

PART XI

CHAPTER XXXV

APPLICATIONS TO AND PROCEEDINGS BEFORE, THE
DIRECTOR-GENERAL AND COURT

Correction and
rectification of
register.

163. (1) The Director-General may, on application made in the prescribed manner by or on behalf of the registered owner of an industrial design, patent, trade mark or any other registration provided for under the Act, correct any error or make any change—

- (a) in the name, address or description of the registered owner of any Industrial Design, Patent or Mark or any other registration provided for under the Act ;
- (b) concerning any other particulars relating to the registration of an Industrial Design, Patent or Mark or any other registration as may be prescribed.

(2) Subject and without prejudice to other provisions of the Act—

- (a) the Court may on the application of any person aggrieved by the non-insertion in or omission from any register, of any entry, or by any entry made in any register without sufficient cause, or by any entry wrongly remaining on any register, or by any error or defect in any entry in any register, make such order for making, expunging, or varying such entry, as it may think fit ;
- (b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of any register ;

- (c) in case of fraud in the registration, assignment or transmission of any registered Industrial Design, Patent or Mark, or any other registration provided for under the Act, the Director-General himself may apply to the Court under the provisions of this section.

(3) In any proceedings under this Act in which the relief sought includes correction, alteration or rectification of any register, the Director-General shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Director-General in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issue, and within his knowledge as such Director-General shall think fit, and such statement shall be deemed to form part of the evidence in the proceedings.

(4) The Court, in dealing with any question of the correction, alteration or rectification of any register shall have power to review any decision of the Director-General relating to the entry in question or the correction, alteration or rectification sought to be made.

164. (1) Where the Director-General is satisfied that any volume of any register kept under this Act has been so damaged as to render that volume incapable of being mended, he may cause a copy thereof to be made and authenticated in such manner as he may direct.

Power to make copies of damaged volumes of any register, to prepare and insert reconstructed folios.

(2) Any copy made and authenticated under the provisions of subsection (1) shall replace the volume of which it is a copy, and shall for all purposes be deemed to have the same legal force and effect as the volume which such copy replaces.

(3) The Director-General shall cause every damaged volume of which a copy has been made under the provisions of subsection (1) to be preserved as long as it is reasonably practicable for any reference which may be necessary.

(4) Where the Director-General, after due investigation, is satisfied that any folio of any volume of any register has been lost and cannot be recovered or that any such folio has been permanently mutilated or so obliterated or damaged as to render the entries or any material part of the entries therein illegible, he may cause a reconstructed folio to be prepared.

(5) No folio shall be reconstructed as provided in subsection (4) except in accordance with the prescribed procedure, providing—

- (a) for evidence to be admitted and used by the Director-General in ascertaining the particulars originally contained in the lost or mutilated or damaged folio ;
- (b) for the giving of notice by the Director-General of the preparation of the reconstructed folio ;
- (c) for the lodging of objections by any person affected by any of the particulars contained in the folio to be reconstructed ; and
- (d) for the holding of an inquiry by the Director-General into any such objections.

(6) Where any folio has been reconstructed by the Director-General in accordance with the preceding provisions of this section, the Director-General shall authenticate the reconstructed folio in the prescribed manner and shall thereafter cause the reconstructed folio to be inserted in the appropriate volume of the register in the place formerly occupied by the lost folio or in place of the mutilated or damaged folio, or in a copy of a volume prepared under the provisions of this section, as the case may be, and the reconstructed folio, when so authenticated and inserted, shall for all purposes be deemed to have the same legal force and effect as the folio which such reconstructed folio replaces.

(7) The Director-General may, after such inquiry as he may deem necessary, correct any clerical error or omission which may be discovered in any entry in any register or in any certificate kept or issued under the provisions of this Act and for that purpose may recall any such certificate and amend the same or issue a fresh certificate in its place.

165. A certificate purporting to be under the hand of the Director-General as to any entry, matter, or thing which he is authorized by this Act or regulations made thereunder to make or do, shall be, *prima facie*, evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certificate of Director-General to be evidence.

166. Printed, mechanically produced, typed or written copies or extracts, certified by the Director-General, of or from any document, register, or other book filed or kept under this Act in the office shall be admitted in evidence in any Court of Sri Lanka, without further proof or production of the originals.

Certified copies to be evidence.

