or
  - (d) as to the material of which any goods are composed ; or
  - (e) as to any goods being the subject of an existing copyright, industrial design or patent ; or
  - (f) as to the quality, kind or nature of the services ; or
  - (g) as to the standard of quality of any goods, according to a classification commonly used or recognized in the trade ; or

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(h) as to the fitness for purpose, strength, performance or behaviour of any goods,

and the use of any figure, word or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters. shall be deemed to be a trade description within the meaning of this Part ;

“trade mark” means any visible sign serving to distinguish the goods of one enterprise from those of other enterprises ; and

“trade name” means the name or designation identifying the enterprise of a natural or legal person.

**CHAPTER XX**

*Admissibility of Marks*

**Admissibility  
of marks.**

98. (1) The exclusive right to a mark conferred by this Part shall be acquired, subject to the following provisions, by registration.

(2) Registration of a mark may be granted only to the person who has first fulfilled the conditions for valid application or who is the first validly to claim the earliest priority for his application.

(3) Provided that they are not inadmissible under sections 99 and 100 marks may consist, in particular, of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedges, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

**Marks in-  
admissible  
on objective  
grounds.**

99. (1) A mark shall not be registered—

(a) which consists of shapes or forms imposed by the inherent nature of the goods or services or by their industrial function ;

(b) which consists exclusively of a sign or indication which may serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production, or of supply, of the goods or services concerned ;

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- (c) which consists exclusively of a sign or indication which has become, in the current language or in the bona fide and established practices of the trade of Sri Lanka, a customary designation of the goods or services concerned ;
- (d) which, for other reasons, is incapable of distinguishing the goods or services of one enterprise from those of other enterprises ;
- (e) which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious or racial susceptibilities of any community ;
- (f) which is likely to mislead trade circles or the public as to the nature, the source, the manufacturing process, the characteristics, or the suitability for their purpose, of the goods or services concerned ;
- (g) which does not represent in a special or particular manner the name of an individual or enterprise ;
- (h) which is, according to its ordinary signification, a geographical name or surname ;
- (i) which reproduces or imitates armorial bearings, flags or other emblems, initials, names or abbreviated names of any State or any inter-governmental international organization or any organization created by international convention, unless authorized by the competent authority of that State or international organization ;
- (j) which reproduces or imitates official signs or hallmarks of a State, unless authorized by the competent authority of that State ;
- (k) which resembles in such a way as to be likely to mislead the public, a mark or a collective mark the registration of which has expired and has not been renewed or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding the filing of the mark in question ;
- (l) which consists of any other words or definitions as may be prescribed.

(2) The Registrar shall in applying the provisions of paragraphs (b), (c), (d), (f), (g) and (h), of subsection (1), have regard to all the factual circumstances and, in

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particular, the length of time the mark has been in use in Sri Lanka or in other countries and the fact that the mark is held to be distinctive in other countries or in trade circles.

**Marks  
inadmissible  
by reason  
of  
third-party  
rights.**

100. (1) A mark shall not be registered—

- (a) which resembles, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a third party, or subsequently filed by a person validly claiming priority in respect of the same goods or services or of other goods or services in connection with which use of such mark may be likely to mislead the public ;
- (b) which resembles, in such a way as to be likely to mislead the public, an unregistered mark used earlier in Sri Lanka by a third party in connection with identical or similar goods or services, if the applicant is aware, or could not have been unaware, of such use ;
- (c) which resembles, in such a way as to be likely to mislead the public, a trade name already used in Sri Lanka by a third party, if the applicant is aware, or could not have been unaware, of such use ;
- (d) which constitutes a reproduction in whole or in part, an imitation, translation or transcription, likely to mislead the public, of a mark or trade name which is well known in Sri Lanka and belongs to a third party ;
- (e) which infringes other third party rights or is contrary to the provisions of Chapter XXIX relating to the prevention of unfair competition ;
- (f) which is filed by the agent or representative of a third party who is the owner of such mark in another country, without the authorization of such owner, unless the agent or representative justifies his action.

(2) The Registrar shall, in applying the provisions of paragraphs (a) to (e) of subsection (1), have regard to the fact that the third parties referred to therein have consented to the registration of such mark.

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101. There shall not be entered in the register notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Trust not to be entered in register.

CHAPTER XXI

*Requirements of Application and Procedure  
for Registration*

102. (1) An application for registration of a mark shall be made to the Registrar in the prescribed form and shall contain—

Requirements of application.

- (a) a request for the registration of the mark ;
- (b) the name, address and description of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka ;
- (c) four copies of a representation of the mark ;
- (d) a clear and complete list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification, as may be prescribed.

(2) Where the application is filed through an agent, it shall be accompanied by a power of attorney granted to such agent by the applicant :

Provided that legalization or certification of the applicant's signature shall not be necessary.

103. An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in a Convention country shall, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in which he or his predecessor in title filed such application and shall, within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.

Right of Priority.



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Temporary protection of mark exhibited at international exhibition.

**104.** (1) An applicant for registration of a mark who has exhibited goods bearing the mark or rendered services under the mark at an official or officially recognized international exhibition and who applies for registration of the mark within six months from the date on which the goods bearing the mark or services under the mark were first exhibited or rendered at such exhibition shall, on request, be deemed to have applied for registration of that mark on the date on which the goods bearing the mark or the services rendered under the mark were first exhibited or rendered at such exhibition.

(2) Evidence of the exhibition of the goods bearing the mark or the services rendered under the mark shall be by a certificate issued by the competent authority of the exhibition stating the date on which the mark was first used at such exhibition in connection with such goods or services.

(3) The provisions of subsections (1) and (2) shall not extend any other period of priority claimed by the applicant.

Application fee.

**105.** An application for registration of a mark shall not be entertained unless the prescribed fee has been paid to the Registrar.

Examination of application as to form.

**106.** (1) The Registrar shall examine whether the application for registration complies with sections 102 and 105 and, where applicable, sections 103 and 104.

(2) Where the application does not comply with sections 102 and 105, the Registrar shall refuse registration of the mark :

Provided that the Registrar shall first notify the applicant of any defect in the application and shall afford him an opportunity to remedy such defect within three months from the date of receipt of such notification.

(3) Where the application does not comply with section 103 or 104, the Registrar shall not, in connection with the registration of the mark, make any reference to the priority claimed.

(4) Where the application complies with sections 103 and 104, the Registrar shall in connection with the registration of the mark record the priority claimed or the date of the certified use of the mark at an international exhibition.

(5) Where the Registrar refuses to register a mark, he shall, if required by the applicant, state in writing the grounds of his decision.

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107. (1) Where the application complies with sections 102 and 105, the Registrar shall examine the mark in relation to the provisions of sections 99 and 100.

(2) Where the mark is inadmissible under section 99 or 100 the Registrar shall notify the applicant accordingly stating in writing the grounds on which registration of the mark is refused.

(3) Where the applicant is dissatisfied with all or any of the grounds stated by the Registrar in the notification referred to in subsection (2) he may, within a period of one month from the date of such notification, make his submissions in writing to the Registrar against such refusal.

(4) On receipt of any such submissions the Registrar may grant the applicant a hearing and inform him of the date and time of such hearing.

(5) The Registrar may, after such inquiry as he thinks fit, refuse to accept the application for registration of the mark, or may accept it absolutely or subject to conditions, amendments or modifications, or to such limitations, if any, as to the mode or place of user or otherwise as he may think fit to impose.

(6) In case of any refusal or conditional acceptance of an application for registration of a mark, the Registrar shall, if required by the applicant, state in writing the grounds of his decision.

(7) Where the Registrar is of the opinion that the mark is admissible under section 99 or 100 he may request the applicant to pay within a period of two months the prescribed fee for publication of the application.

(8) Where the fee for publication of the application is not paid within the prescribed period registration of the mark may be refused.

(9) If the fee for publication is paid within the prescribed period the Registrar shall proceed to publish the application setting out the date of application, the representation of the mark, the goods or services in respect of which registration of the mark is requested with an indication of the corresponding class or classes, the name and address of the applicant and, if the applicant is resident outside Sri Lanka, a postal address for service in Sri Lanka, the priority claimed, if any, or the date of certified use of the mark at an international exhibition.

Registration  
of mark  
after  
further  
examination  
and  
publication  
of mark.

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(10) Where any person considers that the mark is inadmissible on one or more of the grounds referred to in section 99 or 100 he may, within a period of three months from the date of publication of the application, give to the Registrar in the prescribed form, and together with the prescribed fee, notice of opposition to such registration stating his grounds of opposition.

(11) Where notice of opposition has not been received by the Registrar within the period specified in subsection (10) the Registrar shall register the mark.

(12) Where, within the period specified in subsection (10) notice of opposition in the prescribed form is received by the Registrar, together with the prescribed fee, he shall serve a copy of such grounds of opposition on the applicant and shall request him to present his observations on those grounds in writing within a period of three months.

(13) On receipt of the observations of the applicant the Registrar shall after hearing the parties, if he considers such hearing necessary, decide, as expeditiously as possible, whether or not the mark may be registered. If he decides that the mark is registrable he shall accordingly register such mark.

(14) The Registrar may allow a reasonable extension of the prescribed period within which any act has to be done or any fee has to be paid under this section.

Non-  
completion  
of  
registration.

108. Where, by reason of default on the part of the applicant, registration of a mark is not completed within twelve months from the date of receipt by the Registrar of the application, the Registrar may, after giving notice of non-completion to the applicant in writing in the prescribed form, treat the application as abandoned, unless it is completed within the time specified in that behalf in such notice.

Register  
of marks  
and issue  
of  
certificate.

109. (1) The Registrar shall keep and maintain a register called the Register of Marks wherein shall be recorded, in the order of their registration, all registered marks and such other matters relating to marks as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.

(2) The registration of a mark shall include a representation of the mark and shall specify its number, the name and address of the registered owner and, if the registered

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owner's address is outside Sri Lanka, a postal address for service in Sri Lanka ; the dates of application and registration ; if priority is validly claimed, an indication of that fact and the number, date and country of the application on the basis of which the priority is claimed ; if a valid certificate has been filed relating to the use of a mark at an international exhibition, the contents of such certificate ; the list of goods and services in respect of which registration of the mark has been granted with an indication of the corresponding class or classes.

