

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.