

L.D.O 28/2012

An Act to Amend the Intellectual Property Act, No.36 of 2003

BE it enacted by the Parliament of the Democratic Socialist Republic of Sri Lanka as follows :-

Short title. **1.** This Act may be cited as the Intellectual Property (Amendment) Act, No. of 2013.

Amendment of section 2 of the Intellectual Property Act, No.36 of 2003. **2.** Section 2 of the Intellectual Property Act, No. 36 of 2003 (hereinafter referred to as the “principal enactment”) is hereby amended in paragraph (b) of subsection (2) thereof, by the substitution for the words “copyright and related rights under Part II of the Act.”, of the words “copyright and related rights recognized under Part II of the Act.”.

Amendment of section 5 of the principal enactment. **3.** Section 5 of the principal enactment is hereby amended as follows-

(1) by the repeal of the definition of the expression “communication to the public” and the substitution therefor, of the following definition :-

“communication to the public” means the transmission to the public by wire or without wire of images or sounds, or both, of a work, a performance or a sound recording, including the making available to the public of a work, a performance or a sound recording, in such a way that members of the public may access them from a place and at a time individually chosen by them.⁽²⁾;

(2) by the repeal of the definition of the words “published” and the substitution therefor, of the following definition:-

“published” means –

- (a) to make available to the public, copies of any work or a sound recording in a reasonable quantity for sale, rental, public lending or for transfer of the ownership or possession of such copies; or
- (b) to make available to the public, copies of any work or a sound recording by means of an electronic system:

Provided that, the making available of copies to the public shall, in the case of a work, take place with the consent of the owner of copyright and, in the case of a sound recording, take place with the consent of the producer of the sound recording or his successor in title.”

Amendment of section 7 of the principal enactment.

4. Section 7 of the principal enactment is hereby amended by the repeal of paragraph (b) of subsection (1) thereof and the substitution therefor, of the following paragraph :-

“(b) collections of works and collections of mere data (databases), whether in machine readable or other form, provided that such collections are original by reason of the selection, coordination or arrangement of their contents.”.

Amendment of section 9 of the principal enactment.

5. Section 9 of the principal enactment is hereby amended as follows—

- (1) in subsection (1) of that section, by the subsection for the words and figures “subject to the provisions of sections

11 to 13, the owner of copyright of a work shall have the exclusive right to carry out or to authorize the following acts in relation to the work-“, of the words and figures “subject to the provisions of sections 11 to 13, the owner of copyright of a work shall have the exclusive right to carry out or to authorize the following acts in relation to such work-“;

- (2) in subsection (1) of that section, by the repeal of paragraph (e) of that subsection and the substitution therefor, of the following paragraph :-

“(e) rental of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer program, a data base or a musical work in the form of notation, irrespective of the ownership of the original or copy concerned;”;

- (3) in subsection (1) of that section, by the repeal of paragraph (g) of that subsection and the substitution therefor, of the following paragraph :-

“(g) public display of the original or a copy of the work;” and

- (4) by the repeal of subsection (4) of that section and the substitution therefor, of the following subsection :-

“(4) Notwithstanding the provisions of paragraph (d) of subsection (1), the owner of a lawfully made copy of a work or any person authorized in that behalf by such owner, is entitled, without the authority of the owner of

copyright, to sell or otherwise dispose of that copy.”.

Amendment of section 12 of the principal enactment.

6. Section 12 of the principal enactment is hereby amended by the repeal of paragraph (a) of subsection (6) of that section and the substitution therefor, of the following paragraph :-

“(a) the reproduction, in a newspaper or periodical, in the manner of broadcasting or any other manner of communication to the public, of an article on a current economic, political or religious topic published in a newspaper or periodical or broadcast or any other manner of communication to the public, and such permission shall not apply where the right to authorize reproduction, broadcasting or other communication to the public is expressly reserved on the copies by the owner of copyright, or in connection with broadcasting or other communication to the public of the work.”.

Amendment of section 14 of the principal enactment.

7. Section 14 of the principal enactment is hereby amended by the repeal of subsections (3) and (4) of that section and the substitution therefor, of the following subsections :-

“(3) in respect of a collective work, the physical person or legal entity at the initiative, and under the direction, of whom or which the work has been created shall be the original owner of the economic rights.

