

Provided, however, that the grounds of nullity referred to in subsection (2) of section 29 shall not be taken into account if such grounds are not apparent on the date of the making 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 33.

(2) Where an application under subsection (1) of this section relates to several industrial designs, included in the registration and any ground for nullity applies to some, 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 for nullity applies.

Date and effect of nullity.

61. (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 Director-General who shall record such declaration in the register and cause it be published in the Gazette.

PART IV

CHAPTER XI

DEFINITIONS

62. (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.

Definition of invention.

(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) plants, animals and other micro organism other than transgenic micro organism and an essentially biological process for the production of plants and animals other than non-biological and microbiological processes :

Provided however, that a patent granted in respect of micro-organisms shall be subject to the provisions of this Act;

- (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, any product used in any such method shall be patentable ;

- (e) an invention which is useful in the utilization of special nuclear material or atomic energy in an atomic weapon ;

- (f) any invention, the prevention within Sri Lanka of the commercial exploitation of which is necessary to protect the public order, morality including the protection of human, animal or plant life or health or the avoidance of serious prejudice to the environment.

Patentable
inventions.

63. An invention is patentable if it is new, involves an inventive step and is industrially applicable.

Novelty.

64. (1) An invention is 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 or, where appropriate, priority date of the patent application claiming the invention ;
- (b) the contents of patent application made in Sri Lanka having an earlier filing or, where appropriate, priority date than the patent application referred to in paragraph (a), to 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 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.

65. 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.

Inventive step.

66. An invention shall be considered industrially applicable if it can be made or used in any kind of industry.

Industrial application of invention.

CHAPTER XII

RIGHT TO A PATENT

67. (1) Subject to the provisions of section 68 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.

(3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filling date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to the patent, so long as that application is not withdrawn, abandoned or rejected.

68. Where the essential element 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 :

Assignment of patent application or patent, by court in case of usurpation.

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 the expiry of a period of five years from the date of grant of the patent.

Inventions made
by an employee
or pursuant to a
commission.

69. (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 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 an application made to it in that behalf, in the absence of an 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 an application made to it in that behalf 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.

Naming of
inventor.

70. (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 Director-General, he indicates his decision to forgo his name being included in the patent.

(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 OF A PATENT

71. (1) (a) An application for the grant of a patent shall be made to the Director-General in the prescribed form and shall contain—

Requirements of applications

- (i) a request for the grant of the patent ;
- (ii) a description of the patent ;
- (iii) a claim or claims ;
- (iv) a drawing or drawings, where required ;
- (v) an abstract ;
- (vi) date and number of any application for a patent filed by the applicant abroad (hereinafter referred to as the “foreign application”), if any, relating to the same, or essentially the same invention as that claimed in the present application ;
- (vii) a declaration that the applicant or his predecessor in title has not obtained a patent abroad before the application was filed relating to the same or essentially the same invention as that claimed in the application.

(b) If the declaration referred to in sub-paragraph (vii) of paragraph (a) of subsection (1) of this section is found to be false, the Court may declare the patent to be null and void on an application made to it by any interested party or a Competent Authority including the Director-General. The registered owner of the patent, assignees and licensees shall be made party to that application.

(c) 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.

(d) 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.

(c) The Director-General 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 relevant technology 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 any claim shall determine the scope and extent of the protection afforded by the patent, and the description and drawings may be used to interpret such claim.

(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.

(8) Any application filed outside Sri Lanka under the Patent Corporation Treaty for a patent designating Sri Lanka shall if the applicant files a corresponding application with the Director-General be deemed to be an application made under this Act.

For the purposes of this Chapter “the Patent Corporation Treaty” means the Patent Corporation Treaty made in Washington on June 19th 1970, as amended from time to time.

72. An application for the grant of a patent shall not be entertained unless prescribed fee has been paid to the Director-General.

Application fee.

73. (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 a search which shall conform such type as may be prescribed :

Search report.

Provided, however, that in lieu of the said search an applicant may request the Director-General to refer the application to a local examiner who shall examine the application on the basis of any claim with due regard to the description and the drawings, if any, and furnish a report to the Director-General within the prescribed period, on the relevant prior art, after making the required effort to discover as much of the relevant prior art as facilities permit ; and for the purposes of the search the local examiner shall make reference to every documentation on prior art available to him.

(2) The applicant shall, when requiring the Director-General to refer his application to a local examiner, forward such application with the prescribed fee to Director-General.

