

Intellectual property law and e-commerce in Sri-Lanka: towards a jurisprudence based on constitution, Roman-Dutch law and Buddhist principle

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**INTELLECTUAL PROPERTY LAW
AND
E-COMMERCE IN SRI LANKA:
TOWARDS A JURISPRUDENCE BASED ON
CONSTITUTION,
ROMAN- DUTCH LAW AND BUDDHIST PRINCIPLE**

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ABSTRACT

Modern developments in technology, commerce and the cultural industries pose problems for intellectual property in Sri Lanka, as everywhere. Case law may be used for judicial guidance but there are comparatively few reported cases from the Sri Lankan courts. By examining Sri Lanka's juridical history and Constitution, together with constitutionally recognised Buddhist principles, it is possible to suggest further sources of guidance for judges. Using the proposed framework, it may be possible for the judges to apply existing law to new situations and avoid the need for constant legislative change in an attempt to keep up with developments and comply with Sri Lanka's international obligations.

The extent to which such guidance may be useful is explored by looking at specific issues, which have caused difficulty in other jurisdictions. It is hoped that the proposed techniques could be used to build up a body of Sri Lankan jurisprudence. This may prove more stable and effective than incremental legislation.

Status juris – This study (unless otherwise stated) based on material available as at 01.12.2004 and the law in force on that date.

This work is dedicated to

Mrs. A. E. S. ATTANAYAKE

my dearest mother

and

to the loving and cherished memory of

Mr. T.M. HEMARATNE

my dearest father

who passed away untimely

without seeing my success

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sace labetha nipakam sahāyam
saddhimcaram sādhuviharidhīram
abhibhuyya sabbani parissayani
careyya ten attamano satima
(The Buddha, Dhammapada, verse 328)

The association of and working with a talented, skilful, dependable and virtuous person can overcome much of the obstacle in the life.

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TABLE OF CONTENTS

ABSTRACT.....	2
ACKNOWLEDGEMENTS.....	4
LIST OF TABLES.....	13
LIST OF DIAGRAMS.....	13
LIST OF ABBREVIATIONS.....	14
CHAPTER ONE	
INTRODUCTION AND BACKGROUND	18
1.1 INTRODUCTION.....	18
1.2 ISSUES.....	20
1.2.1 ACADEMIC WRITINGS.....	23
1.2.2 SPECIALIST JUDICIARY	24
1.2.3 AVAILABILITY OF CASES	27
1.2.4 NEEDS AND THE VALUES OF THE SOCIETY.....	28
1.2.5 RECOURSE TO OTHER JURISDICTION OR PRINCIPLE OF LAW	31
1.2.6 INTERNATIONAL TREATY OBLIGATIONS	32
1.2.7 BILATERAL INVESTMENT TREATIES.....	34
1.2.8 AWARENESS AND UNDERSTANDING OF THE SOCIETY.....	35
1.2.9 ENFORCEMENT AUTHORITY SUCH AS CUSTOMS, POLICE	38
1.2.10 POLICY MAKERS AND THE CONCERNING AUTHORITY.....	38
1.3 OBJECTIVES.....	40
1.4 SIGNIFICANCE.....	40
1.5 DEFINITION OF TERMS	43
1.6 LIMITATIONS.....	43
1.7 METHODOLOGY AND RESEARCH STRATEGY.....	44
1.8 PROPOSED JUDICIAL METHODOLOGY FOR THE INTERPRETATION AND APPLICATION OF INTELLECTUAL PROPERTY LAW IN SRI LANKA.....	45
1.9 STUDY OVERVIEW.....	48
1.10 CONCLUSION	49
CHAPTER TWO	
ORIGIN, RECOGNITION AND PROTECTION OF INTELLECTUAL PROPERTY IN SRI LANKA.....	50
2.1 INTRODUCTION.....	50
PART A	
A BRIEF SURVEY OF THE DEVELOPMENT OF THE NOTION OF PROPERTY RIGHTS IN SRI LANKA.....	51
2.2 ORIGIN AND DEVELOPMENT OF THE STATE.....	51
2.3 LAW AND ORDER.....	52
2.4 MARKET ECONOMY	53
2.5 OWNERSHIP OF PROPERTY	55
2.6 EXISTENCE OF INTELLECTUAL PROPERTY.....	56
2.7 PROTECTION OF WORKS.....	58
2.7.1 BUDDHISM AS A MECHANISM.....	58
2.7.2 PUNISHMENT AS A MECHANISM.....	58
2.7.3 RETRIBUTION IN THE NEXT BIRTH AS A MECHANISM.....	59

2.7.4 CASTE AS A MECHANISM	61
2.7.5 LEXICON.....	62

PART B

A BRIEF EXAMINATION OF THE FOREIGN INFLUENCES ON INTELLECTUAL PROPERTY LAW.....	63
2.8 INTRODUCTION.....	63
2.8.(A) DRAVIDIANS/ TAMILS.....	63
2.8.(B) MUSLIMS	64
2.8.(C)(I) PORTUGUESE.....	65
2.8.(C)(II) PROPERTY RIGHTS UNDER THE PORTUGUESE.....	66
2.8.(D)(I) THE DUTCH	66
2.8.(D)(II) PROPERTY RIGHTS UNDER THE DUTCH	67
2.8.(E)(I) KANDYAN LAW	68
2.8.(E)(II) INTELLECTUAL PROPERTY	70
2.8.(F)(I) INFLUENCE OF THE BRITISH	71
2.8.(F)(II) PROPERTY RIGHTS UNDER THE BRITISH.....	72
2.8.(F)(III) INTRODUCTION OF COMMERCIAL LAWS.....	72
2.8.(F)(IV) INTRODUCTION OF INTELLECTUAL PROPERTY LAW	75

PART C

A BRIEF EXAMINATION OF SOME BUDDHIST PRINCIPLES.....	76
2.9 INTRODUCTION.....	76
2.9.(A) DICTIONARY DEFINITION	76
2.9.(B) ENLIGHTENMENT	77
2.9.(C) PANCA SĪLA OR THE CODE OF FIVE MORAL PRECEPTS.....	78
2.9.(C)(I) ADINNĀDĀNĀ VERAMANĪ	79
2.9.(C)(II) MUSĀVĀDĀ VERAMANĪ.....	80
2.9.(D) NOBLE EIGHT-FOLD PATH (ARIYA ASTṬANGIKA MAGGA).....	81
2.9.(D)(I) RIGHT WORDS (SAMMĀ VĀCĀ).....	82
2.9.(D)(II) RIGHT LIVELIHOOD (SAMMĀ ĀJĪVA).....	82
2.9.(E) FOUR NOBLE TRUTHS (CHATHURĀRYA SATHYAYA).....	83
2.9.(F) NOTION OF PRIVATE PROPERTY	83
2.9.(F)(I) ACQUISITION	83
2.9.(F)(II) MERITS OF LAWFUL ACQUISITION	84
2.9.(G) THE CONCEPT OF GOVERNMENT AND PROPERTY PROTECTION IN BUDDHISM	86

PART D

THE THEORISATION PROCESS	87
2.10 INTRODUCTION.....	87
2.11 THEORY TO BE APPLIED	91
2.13 CONCLUSION	98

CHAPTER THREE

LAWS RELATING TO TRADE MARKS, TRADE NAMES, AND GEOGRAPHICAL INDICATIONS IN SRI LANKA AND THEIR APPLICATION WITHIN THE INFORMATION AGE.....	100
3.1 INTRODUCTION.....	100

PART A

HISTORICAL DEVELOPMENT OF TRADE MARK LAW IN SRI LANKA.....	100
3.2 PRE BRITISH ERA.....	100
3.3 FIRST GENERATION.....	102
3.4 SECOND GENERATION.....	105
3.5 THIRD GENERATION.....	107
3.6 THE FOURTH GENERATION.....	109
3.6.1 SALIENT FEATURE IN RELATION TO MARKS.....	110
3.6.2 OBJECTIVE GROUNDS AND THIRD PARTY RIGHTS.....	110
3.6.3 EXCLUSIVE RIGHTS.....	111
3.6.4 CERTIFICATION MARKS.....	111
3.6.5 PROTECTION OF TRADE NAMES.....	112
3.6.6 UNFAIR COMPETITION.....	112

PART B

APPLICATION OF PRESENT TRADE MARK LAW-AN OVERVIEW.....	114
3.7 THE FIFTH GENERATION.....	114
3.7.1 DEFINITION OF MARKS.....	115
3.7.2 ADMISSIBILITY OF MARKS.....	115
3.7.2.(a) Morality and the public order.....	117
3.7.2.(b) Marks likely to mislead.....	117
3.7.3 LIMITS TO TRADE MARK RIGHTS.....	122
3.7.4 EXCLUSIVE RIGHTS, THEIR INFRINGEMENT AND REMEDIES.....	123
3.7.5 CERTIFICATION MARKS.....	128
3.7.6 COLLECTIVE MARKS.....	129
3.7.7 TRADE NAMES.....	129
3.7.8 GEOGRAPHICAL INDICATIONS.....	131
3.7.9 PASSING OFF.....	132
3.7.10 UNFAIR COMPETITION.....	133

PART C

APPLICATION OF TRADE MARK LAW IN CYBERSPACE.....	135
3.8 INTRODUCTION.....	135
3.8.(I)(A) METHODOLOGY TO BE APPLIED.....	135
3.8.(I)(B) POTENTIAL INFRINGEMENT OF TRADE MARKS IN CYBERSPACE.....	136
3.8.2 DOMAIN NAMES.....	137
3.8.2.(I) Conflicting interest disputes.....	138
3.8.2.(II) Palming off disputes.....	139
3.8.2.(III) Competitor disputes.....	139
3.8.2.(IV) Cybersquatting.....	139
3.8.2.(V) Cyber griping/parodyor Commentary.....	140
3.8.2.(a) Position in the USA.....	140
3.8.2.(b) Position in the United Kingdom.....	141
3.8.2.(c) Sri Lankan domain name policy.....	143
3.8.3. USE OF TRADE MARKS AS META TAGS.....	147
3.8.3.(a) Position in the USA.....	148
3.8.3.(b) Position in the United Kingdom.....	151

3.8.3.(c) Sri Lankan position	152
3.8.4 SPAMMING	154
3.8.4.(a) Position in the USA	155
3.8.4.(b) Position in the United Kingdom.....	156
3.8.4.(c) Sri Lankan Position	156
3.8.5 LINKING.....	157
3.8.5.(a) Position in the USA	158
3.8.5.(b) Position in the United Kingdom.....	160
3.8.5.(c) Sri Lankan position	160
3.8.6 FRAMING	161
3.8.6.(a) Position in the USA	162
3.8.6.(b) Position in the United Kingdom.....	162
3.8.6.(c) Sri Lankan Position	162
3.8.7 SALE OF TRADE MARKS AS KEYWORDS	163
3.8.7.(a) Position in the USA	163
3.8.7.(b) Position in the United Kingdom.....	164
3.8.7.(c) Sri Lankan position	164
3.8.8 POP-UP AND POP-UNDER ADVERTISEMENTS	165
3.8.8.(a) Position in the USA	165
3.8.8.(b) Position in the United Kingdom.....	166
3.8.8.(c) Sri Lankan position	166
3.8.9 MOUSETRAPPING.....	166
3.8.9.(a) Position in the USA	167
3.8.9.(b) Position in the United Kingdom.....	167
3.8.9.(c) Sri Lankan position	168

PART D

APPLICABILITY AND THE EFFICACY OF THE PROPOSED THEORY	168
3.9 INTRODUCTION.....	168
3.9.1 Application of the theory.....	169
3.9.2 Conclusion.....	171

CHAPTER FOUR

LAWS RELATING TO COPYRIGHT AND RELATED RIGHTS IN SRI LANKA AND THEIR APPLICATION IN THE INFORMATION AGE: HISTORICAL, PHILOSOPHICAL AND LEGAL PERSPECTIVE.....	172
4.1 INTRODUCTION	172

PART A

HISTORICAL DEVELOPMENT.....	180
4.2 PRE BRITISH ERA.....	180
4.3 DURING AND AFTER THE BRITISH REGIME	181
4.3.1 The first generation.....	181
4.3.2 The second generation	183
4.3.3 The third generation	186
4.3.3.(a) Constitutional recognition of Copyrights.....	187
4.3.3.(b) Copyright works	187
4.3.3.(c) Infringements and fair use etc.....	188

4.4 THE FOURTH GENERATION	189
4.4.(1) Salient features of the Code	189
4.4.(2) Compulsory licensing	193
4.4.(3) Fair use and infringement.....	194
 PART B	
APPLICATION OF PRESENT LAWS: AN OVERVIEW	195
4.5 INTRODUCTION	195
4.5.1 Scope of the protection.....	196
4.5.2 Works	197
4.5.2.(a) Literary works	200
4.5.2.(b) Scientific works	200
4.5.2.(c) Artistic works	200
4.6 DERIVATIVE WORKS	203
4.6.1 Translations, adaptation etc	203
4.6.2 Database	204
4.6.2.(a) Intellectual creativity vs. originality of derivative works.....	206
4.7 FOLKLORE	207
4.8 WORKS EXCLUDED FROM COPYRIGHT PROTECTION.....	209
4.9 REQUIREMENTS FOR PROTECTION.....	209
4.10 DURATION OF ECONOMIC RIGHTS AND MORAL RIGHTS	210
4.10.(A) ECONOMIC RIGHTS.....	211
4.10.(B) MORAL RIGHTS	211
4.11 LIMITATIONS OF THE PROTECTION	211
4.12 INFRINGEMENTS AND FAIR USE	212
4.13 REMEDIES FOR INFRINGEMENT OF COPYRIGHT	215
 PART C	
APPLICATION OF COPYRIGHT LAW IN THE INFORMATION AGE.....	216
4.14 INTRODUCTION	216
4.15 METHODOLOGY TO BE APPLIED	218
4.16 POTENTIAL COPYRIGHT CONFLICTS IN THE INFORMATION AGE	220
4.17 WORKS ON THE INTERNET AND COPYRIGHT	221
4.17.(a) Text and verbal contents.....	221
4.17.(b) Computer programs.....	222
4.17.(c) Databases	223
4.17.(d) Artistic works.....	224
4.17.(e) Dramatic works	224
4.17.(f) Musical works.....	224
4.18 EXTENSION OF EXCLUSIVE RIGHTS TO THE DIGITAL WORLD AND ESPECIALLY TO THE INTERNET ..	225
4.18.(a) Reproduction right.....	225
4.18.(b) Translation, adaptation, and transformation	227
4.18.(c) Communication to the public of the work.....	229
4.19. POTENTIAL INFRINGEMENT ACTIVITIES ON THE INTERNET.....	231
4.19.(1) BROWSING.....	232
4.19.(1)(a) Position in USA	232
4.19.(1)(b) Position in the United Kingdom.....	233
4.19.(1)(c) Position in Sri Lanka.....	233
4.19.(2) CACHING.....	235

4.19.(2)(a) Position in the USA.....	235
4.19.(2)(b) Position in the United Kingdom.....	236
4.19.(2)(c) Position in Sri Lanka.....	236
4.19.(3) HYPER LINKING AND DEEP LINKING	237
4.19.(3)(a) Position in the USA.....	238
4.19.(3)(b) Position in the United Kingdom.....	238
4.19.(3)(c) Position in Sri Lanka.....	239
4.19.(4) FRAMING	241
4.19.(4)(a) Position in the USA.....	242
4.19.(4)(b) Position in the United Kingdom.....	242
4.19.(4)(c) Position in Sri Lanka.....	242
4.19.(5) PEER-TO-PEER (P2P) FILE SHARING	243
4.19.(5)(a) Position in the USA.....	244
4.19.(5)(b) Position in the United Kingdom.....	245
4.19.(5)(c) Position in Sri Lanka.....	245
 PART D	
APPLICABILITY AND THE EFFICACY OF THE PROPOSED THEORY	246
4.20 INTRODUCTION	246
4.21 APPLICATION OF THE PROPOSED THEORY: AN EVALUATION.....	247
4.22 CONCLUSION.....	251
 CHAPTER FIVE	
CONCLUSIONS AND RECOMMENDATIONS	253
5.1. INTRODUCTION.....	253
5.2. IMPLICATIONS FOR POLICY AND PRACTICE.....	255
5.3. IMPLICATIONS FOR FURTHER RESEARCH.....	255
5.6. IN CONCLUSION	256
 BIBLIOGRAPHY.....	 257
 APPENDIXES	
APPENDIX (A) COUNTRY PROFILE.....	300
APPENDIX (B) EXTRACTS OF THE CONSTITUTION OF THE DEMOCRATIC SOCIALIST REPUBLIC OF SRI LANKA –1978.....	302
APPENDIX (C) TABLE OF BILATERAL INVESTMENT TREATIES.....	313
APPENDIX (D) MERCHANDISE MARKS ORDINANCE, NO.05 OF 1865 ..	316
APPENDIX (E) MERCHANDISE MARKS ORDINANCE, NO.13 OF 1888.....	323
APPENDIX (F) MERCHANDISE MARKS ORDINANCE, NO.14 OF 1892.....	333
APPENDIX (G) TRADE MARKS ORDINANCE, NO.14 OF 1888	335
APPENDIX (H) TRADE MARKS ORDINANCE, NO. 4 OF 1890	346
APPENDIX (I) TRADE MARKS AMENDMENT ORDINANCE, NO. 6 OF 1904.....	351
APPENDIX (J) TRADE MARKS AND DESIGNS ORDINANCE, NO. 9 OF 1906.....	354
APPENDIX (K) TRADE MARKS (AMENDMENT) ORDINANCE, NO. 15 OF 1908	356
APPENDIX (L) THE PATENTS, DESIGNS, AND TRADE MARKS	

(TEMPORARY RULES) ORDINANCE, NO.10 OF 1915.....	358
APPENDIX (M) THE TRADE MARKS (AMENDMENT) ORDINANCE, NO. 23 OF 1918.....	360
APPENDIX (N) THE ALIEN ENEMY (VESTING OF TRADE MARKS) ORDINANCE, NO.5 OF 1919.....	362
APPENDIX (O) TRADE MARKS ORDINANCE, NO.15 OF 1925... ..	364
APPENDIX (P) TRADE MARKS (CONVENTION) AMENDMENT ORDINANCE, NO.23 OF 1932.....	389
APPENDIX (Q) THE COPYRIGHT ORDINANCE, NO.12 OF 1908.....	391
APPENDIX (R) THE COPYRIGHT ORDINANCE, NO.20 OF 1912.....	403
APPENDIX (S) COPYRIGHT ORDINANCE, NO.21 OF 1915.....	406
APPENDIX (T) THE COPYRIGHT (AMENDMENT) ORDINANCE, NO.11 OF 1918.....	409
APPENDIX (U) THE COPYRIGHT (AMENDMENT) ORDINANCE, NO. 6 OF 1919.....	411
APPENDIX (V) THE TELEGRAM COPYRIGHT ORDINANCE, NO.19 OF 1898.....	413
APPENDIX (W) THE TELEGRAM COPYRIGHT ORDINANCE, NO.1 OF 1926.....	416
APPENDIX (X) EXTRACTS OF THE CODE OF INTELLECTUAL PROPERTY ACT, NO.52 OF 1979.....	418
APPENDIX (Y) EXTRACTS OF THE INTELLECTUAL PROPERTY ACT, NO.36 OF 2003.....	436

LIST OF TABLES

<i>Table one- Comparison of specific provision in Sri Lankan, UK and USA law.....</i>	126
<i>Table two- Growth of Internet subscribers in Sri Lanka</i>	179
<i>Table three - Comparison of Common law(CL) and Statutory copyrights</i>	184
<i>Table four- Duration of Copyrights under Ordinance 1908.....</i>	185
<i>Table five- Duration of Copyrights under Ordinance 1912</i>	188
<i>Table six- Duration of Copyrights under Code.....</i>	191
<i>Table seven- Comparison of protection of collection/database</i>	204
<i>Table eight - Comparative table of database protection.....</i>	205
<i>Table nine - Duration of Copyrights under the Act</i>	210

LIST OF DIAGRAMS

<i>Diagram one- The Hierarchy of the Courts -----</i>	27
<i>Diagram two- Procedural steps of methodology -----</i>	98
<i>Diagram three - Copyright protection under the Act -----</i>	197

LIST OF ABBREVIATIONS

A.C.	Law Reports, Appeal Cases
A.L.J.R.	Australian Law Journal Reports
A.L.R.	Australian Law Reports
AIPJ	Australian Intellectual Property Journal
AIPLA Quarterly Journal	The American Intellectual Property Law Association Quarterly Journal
All ER	All England Law Reports
Am. U. Int'l L. Rev	American University International Law Review
B&C	Barnewall and Crosswell's Reports
Berkeley Tech. L.J.	Berkley Technology Law Journal
C.L.J.	Ceylon Law Journal
C.L.J.R.	Ceylon Law Journal Reports
C.L.R.	Ceylon Law Recorder
C.L.S.J	Ceylon Law Society Journal
C.L.S.Rev.	Ceylon Law Students Review
C.L.W.	Colombo Law weekly
C.M.L.R.	Common Market Law Reports
C.T.L.R.	Computer and Telecommunications Law Review
C.W.R.	Ceylon Weekly Recorder
Cal.L.Rev	California Law Review
Cardozo J. Int'l & Comp. L.	Cardozo Journal of International and Comparative Law
Cardozo L. Rev.	Cardozo Law Review
Cey.J.Hum	The Ceylon Journal of the Humanities,
Ch.	Law Reports, Chancery Division, 1891-
Ch.D	Law Reports, Chancery Division, 1875-1890
CJHSS	The Ceylon Journal of History and Social Studies, New Series
CMLRev	Common Market Law Review

Col LR	Columbia Law Review
Col. J. Trans. Law	Columbia Journal of Transnational Law
Colom L.Rev / Colom.L.R	Colombo Law Review
Columbia L. Rev	Columbia Law Review
Comms. L.	Communications Law
Comp.& Telecom. L. R.	Computer and Telecommunications Law Review
Computer L.Rev.& Tech.L.J.	Computer Law Review and Technology Law Journal
E.B.L.R	Electronic Business Law Reports
E.C.C	European Commercial Cases
E.I.P.R	European Intellectual Property Review
E.T.M.R	European Trade Marks Report
E.W.H.C	High Court (neutral citation)
Ent. L. Rev	Entertainment Law Review
F2d	Federal Report Second series
F3d	Federal Report Third series
Fed	Federal
F Supp	Federal Report Supplement
F.S.R	Fleet Street Reports
Fordham Intell. Prop. Media & Ent. L.J.	Fordham Intellectual Property, Media & Entertainment Law Journal
Fordham Law Rev.	Fordham Law Review
Geo. L.J.	Georgetown Law Journal
Harv. J.L. & Tech.	Harvard Journal of Law & Technology
Harv. LR	Harvard Law Review
I & C.T.L.	Information and Communication Technology Law
I.J.L & I.T.	International Journal of Law and Information Technology
I.P.Q	Intellectual Property Quarterly
ICCLR	International Company and Commercial Law Review
Idaho L. Rev	Idaho Law Review

IDEA	The Journal of Law and Technology
IIC	International Review of Industrial Property and Copyright Law
Ind. J. Global Legal Stud.	Indiana Journal of Global Legal Studies
Int. R. of Law & Ec.	International Review of Law and Economics
Int. Rev. Law & Econ.	International Review of Law & Economics
Int.J.of Global Legal Studies	International Journal of Global Legal Studies
Int.T.L.R.	International Trade Law and Regulation
IPJ	Intellectual Property Journal
J. Budd. Ethics	Journal of Buddhist Ethics
J. Int'l Econ. L	Journal of International Economic Law
J. Tech. L. & Pol'y	Journal of Technology Law & Policy
J.B.L	Journal of Business Law
JIABS	Journal of International Buddhist Studies
J.I.L.T	Journal of Information, Law and Technology
J.W.I.P.	Journal of World Intellectual Property
J.W.T.L	Journal of World Trade Law
JIEL	Journal of International Economic Law
JLH	Journal of Legal History
JLP	Journal of Legal Pluralism and Unofficial Law
JLS	Journal of Legal Studies
JPTOS	Journal of the Patent and Trademark Office Society
N.L.R	New Law Reports
NSWLR	New South Wales Law Reports
NYILR	New York International Law Review
R.P.C.	Reports of Patent, Design, and Trade Marks Cases
RICH. J.L.& TECH	Richmond Journal of Law & Technology
S.C.C.	Supreme Court Circular

S.C.L. Rev	South Carolina L. Review
S.L.R.	Sri Lanka Law Reports
San Diego L. Rev.	San Diego Law Review
SLLR / Sri L.R	Sri Lanka Law Reports
Sw.U.L.Rev.	Southwestern University Law Review
T.C.L.R.	Times of Ceylon Law Reports
TMR	Trade Mark Reporter
Va. L. Rev.	Virginia Tax Review
W.L.R	Weekly Law Reports
WVJOLT	West Virginia Journal of Law and Technology
Yale L.J	Yale Law Journal

CHAPTER ONE

Introduction and background

1.1 Introduction

Intellectual property plays a vital role in the overall economic development of any country. This is relevant to all societies today, including Sri Lanka, where knowledge has become the core capital. The compelling need for investment, inventive and creative activity, transfer of technology and the dissemination of knowledge in all the areas of human endeavour are felt more strongly now than ever before. Consequently, a strong and fair intellectual property system, which can address the needs of the information society, has become vital for the economic development of Sri Lanka.