(3) Upon the registration of a mark the Registrar shall issue to the registered owner thereof a certificate of registration and shall, at the request of the registered owner, send such certificate to him by registered post at his last recorded postal address in Sri Lanka or, if he is resident outside Sri Lanka, at his last recorded postal address for service in Sri Lanka.

110. The Registrar shall cause to be published in the *Gazette*, in the prescribed form, all registered marks in the order of their registration, including in respect of each mark so published reference to such particulars as may be prescribed.

**Publication  
of registered  
marks.**

111. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

**Examination  
of register  
and  
certified  
copies.**

112. Where application is made for the registration of a mark identical with or so closely resembling a mark of the applicant already on the register for the same goods or description of goods as to be likely to mislead or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that such marks shall be entered on the register as associated marks.

**Associated  
marks.**

113. Associated marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate marks :

**Assignment  
and user of  
associated  
marks.**

Provided that where under the provisions of this Part user of a registered mark is required to be proved for any purpose, the Registrar may, if and so far as is considered right, accept user of an associated registered mark, or of the mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

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**CHAPTER XXII**

*Duration of Registration*

**Duration of  
registration.**

114. (1) Subject and without prejudice to other provisions of this Part, registration of a mark shall expire ten years after the date of registration.

(2) A mark when registered shall be registered as of the date of receipt by the Registrar of the application for registration, and such date shall be deemed for the purposes of this Part to be the date of registration.

**Renewal.**

115. (1) Registration of a mark may be renewed for consecutive periods of ten years each on payment of the prescribed fee.

(2) Renewal of registration of a mark shall not be subject to any further examination of the mark by the Registrar or to opposition by any person.

(3) The renewal fee shall be paid within the twelve months preceding the date of expiration of the period of registration :

Provided, however, that a period of grace of six months shall be allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed.

(4) The Registrar shall record in the register and cause to be published in the *Gazette* in the prescribed form all renewals of registration stating any elimination from the lists of goods or services.

(5) Where the renewal fee has not been paid within such period or such extended period specified in subsection (3), the Registrar shall remove the mark from the register.

**Alteration of  
registered  
mark.**

116. The registered owner of any mark may apply in the prescribed manner to the Registrar for leave to add to or alter such mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of user as he may think fit. If leave be granted, the mark as altered shall be published in the prescribed manner.

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CHAPTER XXIII

*Rights of registered owner of mark*

117. (1) Subject and without prejudice to other provisions of this Part, the registered owner of a mark shall have the following exclusive rights in relation to the mark:—

**Rights of registered owner.**

- (a) to use the mark ;
- (b) to assign or transmit the registration of the mark ;
- (c) to conclude licence contracts.

(2) Without the consent of the registered owner of the mark third parties are precluded from the following acts:—

- (a) any use of the mark, or of a sign resembling it, in such a way as to be likely to mislead the public, for goods or services in respect of which the mark is registered, or for other goods or services in connection with which the use of the mark or sign is likely to mislead the public; and
- (b) any other use of the mark, or of a sign or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interests of the registered owner of the mark.

118. The registration of the mark shall not confer on its registered owner the right to preclude third parties—

**Limitation of registered owner's rights.**

- (a) from using bona fide their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production or of supply of their goods and 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 ;
- (b) from using the mark in relation to goods lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka under that mark, provided that such goods have not undergone any change.

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CHAPTER XXIV

*Assignment and Transmission of Applications and  
Registrations*

**Assignment  
and  
transmission  
of  
applications  
and  
registrations.**

119. (1) An application for registration or the registration of a mark may be assigned or transmitted independently of the transfer of all or part of the enterprise using the mark, in respect of all or part of the goods or services for which the application was filed or the mark registered.

(2) Such assignment or transmission shall be invalid if the purpose or effect thereof is to mislead the public, in particular in respect of the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark is applied.

(3) Any person becoming entitled by assignment or transmission to an application for registration or the registration of a mark may apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the register.

(4) No such assignment or transmission shall be recorded in the register unless—

- (a) the prescribed fee has been paid to the Registrar ;
- (b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.

(5) No such assignment or transmission shall have effect against third parties unless so recorded in the register.

CHAPTER XXV

*Licence Contracts*

**Inter-  
pretation.**

120. (1) For the purposes of this Part licence contract means any contract by which the registered owner of a mark ("the licensor") grants to another person or enterprise ("the licensee") a licence to use the mark for all or part of the goods or services in respect of which the mark is registered.

(2) Use of the mark by the licensee shall be deemed to be use of the mark by the registered owner.

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**121.** (1) A licence contract shall be in writing signed by or on behalf of the contracting parties.

Form and  
record of  
licence  
contract.

(2) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall, on payment of the prescribed fee, record in the register such particulars relating to the contract as the parties thereto might wish to have recorded :

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

**122.** (1) In the absence of any provision to the contrary in the licence contract, the licensee shall—

Rights of  
licensee.

(a) be entitled to use the mark within the whole geographical area of Sri Lanka, during the whole period of registration of the mark, including renewals, in respect of all the goods or services for which the mark is registered ;

(b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.

(2) The provisions of this Chapter shall apply, *mutatis mutandis*, to assignments and sub-licences.

**123.** (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same mark or himself use the mark.

Rights of  
licensor.

(2) Where the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor shall not grant further licences to third parties in respect of the same mark or himself use the mark.

**124.** (1) A licence contract shall be null and void in the absence of stipulations ensuring effective control by the licensor of the quality of the goods or services in respect of which the mark may be used.

Nullity of  
licence  
contract  
and  
certain  
clauses.

(2) Any clause or condition in a licence contract shall be null and void in so far as it imposes upon the licensee restrictions not derived from the rights conferred by this Part on the registered owner of the mark, or unnecessary for the safeguarding of such rights :



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Provided that—

- (a) restrictions concerning the scope, extent, duration of use of the mark or the geographical area in or the quality or quantity of the goods or services in connection with which the mark may be used ;
- (b) restrictions justified by the stipulations referred to in subsection (1) ; and
- (c) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the mark,

shall not be deemed to constitute such restrictions.

**Cancellation  
of licence  
contracts.**

125. The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, annul and cancel the said contract if—

- (a) the licensor has lost effective control over the quality of the goods or services in respect of which the mark is used ;
- (b) the licensee has used the mark in such a way as to mislead or confuse the public.

**Licence  
contracts  
involving  
payments  
abroad.**

126. (1) Where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof—

- (a) which involves the payment of royalties abroad ; or
- (b) which by reason of other circumstances relating to such licence contract ;

is detrimental to the economic development of Sri Lanka he shall in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.

(2) Where the Governor of the Central Bank on receipt of any communication under subsection (1) informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka the Registrar shall cancel and invalidate the record of such contract in the Register.

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127. Where, before the expiration of the licence contract, the registration is declared null and void the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payments already made :

Effect of nullity of registration on licence contract.

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.

128. The Registrar shall—

- (a) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the register upon a request in writing to that effect signed by or on behalf of the parties thereto ;
- (b) record in the register the expiry, termination, annulment or invalidation of a licence contract under any provision of this Part.

Expiry, termination or invalidation of licence contract.

## CHAPTER XXVI

### *Renunciation and Nullity of Registration*

129. (1) The registered owner of a mark may renounce the registration, either wholly or in respect of part of the goods or services for which the mark is registered, by a declaration in writing signed by him or on his behalf and submitted to the Registrar.

Renunciation of registration.

(2) The Registrar shall, on receipt of the said declaration, record it in the register and cause such record to be published in the *Gazette*.

(3) The renunciation shall take effect from the date that the Registrar receives the said declaration.

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(4) Where a licence contract in respect of a mark is recorded in the register the Registrar shall not, in the absence of provision to the contrary in such licence contract, accept or record the said renunciation except upon receipt of a signed declaration by which any assignee, licensee or sub-licensee on record consents to the renunciation, unless his consent is expressly waived in the licence contract.

**Nullity of registration.**

130. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, declare the registration of the mark null and void if its registration is precluded under the provisions of sections 99 and 100 :

Provided, however, that grounds of nullity which do not exist at the date of the application to Court shall not be taken into account.

(2) Where the grounds for nullity of registration of the mark exist in respect of only part of the goods or services for which the mark is registered, nullity of the registration shall be declared for that part only of such goods or services.

(3) An application for a declaration of nullity based on any of the grounds specified in section 100 (1) shall be made within five years from the date of registration of the mark.

**Date and effect of nullity.**

131. (1) Upon a final decision of the Court declaring total or partial nullity of registration of a mark, the registration shall be deemed to have been null and void totally or partially, as the case may be, from the date of such registration.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Registrar who shall record the said declaration in the register and cause it to be published in the *Gazette*.

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**CHAPTER XXVII**

*Removal of mark*

132. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, remove any registered mark from the register :—

**Removal of  
mark.**

- (a) if the registered owner has, without valid grounds, failed to use the mark within Sri Lanka or cause it to be used within Sri Lanka by virtue of a licence, during five consecutive years immediately preceding the date of the application to Court ;
- (b) if the registered owner has caused, provoked or tolerated the transformation of the mark into a generic name for one or more of the goods or services in respect of which the mark is registered so that in trade circles and in the eyes of the public its significance as a mark has been lost.

(2) In any application under subsection (1) (a) the Court may take into account the fact that non-use of the mark was due to circumstances beyond the control of the registered owner. The Court shall not take into account the lack of funds of the registered owner as a ground for non-use of the mark.

(3) The use of a mark—

- (a) in a form differing, in elements which do not alter the distinctive character of the mark, from the form in which it was registered, shall not be a ground for removal of the mark ;
- (b) in connection with one or more of the goods or services belonging to any given class in respect of which the mark is registered, shall suffice to prevent the removal of the mark in respect of all the other goods or services of the same class.

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**Date and effect of removal of mark.**

133. Upon a final decision of the Court removing any registered mark from the register—

- (1) the Court may, taking into account the date of the events and other circumstances which occasion the removal of the mark, determine the date on which the registration of the mark shall be deemed to have ceased to have any legal effect ;
- (2) the Registrar of the Court shall communicate the decision of the Court to the Registrar who shall, if the Court decides that the mark be removed, enter in the register a record of such removal and cause the decision of the Court to be published in the *Gazette*.

