

SRI LANKA PATENT PROCEDURE

The Law relating to the registration and enforcement of patents in Sri Lanka is contained in the **Code of Intellectual Property Act No.52 of 1979** and the regulations made thereunder. An invention is patentable if it is new, involves an inventive step and is industrially applicable. 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 patent application claiming the invention and;
- (b) the contents of a domestic patent application having an earlier filing or, where appropriate, priority date of 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 so made 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 shall be considered as inventive if –

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 art.

The right of the patent shall belong to the inventor. Two or more persons may make an application jointly.

An invention made in the performance of a contract of employment shall in the absence of any provision to the contrary in the contract of employment be deemed to accrue to employer or the person who commissioned the work.

The application for the grant of a patent shall be made to the Director of Intellectual Property in the prescribed form –

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

1. a request for the grant of the patent;
2. a description;
3. a claim or claims;
4. a drawing or drawings, where required;
5. an abstract

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:

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 for grant of a patent shall contain -

- a. a petition that the patent be granted;
- b. the title of the invention;
- c. 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 right to the patent.

Title of the invention shall be as appearing in the request and shall –

- (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 drawings, if any;
- (vi) indicate explicitly, when it is not obvious from the description, the nature of the invention, the way in which the invention is industrially applicable and the way in which it can be used.

Drawings shall be required when they are necessary for the understanding of the invention. Abstracts shall consist of -

- 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;
- c. The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words);
- d. The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application;
- e. 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;
- f. The abstract shall be accompanied by the most illustrative of any drawings furnished by the applicant;

The date of receipt of the application shall be recorded as the filing date of the application.

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 Director 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 Director, 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.

The Director shall examine the application to ensure that all the formalities contained in the Act are satisfied and if any other conditions are not fulfilled he may request the applicant to file the required correction.

Where the Director is satisfied that the formal requirements have been complied with he shall grant the patent and record the patent in the register and make available to the public on payment of a prescribed fee copies of such application.

A patent so granted shall consist of –

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 symbol of the International Patent Classification;
- (iv) the date and, if any, the number of the international-type search report and the name of the institution issuing the report.

In Sri Lanka there is only a formal examination of the patent and substantive examination is not carried out and there is no provision for Patent Opposition Proceedings.

There is provision contained in the Act for license contracts to be entered into. Such an agreement shall be signed by both parties and may be filed with the Director with the prescribed fee. If the license contract contains provision for the payment of royalty abroad then the permission of the Central Bank of Sri Lanka would be required.

The registered owner may surrender his patent.

The Code also makes provision for a person showing a legitimate interest or the Director himself to make an application to court to declare a patent null and void. It is also possible for a patent claiming infringement to institute proceedings in court for the issue of an injunction restraining such a person from committing or continuing such infringement and the court may also award damages and any other relief which appears to the court to be just and appropriate. Proceedings may also be instituted in the Magistrate Court in respect of infringement of a patent right and the Magistrate may on conviction impose a fine on the offender of a sum not exceeding Rs. 20,000/- or imprisonment of six months.

PCT Procedure –

The Patent Co-orporation Treaty is an agreement for international cooperation in the field of patent. The principle objective of the PCT is to simplify and render more effective and more economic and increase the uses of the Patent System through the offices which have the responsibility for administering in Sri Lanka a Patent application by providing for a Declaration claiming the priority pursuant to one or more earlier International applications filed by the applicant or his predecessor in title, in or for a State, party to the convention.

An application contains a declaration of claiming priority as referred to above. The Director of Intellectual Property may require that the applicants furnish within the prescribed time a copy of the earlier application certified as correct by the international application filed under the Patent Cooperation Treaty,

SRI LANKA

It gives me pleasure to present I believe for the first time a report on Sri Lanka for the past year concerning the majority developments in the field of Intellectual Property.

The current legislation is contained in the Code of Intellectual Property Act No. 52 of 1979. This statute which came into force on 01st January 1980 is modelled on the WIPO Code. Prior to the enactment of this law, legislation in Sri Lanka was modelled on the English legislation. Even after the enactment of the Code, courts do regularly refer to english uthorities.