167. (1) In any proceeding under this Act before the Court, the evidence shall be given by affidavit in the absence of directions to the contrary. However in any case in which the Court shall think it right so to do, the Court may take evidence, *viva voce*, in lieu of or in addition to evidence by affidavit.

Mode of giving evidence.

(2) The provisions of subsection (1) shall, *mutatis mutandis*, apply in respect of the giving of evidence at an inquiry before the Director-General.

(3) In case any part of the evidence is taken *viva voce*, the Director-General may exercise the powers conferred on a Commission appointed under the provisions of the Commissions of Inquiry Act for compelling the attendance of witnesses and the production of documents and for administering oaths to all persons who shall be examined before him.

Exercise of discretionary power by Director-General.

168. Where any discretionary or other power is given to the Director-General by this Act or any regulation made thereunder, he shall not exercise that power adversely in respect of the applicant for registration or the registered owner of an Industrial Design, Patent or Mark or any other matter provided under this Act without (if duly required so to do within the prescribed time) giving such applicant or registered owner an opportunity of being heard.

Director-General may seek assistance of Attorney-General.

169. The Director-General may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, seek the assistance of the Attorney-General.

Infringement and the remedies.

170. (1) Where a person to whom any recognised rights granted under this Act, proves to the satisfaction of the Court that any person is threatening to infringe or has infringed his rights or is performing acts which makes it likely to infringe a right under this Act, will occur, the Court may grant an injunction restraining any such person from commencing or continuing such infringement or performing such acts and may order damages and such other relief as the Court may deem just and equitable. The injunction may be granted along with an award of damages and shall not be denied only for the reason that the applicant is entitled to damages.

(2) The defendant may in the proceedings referred to in subsection (1) request the Court to declare the registration of an Industrial Design, Patent, Mark or any other registration provided for under the Act, as the case may be, or any part of it, null and void, in which event the provisions of the section relating to the nullity of such registration shall apply as appropriate.

(3) (a) The court shall have the power to order—

- (i) the infringer to pay the right holder such damages as are adequate to compensate him for the loss suffered by him, by reason of such infringement, in addition to the recovery of any profits ;

- (ii) the infringing goods to be disposed of outside the channels of commerce or to be destroyed without the payment of any compensation ; and
- (iii) subject to the protection of confidential information, the tendering of any evidence by the opposing party which evidence is relevant to the substantiation of the claim and is in the control of the opposing party, in cases where a party has presented reasonably available evidence in support of the claim and has specified that evidence relevant to the substantiation of such claim lies in the control of the opposing party.

(b) The court may make any order specified in subsection (1) in respect of materials and implements used in the creation of the infringing goods.

(4) In making such orders the need for maintaining a balance between the seriousness of the infringement and the remedies ordered, as well as the interests of third parties shall be taken into consideration. In regard to counterfeit trade mark goods, the simple removal of the trade mark unlawfully affixed shall not other than in exceptional cases, be sufficient, to permit the release of the goods into the channels of commerce.

(5) The Court may, other than in an instance where it would not be in proportion to the seriousness of the infringement, order the infringer to inform the right holder of the identity of the persons involved in the production and distribution of the infringing goods or services and of channels of distribution used by them.

(6) The Court shall have power to order interim measures relating to protection, *ex-parte*, where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder or where there is a demonstrable risk of evidence being destroyed.

(7) Where interim measures have been ordered *ex-parte* the parties affected shall be given notice and shall on receipt of such notice be entitled to be heard as to whether the interim measures ordered should be modified or revoked.

(8) Where the interim measures are modified or revoked or it is subsequently found that there has been no infringement of a protected right, the Court shall have the power to order the applicant, upon the request of the defendant to pay appropriate compensation for any injury caused.

(9) The Court may require the applicant to provide security or other equivalent assurance sufficient to protect the defendant and to prevent abuse of any interim measures referred to in the preceding provisions of this section.

(10) Any owner of the rights protected under this Act may, notwithstanding any provision in the Act relating to the award of damages, elect at any time before final judgment to recover, instead of proved actual damages, an award of statutory damages for any infringement involved in the action of a sum not less than rupees fifty thousand and not more than rupees one million as the court may consider appropriate and just.

(11) No suit or prosecution shall lie against any official for any act which is done in good faith and in pursuance of any provisions of this Act.

Infringement proceedings by or at the request of licensee.