It is obvious that the most significant outcome of the information society is e-commerce.¹ It is now an established view that the subject matter of electronic commerce can be tangible or intangible goods and services. The basic nature of e-commerce transactions raises many questions in the context of traditional legal system in general and intellectual property law in particular. The questions in relation to traditional legal systems can be seen in the area of general principles of law of contracts, Bills of Exchange, Sale of Goods, Insurance, Banking and Securities, Consumer Protection, Prevention of Fraud, Law of Evidence, Law of Interpretation, Company Law, Competition Law, Law of Negligence, Customs Law, Privacy Law, Criminal law, Constitutional Law, Tax Law, Customary International Law and almost all laws in relation to off-line transactions.

E-commerce transactions raise questions especially in relation to intellectual property laws such as copyright, patent, trademarks, undisclosed information, and other related rights. The main reason to this development is the capability of digitisation of works of intellectual property by a process that reduces text, visual images, and sound to a binary medium. Thus, once intellectual properties are converted into digital form it is easy to transmit over the globe via net without any barriers.² This practice has put pressure on existing system of intellectual property protection especially in relation to copyright and other related rights, trade marks, and undisclosed information to accommodate these changes. Accordingly, the present intellectual property law, which evolved in an

¹ E-commerce has been defined in many ways. Nevertheless, for this study, the meaning is confined to business, which is conducted online whether open-ended or close ended network.

² For instance WIPO, *Intellectual Property on the Internet A Survey of Issues* (Geneva: WIPO, 2002),19.

industrial society where information technology has had little effect, is now faced with an unexpected mismatch with the emerging information driven environment.

In Sri Lanka, computer mediated dissemination of information has assumed a vital role in industry and commerce. This in turn has been a result of economic reforms taking place from the recent past. Until the late 1970s, Sri Lanka's economic development centred on import-substituting activities performed mainly by state-owned firms resulting in low economic expansion, however economic performance was ahead of many other countries in the region. The government that came to power in the early 70's consisted of many Marxist factions and their economic policies were inward bound. This led to the decline of economic activities. Realisation of this led to enormous economic and trade reforms from 1977 by liberalising and opening up the economy. Consequently, the clothing industries have emerged as the main merchandise in the 1980s, in place of traditional tea, coconut, and rubber, leading Sri Lanka to get involved in many trade agreements including bilateral investment agreements.³

Since the late 1980s, Sri Lanka has experienced traditional electronic transactions such as electronic money transfer and using of electronic teller cards etc. This situation changed rapidly due to many reasons such as technological education and computer skills of the new generation. Consequently, several Sri Lankan companies are in the information and communication technology software export business, which brings in around \$ 500 million each year and there has been a 30% annual growth in this sector.⁴ The Securities and Exchange Commission (Sri Lanka), the Colombo Stock Exchange (CSE) and Stock Brokers Association⁵ introduced a mechanism in which shares, debt instruments including government securities (treasury bills), debentures, and commercial papers in the corporate sector could be sold electronically via internet. The main idea is to attract more investors including foreign investors.⁶

However, at present, Sri Lanka does not have adequate laws for regulating the electronic environment specifically. Consequently, transactions such as electronic banking, online share trading, and contracting via Internet remain largely unregulated. The whole area of

³ Sri Lanka is signatory to regional agreements such as Bangkok Agreement. It is a participant to South Asian Preferential Trade Area (SAPTA), Agreement on South Asian Free Trade Area (SAFTA) and party to more than 26 bilateral investment treaties.

⁴ Daily News on 20.11.2002 at <http://www.dailynews.lk/2002/11/20/new01.html> (Accessed: 01.12.2004).

⁵ At <http://www.cse.lk/home/main.jsp> (Accessed: 01.12.2004).

⁶ Daily News on 20.11.2002 at <http://www.dailynews.lk/2002/11/20/new01.html> (Accessed: 01.12.2004).

intellectual property protection is also facing a dilemma as to whether the present law is adequate to address the online transactions.⁷ Recent instances of misuse in Sri Lanka⁸ have demonstrated the consequences of the absence of a proper legal mechanism to address these issues.⁹

Despite this, the government of Sri Lanka launched a project called “e-Sri Lanka” on 20th November 2002, with the intention of maximising information, and communication technology services in the country and thereby to provide access to information nationwide, to create, and develop global market for employment in all sectors.¹⁰

If the legal rules of a country are not set and applied appropriately, the digital medium has the potential to undermine the basic philosophy of intellectual property. Sri Lankan intellectual property law is not exempt from this phenomenon. Hence, the focus should be given either to the implementation of new intellectual property laws, which could address the national and international dimensions of computer-mediated transactions or to the present intellectual property laws, which could be applied to new situations by synthesising with local values, and customs, which would give synergic effect.

1.2 Issues

As noted above, new technology allows for the transmission of intellectual property over communication networks without being embodied on a fixed carrier. Since the laws based on traditional notion of transactions are not always capable of addressing the issues that are emerging within an information society, many attempts have been made by different countries or world organisations to address those issues. For instance, countries

⁷ Likewise, there is absence of data protection laws which seriously impeding business opportunity in Sri Lanka.

⁸ For example dealing with software that belongs to another etc. *Seven Seas Computers Lanka (Pvt.) Ltd. v. Qsoft Software Development Company*, (Unreported) HC/Civil/18/2001(3). Also Daily News on 04.03.2003 at <http://www.dailynews.lk/2003/03/04/bus14.html> (Accessed: 01.12.2004).

⁹ However, Sri Lanka officially launched a programme at the end of October 2000 to provide island-wide Internet access. One of the visions of this programme is to make Sri Lanka “Cyber Island” and “Telecommunication Hub” in South Asia. (Lanka Net, on 31.10.2000). This will enhance the infrastructure facilities that are needed to e-commerce transactions. Nevertheless, the promulgation of law in relation to e-commerce is far ahead in the near future.

¹⁰ Daily News on 20.11.2002 at <http://www.dailynews.lk/2002/11/20/businesslead.html> (Accessed: 01.12.2004). The e-Sri Lanka Action Plan envisions the creation and development of global markets for employment generation, deployment of e-government concepts with emphasis on productivity and competitiveness; Island on 22.11.2002, at <http://www.island.lk/2002/11/22/> (Accessed: 01.12.2004); The World Bank’s Senior Advisor e-development, Nagy Hanna, is of the opinion that with the launch of e-Sri Lanka, the country would become a regional ICT-enabled commercial and logistics hub, which provides an attractive investment environment and builds a dynamic information infrastructure and thriving knowledge service industry. The Lanka Academic at <http://www.theacademic.org> on 20.11.2002, (Accessed: 20.11.2002).

like United States of America¹¹ and world Organisations such as World Intellectual Property Organisation (hereinafter 'WIPO')¹² and United Nations Commission on International Trade (hereinafter 'UNCITRAL')¹³ have taken steps in search of the possibilities in addressing the issues arising in the information age. However, many issues remain unaddressed.

It is submitted that, even though traditional objectives of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (hereinafter 'TRIPS') focus on off-line transactions, the language of TRIPs is sufficiently technologically neutral to cover on-line as well as off-line transactions. The WIPO Copyright Treaty (hereinafter 'WCT'), WIPO Performance, and Phonograms Treaty (hereinafter 'WPPT') are commendable, since they provide definitions and scope of rights in the digital environment. Nevertheless, WCT leaves a lacuna in relation to questions of copyright and related rights. For instance, a question could be raised as to whether the temporary copies in computer random access memory (RAM) constitute a reproduction?¹⁴ Likewise, determination of exclusive rights to control (the making available right) is left to national laws by these treaties.¹⁵ Audio-visual performer's rights, broadcaster's rights, and non-copyright protection for database are also non-considered subject areas of WIPO treaties.

Furthermore, Webcasting or streaming¹⁶ and digital film and television are not addressed by these treaties. No treaty covers the rights of performers in authorised audio-visual fixation of their performances. Determination of online service provider's liability is left to the national laws. None of those treaties deal with database protection in the digital media. Likewise, WIPO treaties have not addressed Peer-to-Peer file sharing system,¹⁷ which facilitates swapping of music and video files between two or more users.

Software products are often marketed in the form of computer readable media e.g. Diskettes and CD-ROM or directly over the Internet. The protection of such products is yet to be addressed.

¹¹ E.g. Digital Millennium Copyright Act of 1998 (DMCA), Audio Home Recording Act (AHRA) of 1992, Anti cyber squatting Consumer Protection Act of 1999.

¹² E.g. international conference on e-commerce and intellectual property in Geneva from 14-16 September 1999 and Geneva from 19-21 September 2001.

¹³ UNCITRAL Model Law on E-Commerce at www.uncitral.org (Accessed: 01.12.2004).

¹⁴ E.g. Silke von Lewinski, "The New WIPO Treaties: A first resume", *E.I.P.R.*, (1997), 171.

¹⁵ E.g. J.A.L Sterling, *World Copyright Law 2nd* (edn) (London: Sweet & Maxwell, 2003).

¹⁶ Transmitting audio, radio, and television broadcast over the Internet.

¹⁷ Commonly called as P2P.

Furthermore, in order to give patent protection, an invention is compared with existing state of art (prior art). Nevertheless, it is clear that the authenticity, veracity, and integrity are the critical issues for prior art in cyberspace since it could be altered easily.

Trade marks and geographical indications often find it difficult to fit into the digital environment. For instance, Hyperlink, meta tags, pop-up and pop-under advertisement, user-traffic diversion, linking, framing, sale of trade marks as keywords, mousetrapping and trade marks in another language raise novel issues to be addressed by the traditional concepts of trade marks. Likewise, well-known marks could be abused on the Internet/digital media.

Moreover, multilingual application in the electronic media emerged as a result of contribution made to the field by countries such as China, Korea, Malaysia, and India.¹⁸ Thus, it is obvious that the same problems discussed above would necessarily become the subject matter of the debate under the umbrella of multilingual application in the Internet. For instance multilingual issues of meta tags.

Issues concerning the applicable law and jurisdiction applicable to intellectual property transaction and enforcement of rights also present an unresolved problem in the development of the information age.¹⁹

Protection against unfair competition in relation to intellectual property rights is another important issue to be considered. Notwithstanding the Paris Convention for the Protection of Industrial Property 1883 (hereinafter 'Paris Convention') and TRIPS deal with the matter, its application to the digital environment poses a number of questions. Domain names and parallel imports raise other problems yet to be solved. All the above questions raise a very fundamental question of a proper legal and theoretical framework for better protection of Intellectual property in the field of computer-mediated environment.

The significance of the foregoing discussion lies in the fact that the digital environment has created many problems especially in relation to protection of intellectual property rights and in the field of commerce in general. This reveals the importance of having an intellectual property law system in any given country that is capable of addressing these

¹⁸ Sri Lanka has also launched a programme to introduce "Sinhala" language (the country's main language) to computer applications to set off over 270 languages used with computers all over the world. Daily News on 18.11.2002 at <http://www.dailynews.lk/2002/11/18/new12.html> (Accessed: 01.12.2004).

¹⁹ Generally, J.A.L Sterling, *World Copyright Law 2nd* (edn) (London: Sweet & Maxwell, 2003).

issues in order to protect intellectual labour of human beings. Sri Lanka is not an exception to this phenomenon.

The Sri Lankan intellectual property law regime had been governed by the Code of Intellectual Property Act, No.52 of 1979,²⁰ which was significantly influenced by the WIPO Model Law for developing countries. The declared policy and rationale underlying the introduction of the Code was to give effective expression to the moral and economic rights of creators to their intellectual creations. Likewise to promote the creativeness of the people and dissemination and application of such creations for the benefit of both creator and the nation while stimulating and promoting investment, transfer of technology and fair and competitive trade.²¹ The Code has governed the intellectual property law in the last twenty-four years. Although the subject matter of intellectual property was in the main stream of law, only a few cases have come to the court since 1979. Although a new law was passed in 2003,²² this scenario has not changed. This urges the importance of the consideration of the efficacy of the law.

Hence, the subtle question to be addressed at this juncture is one of the main themes of this study, to investigate the possibility of the response of the existing intellectual property laws of Sri Lanka to the above mentioned digital environmental issues or to investigate if Sri Lanka needs a new legislation?

Ironically, while overcoming those issues raised in the digital media over the globe, Sri Lankan intellectual property laws have to also overcome many other hurdles, which are rooted in the system itself as veiled inhibitory factors to the development of intellectual property jurisprudence in the country. A brief examination of these veiled and interconnected factors, which are associated with the social, political, economical, and cultural conditions throughout the legal history of Sri Lanka, is warranted for a better understanding of the peculiar situation of the country on which this study is based.

1.2.1 Academic writings

The first and most important impediment to the development of intellectual property jurisprudence in Sri Lanka is the lacuna of literature. It is unnecessary to emphasise the importance of having a rich academic literature on the subject, which leads to enhanced jurisprudence of the relevant subject, in the long term, of any given country. Intellectual

²⁰ Previous legislations in relation to Patent, Copyright, and Trade Marks etc. were abolished by this Code.

²¹ Hansard Records of the Parliament of Sri Lanka on 19.06.1997, p.252.

²² Intellectual Property Act, No.36 of 2003.

property in developing countries has been the subject matter of many scholarly debates.²³ Paradoxically, there is little academic writing on the intellectual property rights in Sri Lanka. A few studies have been undertaken often aimed at gaining academic qualifications.²⁴ Nevertheless, hardly any attempts have been made to study, as a piece, to understand the intellectual property in Sri Lanka by seeking the possibilities to introduce a system where social values have impacted the law. New researchers also find difficulties in entering this section, given the fact that the area is not well established.

1.2.2 Specialist judiciary

Lack of academic writings and dialogues are interconnected with the second problem to be addressed, which is lack of knowledge of Sri Lankan judiciary on the subject matter. It is viewed that the informed judiciary is not independent of legal education and legal writings of a given country. Obviously, there has been a continuous interplay between the two as one shapes, and is shaped by the other in any given country. Hence, the phenomenon has to be studied by locating it in the wider socio-political ramification.

Admittedly, legal education of any given country is one of the moulding machinery of legal thought in that country. In Sri Lanka, as well, the system of teaching in the legal field has played a vital role and greatly influenced the shaping of the scope and the ambit of the property jurisprudence in the country. As will be seen the way that the judges and other legal personnel understand the notion of property and especially intellectual property jurisprudence heavily influences the decisions delivered in courts and consequently affect the development the jurisprudence of intellectual property law in Sri Lanka. The Supreme Court of Sri Lanka was established in 1799 and authorised Supreme Court to admit advocates.²⁵ Paradoxically, there was no proper teaching system

²³ E.g. Jayashree Watal, 'Implementing the TRIPS Agreement on Patents: Optimal Legislative Strategies for Developing Countries', in *Competitive Strategies for the Protection of Intellectual Property*, ed. by Owen Lippert, (Canada: The Fraser Institute, 1999), pp. 105-23, Christopher Heath, and Anselm Kamperman Sanders, *Intellectual Property in the Digital Age, Challenge for Asia* (Netherlands: Kluwer Law International, 2001), Jayashree Watal, *Intellectual Property Rights in the WTO and Developing Countries* (Netherlands: Kluwer Law International, 2001) survey much of the literature listed in the bibliography to this thesis. None refers to Sri Lanka.

²⁴ E.g. Mahinda Ralapanawe, *Decided Copyright Cases in Sri Lanka* (Sri Lanka: Saman & Madara Publishers, 1988), G.L. Peiris, *Background Reading Material on the Intellectual Property System of Sri Lanka* (Geneva: World Intellectual Property Organisation, 1991), D.M. Karunaratna, *A Guide to Law of Trade Marks and Service Marks in Sri Lanka* (Colombo: Vishva Lekha, 1997), I. N. Abeysekere, Copyright Law Sri Lanka, 28 *IIC* (1998), 27, I. N. Abeysekere, *Sri Lankan Copyright and the TRIPS Agreement* (Colombo: Mahapola Higher Education Scholarship Trust Fund, 1999), B.V. Mirando, *Critical Analysis of the Trade Marks under the Code of Intellectual Property Act, No.52 of 1979* (Colombo: Vijitha Yapa Publications, 1999).

²⁵ Historically speaking, during the British regime, the Supreme Court was established in the island by the Proclamation of 14.12.1799. With the establishment of the Supreme Court, the legal profession

of law until 1911 irrespective of the fact that the Council of Legal Education was established in 1900.²⁶ In 1911 Ceylon Law College, the first institution of the island to teach law was established. However, up to now the Law College has not offered a course on intellectual property law to their students. Nevertheless, in the year 2000, Law College started a course leading to a diploma in intellectual property law. This was meant only for qualified legal practitioners.

At present there are two universities in Sri Lanka, which offer courses leading to the Degree of Bachelor of Laws (LL.B), namely the University of Colombo and the Open University of Sri Lanka. Though the University of Colombo (formerly University of Ceylon) started a course leading to the LL.B in 1947, it did not offer any course in relation to intellectual property law, irrespective of the fact that intellectual property has been in the main stream of law since 1859.²⁷ However, it is remarkable that the University of Colombo commenced a course on intellectual property law in 2000 the first time in the history of legal education in Sri Lanka. The results are yet to be assessed.

The Open University of Sri Lanka was established in 1980²⁸ and this University recognised the necessity of offering legal education and thus started a course leading to the Degree of Bachelor of Laws (LL.B) in 1985. The important fact is that a considerable number of judges and lawyers are enrolled every year by the Open University to gain higher academic qualifications. However, the Open University, *where this researcher comes from* has failed to offer any courses on intellectual property law up until now due to the dearth of qualified academics in the subject area. The Open University, unlike the University of Colombo, caters to the academically needs of laypersons and legal professionals alike. Hence, the present situation would seem a great impediment to the enhancement of intellectual property knowledge of legal professionals in the country.

also emerged. The Charter of Justices, 1801, authorized the Supreme Court to admit and enrol Advocates and Proctors, (the name was changed to Attorney-at-Law by the Administration of Justice Law, No.44 of 1973) and make rules regulating their admission. The Charter of 1833 re-enacted the power given to the Supreme Court in order to admit person as legal practitioners in the Supreme Court. At the same time, it has given the power to the Supreme Court to admit legal practitioners in the newly created District Court.

²⁶ Council of Legal Education Ordinance, No.2 of 1900.

²⁷ In 1859, the first Intellectual Property laws in the island was promulgated. That was the Exclusive Privileges to Inventors Ordinance, No.06 of 1859.

²⁸ The Open University of Sri Lanka (OUSL) was established under the University Act, No.16 of 1978 and OUSL Order, No.1 of 1989.

The significance of the above discussion raises a basic but subtle question as to how the intellectual property jurisprudence in the country survived up to the present moment without a specialised legal education on the subject until 2000.²⁹

As noted,³⁰ in theory, lack of specialist knowledge of judiciary, coupled with the lack of legal writings directly affected judicial decisions. In reality, most of the judges in first instance courts, and higher courts as well do not possess in-depth legal knowledge on intellectual property law because of the reasons mentioned above.³¹ Consequently, it is submitted with due respect that some of the available reported judgments in Sri Lanka, in relation to intellectual property law, do not necessarily reflect the correct view of the law due to this lack of specialist knowledge of the subject. Obviously, this inhibits the development of intellectual property jurisprudence in the country.³²

This situation is evidenced by the decision of *Stassen Exports Ltd. and Others vs. M.S.Hebtulabhoy & Co. Ltd.*³³ The issue in this case was whether the application of a trade mark in Sri Lanka to goods that were meant for export constitutes an act of use of the mark. While interpreting sec.117³⁴ the Supreme Court of Sri Lanka held that such application did not amount to an infringement. Since there is no higher court above the Supreme Court in Sri Lanka the legislature took an action in the year 2000 to amend the then existing trade mark law in order to protect the rights of the parties in future litigation. By introducing the Bill to amend the law, the Minister of Trade stated that:

The protection of trade mark rights is a mandatory requirement in the promotion of trade and commerce....the present law is silent on the application of a mark by an unauthorised person in Sri Lanka to the goods to be exported from Sri Lanka. This situation has led the Supreme Court to hold the application of a mark in Sri Lanka to the goods meant for exports does not constitute an act of use of the mark and therefore an act of infringement of trade mark rights.... This situation is not only contrary to the basic norms of trade marks law and trade marks rights but also dangerously harmful to the fair and competitive trade specially in the area of Ceylon tea.³⁵

²⁹ According to records as on 01.12.2004, 15,844 Attorneys have taken oaths and have been admitted to the profession in Sri Lanka. (Source: Attorney Registry at the office of the Registrar of the Supreme Court of Sri Lanka). However, it is not to forget that there were and are very few foreign qualified lawyers on the subject among them.

³⁰ Para 1.2.1

³¹ Mr. Dhammiaka Hemapala, one of the Magistrates in Sri Lanka was interviewed by the researcher on 25.09.2002.

³² Although the Sri Lankan judiciary look to other jurisdictions until now no significant impact has been demonstrated.

³³ SC.Appeal No.20/89.

³⁴ Sec.117(1) of the Code of Intellectual Property Act, No.52 of 1979.

³⁵ Hansard Reports of the Parliament of Sri Lanka on 20.06.2000, p.1315.