CHAPTER XXVIII

*Collective marks*

**Collective marks.**

134. Sections 102, 116, 118, 119, and 129 to 133 of this Part shall apply to collective marks.

**Application for registration of collective mark.**

135. (1) An application for registration of a collective mark shall not be filed unless in the said application the mark is designated as a collective mark and unless the application is accompanied by a copy of such conditions as may be prescribed governing the use of the mark duly certified by the applicant.

(2) The conditions prescribed under subsection (1) shall define the common characteristics or quality of the goods or services which the collective mark shall designate and the conditions in which and the person by whom it may be used. They shall also provide for the exercise of effective control of the use of the mark and shall specify proper sanctions for the use of the mark contrary to the said conditions.

**Registration and publication of collective marks.**

136. (1) Registration of a collective mark shall be in such part of the register as the Registrar may decide and a copy of the conditions governing the use of the mark shall be appended to the registration.

(2) The publication of an application for a collective mark in accordance with section 107 (9) shall include a summary of the conditions to be appended to the registration.

(3) When so registered under subsection (1) a collective mark shall be deemed in all respects to be a registered mark.

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137. (1) The registered owner of a collective mark shall notify the Registrar in the prescribed manner of any changes effected in the conditions governing the use of the mark.

Changes in conditions governing use of collective mark.

(2) Any notification of such change shall be recorded in the register on payment of the prescribed fee. Any change in the conditions shall be effectual only if they have been so recorded.

(3) The Registrar shall cause to be published in the *Gazette* a summary of the changes so recorded in the register.

138. The provisions of sections 117 to 133 shall apply, *mutatis mutandis*, to collective marks.

Use of collective marks and other matters.

CHAPTER XXIX

*Trade Names and Unfair Competition*

139. A name or designation shall not be admissible as a trade name if, by reason of its nature or the uses to which it may be put, it is contrary to morality or public order or is likely to offend the religious or racial susceptibilities of any community or is likely to mislead trade circles or the public as to the nature of the enterprise identified by that name.

Prohibited trade names.

140. (1) Notwithstanding the provisions of any written law providing for the registration of a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party.

Protection of trade names.

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

(3) Section 118 of this Part shall apply to trade names.

141. (1) A trade name may be assigned or transmitted together with the assignment or transmission of the enterprise or part of the enterprise identified by that name.

Assignment and transmission of trade names.

(2) The provisions of section 119 shall apply, *mutatis mutandis*, to trade names.

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**Unfair  
 competition.**

142. (1) Any act of competition contrary to honest practices in industrial or commercial matters shall constitute an act of unfair competition.

(2) Acts of unfair competition shall include the following:—

- (a) all acts of such a nature as to create confusion by any means whatsoever with the establishment, the goods, services or the industrial or commercial activities of a competitor;
- (b) a false allegation in the course of trade of such a nature as to discredit the establishment, the goods, services or the industrial or commercial activities of a competitor;
- (c) any indication of source or appellation of origin the use of which in the course of trade is liable to mislead the public as to the nature, manufacturing process, characteristics, suitability for their purpose or the quantity of goods;
- (d) making direct or indirect use of a false or deceptive indication of the source of goods or services or of the identity of their producer, manufacturer or supplier;
- (e) making direct or indirect use of a false or deceptive appellation of origin or imitating an appellation of origin even if the true origin of the product is indicated, or using the appellation in translated form or accompanied by terms such as "kind", "type", "mark", "imitation" or the like.

(3) Any person or association of producers, manufacturers or traders aggrieved by any of the acts referred to in subsection (2) may institute proceedings in Court to prohibit the continuance of such acts, and the provisions of Chapter XXXII relating to infringements shall apply, *mutatis mutandis*, to such proceedings.

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## PART VI

## OFFENCES AND PENALTIES

## CHAPTER XXX

143. Any person who makes or causes to be made a false entry in any of the registers kept under this Code, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false shall be guilty of an offence and shall be liable on conviction after trial to imprisonment for a term not exceeding seven years.

Falsification  
of entries  
in any  
register.

144. (1) Any person who wilfully infringes any of the rights protected under Part II of this Code shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

Infringement  
of  
copyright.

(2) The Magistrate may, whether the alleged offender is convicted or not, order that all copies of the work and all implements used for the infringement, or all plates in the possession of the alleged offender, which appear to him to be infringing copies or plates for the purpose of making infringing copies, shall be destroyed or delivered up to the owner of the copyright, or otherwise dealt with as the Magistrate may think fit.

145. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of an industrial design shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

Infringement  
of  
industrial  
designs.



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False  
representa-  
tions  
regarding  
industrial  
designs.

146. (1) Any person who, for industrial or commercial purposes, makes a representation—

- (a) with respect to an industrial design not being a registered industrial design to the effect that it is a registered industrial design ;
- (b) to the effect that a registered industrial design is registered in respect of any products in respect of which it is not registered ; or
- (c) to the effect that the registration of an industrial design gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that an industrial design is registered if he uses in connection with the industrial design the word “registered”, or any word or words expressing or implying that registration has been obtained for the industrial design.

Infringement  
of patents.

147. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

False  
representa-  
tions  
regarding  
patents.

148. (1) Any person who, for industrial or commercial purposes, makes a representation—

- (a) with respect to a patent not being a registered patent to the effect that it is a registered patent ;
- (b) to the effect that a registered patent is registered in respect of any product or process in respect of which it is not registered ; or

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- (c) to the effect that the registration of a patent gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that a patent is registered if he uses in connection with the patent the word "registered", or any word or words expressing or implying that registration has been obtained for the patent.

149. Any person who being or having been employed in or at the Registry, communicates any information relating to patents or matters connected therewith obtained by him during the course of his employment in or at the Registry to any person not entitled or authorized to receive such information, or discloses such information to the public or makes any other unlawful use of such information shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding twelve months or to both such fine and such imprisonment.

**Unlawful disclosure of information relating to patents.**

150. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a mark shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

**Infringement of marks.**

151. (1) Any person who, for industrial or commercial purposes, makes a representation—

**False representations regarding marks.**

- (a) with respect to a mark not being a registered mark to the effect that it is a registered mark ;
- (b) to the effect that a registered mark is registered in respect of any goods or services in respect of which it is not registered ; or

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(c) to the effect that the registration of a mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitation recorded in the register, the registration does not give that right,

shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that a mark is registered if he uses in connection with the mark the word "registered", or any word or words expressing or implying that registration has been obtained for the mark.

**Other offences as to marks and trade descriptions.**

152. (1) Any person who—

- (a) forges any mark ; or
- (b) falsely applies to goods any mark or marks so nearly resembling a registered mark as to be likely to mislead ; or
- (c) makes any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a mark ; or
- (d) applies any false trade description to goods ; or
- (e) disposes of, or has in his possession, any die, block, machine, or other instrument for the purpose of forging a mark ; or
- (f) cause to be done any of the things referred to above in this subsection,

shall, subject to the provisions of this Part, and unless he proves that he acted without intent to defraud, be guilty of an offence.

(2) Any person who sells or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged mark or false trade description is applied, or to which any mark so nearly resembling a registered mark as to be likely to mislead, is falsely applied, as the case may be, shall, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, or trade description ; and

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- (b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things ; or
- (c) that otherwise he had acted innocently,

be guilty of an offence.

(3) Any person who imports any piece-goods ordinarily sold by length or by the piece, manufactured beyond the limits of Sri Lanka, or who sells or exposes for, or has in his possession for, sale, or any purpose of trade, any piece-goods ordinarily sold as aforesaid, whether manufactured within or beyond the limits of Sri Lanka, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres, or in standard metres and a fraction of such a metre, according to the real length of the piece, shall be guilty of an offence :

Provided that nothing in this subsection contained shall apply to any piece-goods manufactured within the limits of Sri Lanka by hand labour only.

(4) Any person found guilty of an offence under this section after trial before a Magistrate shall be liable on conviction to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding two years or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

(5) The Magistrate may, whether the alleged offender is convicted or not, order that every chattel, article, instrument or thing by means of or in relation to which the offence has or might have been committed shall be destroyed or declared forfeit to the State or otherwise dealt with as he may think fit.

153. Where an offence under this Code has been committed by a body corporate, every person who at the time of the commission of the offence was a director, general manager, secretary or other similar officer of that body or was obliged to act in any such capacity, shall be deemed to be guilty of such offence, unless he proves that the offence was committed without his consent or connivance and that he exercised all due diligence to prevent the commission of the offence having regard to the nature of his functions in that capacity and to all the circumstances.

**Offences  
by bodies  
corporate.**

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**Interpreta-  
tion.**

154. For the purposes of this Part, the definitions contained in section 97 shall apply, unless the context otherwise requires.

**False  
name or  
initials.**

155. (1) The provisions of this Part respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods—

- (a) of any such figures, words, marks or arrangement or combination thereof, whether including a registered mark or not, as are likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are ;
- (b) of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purposes of this Part the expression "false name or initials" means, as applied to any goods, any name or initials of a person which—
  - (i) are not a mark, or part of a mark ; and
  - (ii) are identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials ; and
  - (iii) are either those of a fictitious person or of some person not bona fide carrying on business in connection with such goods.

(2) A trade description which denotes or implies that there are contained in any goods to which it is applied more metres or standard metres than there are contained therein, is a false trade description.

**Forging  
marks.**

156. A person shall be deemed to forge a mark who either—

- (a) without the assent of the owner of the mark makes that mark, or a mark so nearly resembling that mark as to be likely to mislead ; or
- (b) falsifies any genuine mark, whether by alteration, addition, effacement or otherwise,

and any mark so made or falsified is in this Part referred to as a forged mark :

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Provided that in any prosecution for forging a mark the burden of proving the assent of the owner shall lie on the accused.

157. (1) A person shall be deemed to apply a mark or trade description to goods who—

Applying  
marks and  
descriptions.

- (a) applies it to the goods themselves ; or
- (b) applies it to any covering, label, reel or other thing in or with which the goods are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture ; or
- (c) places, encloses, or annexes any goods which are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a mark or trade description has been applied ; or
- (d) uses a mark, or trade description in any manner likely to lead to the belief that the goods in connection with which it is used are designated or described by that mark, or trade description.

(2) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper ; and the expression "label" includes any band or ticket.

(3) A mark, or trade description shall be deemed to be applied whether it is woven, impressed, stamped, branded, or otherwise worked into or annexed, or affixed to the goods, or any covering, label, reel, or other thing.