(3) (a) The applicant shall, at the request of the Director-General, furnish him with the following documents in respect of any foreign application for a patent filed by him abroad relating to the same or essentially the same invention as that claimed in the application filed under this Act –

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application ;
- (ii) a copy of the patent granted on the basis of the foreign application ; and
- (iii) a copy of any final decision rejecting the foreign application or refusing the grant of a patent requested in the foreign application.

(b) The applicant shall, at the request of the Director-General, furnish him with a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in paragraph (a).

(4) For this purposes of the section “local examiner” means any skilled person to whom the Director-General may refer questions concerning patents.

Unity of
invention.

74. An application shall relate to one invention only or to a group of inventions which are so linked to each other so as to form a single general inventive concept.

Amendment
and division
of application.

75. (1) An applicant may amend the application, provided that the amendment shall not exceed the limits of the disclosure in the initial application.

(2) (a) An applicant may divide the application into two or more applications (hereinafter referred to as “divisional applications”) provided that each divisional application shall not exceed the limits of disclosure in the initial application.

(b) Each divisional application shall be entitled to the filing, or where applicable, priority, from date of the initial application.

(3) An amendment to an application or a division of an application shall be subject to the payment of a prescribed fee.

76. (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 Director-General may require the applicant to furnish, within the prescribed period, a copy of the earlier application, certified as correct by an officer authorized in that behalf, for that purpose 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 an office authorized in that behalf for that purpose by the International Bureau of the World Intellectual Property Organization.

(3) The effect of the declaration referred to in subsection (1) shall be the same as provided for in the Convention referred to therein.

(4) Where any of the requirements of this section or any regulation made thereunder have not been complied with, the declaration referred to in subsection (1) shall be deemed to be null and void.

77. (1) The Director-General shall record as the filing date, the date of receipt of the application :

Filing date.

Provided that on the date of the receipt of 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 his inventor, the statement referred to in paragraph (b) of subsection (2) of section 71 ;
- (c) a description of the patent;
- (d) a claim or claims :

Provided further that at the time of receipt of the application the prescribed fee has been paid.

(2) Where the Director-General finds, at the time of receipt of the application, that the provisions of subsection (1) have not been complied with, he shall request the applicant to file the required correction within a period of three months from the date of such request.

(3) Where the applicant complies with the request referred to in subsection (2), the Director-General shall record as the filing date, the date of receipt of the required correction ; where the applicant fails to so comply the Director-General 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 Director-General shall request the applicant to furnish the missing drawings.

(5) Where the applicant complies with the request referred to in subsection (4), the Director-General shall record as the filing date the date of receipt of the missing drawings ; where the applicant fails to so comply the Director-General shall record as the filing date, the date of receipt of the application and shall make no reference to the said drawings.

(6) The title, description, drawings, abstracts and claims filed with any international application made under subsection (8) of section 71, designating Sri Lanka shall be deemed to be carried out in accordance with specifications required under this Act.

(7) The filing date of such application made under subsection (8) of section 71 and processed by the office shall be deemed to be the date of filing of such application under the Patent Corporation Treaty.

78. (1) The Director-General shall examine the application and shall satisfy himself as to the fulfilment of the following :—

Examination of applications &c.

- (a) where applicable, the requirements of paragraph (b) of subsection (1) of section 71 ;
- (b) the requirements of paragraph (a) of subsection (2) of section 71 ;
- (c) where applicable, the requirements of paragraph (b) of subsection (2) of section 71 ;
- (d) the description, the claims and where applicable, the drawings, which comply with the prescribed requirements ;
- (e) the essential elements of the invention claimed in the application have not been unlawfully derived from a patent already granted in Sri Lanka ;
- (f) the application contains an abstract ;
- (g) the search report referred to in section 73 has been submitted.

(2) Where the Director-General finds that the conditions referred to in subsection (1) are not fulfilled he shall request the applicant to file the required correction within a period of three months from the date of such request ; where the applicant fails to so comply the application shall, subject to the provisions of subsection (3), be rejected.

(3) Where no correction is provided in response to a request under subsection (2), the Director-General shall, on payment of the prescribed fee within the prescribed period, include the corrections into the application and if the prescribed fee is not paid within the prescribed period the application shall be rejected.

(4) Where the Director-General finds that the essential elements of an invention claimed in an application are unlawfully derived from a patent already granted in Sri Lanka, such application shall be rejected.

(5) The Director-General shall notify the applicant of any decision under subsections (2), (3) and (4) and any decision taken to reject the application shall be in writing stating the reasons for such rejection.

Grant of patent.