1.2.3 Availability of cases

Lack of judgments of competent courts is the third inhibiting factor to the development of intellectual jurisprudence in Sri Lanka. Under the doctrine of judicial precedence (*stare decisis*), as it applies in Sri Lanka, the lower courts are bound to follow the decisions of the higher courts on similar matters. The court structure in Sri Lanka and the jurisdiction assigned to them in relation to intellectual property matters, it is submitted, indirectly inhibits the development of intellectual property jurisprudence because all of the cases are adjudicated by the non-recorded courts of the country. Consequently, this practice creates a situation where cases are unavailable for reference. The hierarchical order of the court system is shown in diagram 1 below.

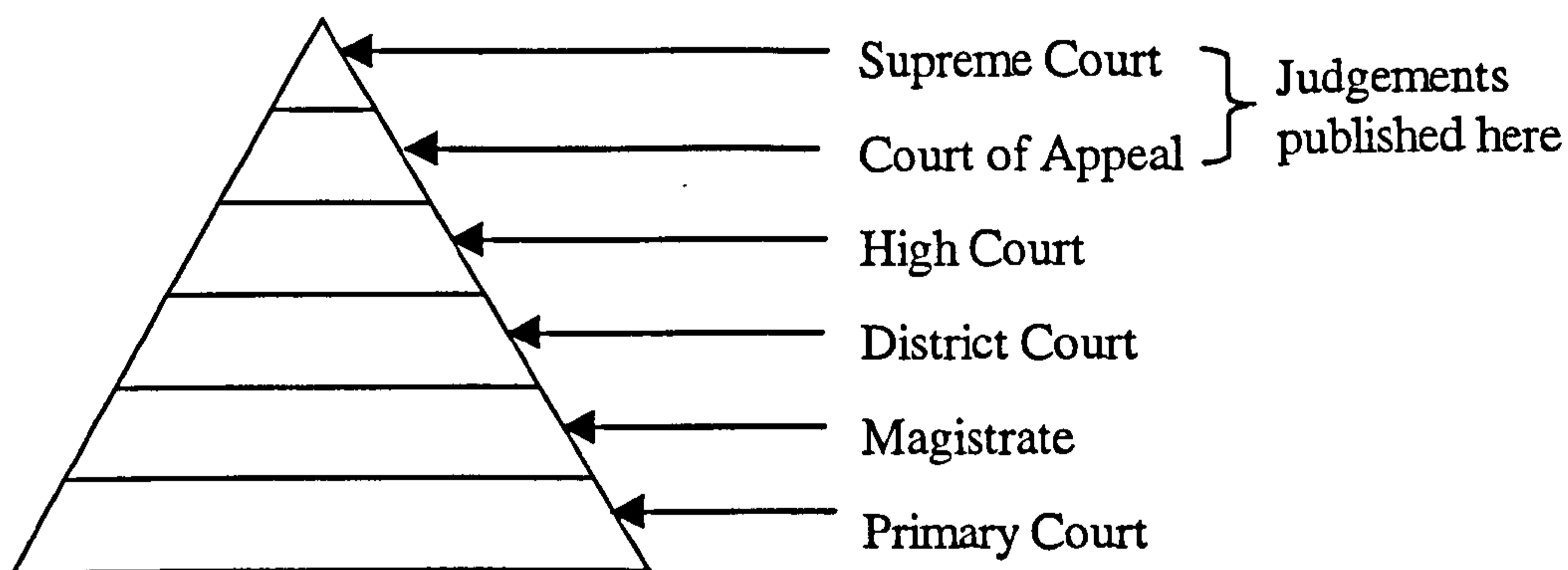


Diagram One- The Hierarchy of the Courts

Until the new law came into force in 2003, the jurisdiction over intellectual property matters, in first instance, was vested with the Magistrate Courts and the District Courts³⁶ and appellate jurisdiction was with the Provincial High Court in Colombo.³⁷ Nevertheless, according to sec.205 of the Intellectual Property Act, No.36 of 2003 the power of first instance is vested in the Provincial High Court,³⁸ with a right to appeal to the Court of Appeal and the Supreme Court has final jurisdiction over the appeals.

At present, infringement cases and appeal against the decision of the Director-General of Intellectual Property are brought to the High Court. However, it is submitted that, these judgments do not support the development of intellectual property jurisprudence of the

³⁶ There are 22 districts in Sri Lanka and each of them has a District Court except Colombo District, which has two District Courts. Every district has two or more Magistrate Courts depending on the population, size of geographical area etc.

³⁷ High Court of the Provinces (Special Provisions) Act, No.10 of 1996.

³⁸ Nevertheless, Magistrate Courts have power in few instances: sec.157, 160(8)(a), 177-79, 180(1), 181, 182(1), 183, 184, 185, 186(1) and (2), 192(1)(a), (b), (c).

country due to two reasons: First, these courts are not courts of record. Secondly, the decisions of courts are not considered as decision of higher courts for the application of the concept of judicial precedence (*stare decisis*). Thus, the only available decisions/resources for any further research are those of the Court of Appeal and the Supreme Court since those courts are Courts of Record.

Moreover, under the new law extra judicial procedure is established to address infringement of rights. For instance, procedure for administrative determination by the Director General under of intellectual property Part XXXV and sec.22(2)(f). Though these provisions are intended for industrial property disputes, they also apply to copyrightable subject matters. This is unfavourable since the aggrieved person has to come to Colombo where the Director General hears the case. One would hope that the Director General would hear cases or recommend their transfer to appropriate Provincial High Courts. This would lead to unnecessary delay of remedy, an extra cost for aggrieved party and also inhibit the development of case law of the country. Therefore, it is submitted that the existing administrative and judiciary practice in Sri Lanka directly inhibit the development of intellectual property law jurisprudence in the country.

1.2.4 Needs and the values of the society

Local values, which would have to be considered in the process of application of law, are overlooked in intellectual property litigation.³⁹ It is obvious that religion plays an indispensable role in the society, building and moulding the values of that society.⁴⁰ Buddhism, as a religion, has greatly influenced Sri Lankan society since the introduction of Buddhism to the country in the 3rd Century BC.⁴¹ Consequently, Buddhism has been given protection not only by the Kings in the pre-colonial era in the country but also by the government during the British rule in Sri Lanka.⁴² This was extended to Constitutional guarantee after independence.

³⁹ This will be discussed in detail wherever appropriate in this study.

⁴⁰ Generally, K.M. De Silva, *A History of Sri Lanka* (Delhi: Oxford University Press, 1981).

⁴¹ De Silva, *supra* n.40.

⁴² On 02.03.1815, the Kandyan Convention was signed between Robert Brownrigg, the Governor and Commander in Chief of Ceylon, and the Adigars, Dissawes and the other principal chiefs of the Kandyan Provinces on behalf of the inhabitants. It was declared under Clause 5 of this Convention that "the religion of Boodhood, professed by the chiefs and inhabitants of these provinces, is declared inviolable and its rights, ministers, and places of worship are to be maintained and protected." Legislative Enactments of Sri Lanka, Ch.637.

Although the first independent Constitution of the country⁴³ did not categorically mention Buddhism, the first Republican Constitution made provisions for the protection of Buddhism by the State.⁴⁴ Furthermore, Buddhism is given foremost place under the present Constitution of Sri Lanka (1978), which declares that it is the duty of the government to foster and protect Buddhism. Thus, Art.9 of the Constitution of Sri Lanka states that

The Republic of 'Sri Lanka shall give to Buddhism the foremost place and accordingly it shall be the duty of the State to protect and foster the Buddha Sasana while assuring to all religions the rights granted by Art.10 and 14(1)(e).⁴⁵

This position of Buddhism is upheld by the Supreme Court of Sri Lanka in many instances.⁴⁶

Furthermore, Constitutional provisions relating to Directive Principles of State Policy and Fundamental Duties provides that it is the duty of the state to establish a just, equitable, and moral social order and among other things, raise the moral standard of the people.⁴⁷ Thus, it is necessary to consider this constitutional duty while executing the duties of the state including codification, promulgation, and implementation of laws.

More significantly, Art.83(a) of the Constitution of Sri Lanka gives, among other things, further constitutional protection to Buddhism. Accordingly, the Article provides that a bill for the amendment or for the repeal and replacement of or which is inconsistent with any of the provisions, including Art.9 shall become law if the number of votes cast in favour thereof, amounts to not less than two-thirds of whole number of Members (including those not present), is *approved by the People at a Referendum* and a certificate endorsed thereon by the President in accordance with Art.80 (Emphasis

⁴³ The first independent Constitution of Sri Lanka (the then Ceylon) is the Ceylon (Constitution and Independence) Orders in Council - (Solbury Constitution) came in to force in 1948.

⁴⁴ Art.6 of the 1972 Constitution stated that "The Republic of Sri Lanka shall give to Buddhism the foremost place and accordingly it shall be the duty of the state to protect and foster Buddhism while assuring to all religions the rights granted by sec.18(1)(d)."

⁴⁵ Art.10 deals with the freedom of thoughts and consciousness and Art.14(e) deals with the freedom to profess of religion.

⁴⁶ The judgment regarding constitutionality of Bill to incorporate a Christian Missionary in Sri Lanka on Daily News on 04.03.2003 at <http://dailynews.lk/2003/03/04/new26.html> (Accessed: 01.12.2004). The government is planning to table in parliament three new bills on Prevention of unethical conversions, the introduction of Sangādikaranaya (judiciary) for monks and the Buddhist Chapter Convention. Colombo Page on 02.06.2003 at <http://www.colombopage.com/archive/June2141657UN.html> (Accessed: 08.06.2003). However, this does not mean that there is no religious tolerance in Sri Lanka, but the objective of these laws is to prohibit conversion of adherent to the religion by manipulating of peoples' economic disadvantages.

⁴⁷ Art.27(2)(g) of the Constitution of Sri Lanka.

added). Accordingly, a State, which constitutionally pledges to uphold the culture of Buddhism, cannot neglect the primary aspects of Buddhism while promulgating and enforcing laws.

Furthermore, it is obvious that law and morality are connected.⁴⁸ There is no exception for intellectual property laws from this phenomenon since intellectual property law is located within and not outside the public ethics of community values. International Conventions and treaties pertaining to intellectual property refer to morality and public order in the fields of copyright, trademarks, patent, and design laws.⁴⁹ Sri Lankan legislation on the subject also reflects the same. Accordingly, the Code explicitly requires decision-makers to consider moral standards as part of the process of deciding whether to grant protection.⁵⁰

The significance of the above passages lies in the presumption that each law, which has already been passed by the Parliament of Sri Lanka, has satisfied the test of the constitutional obligations. That is to say, all legislation have passed the test of compliance with morality of the country. Accordingly, the logical conclusion would be that the relevance of morality, especially that derived from Buddhism, cannot be overlooked or dismissed lightly by the courts under any circumstances. Thus, the aspect of morality must be given serious consideration in the process of legal decision-making.

However, as will be seen from an examination of decided cases, it is questionable as to whether the court of Sri Lanka has used the moral standards in the process of interpretation of intellectual property legislation, especially where there is an infringement of rights. It is submitted that, the Courts have been neglecting their constitutional obligation and thereby ignoring their Constitutional duty while delivering

⁴⁸ Generally, H.L.A. Hart, *Law, Liberty, and Morality* (Oxford: Oxford University Press, 1963), Joseph. Raz, *The Authority of Law: Essays on Law and Morality* (Oxford: Clarendon Press, 1979).

⁴⁹ Obviously immoral or scandalous work is not protected under copyright laws. Thus Art.17 of the Berne Convention reserved the right of individual countries to self regulate any works though nowhere in the Convention does it define the circumstances where such exercise can be undertaken. This is affirmed by Art.9 of the TRIPs as well. Art.6^{quinquies}(B)1 of the Paris Convention which states that trade marks registration can be denied when they are contrary to morality or public order. Art.15(2) of the TRIPs affirms this position. cf. Para 3.7(2)(a) and Para 4.11.

⁵⁰ Sec.29(b) of the Intellectual Property Act, No.36 of 2003, which states that protection of industrial design shall not apply to an industrial design, which, consists of any scandalous design or is contrary to morality or public order. Section 79 of 2003 Act provides ground for refusal of grant of patent where the performance of act in respect of claimed invention would be contrary to the public order and sec.103 makes ground for not to register a mark, which is contrary to morality or public order.

judgement in relation to intellectual property matters.⁵¹ Had the courts applied the concept of morality derived from Buddhism and strongly rooted in the customs of the country and commonly used in other areas of law, the present intellectual property jurisprudence would have developed to the extent that it could be applied to novel issues that emerge from time to time.

1.2.5 Recourse to other jurisdiction or principle of law

It is obvious that in order for the law of the land to be effective and to be meaningful it must reflect the religious, cultural, and social values of that country. Laws that fail to satisfy these local requirements are bound to be ineffective. Therefore, courts must consider the country's broader historical, political, cultural, economic, and religious setting while interpreting laws introduced by foreigners or originating in foreign soil in order to minimise the non-compliance of that with local needs. However, the decided cases available in Sri Lanka do not reveal the fact that courts have ever considered local social, cultural, or economic aspects in the process of delivering justice. The statement below by the Parliament of Sri Lanka gives evidence to this.

Our country has never had a copyright ordinance until this was introduced. Until now, it was 99 percent based on English law...The English law of 1911 applied to Sri Lanka and we have carried on with that. That is, their interests were accepted here- all their English copyrights and their right to use this country as a part of England as far as the copyrights law in England was concerned.⁵²

Until the promulgation of the present intellectual property laws in Sri Lanka in 1979, the subject had been governed by mere reproductions of English laws or slight modifications of them. Therefore, the Sri Lankan judiciary depends upon interpretations of English Courts while delivering justice thereby neglecting the local interests and needs. It is submitted that, Sri Lankan Courts could have also considered some other close jurisdictions such as India but failed to take advantage of such valuable source of guidance. Paradoxically, the state of affairs has not changed even after the present legislation came in to force. This approach of the courts indirectly inhibited the development of intellectual property jurisprudence in Sri Lanka.

⁵¹ The judges in the Court of law have to take an oath to uphold and defend the Constitution before they assume duties as judge. Art.107 of the Constitution.

⁵² Hon. Minister of Trade. Hansard Reports of the Parliament of Sri Lanka on 25.05.1979.

However, an attempt had been made under previous law to change this trend by the Supreme Court of Sri Lanka. In *James Finlay and Company Ltd. vs. Stassen Exports Ltd. and another*,⁵³ the Supreme Court held that:

It would seem on an examination of the scheme of the Act in the light of the above said preamble, that there is no need for us to conclude that English Law principles were introduced to Sri Lanka through the Code of Intellectual Property Act...The Act must be viewed as it is and any attempt to read into its provisions, principles and traditions peculiar to English Law might do harm to the Act.

While commending this trend, it should be noted that, had the Court taken this approach in the past, Sri Lanka's intellectual property jurisprudence would have developed beyond its present status. Thus, it is necessary to consider local factors, including social, and the development of intellectual property jurisprudence in other jurisdictions in order to create a balanced intellectual property system in Sri Lanka.

1.2.6 International treaty obligations

Sri Lanka is a party to many international treaties/conventions on intellectual property.⁵⁴ Though Sri Lankan intellectual property laws are fundamentally similar to those of other nations, they do not reflect the influence of international treaties to which the country is a party. To understand the domestic effect of treaties in Sri Lanka it is necessary to look into the legal provisions of the Constitution.

Under the first independent Constitution of Sri Lanka, the approach in relation to the applicability of international treaty based law to domestic law was similar to that of the United Kingdom. Art.45 of the Order in Council (1946) provides that the executive power of the land shall continue to vest in His Majesty and the power may be exercised on behalf of His Majesty by the Governor-General in accordance with the provisions of the Order and of any other law for the time being in force. Furthermore, Art.4(2) provides that

⁵³ (2001) 3 Sri.L.R.334.

⁵⁴ As for 01.12.2004 Sri Lanka is a party to the following treaties and conventions: Paris Convention for the protection of Industrial Property-since December 1952, Berne Convention for the Protection of literary and Artistic Works-since July 1959, Patent Co-operation Treaty- since Feb.1982, Madrid Agreement for the Repression of False or Deceptive Indication of Source on Goods -since December 1952, The Convention Establishing the WIPO -since September 1979, The Patent Cooperation Treaty -since Feb.1982, The Universal Copyright Convention- since Oct.1983, The Nairobi Treaty for the Protection of Olympic Symbol -since Feb.1984, Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)-since Jan.1995, Trade Mark Law Treaty-since Aug.1996. All major conventions relating to "classification" are followed, even though Sri Lanka has not signed them. However, legislative changes in Sri Lanka do not seem correlate with treaty accessions.

All powers, authorities and functions vested in His Majesty or the Governor General shall, subject to the provisions of the Order and of any other law for the time being in force, exercised as far as may be, in accordance with the constitutional conventions applicable to the exercise of similar powers, authorities and functions in the United Kingdom by His Majesty.

Thus, it is clear from these provisions that the position of Sri Lanka and United Kingdom in relation to the application of international treaty based law in to domestic law had been the same. Since there is no treaty-making procedure or powers categorically set forth in the First Republican Constitution⁵⁵ or in the present Sri Lankan Constitution, (1978) reasonable doubt arises as to whether Sri Lanka adheres to a monism or dualism system.⁵⁶

The law regarding the application of treaties to domestic law in Sri Lanka is complex in nature. In practice, Sri Lanka seems to adopt the concept of dualism or transformation theory of reception. Pursuant to this theory, an international convention or treaty is of no force or effect within the national legal system unless and until its terms are transformed into domestic law in the form of legislation. Accordingly, treaties are valid in the domestic law only to the extent that Acts of Parliament incorporate them. This necessarily implies that mere ratification of a treaty does not give effect to the treaty in domestic law.⁵⁷ It gives only a moral obligation.

In *Bulankulama and Others v Secretary, Ministry of Industrial Development and Others (Eppawala case)*⁵⁸ Amarasinghe J has made a very important dictum on the issue, ignoring the previous judicial decisions. He said:

... the proposed agreement must be considered in the light of the foregoing principles. Admittedly, the principles set out in the Stockholm and Rio de

⁵⁵ The First Republican Constitution came to force in 1972.

⁵⁶ Art.157 of the Constitution (1978) states that such treaties cannot be contravened by domestic legislative, executive, or administrative actions. This further demonstrates that bilateral investment treaties occupy a position superior to that of Acts of Parliament. Further C. Mathews, "The Constitutional Power of the President to Conclude International Agreements," (1955) *Yale L.J.* 345.

⁵⁷ In *M.R.Leelawathie v. The Minister of Defense and External Affairs* (1965)65 N.L.R.487 the head note says, "If a spouse's application for registration as a citizen of Ceylon in terms of Sec.12 of the Citizenship Act is refused by the Minister, it is not necessary for the Minister to give his reasons for the refusal. Subsection 4 and 6 of sec.12 make the Minister sole and final judge of the merits of the application. In such a case, the Universal Declaration of Human Rights has no binding force." In the same case, Sansoni J has observed in p.487 "Lastly, it was submitted that the refusal was breach of the Universal Declaration of Human Rights. Even if the principles contained in the instrument have any relevance, it is sufficient to say that while it is of the highest moral authority, it has no binding force as it is not a legal instrument and forms no part of the law of this country." (emphasis added) Also *Ekanayaka v Attorney General* (1987)1SLLR.106 (A/C), (1988)1SLLR 46 (S/C) and also Eric Jenson, *Introduction to International Law in Sri Lanka* (Colombo: The Open University of Sri Lanka, 1989),49.

⁵⁸ (2000) 3 SLLR.243 at pp.274-275.

Janeiro Declarations are not legally binding in the way in which an Act of our Parliament would be. It may be regarded merely as 'soft law.' Nevertheless, as a member of the United Nations, they could hardly be ignored by Sri Lanka. Moreover, they would, in my view, be binding if they have been either *expressly enacted or become a part of the domestic law by adoption by the superior Courts of record and by the Supreme Court in particular, in their decisions* (emphasis added).⁵⁹

Therefore, it is obvious that a Sri Lankan cannot normally invoke an international treaty on intellectual property to pursue an action for infringement of intellectual property in a domestic court. Thus, as mentioned above domestic legislation is required in order to give effect to a treaty. Although Sri Lanka is a party to many major treaties on intellectual property protection, until now no legislation has been passed to give effect to those treaties. Consequently, the subtle question arises in this juncture as to whether the effect of international treaties in relation to the protection of intellectual property to which Sri Lanka is a party and as to whether it is possible for the Sri Lankan judiciary to seek guidance from those treaties to interpret local legislation as envisaged in *Bulankulama* case.

1.2.7 Bilateral investment treaties

Admittedly, bilateral investment treaties and intellectual property system of a given country have a strong connection with each other. Sri Lanka is not an exception. In theory, Sri Lankan constitutional principles recognise two different types of approach in relation to international agreements i.e. one approach is for the international treaties in general and another for bilateral investment treaties. An important fact is that bilateral investment treaties seem to occupy a higher position in the Constitution than other bilateral treaties. Art.156 of the Constitution of Sri Lanka empowers the President to enter in to bilateral investment treaties. It seems that the President of Sri Lanka has the power to enter into investment treaties without previous authorisation of the legislature.⁶⁰ In terms of Art.157 of the Constitution, such treaties cannot be contravened by domestic legislative, executive, or administrative action. Hence, it seems that bilateral investment treaties occupy a position superior than that of an Act of the parliament in Sri Lanka. It is therefore, obvious that intellectual property protection could be strengthened through these treaties by including necessary measures as those treaties have given a prominent status within the constitutional framework.

⁵⁹ cf. *Azrak-Hamway International Inc's Licence of Right* [1997] R.P.C 134 for UK Position.

Sri Lanka has made many attempts to enhance its economic stability. An important effort in this direction is entering into bilateral treaties with other developed and developing countries. Though the main goal of these agreements is to promote investments and thereby facilitate development, many bilateral investment treaties have not made provisions for the protection of intellectual property rights.⁶¹ Had those bilateral investment treaties made provisions for the protection of intellectual property rights it would have become one of the major influences in the development of intellectual property jurisprudence in the country.

Ironically, as has been seen previously in this Chapter, it is clear that the provisions of an international treaty or even a bilateral treaty do not become part of the domestic law unless there is specific legislation or (possibly) judicial adoption. Thus, it would seem that the protection of intellectual property could not be enforced by only being a party to bilateral treaties unless those provisions were incorporated into national law by domestic legislation. Thus, now a subtle question arises as to whether the efficacy of all those treaties made by the government of Sri Lanka throughout history was with a view to promote the economic development in Sri Lanka.⁶²

1.2.8 Awareness and understanding of the society

A lack of understanding of the basic norms of intellectual property by the people is another contributing factor for the existing state of affairs. One of the reasons would be the transplantation of the English laws without considering Sri Lanka's non-legal factors, such as social, cultural, and religious values, as well as corresponding economic and political factors. Obviously, laws that do not satisfy these are bound to seem ineffective.

⁶⁰ Art.157 of the constitution states that "*treaties essential for the development of the national economy*" (emphasis added) shall be passed by two-thirds majority in the Parliament and shall have the force of law in Sri Lanka.

⁶¹ However, few treaties make provision for the protection of intellectual property. For instance, Art.1 of the agreements between Sri Lanka and Japan and between Sri Lanka and the Republic of Finland defined the term investments including trade names/business names among other things, while Finland-Sri Lanka agreement includes goodwill as well. Furthermore, the agreement between Sri Lanka and Italy includes trade names in the definition of investment while the agreement between United State of America and Sri Lanka includes literary and artistic works including sound recording, industrial design, semiconductor mask works, trade secrets, confidential business information, and service marks. The agreement between Sri Lanka and Arab Republic of Egypt includes trade juridical rights in the definition of investments. However, most of those bilateral investment treaties do not provide protection for Intellectual property rights.

