

PATENT LAW IN SRI LANKA

Introduction

Patent legislation in Sri Lanka can be traced to the earlier years of this century. As pointed out by **T.A. Blanco White** "the basic theory of the patent system is simple and reasonable. It is desirable in the public interest that industrial techniques should be improved" (quoted by Banks Commission in its Report on the British Patent System 1970). It encourages research and invention, it induces an inventor to disclose his discoveries instead of keeping them as a trade secret, it offers a reward for the expenses of developing invention to the stage at which they are commercially practicable and finally provides an inducement to invest capital in new lines of production (Swan Committee's Report quoted with approval by the Indian Ayyangar's Report (1959).

Patent Ordinance (1907)

This Ordinance came into effect from 1st January 1907 and was in force until the enactment of the **Code of Intellectual Property Act No.52 of 1979**. This Act was modeled on the British Act of the relevant period, as was the case in most colonial enactments. It provided for a person whether a British subject or not to make an application for a patent. Two or more persons may make a joint application. Provision was also made for a person to whom the invention was communicated by the actual inventor, if the actual inventor is not resident in Ceylon (former name for Sri Lanka). The application must contain a declaration that the Applicant is in possession of the invention and that he is the first inventor. It must be accompanied either by a complete specification or provisional specification and have an address in Colombo for the reception of notices and communication. The Registrar shall refer every application to an examiner who shall ascertain whether the name of the invention has been fairly described and the application, specification, and drawings if any have been prepared in the prescribed manner.

Where a complete specification has been left after the provisional specification, the Registrar shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner and whether the invention particularly described in the complete specification is substantially the same as that, which is described in the provisional specification. The examiner shall also make an investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any petition or specification (other than a petition not followed by a complete specification) published before the date of the application and filed or deposited in Ceylon before the date of the application. On acceptance of the complete specification the Registrar shall advertise in the Gazette and any person may oppose a grant of the patent on the ground of an Applicant having obtained the invention from him, or on the ground that the invention has been patented in Ceylon on application or petition of prior date, or on the ground of the complete specification described or claim an invention other than described in the

provisional specification. The Opposition inquiry will be held by the Attorney General. If there is no Opposition or if the Opposition proceedings are determined in favour of the Applicant the patent would be sealed. The term of patent is for a period of 14 years.

There was also provision in the Ordinance for amendment of specification by Applicant or a patentee from time to time to amend the specifications including drawings by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reason for the same.

The Ordinance also provided for the grant of compulsory licenses. Any person interested may present the petition to the Minister alleging that the reasonable requirements of the public with respect to a patented invention has not been satisfied and praying for a grant of a compulsory license or in the alternative for a revocation of the patent. Provisions were also made regarding the grounds of revocation of patent.

Following the provisions of most colonial legislation of the time, special provision was made for the registration of British patent and it was provided that it shall be lawful for the Registrar in his discretion on the application of any person being the holder or assignee of any patent for any invention granted or issued in Great Britain and upon such proof as the Registrar may deem sufficient that such person is the bona fide holder of the said patent and upon the payment of the prescribed fee apply to the Minister for the grant of a Certificate under the Public Seal of Island and such Certificate shall be deemed to be a patent issued under the Ordinance.

Code of Intellectual Property Act No. 52 of 1979

Part IV of this law deals with patents. An invention has been defined in Section 59 to mean "**an idea of an inventor which permits in practice the solution to a specific problem in the field of technology**". Both product and process patents are recognised in Sri Lanka as Section 59(2) provides that an invention may be, or may relate, to product or process. However the following inventions are not 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 of 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 practiced on the human or animal body;

Provided, however, that this paragraph shall not apply to the products used in any such methods.

With regard to plant or animal varieties referred to in (b) above, the Sri Lankan Courts have not had an opportunity of laying down any principles as no case has been taken to the Superior Courts. Under U.K. patent law the methods of agriculture were not considered a patentable manner of manufacture. For instance the method of producing a new form of a known plant was not a manner of manufacture even if it involved a modification of the conditions under which natural phenomena would pursue their inevitable course (N.V. Philips Gloeilampenfabrieken's Appln 71 RPC 192).