79. (1) The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the commercial exploitation of the claimed invention is prohibited by any law except where the prevention of the commercial exploitation of the claimed invention is necessary in order to protect public order, and morality including the protection of human, animal or plant life or health or for the avoidance of serious prejudice to the environment.

(2) Where the applicant fulfils the requirements of subsection (1) of section 78 to the satisfaction of the Director-General, he shall grant the patent, and shall forthwith —

- (a) record the particulars relating to patent in the Register of patents required to be maintained in accordance with the provisions of section 80 ;
- (b) issue a certificate to the applicant in respect of the grant of a patent together with a copy of the patent documents including the search report :

Provided however where the applicant has not tendered an international search report, but has requested the Director-General to refer the application to a local examiner under the proviso to section 73, the Director-General shall 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 publication of the notice, unless otherwise directed by the Court.

(3) The Director-General shall thereafter as soon as practicable cause to be published in the Gazette a notice pertaining to the grant of the patent.

(4) The patent shall be deemed to be granted on the date that the Director-General acts in accordance with the provisions of paragraph (a) of subsection (2).

(5) The notice referred to in the proviso to subsection (2) shall contain the name and address of the applicant and where the applicant is resident outside Sri Lanka a postal address for service in Sri Lanka, a description of the invention and any other information as may be prescribed.

(6) The applicant shall make the payment of the prescribed fee for the publication referred to in the proviso to subsection (2) upon the request of the Director-General, and where the applicant fails to satisfy such request within one month from the date of such request the Director-General shall refuse to grant such patent.

80. The Director-General shall keep and maintain a register (hereinafter called and referred to as 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 date 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 authorised or directed by this Part to be so recorded or may from time to time be prescribed.

Register of
Patents.

81. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

Examination of
register and
certified copies.

Inspection of
files.

82. (1) Any person may, after the grant of a patent, inspect, subject to subsections (2) and (3), the file relating to any patent 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 Director-General 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, when 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.

(3) Where the provisions of the proviso to subsection (2) of section 79 are applicable, the reference to the grant of a patent in subsections (1) and (2) of this section shall be deemed to be a reference to the publication of the notice referred to in the said proviso.

(4) No person employed in or at the Office may make a patent application or be granted a patent or acquire or hold in any manner whatsoever any right relating to a patent during the period of his employment in or at the office and for one year after the termination of such employment.

CHAPTER XIV

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 application for its registration. 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 prior to 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 further 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

84. (1) Subject and without prejudice to the other provisions of this Part, the owner of a patent shall have the following exclusive rights in relation to a patented invention:— Rights of owner of patent.

- (a) to exploit the patented 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 :—

- (a) when the patent has been granted in respect of a product—
 - (i) making, importing, offering for sale, selling, exporting or using the product ;
 - (ii) stocking such product for the purpose of offering for sale, selling, exporting or using ;
- (b) when the patent has been granted in respect of a process—
 - (i) using of 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 ;
 - (iii) preventing any person using that process or using, selling or importing any product obtained directly by means of that process unless such person is authorized to do so.

Burden of proof to be on the alleged infringer.

85. (1) Where the subject matter of a patent is a process for obtaining a product, the burden of proof in a civil action of establishing that an alleged infringing product was not obtained by that patented process shall be on the alleged infringer—

- (a) if the product obtained by the patented process is new ; or
- (b) if a substantial likelihood exists that the product was made by the patented process and the patent owner has been unable through reasonable efforts to determine the process actually used.

(2) In the gathering and evaluation of evidence, the legitimate interests of the alleged infringer in protecting his undisclosed information shall be taken into account.

86. (1) The provisions of section 84 shall—

Limitation of
owner's rights.

- (i) extend only to acts done for industrial or commercial purposes and in particular shall not extend to acts done only for the purpose of scientific research ;
- (ii) not preclude a person having the rights referred to in section 87 or a licensee, from exploiting the patented invention ;
- (iii) 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 ;
- (iv) not extend to acts in respect of articles which have been put in the market by the owner of the patent or by a manufacturer under licence.

(2) (a) Any person, body of persons, a government department or a statutory body may make an application to the Director General for the purpose of obtaining a licence to exploit a patent in the manner hereafter provided.

(b) Upon the receipt of such application, the Director General may issue a licence for exploitation if he is satisfied that the applicant has made efforts to obtain approval from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time.

(c) Director-General may waive the requirements set out in paragraph (b) where he has satisfied himself of the existence of a national emergency or any other circumstances of extreme urgency or in case of public non-commercial use

for the purposes such as national security, nutrition, health or for the development of others vital section of the national economy.