⁶² Also Amanda Perry, 'An ideal legal system for attracting foreign direct investment? Some theory and reality', 15 *Am.U.Int'l L.Rev.*(2000),1627.

However, irrespective of the fact that the literacy rate of the country is 92%, the awareness of intellectual property law amongst the people is very low.⁶³ This was evidenced by the speech of the then Minister of Trade and Shipping Hon. Lalith Athulathmudali while introducing the 'Code of Intellectual Property Bill' in May 1979.⁶⁴

The Bill is not something that is widely understood, naturally, because it is really a specialist's field: but it really is revolutionary in terms of this particular class of property so necessary for the commercial development of Sri Lanka.⁶⁵

Moreover, until now intellectual property legislation has not been translated into the official languages of Sri Lanka (Sinhala and Tamil), which indirectly inhibits access to knowledge by the majority of the country.

As a result of this lack of awareness and understanding, the country's intellectual property law is being infringed despite there being an Act in force, which provides protection for the main areas of intellectual property such as copyright and trade marks. One finds numerous infringements of copyrights. An example is "Photocopy shops" accepting whole books for photocopying without question. This happens not only in front of Universities but also within University premises.⁶⁶

Furthermore, copies of popular audiocassettes and videocassette can be purchased for half of the original price. One can get any song copied to audiocassette from mushroomed "Record Bars." Copies of original Compact Discs (CD) or Video Compact Discs (VCD) and other optical media are openly available and a customer can get it done while he or she is in the shop.⁶⁷ In most areas of the country, it is difficult to find retail shops that sell legitimate copies of CD, VCD, or computer software. Computers are sold with all software installed, usually pirated. One can get Microsoft Windows applications, costing more than US\$ 350, for as little as 75 US cents with a "genuine" serial number.⁶⁸

⁶³ Country profile at <http://www.cia.gov/cia/publications/factbook/geos/ce.html> (Accessed: 01.12.2004).

⁶⁴ This is the present law governing the subject of intellectual property in Sri Lanka.

⁶⁵ Hansard Reports, Parliament Debates, 25.05.1979, p.507.

⁶⁶ cf. Australian case: *University of New South Wales v. Moorehouse and Angus & Robertson (Publishers) Pty. Ltd.* (1975), 49 A.L.J.R.267 which held that a university library was liable for "authorizing" copyright infringement by providing photocopying machines with limited efforts to restrict the equipment to lawful copying. Also Canadian case: *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339, 2004 SCC.13 which held that Law Society does not authorize copyright infringement by maintaining a photocopier in the Great Library and posting a notice warning that it will not be responsible for any copies made in infringement of copyright.

⁶⁷ There are many incidents of producing of counterfeit CDs and DVD of leading artistes both local and foreign. E.g. <http://www.dailynews.lk/2003/01/29/new11.html> and <http://www.dailynews.lk/2004/10/11/new22.html> (Accessed: 01.12.2004).

⁶⁸ http://www.ptd.net/webnews/wed/bg/Qsrilanka-piracy.R2kJ_DJJ.html (Accessed: 20.01.2003).

Although Sri Lanka is not known for producing pirated works, it is a big market for imports from India, Pakistan, China, and Malaysia. Video rental outlets rent unauthorised copies of movies to their members. The situation is evidenced by the International Intellectual Property Alliance 2003 Special 301 Report on Global Copyright Protection and Enforcement ⁶⁹

Though a Performing Rights Society had been established in the early nineties, up to now nothing has been done for the protection of performing rights in the country. One can listen to a “reply song” (same tune of the original song but sung by an opposite sex singer of the original) within couple of days of a new song being released.

Cultural properties and common heritage of mankind are being exploited. For instance, ancient wall paintings and folklore are exploited in the market despite the provisions of the law.⁷⁰ The prevailing intellectual property laws in Sri Lanka are primarily concerned with protecting new and original creations, inventions and applications, except in the case of folklore, rather than those that already exist in the society. It does not provide protection for traditional knowledge. Consequently, many biological resources, including local knowledge of useful biological applications that the local community has known and used for ages, are being misappropriated. For instance, many of the country’s better-known agricultural tree crops have one or more wild relatives-but these are being pirated in the guise of “research materials.”⁷¹ Moreover, components of herbal plants, which are used to produce indigenous medicine under the Āyurvedic medical system⁷², are also pirated and patented.⁷³ Nevertheless, the concerned authorities such as Wildlife and

⁶⁹ Sri Lanka put in to watch list, http://www.iipa.com/special301_TOCs/2003_SPEC301_TOC.html (Accessed: 01.12.2004).

⁷⁰ According to sec.12 of the Code, the previous law, economic rights and moral rights of folklore shall be exercised by the Minister of Cultural Affairs. Nevertheless, practically this seems to be a myth. However, new law also provide no solution to this.

⁷¹ Senior custom officer of Sri Lanka Samantha Gunasekera said that the theft of Sri Lankan genetic resources has been worsened. He attributes this to loopholes in existing laws. Sri Lankan Page on 17.02.2003 at <http://www.lankapage.com/> (Accessed: 17.02.2003). Further, he stated that even local researchers were involved in the illegal export of herbal plants, timber and other rare flora and fauna species. He charged that politicians were protecting those responsible when they are brought before justice. Also, Tharika Goonathilake “Genetic piracy threatens ‘wild relatives’ of agri crops” Daily News on 20.02.2003 at <http://www.dailynews.lk/2003/02/20/new21.html> (Accessed: 01.12.2004).

⁷² Indigenous system of medicine.

⁷³ Tilaka Nawaratne, “Hela Osuwe Aythiya Es Wasa Ahimikarana Jagath Patent Kollaya, (Alienation of Rights of Sinhalese Medicine by International Patent Robbery),” *Subasetha* (Colombo), 11.10.2002: 8-9. By the time, a Japanese company has already patented traditional formulas, which used twelve herbal medicines, which were used by the people in Sri Lanka from ages. A person called Shyam Singh, an Indian, resided in Germany has also obtained a patent for a skin lotion made of special properties in *centella asiatica*. The name used in the application (*gotukola*) clearly shows that the recipe for the medicine was taken from traditional medicine system in Sri Lanka.

Customs are finger pointing at the lacuna of the Fauna and Flora Protection Ordinance⁷⁴ but not the actual piracy of genetic materials of the country. This is mainly due to lack of overall understanding of subject matters of intellectual property in Sri Lanka.

1.2.9 Enforcement authority such as Customs, Police

Lack of awareness of intellectual property is not confined to the public in general but to the government officials who are involved directly or indirectly in protection of intellectual property rights of the country. Under the new law, Sri Lankan custom officers have powers to prohibit importation and exportation of counterfeit trade mark goods, pirated copyright goods or other goods in contravention of the Act.⁷⁵ Nevertheless, many officials of the customs department do not have knowledge of current issues such as bio-piracy, intellectual property rights on indigenous technology/traditional knowledge.⁷⁶ Moreover, Police officers in Sri Lanka do not possess knowledge as to basic violations of intellectual property rights specially in the digital world.⁷⁷ The situation exacerbates since the present law emphasises infringement in physical world rather than digital.

1.2.10 Policy makers and the concerning authority

Fifty pieces of legislation had been introduced to govern intellectual property in Sri Lanka. Forty-five of them were introduced before the country's independence. There was no significant change from the date of independence⁷⁸ to 1979 when the Code had been passed, though the country had been party to major treaties on intellectual property during this period.⁷⁹

According to World Bank Press release on 19.12.1997, at least 189 of the 1,414 medicinal plants used in Sri Lanka are specific to the island-or geographically restricted to the Indian subcontinent-including 79 that are threatened with extinction (News Release No.98/1585SAS). A project called "Sri Lanka Conservation of Medicinal Plants Project" launched under the auspices of the World Bank. The project focuses on the long-term viability of Sri Lanka's medicinal plants by promoting the appropriate legal and regulatory framework through draft regulations to ensure the protection of Intellectual Property Rights. Ironically, this is yet to materialise.

⁷⁴ No.02 of 1937 as amended by the Act, No.49 of 1993.

⁷⁵ Ch.XLI of the Intellectual Property Act, No 36 of 2003. However, custom officers in Sri Lanka will generally not, as a practical matter, take the initiative to inspect goods believed to be counterfeit through the import and export process. This would happen only upon an application of a right holder.

⁷⁶ Personal communication with R.W.M.T.K.B.Rnatunge, a Senior Officer of the Dept of Customs in Sri Lanka on 12.10.2002.

⁷⁷ Personal communication with an Inspector of Police in Sri Lanka on 16.10.2002. Generally, Michael Blakeney (ed), *Border Control of Intellectual Property Rights* (London: Sweet & Maxwell, 2003).

⁷⁸ Sri Lanka became an independent country on 04.02.1948.

⁷⁹ Paris Convention December 1952, Berne Convention-since July 1959, Madrid Agreement-since December 1952.

Amendments had been made to the Code during last twenty-four years. Paradoxically, many of these amendments, except two, do not necessarily relate to substantive issues of intellectual property. The main objectives of these amendments were to change the designations of the officials to protect their bureaucracy or to appoint so-called advisory committee. As will be seen,⁸⁰ the situation has not changed since the promulgation of the new law in 2003 since the first matter addressed by the 2003 Act was the change of designation of Director to Director General and hence questionable whether this change would provide miraculous answer to those lacunae in the law.

On the other hand, although the government from time to time introduced piecemeal legislations such as Consumer Protection Act, No.1 of 1979,⁸¹ Unfair Contract Terms Act, No.26 of 1997,⁸² Prevention of Computer Crime Bill,⁸³ and Sri Lankan Inventors Incentive Act, No.53 of 1979⁸⁴ and established some authorities like Fair Trading Commission Act, No.1 of 1987⁸⁵, the Consumer Affairs Authority Act, No.09 of 2003, Information and Communication Technology Act, No.27 of 2003 none of these legislations deal with intellectual property aspects. Since these legislations had been made on pragmatic basis, they do not necessarily reflect the understanding of the subject by the policymakers in Sri Lanka. Therefore, there is an acute difficulty in discerning any coherent philosophy, which determines the future legislations.

The foregoing discussion clearly demonstrates that Sri Lanka's mission of the day is not only to overcome the above mentioned impediment factors to the development of intellectual property jurisprudence but also to address the emerging global issues in the field of intellectual property. Hence, it is the aim of this research to analyse and evaluate prevailing intellectual property legislation in Sri Lanka and suggest ways in which it can meet modern challenges while taking into consideration the rich cultural values of the society and institutions. Such an approach is necessarily an interdisciplinary effort. Accordingly, this study is not confined to an analysis of the existing state of affairs of intellectual property law of the country but endeavours to develop a coherent and logical conceptual framework from a Buddhist perspective, which has potential applicability in

⁸⁰ Ch.3 and 4.

⁸¹ This Act deals with the food adulteration and use of unauthorised colours etc and the power of the Officers.

⁸² This Act deals mainly with unfair terms in contract in relation to goods and services and adds some clarifications to standard forms of contracts etc.

⁸³ This is mainly dealt with situations like unauthorised access of computer etc. This is still a Bill.

⁸⁴ Under this act, a Commission was established "to encourage the making or creation of inventions by citizens of Sri Lanka."

the determination of the infringement of intellectual property right in whatever manner i.e. online or off-line transactions. Using the proposed framework, it may be possible for judges to apply existing laws to new situations and avoid the need for constant legislative change in an attempt to keep up with developments and comply with Sri Lanka's international obligations.

1.3 Objectives

Given the nature of the problem so far identified, the present research is aimed at accomplishing four main objectives:

- (i) as a preliminary matter to investigate how Sri Lankan legal system in relation to its intellectual property rights has developed to the present state,
- (ii) to analyse and evaluate as to what extent the prevailing intellectual property law in Sri Lanka may be applied to modern fact situations,
- (iii) to seek the possibilities, if any, to interpret, apply in a balanced manner and possibly to alter parameters, fill gaps in the law (rights and defences) in Sri Lanka by applying basic principles of Buddhism; and
- (iv) to propose a coherent and logical theoretical framework, while considering the technicality of the information society, which has led to the expansion of existing intellectual property laws in Sri Lanka and can be a hard testing ground for law and theory.

1.4 Significance

Sri Lanka is a multicultural, multi-religious, country where legal pluralism exists. Sri Lankan legal system is derived from many sources. The English Law and Roman Dutch Law have largely influenced it.⁸⁵ In Sri Lanka, Roman Dutch Law has been called as "Common Law"⁸⁷ as it is the residuary law applicable to all sections of the community,

⁸⁵ This Commission empowered to deal with price control and unfair trading including monopoly.

⁸⁶ Today Roman Dutch Law applies in the following areas: incidence of birth and parental power, capacity of minor to sell immovable property, law of delict in general, the delictual liability of a minor, guardianship, the capacity of a lunatic to enter into contract, intestate succession (if the statutory law is silent), quasi-contract, defamation, malicious prosecution, action for seduction, law relating to actions for damage done by animals, the law of maintenance, contractual remedy such as *restitutio in integrum*, transfer of movable property other than by sale, such as gifts, the concept of ownership and possession etc. Generally, H.W Tambiah, *Principles of Ceylon Law* (Colombo: Cave & Co., 1972).

⁸⁷ In *Karonchihamy v Angohamy* (1906) 8 N.L.R.1 at 8 Moncrief ACJ held that the Common Law of Ceylon is the Roman Dutch Law as prevailed in the Netherlands at the date of capitulation. The

which mainly governs the concept of property. Thus, it significantly differs from that of the English law. The term “common law” has been used in the present intellectual property laws in Sri Lanka until 2003.⁸⁸ Nevertheless, the applicability of “common law” has not been discussed in intellectual property litigations in the country. It is felt that it would be fruitful to examine whether there is a possibility to accommodate positive features of the “common law” within the ambit of intellectual property law in Sri Lanka. Hence, this study will open up a new arena for intellectual property jurisprudence in Sri Lanka.

As it is observed in this Chapter, dissemination of information via digital media is likely to be the natural phenomena in this century. Since Sri Lanka is a signatory to many international treaties, it has an obligation to implement proper legal structure to facilitate such transactions. This study will explore the possible framework for the better protection of intellectual property in Sri Lanka; hence, the outcome of this study will be a guideline to carry out those international treaty based obligations.

Furthermore, Sri Lanka as a developing country need not wait for the international legal order in relation to e-commerce and intellectual property protection in the digital era to be established, since the State has pledged to establish in Sri Lanka, a democratic socialist society, the objective of which include,

to promote the rapid development of the whole country by means of public and private economic activities and by *laws* (emphasis added) prescribing such planning and controls as may be expedient for directing and co-ordinating such public and private economic activities towards social objectives and the public wealth.⁸⁹

Hence, it is the duty of the State to carry out its constitutional obligations by achieving the above-mentioned objectives. The possible outcome of this study will give a

Roman Dutch law was described in *Sultan v Peiris* (1934) 35 N.L.R. at p.68 as the General Law or the ‘Common law’ of the Island. In *De Costa v Bank of Ceylon* (1970) 72 N.L.R. at p.519, Roman Dutch Law was described as the general or... residuary law of the Island. It is clear from the dictum of these cases, that the Roman Dutch Law became the general law of the Island, applicable to all its inhabitants in all matters upon which their personal laws were silent and in this sense, the reference was to the Common Law of the land and not Common Law of England. By the end of British rule, the Roman Dutch law represents the body of law as modified in many directions, both expressly and by necessary implication by statutes and also by judicial decision. As mentioned in *Kodeeswaran v The Attorney General of Ceylon* (1970) 72 N.L.R. at p.342. “Like the Common Law of England the Common Law of Ceylon has not remained static since 1799. In the course of time it has been the subject of progressive development by a *cursus curiae* ... as the courts of Ceylon have applied its basic principles to the solution of legal problems posed by the changing conditions of society in Ceylon.”

⁸⁸ Sec.24 of the Code.

⁸⁹ Art.27(2)(d) of the Constitution.

comprehensive understanding of the way in which intellectual property rights in Sri Lanka can be protected. Especially the study suggests a viable system of protection for intellectual property in the digital environment.

It is well known that intellectual property rights could be expanded either by creating new, specific *sui generis* rights or by giving a broader definition of existing rights under the current law. It is the opportunity for Sri Lanka to alter the boundaries of the intellectual property rights not by exclusively depending on or by adopting foreign concepts but by considering basic values underlying the society. Therefore, it would seem that, the need of the day is to focus on developing a theoretical framework to protect intellectual property in Sri Lanka that facilitates electronic-mediated commerce and thereby enhances the socio-economic standard of the country in the long term. Since this area is relatively new and yet there is no considerable record of accomplishment by which to evaluate the ambit of such a legislative regime, the outcome of this study will be helpful for further research in this field in general.

More significantly, the legal and social order of the country has been moulded by Buddhist religion. As will be seen in Chapter Two, this is also applicable to intellectual property. A theoretical and conceptual framework based on the country's moral values would probably address the issues rooted in the intellectual property system itself. No research has been conducted in the area based on Buddhist principles in relation to intellectual property. Obviously, it would be more useful if, at least, there had been an attempt to see the possibility of using Buddhist morality principles to address the concept of property in Sri Lanka. Paradoxically, no attempt has been made until now. It is felt that Buddhist principles offer a coherent and conceptually methodical paradigm, which in deeper analysis can offer a theoretical framework for the protection of intellectual property in Sri Lanka. This study provides the first treatment of Buddhist principles for the protection of intellectual property from legal perspectives. Accordingly, this study aims to contribute to the development of intellectual property law by providing a set of rules that could be applied in determining infringements of intellectual property rights in Sri Lanka. Likewise, the research outcome will contribute to policy and legal rules formulation, which would ultimately enhance the protection of intellectual property rights and thereby development of the Sri Lankan society.

1.5 Definition of terms

The following definitions are employed throughout the study. Thus, any other definition that is given by different authorities would not be considered in this study for a coherency of the arguments and proposition made throughout the study.

- Buddhism - The religious teaching propagated by the Buddha.
- Common Law - Roman Dutch Law as established as the common law in Sri Lanka
- dharma or dhamma* - the body of teachings expounded by the Buddha which is codified to three codes known as “*tripitaka*” under the “*Theravada*” tradition, not the “*Mahayana*” tradition which is not practiced in Sri Lanka.
- Morality - morality derived from Buddhist principles
- panca sīla* - Five precepts that are observed by Buddhist laymen and practices in Sri Lanka.
- Sri Lanka - Democratic, Socialist Republic of Sri Lanka

“Information age,” “digital age”, “digital era” will be used interchangeably.

1.6 Limitations

A study of this nature has some inherent limitations. As addressed above, peculiar problems, which exist as part and parcel of the Sri Lankan system itself makes limitation to the study. The first and probably the most prominent limitation is not only the lack of literature but also of dialogue on various issues in relation to intellectual property in Sri Lanka. As mentioned above, one of the main inhibiting factors, namely the unavailability of judicial decisions, would also limit this study. Similarly, none of the presently available literature pertaining to Buddhism written by scholars has dealt with the protection of intellectual property aspect, though many of them have dealt with the application of Buddhist principles in international law, environmental law, Management, and economics.⁹⁰ As a consequence, a pioneering study like this suffers from the unavailability of reference materials on the methodology of analysis.

⁹⁰ E.g. D. Keown, *Buddhism and Bioethics*, (London: Macmillan, 1995), Shinchi Inoue, *Putting Buddhism to Work: A new approach to Management and Business*, (Tokyo:Kodansha International

Another limitation is the lack of conceptual framework in Sri Lanka, which forms the basis of policy formulation for the protection of intellectual property laws in the country. Though a few amendments have been made to the present legislation from time to time, none of those amendments represent the country's policy towards the protection of intellectual property since all those amendments were made on pragmatic basis. Likewise, though Sri Lanka ratified many international treaties in relation to intellectual property none of those amendments show adherence to those principles embodied in treaties. Consequently, it is obvious that a study like this is limited.

1.7 Methodology and research strategy

In so far as the objectives are to investigate, understand, and analyse, this study is historical, critical, and analytical. It is historical in the sense that the study is aimed at investigating archival reports on development of intellectual property laws in Sri Lanka since historical evidence, e.g. intellectual property in general and old case laws, which remain applicable, provide guidance for the future.⁹¹ How these laws have been introduced to this country and how they have been practised in the contexts of both centrally planned economy and market economy are the main concerns of this historical investigation. The potential archival reports range from legislative promulgations to judicial decisions. Hence, Sri Lanka Archives Department, the Museum Library, the Parliament Library, and the Library of Bar Association of Sri Lanka had been the best research sites for this exercise.

This study is critical in the sense that it embarks on an analysis with a view to understanding how a particular socio-economic and political context has given rise to the current state of intellectual property law in Sri Lanka. It is viewed that the development in this area is not independent of the social system. Thus, there has been a continuous interplay between the two as one shapes, and is shaped by, the other. Hence, the phenomenon has to be studied by locating it in the wider socio-political ramification.

This study is also analytical towards providing possible policy options. Having studied the phenomenon from a critical perspective, it is hoped that the issues, problems, and causes would be clearly identified. It is also hoped that this identification would guide us to derive a set of sensible guidelines for improving and modifying the existing system. By

Ltd., 1997), Michael G. Barnhart, *Nature, Nature and No-self : Bioengineering and Buddhist Values*, *J. Budd. Ethics* 7 (2000), 126-144.

⁹¹ P.B. Maxwell, *Maxwell on the Interpretation of Statutes*, Langan, P St. J, 12th(edn) (London: Sweet and Maxwell, 1969), 47.

doing so, it would be possible to compare and contrast with the other institutional arrangements in other countries in the region, giving an example for other jurisdiction to understand the way in which policy options could be brought forward towards eliminating the emerging problem in the digital age. To deal with the task of analysis, more data is collected from some multiple sources including international treaties, conventions, WIPO documents and working papers, domestic legislation and related judicial decisions.

The research data is collected from both primary and secondary sources. The primary data for the proposed study are international treaties, conventions, WIPO documents and working papers, domestic legislation and the judicial decisions. Since Sri Lanka has experimented more than one decade without proper legislation in relation to the protection of intellectual property rights in the information age, the data collected from Sri Lanka will greatly apply to develop the theoretical framework. Data is also collected from secondary sources such as research works and articles.

While sustaining these methodological properties, the research design is portrayed with a potential proposition: *Intellectual property right should be protected under the evolving growth of transactions in the information society, by interpreting legislation which guided by the values and the needs of the country while considering a balance between individuals property rights and freedom of trade and access to information.*

It is hoped that the methodological approach that has already been mentioned and the following proposed interpretative methodology could provide better means for accomplishing this pragmatic end.

1.8 Proposed judicial methodology for the interpretation and application of intellectual property law in Sri Lanka

Interpretation and application of intellectual property laws in Sri Lanka should not be confined only to the local legislation but many sources of interpretation available in the country. As will be seen, such interpretation of law would be widely acceptable and effective in Sri Lanka. Moreover, it is evident that the rate of change of technology and the mode of dissemination, use/appropriation of intellectual property is faster than that of legislation. A law, which aimed to deal with new technology, will become obsolete very soon. This is evidenced in other jurisdictions such as USA and Australia. It is unwise to have knee-jerk legislative reactions for a country like Sri Lanka. Hence, it is better to

have a good interpretative methodology than constant change of law to cope with new technologies.

