

**PARLIAMENT OF THE DEMOCRATIC SOCIALIST REPUBLIC OF**   
**SRI LANKA**

*————————*

**INTELLECTUAL PROPERTY (AMENDMENT)**

**A**

**BILL**

**to amend the Intellectual Property Act, No. 36 of 2003**

*————————*

*Presented by the Minister of Trade on 23rd of February, 2022*

(Published in the Gazette on February 10, 2022)

*Ordered by Parliament to be printed*

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**[Bill No. 108]**

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*STATEMENT OF LEGAL EFFECT*

This Bill amends the Intellectual Property Act, No. 36 of 2003 to introduce a“Geographical Indications Registration System” to provide for the registration and administration of geographical indications and matters relating thereto.

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| *Intellectual Property (Amendment)* | 1 |

L.D.–O. 8/2020   
 AN ACTTOAMENDTHE INTELLECTUAL PROPERTY

ACT, NO. 36 OF 2003   
BE it enacted by the Parliament of the Democratic Socialist Republic of Sri Lanka as follows:-

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| 5 | **1.**  This Act may be cited as the Intellectual Property  (Amendment) Act, No. of 2022. | Short title |
| **2.**  Section 2 of the Intellectual Property Act, No.36 of  2003 (hereinafter referred to as the “principal enactment”) is | Amendment of section 2 of Act,  No.36 of  2003 |
| hereby amended in paragraph (*a*) of subsection (2), by the |
| substitution for the words “administration of Industrial |
| Designs, Patents, Marks and of any other matter” of the words |
| 10 | “administration of Industrial Designs, Patents, Marks, | Amendment of section 4 of the  principal  enactment |
| Geographical Indications and of any other matter”. |
| **3.**  Section 4 of the principal enactment is hereby  amended as follows:- |
| 15 | (1) in subsection (1), by the substitution for the words |
| “Industrial designs, patents, marks and any other |
| matter” of the words “Industrial designs, patents, | Amendment of section  101 of the  principal  enactment |
| marks, geographical indications and any other |
| matter”; |
| 20 |
| (2) in subsection (2), by the substitution for the words |
| “industrial designs, patents, marks and any other |
| matter” of the words “industrial designs, patents, |
| marks, geographical indications and any other |
| matter”; |
| **4.**  Section 101 of the principal enactment is hereby  amended by the repeal of the definition of the phrase |
| 25 |
| “geographical indication”. |

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| 5 | 2 | *Intellectual Property (Amendment)* | Amendment of section  160 of the  principal  enactment |
| **5.**  Section 160 of the principal enactment is hereby  amended as follows:- | |
| (1) in paragraph (*b*) of subsection (1), by the substitution for the words “protecting inventions, industrial designs, marks, trade names,” of the words“protecting inventions, industrial designs, marks, trade names, geographical indications,”; | |
| 10 | (2) by the repeal of subparagraph (iv) of paragraph (*b*) of subsection (4) and the substitution therefor of the following:- | |

“(iv) the geographical indication of any goods   
including production process of products   
or goods or services;”.

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| 15 | **6.**  The following new section is hereby inserted immediately after the heading “GEOGRAPHICAL INDICATIONS” in PART IX of the principal enactment and shall have effect as section 160A of that enactment:- | | Insertion of  new section  160A in the  principal  enactment |
| 20 | “Definitions | 160A. For the purposes of this Part, unless the context otherwise requires– |
| “authorized user” means a user of a geographical indication registered under this Part of this Act; | |
| 25 | “control plan” means the method as to how the verification of compliance with product specification is carried out; | |
| 30 | “geographical indication” means an indication which identifies any goods as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin; | |

*Intellectual Property (Amendment)*  3

“goods” means any manufactured or naturally   
available agricultural products, food,   
wines, spirits or any item of handicraft or   
industry;

|  |  |
| --- | --- |
| 5  10 | “producer” in relation to goods, means any person who–  (*a*) if such goods are agricultural products, wine or spirit, produces such goods or processes or packages such goods; |