(4) A person shall be deemed to falsely apply to goods a mark who, without the assent of the owner of a mark, applies such mark or any mark so nearly resembling it as to be likely to mislead, but in any prosecution for falsely applying a mark to goods the burden of proving the assent of the owner shall lie on the accused.

158. Where a person is charged with making any die, block, machine, or other instrument for the purpose of forging or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves—

Exemption  
of certain  
persons  
employed in  
ordinary  
course of  
business.

- (a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making,

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or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the case which is the subject of the charge he was so employed by some person resident in Sri Lanka, and was not interested in the goods by way of profit or commission dependent on the sale of such goods ; and

- (b) that he took reasonable precautions against committing the offence charged ; and
- (c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or trade description ; and
- (d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the mark or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor unless he has given due notice to him that he will rely on the above defence.

**Watches.**

159. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall, prima facie, be deemed to be a description of that country within the meaning of this Part, and the provisions of this Part with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for, sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression " watch " means all that portion of a watch which is not the watch case.

**Mark how described in pleading.**

160. In any indictment, charge, proceeding, or document in which any mark or forged mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that mark or forged mark to be a mark or forged mark.

**Rules as to evidence.**

161. In any prosecution for an offence under this Part—

- (a) an accused, and his wife or her husband, as the case may be, may, if the accused thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness ;

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- (b) in the case of imported goods evidence of the port of shipment shall be prima facie evidence of the place or country in which the goods were made or produced.

162. Any person who, being within Sri Lanka, abets the commission, outside Sri Lanka, of any act which, if committed within Sri Lanka, would under this Part be an offence, shall be deemed guilty of that offence, and be liable to be indicted, proceeded against, tried and convicted in any district or place in Sri Lanka in which he may be, as if the offence had been there committed.

Punishment  
of  
accessories.

163. (1) Where, upon information of an offence under this part, a Magistrate has issued either a summons requiring the person charged by such information to appear to answer to the same, or a warrant for the arrest of such person, and either the said Magistrate on or after issuing the summons or warrant, or any other Magistrate, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to, which such offence has been committed are in any house or premises of the person charged by such information, or otherwise in his possession or under his control, in any place, such Magistrate may issue a warrant under his hand, by virtue of which it shall be lawful for any police officer, or other person named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search therefor and seize and take away such goods or things; and any goods or things seized under any such warrant shall be brought before a Magistrate's Court for the purpose of its being determined whether the same are or are not liable to forfeiture under this Part.

Search  
warrant.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Part, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a Magistrate's Court may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows sufficient cause to the contrary, may order such goods or things or any of them to be forfeited, and every such order shall be subject to appeal.



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(3) Any goods or things forfeited under this section, or under any other provisions of this Part, may be destroyed or otherwise disposed of in such manner as the Court by which the same are forfeited may direct, and such Court may, out of any proceeds which may be realized by the disposition of such goods (all marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

**Costs of  
defence  
and of  
prosecution.**

164. In any prosecution under this Part the Court may order costs to be paid to the accused by the prosecutor or to the prosecutor by the accused, having regard to the information given by, and the conduct of, the accused and prosecutor respectively, and the sum so awarded as costs shall be recoverable as if it were a fine.

**Limitation of  
prosecution.**

165. No prosecution for an offence under this Part shall be commenced after the expiration of three years next after the commission of the offence or one year next after the first discovery thereof by the prosecutor, which ever expiration first happens.

**Prohibition  
on  
importation.**

166. (1) All goods which, if sold, would be liable to forfeiture under this Part, and also all goods made or produced beyond the limits of Sri Lanka, and having applied thereto any name or mark being, or purporting to be, or being a colourable imitation of, the name or mark of any manufacturer, dealer, or trader in Sri Lanka, unless such name or mark is accompanied by a definite indication, indicated in letters as large and conspicuous as any letter in the name or mark, of the place and country in which the goods were made or produced, and also all piece-goods such as are ordinarily sold by the length or by the piece, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres or in standard metres and a fraction of such a metre according to the real length of the piece, are hereby prohibited to be imported into Sri Lanka, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were referred to in section 43 of the Customs Ordinance, and included in Schedule B to that Ordinance.

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(2) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the customs, the Principal Collector of Customs, or other officer specially appointed in that behalf by the Minister in charge of the subject of Finance may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

(3) The Principal Collector of Customs may from time to time, with the sanction of the Minister in charge of the subject of Finance, make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of giving such evidence.

(4) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in Sri Lanka, that name, unless accompanied in equally large and conspicuous letters by the name of the country in which such place is situate, shall be treated, for the purposes of this section, as if it were the name of a place in Sri Lanka.

(5) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6) The regulations may provide for the informant reimbursing the Principal Collector of Customs all expenses and damages incurred in respect of any detention made on his information and of any proceedings consequent on such detention.

(7) All regulations under this section shall be published in the *Gazette*.

(8) This section shall have effect as if it formed part of the Customs Ordinance.

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**Implied  
warranty  
on sale of  
marked goods**

167. On the sale, or in the contract for the sale, of any goods to which a mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine mark, and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Part, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to, and accepted by, the vendee.

**Provisions  
as to false  
description  
not to apply  
in certain  
cases.**

168. Where, on the commencement of this Code, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Part with respect to false trade descriptions shall not apply to such trade description when so applied :

Provided that where such trade description includes the name of a place or country, and is likely to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

**Savings.**

169. (1) This Part shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Part, be brought against him.

(2) Nothing in this Part shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence under this Part.

(3) Nothing in this Part shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in Sri Lanka who bona fide acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

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170. All offences under this Part are hereby declared to be "cognizable" and "bailable", within the meaning of those terms as defined in the Code of Criminal Procedure Act, No. 15 of 1979.

Cognizable  
and  
bailable  
offences.

PART VII

MISCELLANEOUS

CHAPTER XXXI

*Regulations*

171. (1) The Minister may from time to time make regulations for the purpose of carrying out or giving effect to the principles and provisions of this Code and in particular in respect of any matter required under this Code to be prescribed.

Regulations.

(2) Without prejudice to the generality of the powers conferred by subsection (1) the Minister may make regulations in respect of any or all of the following matters :—

- (a) the practice of registration ;
- (b) the classification of goods and services for the purposes of registration ;
- (c) the fees payable in respect of registration and other matters ;
- (d) the forms to be used ;
- (e) all matters which under Parts III, IV and V of this Code have been placed under the direction or control of the Registrar.

(3) Every regulation made by the Minister shall be published in the *Gazette* and shall come into operation on the date of such publication or on such later date as may be specified therein.

(4) Every regulation made by the Minister shall as soon as convenient after its publication in the *Gazette* be brought before the Parliament for approval. Any such regulation which is not so approved shall be deemed to be rescinded as from the date of its disapproval, but without prejudice to anything previously done thereunder.

(5) Notification of the date on which any regulation made by the Minister is so deemed to be rescinded shall be published in the *Gazette*.

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**CHAPTER XXXII**

*Applications to, and proceedings before, the  
Registrar and Court*

Correction  
and  
rectification  
of  
register.

172. (1) The Registrar may, on application in the prescribed manner by or on behalf of the registered owner of an industrial design, patent or mark, correct any error or enter any change—

- (a) in the name, address or description of the registered owner of any industrial design, patent or mark; or
- (b) concerning any other particulars relating to the registration of an industrial design, patent or mark as may be permitted by regulation.

(2) Subject and without prejudice to other provisions of this Code—

- (a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from any register, of any entry, or by any entry made in any register without sufficient cause, or by any entry wrongly remaining on any register, or by any error or defect in any entry in any register, make such order for making, expunging, or varying such entry, as it may fit;
- (b) the Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of any register;
- (c) in case of fraud in the registration, assignment or transmission of any registered industrial design, patent or mark, the Registrar may himself apply to the Court under the provisions of this section.

(3) In any proceedings under this Code in which the relief sought includes correction, alteration or rectification of any register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office

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in like cases, or of such other matters relevant to the issue, and within his knowledge, as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceedings.

(4) The Court, in dealing with any question of the correction, alteration or rectification of any register, shall have power to review any decision of the Registrar relating to the entry in question or the correction, alteration or rectification sought to be made.

173. (1) Where the Registrar is satisfied that any volume of any register kept under this Code has been so damaged as to render that volume incapable of being mended, he may cause a copy thereof to be made and authenticated in such manner as he may direct.

Power to make copies of damaged volumes of any register, to prepare and insert reconstructed folios.

(2) Any copy made and authenticated under the provisions of subsection (1) shall replace the volume of which it is a copy, and shall for all purposes be deemed to have the same legal force and effect as the volume which such copy replaces.

(3) The Registrar shall cause every damaged volume of which a copy has been made under the provisions of subsection (1) to be preserved as long as it is reasonably practicable for any reference which may be necessary.

(4) Where the Registrar, after due investigation, is satisfied that any folio of any volume of any register has been lost and cannot be recovered or that any such folio has been permanently mutilated or so obliterated or damaged as to render the entries or any material part of the entries therein illegible he may cause a reconstructed folio to be prepared.

(5) No folio shall be reconstructed as provided in subsection (4) except in accordance with regulations providing—

- (a) for evidence to be admitted and used by the Registrar in ascertaining the particulars originally contained in the lost or mutilated or damaged folio;
- (b) for the giving of notice by the Registrar of the preparation of the reconstructed folio;
- (c) for the lodging of objections by any person affected by any of the particulars contained in the reconstructed folio; and

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(d) for the inquiry into any such objections by the Registrar.

(6) Where any folio has been reconstructed by the Registrar in accordance with the preceding provisions of this section, the Registrar shall authenticate the reconstructed folio in the prescribed manner and shall thereafter cause the reconstructed folio to be inserted in the appropriate volume of the register in the place formerly occupied by the lost folio or in place of the mutilated or damaged folio, or in a copy of a volume prepared under the provisions of this section, as the case may be, and the reconstructed folio, when so authenticated and inserted, shall for all purposes be deemed to have the same legal force and effect as the folio which such reconstructed folio replaces.

(7) The Registrar may, after such inquiry as he may deem necessary, correct any clerical error or omission which may be discovered in any entry in any register or in any certificate kept or issued under the provisions of this Code and for that purpose may recall any such certificate and amend the same or issue a fresh certificate in its place.