The methodology is self-limited. It will not result in an overly strong intellectual property system because the inbuilt balance is created by the constitutional and the Buddhist principles. Moreover, the methodology is not dependent on the mode of exploitation of intellectual property. Hence, it is not time bounded. Therefore, it can be used to address any future convergence of technology. This approach also makes defences less critical, since balance is introduced automatically. Defendants as much as Plaintiffs can advance these interpretative arguments to assist the court in doing justice in novel situations.

A brief description of steps of such methodology is as follows.

In the first place, it is necessary to consider the local legislation as it exists.

Local legislation

STATUTORY INTERPRETATION: Here general principles of interpretation of statutes should be applied. Hence, when the language of local legislation is clear and explicit, then the court should give effect to it. However, interpretation of local legislation should be made with the context of the Act by referring to other rights and defences. Any provision of law should be interpreted so that it would apply in a manner consistent with the Constitution, being the Supreme Law of the land. (See below)

↳ **CASE LAW:** The second step of the methodology would be seeking guidance by the local case law. However, as mentioned earlier in this Chapter this is not very extensive because of the availability of few reported cases in Sri Lanka. Hence, look at persuasive force of decisions from other jurisdictions.

↳ **CONSTITUTION:** The third would be application of the Constitutional principles including fundamental rights and freedoms. Any provision of local legislation should be interpreted so that it would apply in a manner consistent with the Constitution being the Supreme Law of the land.

↳ **BUDDHIST PRINCIPLES:** Application of Buddhist principles in the broadest sense would be the next source of interpretation.

↳ **OTHER AREAS OF LAW:** Seek guidance from other areas of law such as law of Delict, which is based on Roman Dutch Law of the country.

INTERNATIONAL TREATIES: This could be applied in the first instance to interpret local legislation as well as in last resort where other steps of the methodology is exhausted. Hence, interpretation of local legislation should be done wherever possible in conformity with international obligations.⁹²

⁹² Para 2.11 for details of this methodology.

1.9 Study overview

The study is divided to three parts namely Part One–Introduction and proposal. Part Two–Testing the proposal across a range of intellectual property laws. Part Three–Outcomes and Conclusion.

Part one of this study mainly introduces the study while giving a background, which is necessary for the understanding of the study. Accordingly, this Chapter broadly highlighted the issues that emerged as a result of the information society. It is shown that those problems are still unsettled and likely to remain unsolved in the near future. While addressing the lacuna that exists in the international legal order, this chapter emphasised those specific problems, which act as inhibiting factors to the development of Sri Lankan intellectual property jurisprudence. In doing so, the present Chapter declared the main objectives of the study while justifying the significance of the study. Methodology and research strategies are made clear by means of achieving the objectives while demarcating the boundaries of the study.

The situation, which has so far been considered, shows that the problems which have arisen in the legal order cannot be addressed by considering those problems alone. Thus the better view, it is submitted, is an approach that focuses on problems rather than answers. Therefore, the Second Chapter of the study deals with the development of the notion of property in Sri Lanka in general and especially with intellectual property. Indeed, an attempt would be made to examine the non-legal factors such as historical and religious to understand the moulding forces of the notion of the country's policy. Then the Chapter seeks the possibility to suggest a theoretical framework, which could be used as a guide in process of decision making in intellectual property cases. This suggested theoretical framework would be tested throughout this study by applying it to different areas of intellectual property issues.

Part two of the study is the research process. Thus, the goal of this part is to examine the present intellectual property law in Sri Lanka and identify gaps. The exploration is confined to only two selected areas of intellectual property law namely trade mark and copyrights and related rights due to the given length of the thesis.

Part three of the study is devoted to outcomes of the study and to the contributions. This part deals with the cumulative effect of the major conclusions that are made at the end of each chapter of this study. This part closes with postulation of final conclusions while

emphasising the contributions made by this academic endeavour, which would help the future policy formulation of the country.

1.10 Conclusion

In brief, this chapter laid the foundations for the thesis. It introduced the research problem and research questions and developing proposition (hypotheses). Then the research was justified, definitions were presented, the methodology was briefly described and justified, the limitations were given, and the thesis structure was outlined. On these foundations, the thesis can proceed with a detailed description of the research.



CHAPTER TWO

Origin, Recognition and Protection of Intellectual Property in Sri Lanka

2.1 Introduction

Time and again, the development of the information society is confronted with a pertinent question about the notion of intellectual property, while discussing a theoretical framework for the protection of such property from unauthorised appropriation in the information society. It is only because the manifestation of life exhibits the co-existence of life and property. Since the institution of property involves the whole range of aspirations of human life, historical, cultural, legal, and religious backgrounds shape the institution of “property” in any society. Obviously, intellectual property is not exempt from this phenomenon. Thus, the institution of property of a given country should be understood with due consideration of those non-legal factors embedded in that country.

As has been previously discussed in Chapter One, there are many problems yet to be addressed in intellectual property law, which become apparent as a consequence of the rapid development of the information age. Nevertheless, Chapter One emphasised the fact that Sri Lankan intellectual property law has also to address specific issues built into the country’s legal system itself. All the same, it is questionable whether a process of ascertainment and application of the principles of model law or transplanted law, which were derived under different socio-political and legal environments, is capable of resolving all those issues.

Hence, an examination of the set-up of the civil society in Sri Lanka with due consideration of non-legal factors, that crucially determines its legal policy, is warranted to grasp the nature and scope of protection afforded to property, including intellectual property, throughout Sri Lankan history.

Therefore, an attempt is made in this Chapter to trace the main stages in the origin and development of the notion of property, especially intellectual property, in Sri Lanka, and to explore the philosophy behind the protection of such property. Such examination is needed as groundwork for a better understanding to sustain the proposed theoretical framework at the end of this Chapter.

Accordingly, this Chapter is divided into four parts. Part A deals with a brief historical survey of Sri Lanka, which traces the existence, recognition, and protection of intellectual property, if any, during the pre-colonial era of the country. Part B briefly examines the impact of personal laws¹ and colonial laws on the evolution of intellectual property in Sri Lanka. Subsequently, Part C examines some of the Buddhist principles, which underlie the moral rubric of the society from early history to date, with a view to employing these principles in Part D of this Chapter. Part D is the theorisation process. A theoretical framework/methodology is proposed to guide policy and decision makers in determining how intellectual property laws in Sri Lanka can or should be interpreted to protect its infringement in the information age.

PART A

A brief survey of the development of the notion of property rights in

Sri Lanka

2.2 Origin and development of the State

Historical evidence such as stone inscriptions and literature indicate that the origin of civilised society in Sri Lanka² can be traced back to 500 B.C.³ Those evidences also indicate that the Sinhalese were the earliest people of Aryan origin who came to the island from India and began the civilisation of the country in 500 B.C. Though there are disagreements as to the exact time when the civilisation came into being, significant development began with the advent of Arahath⁴ Mahinda the royal emissary of King Asoka of India, who introduced Buddhism to the island during 307-267 B.C.⁵ According to the ancient chronicle records, when the then king was on hunting, Arahath Mahinda

¹ In addition to the general law of the country, some special laws namely Kandyan law, Tesawalamai law and Muslim law apply to a certain segment of people on subjects such as marriage, custody and inheritance. These laws are known as personal laws. *Infra* 2.8 for more details of these personal laws.

² Greeks and Romans knew the island by hearsay and called it 'Taprabone'. The Arab travellers who traded with it called it 'Serandib'. Portuguese were the first Europeans to occupy part of it in 1505 and they called it 'Ceilao'. The Dutch called it 'Zeilan'. Finally, the British called it 'Ceylon'. Secretary of State for the Colonies, "Ceylon: Report of the Special Commission on the Constitution," (London: His Majesty's Office, 1928), 5. Generally, K.M. De Silva (ed.), *Sri Lanka, A Survey*, (London: C. Hurst & Company, 1977). The name Sri Lanka was adopted in 1972, the researcher will use the name Sri Lanka consistent with modern scholarship.

³ De Silva, *Sri Lanka, A Survey*, *supra* n.2, p.31, and generally K.M. De Silva, *A History of Sri Lanka*, (Delhi: Oxford University Press, 1981), Ananda W.P. Guruge, *Mahavamsa (The Great Chronicle of Sri Lanka)*, (Sri Lanka: Associate News Papers of Ceylon Limited, 1998), Chandradasa Kahandawa Arachchi, *Deepawansaya* (Sri Lanka: S. Godage Brothers, 1997).

⁴ In Theravada Buddhism, an individual who has achieved enlightenment is known as Arahath or worthy one.

preached to him a sermon on Buddhism, which persuaded the king to embrace.⁶ His address to the King goes as follows:

O great King, the birds of the air and the beasts have as equal a right to live and move about in any part of the land as thou. The land belongs to the people and all living being; thou art only the guardian of it.⁷

This sermon indeed represents one of the most important principles of Buddhism. The concept of not causing harm to others and hence *sic utere tuo ut alienum non laedas* became the central notion of Buddhism in Sri Lanka.⁸ As will be shown later in this Chapter, Buddhism became the bedrock of the culture and civilisation of the island as it made the essential linkage between the ruler and the ruled. Even the Tamils/ Dravidians who were the minority ethnic group and who were mainly Hindus ruled the island from time to time had protected Buddhism. For instance, Elara, the Chola prince who ruled in Anuradhapura in the 2nd Century B.C is reported to have gone to Cetiya Pabbata (Mihintale - a temple) and invited the *Sangha*⁹ following the custom of the traditional Sinhalese King (*carittam anupālayam*).¹⁰ This state of affairs prevailed up to as late as the beginning of the 19th Century A.D. For instance, the Dravidian kings of the Kandyan period following examples of the earlier Sinhalese Kings, professed the Buddhist faith, and observed Buddhist customs.

2.3 Law and Order

In theory, the King of the Sinhala nation was the absolute ruler. Even though the country was divided for administrative purposes, the manners and social system, the customs and laws of the Sinhalese for the most part were similar enough with visibly slight differences from area to area conditioned by purely local usages.¹¹ Nevertheless, customs and

⁵ De Silva, *Sri Lanka, A Survey*, supra n.2, p.33.

⁶ This occurred during the reign of King Devanampiya Tissa, a contemporary of the great Indian emperor Asoka's, according to Mahavamsa or the great chronicle of Sri Lanka, which was compiled in the sixth Century A.D. and maintained contemporaneously by the Buddhist monks. Commencing at the close of the 4th Century A.D. and incorporating earlier chronicles and oral traditions dating back a further eight Centuries, this continued a record for over 15 centuries. Wilhelm Geiger, (trans. to English), *Mahavamsa or the Great Chronicle of Ceylon* (London: The Pali Text Society, 1912), Ch.XI, p.78.

⁷ Folktale in Sri Lanka and these wordings are displayed near the place where the sermon was made.

⁸ Sri Lankan Buddhist are the first to write down the Buddha's teaching (1st Century B.C) and were the first group to create a Buddhist historical record (2nd – 4th Century B.C).

⁹ Buddhist monastic are called Sangha.

¹⁰ L.C Wijesinghe, *Mahāvamsa- Part II* (Colombo: Government Printers, 1889), 82.

¹¹ F.A Hayley, *Laws and Customs of Sinhalese* (Colombo: H.W.Cave and Co, 1923), 23-25.

traditions posed some formidable constraints on the Kings absolutism.¹² Hence, the King governed the whole island¹³ according to these principles called the ten royal virtues or *dasarāja dharma*.¹⁴ Furthermore, the King himself was the head of Buddhism by virtue of being the protector of the Buddhist relics. The strong symbolic connection between the throne and Buddhism automatically transformed his image into that of a future Buddha or a *bodhisathwa*. Consequently, union of state law and moral law was a happy blend, which gave a unique character and wide acceptance among the people.

King Nissanka Malla (1187-96 Century A.D) claims to have established a court of law-*dharmādhikarana* in different parts of the country to deliver justice.¹⁵ The term *dharmādhikarna* denoted the aforementioned combination of two words *dharma* (teaching of Buddha) and *adhikarana* (court). *Dharmādhikarana* has special responsibility to act according to the Buddha's teaching. Slab inscription in Sri Lanka shows the dedication of the King to protect and preserve *dhamma*.¹⁶ As can be seen later in this Chapter, protecting and safeguarding Buddhism still plays an integral part of the State today.

2.4 Market economy

According to available inscriptions and other literature/ documentary evidence of the country, there had been established trade and commerce practices in the early period of history and the market was regulated according to established principles of law. For

¹² John D'Oyly, *A Sketch of the Constitution of the Kandyan Kingdom*, Turner, L.J.B., 2nd (edn) (Sri Lanka: Department of Statistics and Office Systems, 1929; Tisara Prakasakayo Ltd, 1975), v.

¹³ Generally, A.R.B. Amerasinghe, *The Legal Heritage of Sri Lanka* (Sri Lanka: Sarvodaya Vishvaleka, 1999).

¹⁴ Don Martino De Silva Wickremasinghe, (ed. & trans.) *Epigraphia Zelanica Being Lithic and Other Inscriptions of Ceylon*, (London: Oxford University Press, 1912), (Hereinafter "EZ"). EZ. Vol.1, No.14, Vol.II, No.19, No.28 and No.29. Also, Amerasinghe, *supra* n.12. Daily News for detail explanation of Ten Royal Virtues at <http://www.dailynews.lk/2001/11/28/fea08.html> (Accessed: 01.12.2004). The 'Ten Royal Virtues' are as follows: 1. *Dāna*: liberality, generosity, or charity. 2. *Sīla*: morality - a high moral character. 3. *Pariccāga*: Philanthropy: Making sacrifices if they are for the good of the people. 4. *Ajjava*: Uprightness: Honesty and integrity. 5. *Majjava*: Kindness or gentleness. 6. *Tapa*: Self-control: Restraint of senses and austerity in habits. 7. *Akkodha*: Non-hatred. The ruler must act with forbearance and love. 8. *Avihimsā*: non-violence. Not only should he refrain from harming anybody but he should also try to promote peace and prevent war, when necessary. 9. *Khantī*: Patience and tolerance. In any occasion, he should be able to conduct himself without giving into emotions. 10. *Avirodhatā*: Absence of obstruction: Non-opposition and non-enmity. The ruler should not oppose the will of the people. It is submitted that the modern concept of the welfare state is to be seen in the perspectives of the ten royal virtues.

¹⁵ Priti danaka mandapa rock inscription. EZ.Vol.V, No.22. Also, M.B Ariyapala, *Society in Medieval Ceylon (The State of Society in Ceylon as Depicted in the Saddharma-Ratnāvaliya and Other Literature of the Thirteenth Century)* (Colombo: The Colombo Apothecaries Co. Ltd, 1956), 124.

¹⁶ In Polonnaruwa-Hata-da-ge, poetic slab inscription King appeals to future King to protect and preserve *dhamma*. EZ.Vol.II, No.10.

instance, there are Brahmi inscriptions belonging to pre-Christian era, which mentioned corporations and guilds of merchants (*puga or pugia*).¹⁷ According to Hopitigama Rock inscription, there were specific areas in the market, which allocated traders to trade in stalls.¹⁸ Coins have been found which belong to 200 Century B.C and the beginning of the Christian era.¹⁹

Furthermore, market function was an all-important part at Anuradhapura kingdom.²⁰ Currency was deposited with guilds in return of interest.²¹ In 4th and 5th Century A.D, mercantile guilds provided “banking” facilities where customer could deposit money, grain such as paddy, black peas, green gram and obtain annual interest on their deposits.²² In addition, pillar inscriptions mentions about well-regulated market towns, which were functioning during the regime of King Udaya IV (946-954 Century A.D).²³ A rock pillar was made to publish certain rules on trading. Thus, it states that

...whereas , it was ordered [by his Majesty] that the decree should be passed and promulgated prohibiting unlawful acts continued in violation of the institution of trade ...²⁴

This inscription maintains that local mercantile and other corporations were empowered to levy fines and assist the Royal Officers in the administration. According to the same pillar inscriptions, trade on *pōya day* should be levied.²⁵ Furthermore, the same inscription says that commodities should be measured with special measurement and the authority should stamp all weights.²⁶

Hence, it would be safer to conclude that the established trading system in the early period was concerned not only with the efficiency of trade but religious obligations as well.

¹⁷ Generally, S. Paranavitana, *Inscriptions of Ceylon*, Vol.I (Colombo: The Department of Archaeology, 1970),320 and 720.

¹⁸ EZ.Vol.III, No.4.

¹⁹ M.H. Sirisoma, "Coins," *Ancient Ceylon- Journal of the Archaeological Survey Department of Ceylon* (Colombo) II (1972): 147-150.

²⁰ EZ.Vol.III, No.9.

²¹ EZ.Vol.I, No.18, EZ.Vol.IV, No.14 and No.24, EZ.Vol.V, No.17.

²² EZ.Vol.III, No.17 and No.26.

²³ EZ.Vol.V, No.16.

²⁴ EZ.Vol.III, No.4.

²⁵ *Pōya day* means full moon day of the month. In terms of Buddhist practice, *pōya day* is reserved for religious observances.

²⁶ EZ.Vol.VI, No.21 regarding some other regulations on trade.

2.5 Ownership of property

It is a popular notion that a concept of private property was not known in Sri Lanka before the European introduction of laws relating to private property assuming that all the land of the country belonged to the King. Nevertheless, many inscriptions show that this notion is not correct as the concept of private property had been recognised as early as 1st Century A.D. An inscription records the donation of a cave along with some land by an individual named Mataya to a Buddhist monk.²⁷ Another inscription belonging to 7th Century A.D mentions donation of a land by an individual to a Buddhist temple called Dakkhina Vihāra.²⁸

Furthermore, an inscription belonging to 10th Century A.D provides information that one *paya* (a measure of land) of paddy land was sold (*vikina*) for eight *kalandas* (measure of weight) of gold by a certain person called Velatme Mihindu to a person named Ukunhasa Kotta.²⁹ An inscription states that King Kumaradasa (508 B.C-16 A.D) was to be the purchaser of a parcel of land for the purpose of donating it to *sangha*.³⁰ Inscriptions of King Nissanka Malla³¹ mention about a grant of paddy land to a temple but the King first purchased it before it was donated.³² Therefore, this evidence amply demonstrates that there is no sound basis for the popular theory that 'all land belong to the King'. On the other hand, there was no collective ownership of land as 19th Century writers claimed to have existed in South Asian countries.³³ Nevertheless, this does not mean that there was no collective interest over traditional knowledge.

The recognition of private property rights prevailed until the beginning of British rule in 1796. This is further evidenced by Armour's writing.³⁴ He states that forests, wilderness unclaimed and untenanted by men belong to the King. Although he could claim over most lands a portion of produce as tax, this was in return for service he rendered to the

²⁷ EZ.Vol.V, No.20. This is also an inscription of a cave temple and datable to 1st Century A.D.

²⁸ EZ.Vol.V, No.5.

²⁹ EZ.Vol.III, No.18. Also EZ.Vol.IV, No.25, which refers to a land sale by an individual. Furthermore, the Mahavamsa also refers that the King Gajabahu I (114-36 Century A.D) bought the plot of land, which he donated, to the Issarasamana and Mariccaveti Monasteries.

³⁰ Buddhist monastic are called Sangha. Sangha comprises of bhikkus (monks) and bhikkunies (nuns).

³¹ King Nissanka Malla (1187-96 Century A.D).

³² EZ.Vol.IV, No.14 and EZ.Vol.V, No.17.

³³ H. S. Main, *Village Communities in the East and West*, 7th (edn) (London: J. Murray, 1895).

³⁴ John Armour, *Grammar of the Kandyan Law* (Colombo: Ceylon Times Press Co: 1880), 5.

people in the kingdom.³⁵ Accordingly, the popular notion of King's ownership of all land can be rejected.³⁶

From the above evidence, it can be deduced that the concept of private property, movable or immovable, had been recognized before the European influence. As will be seen later in this Chapter, the recognition of private property rights in Sri Lanka during the early period extended to intangible property as well.³⁷

2.6 Existence of intellectual property

After ascertaining the existence of private property rights in pre-colonial early Sri Lanka, it is worth considering whether there was any recognition of intellectual property in the country. Historical evidence indicates that the early settlement of Sinhalese was in dry zone. The climate was harsh and not suited for agriculture. As a solution, the ancient Sinhalese developed a highly sophisticated irrigation system.³⁸ A commentator describing the ancient canals in China observed, "it was comparable only with the irrigation contour canals of Ceylon, not with any works in Europe."³⁹ There is evidence of a remarkable invention of a device (*bisokotuwa*) to control the pressure and quantity of the outflow of water from the reservoirs.⁴⁰

Intellectual endeavour and skill expressed in artistic work were recognised and rewarded in early societies. For instance, Jetawanārāma Sanskrit Inscription that belonged to 9th Century A.D states that

[Line 25-30] [There shall be] clever stone –cutters and skilful carpenters in the village devoted to the work of [temple] renewal. They all...shall be experts in their [respective] work. To each of them shall be given a field of one and a half *kiri* [in sowing extent] for their maintenance ... an enclosed piece of ground. And one *hena* (or a plot of dry land) shall be granted to enclosed to each of them for the purpose of sowing fine grain...⁴¹

³⁵ It is personally known to the researcher that similar systems still in use among paddy cultivators in rural areas in Sri Lanka where a person gets a portion of produce who organizes collective works such as clearance of water supplying channels and making fence around the paddy field etc.

³⁶ Further W.I. Siriweera, "Land Tenure and Revenue in Medieval Ceylon (AD1000-1500)," *CJHSS New Series* (Ceylon Historical and Social Studies Publication Board, Peradeniya, Sri Lanka) II, January-June (1972), 11-19.

³⁷ Kandyan Law *infra* para 2.8(E)(I).

³⁸ Generally, R.L. Brohier, *Ancient Irrigation Works in Ceylon* (Colombo: Ceylon Government Press, 1935).

³⁹ Joseph Needham, *Science and Civilisation in China-Physics and Physical Technology*, 4th vol. (Cambridge University Press, 1974), 359.

⁴⁰ Again, Needham observed that "already in the 1st Century A.D they (the Sinhalese engineers) understood the principle of the oblique weir... But perhaps the most striking invention was the intake towers or valve tower (*bisokotuwa*) which were fitted in the reservoirs perhaps from the 2nd Century B.C onwards, certainly from the 2nd Century A.D." Needham *supra* n.39, p.372.

⁴¹ EZ.Vol.I, No.1.

It appears that in the process of building and renovating temples, most of the kings acknowledged the superior skills in the art of carving. There were many instances where the creators were given valuable property in appreciation of their skill.⁴² The King Nissanka Malla gave appropriate allowance to those versed in science (*sāstra*).⁴³ In contrast, creativity was not inhibited in the absence of such stimuli. Songs, dances, artistic designs, paintings, sculptures, and folk tales added to the body of intellectual property during the pre-colonial era.

Furthermore, there exists thousands of folklore including peculiar tunes and melodies passed from generation to generation. Folk healing was popular among the people. An example is the *bali kavi*. *Bali kavi* – a collection of songs and charms chanted at *bali-yāga* ceremonies, to the accompaniment of drums. The *bali-yāga* performance was used for averting evil influences. Even today, this kind of healing system is still used in Sri Lanka. *Thovil* (a kind of performance for the same purpose as *bali*) and *mantras* (chanting used for different purposes including healing) are also used by certain group of people in Sri Lanka.