(*b*) if such goods are natural goods,   
 exploits such goods; or

|  |  |  |  |
| --- | --- | --- | --- |
| 15 | (*c*) if such goods are handicrafts or | | Amendment |
| industrial goods, makes or | |
| manufactures such goods; and | |
| 20 | “specification” means a document to be | |
| submitted with the application for | |
| registration of a geographical indication | |
| which provides technical details of the | |
| characteristics of the goods or products, | |
| the method of production, the | |
| 25 | geographical area and the link between | |
| the characteristics, quality or reputation | |
| of the goods or product and its | |
| geographical origin.”. | |
| **7.** | Section 161 of the principal enactment is hereby |
| amended by the repeal of subsections (4A) and (5) thereof. | | of section |
| 161 of the |
| principal |
| enactment |

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| 5 | 4 | *Intellectual Property (Amendment)* | Insertion of |
| **8.** The following new sections are hereby inserted immediately after section 161 of the principal enactment | |
| new sections |
| 161A, 161B, |
| and shall have effect as section 161A, 161B, 161C, 161D and | |
| 161c, 161D |
| 161E of that enactment:- | |
| and 161E in |
| “Admissibility of  geographical indications  for  registration | 161A. Where, any geographical indication–  (*a*) that does not comply with the definition of geographical indication as specified in section 160A; | the principal enactment |
| 10 | (*b*) the use of which is contrary to law, | |
| morality, religion, accepted customs | |
| 15 | or public order; | |
| (*c*) that is not or that ceases to be | |
| protected in the country of origin as | |
| a geographical indication, or which | |
| has fallen into disuse in such country; | |

(*d*) that is identical with the term   
customary in common language as   
the common name of the relevant   
good;

|  |  |
| --- | --- |
| 20  25 | (*e*) that misleads or deceives the public as to the characteristics, nature, quality, place of origin and production process of the good or its use; or  (*f*) which constitutes the name of a plant variety or an animal breed, |

shall not be registered under this Act.

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| 30 | Application | 161B. (1) Any association of persons or |
| to register |
| producers or any organization or authority established by any law for the time being |
| geographical |
| indications |

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| --- | --- | --- |
| 5  10  15  20  25  30  35 | *Intellectual Property (Amendment)* | 5 |
| representing the interests of the producers of any relevant good (hereinafter referred to as the “applicant”) may make an application to the Director-General for the registration of such good as a geographical indication in such manner and form and accompanied by such documents and processing fee as shall be prescribed.  (2) Upon receipt of an application, the Director-General shall examine such application in the manner as shall be prescribed .  (3) Where the geographical indication intended to be registered is not admissible for registration in terms of section 161A, the Director-General shall refuse to register such geographical indication and the reasons therefore shall be informed to the applicant:  Provided that, where there is any defect in any application submitted to the Director-General under this section, the Director-General shall within three months from the date of application, notify that to the applicant and shall afford the applicant an opportunity to rectify any such defect within three months from the date of such notification. The date on which the applicant resubmits the rectified application to the Director-General, shall be deemed to be the date of receipt of such application for registration.  (4) Any applicant whose application has been refused under subsection (3), may if not satisfied with the reasons specified by the Director-General for such refusal, make to the Director-General, within three months from the | |

6 *Intellectual Property (Amendment)*

date on which the refusal was informed to the

applicant, his submissions in writing against

the refusal.