Certificate of Registrar to be evidence.

174. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorized by this Code or regulations made thereunder to make or do, shall be prima facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certified copies to be evidence.

175. Printed, mechanically produced, typed or written copies or extracts, purporting to be certified by the Registrar, of or from any document, register, or other book filed or kept under this Code in the Registry shall be admitted in evidence in all Courts in Sri Lanka, and in all proceedings, without further proof or production of the originals.

Mode of giving evidence.

176. (1) In any proceeding under this Code before the Registrar or the Court, the evidence shall be given by affidavit in the absence of directions to the contrary. But, in any case in which the Registrar or the Court shall think it right so to do, the Registrar or the Court may take evidence *viva voce* in lieu of or in addition to evidence by affidavit.

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(2) In case any part of the evidence is taken *viva voce*, the Registrar may exercise the powers conferred on a commission appointed under the provisions of the Commissions of Inquiry Act for compelling the attendance of witnesses and the production of documents and for administering oaths to all persons who shall be examined before him.

177. Where any discretionary or other power is given to the Registrar by this Code or regulations made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered owner of an industrial design, patent or mark without (if duly required so to do within the prescribed time) giving such applicant or registered owner an opportunity of being heard.

**Exercise of  
discretionary  
power by  
Registrar.**

178. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Code, apply to the Attorney-General or Solicitor-General for directions in the matter.

**Registrar  
may take  
directions  
of law  
officers.**

179. Where the registered owner of an industrial design, patent or mark proves that any person is threatening to infringe or has infringed the said industrial design, patent or mark, as the case may be, or is performing acts which make it likely that infringement will occur, the Court may grant an injunction restraining any such person from committing or continuing such infringement or performing such acts and may award damages and such other relief as to the Court appears just and appropriate :

**Infringement  
proceedings  
by registered  
owner of  
industrial  
design,  
patent or  
mark.**

Provided that the defendant may in the same proceedings request the Court to declare the registration of the said industrial design, patent or mark, as the case may be, or any part of it, null and void, in which event the provisions of sections 57, 58, 95, 96, 130 and 131 shall apply as appropriate.

180. In the absence of any provision to the contrary in a licence contract relating to an industrial design, patent or mark, the licensee may—

**Infringement  
proceedings  
by  
or at request  
of licensee.**

(a) in respect of the threatened infringement, infringement or acts referred to in section 179 request the registered owner of the industrial design, patent or mark to apply for an injunction :



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Provided that the licensee shall indicate the threatened infringement, infringement or acts being performed, and specify the relief desired ; and

- (b) if the registered owner of the said industrial design, patent or mark refuses or fails to apply for an injunction within three months from receipt of the said request, apply for an injunction in his own name, with notice to the registered owner who may join in the proceedings :

Provided that the Court may, on the application of the licensee, even before the expiry of the period of three months, grant an injunction if he proves that immediate action is necessary to avoid substantial damage.

**Declaration  
of  
non-infringe-  
ment.**

181. (1) The Court may on the application of any person showing a legitimate interest to which the registered owner of the industrial design, patent or mark, as the case may be, shall be made party, declare that the threatened performance or performance of a specific act does not constitute a threatened infringement or infringement of the said industrial design, patent or mark.

(2) The registered owner of the industrial design, patent or mark, as the case may be, shall give notice of the said application to any assignee or licensee, who shall be entitled to join in the proceedings in the absence of any provision to the contrary in any agreement with the registered owner.

(3) Proceedings for a declaration of non-infringement may be instituted concurrently with proceedings to declare the registration of an industrial design, patent or mark null and void :

Provided that the matters in issue in the proceedings for a declaration of non-infringement are not already the subject of infringement proceedings.

(4) The provisions of the Judicature Act, No. 2 of 1978, and the Civil Procedure Code shall apply to every application for an injunction made to the Court under this Code.

**Appeals.**

182. (1) Any person aggrieved by any decision or order made by the Registrar under any provision of this Code may appeal therefrom to the Court.

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(2) In any such appeal the Court shall have and exercise the same discretionary powers as under this Code are conferred upon the Registrar.

(3) Every judgement or order of the District Court under this Code shall be subject to an appeal to the Court of Appeal and such appeal shall be subject to the same rules which govern interlocutory appeals from District Courts.

183. (1) In all proceedings before the Registrar under this Code, the Registrar shall have power to award any party such costs as he may consider reasonable, and to direct to whom and to what parties they are to be paid, and such order may be filed in Court, and thereupon such order may be enforced as if it were an order of the Court.

Costs of  
proceedings  
before  
Registrar and  
Court.

(2) In all proceedings before a Court under this Code, the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

184. The minimum stamp duties chargeable in the District Court in civil proceedings and in the Court of Appeal under the provisions of the enactment for the time being in force relating to stamps shall, so far as the same may be applicable and except as herein otherwise provided, be charged in all proceedings under this Code in the District Court and in the Court of Appeal :

Stamp  
duties.

Provided that in no case shall the Registrar be required to use any stamp or be charged with any stamp duty.

185. (1) For the purposes of this Code there shall be established a Fund which shall be maintained in such manner as the Secretary to the Ministry of the Minister in charge of the subject of Trade and the Registrar may direct.

Fund.

(2) There shall be paid into the Fund two thirds of each and every fee or charge prescribed, levied or recoverable under this Code by the Registrar.

(3) The balance one-third of each and every such fee or charge prescribed, levied or recoverable under this Code by the Registrar shall be paid into the Consolidated Fund.

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(4) There shall be paid out of the Fund referred to in subsection (1) all sums of money required to defray any expenditure incurred by the Registrar in the exercise, discharge and performance of his powers, functions and duties under this Code and all such sums of money as are required to be paid out of such Fund by or under this Code or any regulation made thereunder.

(5) The Secretary to the Ministry in charge of the subject of Trade shall as soon as possible after the end of each calendar year prepare a report on the administration of the Fund and shall cause to be maintained a full and appropriate account of the Fund in respect of each calendar year.

(6) The Auditor-General shall audit the accounts of the Fund.

(7) The financial year of the Fund shall be the calendar year.

**Interpretation.**

186. In this Code unless the context otherwise requires—  
“Central Bank of Ceylon” means the Central Bank of Ceylon established under the Monetary Law Act ;

“Convention country” means any country that has acceded to or ratified or that may hereafter accede to or ratify the Paris Convention for the Protection of Industrial Property and includes any country which has entered into or which may hereafter enter into any treaty, convention or arrangement with Sri Lanka creating reciprocal rights and obligations between such country and Sri Lanka in regard to industrial designs, patents and marks and the registration thereof ;

“Court” means the District Court of Colombo ;

“prescribed” means prescribed by this Code or any regulation thereunder.

**CHAPTER XXXIII**

*Repeals and Savings*

187. (1) The Copyright Ordinance (Chapter 154) is hereby repealed.

(2) The Copyright Act, 1911, of the Parliament of the United Kingdom or any provision therein contained shall have no application to any right or title acquired in any copyright after the appointed date.

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(3) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder, and under section 14 of the Copyright Act, 1911, of the Parliament of the United Kingdom, as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part II of this Code shall be deemed to be a regulation made under this Code, and may be amended, or rescinded by regulations made under this Code.

188. (1) The Designs Ordinance (Chapter 153) is hereby repealed.

**Industrial  
Designs :  
Repeal of  
Chapter 153  
and savings.**

(2) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part III of this Code shall be deemed to be a regulation made under this Code, and may be amended or rescinded by regulations made under this Code.

(3) The validity of the original entry of a design on the register of designs existing under the repealed Ordinance immediately before the appointed date or on any register of designs which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in accordance with the law in force at the date of such entry, and every such design shall retain its original date, but for all purposes it shall be deemed to have been registered under Part III of this Code.

189. (1) The Patents Ordinance (Chapter 152) is hereby repealed.

**Patents :  
Repeal of  
Chapter 152  
and savings.**

(2) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part IV of this Code shall be deemed to be a regulation made under this Code, and may be amended or rescinded by regulations made under this Code.

(3) The validity of the original entry of a patent on the register of patents existing under the repealed Ordinance immediately before the appointed date or on any register of

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patents which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in accordance with the law in force at the date of such entry, and every such patent shall retain its original date, but for all purposes it shall be deemed to have been registered under Part IV of this Code.

(4) The Registrar may in his discretion notwithstanding the provisions of section 46 of the repealed Ordinance issue a certificate under section 76 of this Code in respect of applications under section 46 of the repealed Ordinance received by him prior to the appointed date.

**Marks :**  
**Repeal of**  
**Chapters 150**  
**and 151 and**  
**savings.**

190. (1) The Trade Marks Ordinance (Chapter 150) and the Merchandise Marks Ordinance (Chapter 151) are hereby repealed.

(2) Notwithstanding the repeal of the aforesaid Ordinances—

(a) every rule or regulation made thereunder as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part V of this Code shall be deemed to be a regulation made under this Code and may be amended or rescinded by regulations made under this Code ;

(b) any trade mark registered in Part B of the Register of Trade Marks by virtue of the provisions of Part III of the repealed Trade Marks Ordinance shall be deemed to be valid and effectual and shall continue to be so registered until such time not exceeding a period of five years from the appointed date, as the owner of such trade mark shall satisfy the Registrar that he is entitled to registration of such trade mark under the provisions of this Code ;

(c) the validity of the original entry of a trade mark on the Register of Trade Marks existing under the repealed Trade Marks Ordinance immediately before the appointed date or on any register of trade marks which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in accordance with the law in force at the date of such entry, and every such trade mark shall retain its original date, but for all purposes it shall be deemed to have been registered under Part V of this Code ;

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- (d) no trade mark which was on the register at the commencement of the repealed Trade Marks Ordinance and which under that Ordinance was then a registerable trade mark shall be removed from the register on the ground that it was not registerable under the law in force at the date of its registration ;
- (e) no trade mark which was on the register immediately before the appointed date and which under Part V is a registrable mark shall be removed from the register on the ground that it was not registrable under the law in force at the date of its registration ;
- (f) nothing in Part V shall—
  - (i) invalidate the original registration of a trade mark which was validly on the register immediately before the appointed date ; or
  - (ii) subject any person to any liability in respect to any act or thing done before the appointed date to which he would not have been subject under the law in force at the time such act or thing was done.

