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SOCIALIST REPUBLIC OF
SRI LANKA**

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SUPPLEMENT

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INTELLECTUAL PROPERTY (AMENDMENT)

A

BILL

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

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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.

Intellectual Property (Amendment)

L.D.-O.8/2020

AN ACT TO AMEND THE INTELLECTUAL PROPERTY
ACT, No. 36 OF 2003

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

1. This Act may be cited as the Intellectual Property (Amendment) Act, No. of 2022. Short title
- 5 2. Section 2 of the Intellectual Property Act, No.36 of 2003 (hereinafter referred to as the “principal enactment”) is 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, Geographical Indications and of any other matter”. Amendment
of section 2
of Act,
No.36 of
2003
3. Section 4 of the principal enactment is hereby amended as follows:- Amendment
of section 4
of the
principal
enactment
 - 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, 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”;
- 25 4. Section 101 of the principal enactment is hereby amended by the repeal of the definition of the phrase “geographical indication”. Amendment
of section
101 of the
principal
enactment

2 *Intellectual Property (Amendment)*

5. Section 160 of the principal enactment is hereby amended as follows:-

Amendment
of section
160 of the
principal
enactment

5 (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;”.

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

“Definitions 160A. For the purposes of this Part, unless the context otherwise requires—

20 “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;

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

5 “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

(c) if such goods are handicrafts or industrial goods, makes or manufactures such goods; and

“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 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.

Amendment
of section
161 of the
principal
enactment

8. The following new sections are hereby inserted immediately after section 161 of the principal enactment and shall have effect as section 161A, 161B, 161C, 161D and 161E of that enactment:-

Insertion of new sections 161A, 161B, 161C, 161D and 161E in the principal enactment

- 5 “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;
- (b) the use of which is contrary to law, morality, religion, accepted customs 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;
- (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.

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

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.

10 (2) Upon receipt of an application, the Director-General shall examine such application in the manner as shall be prescribed .

15 (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:

20 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.

30 (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

35

date on which the refusal was informed to the applicant, his submissions in writing against the refusal.

5 (5) The Director-General may, upon receipt of such submissions, if he considers a hearing is necessary, inform the applicant of a date, time and place for the hearing of the matter relating to such submissions.

10 (6) The Director-General may, after such hearing refuse to register such application or register the application as it is or subject to such conditions, amendments or limitations as to the mode or place of use of such geographical indication as the Director-General may consider
15 appropriate.

(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,
20 furnish the reasons for such refusal or conditional acceptance for registration.

Publication
of the
application
25 161C. (1) Where the Director-General is of the opinion that the geographical indication 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 application publish such application in the *Gazette*, within a period of two months from
30 the date of receipt of such application by the Director-General. Where the applicant fails to pay such fee within such specified time period,

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

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 (f) if the applicant is resident outside Sri Lanka, a postal address for service in Sri Lanka.

Opposition
to
registration

20 161D. (1) Where any person considers the geographical indication published under 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

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

shall submit necessary information and evidence to substantiate such grounds.

5 (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.

10 (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
15 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
20 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
25 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 –

30 (a) where no appeal is preferred under section 173 against his decision, upon the expiry of the period within which an

appeal may be preferred against his decision; or

(b) where an appeal is preferred under section 173 against his decision, upon 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.

10 Renewal of
 registration
 of
 geographical
 indications

161E. (1) The registration of any geographical indication, unless it is cancelled earlier shall be valid for ten years from the date of application.

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(2) The registration of any geographical indication may be renewed by the owner of such geographical indication for consecutive 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:

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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.

25

(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.

30

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

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

5 (5) Where an application has not been sent for renewal along with the renewal fee by the applicant as specified in subsection (2), the Director-General shall remove the geographical indication from the register of geographical indications.”.

10 9. The following new Chapters are hereby inserted immediately after section 161E in the principal enactment and shall have effect as Chapters XXXIIIA, XXXIIIB, XXXIIIC, XXXIIID and XXXIIIE of that enactment:-

Insertion of new Chapters XXXIIIA, XXXIIIB, XXXIIIC, XXXIIID and XXXIIIE in the principal enactment

“CHAPTER XXXIIIA

15 ISSUE OF CERTIFICATE OF REGISTRATION AND THE REGISTER OF GEOGRAPHICAL INDICATION

Issue of certificate of registration

20 161F. If any application has duly been registered by the Director-General under this Part, he shall upon receipt of the prescribed fee for the certificate, issue a certificate of registration to the applicant who shall be the owner of the geographical indication (hereinafter referred to as the “registered owner”) in the prescribed form.