As can be seen, creativity of the people was always focused towards the benefit of the society rather than for commercial purpose. This is due to the influence of Buddhism.⁴⁴ Thus, creator of many utensils that were made to improve the living standards of the society and authors of literary,⁴⁵ artistic works⁴⁶ remained anonymous. Therefore, the public still do not know the creator/ author of many ‘works’.

In contrast to Western ideology of intellectual property, (i.e. the fruit of a creation belong to the creator not humanity), the Sri Lankan intellectual property belonged to the common heritage of mankind. Generosity or *dāna* is highly commendable in Buddhism.⁴⁷ *Parichariā dāna* or gift of work is one of them. This means lending one’s talents, skills,

⁴² EZ.Vol.1, No.7.

⁴³ EZ.Vol.I, No.7 and No.8.

⁴⁴ *Infra* Part C.

⁴⁵ E.g. Kavsilumina, Sadavata, Muvadavatha. The authors are unknown.

⁴⁶ Those thousands of wall paintings of temples, woodcarvings, sculptures constitute protectable subject matter under modern intellectual property law. Nevertheless, author of those ‘works’ are unknown.

⁴⁷ As can be seen later by giving *dāna*, one can practice to eliminate greed or *lōbha*, which ultimately leads to achieving happiness in life. Traditionally Buddhism recognises four types of giving or *dāna*. Also Kindada Sutta of Samyutta Nikāya at <http://www.accesstoinsight.org/canon/sutta/samyutta/sn01-042.html> (Accessed: 01.12.2004) and also Aputtaka Sutta, Heirless (2) of Samyutta Nikāya for generosity at <http://www.accesstoinsight.org/canon/sutta/samyutta/sn03-019.html> (Accessed: 01.12.2004) and Issattha Sutta of Samyutta Nikāya at <http://www.accesstoinsight.org/canon/sutta/samyutta/sn03-024.html> (Accessed: 01.12.2004).

and time for the benefit of the society at large. It is no surprise of the vast anonymous creations made by earlier generation of the country. Thus, it is assumed that those intellectual properties were in the public domain.

2.7 Protection of works

Historically, Sri Lanka did not seem to have viewed intellectual discoveries and scientific invention as private property. Cultural esteem rather than material gain were the incentive for creativity of their discoveries and inventions. Hence, new ideas or technology were good for everybody to share freely. However, an examination of inscriptions suggests that there would have been misuses of 'intellectual property'.⁴⁸ Hence, it is submitted that, attention should be made to those factors such as Buddhism, customs, caste system etc., which played a vital role as a mechanism to protect 'intellectual creations' in the pre-colonial era.

2.7.1 Buddhism as a mechanism

Though the society had been by and large governed by Buddhist principles, it does not mean that there was no misuse or misappropriation of intellectual creations at all in those days.⁴⁹ Nevertheless, property including intellectual creations was protected due to two compelling reasons. First, is the influence of Buddhism. Second is the fear of punishments. As seen later in this Chapter, the basic principles of Buddhism centre on human being and not metaphysical things. Buddhism seeks to maintain moral purity in order to achieve the ultimate goal of one's life called *nibbāna* (Pāli) or *nirvāna* (Skt). And more, according to Buddhist social theories, the important factors that govern and control society are called *hiri* and *ottappa* i.e. fear and shyness to commit evil acts.⁵⁰ Thus, it seems that social behaviour in those days was affected by Buddhist morality and hence artefacts whether private or public was protected from misappropriation.

2.7.2 Punishment as a mechanism

The second way of protection was the fear of punishment. It can be argued that people might have refrained from taking what has been not given due to the fear of punishment. Punishment is described in the scriptures in two ways. One of the ways is the punishment

⁴⁸ *Infra* Para 2.7.2 for punishments for misuse of 'mark'.

⁴⁹ *Infra* Para 4.1 and 2.7.2.

⁵⁰ Buddhism says emphatically that there are two essential moral factors of socialisation without the sense of which society will plunge into disorder namely moral shame (*hiri*) and moral dread (*ottappa*). Thus, one must be shameful of misdeed and be afraid of violating social standards. When one is morally good (*sīla sampanna*) one wilfully abstains from any type of deed that hurts others.

in this life itself and the other way is the punishment in the next life. It seems that severe punishments were given when the law of the land was broken. According to Panākadu inscription punishments were graded in the following order:

- (1) verbal reprimand.
- (2) fine.
- (3) imprisonment.
- (4) confiscation of property.
- (5) capital punishment.⁵¹

This inscription evidenced that the punishments ranged from verbal punishment to capital punishments. Apart from these types of punishments, there was another peculiar system of punishment known as *valakma* or moral compulsion. Here a circle will be drawn on the earth by the authority around the wrongdoer when he is in public and he is asked not to come out from the circle. Since the authorities order the wrongdoer not to come out, the wrongdoer will be exhibited to the public a number of hours.

Vevalketiya Slab-Inscription of Mahinda IV (1026-1042 Century A.D) suggests that severe punishments were given when there was misuse of intellectual property. This inscription states in line 31 that “...*ana makuwan rat-kala ya-maravadiye situvanu.*” Meaning, “those who have effaced marks shall be made to stand on red-hot iron sandals.”⁵² This is clear evidence to prove the existence of law to protect marks prior to the introduction of European intellectual property law to the island. It is, therefore, apparent that people obeyed the law due to the fear of punishment.

2.7.3 Retribution in the next birth as a mechanism

The other way of punishment is the fear of punishment not in this life but in the next birth.⁵³ According to Buddhism, one’s life is determined on *karma or kamma*. Karma is intentional action, that is, a deed done deliberately through body, speech, or mind. Hence, *karma* means good (*kusala*) and bad (*akusala*) volition.⁵⁴ The concept of karma

⁵¹ EZ.Vol.V, No.2.

⁵² EZ.Vol.I, No.21.

⁵³ For the explanation of Buddha on future rebirth that can be expected. Puggala Sutta of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an04-125.html> (Accessed: 01.12.2004).

⁵⁴ As can be seen there are basic precepts one has to observe as part of life in order to attain the enlightenment or *nibbāna*. Ariyamagga Sutta of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an04-235.html> (Accessed: 01.12.2004).

(volitional act), retribution (*vipāka*), and rebirth (*punabbhava*) are interconnected. These operate in their own field without the intervention of an external, independent agency. The Buddha said,

According to the seed that is sown, so is the fruit you reap. The door of good will gather good results. The door of evil reaps evil results. If you plant a good seed well, then you will enjoy the good fruits.⁵⁵

According to Buddhism the effect of one's past karma determine the nature of one's present situation in life.⁵⁶ Thus, people in their present lives are experiencing the effects of their past actions or karma. It is said that

*Mano pubbaṅgama dhammā - Mano seṭṭhā manomayā,
Manasā ce paduṭṭhena - Bhāsati vā karoti vā,
Tato nam dukkhamanveti - Chakkhan va vahato padam.*

This means that the retribution of an action follows the doer just as the cartwheel follows the foot of the ox tied to the cart.⁵⁷

Nevertheless, by their present actions, people can produce new karma with short term and long-term effects. This new karma will determine their situation in future lives.⁵⁸ Thus, it seems that the concept of karma served as a rubric for moral behaviour devoted to improving one's life in the future as well as providing an understanding and explanation of one's present existential circumstances. It is therefore due to the belief of next birth (*punabbhava*) and the fear of suffering in the next birth (*vipāka*) that the society might have not done any bad volition (*akusala*). It is submitted that the belief of *karma* could have prevented people from committing wrong and hence, among other things, protected the property rights of the people.

⁵⁵ Also, Vipāka Sutta of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an08-040.html> (Accessed: 01.12.2004).

⁵⁶ Kamma Sutta of Samyutta Nikāya for the Buddha explanation how old kamma and new kamma are both experienced in the present at <http://www.accesstoinight.org/canon/sutta/samyutta/sn35-145.html> (Accessed: 01.12.2004). Furthermore, the Buddha explained how the principles of kamma and rebirth are inviolable as the law of gravity. Paccha-bhumika Sutta of Samyutta Nikāya at <http://www.accesstoinight.org/canon/sutta/samyutta/sn42-006.html> (Accessed: 01.12.2004). And also Cula-kammavibhanga Sutta of Majjhima Nikāya for analyse of action at <http://www.accesstoinight.org/canon/sutta/majjhima/mn135.html> (Accessed: 01.12.2004).

⁵⁷ Dhammapada, Yamakavaggo at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/02Dhammapada/01-Yamakavaggo-e1.html#V1> (Accessed: 01.12.2004).

⁵⁸ Buddhist discourses of the results of right conduct and wrong conduct in Sāleyyaka Sutta of Majjhimanikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/2Majjhima-Nikaya/Majjhima1/041-saleyaka-sutta-e1.htm> (Accessed: 01.12.2004).

2.7.4 Caste as a mechanism

However, it seems that many methods have been used to protect properties including intellectual creations belonging to others from misappropriation apart from the general belief in karma and fear of punishment. One such method was the caste system. Buddhism does not recognise a caste system in human society. As it is declared in the Buddhā's teaching

Na jaccā wasalōhōti - Na jaccā hoti Brāhmanō

*Kammanā wasalōhōti-Kammanā hōti Brāhmanō*⁵⁹

This means that by birth one does not become a *Brahmin* (the highest caste in India at the time of Buddha) or outcast. One will become a Brahmin or an outcast only due to his action or conduct (*kamma*).⁶⁰ Thus, a man can be considered as a worthy person or unworthy person based on his conduct.⁶¹ However, the caste system⁶² was developed in the country during the Polonnaru Period (993-1235 A.D).⁶³ In contrast to the Indian caste system, the basis of the Sri Lankan caste system did not emerge as an attachment to religion. This is possibly due to the impact of Buddhism on the society. The very essence of the Sinhalese caste system was its flexibility. The caste groups were brought within a system of services in which hereditary status was the determinant role and function.⁶⁴

However, it seems that the caste system played a role as a means of protecting of intellectual property in the country during those times. For instances, knowledge in relation to performances, music and methods of production such as sugar molasses, bronze utensils, jewellery were kept within the caste and passed by generation to

⁵⁹ Vasala Sutta in Sutta Nipata of Khuddaka Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/05Suttanipata/01-uragavagga-e.htm> or <http://www.accesstoinight.org/canon/khuddaka/suttanipata/snp1-07.html> (Accessed: 01.12.2004).

⁶⁰ Thus, this emphasises the worthiness of good conduct of human being.

⁶¹ A person's goodness is not measured by his or her wealth, beauty, or status, but by the goodness of his or her action. Tamonata Sutta of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an04-085.html> (Accessed: 01.12.2004).

⁶² Generally, R. Pieris, *Sinhalese Social Organisation the Kandyan Period* (Colombo: Ceylon University Press, 1960), E. Leach, *Aspects of Caste in South India, Ceylon and North-West Pakistan* (Cambridge: Cambridge University Press, 1960), B. Ryan, *Caste in Modern Ceylon* (New Brunswick, 1953).

⁶³ The history of pre-colonised Sri Lanka is divided in to five major periods. Namely early Anuradhapura Period from 500 B.C-300 A.D, Later Anuradhapura Period from 300 A.D-1000 A.D, Polonnaru Period from 993 A.D-1235 A.D, Divided Kandyan Period from 1232 A.D-1597 A.D and Kandyan Period from 1480 A.D-1815 A.D.

⁶⁴ Navandanno (artificers), karava (fishers), salagama (cinnamon peelers), durava (toddy trappers), are examples of castes in Sri Lanka.

generation. Furthermore, *bali kavi*⁶⁵ and *yāga*⁶⁶ were protected by not passing them on to non-family members.⁶⁷

Similarly right to participate in ceremonies, the right to wear certain insignia and right to perform a particular dance were confined only to the members of the *gurukula*⁶⁸ (schools) which was based on caste. By maintaining such structural form for administering the right to participate in dances etc the caste system were able to guard the value of the intangible property. Since the hierarchical recognition of this caste system, probably no one in the upper caste attempted to do some things, which belong to lower caste since he/she get recognition as a lower caste person. Hence, it is submitted that the caste system played a vital role in the protection of intellectual property rights in early period of Sri Lanka.

2.7.5 Lexicon

The most important way of protection of *Āyurveda*⁶⁹ medicinal knowledge is noteworthy of mention.⁷⁰ The types of medicines, methods of diagnosis, and methods of treatments were written in a Code form.⁷¹ This means that though the texts were written in common language, a layman could not understand them by mere reading of the text since it is written by using meaningless connotations. Only by learning the related lexicon, which normally was transferred from generation to generation within the caste or family, could one understand the meaning of the text. The original text without the relevant lexicon is useless. This method seems to be the same as the cryptography of present days, used in electronic transactions to maintain authenticity of a text.

⁶⁵ Supra Para 2.6.

⁶⁶ Supra Para 2.6.

⁶⁷ It is important that many of these *bali kavi* and *mantras* shows the Buddhist influence. Jinadasa Liyanratne, *Bhesajjamanjūsā* (Oxford: Pali Text Society, 1996), and Jinadasa. Liyanratne, *Buddhism and Traditional Medicine in Sri Lanka* (Sri Lanka: Kelanya University Press, 1999), Jinadasa Liyanratne, "Some Sri Lankan Medical Manuscripts of Importance for the History of South Asian Traditional Medicine," *Bulletin of SOAS* 64, 3 (2001), 392-400. cf. Guilds system in UK.

⁶⁸ However, it can be said that apart from the manifestation of creativity in material object, creative expression in Sri Lankan society took place in the context of specific cultural institutions such as *gurukula* which were responsible for accumulating and preserving them.

⁶⁹ A Sanskrit term meaning 'science of life'.

⁷⁰ There is a Ministry of Indigenous Medicine in Sri Lanka and Ayurvedic Drug Corporation to promote and protect the tradition from generation to generation.

⁷¹ In Sinhala these codes are called '*veda geta pada*'. 'Saratha Sangrahaya' is the first book that use '*veda geta pada*', which is believed to be one of the standard compilations in historical medicines in Sri Lanka. It was composed by King Buddhadasa who reigned at Anuradhapura in the 5th Century A.D. Ariyadasa Kumarasinghe, *Vaidyaka Sarartha Sangrahaya* (Colombo: Department of Museums, 1986), 1.

What can be deduced from the above discussion is that there was a system of recognition of intellectual property in Sri Lanka before colonization though not in the form of copyright, patent etc but in a different form and were protected by different means in conjunction with legal and non-legal factors such as religion and caste. In other words, recognition and protection of intellectual property was a function of, and deeply embedded in, the institution and underlying norms of social organisation in Sri Lanka. As can be seen later in this chapter, the recognition and protection of intellectual property was not new to Sri Lanka and the system of protection prevailed until the Kandyan Province was ceded to the British in 1818.⁷²

PART B

A brief examination of the foreign influences on intellectual property law

2.8 Introduction

The island has been subjected to several invasions during its history such as by the Portuguese in 1505, the Dutch in 1656, and the British in 1796. However, some invaders settled in the island and became the ancestors of the present population. As a result of these immigration and innovations, Sri Lanka today is a multi-cultural, multi-linguistic, multi-religious country. Especially, it is a country where legal pluralism exists.⁷³ The people of the country are governed under special laws namely Kandyan law, Tesawalamai law and Muslim law and /or general laws of the country. An examination of these laws is required to determine their influence on intellectual property laws in the country.

2.8.(A) Dravidians/ Tamils

During the period 1017-1235 A.D, there were several invasions from South India⁷⁴ and the invaders settled in the Northern part of the island. The Dravidians or Tamils had their own customs and these were codified. This customary law of the Tamils is known as Tesawalamai.⁷⁵ The Tesawalamai⁷⁶ law is still in force as a personal law and territorial

⁷² *Infra* Para. 2.8(E)(I).

⁷³ Thus interpersonal conflict of law arises because a citizen is opt for their personal law and still have access to the general law of the country which uniformly applicable to every one. Generally, John Griffiths, "What Is Legal Pluralism?," *JLP* 24 (1986),1-50, G. Teubner, "Two Faces of Janus: Rethinking Legal Pluralism," *Cardozo L. Rev.* 13 (1992),1443.

⁷⁴ There is no firm evidence as to when the Tamils (*Dravidians*) first came to the island. Generally, De Silva, *supra* n. 2.

⁷⁵ Tesawalamai is a combination of the two words "Tesa" which means country or territory and "Walamai" which means custom. Since the Tamil immigrants from India had brought their customs and traditions influenced by Hindu Law, a different legal system, this resulted in the formation of

law.⁷⁷ It is territorial because it applies to property situated in the province of Jaffna. It is personal because it applies to a certain segment of people in the country.

From the time of recognition of Tesawalamai law as a customary law it had played a major role in shaping private property rights in Sri Lanka. However, there are no provisions dealing with intellectual property rights although it provides laws for other properties and proprietary rights. It can be said therefore that there was no impact on intellectual property rights of the country by the Tesawalamai, the customary law of Tamils.

2.8.(B) Muslims

Over time, some Muslim immigrants also settled in the Western Sea coast of the island. During the Dutch period, the Muslims were governed by their own laws and usages. A collection of these laws was published as a part of the Statutes of Batavia.⁷⁸ During

Tesawalamai law. The main subjects with which the Tesawalamai dealt is succession to property, adoption, possession of land, slaves, mortgage of land, pawn of jewels, donation, sale of land or cattle, hire or loan of cattle and loan of money. It seems that there was no major concern among the community in the province of Jaffna on movable property except cattle. The Dutch codified the old customs and habits of the Jaffnapatnam, (at present it is called Jaffna, the Northern Province of the country) called Tesawalamai Code of 1707. The Tesawalamai or the customs of the Malabar inhabitants of the province of Jaffna was given legal recognition by Regulation, No.18 of 1806. Unlike the Kandyan law, it seems that the Portuguese effected various changes in the Law of Tesawalamai. This is amply demonstrated from a passage in the Tesawalamai code which states as follows "But in process of time, and in consequence of several changes of Government, particularly those in the times of Portuguese (when the Government was placed by the order of the King of Portugal in the hands of Don Philip Mascarenha) several alterations were gradually made in the customs and usages according to the testimony of the modliars...." Sec.2 of the Tesawalamai Code of 1806. Thus, the Tesawalmal Code contains the customs of Jaffna inhabitants, which were modified by the influence of the Portuguese.

⁷⁶ Today, the Tesawalamai code mainly deals with succession of property (the law of the Tesawalamai in relation to marriage and inheritance has been consolidated by Jaffna Matrimonial and Inheritance Ordinance, No.1 of 1911), adoption, possession of land (the law relating to pre-emption has been amended and consolidated by the Tesawalmal Pre-emption Ordinance, No.59 of 1947), mortgage of land, pawn of jewels, donations, sale of land or cattle, hire or loan of cattle and loan of money. Tesawalamai recognises some servitude rights over immovable property such as right to use coastal land to dry the fishing nets. Property is divided into three kinds under the Tesawalamai law. They are (i) *mudusam* or hereditary property inherited by husband, (ii) *chidenam* or property brought by wife, (iii) *tediyatettam* or property acquired after marriage. It seems that the division of property under the Tesawalamai is according to its mode of acquisition by a person and not according to its nature. No concept relating to intangible property is found in it except some instances of servitude. The application of the Code of Tesawalamai also has been changed by legislation and individual decisions and the residuary general law was applied in the absence in the Tesawalamai or any other law or any other provisions from which principles could be deduced to decide some question. *Chanmugam v Kandiah* (1923)23 N.L.R.223.

⁷⁷ Territorial law is a law, which applies to all subject matters in a specific territory irrespective of the caste, religion etc to which people in that territory may belong, whereas personal law is a law, which applies to a certain segment of people in the society.

⁷⁸ It was called the *Bysondere Wetten aangaande Mooren off Mohametanen en andere Indlandsche Natien* or the Special Laws relating to Moors or Mohameddans.

British rule i.e. 1796-1948, the British recognised the compilation of Muslim customs and the Code of Muslim Law was promulgated in 1806.⁷⁹

The Code of Muslim Law mainly deals with the law of inheritance and marriage.⁸⁰ It is emphasised that the Muslim Law contained in the Code represented usages and customs peculiar to local Muslims. The Code does not contain the principles of Islamic jurisprudence. Thus, it is quite different from the Arabic perspectives of Islam. The Code of Mohamedan law or Muslim Law, 1806 has been amended by modern statutes, which superseded the Code on several issues.⁸¹ Today Muslim law applies only to Muslims in the country in terms of judicial decision and according to the statutory provisions.

However, it is important note that Sri Lankan Muslim customary law does not deal with the concept of private property as such, except by way of succession or being incidental to marriage. Thus, it can be deduced that Muslim law did not impact on the intellectual property jurisprudence in the country.

2.8.(C)(I) Portuguese

Since the Portuguese made some influence to the Sinhalese society, a brief examination of Portuguese period in Sri Lanka is required for better understanding of the subject. The Portuguese arrived in 1505 with the intention to acquire a monopoly of Eastern Trade. Gradually the Portuguese were able to extend their authority and influence to Sri Lankan maritime regions.⁸² During the 151 years of their occupation in Sri Lanka, they were only confined to the Maritime Provinces of the island. Many failed attempts were made at various times to establish themselves in the Kandyan province.⁸³

⁷⁹ Muslim Law applies only to a person who is a Muslim. Although the Portuguese were concerned mainly with trade and religion during their rule in Sri Lanka, they recognised the Muslim laws and customs and administered it as a separate system. Generally, M.L.S. Jayasekera, *Customary Laws of Sri Lanka in Their Historical and Cultural Background* (Colombo: Ministry of Cultural Affairs, 1984). As mentioned above the compilation of the customary laws of the Muslims had taken place during the Dutch regime. The body of Muslim law was preserved by Proclamation, 23.09.1799. Likewise, the Charter of 1801 categorically provided that Muslims be governed in matters of succession, land, goods, and contract by their own laws and usages. Even though this was not the whole body of Mohammedan law it is only so much of it as had seen adopted in this country either by the legislative or by long established customs recognised by the courts. *Abdul Rahiman v Ussan Umma* (1917) 19 N.L.R.175. The Muslim Law Code has been repealed and today many legislations are in force to deal with the branches of law with which the Code was concerned.

⁸⁰ The Code of Muslim Law, 1806. Title I deals with succession, right of inheritance, and other issues occasioned by death. Title II dealt with matrimonial matters.

⁸¹ Muslim Intestate succession and Wakfs Ordinance, No.10 of 1931, Muslim Marriage and Divorce Registration Ordinance, No.29 of 1927, Muslim Marriage and Divorce Act, No.13 of 1951, etc.

⁸² The Portuguese possession in Sri Lanka was a part of their Estado da India. Generally, K.M. De Silva, *History of Sri Lanka* (Sri Lanka: University of Ceylon, 1959-60 and 1973).

⁸³ Kandy was a large Kingdom in the central part of Sri Lanka. Under Portuguese, there was little or no interference with the existing administrative structure of the territories they controlled. However,

Since the main goal of the Portuguese was to do mercantile activities they did not introduce a legal system compared to the Dutch. Nevertheless, they influenced the local customs that prevailed in the Maritime Provinces in Sri Lanka.⁸⁴

2.8.(C)(II) Property rights under the Portuguese

Portuguese officials compiled a '*tombo*' or land register, to provide a detailed statement of land holding, crops grown, tax obligation, and the nature of ownership. Since their major concern was the cinnamon trade, they introduced several important modifications to the traditional land tenure system.⁸⁵ As a result of the Portuguese period in Sri Lanka, there was greater commercial activity, increased monetisation of the economy and higher price for products. Nevertheless, the Portuguese made no impact on the intellectual property laws of the country.