191. The Patents, Designs and Trade Marks (Neuchatel Agreement) Act (Chapter 156), the Patents, Designs, Copyright and Trade Marks (Emergency) Ordinance (Chapter 157) and the Trade Marks Act, No. 30 of 1964, are hereby repealed.

**Additional  
repeals.**

192. Notwithstanding the repeal of the Acts and Ordinances referred to in sections 187 to 191—

**Additional  
savings.**

- (1) every application for registration of an industrial design, patent or mark made to the Registrar before the appointed date shall be deemed to be an application made to the Registrar under Part III, IV or V respectively of this Code, and the Registrar shall deal with such applications under the provisions of this Code applicable to applications made after the appointed date ;
- (2) every action, proceeding or other matter relating to copyright, industrial designs, patents and marks already instituted and pending under the provisions of the repealed Acts and Ordinances in any Court, original or appellate, on the appointed date shall be continued and proceeded with to final judgment, completion and execution under the provisions of the repealed Acts and Ordinances ;

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- (3) nothing in Parts III, IV and V of this Code shall affect any order or requirement made, table of fees or certificates issued, notice, decision, determination, direction or approval given, application made, or thing done, under the Acts and Ordinances repealed by this Code ; and every such order, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force on the date immediately preceding the appointed date, continue in force and shall, so far as it could have been made, issued, given or done under this Code have effect as if made, issued, given or done under the corresponding provisions of this Code.

SRI LANKA  
**Intellectual Property Regulations, 1980,**  
 Under the  
**Code of Intellectual Property Act,**  
**No. 52 of 1979\***

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1. These regulations may be cited as the Intellectual Property Regulations, 1980, and shall come into operation on January 2, 1980. Short title and date of operation.

PART I

INDUSTRIAL DESIGNS

2. The application for the registration of one or more industrial designs under section 33 of the Code shall be made on Form DI set out in the First Schedule<sup>1</sup> hereto and shall be signed by the applicant or his authorized agent. Application form for registration.

3. The application shall be accompanied in respect of each industrial design by either one specimen or by the following:— Number of specimens or other representations.

(i) if the industrial design is two-dimensional, by one photographic or graphic representation or one drawing or tracing;

(ii) if the industrial design is three-dimensional, by two photographic or graphic representations or two drawings or tracings, each showing a different aspect of the industrial design.

4. Each specimen shall be of a size not exceeding 20 centimetres × 20 centimetres × 20 centimetres. Size of specimens.

\* *English title.*

*Entry into force:* January 2, 1980.

*Source:* The Gazette of the Democratic Socialist Republic of Sri Lanka, Extraordinary, No. 60/20, October 31, 1979.

*Note:* For the text of the Code of Intellectual Property Act, No. 52 of 1979, see *Industrial Property Laws and Treaties, SRI LANKA* — Text 1-001 (*Industrial Property*, March and April 1980).

<sup>1</sup> The Schedules are not reproduced here (*Editor's Note*).



- Size of representations.** 5. No photographic or graphic representation, drawing or tracing of the industrial design shall exceed 10 centimetres × 20 centimetres. Where there is one or two of such representations, drawings or tracings, they shall be affixed on one sheet of paper of A4 size. Photographic and graphic representations may be in colour. Drawings and tracings shall be in black ink.
- Kind of Products.** 6. The indication of the kind of products for which industrial designs are to be used shall be the same for all the industrial designs to which the application relates.
- Date of application.** 7. The date of the application shall be the date of its receipt in the Registry, provided that, where the fee in respect of such application is received on a date later than the date of receipt of the application then that later date shall be deemed to be the date of the application.
- Translation of earlier applications.** 8. Where the earlier application referred to in the declaration claiming priority is in a language other than the language of the application for the registration of the industrial design in Sri Lanka, the Registrar may require the applicant to furnish him within three months with a translation of the said earlier application in the language of the application for the registration of the industrial design in Sri Lanka.
- Register of Industrial Designs.** 9. In addition to the particulars referred to or specified in section 39(2) of the Code the following particulars shall also be recorded in respect of each registered industrial design:—  
 (a) the number of the application;  
 (b) the name and address of any authorized agent or the owner of the registration;  
 (c) the reference to the date and Number of the *Gazette* in which the registration was published;  
 (d) any change in the address of the registered owner of the registration.
- Particulars to be published.** 10. The publication of each registered industrial design in the *Gazette* by virtue of section 41 of the Code shall contain the particulars specified in section 39(2) of the Code and regulation 9(a) and 9(b).
- Renewal.** 11. The registration of an industrial design may be renewed by the Registrar upon a written request made in that behalf by the registered owner or his authorized agent on payment of the prescribed fee.
- Publication of renewal.** 12. Every renewal of a registration of an industrial design shall be published in the *Gazette* in Form D2 set out in the First Schedule hereto.
- Assignment or transmission.** 13. (a) Any application under section 46 of the Code to the Registrar requesting him to record in the Register of Industrial Designs the assignment or transmission of an application for registration, or the registration, of any industrial design or designs, shall be made on Form D3 set out in the First Schedule hereto. It shall be signed by the assignee or transferee and shall be forwarded to the Registrar together with the fee.  
 (b) Where the provisions of paragraph (a) have been complied with the Registrar shall record such assignment or transmission in the Register of Industrial Designs.
- Fees.** 14. The fees specified in Column II of the Second Schedule hereto shall be payable in respect of the matters specified in the corresponding entry in Column I of that Schedule.

## PART II

## MARKS

15. The application for the registration of a mark under section 102 of the Code or a collective mark under section 135 of the Code shall be made on Form MI set out in the Third Schedule hereto. It shall be signed by the applicant or his authorized agent. Application for mark.
16. Where the mark consists of letters, words, numerals or punctuation signs and no special graphic features are claimed, the said elements may be reproduced by typewriter in the appropriate space in the form. One copy of the representation of any other two-dimensional mark shall be affixed to the appropriate space in the form. Two-dimensional representation.
17. Where the mark is three-dimensional, the application shall contain an indication to that effect and the representation shall comprise at least two aspects of the mark sufficient to illustrate the shape and features of the mark. One copy of the representation shall be affixed to the appropriate space in the form. Three-dimensional representation.
18. Where the copy of the representation to be affixed to the appropriate space in the form is larger than that space, it may be affixed on a separate sheet of paper of A4 size and appended to the form. When representation is too large for the form.
19. The representation of the mark or collective mark shall not exceed 10 centimetres × 10 centimetres. Maximum size of representation.
20. The application may relate to goods or services in one class of the International Classification<sup>2</sup> set out in the Fourth Schedule hereto. List of goods and services.
21. The date of the application shall be the date of its receipt in the Registry, provided that, where the fee in respect of such application is received on a date later than the date of receipt of the application, then that later date shall be deemed to be the date of the application. Date of application.
22. Where the earlier application referred to in the declaration claiming priority is in a language other than the language of the application for the registration of the mark or collective mark in Sri Lanka, the Registrar may require the applicant to furnish him, within three months, with a translation of the earlier application in the language of the application for the registration of such mark in Sri Lanka. Translation of earlier applications.
23. Where the certificate referred to in section 104 of the Code is in a language other than the language of the application, the Registrar may require the applicant to furnish him, within three months, with a translation of that certificate in the language of the application. Translation of certificate.
24. Any notice of opposition referred to in section 107(10) of the Code shall be made on Form M2 set out in the Third Schedule hereto and shall be signed by the opposing party or his authorized agent. Notice of opposition.

<sup>2</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks, adopted by the Nice Agreement (*Editor's Note*).

- Notice of non-completion of registration.**      **25.** Any notice of non-completion of registration referred to in section 108 of the Code shall be made on Form M3 set out in the Third Schedule hereto. The time specified in the notice for the completion of the registration shall be three months from the date of issue of such notice.
- Refusal of registration.**      **26.** The Registrar shall not register any application for a mark or collective mark where words or definitions appear such as "President", "Prime Minister", "Minister", "State", "Government" or any words of similar meaning which are likely to mislead the public into believing that such mark or collective mark has state patronage or authorization.
- Particulars to be recorded in Register of Marks.**      **27.** In addition to the particulars referred to or specified in section 109(2) of the Code the following particulars shall also be recorded in the Register of Marks in respect of each registered mark or collective mark:—  
 (a) the number of application;  
 (b) the name and address of any authorized agent or the owner of the registration;  
 (c) the reference to the date and number of the *Gazette* in which the registration was published;  
 (d) any change in the name of the address of the registered owner of the registration.
- Publication of registered marks.**      **28.** Every registered mark or collective mark shall be published in the *Gazette* in Form M4 set out in the Third Schedule hereto.
- Renewal.**      **29.** The registration of a mark or collective mark may be renewed by the Registrar upon a written request made in that behalf by the registered owner or his authorized agent on payment of the fee.
- Publication of renewal.**      **30.** Every renewal of a registration of a mark or collective mark shall be published in the *Gazette* in Form M5 set out in the Third Schedule hereto.
- Application for alteration of registered mark.**      **31.** Any application under section 116 of the Code shall be made on Form M6 set out in the Third Schedule hereto. It shall be signed by the applicant or his authorized agent. It shall be accompanied by the fee.
- Publication of alteration.**      **32.** Where the Registrar grants leave that the registered mark or collective mark be added to or altered, the publication referred to in section 116 of the Code shall include a representation of the mark as added to or altered, the registration number, the name and address of the registered owner, the date of the registration, the date of the grant of the said leave, the list of the goods or services in respect of which the mark has been registered with an indication of the corresponding class and the reference to the publication of the registration in the *Gazette*.
- Assignment or transmission.**      **33.** (a) Any application under section 119 of the Code to the Registrar requesting him to record in the Register of Marks the assignment or transmission of an application for registration, or the registration of a mark or collective mark shall be made on Form M7 set out in the Third Schedule hereto. It shall be signed by the assignee or transferee and shall be forwarded to the Registrar together with the fee.  
 (b) Where the provisions of paragraph (a) have been complied with, the Registrar shall record such assignment or transmission in the Register of Marks.

**34.** Any changes effected in the conditions governing the use of a recorded collective mark shall be notified by the registered owner to the Registrar on Form M8. It shall be signed by the registered owner of the collective mark or his authorized representative and shall be accompanied by the payment of the fee.

Changes in conditions governing use: notification by owner.