Register of Geographical Indication

25 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

shall be recorded in the order of their registration.

5 (2) The following particulars shall be included in the Register of Geographical Indications:-

- (a) the geographical indication;
- (b) number of registration;
- 10 (c) the name and address of the registered owner and if the registered owner is outside Sri Lanka, a postal address for service in Sri Lanka;
- (d) the date of application and registration;
- 15 (e) the list of goods in respect of which the registration of geographical indication 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.

CHAPTER XXXIIIB

RIGHTS OF A REGISTERED OWNER AND
ADMINISTRATION OF REGISTER OF GEOGRAPHICAL
INDICATIONS

- 5 Rights of a registered owner
- 161H. The registered owner of a geographical indication shall be entitled to prevent -
- 10 (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 spirit or handicraft manufactured and natural goods not originating in the place indicated by the geographical indication in question or not
- 20 complying with any other 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 or accompanied by expression
- 25 “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar” or such similar expression; or
- 30 (ii) any direct or indirect use, misuse, imitation or evocation of a

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

- 5 (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 spirit or handicraft
10 manufactured and natural goods;

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

- 15 (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
20 product, food, wine or spirit 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
25 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
30 dilute in an unfair manner, or take unfair advantage of that reputation;

- (ii) any direct use, misuse, imitation or evocation of the geographical
35 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 spirit 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

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

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

CHAPTER XXXIIIC

25 CANCELLATION OF REGISTRATION OF GEOGRAPHICAL INDICATIONS

Cancellation of registration of geographical indications 161j. The Director-General may cancel the registration of any geographical indication in the case of –

30 (a) any goods registered as geographical indications lose their special characteristic as geographical indication goods;

- (b) the registered owner fails to comply with the conditions and requirements, if any, subject to which such geographical indication is registered;
- 5 (c) the registered owner of such geographical indication requests the Director-General in writing for cancellation of registration of such geographical indication; or
- 10 (d) the registered owner fails to renew the registration of a geographical indication as specified in section 161E.

CHAPTER XXXIIID

FOREIGN GEOGRAPHICAL INDICATIONS

- 15 Foreign geographical indications 161k. Any foreign geographical indication 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
- 20 provisions relating to registration of geographical indications in this Act, shall be applicable to such foreign geographical indication.

CHAPTER XXXIIIE

- 25 MISCELLANEOUS

- Alterations to registered geographical indications 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,
- 30

make a request to the Director-General to that effect along with the fees as shall be prescribed :

5 Provided that, any substantial amendment to a registered geographical indication which affects the identity of such geographical indication shall not be accepted by the Director-General.

10 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:- Amendment of section 162 of the principal enactment

 (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”;

20

 (2) in subsection (8) -

 (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”;

25

 (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”;

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11. Section 168 of the principal enactment is hereby amended by the substitution for the words “Patent or Mark or” of the words “Patent, Mark or geographical indication or ”.

Amendment
of section
168 of the
principal
enactment

5 **12.** Section 170 of the principal enactment is hereby 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”.

Amendment
of section
170 of the
principal
enactment

10 **13.** Section 172 of the principal enactment is hereby amended as follows:-

Amendment
of section
172 of the
principal
enactment

(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 other register”;

20

(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 immediately after section 186 of the principal enactment and shall have effect as section 186A of that enactment:-

Insertion of
new section
186A in the
principal
enactment

“Offences relating to geographical indications 186A. The provisions relating to offences and penalties in respect of Marks as specified in this Part shall *mutatis mutandis apply* in respect of geographical indications.”.

5 **15.** Section 212 of the principal enactment is hereby amended in the definition of the term “Convention”, by the substitution for the words “Patents, Marks and any other matter” of the words “Patents, Marks, Geographical Indications or any other matter”. Amendment of section 212 of the principal enactment

10 **16.** 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