2.8.(D)(I) The Dutch

The Dutch made significant influence upon the Sri Lankan concept of property and the legal system. A brief examination of their impact is required. The Dutch captured main centres of administration in the maritime areas of the island held by the Portuguese over a period in 1656 and governed until 1796 when the British conquered it.⁸⁶ A treaty was made between the ruler of the Kingdom of Kandy in the central province of the island and the Dutch East India Company.⁸⁷ The Dutch introduced a well-organised judicial system in the Maritime Provinces that were under their control.⁸⁸ During the Dutch regime, justice was administered by the Dutch according to the laws in force in Holland

the Portuguese used the native administrative hierarchy for their own purposes while leaving it much as they found it. Generally, De Silva, *supra* n.82.

⁸⁴ Para 2.8.(A).

⁸⁵ De Silva, *supra* n.2. Also T. Abeysinghe, *Portuguese Rule in Ceylon*, (Colombo: Lake House Investment Limited, 1966), 172-173.

⁸⁶ Though the Dutch East India Company first controlled only the coastal lands, they gradually pushed inland occupying considerable territory in southern, south western, and western Sri Lanka.

⁸⁷ The Treaty of 14th February 1766. According to Art.2 and 3 of the treaty, the Dutch secured the mastery of all the coastal low land. The Articles of the same treaty affirmed the sovereignty of the king in the central regions of the island.

⁸⁸ During the Dutch period, justice was administered by three kinds of Courts viz. the *Raden van Justitie* (the High Court of Justice), the *Landraden* (the land or country or district court) and the *Civiele Raden* or *Stads Raden* (the Civil or Town Courts) These courts also acted as courts of records. *Raden van Justitie* or High court of justice exercised an original and appellate jurisdiction in both civil and criminal matters. The *Landraden* courts were to be composed of Sinhalese officials. As per de Sampayo J. in *Karonchihamy v Angohamy* (1906)8 N.L.R.1 at.27. "It would be strange if this singular court knew or were able to apply the intricacies and refinements of the Roman Dutch Law". It seems that Sinhalese laws and customs were recognised by the Dutch judicial system. *Civiele Raden* was to act as a first instance court, which ultimately relieved the High Court of Justice from a number of small cases in its original jurisdiction. Generally, M.J.A.

and the Statutes of Batavia. The natives were governed according to the local customs if they were clear and reasonable; otherwise the Dutch Law was applied to the natives also.⁸⁹ No code of the customary laws of the Sinhalese of the Maritime Provinces appears to have been compiled in Dutch time. Nevertheless, Dutch Law largely superseded the customary laws of the Sinhalese of the Maritime Provinces in the later stage of Dutch Rule.⁹⁰

2.8.(D)(II) Property rights under the Dutch

The basic principles of Roman Dutch Law were applied in relation to property matters during the Dutch period. According to Roman Dutch Law, things can be classified as *res communes*, *res publicae*, *res universitatis*, *res nullius* and *res singulorum*.⁹¹ The Roman Dutch Law accepts Justinian's classification of things according to the nature such as *corporeal things* (tangibles) and *incorporeal things* (intangibles).⁹² Land usually was classified as corporeal things while certain rights over the land e.g. servitudes classified as incorporeal.⁹³

It is clear that the strongest influence of Roman Dutch law was on inheritance of property and indeed on the concept of private property.⁹⁴ From the late 17th century onwards, the Dutch had endeavoured to bring the transfer of property; movable and immovable, under certain rules and procedures prescribed by them. The regulations devised by the Dutch brought the instruments for the transfer of private property in line with Roman Dutch Law. The establishment of *Landraden* court in the areas, where they gained control, demonstrates the extent of their importance in property matters in the

Cooray, *Judicial Role under the Constitutions of Ceylon/Sri Lanka-A Historical and Comparative Study*, (Sri Lanka: Lake House Investment Ltd, 1982), Ch.1.

⁸⁹ T. Nadaraja, *The Legal System of Ceylon in its Historical Setting*, (Leiden, 1972), 10-11.

⁹⁰ Thus the basic but subtle question arises as to what matters were recognised by the Dutch authorities as the essential part of the Sinhalese customs in the Maritime Provinces. It is not possible to answer this question with certainty. By the last decade of the eighteenth century the obsolescence of Sinhalese customary law was an established fact; the Roman Dutch Law had superseded it. Nadaraja, *supra* n.89, pp.12-16.

⁹¹ R.W. Lee, *An Introduction to Roman Dutch Law*, 5th(edn) (Colombo: Government Press, 1953),123.

⁹² *Ibid.* p.123.

⁹³ There were significant changes over time to the meanings of the terms 'ownership', 'possession' of property and aspects of acquisition and alienation of land.

⁹⁴ The Dutch continued the Portuguese policy of respecting the traditional land structure and service relationship but used it methodically to enhance revenues. The Dutch tried to promote trade with neighbouring countries but under a strictly controlled system. They gained a considerable control over the exports such as cinnamon, elephants, pearls, areca nuts and other products.

Dutch period.⁹⁵ Nevertheless, as will be seen, the Dutch did not attempt to recognise and regulate the existing guild system in Sri Lanka.⁹⁶

2.8.(E)(I) Kandyan Law

The middle part of the country, the Kandy province, was controlled by neither Portuguese nor the Dutch. The changes, which took place in the Maritime Provinces, had little or no impact on the people of the Kandyan kingdom. Thus, the traditional Sinhalese system prevailed in the Kandyan kingdom including the administrative machinery, the social structure and the economy maintained their independence until 1815.⁹⁷ In terms of declared British policy, the territorial integrity and the law of the territory have not been changed until the British gained full control in 1818.⁹⁸ Thus, it is worthy to examine the remaining Sinhalese law of the land, the Kandyan Law, in brief to understand whether the recognition of the notion of private property and intellectual property existed until that time.

Kandyan law prevailed in the Kandyan provision at the time the British control. It still applies to Kandyans or the descendants of the people who lived in the Kandyan Provinces before 1815.⁹⁹ Section 4 of the Kandyan Convention 1815 declared that all classes of people are to be governed by their customs and laws. Furthermore, the Proclamation of 2nd March 1815 declared that

Dominion of the Kandyan Provinces¹⁰⁰ is vested in the Sovereign of the British Empire, and to be exercised through the Governors ... the Rights, Privileges and Powers of their persons and property, which their Civil Rights and immunities,

⁹⁵ The Roman Dutch Law aspects on property have changed over a period of time by new legislation. These legislations introduced new legal value and concepts because of policy changes. These policy changes related to distribution of land, tenancy right and the role of the State in the development of land utilisation, environment control, and city planning in the community. Thus, the statutes have replaced Roman Dutch Law.

⁹⁶ Para 2.4 and 3.2.

⁹⁷ Under the Proclamation of 2nd March 1815, the Kandyan kingdom became part of the British Empire.

⁹⁸ Sec.2 of the Proclamation of 1799.

⁹⁹ As per judicial recognition the Sinhalese are one race. Thus, a low country Sinhalese is not a person of "different race or nationality (in the words of sec. 2 of the Ordinance, No.15 of 1876) from a Kandyan Sinhalese. (*Manikkan v Peter* (1901) 4 N.L.R.243. (Since the Portuguese and Dutch governed the Maritime Provinces for a long time, many significant differences could be seen between the Sinhalese living in the Maritime Provinces and the rest of the country. The Portuguese influenced many of them and Dutch dialect as well as other factors such as religion, customs etc. Hence, the British called them 'low country Sinhalese' and the rest 'up country Sinhalese'.) Though this was the situation before 1505, it changed after the Portuguese arrival i.e., beginning of the Portuguese period on coastal areas of the country.

¹⁰⁰ The Proclamation does not define the phrase "Kandyan Provinces". Nevertheless, it is obvious that it meant the Kandyan kingdom, the territory in the interior of the island.

according to the laws, institution and customs established and in force amongst them.¹⁰¹

Furthermore, the Proclamation of 31st May 1816 provided that

The ancient Laws of Kandy are to be administered till his Majesty's pleasure shall be known as to their adoption in *toto* as to all persons within those Provinces, or their partial adoption as to the Natives, and the substitution of new Laws and Tribunals for the Trial and Punishment of his Majesty's European subjects, for offences committed therein.

It seems that Kandyan Law was applied to all persons within the Kandyan provinces during the early British rule. By the Proclamation of 21st November 1818, it made no changes in the law to be administered by the tribunals to Kandyans, Moorman, people of the low country and foreigners coming to the Kandyan province.

These Proclamations and the Convention evidenced the existence of a legal system in force at the time the country was ceded to the British. Thus, it seems that the unwritten ancient laws of Kandy, which were based on tradition and living testimonies, were applied to both the Asian and the European inhabitants regarding all matters.¹⁰²

However, a major rebellion in 1818 against the ruler of the Kandyan kingdom freed the British of their legal obligations.¹⁰³ Thus, they began to consciously depart from Kandyan customs and institutions and introduce their own. Furthermore, this situation led to a break up of the link between *Sangha*, Buddhist monks and the ruler. Furthermore, later some customs prevailing in the Kandyan provinces were abrogated by legislations.¹⁰⁴ By the end of 1830, the Kandyan law survived chiefly in matters relating to inheritance, the tenure of land, personal service for lands and marriages.¹⁰⁵

Ordinance No. 5 of 1852 introduced the law of England to certain cases¹⁰⁶ and restricted the operation of Kandyan Law¹⁰⁷ while leaving the application of Roman Dutch Law

¹⁰¹ Art.4 of the Proclamation of 02nd March 1815.

¹⁰² Generally Nadaraja, *The Legal System*, *supra* n.89.

¹⁰³ Many resources were demolished during this time. There is no firm evidence as to whether the Sinhalese Law or the Kandyan Law was systematically reduced to writing. Unlike Tesawalamai or Muslim Law there was no proper code or written work setting out the basic principles of Kandyan Law. Niti Nighanduwa *infra* n.110.

¹⁰⁴ Proclamation of 03rd January 1821, Proclamation of 25th September 1821, Proclamation of 14th July 1821, Proclamation of 28th October 1820, Proclamation of 18th September 1819.

¹⁰⁵ In 1833, the separate existence of the Kandyan provinces was abolished and they were amalgamated with maritime provinces in a single united administration for the whole island.

¹⁰⁶ This was amended by the Ordinances No.22 of 1866, No.2 of 1889, No.18 of 1914, No.25 of 1927, No. 51 of 1938, and No. 17 of 1944. The preamble of this Ordinance, No.5 of 1852 states that "...to introduce into Ceylon the law of England in certain cases, and to restrict the operation of the Kandyan Law."

where Kandyan law did not apply or customs were not in force.¹⁰⁸ This allowed the application of Roman Dutch Law in any matter or question arising for adjudication within the Kandyan Provinces. As a consequence of these limitations and alterations, today Kandyan Law is mainly seen as a personal law and its application is restricted to a few areas.¹⁰⁹

What can be deduced from this is that the Kandyan Law was suppressed by the application of Roman Dutch Law and English Law and thus the basic characteristics of the last indigenous legal system almost disappeared forever, which could have been used as guidance for present day legislations.

2.8.(E)(II) Intellectual Property

It is important to examine the recognition of intellectual property under Kandyan Law. Though the many sources of Sinhalese law were destroyed, an invaluable source as far as property matters are concerned was protected by Sinhalese family and published in 1880 as *Niti-Nighanduwa*.¹¹⁰ This book gives invaluable evidence of the recognition of intangible property under the Kandyan law, which was not seen in other customary laws in the country such as Muslim Law and Tesawalamai.

According to *Niti-Nighanduwa* property may be sub-divided into three categories. Those are

1. Immovable or movable or (*nischala dey* and *chanchala dey*)
2. Animate or inanimate (*sawinnanaka dey* and *awinnanaka dey*)
3. Material or immaterial (*drawyawat* and *adrawyawat*)

¹⁰⁷ Sec.7 of the Ordinance declared that "Where there is no Kandyan law or custom having the force of law applicable to the decision of any matter or question arising for adjudication within the Kandyan provinces, for the decision of which other provision is not herein specially made, the court shall in any such case have recourse to the law as to the like matter or question in force within the Maritime provinces, which is hereby declared to be the law for the determination of such matter or question"

¹⁰⁸ It is doubtful as to what extent Kandyan law prevailed, due to its suppression by the British.

¹⁰⁹ This has taken place due to many judicial decisions and legislation. Thus today marriage and divorce, adoption, gift, succession on intestacy, subject to the performance of service are seen as application of the Kandyan Law.

¹¹⁰ C.R.J. Le Mesurier, T.B. Panabokke, *Niti-Nighanduwa or the Vocabulary of Law. As it Existed in the Days of the Kandyan Kingdom*, (Colombo: Government Printer, 1880; Navarang, New Delhi, 1994), 12. Although the *Niti-Nighanduwa* was written in early days, it was published only in 1880. A leading authority on legal history and legal systems in Sri Lanka H.W. Thambiah in his *Sinhala Laws and customs* (Colombo: Lake House Investment Limited Co., 1968), pp. 38-43, has referred many text on Kandyan Law such as John D'Oyly (*Sketch of the constitution of the Kandyan kingdom*) Simon Sawers (*Digest of Kandyan Law*), John Armour (*Grammar of Kandyan law*) and Hayley (*Laws and Customs of Sinhalese*) but he has not come to a conclusion as to the approximate period in which *Niti-Nighanduwa* was written. However, by analysing the contents of that book pertaining to the *Niti-Nighanduwa* it appears that the *Niti-Nighanduwa* was in existence prior to the year 1829 AD.

Immovable were lands. Movable were slaves,¹¹¹ cattle, gold, silver, clothes, money, grain, and so forth. Immaterial things are such as honour, titles, a collection of rights and privilege such as right of inheritance, and *other titles of property*, offices, and so forth. (Emphasis added).

As seen in Part A of this Chapter, some forms of recognition and protection were given to intellectual property. Hence, it can be argued that the meaning of the term “other titles of property” under Kandyan Law include intellectual property rights, not in present forms such as copyrights etc. but a local recognition of the same in a different form. Thus, it can be logically concluded that the recognition and protection of intellectual property under the Sinhalese law were in force until the British began to change the entire legal system of the country by curtailing the customary laws, applying Roman Dutch Laws in the area where the customary laws could have been applied and introducing English laws.

2.8.(F)(I) Influence of the British

The British conquered the Dutch-held territories in the island in 1796.¹¹² The British Constitutional practice before the acquisition of the Maritime Provinces in Ceylon was that the laws of the conquered country continued in force until they were altered by them.¹¹³ Due to the practical difficulties that arose in the administration of justice, the Proclamation of 23rd September 1799 was declared. This Proclamation declared that:

The administration of Justice and police...shall be exercised by all courts of Judicature... Magistrates and Ministerial officers, according to the laws and institutions that subsisted under ancient government of the United Provinces (of the Netherlands) subject to such alterations, or might be made by lawful Authority.¹¹⁴

Because of the above-mentioned Proclamation, special laws,¹¹⁵ which had been applied to a particular section of the Ceylon inhabitants under the Dutch regime, continued. Where the special laws did not apply the residuary general law or “common law”¹¹⁶

¹¹¹ Slavery was totally abolished by Ordinance, No.20 of 1944.

¹¹² On 15.02.1796, the Governor of the Dutch possessions in Ceylon and the Adjutant General of British troops in the Island signed the Articles of Capitulation. Nadarajah, *The Legal System, supra* n.89.

¹¹³ *Campbell v Hall* (1774) 1 Cowper 204.

¹¹⁴ The Proclamation, 23rd September 1799.

¹¹⁵ As mentioned earlier at the time of British occupations there were well established systems of indigenous laws including Sinhala Law, Muslim Law and Tesawalamai Law. Generally, Nadarajah, *Legal System, supra* n.89.

¹¹⁶ Further, H.W. Thambiah., "Roman Dutch Law in Ceylon," *Ceylon Law Students Review* XIII (1951), 36-45, Nadarajah, *Legal System, supra* n.89, pp.247-248, S. Marsoof., "Common Law in

applied and continued to have legal validity subject to alteration.¹¹⁷ It seems that administration of justice, the concepts and scope of the terms 'civil wrong' and 'criminal offence' changed during the British period. Most of the criminal matters were governed according to English law while some civil matters were dealt according to customary laws.

2.8.(F)(II) Property rights under the British

During the British period, legislation was introduced to regulate the area of property rights of the people of the country. Most of the legislation was aimed at state control of land, qualifying private property rights of the people and altering or regulating the principles of Roman Dutch Law pertaining to the right of property.¹¹⁸

However, it is important to consider the steps taken by the British to recognise private property rights in relation to intangible property in Sri Lanka. Promulgating legislation pertaining to industrial property in the first instance and intellectual property legislation in the later stages did this. The Governor of Sri Lanka enacted most of this legislation on behalf of the Crown.¹¹⁹ This legislation had been supported by subsidiary legislation promulgated in the form of rules and regulations.

2.8.(F)(III) Introduction of Commercial Laws

Introduction of English law to the country was done in different methods. One way of introducing English general law to Sri Lanka was by direct extension of Imperial Laws and Statutes of the United Kingdom, as Sri Lanka was a colony of the Great Britain. In this process, many laws were introduced into Sri Lanka until her independence. For instance the Colonial Laws Validity Act (1865), the Air Navigation Acts (1920 and

Ceylon," *Colom LR* 2 (1971), 83-93, N. Chandrahasan, "Roman Dutch in Ceylon-A Comment on *De Costa v Bank of Ceylon*," *Colom LR* 3 (1972), 74-84, L.J.M. Cooray., "Common Law of Ceylon," *C.L.S.J* X (1972), xlv-xlvii, L.J.M. Cooray., *An Introduction to the Legal System of Ceylon* (Colombo: Lake House Investment Ltd, 1972), 71-75, *Korossa Rubber Company v Silva* (1919) 20 N.L.R.65, *Sameed v Segutamby* (1925) 25 N.L.R.481, *Sultan v Peris* (1934) 35 N.L.R.57; *Kodeeswaran v Attorney General* (1970) 72 N.L.R.337, *Lily M De Costa v Bank of Ceylon* (1970) 72 N.L.R.457.

¹¹⁷ Sec.4 of the Kandyan Convention, 1815. Also *Sultan v Peiris* (1934) 35 N.L.R. 57 at 67-68, and 80-81.

¹¹⁸ The following legislations are more important in this regard. Encroachment Upon Crown Land Ordinance, No.12 of 1840, Land Registration Ordinance, No.8 of 1863, No.5 of 1877, No.4 of 1887 and No.3 of 1907, Prescription Ordinance, No.22 of 1871, Prevention of Fraud Ordinance, No.7 of 1840, Sannas and Old Deed Ordinance, No.6 of 1866. Land Development Ordinance, No.19 of 1935, Irrigation Ordinance, No.32 of 1946, Crown Lands Ordinance, No.8 of 1947, Land Settlement Ordinance, No.20 of 1931, Married Women's Property Ordinance, No.18 of 1923.

¹¹⁹ These legislations will be considered in greater detail in the forth-coming chapters.

1947), the Copyright Act (1911),¹²⁰ the Indian and Colonial Divorce Jurisdiction Acts (1926 and 1940), and the Extradition Acts (1870 and 1873) applied English law to Sri Lanka.¹²¹

The second way of introducing English Law was through local legislation. English statutory laws, common law, and law of equity were introduced in this way. This was done through many methods, such as an inclusion of a mere reception clause in the local enactment in Sri Lanka. Ordinance, No.5 of 1852, and Ordinance, No.22 of 1866 gave legislative power to administer English law in accordance with the needs of the British Commercial system.¹²² As pointed out by the court in *De Costa v Bank of Ceylon*¹²³ the legislation of 1852 and 1866 introduced a systematisation of commercial law, which had the multiple advantages of being at once familiar, practical, and international.¹²⁴

Local legislation relating to commercial matters followed the English statutes on the subjects closely. As a consequence of the 1852 and 1866 Ordinances, English Common Law and Rules were allowed to be administered in the country.¹²⁵ However, it should be mentioned that the law to be administered in Ceylon in respect of the matters specified in the Ordinance should be the same as would be administered in England in a like case at

¹²⁰ It is important to emphasize here that this Act was in force until the enactment of the Code of Intellectual Property Law Act, No.52 of 1979.

¹²¹ This situation ceased with the coming into force of Art.1 of the Ceylon Independence Act of 1947. It declared, "no act of the United Kingdom Parliament passed on or after that date shall extend or be deemed to extend to Ceylon as a part of the law of Ceylon, unless it is expressly declared in that Act that Ceylon has requested and consented to its enactments". Some provisions of the Independence Act will be examined in the relevant chapters.

¹²² Section 3 of the Proclamation, No.5 of 1852 declared that "In all questions or issues which may hereinafter arise or which may have to be decided in Ceylon with respect to the law of partnerships, corporation, bank and banking, principals and agents, carriers by land, life and fire insurance, the law to be administered shall be the same as would be administered in England in the like case at the corresponding period of such question or issue had arisen or had to be decided in England, unless in any case other provision is or shall be made by any enactment now in force in Ceylon or hereafter to be enacted."

¹²³ (1970) 72 N.L.R. 457 at p.517.

¹²⁴ Thus the law relating to shipping and maritime matters, Bills of Exchange, partnerships, joint stock companies, corporations, banks and banking, principals and agents, carriers by land, life and fire insurance were as administered by English Law. However, the proviso of the Sec.1 of the Proclamation, No.22 of 1866 declared "nothing herein contained shall be taken to introduce in to Ceylon any part of the law of England relating to the tenure or conveyance, or assurance of, or succession to, any land or other immovable property, or any estate, right, or interest therein".

¹²⁵ Sec.58(2) of the Sale of Goods Ordinance, No.11 of 1896 provided that the "rules of the English Law, including the law of merchant, save in so far as they are inconsistent with the express provisions of this ordinance" should apply to contracts for the sale of goods". Sec. 97(2) of the Bills of Exchange Ordinance, No.25 of 1927 provided that "the rules of Common law of English, save in so far as they are inconsistent with the express provisions of this ordinance or any other ordinance for the time being in force, should apply to bills of exchange, promissory notes and cheque".

the corresponding period.¹²⁶ Thus, it is very clear that the “*rules of the common law of England*” and “*rules of the English law*” were administered in Ceylon only as they relate to the distinctive features of the different subjects enumerated in the legislation.¹²⁷

The other ways of reception of English statutory laws, common law, and law of equity was done through general reception statutes and through reception clauses in specific local legislation. An example of this mode of reception of English law is sec. 97(2) of the Bills of Exchange Ordinance, No.25 of 1927.¹²⁸ The reception of English statutory laws, common law, and law of equity can be seen through some local legislation, which were modelled on English statutes or influenced by English law. The Married Women’s Property Act, No.18 of 1923, the Companies Act, No.51 of 1938,¹²⁹ Prevention of Fraud Ordinance, No.7 of 1840, and the Penal Code, No.2 of 1883 are good examples of the same.