**35.** The fees specified in Column II of the Fifth Schedule hereto shall be payable in respect of matters specified in the corresponding entry in Column I of that Schedule.

Fees.

### PART III

#### PATENTS

**36.** An application for the grant of a patent under section 68 of the Code shall be made on Form P1 set out in the Sixth Schedule hereto and shall be signed by the applicant or his authorized agent.

Application for grant of a patent.

**37. (a)** Where the inventor or the person having title to the invention is dead the legal representative of such inventor or such person having title to the invention may apply for and obtain the patent.

Application for grant of patent in certain cases.

**(b)** Where the applicant dies during the time intervening between the filing of his application and the granting of a patent thereon, the patent may be granted to the legal representative upon proper intervention by him.

**(c)** Where the inventor or the person having title to the invention is insane or otherwise legally incapacitated, the legal representative of such inventor or person may apply for and obtain the patent.

**(d)** In the cases referred to in paragraphs (a), (b) and (c) proof of the power or authority of the legal representative shall be filed with the Registrar. The Registrar may, before the grant of the patent, call for such further evidence as he may require.

**38.** Where an invention has been assigned the assignee shall make an application for the grant of a patent and such application shall be accompanied by a statement specifying the basis of the applicant's right to the patent.

Assignee may make application.

**39.** Where two or more persons have jointly made an invention the application for the grant of a patent shall, subject to regulation 37, be made by them jointly. Form P1 shall, *mutatis mutandis*, be used for making such application.

Joint invention.

**40.** The inventor may address the declaration referred to in section 67(1) or section 68(1)(c) of the Code to the Registrar at any time before the grant of the patent.

Declaration of inventor.

**41.—(1)** The description of invention shall first state the title of the invention as appearing in the request and shall—

Description of invention.

- (i) specify the technical field to which the invention relates;
- (ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and preferably, cite the documents reflecting such art;
- (iii) disclose the invention in such terms that it can be understood and in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person having ordinary skill in the art, and state the advantageous effects, if any, of the invention with reference to the background art;

- (iv) briefly describe the figures in the drawings, if any;
- (v) set forth at least the best mode contemplated by the applicant for carrying out the invention; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any;
- (vi) indicate explicitly, when it is not obvious from the description of the nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used, or, if it can only be used, the way in which it can be used.

(2) The manner and order specified in paragraph (1) shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more economical presentation.

**42.—(1)** The number of the claims shall be reasonable in consideration of the nature of the invention.

(2) If there are several claims, they shall be numbered consecutively in arabic numerals.

(3) Any claim submitted after the filing date of the application and which is not identified with the claims previously appearing in the application shall, at the choice of the applicant, be submitted either—

- (a) as an amended claim, in which case, it shall bear the same number as the previous claim it amends; or
- (b) as a new claim, in which case, it shall bear the next number after the highest previously numbered claim.

(4) The deletion of any claim previously appearing in the application shall be made by indicating the number of the previous claim followed by the word “cancelled”.

(5) Where the application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features. When used, the reference signs shall preferably be placed between parentheses. If inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made.

(6) (a) The definition of the invention shall be in terms of the technical features of the invention.

(b) Whenever appropriate, claims shall contain—

- (i) a statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art;
- (ii) a characterizing portion—preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect—stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.

(7) (a) Any claim which includes all the features of one or more other claims (claim in dependent form, hereinafter referred to as “dependent claim”) shall do so by a reference, if possible at the beginning, to the other claim or claims and shall then state the additional features claimed. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such claims in the alternative only. Multiple dependent claims shall not serve as a basis for any other multiple dependent claim.

(b) Any dependent claim shall be construed as including all the limitations contained in the claims to which it refers or, if the dependent claim is a multiple dependent claim, all the limitations contained in the particular claim in relation to which it is considered.

(c) All dependent claims referring back to a single previous claim as well as all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most practical way possible.

**43.—**(1) (a) Subject to the provisions of paragraph (b) (ii), drawings shall be required Drawings.  
when they are necessary for the understanding of the invention.

(b) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings—

- (i) the applicant may include drawings in the application when filed;
- (ii) the Registrar may require that the applicant file such drawings with him and within a time limit specified by him.

(c) Where drawings are supplied, a reduction of the most illustrative drawing shall be furnished by the applicant in the size and within the time limit specified by the Registrar.

(2) Flow sheets and diagrams are considered drawings.

**44.—**(1) The abstract shall consist of the following:—

Abstract.

(a) a summary of the disclosure as contained in the description, the claims, and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention;

(b) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.

(2) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words).

(3) The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(4) Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by a reference sign placed between parentheses.

(5) The abstract shall be accompanied by the most illustrative of any drawings furnished by the applicant.

**45.—**(1) Section 71 of the Code shall be construed as permitting, in particular, either of the following two possibilities:—

Unity of  
invention.

(a) in addition to an independent claim for a given product, the inclusion in the same application of one independent claim for one process specially adapted for the manufacture of the said product, and the inclusion in the same application of one independent claim for one use of the said product; or

(b) in addition to an independent claim for a given process, the inclusion in the same application of one independent claim for one apparatus or means specifically designed for carrying out the said process.

(2) Subject to section 71 of the Code it shall be permitted to include in the same application two or more independent claims of the same category which cannot readily be covered by a single generic claim.

(3) Subject to section 71 of the Code it shall be permitted to include in the same application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention.

Divisional applications.

**46.**—(1) Any divisional application under section 72(2) of the Code shall contain a reference to the initial application.

(2) If the applicant wishes a divisional application to benefit from any priority claimed for the initial application, the divisional application shall contain a request to that effect. In such a case, the declaration of priority and the documents furnished in accordance with regulation 47 for the initial application shall be deemed to relate also to the divisional application.

(3) Where the priorities of two or more earlier applications are claimed for the initial application, a divisional application may benefit only from the priority or priorities that are applicable to it.

Matters to be disregarded for prior art purposes.

**47.** An applicant who wishes that the disclosure of matter constituting the invention claimed in the application should be disregarded for prior art purposes under section 61(3) of the Code may so refer to that in the request and shall set forth the facts in a statement accompanying the application.

Declaration of priority.

**48.**—(1) The declaration of priority referred to in section 73(1) of the Code shall indicate—

- (a) the date of each earlier application;
- (b) the number of each earlier application, subject to paragraph (2);
- (c) the symbol, if any, of the International Patent Classification which has been allocated to each earlier application, subject to paragraph (3);
- (d) the name of the State in which each earlier application was filed or, where the earlier application is a regional or an international application, the name of the State or States for which it is filed;
- (e) where the earlier application is a regional or an international application, the Office with which it was filed.

(2) Where at the time of filing the declaration referred to in paragraph (1), the number of any earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed.

(3) Where a symbol of the International Patent Classification has not been allocated to the earlier application, or had not yet been allocated at the time of filing the declaration referred to in paragraph (1), the applicant shall state this fact in the said declaration.

(4) Where the priorities of two or more earlier applications are claimed, in accordance with paragraph (1), the indication relating to those earlier applications may be included in a single declaration.

(5) The applicant may, at any time before the grant of the patent, amend the contents of the declaration referred to in the preceding paragraphs.

Copy and translation of earlier application.

**49.**—(1) Where section 73(2) of the Code applies, the period for furnishing the certified copy of each earlier application shall be three months from the date of the Registrar's request.

(2) Where the copy referred to in paragraph (1) has already been furnished for another application, the applicant may respond to the Registrar by making a reference to that other application.

(3) Where the earlier application referred to in paragraph (1) is in a language other than the language of the application for grant of a patent in Sri Lanka, the Registrar may require the applicant to furnish him, within three months, with a translation of the earlier application in the language of the application for the grant of such patent in Sri Lanka. The Registrar may extend the time limit for such period as he deems appropriate.

**50.** If the Registrar finds that the requirements of section 73 of the Code and regulations 48 and 49 have not been complied with, he shall invite the applicant to file the required correction within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate. If the applicant does not comply with the said invitation, the declaration referred to in section 73 (1) of the Code shall be deemed to be null and void. Corrections.

**51.—(1)** The applicant or his authorized agent, if so authorized in that behalf by the applicant, may withdraw the application at any time during its pendency. Withdrawal of application.

(2) The withdrawal of the application shall be effected by a written declaration addressed to the Registrar. In the case of several applicants, the declaration shall be signed by all the applicants.

**52.—(1)** The date of receipt of the application shall be recorded as the filing date of such application. Filing date.

(2) If the Registrar finds that, at the time of receipt of the application, the requirements referred to in section 74 (1) of the Code were not complied with, he shall invite the applicant to file the required correction within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate.

(3) If the applicant complies with the invitation referred to in paragraph (2), the Registrar shall record as the filing date, the date of receipt of the required correction.

(4) Where the application refers to drawings, which in fact are not included in the application, the Registrar shall invite the applicant to furnish the missing drawings within three months from the date of the Registrar's invitation. The Registrar may extend that time limit for such period as he deems appropriate. If the applicant complies with the said invitation, the Registrar shall record as the filing date of the application, the date of the receipt of the missing drawings. Otherwise, the Registrar shall record as the filing date of the application the date of the receipt of the application and shall treat any reference to the said drawings as non-existent

**53.—(1)** The applicant shall furnish to the Registrar, within three months from the date of issue of the international-type search report referred to in section 70 (1) of the Code, two copies of that report. International-type search report.

(2) The international-type search report prescribed for the purpose of section 70 (1) of the Code shall be a report issued by any national industrial property office or any inter-governmental organization appointed as an International Searching Authority under the Patent Cooperation Treaty.

(3) For the purpose of section 70 (1) of the Code, the translation in the English language of the international-type search report shall extend to the text of that report as such, but need not include the text of any document cited in that report unless the Registrar, after an examination of the translation accompanying that report, requires that the applicant furnish a translation of the text of any given document so cited or of any portion of that document. Translation of report.

**54.** The prescribed period referred to in section 70 (1) of the Code for the furnishing by the local examiner of his report on examination as to relevant prior art shall be not later than three months from the date of reference to him by the Registrar. Report of local examiner.