CODE OF INTELLECTUAL PROPERTY AMENDMENT ACT NO. 40 OF 2000

This Statute was introduced and specifically provides computer software is included for copyright protection. There were cases decided by the Supreme Court which had the effect of holding that goods for export may not amount to use in Sri Lanka and therefore infringe another's trademark. This unsatisfactory state of the law has now been remedied by the legislation, which specifically provides that export goods could also be a subject matter of infringement action.

There have been not many cases on intellectual property law, which have been reported in the law reports of Sri Lanka during the last year. One case that has recently been reported is the case of **Malhotra International (Pvt) Ltd., vs Anglo-Asian Distributors Ltd., (2000) 3SLR** Page 116. In this case the Appellant was the owner of the trademark "TOPAZ" in respect of inter alia razors and safety razor blades in several countries including Sri Lanka and India. The first Respondent applied to register the marks "2PAS", "2-PAZ", and "FOBAS" in respect of inter alia safety razors and safety razor blades. The appellant objected to the applications alleging that the proposed trademark had a close resemblance to the appellant's trademark "TOPAZ" and intended to mislead the public. The Registrar disallowed the application in respect of "2PAS" and "2-PAZ" but allowed the application in respect of "FOBAS". The Appellant appealed to the District Court, which was subsequently transferred to the High Court in terms of the provisions of High Court of the Provinces (Special Provisions Act No. 10 of 1996) and thereafter the Supreme Court. The Supreme Court held that the documentary evidence before the court showed that the get up colour scheme of labels or hanging cards adopted by the first respondent were deceptively similar to those of the appellant under the mark "TOPAZ". Such evidence was relevant to determine whether there was unfair competition within the meaning of the Act. The Supreme Court further observed, "in order to determine the existence of unfair competition, it would not be adequate to consider only the form in which the propounded mark is applied for but a consideration of the actual use of the mark is also necessary. The form in which the propounded mark is applied for, by itself may look quite innocuous.

An action for infringement of patents was considered in the case **St. Regis Packaging (Pvt) Ltd., vs Ceylon Paper Sacks Ltd., 2001 I SLR** Page 36. In this case the Plaintiff filed an action against the Defendant for the alleged infringement of its rights in Patent No. 10674. The patent was for a product called **SAFE T PACK** a container used for packing tea, an alternative to plywood chests. The inventor of the patent

Mr.Caderamanapulle had a dispute with the Defendant that resulted upon an application filed in the Commercial High Court of Colombo. The Court directed the registrar of Court to enter Mr.Caderamanapulle's name as the registered owner of the patent. Mr.Caderamanapulle subsequently assigned his rights to the Plaintiff, which were recorded. The Plaintiff thereupon instituted an action in terms of Section 179 of the Code alleging that the Defendant was infringing its rights and selling products exploiting the patent registered in the name of the Plaintiff and seeking an injunction against the Defendant restraining him from continuing to infringe the rights of the Plaintiff. The Plaintiff had before the assignment, instituted an action against **E.I.& M. (Pvt) Ltd.**, in terms of Section 67 of the Code that Industrial Design No. 5469 is null and void. The Supreme court held that once the assignment of the patent was recorded, the Plaintiff had the rights of the proprietor and was entitled to file action for infringement under Section 179 and when an action against **E.I.&M.(Pvt) Ltd.**, was filed by the Plaintiff in terms of Section 57 for declaration, the design was null and void, the Plaintiff was not the registered owner of the Industrial Design. As such, the Plaintiff's failure to seek an injunction at the stage did not bar his right to seek an injunction in the present case. The Supreme Court further held that infringement of intellectual property is a continuous act giving a recurrent cause of action.

The Intellectual Property Advisory Commission has prepared a new draft amending the legislation in respect of trademarks, patents and designs. Although the changes in respect of trademarks is minimal, in view of the fact that Sri Lanka complies broadly with the TRIPS, as far as trademarks are concerned, certain provisions such as geographical appellations and time limit for appeals have now been specifically provided.

In regard to patents, the validity period has been extended to twenty years and local examination of patents has also been provided for in certain circumstances. Extensive provisions have been made in respect of the copyright law which includes performance rights, rental rights and provisions relating to semi conductor chips. Detailed provision is also expected to be made in respect of unfair competition.

More details on the proposed legislation may be available for the next year's conference once the legislation has been passed by Parliament.

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

