CHAPTER XX

Admissibility of Marks

Admissibility of marks.

- **102.** (1) The exclusive right to a mark conferred by this Part shall be acquired, subject to the succeeding provisions, by registration.
- (2) Registration of a mark may be granted to the person who—
 - (a) is the first to fulfill the conditions of a valid application; or
 - (b) is the first to validly claim the earliest priority for his application:

Provided however such mark shall not be inadmissible under sections 103 and 104.

(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.

Marks inadmissible on objective grounds.

- **103.** (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;

- (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 trade in Sri Lanka, a customary designation of the goods or services concerned;
- (d) which, is incapable of distinguishing the goods or services of one enterprise from those of another enterprise;
- (e) which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Director-General or of any court to which the matter may be referred to, as the case may be, 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, geographical indication the manufacturing process, the characteristics, or the suitability for their purposes, 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 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 or a certification mark the registration of which has expired and has not been renewed during a period of two years preceding the filing of the application for the registration of the mark in question or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding the filing of the application for the mark in question;
- (l) the registration of which has been sought in respect of goods or services the trading of which is prohibited in Sri Lanka;
- (m) which consists of any other word or definition as may be prescribed.
- (2) The Director-General 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 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 thirdparty rights.

- **104.** (1) The Director-General shall not register a mark
 - (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 identical or similar goods or services in connection with which the 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) if it is identical with, or misleadingly similar to, or constitutes or translation or transliteration or transcription of a mark or trade name which is well known in Srl Lanka for identical or similar goods or services of a third party, or such mark or trade name is well known and registered in Sri Lanka for goods or services which are not identical or similar to these in respect of which registration is applied for, provided in the latter case the use of the mark 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;
- (e) which infringes other third party rights or is contrary to the provisions of Chapter XXXII relating to the prevention of unfair competition;
- (f) which is filed by the agent or a 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 following criteria shall be taken into account in determining whether a mark is well known:—
 - (i) particular facts and circumstances relating to each mark;
 - (ii) any fact or circumstance from which it may be inferred that the mark is well known;
 - (iii) the degree of knowledge or recognition of the mark of the relevant sector of the public;
 - (iv) the duration, extent and geographical area of use of the mark:

- (v) the duration, extent and geographical area of promotion of the mark, including advertising or publicity and the presentation at any fair or exhibition of the goods or services to which the mark applies;
- (vi) the duration and geographical area of the registration or the application for registration, of the mark, to the extent that they reflect use or recognition of the mark;
- (vii) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognized as being well known, by the Competent Authority;
- (viii) the value associated with the mark;
 - (ix) the criteria specified in this subsection to determine whether a mark is well known or not shall not be exclusive nor exhaustive;
 - (x) for the purpose of this subsection
 - (a) "Competent Authority" means an administrative, judicial or quasi-judicial authority which is competent, to determine whether a mark is well known mark or to enforce the protection given to a well known mark;
 - (b) "relevant sector of public" includes :-
 - (i) actual or potential consumers of the types of goods or services to which the mark applies;
 - (ii) persons involved in channels of distribution of the types of goods or services to which the mark applies;
 - (iii) any person or a body of persons dealing with the type of goods or services to which the mark applies.

- (3) The Director-General 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.
- **105.** There shall not be entered in the register a notice of any Trust expressed, implied, or constructive, nor shall any such notice be receivable by the Director-General.

Trust not to be entered in register.

CHAPTER XXI

REQUIREMENTS OF APPLICATION AND PROCEDURE FOR REGISTRATION

106. (1) An application for registration of a mark shall be made to the Director-General in the prescribed form and shall contain —

Requirements of application.

- (a) a request for the registration of the mark;
- (b) the name, address of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka:
- (c) five 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.
- 107. 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

Right of priority.