(4) in respect of a work created by an author employed by a physical person or legal entity in the course of his employment, the original owner of the

economic rights shall, unless provided otherwise in a contract, be the employer. If the work is created pursuant to a commission, the original owner of economic rights shall, unless otherwise provided in a contract, be the person who commissioned the work.”.

Amendment of section 19 of the principal enactment.

8. Section 19 of the principal enactment is hereby amended by the repeal of subsections (1) and (2) of that section and the substitution therefor, of the as following subsections :-

“(1) If a sound recording published for commercial purposes, or a reproduction of such sound recording, is used directly for broadcasting or other form of communication to the public, or is publicly performed, a single equitable remuneration for the performer or performers who contributed to such sound recording and the producer of the sound recording shall be paid by such user to the producer.

(2) Unless otherwise agreed between the performer or performers and the producer, half of the amount of the money received by the producer under subsection (1) shall be paid by the producer to the performer or performers.”.

Amendment of section 24 of the principal enactment.

9. Section 24 of the principal enactment is hereby amended by the repeal of subsection (1) of that section and the substitution therefor, of the following subsection :-

“(1) Subject to the provisions of subsection (4), expressions of folklore shall be protected against any act of –

- (a) reproduction;
- (b) communication to the public by performance, broadcasting, distribution by cable or other means; and
- (c) adaptation, translation, and other transformation,

when such an act is carried out either for a commercial purpose or outside the traditional or customary context.”.

Amendment of section 25 of the principal enactment.

10. Section 25 of the principal enactment is hereby amended by the repeal of sub-paragraph (i) of paragraph (a) of subsection (2) of that section and the substitution therefor, of the following paragraph :-

- (i) a society may accept from an owner of the rights the exclusive authorization to administer any or all of the rights recognized under this Part by the issue of licences or collection of licence fees or both; and”.

Insertion of new section 25A in the principal enactment.

11. The following new section is hereby inserted immediately after section 25 of the principal enactment and shall have effect as section 25A of that enactment :-

“Director-General to maintain a Register.

25A.(1) The Director-General shall keep and maintain a Register called and known as “the Register of Copyright” as provided herein below and as may be prescribed. There shall be included in such Register the names or titles of the works and sound recordings protected under this Part and the names and addresses of the authors and owners of copyright of such works, of the producers of such

sound recordings and of the publishers, if the work has been published, and any other information as may be prescribed.

(2) It shall be presumed that the information entered and remaining in the Register of Copyright is correct until proved otherwise.

(3) The author of a work or the owner of copyright of a work or the publisher of a work or a producer of a sound recording may make an application, in the form as may be prescribed together with the prescribed fee, to the Director-General for entering the information referred to in subsection (1), in the Register of Copyright.

(4) (i) Where a work or the name or title of a work or sound recording is used or is capable of being used, as a mark in terms of the provisions of this Act, the application shall accompany a statement by the applicant to that effect and a certificate issued by the Director-General to the effect that no application has been made for the registration of a mark identical with or misleadingly similar to such a work or a name or title by any person other than the applicant and no mark identical with or misleadingly similar to such a work or a name or title has been

registered under the Act in the name of any person other than the applicant;

(ii) The Director-General shall upon the receipt of an application in the form as may be prescribed and subject to the payment of the prescribed fee and on being satisfied that the work or the name or title of the work or sound recording is not so identical or similar, issue a certificate to that effect;

(iii) The Director-General shall refuse the application to issue a certificate if the work or the name or title of the work or sound recording is so identical or similar.

(5) On the receipt of an application in respect of a work or a sound recording as provided above, the Director-General shall, after conducting such inquiry as he may deem necessary, enter the information in the Register of Copyright as provided in subsection (1).

(6) The registration of information in the Register of Copyright shall be voluntary and shall not be a mandatory requirement for the protection of a work or sound recording as provided under this Part.

(7) The Register of Copyright shall be *prima facie* evidence of the information entered therein. The copies of any entry thereof or extract therefrom certified by the Director-General shall be admissible in evidence in any court or proceedings without further proof or production of the originals.

(8) The Director-General may, upon receipt of an application made by any interested party amend the Register of Copyright by correcting any error in the name, title, address or any other information caused by a bona fide mistake or oversight.

(9) The Director General may, upon receipt of an application made by any interested party and after hearing the parties as the Director General deems appropriate, rectify the Register of Copyright by –

- (a) correcting any omission made in entering any information in the Register of Copyright; and
- (b) expunging any entry wrongfully made in the Register of Copyright.