- Period for payment to the Registrar to prepare abstract. **55.** The prescribed period referred to in section 75 (3) of the Code shall be a period of three months from the date of the request made by the Registrar.
- Certificate of grant of patent. **56.** The certificate of the grant of a patent, referred to in section 76 (2) (a) of the Code shall, *inter alia*, contain the number of the patent, the name and address of the owner of the patent, the filing date and the priority date, if any, of the application, the date of the grant of the patent and the title of the invention. The certificate of the grant of the patent shall be signed by the Registrar.
- Contents of the patent. **57.** The patent granted pursuant to section 76(2) of the Code shall, in addition to containing a copy of the description, the claims, all the drawings, if any, and the abstract, include the following particulars:—  
 (i) the name and address of the inventor, except where the inventor has indicated that he wishes not to be named in the patent;  
 (ii) the name and address of the agent, if any;  
 (iii) the title of the invention;  
 (iv) the symbol of the International Patent Classification;  
 (v) the date and, if any, the number of the international-type search report and the name of the institution issuing the report.
- Recording of the patent. **58.** The Registrar shall, in respect of each patent, record in the Register of Patents the particulars mentioned in section 77 of the Code and in regulation 57.
- Assignment or transmission. **59.—**(1) Any application under section 84 of the Code to the Registrar, requesting him to record in the Register of Patents the assignment or transmission of an application for the grant of a patent or the grant of a patent, shall be made on Form P2 set out in the Sixth Schedule hereto. It shall be forwarded to the Registrar together with the fee.  
 (2) Where the provisions of paragraph (1) have been complied with, the Registrar shall record such assignment or transmission in the Register of Patents.
- Lapse of a patent. **60.** The Registrar may record in the Register of Patents the lapse of a patent.
- Fees. **61.** The fees specified in Column II of the Seventh Schedule hereto shall be payable in respect of matters specified in corresponding entry in Column I of that Schedule.

## PART IV

## MISCELLANEOUS

- Mode of payment of fees. **62.—**(1) Subject to paragraph (2), any fee payable under these regulations shall be paid in cash, or by cheque or money order or postal order drawn in favour of the Registrar.  
 (2) Where any person liable to pay any fee under these regulations is not resident in Sri Lanka, such person shall pay such fee by way of a bank draft drawn in favour of the Registrar.

**63.** The following Rules are hereby rescinded:—

Rescissions.

- (a) The Trade Mark Rules published in *Gazette Extraordinary* No. 7,559 of December 12, 1926, as last amended by Rule published in *Gazette* No. 10,634 of January 29, 1954;
- (b) The Designs Rules published in *Gazette* No. 6,124 of June 1, 1906, as last amended by Rules published in *Gazette* No. 10,634 of January 29, 1954; and
- (c) The Patent Rules published in *Gazette* No. 6,182 of May 3, 1907, as last amended by Rules published in *Gazette* No. 11,670 of September 20, 1959.

**64.** In these regulations, "the Code" means the Code of Intellectual Property Act, Interpretation. No. 52 of 1979.

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[An Extract of the Gazette of the Democratic Socialist  
Republic of Sri Lanka, No. 597 of 08.02.1990]

L.D.—B. 12/79

THE CODE OF INTELLECTUAL PROPERTY ACT  
No. 52 OF 1979

REGULATIONS made by the Minister of Trade and Shipping, under  
Section 171 of the Code of Intellectual Property Act, No. 52 of 1979.

ABDUL RAZAK MUNZOR,  
Minister of Trade and Shipping.

Colombo, 18th January, 1990.

Regulation

Intellectual Property Regulations 1980, published in *Gazette Extraordinary* No. 60/20 of 31st October 1979, are hereby amended, by the substitution for the Second, Fifth and Seventh Schedules thereof of the following Schedules :—

"SECOND SCHEDULE  
INDUSTRIAL DESIGNS—FEES

<i>Column I</i> <i>Subject Matter</i>	<i>Column II</i> <i>Fee</i>
1. On application for registration of each design	Rs. 150.00
2. For inspection of application and to obtain a copy thereof by the creator or a person named as the creator	Rs. 20.00 each page subject to a minimum fee of Rs. 50
3. For issue of Certificate upon registration of an Industrial Design	Rs. 100.00
4. For inspection of the register	Rs. 20.00
5. For obtaining a certified extract of the register 120 words or part thereof	Rs. 5.00 Subject to a minimum fee of Rs. 50
6. For publication in the <i>Gazette</i> of the registration of the Industrial Design	Rs. 42 per inch
7. For 1st renewal of registration	Rs. 500.00
8. For 2nd renewal of registration	Rs. 1,000.00

<i>Column I</i> <i>Subject Matter</i>	<i>Column II</i> <i>Fees</i>
9. Payment of surcharge for late payment at the rate of 10% of the Renewal fee	—
10. On request for Certificate of Registrar for legal proceedings or other specific purpose	Rs. 100.00
11. On request to enter name of subsequent proprietor by assignment or transmission	Rs. 150.00
12. On request to correct clerical error	Rs. 20.00
13. On request to enter new address	Rs. 30.00
14. Application for recording particulars of licence contract or sub-licence	Rs. 150.00
15. Application for recording the renumeration expiration or termination of a licence contract or sub-licence	Rs. 30.00

#### FIFTH SCHEDULE

#### MARKS FEES

The following fees shall be paid in connection with applications, registrations, and other matters under Part V of the Code. Such fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid.

1. On application for registration of each—	
(a) mark	Rs. 250.00
(b) collective mark	Rs. 500.00
2. On application to Registrar to state grounds of decision	Rs. 250.00
3. On notice of opposition for application opposed	Rs. 600.00
4. On observations of applicant in answer to notice of opposition	Rs. 200.00
5. On the hearing of opposition by applicant and opponent respectively	Rs. 400.00
6. For registration of a mark and issue of certificate	Rs. 400.00
7. Upon each entry in the register of a note that mark is associated with a newly registered mark	Rs. 50.00

<i>Column I</i> <i>Subject Matter</i>	<i>Column II</i> <i>Fee</i>
8. On application to register a subsequent proprietor in cases of assignment or transmission—	
(a) For a single mark	Rs. 500.00
(b) For every additional mark, the Devolution being identical in each case and if made in one application	Rs. 50.00
9. On application to change the name of proprietor where there has been no alteration of proprietorship—	
(a) For a single mark	Rs. 100.00
(b) For every additional mark, the charge being the same in each case and if made in one application	Rs. 50.00
10. Renewal of Registration	Rs. 1,000.00
Surcharge	Rs. 100.00
11. On application to alter the address of registered proprietor of licence—	
(a) For a single mark	Rs. 100.00
(b) For every additional mark the alteration being the same in each case and if made in one application	Rs. 50.00
12. For every entry in the register of a rectification thereof or an alteration therein not otherwise charged	Rs. 100.00
13. For cancelling the entry or part of the entry of a mark upon the register on the application of the owner of such mark	Rs. 100.00
14. On an application to the Registrar for leave to add to or alter a mark or collective mark	Rs. 300.00
For publication in the Gazette of mark or collective mark if leave is granted	Rs. 42.00 per inch
15. For inspecting Register, application, notice of opposition, observation or decisions, or any other document related to documents enumerated above	Rs. 20.00
16. For obtaining certified extracts of Register and copies of documents	For every 120 words Rs. 5.00 Subject to a minimum fee of Rs. 50.00
17. For certifying office copies or printed matter	Rs. 50.00

<i>Column I</i> <i>Subject Matter</i>	<i>Column II</i> <i>Fee</i>
18. Publication of the application in the Gazette	Rs. 42.00 per inch
19. Application on request for recording particulars of licence contract of sub-licence	Rs. 500.00
20. Application for recording the expiration or termination of a licence contract	Rs. 100.00
21. Application for renunciation of the registration of goods or services for which a mark is registered either wholly or in respect of part of the goods or services	Rs. 100.00
For publication in the Gazette of the renunciation of registration	Rs. 42.00 per inch
22. Application of change in the conditions governing the use of a collective mark	Rs. 300.00
For publication in the Gazette of the notification of change	Rs. 42.00 per inch
23. For certificate under hand or Registrar as to any entry, matter or thing which he is authorised to make	Rs. 100.00

SEVENTH SCHEDULE  
*PATENTS FEES*

1. On application for the grant of a patent	Rs. 1,500.00
2. On inspection by the inventor of the application and to obtain copy thereof by the inventor	Rs. 20.00 per page subject to a minimum fee of Rs. 50.00
3. On request to refer an application to a local examiner	Rs. 450.00
4. For the preparation by the Registrar of an abstract	Rs. 200.00
5. For a copy of the patent together with the search report	Rs. 200.00
6. For a certified extract of the Registrar of Patents	Rs. 50.00
7. On application for the assignment or transmission of a patent application or patent	Rs. 750.00

<i>Column I</i> <i>Subject Matter</i>	<i>Column II</i> <i>Fees</i>
8. On request for recording particulars of—	
(a) a license contract or of any assignment, transmission, sub-license, amendment, renewal	Rs. 550.00
(b) expiration or termination thereof	Rs. 100.00
9. For an amendment of the application and for each divisional application	Rs. 150.00
10. (i) For inspection of the Register of Patents in respect of each patent	Rs. 20.00
(ii) For inspection of the Classified Abstracts in respect of each class	Rs. 20.00
11. For inspection of the file relating to the Patent after the grant of the Patent or with the permission of the applicant before the grant	Rs. 20.00
12. For obtaining certified extracts of the file relating to the Patent after the grant of the patent or with the permission of the applicant before the grant of the Patent	Rs. 20.00 per page, subject to a minimum fee of Rs. 50.00
13. For divulging permissible information before the grant of the Patent by the Registrar	Rs. 20.00
14. In order to keep the Patent in force—	
(a) For the 1st extention	Rs. 2,000.00
(b) For the 2nd extention	Rs. 2,000.00
(c) For the 3rd extention	Rs. 3,000.00
(d) For the 4th extention	Rs. 3,000.00
(e) For the 5th extention	Rs. 3,500.00
(f) For the 6th extention	Rs. 3,500.00
(g) For the 7th extention	Rs. 3,500.00
(h) For the 8th extention	Rs. 7,000.00
(i) For the 9th extention	Rs. 7,000.00
(j) For the 10th extention	Rs. 7,000.00
(k) For the 11th extention	Rs. 7,000.00
(l) For the 12th extention	Rs. 7,000.00
(m) For the 13th extention	Rs. 7,000.00

15. Surcharge on late applications for extentions—10 percent of the fee due.”