|  |  |  |
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| 5 | Publication | (5) The Director-General may, upon receipt |
| of such submissions, if he considers a hearing |
| is necessary, inform the applicant of a date, |
| 10 | time and place for the hearing of the matter |
| relating to such submissions. |
| (6) The Director-General may, after such |
| hearingrefuse to register such application or |
| register the application as it is or subject to |
| such conditions, amendments or limitations as |
| 15 | to the mode or place of use of such geographical |
| indication as the Director-General may consider |
| appropriate. |
| 20 | (7) Where the Director-General refuses to |
| register any application or register an |
| application subject to any conditions as |
| specified in subsection (6), the Director- |
| General shall if the applicant requests so, |
| 25 | furnish the reasons for such refusal or |
| conditional acceptance for registration. |
| 161C. (1) Where the Director-General is of |
| of the |
| the opinion that the geographical indication |
| application |
| sought to be registered is admissible under |
| section 161A, he shall upon receipt of the fee |
| as shall be prescribed for the publication of the |
| 30 | application publish such application in the |
| *Gazette,* within a period of two months from |
| the date of receipt of such application by the |
| Director-General. Where the applicant fails to |
| pay such fee within such specified time period, |

*Intellectual Property (Amendment)*  7

the Director-General shall refuse to register the   
geographical indication.

|  |  |
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| 5 | (2) The Director-General shall when publishing the application under subsection (1) set out the following:- |

(*a*) the name and address of the applicant;

(*b*) the date of application;

(*c*) the representation of the geographical   
 indication;

|  |  |
| --- | --- |
| 10 | (*d*) the goods for which the geographical indication sought to be registered; |

(*e*) the summary of the specification and   
the map of the geographical area; and

|  |  |  |
| --- | --- | --- |
| 15 | Opposition | (*f*) if the applicant is resident outside |
| Sri Lanka, a postal address for service |
| in Sri Lanka. |
| 20 | 161D. (1) Where any person considers the |
| to |
| geographical indication published under |
| registration |
| section 161C is inadmissible in terms of section |
| 161A, such person may within a period of three |
| months from the date of such publication send |

notice of opposition to the registration of the   
geographical indication so published, by post   
or by hand delivery to the Director-General in

|  |  |
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| 25 | the prescribed form together with the prescribed fee. The person who gives the notice of |

opposition shall also specify the grounds on   
which such notice of opposition is made and

8 *Intellectual Property (Amendment)*

shall submit necessary information and

evidence to substantiate such grounds.

|  |  |  |  |  |
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| 5  10  15  20  25  30 | (2) If any notice of opposition has not been received by the Director-General within the period as specified in subsection (1), the | | | |
| Director-General | shall | register | the |
| geographical indication sought to be registered under section 161B.  (3) Where any notice of opposition has been received by the Director-General in the prescribed form together with the prescribed fee and accompanied by the evidence or information to substantiate the grounds specified in such notice, within one month from the date of such notice, the Director-General shall serve a copy of such notice on the applicant and require him to make his observations on such grounds accompanied by evidence or information to support his application within three months from the date of receipt of such notice.  (4) Upon receipt of the observation of the applicant, the Director-General shall after hearing the parties if he considers such hearing necessary, decide as expeditious as possible whether such geographical indication shall be registered or not. If the Director-General decides that it shall be registered, then the Director-General shall –  (*a*) where no appeal is preferred under section 173 against his decision, upon the expiry of the period within which an | | | |

*Intellectual Property (Amendment)*  9

appeal may be preferred against his

decision; or

(*b*) where an appeal is preferred under

section 173 against his decision, upon

5 the dismissal of such appeal,

as the case may be, register such geographical   
indication subject to any conditions,   
requirements or to such amendments or   
modifications.

|  |  |  |
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| 10 | Renewal of | 161E. (1) The registration of any |
| registration | geographical indication, unless it is cancelled earlier shall be valid for ten years from the date of application. |
| 15 | of |
| geographical |
| indications |
| (2) The registration of any geographical |
| indication may be renewed by the owner of |
| such geographical indication for consecutive |
| 20 | periods of ten years each on making an |
| application together with the prescribed fee |
| for such renewal to the Director-General within |
| six months prior to its expiration: |
| 25 | Provided that, the Director-General may |
| afford to the applicant a grace period of six |
| months after the date of such expiration to |
| renew the registration upon payment of a |
| surcharge as shall be prescribed. |

(3) Renewal of registration shall not be   
subject to any further examination of the   
geographical indication by the Director-  
General or to opposition by any person.