(10) The Director-General shall publish every entry made in the Register of Copyright or rectification of any entry made therein for the information of the public.

(11) The Register of Copyright may be inspected by any person, subject to payment of a prescribed fee and such person may obtain, subject to payment of prescribed fees, the copies of or extracts from, the information entered in the Register of Copyright.

Amendment of section 27 of the principal enactment.

12. Section 27 of the principal enactment is hereby amended by the repeal of paragraph (a) of subsection (2) of that section and the substitution therefor of the following paragraph :-

“(a) sound recordings the producers of which are nationals of Sri Lanka.”.

Replacement of section 30 of the principal enactment.

13. Section 30 of the principal enactment is hereby repealed and the following section in substituted therefor :-

“Definition of industrial design.

“30. 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:

Provided that anything in an industrial design which serves solely to obtain a technical result shall not be protected under this Part.”.

Amendment of section 39 of the principal enactment.

14. Section 39 of the principal enactment is hereby amended by the repeal of subsection (2) of that section and the substitution therefor of the following subsection :-

“(2) Where the applicant fails to comply with the provisions of sections 36 and 38, the Director General shall refuse the registration of the industrial design:

Provided that the Director-General 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 such notification.”.

Replacement of section 50 of the principal enactment.

15. Section 50 of the principal enactment is hereby repealed and the following section is substituted therefor :-

Joint ownership of applications and registration.

50. 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 paragraphs (a) to (c) of subsection (1) of section 47, but may only jointly withdraw the application, renounce the registration or conclude a licence contract.

Replacement of Heading of Chapter XI of Part IV.

16. The heading to Chapter XI of Part IV of the principal enactment is hereby repealed and the following heading is substituted therefor :-

“Patents”.

Amendment of section 62 of the principal enactment.

17. Section 62 of the principal enactment is hereby amended by the repeal of subsection (1) of that section and the substitution therefor of the following paragraph :-

“(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 any field of technology.”.

Replacement
of section 64
of the
principal
enactment.

18. Section 64 of the principal enactment is hereby repealed and the following section is substituted therefor :-

“Novelty.

64. (1) An invention shall be considered new if it is not anticipated by prior art.

(2) Prior art shall consist of—

- (a) everything disclosed to the public, anywhere in the world, by written publication, oral disclosure, use or in any other way, prior to the filing date or where appropriate, prior to the priority date of the patent application claiming the invention;
- (b) the contents of a patent application made in Sri Lanka having an earlier filing date than the patent application or where appropriate, having obtained a priority date earlier 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

patent application made in Sri Lanka.

(3) A disclosure made under paragraph (a) of subsection (2) shall be disregarded –

(a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure occurred 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 occurred by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title by another party.”.

Amendment of section 65 of the principal enactment.

19. Section 65 of the principal enactment is hereby amended by the substitution for the words “such inventive step would not have been obvious”, of the words “such inventive step would not have been obvious”.

Amendment of section 69 of the principal enactment.

20. Section 69 of the principal enactment is hereby amended by the repeal of subsection (1) of that section and the substitution therefor of the following subsection :-

“(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 entering into 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, in the absence of an agreement between the parties, fixed by the Court on an application made to it in that behalf.”.

Amendment of section 71 of the principal enactment.

21. Section 71 of the principal enactment is hereby amended as follows :-

(1) in subsection (1) of that section, by the repeal of sub paragraph (ii) of paragraph (a) of that subsection and the substitution therefor of the following sub-paragraph :-

“(ii) a description of the invention;”.

(2) in subsection (2) of that section, by the repeal of sub-paragraph (ii) of paragraph (a) of that subsection and the substitution therefor of the following sub-paragraph :-

“(ii) the title of the invention;”.

(3) by the repeal of subsection (3) of that section and the substitution therefor of the following subsection :-

“(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 relevant technology and shall, in particular, indicate at least one mode known to the applicant for carrying out the invention.”.

Handwritten signature or initials in blue ink, possibly reading "S. S. S. S. S."

Amendment of section 73 of the principal enactment.

22. Section 73 of the principal enactment is hereby amended by the repeal of subsection (1) of that section and the substitution therefor of the following subsection :-

“(1) (a) 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 a search which shall conform to such type as may be prescribed.