However the process for the production of edible mushroom tissue in firm pellet form has been held in England to be patentable (Szeucs Appln. (1956) RPC 25). Again English Law has always considered the method of medical treatment of human beings does not constitute a patentable invention (Upjohn company (Robert's) Appln. (1977) RPC94, contra the position in Israel (Wellcome Foundation vs Planters (1974) RPC 514 and doubts were raised in Australia in Joos vs Commissioner of patents (1973) RPC 59 although New Zealand appears to have followed the Upjohn case in Wellcome Foundation's (Hittching) Appln. (1983) FSR 593). However these matters have not received consideration by the Sri Lanka Court has yet.

An invention is patentable if it is new, involves an inventive step and is industrially applicable (s.60). An invention is new if it is not anticipated by prior art. 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 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.

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.

An **invention** has been defined as follows: -

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 invention steps would not have been obvious to a person having ordinary skill in the art (s.62).

Industrial application has been defined as follows: -

An invention shall be considered industrially applicable if it can be made or used in any kind of industry (s.63).

Who may apply for a patent?

The right to obtain a patent belongs to the inventor. Where two or more persons have jointly made an invention, the right to a patent shall belong to them jointly (s.64). Section 65 however provides that 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 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.

In the case of inventions made by an employee or pursuant to a commission 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 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 the Agreement between the parties.

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.

Application for a grant

An application for a grant of a patent shall be made to the Registrar in the prescribed form and contain: -

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

Where the applicant's ordinary residence or principal place of business is outside of Sri Lanka he shall be represented by an agent resident in Sri Lanka.

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. The request shall contain: -

- (1) a petition that the patent be granted;
- (2) the title of the invention;
- (3) 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 shall be, accompanied by a statement justifying the applicant's rights to the patent.

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. The claim or claims shall be clear, concise and supported by the description. Drawings shall be required when they are necessary for the understanding of the invention. 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. 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 shall be accompanied by the prescribed fee and by a search report of an International type search as may be prescribed. However in view of such International type search the applicant may request the Registrar to refer the application to a local examiner who shall examine the application on the basis of the claims with due regard to the description and drawings and furnish a report to the Registrar on the relevant prior art after having endeavoured to discover as much of the relevant prior art as the facilities permit.

Amendment and Divisional Application

An applicant may amend the application provided that such amendment does not go beyond the disclosure in the initial application. An applicant may divide an application into two or more applications called divisional applications provided that such divisional application shall not go beyond the initial application. Each divisional application shall be entitled to filing where applicable according to the priority date of the initial application.

Priority

Application may contain a declaration claiming priority in terms of the provisions of the Paris Convention in one or more earlier national, regional or international applications filed by the applicant or his predecessor-in-title.

Examination

In Sri Lanka an application for a patent is examined as to basic formal requirements. There is no substantive examination of the patent application. This simplified procedure for granting of patent is due to two reasons. The first, while requiring an application to be accompanied by an International Search Report or be subject to a search by a local examiner which may be consulted in judicial proceedings if the validity of the patent is challenged, the law dispenses with the examination of patentability as to the substance in the granting procedure. The patent is generally granted if the formal requirements recognised for a valid application are complied with. Secondly there is no provision regarding Opposition Proceedings in the granting stage and it is left to the Court to decide on the validity of the patent after grant thereby eliminating the delay and expenses at the stage of the grant (Administration of Intellectual Property in Sri Lanka published by the Registry of patents and Trademarks in Sri Lanka.

Grant

Once the Registrar is satisfied that the applicant has fulfilled the required formalities a patent would be granted and such grant shall be recorded in the register and published in the Gazette. Copies of the patent together with search report would be made available to the public.

Duration

A patent is valid for 15 years from the date of the grant. After two years of the grant a patent must be renewed each year until the expiration period of 15 years.

Classification

A patent document is classified according to the International patent Classification.

PCT Application

Sri Lanka is a contracting party to the patent Co-operative Treaty, and Sri Lanka is designated in PCT applications. The Sri Lanka registry is not a receiving office for the purposes of PCT applications and WIPO Headquarters in Geneva act for Sri Lanka as the receiving office.

Assignment and License Agreement

The Code also provides for patent applications to be assigned and for parties to enter into license contract.

J.M. SWAMINATHAN

LLB (Cey), LLM M Phil (Col)

Attorney-at-Law,

Partner, M/S Julius & Creasy

Lecturer Diploma in International Law Course - Sri Lanka Law College

Member Intellectual Property Advisory Commission