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| 30 | (4) The Director-General shall record in the register of the renewal of such geographical |

10 *Intellectual Property (Amendment)*

indication and cause it to be published in the   
*Gazette.*

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| --- | --- | --- | --- | --- | --- |
| 5 | (5) Where an application has not been sent | | | | Insertion of |
| for renewal along with the renewal fee by the | | | |
| applicant as specified in subsection (2), the | | | |
| Director-General | shall | remove | the |
| 10 | geographical indication from the register of | | | |
| geographical indications.”. | | | |
| **9.** The following new Chapters are hereby inserted immediately after section 161E in the principal enactment | | | |
| new Chapters |
| XXXIIIA, |
| and shall have effect as Chapters XXXIIIA, XXXIIIB, | | | |
| XXXIIIB, |
| XXXIIIC, XXXIIID and XXXIIIE of that enactment:- | | | |
| XXXIIIC, |
| XXXIIID |
| and XXXIIIE |
| in the |
| principal |
| enactment |

“CHAPTER XXXIIIA

|  |  |  |
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| 15 | Issue of | ISSUEOFCERTIFICATEOFREGISTARTIONANDTHE |
| REGISTEROFGEOGRAPHICALINDICATION |
| 161F. If any application has duly been |
| certificate of | registered by the Director-General under this |
| registration |
| Part, he shall upon receipt of the prescribed fee |

for the certificate, issue a certificate of 20 registration to the applicant who shall be the owner of the geographical indication (hereinafter referred to as the “registered owner”) in the prescribed form.

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| 25 | Register of  Geographical Indication | 161G. (1) The Director-General shall keep |
| and maintain a register in the Office called the |
| “Register of Geographical Indications” in |

which all registered geographical indications

*Intellectual Property (Amendment)*  11

shall be recorded in the order of their   
registration.

(2) The following particulars shall be included in the Register of Geographical 5 Indications:-  
 (*a*) the geographical indication;   
 (*b*) number of registration;   
 (*c*) the name and address of the registered owner and if the registered owner is 10 outside Sri Lanka, a postal address for service in Sri Lanka;   
 (*d*) the date of application and registration; (*e*) the list of goods in respect of which the registration of geographical indication 15 has been granted;   
 (*f*) the summary of the specification; (*g*) the map of the geographical area; and (*h*) specifications and associated control plan.

|  |  |
| --- | --- |
| 20 | (3) Any person may examine the register of geographical indications and obtain certified |

extracts thereof on payment of the prescribed   
fee.

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CHAPTER XXXIIIB

RIGHTSOFAREGISTEREDOWNERAND   
ADMINISTRATIONOFREGISTEROFGEOGRAPHICAL   
INDICATIONS

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| 5 | Rights of a | 161H. The registered owner of a | | | |
| registered | geographical indication shall be entitled to | | | |
| 10 | owner |
| prevent - | | | |
| (a) in respect of goods of the same kind as | | | |
| those to which the geographical | | | |
| indication applies – | | | |
| 15 | (i) any direct or indirect use , misuse, | | | |
| imitation or evocation of a | | | |
| geographical | | indication | |
| identifying goods including an | | | |
| agricultural product, food, wine or | | | |
| 20 | sprit or handicraft manufactured and | | | |
| natural goods not originating in the | | | |
| place indicated by the geographical | | | |
| indication in question or not | | | |
| complying | with | any | other |
| 25 | applicable requirement for using the | | | |
| geographical indication, even | | | |
| where the true origin of the goods is | | | |
| indicated or the geographical | | | |
| indication is used in translated form | | | |
| 30 | or accompanied by expression | | | |
| “style”, “kind”, “type”, “make”, | | | |
| “imitation”, | “method”, | | “as |
| produced in”, “like”, “similar” or | | | |
| such similar expression; or | | | |

