

made or produced in that place or country, the provisions of this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

Savings.

200. (1) The Provisions of this Part shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Part, be brought against him.

(2) Nothing in this Part shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence under this Part.

(3) Nothing in this Part shall be construed so as to make any servant of a master resident in Sri Lanka liable to a suit or prosecution due to disclosure of information regarding the servant of a master, when required by or on behalf of the prosecutor who, *bona fide*, acts in compliance with the instructions of such master.

Cognizable and
bailable offences.

201. All offences under this Part shall be cognizable and bailable, within the meaning of the Code of Criminal Procedure Act, No. 15 of 1979. The provisions of the Code of Criminal Procedure Act shall apply to any offence committed under this Part.

Limitation of
prosecution.

202. No prosecution for an offence under this Act shall be commenced after the expiration of three years after the commission of the offence charged or two years after the discovery thereof by the prosecutor, whichever expiration first occurs.

203. On the sale, or in the contract for the sale, of any goods to which a Mark, or trade description has been applied, the vendor shall be deemed to warrant that the Mark is a genuine Mark, and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Part, unless the contrary is expressed in writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to, and accepted by, the vendee.

Implied warranty on sale of marked goods.

CHAPTER XXXIX

REGULATIONS

204. (1) The Minister may from time to time make regulations for the purpose of carrying out or giving effect to the principles and provisions of this Act and in particular in respect of any matter required under this Act to be prescribed.

Regulations.

(2) Without prejudice to the generality of the powers conferred by subsection (1) the Minister may make regulations in respect of any or all of the following matters :—

- (a) the procedure of registration ;
- (b) the classification of goods and services for the purposes of registration ;
- (c) the fees payable in respect of registration and other matters ;
- (d) the forms to be used for any purpose under the Act ;
- (e) the setting up of organizations to administer rights specified in Part II on behalf of the owners of such rights and the conditions under which such organizations are required to work ;
- (f) the admission, registration, cancellation, removal and any other matter relating to agents specified in Chapter XXXVI of the Act ;
- (g) The manner of the administration of the Patent Co-operation Treaty in Sri Lanka ;

- (h) all matters which under this Act have been placed under the direction or control of the Director-General.

(3) Every regulation made by the Minister shall be published in the Gazette and shall come into operation on the date of such publication or on such later date as may be specified therein.

(4) Every regulation made by the Minister shall as soon as convenient after its publication in the Gazette be brought before the Parliament for approval. Any such regulation which is not so approved shall be deemed to be rescinded as from the date of its disapproval, but without prejudice to anything previously done thereunder.

(5) Notification of the date on which any regulation made by the Minister is so deemed to be rescinded shall be published in the Gazette.

CHAPTER XL

AMENDMENT OF HIGH COURT OF THE PROVINCES (SPECIAL PROVISIONS) ACT, No. 10 OF 1996

Amendment of
Act No. 10 of
1996.

205. High Court of the Provinces (Special Provisions) Act, No. 10 of 1996 is hereby amended as follows :—

- (1) by the repeal of item 3 of the First Schedule to that Act and substitution thereof of the following :—

“All proceedings required to be taken under the Intellectual Property Act, No. 36 of 2003 in the High Court established under Article 154 P of the Constitution”.

- (2) by the repeal of item 2 of the Second Schedule to the Act.

CHAPTER XLI

AMENDMENT OF THE CUSTOMS ORDINANCE

206. Section 101 of the Customs Ordinance (Chapter 235) is hereby amended by the insertion immediately after paragraph (e) of that section of the following new paragraph :—

Amendment of
section 101 of the
Customs
Ordinance.
(Chapter 235)

“(ee) for prohibiting of importation and exportation of counterfeit trade mark goods or pirated copyright goods or any other goods in contravention of the provisions of the Intellectual Property Act, No. 36 of 2003”.

207. The Customs Ordinance hereinafter referred to as “the Ordinance ”is hereby amended in Part XIII of that Ordinance by the insertion immediately after section 125 thereof of the following new sections :—

Insertion of new
sections in the
Customs
Ordinance.

“Inclusion of
prohibited
goods in
Schedule B of
Customs
Ordinance.

125A. (1) The importation of counterfeit trade mark goods or pirated copyright goods or any other goods in contravention of the provisions of the Intellectual Property Act, No. 36 of 2003 (hereinafter referred to as the “Act”) shall be prohibited and such goods shall be included among the goods the importation of which, are prohibited under section 43 of the Ordinance and included in Schedule B of the Ordinance as prohibited goods.

(2) The exportation of the goods referred to in subsection (1) of this section shall be prohibited and such goods shall be included among the goods the exportation of which, are prohibited as if they were referred to in section 44 of the Ordinance and included in Schedule B of the Ordinance as prohibited goods.