(d) The exploitation of the patent shall be limited in scope and duration to the purpose as is specified in the licence. Such exploitation shall be predominantly for the purpose of supply to the domestic market.

(e) The Director-General shall consider each application on its individual merits before granting a licence to exploit a patent.

(f) The issuance of a licence shall be non-exclusive and subject to the payment of adequate remuneration to the owner of the patent taking into consideration the economic value as determined by the Director-General, and where applicable, the need to correct anti-competitive practices.

(g) Where such application is for the exploitation of the patent (the second patent) which cannot be exploited without infringing another patent (the first patent), the following conditions shall apply :

- (i) the invention claimed in the second patent shall involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent ;
- (ii) the owner of the first patent shall be entitled to a cross licence on reasonable terms to exploit the invention claimed in the second patent ; and
- (iii) the exploitation authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.

(h) The decision of the Director-General, shall be notified in writing to the owner of the patent as soon as practicable.

(i) The Director-General, shall upon, the request of the owner or of the beneficiary of the licence, after hearing the parties, vary his decision by amending the terms subject to which licence for the exploitation of the patent is issued to the extent only that the changed circumstances justify such variation.

(j) The Director-General shall upon the request of the owner, terminate the non-voluntary license if he is satisfied that the circumstances which led to his decision have ceased to exist and are unlikely to recur or that the license has failed to comply with terms of such licence.

(k) Notwithstanding anything contained in paragraph, (j) the Director-General shall not terminate a licence, if he is satisfied that adequate protection of the legitimate interest of the beneficiary of the licence justifies the continuity of such licence.

(l) The licence to exploit a patent may be transferred only with the enterprise or the business of the licensee of such patent or with the part of such enterprise or business, in relation to which the licence to exploit has been granted.

(m) Where a judicial or administrative body has determined that the manner of exploitation of a patent by its owner or its licensee is anti-competitive, and the Director-General is satisfied that the exploitation of a patent in accordance with this section would remedy such practice, the Director-General may authorize any person, body of persons, government departments or statutory body to exploit the patent without a licence of the owner of the patent. The provisions of the above paragraphs except those of paragraphs (b), (c) and (g) shall be applicable to such licence.

(3) Any person aggrieved by any decision of the Director-General under subsection (2), may tender an appeal therefrom. The provisions of section 173 shall, *mutatis mutandis*, apply in respect of such appeal.

Rights derived from prior manufacture or use.

87. (1) Where a person at the filing date or, where applicable, the priority date, of the patent application—

- (a) was in good faith making the product or using the process in Sri Lanka which is the subject of the invention claimed in such application ;
- (b) had in good faith made serious preparations in Sri Lanka towards 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 :

Provided further, if the invention was disclosed under circumstances referred to in paragraph (a) or (b) of subsection (3) of section 64, he may prove, that his knowledge of the invention was not as 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.

(3) The provisions of this section shall not affect the rights of any person to object to the grant of a patent on the ground that such invention is not patentable under sections 63, 64, 65 and 66 of the Act, or to seek relief under sections 68 and 99 of the Act.

CHAPTER XVI

ASSIGNMENT AND TRANSMISSION OF PATENT APPLICATIONS AND PATENTS

Assignment and transmission of patent applications and patents.

88. (1) A patent application or patent may be assigned or transmitted and such assignment or transmission shall be in writing signed by or on behalf of the contracting parties.

(2) Any person becoming entitled by assignment or transmission to a patent application or patent may apply to the Director-General 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 the prescribed fee has been paid to the Director-General.

(4) No such assignment or transmission shall have effect against third parties unless so recorded in the register.

89. 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.

CHAPTER XVII

LICENCE CONTRACTS

90. For the purposes of this Part licence contract means any contract by which the owner of a patent (hereinafter referred to as “the licensor”) grants to another person or enterprise (hereinafter referred to as the “the licensee”) a licence to do all or any of the acts referred to in paragraph (a) of subsection (1) and subsection (3) of section 84.

Interpretation.

91. (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 Director-General 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 so 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.

92. In the absence of any provision to the contrary in the licence contract, the licensee shall—

- (a) be entitled to do all or any of the acts referred to in paragraph (a) of subsection (1) and subsection (3) of section 84 within the territory of Sri Lanka, without limitation as to time and through 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.

Rights of the licensor.

93. (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 perform all or any of the acts referred to in paragraph (a) of subsection (1) and subsection (3) of section 84.

(2) Where the licence contract provides the licence to be 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 perform all or any of the acts referred to in paragraph (a) of subsection (1) and subsection (3) of section 84.

Invalid clauses in licence contracts.

94. Any term 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 :

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