(ii) any direct or indirect use, misuse,   
imitation or evocation of a

*Intellectual Property (Amendment)*  13

geographical indication which   
constitutes an act of unfair   
competition within the meaning of   
section 160 of the Act; or

|  |  |
| --- | --- |
| 5  10 | (iii) any other practice likely to mislead consumers as to the true origin, provenance or nature of the goods including an agricultural product, food, wine or sprit or handicraft manufactured and natural goods; |

(*b*) for goods that are not of the same kind as   
those to which the geographical   
indication applies –

|  |  |
| --- | --- |
| 15  20  25  30  35 | (i) any direct use, misuse, imitation or evocation of the geographical indication in respect of goods that are not of the same kind as those to which the geographical indication applies including an agricultural product, food, wine or sprit or handicraft manufactured, and natural goods in question, if such use would indicate or suggest a connection between those goods, and the users of the geographical indication and would be likely to damage their interests, or where applicable because of the reputation of the geographical indication such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of that reputation;  (ii) any direct use, misuse, imitation or evocation of the geographical indication in respect of goods that |

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| 5 | 14 | *Intellectual Property (Amendment)* |
| are not of the same kind as those to which the geographical indication applies including an agricultural product, food, wine or sprit or handicraft manufactured, and natural goods in   question amounting to its imitation, even if the true origin of the goods is indicated, or if the geographical indication is used in translated form or is accompanied by expression“style”, “kind”, “type”, “make”,“imitation”,   “method”, “as produced in”, “like”, “similar” or such similar expression; or |
| 10 |
| 15 |

(iii) any other practice likely to mislead   
consumers as to the true origin,   
provenance or nature of the goods.

|  |  |  |
| --- | --- | --- |
| 20 | Registered | 161I. Any geographical indication registered |
| geographical | under this Act shall not become generic which |
| indication |
| refers to the name that is generally known as |
| not to |
| the common designation of the good registered |
| become |
| as a geographical indication. |
| generic |

CHAPTER XXXIIIC

25 CANCELLATIONOFREGISTRATIONOFGEOGRAPHICAL

INDICATIONS

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| --- | --- | --- |
| 30 | Cancellation | 161J. The Director-General may cancel the |
| of | registration of any geographical indication in the case of – |
| registration |
| of |
| geographical | (*a*) any goods registered as geographical indications lose their special characteristic as geographical indication goods; |
| indications |

*Intellectual Property (Amendment)*  15

(*b*) the registered owner fails to comply with   
the conditions and requirements, if any,   
subject to which such geographical   
indication is registered;

|  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- |
| 5  10 | (*c*) the | registered | owner | of | such |
| geographical indication requests the Director-General in writing for cancellation of registration of such geographical indication; or  (*d*) the registered owner fails to renew the registration of a geographical indication as specified in section 161E. | | | | |

CHAPTER XXXIIID

FOREIGNGEOGRAPHICALINDICATIONS

|  |  |  |
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| 15 | Foreign | 161K. Any foreign geographical indication |
| 20 | geographical | may be registered in Sri Lanka as long as such geographical indication is protected in its country of origin as a geographical indication or a certification mark, as the case may be. The provisions relating to registration of geographical indications in this Act, shall be applicable to such foreign geographical indication. |
| indications |

CHAPTER XXXIIIE

|  |  |  |
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| 25 | Alterations to registered  geographical indications | MISCELLENEOUS |
| 30 | 161L. The registered owner of a geographical |
| indication may if he intends to amend the |
| specifications and associated control plan due |
| to the development of technologies, sciences |
| and the delimitation of the geographical area, |