(3) Notwithstanding anything to the contrary in any other law, prohibited goods referred to in subsections (1) and (2) of this section, shall be disposed of outside the channels of commerce

or if such disposal damages the interests of the owner of any right protected under the Act, be destroyed.

(4) “Counterfeit trade mark goods” mean any goods including packaging, bearing without authorization a trade mark which is identical to a trade mark validly registered in respect of such goods or which cannot be distinguished in its essential aspects from such a trade mark, and which thereby infringes the rights of the owner of the trade mark recognised by the Act.

(5) “Pirated copyright goods” mean any goods which are made without the consent of the copyright holder or person duly authorised by the copyright holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right by the Act.

Suspension of
certain goods
by Customs
Authorities.

125B. (1) A right holder, who has valid grounds to believe that the importation of counterfeit trade mark or pirated copyright goods or of any other goods in contravention of the right holder’s rights under the Act is taking place, may make an application in writing to the Director-General, of customs requiring him to suspend of the release of such goods into free circulation.

(2) A right holder who makes an application under subsection (1) shall provide adequate evidence to satisfy the Director-General of Customs that there is a, *prima facie*, case of infringement of the right holder’s rights under the Act and supply a sufficiently detailed description of the goods to make them readily recognisable by any officer of the Customs.

(3) (a) The Director-General of customs shall have the power to require an applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent any abuse ;

(b) Where pursuant to an application made under subsection (1), the Director-General of customs suspends the release of any goods into free circulation, he shall forthwith cause the importer and the applicant to be promptly notified the the suspension.

(4) If the Director-General of customs fails to receive any notice regarding the institution of proceedings in respect of the of release of any goods suspended under subsection (3), within a period not exceeding ten working days after the applicant has been informed of the suspension as provided for in subsection (3), he shall cause the goods to be released, provided all other conditions for importation or exportation have been complied with.

(5) Where pursuant to an application made under subsection (1), the Director-General of customs has suspended the release of any goods into free circulation and the period referred to in subsection (4) has expired without the granting of any provisional relief by a Court, and provided that all other conditions for importation have been complied with, the owner, importer or consignee of such goods shall be entitled to have such goods released.

(6) Notwithstanding anything contained in the preceding provisions of this section, where the suspension of the release of any goods is carried out or continued in accordance with an

order of court, the provisions of subsection 4 of section 170 of Intellectual Property Act, No. 36 of 2003, shall apply.

(7) The court shall have the power to order the applicant to pay the importer, the consignee and the owner of the goods, appropriate compensation for any harm caused to them through the wrongful detention of goods or through the detention of goods released pursuant to the preceding provisions of this section.

(8) Without prejudice to the protection of confidential information, the Court shall have power to give the right holder sufficient opportunity to have any goods detained by the customs authorities inspected in order to substantiate the right holder's claims. The Court shall in addition have power to give the importer an equivalent opportunity to have any such goods inspected.

(9) Without prejudice to other rights of action open to the right holder and the defendant, the Court shall have the power to order the destruction or disposal of any infringing goods in accordance with the principals set out in section 170 of Intellectual Property Act, No. 36 of 2003. In regard to counterfeit trade mark goods, the Court shall not other than in exceptional circumstances allow the re-exportation of the infringing goods in an unrelated state or subject them to a different customs procedure.

(10) The provisions of sections 125A and 125B shall not apply to small quantities of goods of a non-commercial nature contained in a traveller's personal luggage or forwarded in small consignments.

(11) In this section, the expressions “counterfeit trade mark goods” and “pirated copyright goods” shall have the same meanings as are assigned to them in section 125A.”.

CHAPTER XLII

REPEALS AND SAVINGS

208. (1) The Code of Intellectual Property Act, No. 52 of 1979 (hereinafter referred to as the “Code”) is hereby repealed. Repeals and savings.

(2) Notwithstanding the repeal of the Code the National Intellectual Property Office of Sri Lanka established under the Code, and the officials appointed under the Code shall continue and shall be deemed to have been established and appointed respectively under this Act.

(3) Notwithstanding the repeal of the Code every regulation made thereunder as in force on the date of commencement of this Act, in so far as such regulation is not inconsistent, with the provisions of this Act shall be deemed to be made under this Act, and such regulations may be amended, rescinded or altered by regulations made under this Act.