171. In the absence of any provision to the contrary in a licence contract relating to an Industrial Design, Patent or Mark or any other matter provided for by the Act, the licensee may—

- (a) in respect of the threatened infringement, infringement or acts referred to in section 170 request the registered owner of the Industrial Design, Patent or Mark or any other matter provided for by the Act, to apply for an injunction :

Provided that the licensee shall indicate the threatened infringement, infringement or acts being performed in relation to such infringement and specify the relief sought under the Act ; and

- (b) if the owner of the said Industrial Design, Patent or Mark or any other matter provided for by this Act refuses or fails to apply for an injunction within three months from the receipt of the said request, apply for an injunction in his own name, with notice to the registered owner who may join in the proceedings :

Provided that the Court may, on the application of the licensee, prior to the expiry of the period of three months, specified in paragraph (b) of this section grant an injunction if he proves that immediate action is necessary to avoid substantial damage.

172. (1) The Court may on the application of any person showing a legitimate interest to which the registered owner of the Industrial Design, Patent or Mark, or any other matter provided for under the Act as the case may be, shall be made party, declare that the threatened performance or performance of a specific act does not constitute a threatened infringement or infringement of the said Industrial Design, Patent or Mark or any other matter provided for under the Act.

Declaration of
non-infringement.

(2) The registered owner of the industrial design, patent or Mark or any other register provided for under the Act, as the case may be, shall give notice of the said application to any assignee or licensee, who shall be entitled to join in the proceedings in the absence of any provision to the contrary in any agreement with the registered owner.

(3) The proceedings for a declaration of non-infringement may be instituted concurrently with proceedings to declare the registration of an Industrial Design, Patent or Mark or any other matter provided for by the Act be null and void :

Provided that the matters in issue in the proceedings for a declaration of non-infringement are not already the subject of infringement proceedings.

(4) The provisions of the Judicature Act, No. 2 of 1978, and the Civil Procedure Code shall apply to every application for an injunction made to the Court under this Act.

Appeals.

173. (1) Any person aggrieved by any decision made by the Director-General under any provision of the Act may appeal therefrom to the Court within a period of six months from the date of such decision.

(2) Such person may prefer an appeal to the Court by way of a petition of appeal with a certified copy of the decision appealed from, accompanied by copies of all relevant documents and affidavits from the file of the Intellectual Property Office. A copy of the petition of appeal and the accompanying documents and the affidavits shall be served on the Director-General and other respondents named in the petition of appeal. Proof of such service shall be furnished with the petition of appeal to the Court. The respondents may file a statement of objections.

(3) Court may call for the original file from the Director-General and may receive and admit new evidence by way of affidavit and documents, additional to, or supplementary of, the evidence already given before the Director-General in respect of the matter issue as the Court may require.

(4) On any such appeal, the Court may affirm, reverse or vary the decision of the Director-General or may issue such directions to the Director-General, or order a further hearing by the Director-General, as the court may require.

(5) Any person who is dissatisfied with any Order made by the Court under subsection (4) to which such person is a party may prefer an appeal to the Supreme Court against such Order for the correction of any error in fact or in law, with the leave of the Supreme Court first had and obtained.

(6) Every appeal to the Supreme Court under subsection (5) shall be made as nearly as may be in accordance with the procedure prescribed by the rules of the Supreme Court with respect to special leave to appeal to the Supreme Court.

174. (1) In all proceedings before the Director-General under this Act, the Director-General shall have power to award any party such costs as he may consider reasonable, and to direct to whom and to what parties they are to be paid, and such order may be filed in Court, and thereupon such order may be enforced as if it were an order of the Court.

Costs of proceedings before Director-General and Court.

(2) In any proceedings before a Court under this Act, the Director-General shall not be ordered to pay costs. The Court may however in its descretion Order the payment of costs to the Director-General.

CHAPTER XXXVI

REGISTERED AGENTS

175. (1) An Agent referred to in this Act means an agent registered under the provisions of the Act or in accordance with any regulation made thereunder.

Registered agents.

(2) Any person registered as an agent under this Act shall have the authority and be competent to act as an agent under this Act.

(3) A person may be admitted and registered as an agent if he—

- (a) is a citizen of Sri Lanka and is ordinarily resident in Sri Lanka ; and
- (b) (i) is an Attorney-At-Law of the Supreme Court of Sri Lanka ; or
 - (ii) is a person possessing the qualifications prescribed for an agent ; and
- (c) pays the prescribed fee.