16 *Intellectual Property (Amendment)*

make a request to the Director-General to

that effect along with the fees as shall be

prescribed :

|  |  |  |  |
| --- | --- | --- | --- |
| 5 | Provided that, any substantial amendment | | Amendment of section  162 of the  principal  enactment |
| to a registered geographical indication which | |
| 10 | affects the identity of such geographical | |
| indication shall not be accepted by the | |
| Director-General. | |
| Geographical Indications  registered as a  Certification Mark under  this Act | 161M.Any person who has registered a geographical indication as a Certification Mark under section 142 of this Act, may if he so wishes, apply to register such Mark as a geographical indication under section 161B.”. |
| 15 | **10.** Section 162 of the principal enactment is hereby amended as follows:- | |
| 20 | (1) in subsection (1), by the substitution for the words | |
| “Industrial Designs, Marks, Patents and Unfair | |
| Competition” of the words “Industrial Designs, | |
| Marks, Patents, Geographical Indications and | |
| Unfair Competition”; | |

(2) in subsection (8) -

|  |  |
| --- | --- |
| 25  30 | (*a*) by the substitution, in paragraph (*a*) of for the words “Trade Marks, Patents and Unfair Competition” of the words “Trade Marks, Patents, Geographical Indications and Unfair Competition”;  (*b*) by the substitution, in paragraph (*b*) for the words “Trade Marks, Patents and Unfair Competition” of the words “Trade Marks, Patents, Geographical Indications and Unfair Competition”; |

|  |  |  |  |
| --- | --- | --- | --- |
| 5 | *Intellectual Property (Amendment)* | 17 | Amendment |
| **11.** Section 168 of the principal enactment is hereby | |
| of section |
| amended by the substitution for the words “Patent or | |
| 168 of the |
| Mark or” of the words “Patent, Mark or geographical | | principal |
| indication or ”. | | enactment |
| **12.** Section 170 of the principal enactment is hereby | | Amendment of section  170 of the  principal  enactment |
| amended in subsection (2), by the substitution for the words | |
| “Patent, Mark or any other registration” of the words “Patent, | |
| Mark, geographical indication or any other registration”. | |
| 10 | **13.** Section 172 of the principal enactment is hereby | | Amendment of section  172 of the  principal  enactment |
| amended as follows:- | |
| (1) in subsection (1), by the substitution for the words | |

“Industrial Design, Patent or Mark or” of the words  
“Industrial Design, Patent, Mark, Geographical   
Indication or”;

15 (2) in subsection (2), by the substitution for the words “(2) The registered owner of the Industrial Design, Patent or Mark or any other register” of the words “(2) The registered owner of the Industrial Design, Patent or Mark, Geographical Indication or any 20 other register”;

(3) in subsection (3), by the substitution for the words  
“Industrial Design, Patent or Mark or any other   
matter” of the words “Industrial Design, Patent,   
Mark, Geographical Indication or any other matter”.

|  |  |  |
| --- | --- | --- |
| 25 | **14.** The following new section is hereby inserted | Insertion of new section |
| immediately after section 186 of the principal enactment |
| 186A in the |
| and shall have effect as section 186A of that enactment:- |
| principal |
| enactment |

|  |  |  |  |
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| 5 | 18 | *Intellectual Property (Amendment)* | Amendment |
| “Offences  relating to  geographical indications | 186A. The provisions relating to offences and penalties in respect of Marks as specified in this Part shall *mutatismutandis apply* in respect of geographical indications.”. |
| **15.** Section 212 of the principal enactment is hereby amended in the definition of the term “Convention”, by the | |
| of section |
| 212 of the |
| substitution for the words “Patents, Marks and any other | |
| principal |
| matter” of the words “Patents, Marks, Geographical | |
| enactment |
| 10 | Indications or any other matter”. | | Sinhala text |
| **16.** In the event of any inconsistency between the Sinhala and Tamil texts of this Act, the Sinhala text shall prevail. | |
| to prevail in |
| case of |
| inconsistency |

|  |  |
| --- | --- |
| *Intellectual Property (Amendment)* | 19 |

DEPARTMENTOFGOVERNMENTPRINTING