(4) Notwithstanding the repeal of the Code—

- (a) Every application for registration of an Industrial Design, Patent or Mark made to the Director-General under the provision of the code and pending on the date immediately preceeding the date of commencement of this Act, shall be deemed to be an application made to the Director-General under Part III, IV or V respectively of this Act, and shall be dealt with in accordance with the provisions of this Act ;

- (b) any right specified in Part II of this Act, which was granted on the date of coming into operation of the repealed Code shall for all purposes except for the purpose of imposing punishment, continue to be valid and effectual as if herein granted provided that the term of protection previously granted has not expired under the Code or under the laws of the country of origin of such work, performance, sound recording or broadcast that are to be protected under any international treaty to which Sri Lanka is a party ;
- (c) every action, proceeding or other matter relating to Copyright, Industrial Desingns, Patents, Marks and unfair competition pending on the day immediately preceeding the date of the commencement of this Act, shall be deemed to have been instituted under the provision of this Act and shall be continued and proceeded with under the provisions of this Act ;
- (d) nothing in Part III, IV, V or VI of this Act shall affect any order or requirement made, table of fees or certificates issued, notice, decision, determination, direction or approval given, application made, or thing done, under the Code, and every such order, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force on the date immediately preceding the date of commencement of this Act, shall be deemed to have been made under the provisions of this Act and shall continue in force and shall, so far as it could have been made, issued, given or done under this Act have effect as if made, issued, given or done under the corresponding provisions of this Act ;
- (e) all contracts, leases and agreements subsisting on the day immediately preceding the date of commencement of this Act shall be deemed for all purposes to be contracts, leases or agreements made or entered into by or with or for the office, under the provisions of this Act.

- (f) all interests, rights, obligations, debts and liabilities of the office subsisting on the day immediately preceding the date of commencement of this Act, shall be deemed to be the interest, rights, obligations, debts and to liabilities of the office, under the provisions of this Act.

209. The validity of the original entry of a Design on the register of Designs existing on the day immediately preceeding the date of commencement of this Act or any register of Designs which was kept under any previous law and was incorporated with and declared to form Part of the Register of Designs, shall be deemed to have been registered under Part III of this Act. Every such Design shall however retain its original date.

Saving of
Designs.

210. The validity of the original entry of a Patent on the register of Patents existing on the day immediately preceeding the date of commencement of this Act or any Register of Patents which was kept under the previous laws and was incorporated with and declared to form Part of the Register of Patent shall be deemed to have been registered under Part IV of this Act. Every such Patent shall however retain its Original date.

Savings of
Patents.

211. (a) The validity of the original entry of a Mark on the Register of Marks existing on the day immediately preceeding the date of commencement of this Act or any register of Marks which was kept under any previous law and was incorprated with and declared to form Part of the Register of Marks shall be deemed to have been registered under Part V of this Act. Every such Mark shall however retain its original date.

Savings of Marks.

(b) No mark which was on the Register on the day immediately after the date of commencement of the Code and which under the Code was then a registrable mark shall be removed from the Register on the ground that it was not registrable under the law in force at the date of its registration.

(c) No mark which was on the Register on the day immediately preceeding the date of commencement of the Act and which under Part V is a registrable mark shall be removed from the register on the ground that it was not registrable, under the law in force at the date of its registration.

(d) Nothing in Part V shall—

(i) invalidate the original registration of a mark which had validity on the register immediately before the date of commencement of this Act ; or

(ii) subject any person to any liability in respect to any act or thing done before the date of commencement of this Act, to which he would not have been subject under the law in force at the time such act or thing was done.

CHAPTER XLIII

INTERPRETATION

Interpretation.

212. In this Act unless the context otherwise requires—

“Central Bank of Sri Lanka” means the Central Bank of Sri Lanka established under the Monetary Law Act (Chapter 422) ;

“convention country” means any country that has acceded to or ratified or that may hereafter accede to or ratify the Paris Convention for the protection of Industrial Property, as well as all members of the World Trade Organisation or States that may here after become members of the World Trade Organisation, and includes any country which has

entered into or which may hereafter enter into any treaty, convention or arrangement with Sri Lanka creating reciprocal rights and obligations between such country and Sri Lanka in regard to Industrial Designs, Patents and Marks and any other matter provided for by the Act and the registration thereof ;

“convention” means the Paris Convention for the protection of Industrial Property, World Trade Organisation or any other international or regional convention, treaty or arrangement to which Sri Lanka is party creating reciprocal rights and obligations between such country and Sri Lanka in regard to Industrial Designs, Patents. Marks and any other matter provided for by the Act and the registration thereof ;

“Court” means a High Court established under Article 154P of the Constitution for a Province empowered with civil jurisdiction by Order published in the Gazette under section 2 of the High Court of Provinces (Special Provisions) Act, No. 10 of 1996 when the party or parties defendant to such action resides or reside or the cause of action has arisen or the contract sought to be enforced was made within the Province for which such High Court is established, or where no such High Court is established for any Province or vested with such civil jurisdiction the High Court established for the Western Province ;

“Transgenic” means an organism that expresses a characteristic not attainable normally by the species under natural circumstances, but which has been added by means of direct human intervention in its genetic composition.”.

213. In the event of any inconsistency between the Sinhala and Tamil texts of this Act, the Sinhala text shall prevail.

Sinhala text to prevail in case of inconsistency.

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