(b) (i) An applicant may, subject to payment of the prescribed fee, request, in lieu of furnishing the search report referred to in paragraph (a) the Director General to refer the application to a local examiner. Upon the receipt of such a request, the Director General shall refer such application to a local examiner who shall examine the invention on the basis of the claim or claims, with due regard to the description and furnish a report to the Director General on relevant prior art and whether the invention is qualified, in his opinion, for the grant of a patent;

(ii) The local examiner shall, in carrying out the search, endeavour to discover as much of the relevant prior art as facilities permit and shall, for this purpose, consult all sources of information on prior art available to him.”.

Amendment of
section 78 of
the principal
enactment.

23. Section 78 of the principal enactment is hereby amended in subsection (1) of that section as follows :-

(1) by the repeal of paragraphs (a) and (b) and the substitution therefor of the following paragraphs :-

“(a) the requirements of paragraph (a) of subsection (1) of section 71;

(b) where applicable, the requirements of paragraph (c) of subsection (1) of section 71;” and

(2) by the repeal of paragraph (g) and the substitution therefor of the following paragraph :-

“(g) either of the search reports referred to in section 73 has been submitted.”.

Amendment of
section 79 of
the principal
enactment.

24. Section 79 of the principal enactment is hereby amended by the repeal of the proviso to subsection (2) of that section and the substitution therefor of the following proviso :-

“Provided, however, where the applicant has not tendered a search report and has requested the Director-General to refer the application to a local examiner in terms of subsection (1) of section 73, the Director-General shall, upon receipt of the report of the local examiner indicating that the invention is qualified for a patent and being satisfied with the report of the local examiner and prior to granting the patent, publish a notice informing the public of the possibility of granting a patent to the applicant at the expiration of a period of three months from the date of the publication of the notice, unless otherwise directed by the Court. If there is not an order

issued by the Court within the said period of three months restraining him from granting the patent, the Director General may grant the patent. If there is an order of the Court issued within the said period of three months restraining the Director General from granting the patent, the Director-General shall not grant the patent until the final determination of the Court is made.”.

Replacement
of section 83
of the
principal
enactment.

25. Section 83 of the principal enactment is hereby repealed and the following section is substituted therefor :-

“Duration of
Patent..

83. (1) Subject and without prejudice to the other provisions of this Part, a patent shall expire twenty years after the filing date of the application for its registration.

(2) Where the owner of the patent intends at the expiration of the second year from the date of grant of the patent to keep the same in force, he shall, 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 the payment of such surcharge as may be prescribed:

Provided further, that the owner of the patent may pay in advance the whole or any portion of the aggregate of the prescribed annual fees.

(3) Where the annual fee has not been paid as provided above, the patent shall be deemed to have expired on the date on which the respective annual fee is due.”.

Amendment of section 84 of the principal enactment.

26. Section 84 of the principal enactment is hereby amended by the repeal of paragraph (c) of subsection (1) of that section and the substitution therefor of the following paragraph :-

“(c) to conclude licence contracts.”.

Amendment of section 102 of the principal enactment.

27. Section 102 of the principal enactment is hereby amended by the repeal of subsection (3) of that section and the substitution therefor of the following subsection :-

“(3) A mark 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.”.

Amendment of section 103 of the principal enactment.

28. Section 103 of the principal enactment is hereby amended in subsection (1) of that section, by the repeal of paragraph (i) of that subsection and the substitution therefor of the following paragraph :-

(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;”.

Amendment of
section 104 of
the principal
enactment.

29. Section 104 of the principal enactment is hereby amended in subsection (1) of that section as follows :-

(1) by the repeal of paragraph (a) and the substitution therefor of the following paragraph :-

“(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 third party validly claiming priority, in respect of identical or similar goods or services in connection with which the use of such mark may be likely to mislead the public;”;

(2) by the repeal of paragraph (b) and the substitution therefor of the following paragraph :-

“(d) (i) if it is identical with, or misleadingly similar to, or constitutes a translation or transliteration or transcription of a mark or trade name which is well known in Sri Lanka for identical or similar goods or services of a third party; or

(ii) if such a well-known mark is registered in Sri Lanka for goods or services which are not identical with or similar to those in respect of which the registration is applied for; provided, that, the use of the mark, the registration of which is applied for, in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use.”.