¹²⁶ Sec.1 of Ordinance, No.5 of 1852 states that “The law to be hereafter administered in this colony in respect of all contracts or questions arising within the same relating to ships and to the property therein, and to the owners thereof, the behaviour of the master and mariners, and their respective rights, duties, and liabilities, relating to the carriage of passengers and goods by ships, to stoppage in transitu, to freight, demurrage, insurance, salvage, average, collision between ships, to bills of lading, and generally to all maritime matters, shall be the same in respect of the said matters as would be administered in England in the like case of the corresponding period, if the contract been entered into or if the act in respect of which any such question shall have arisen had been done in England, unless in any case other provisions is or shall be made by any Ordinance now in force in this colony or hereinafter to be enacted”. And also the sec.2 of Ordinance, No.5 of 1852 states that “The law hereinafter administered in this colony in respect of all contracts and questions arising within the same upon or relating to bills of exchange, promissory notes, and cheques, and in respect of all matters connected with any such instruments, shall be the same in respect of the said matters as would be administered in England in the like case of the corresponding period, if the contract had been entered into or if the act in respect of which any such question shall have arisen had been done in England, unless in any case other provision is or shall be made by any Ordinance now in force in this colony or hereinafter to be enacted”. In addition, the sec.1 of the Ordinance, No.22 of 1866 declares that the law of England should be observed in all Commercial matters. The Sec.1 of the Ordinance, No.22 of 1866 read as follows “In all questions or issues which may hereinafter arise or which may have to be decided in this colony, with respect to the law of partnerships, joint stock companies, corporations, banks and banking, principals and agents, carriers by land, life and fire insurance, the law to be administered shall be the same as would be administered in England in the like case, at the corresponding period, if such question or issue had arisen or had to be decided in England, unless in any case other provisions is or shall be made by any Ordinance now in force in this colony or hereinafter to be enacted..”

¹²⁷ Thus the court has applied the Roman Dutch Law regarding the right of a pledge to sell the security in *Hong Kong and Shanghai Bank v Krishnapillai* (1932)33 N.L.R.249, The right of the mortgage of shares in a company was determined by the Roman Dutch Law and not by the English law in *Mitchel v Fernando* (1946)46 N.L.R.265.

¹²⁸ Sec.98(2) of the Bills of Exchange Ordinance, No.25 of 1927 provided that “the rules of Common law of England,... save in so far as they are inconsistent with the express provisions of this Ordinance, or any other ordinance for the time being in force, shall apply to bills of exchange, promissory notes and cheque”.

¹²⁹ This act was repealed by the Companies Act, No.17 of 1982.

2.8.(F)(IV) Introduction of intellectual property law

Promulgation of laws relating to intellectual property started in 1859 when the legislature of the country passed legislation to regulate laws relating to patents.¹³⁰ Then the law in relation to merchandise marks was introduced in 1865 and amended later.¹³¹ This law was in force until the enactment of the Code of Intellectual Property Law Act, No.52 of 1979. Trade marks law was introduced in 1875 as part of the extension of British legislation but a domestic legislation was made 1888 and amended subsequently.¹³² Copyright law was introduced in 1898 and amended later.¹³³ In 1906, Ordinance, No.09 of 1906 introduced Design laws. This Ordinance was also amended from time to time.¹³⁴ It is noted that all intellectual property laws introduced by the British were in force until the Code came in to force in 1979.

The above observation of the British period shows that the scope and the application of not only the special laws but also the Roman Dutch Law were restricted.¹³⁵ However, from the beginning to the end of the British era in Sri Lanka many reasons existed to depart from the basic principles of Roman Dutch Law.¹³⁶

As seen later in this study the British ignored the customs and established principles of laws of the country such as Kandyan Law while promulgating laws pertaining to

¹³⁰ Exclusive Privileges to Inventors Ordinance, No.06 of 1859 as amended by No.12 of 1871, No.16 of 1892, No.06 of 1897, No.06 of 1898 and No.05 of 1904.

¹³¹ Ordinance, No.13 of 1888, No.14 of 1892 and No.10 of 1915 amended Merchandise Marks Ordinance, No.05 of 1865.

¹³² *Infra* Para 3.4. Trade Marks Ordinance, No.14 of 1888, No.04 of 1890, No.06 of 1904, No.09 of 1906, No.15 of 1908, No.23 of 1918, No.05 of 1919, No.15 of 1925, Rules of 1926 and 1929, and Amendment Ordinance, No.23 of 1932.

¹³³ Telegram Copyright Ordinance, No.19 of 1898. Copyright Ordinance, No.12 of 1908, No.20 of 1912, No.11 of 1918, and No.06 of 1919.

¹³⁴ Ordinance, No.23 of 1914, No. 24 of 1932, No.32 of 1949.

¹³⁵ Roman Dutch Law is the residuary law of the country. The general law of the country consists of a mixture of English law and Roman Dutch Law.

¹³⁶ Those reasons are Roman Dutch Law was similar to or consistent with English Law hence English law is applicable, Roman Dutch Law did not deal adequately with the situation etc., *John Gognell and Co. Ltd., v Sivaprakagam* (1913) 15 N.L.R.33 *Kapadia v Mohamed* (1919) 20 N.L.R.314, *Krishanan Chetty v Kandesamy* (1924) 3 T.C.L.R.21. This was perhaps inevitable, because the legal atmosphere in the British period strongly favoured the adoption of the English Law. One reason for this was that the Roman Dutch law was inadequate to meet expanding social and economic needs of the country. However, it is submitted that, the basic question arises as to how the British Judges administered justice applying the Roman Dutch Law principles. Especially there are many differences between Common law and Civil law. For instance, the priority in civil law is given to doctrine over jurisprudence, while the opposite is true in the common law. The common law focuses on facts while civil law focuses on legal principles. Another difference is that Common law jurisprudence sets out new specific rule to a new specific set of facts and provides the principles of law, while civil law jurisprudence applies general principles, and is only a secondary source of law of explanation. It is doubtful whether Sri Lankan lawyers made sufficient advocacy at that time since they followed English tradition.

intellectual property. Though they have applied principles of the Roman Dutch Law to many other areas, they never attempted to apply those principles to intellectual property matters. Nevertheless, it is submitted that when the courts turn to general principle to assist in interpreting intellectual property laws, they may consider and use Roman Dutch law.

PART C

A brief examination of some Buddhist principles

2.9 Introduction

As mentioned earlier, Buddhism played an important role in moulding the social life of the country until the country was ceded to the United Kingdom in 1815 A.D.¹³⁷ Before embarking on the development of a theoretical frame for the protection of intellectual property in Sri Lanka, it is imperative that one understands the basic concepts of Buddhism as a background.

2.9.(A) Dictionary definition

Before attempting to summarise the philosophical aspect of Buddhism, let us be clear of its common meaning. Collins dictionary defines Buddhism as follows.

Buddhism is religious teaching propagated by the Buddha and his followers, which declares that by destroying greed, hatred, and delusion, which are the causes of all suffering, man can attain perfect enlightenment.¹³⁸

Buddhism constitutes the set of teachings expounded by Gōtama the Buddha and popularly known as *dhamma* or *dharma*.¹³⁹ Though the literal meaning of *dhamma* is

¹³⁷ The Island as a whole or parts of it was governed by more than 185 kings from the dawn of its history up to 1505 A.D. Also De Silva, *supra* n.81, pp.565-569 and G.P.V. Somaratne, *The Political History of the Kingdom of Kotte, 1400-1521* (Nugegoda, Sri Lanka: Deepanee Printers, 1975),232-233.

¹³⁸ Collins Dictionary and Thesaurus, (England: HarperCollins, 1991).

¹³⁹ The *dhamma* or the Buddhist teaching was authoritatively divided into three groups, but they were inter dependent facets of one process leading to *nibbāna* or ultimate enlightenment. Dhamma is preserved in three great collection of books called *Ti-pitaka* or three basket because it consists of three collection of writings namely (a) the *vinaya pitaka* or collection of discipline, containing the rules of the monastic order, and the *Vinaya pitaka* is divided to five sections or *pāli*. (b) the *sutta pitaka* or collection of discourses, (c) the *abhidhamma pitaka* or philosophical collection presenting the teaching of the *Sutta pitaka* or collection of discourse in strictly systematic and philosophical form. The *Abhidhamma pitaka* contains of seven divisions or *prakarana*. *Sutta Pitaka* is primarily composed of dialogues between the Buddha and other people and divided into five branches (a) *Dīgha Nikāya*, collection of long discourses, which consists of 34 suttas. (b) *Majjhima Nikāya*, or the collection of middle-length discourses, which consists of 152 suttas of varying length, (c) *Anguttara Nikāya* or the collection of further-factored discourses, which consists of 8,777 short suttas, grouped together into eleven nipātas according to the number of items of dhamma covered in each sutta. For example, the Eka-nipāta ("Book of the Ones") contains suttas about a single item of

righteousness, in this context it denotes a set of dealings expounded by the Buddha. Thus, dhamma is not merely an ethic, or a philosophy, but a way of life, a design for living. In other words, Buddhism can be perceived as a path of moral purification and the entire path of moral purification is comprised of ethical purification. According to Buddhism, an ideal moral perfection is the ultimate goal of a life that is to attain perfect enlightenment, the *nibbāna* or *nirvāna*.

2.9.(B) Enlightenment

In order to attain moral perfection one has to eradicate the unwholesome psychological roots or fundamental negative mental attitudes (*akusalamūla*) of human behaviour namely craving or greed (*lōbha*), ill-will or hatred (*dōsa*), and ignorance or delusion (*mōha*). These *lōbha*, *dōsa*, and *mōha* are described as unwholesome roots.¹⁴⁰ They are called unwholesome because, by the influence of them, people commit unethical acts such as taking of life of others, misappropriation of other's belongings, making false speech or representations, committing adultery etc. Thus, by destroying greed (*lōbha*), hatred (*dōsa*) and delusion (*mōha*) which are the root causes of suffering (*dukkha*)¹⁴¹ one can attain perfect enlightenment (*nibbāna*).

The Buddhist greatly values human existence and does not believe in the golden age of a perfect society or permanence of social conditions. Nevertheless, it is difficult to be born as a human being—(*manussāttam dullabo*).¹⁴² Thus, every one should attempt to live as a true human being. According to Buddhism, the main causes of social imperfection are the unwholesome roots. Yet Buddhism strongly believes that social imperfection can be

Dhamma, (d) *Samyutta Nikāya*, the grouped discourses, which consists of 2,889 shorter suttas grouped together by theme into 56 samyuttas, (e) *Khuddaka Nikāya*, the division of short books, consisting of 15 "books." *Khuddakapāṭha* (the reading of short passages), *Udāna* (solemn utterance), *Sutta Nipāta* (collection of sutras), *Therīgāthā* (verses of the Elder Nuns), *Theragāthā* (verses of the Elder Monks), *Dhammapada* (stanzas or gāthā on the teaching), *Itivuttaka* (thus it is said- from the introductory phrase to each sutra), *Vimāna-vatthu* (story about heavenly palaces), *peta-vatthu* (stories about hungry ghosts), *jātaka* (previous lives of the Buddha), *Niddesa* (exposition), *patisambhida-magga* (the way of analysis), *apadana* (verse account of the lives of certain monks and nuns), *buddhavamsa* (the lineage of the Buddha) and *cariya-pitaka* (collection concerning conduct).

¹⁴⁰ Sigalovada Sutta or the Buddhist layman's ethics at Dīgha Nikāya, states four mental drives that cause harm to individuals and society namely prejudice (*chanda*), ill will (*dōsa*), fear (*bhaya*) and ignorance (*mōha*). Here prejudice is complementary to craving. <http://www.accesstosight.org/canon/sutta/digha/dn31.html> (Accessed: 01.12.2004).

¹⁴¹ Pali term *dukkha* is translated in to English as suffering in this context. *Dukka* is a term, which includes all types of unpleasant experiences such as worry, fear, sorrow, dissatisfaction, disharmony etc.

¹⁴² Dhammapada, Buddhavaggo, V.182 states that *Kicco manussa patilābho* at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/02Dhammapada/14-Buddhavaggo-p1.html#V182> (Accessed: 01.12.2004).

reduced, by the reduction of all unwholesome psychological roots of human behaviour that is to say *lōbha*, *dōsa*, and *mōha*. Many utterances of Buddha are illustrative of the above observance. For instance

He who understands the great wisdom does not think of harming himself or another, nor harming both alike. He rather thinks of his own welfare, of that of others, of that of both, and of the welfare of the whole world. In that way, one shows understanding of great wisdom.¹⁴³

Hence, it is worth examining the path to *nibbāna* in order to understand the characteristics embedded in them with a view to utilising them in the process of formulation of the theoretical framework at the end of this chapter.

2.9.(C) Panca sīla or the code of five moral precepts

As mentioned above the ultimate goal of a Buddhist is to achieve *nibbāna* or perfect enlightenment. In order to achieve *nibbāna* one has to eradicate unwholesome psychological roots or fundamental mental attitudes (*akusalamūla*) of human behaviour by observing five precepts or *panca sīla*¹⁴⁴ as the first step of the process. In other words, ultimate freedom¹⁴⁵ is to achieve in full, release from bondages such as greed, hatred, and delusion, which clearly are also the root causes of all social wrongs. It seems that the observance of these five precepts constitutes the basic moral code of Buddhism.

Buddhism recognises a valid basis for the distinctions people make between what is morally right or wrong and good or bad. According to Buddhism when one is observing *panca sīla* it leads to avoidance of the creation of misery to oneself and other as well as the alleviation of the suffering (*dukkha*) of others. A classic definition of good and bad action is given in Buddhist discourse. It says:

Whatever action, bodily, verbal, or mental, leads to suffering for oneself, for others or both, that action is bad (*akusala*). Whatever action, bodily, verbal, or

¹⁴³ Anguttara Nikāya of Sutta Pitaka.

¹⁴⁴ Five precepts are as follows (1) refrain from taking life of others, (2) refrain from taking what is not given, (3) refrain from wrong conduct in sexual desire, (4) refrain from making false representations and (5) refrain from consuming intoxicants. All the precepts are intimately connected to the central concept of karma. As can be seen ones present condition have been predetermined by past action and ones present actions will determine the future (post-death) conditions. This overarching causal framework is integrated into the Sri Lankan understanding of the truth about ultimate existence.

¹⁴⁵ This is different from what the West understands as freedom. In the West, freedom revolves around the rights of individual such as freedom of speech. In Buddhism, freedom means freedom from personal desires or attachments.

mental, does not lead to suffering for oneself, for others or for both, that action is good (*kusala*).¹⁴⁶

The benefit of observation of these basic precepts of *pancha sīla* in daily life was discussed in detail in Buddhist discourse. For instance perfect keeping of the five precepts gives one the right to claim that one who is infallibly on the path to *Nibbāna* (... *pancasu sikkhā padesu kammantam, ...niyato sambodhi parayano*).¹⁴⁷ Furthermore, on another occasion Buddha said that *dhammo have rakkahthi dhammachāri*. This means that by protecting oneself (e.g., morally), one protects others; by protecting others, one protects oneself.¹⁴⁸ Thus, when the *panca sīla* or five precepts are observed scrupulously it protects oneself and others very adequately.¹⁴⁹

2.9.(C)(I) Adinnādānā veramanī

For the purpose of this study, the focus will be primarily made on the second and fourth precepts since those precepts are more relevant. The second precept is *adinnādānā veramanī*. This generally translates to 'do not steal'. Nevertheless, the meaning of *adinnādānā* goes beyond the concept of theft. The term *adinnā* means 'not given' and *ādānā* means taking, seizure, misappropriation, and stealing. Thus, the cumulative meaning is, 'do not take what has not been given'. In other words ...*parassa paravittupakaranam...*, do not deprive another of what legitimately belongs to him.¹⁵⁰ In addition, one should not jeopardise the interest of others - *paravyābādhāya samvatteyya*.¹⁵¹ Thus, this precept precisely impacts on the legitimacy of ownership.¹⁵²

According to the Buddha's teaching, five elements have to be met to complete the action, which amount to breach of the second precept.

¹⁴⁶ Ambalattikārahulovadasutta, of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 01.12.2004).

¹⁴⁷ Gihi sutta, Upāska Vagga of Anguttara Nikāya (Panchanipātha) at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara3/5-pancakanipata/018-upasakavaggo-e.htm> (Accessed: 01.12.2004).

¹⁴⁸ Mahādahammapala Jataka, Khuddaka Nikāya (Dasaka Nipatha, Jataka Pali) of Sutta Pitaka.

¹⁴⁹ The Buddha described the unpleasant consequences of not sticking to the precepts. Vipaka Sutta of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an08-040.html>. (Accessed: 01.12.2004).

¹⁵⁰ Mahatanhāsankhaya Sutta of Majjhima Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/2Majjhima-Nikaya/Majjhima1/038-mahatanhasankhaya-sutta-e1.htm> (Accessed: 01.12.2004).

¹⁵¹ Ambalattikā Rāhulovada Sutta of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 01.12.2004).

¹⁵² Chulla Rahulovāda Sutta of Majjhima Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/2Majjhima-Nikaya/Majjhima3/147-cularahulovada-e.htm> (Accessed: 01.12.2004).

- (1) Existence of a thing.¹⁵³
- (2) Your knowledge of the fact that it belongs to a person other than yourself.¹⁵⁴
- (3) You must have the intention to take/appropriate it.¹⁵⁵
- (4) You must employ a device or perform an act of taking/appropriating it.¹⁵⁶
- (5) The thing must be taken/appropriation.¹⁵⁷

Thus, if any of the constituents is missing in its operation, it would not be counted as committing the offence of taking of what is not given. When all these constituents are met then it amounts to a breach of the second precept. Thus, no matter what the device used for taking. Furthermore, it is clear that a wrong act (*actus reus*) as well as wrong intention (*mens rea*) is needed to commit the wrong (*akusala*) which amounts to taking of what is not given. Accordingly, when a person refrains from taking what has not been given it helps in two ways. Firstly, it leads a person to eradicate fundamental mental attitudes, namely greed (*lōbha*), hatred (*dōsa*) and delusion (*mōha*) and thereby help him to reach towards *nibbāna*. Secondly, it maintains the harmony of the society by protecting property rights.

2.9.(C)(II) *musāvādā veramanī*

The fourth precept of *panca sīla* is *musāvādā veramanī*. This is generally translated as ‘abstain from lying’. However, the word *musā* means false and *vādā* means representations. Thus, the cumulative meaning of this precept is refraining from making false representations in any form or manner.¹⁵⁸ As one authority has explained, the precept “*musāvādā veramanī*” applies “to cover the act of telling an untruth, the concealing of the truth in such a manner as to convince another person that an untruth is a truth, the use of exaggerated language, in short, everything that is in any sense a

¹⁵³ A thing is qualified as ‘what is not given’. Thus, anything that may be a ‘thing’ constitutes this element.

¹⁵⁴ Perception-one perceives that the ‘thing’ belong to another person etc., and the ‘thing’ as being something not given.

¹⁵⁵ Intention-one decides to take it.

¹⁵⁶ An effort to take/appropriate it.

¹⁵⁷ In terms of Visuddhi Magga there is no offence if one takes an object even if it is “not given” if one sincerely believes that it is ownerless or thrown away. Likewise, it is not an offence if one takes an object mistaking it for his own or as belonging to a friend who has given him permission to take things on trust etc. Thus, the intention is the essential factor of deciding the gravity of an offence. Thus once Buddha said, “If there be no wound in one’s hand, one may carry poison in it. Poison does not affect him who has no wound. There is no evil (effect) for him who does no wrong. At <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/02Dhammapada/09-Papavaggo-e2.html#V124> (Accessed: 01.12.2004).

¹⁵⁸ What motivates people to tell lies: Atthakāranā Sutta of Samyutta Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 01.12.2004).

departure from a reliable sober statement of fact.”¹⁵⁹ Furthermore, this precept covers communication through the door of body, which includes gestures, presence, or absence etc.¹⁶⁰

The danger of proneness to false representation is highlighted in Buddhist discourse stating that he who resorts to making false representation with ease is capable of committing any crime. Accordingly, *natthi pāpam akāriyam* meaning no crime is too difficult for him.¹⁶¹ The worthiness of not making false representation is discussed in many Buddhist discourses and it is said that one should not make false representation, with awareness, for one’s benefit, for the benefit of others or for the sake of making material or otherwise gaining.¹⁶² The departure from the truth can occur in one of two ways. By a deliberate lie or by representing something as a statement of fact though it is a misrepresentation of truth. Either way bars the individual from his attempt to attain the supreme enlightenment i.e. *nibbāna*.¹⁶³

2.9.(D) Noble eight-fold path (ariya asṭṭāṅgika magga)

It is clear from the discussion so far that the first step of the path to *nibbāna* or the enlightenment is the observance of *panca sīla* or five precepts. The second step of the path is to live according to the *ariya asṭṭāṅgika magga*¹⁶⁴ or noble eight-fold path.¹⁶⁵ Since those two components of the *ariya asṭṭāṅgika magga* or noble eight-fold path namely right words (*sammā vācā*) and right livelihood (*sammā ājeeva*) are very relevant to one of the main arguments of this study, an examination of these two aspects is therefore made.

¹⁵⁹ H. Saddhatissa, *Buddhist Ethics: Essence of Buddhism* (London: George Allen & Unwin Ltd, 1970), 106.

¹⁶⁰ Ibid. p.107.

¹⁶¹ Verse No.176 of the Dhammapada, which state that “*Ekam dhammam atītaṣṣa- musāvādiṣṣa jantuno – vitinnaparalokassa - natthi pāpam akāriyam*” at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/02Dhammapada/13-Lokavaggo-p1.html> (Accessed: 01.12.2004).

¹⁶² Sāleyyaka Sutta of Majjama Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn041.html> (Accessed: 01.12.2004).

¹⁶³ Ambalathikarahulovada Sutta of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 01.12.2004).

¹⁶⁴ Magga-vibhanga Sutta of Samyutta Nikāya for the summary of the noble eight-fold path at <http://www.accesstoinight.org/canon/sutta/samyutta/sn45-008.html> (Accessed: 01.12.2004).

¹⁶⁵ This eight fold paths is as follows: Right view (*sammā ditti*), Right thought (*sammā sankappa*), Right words (*sammā vācā*), Right action (*sammā kammantha*), Right livelihood (*sammā ājeeva*), Right effort (*sammā vāyama*), Right mindfulness (*sammā sati*), Right concentration (*sammā samādhi*) The first two paths deal with wisdom (*paññā*). The next three paths deal with morality (*sīla*) and the last three deal with concentration (*samādhi*). It is obvious that the second part of the eight-fold path is important to understand the morality of the given society.

2.9.(D)(I) Right words (*sammā vācā*)

Sammā means righteous and *vācā* means speech. As discussed under the description of five precepts, one must refrain from making false representations as a first step to achieve *nibbāna* or perfect enlightenment. It is needed to observe this *sammā vācā* precept in the second part of the path to *nibbāna*, a higher standard than in the five precepts.¹⁶⁶ Thus, *sammā vācā* requires not only refraining from making false statements but also not making dishonest, harmful, defamatory speeches.¹⁶⁷

2.9.(D)(II) Right livelihood (*sammā ājīva*)

The next component of the eight-fold path is to be considered is *sammā ājīva*, which directly affects property matters. The term *ājīva* implies the means whereby one makes a living. The term *sammā* implies righteous or justifiable. Thus, cumulative meaning of *sammā ājīva* is 'right livelihood'.¹⁶⁸ Many Buddhist discourses show that word livelihood implies not only a pure means of earning one's living but it also means that the one has to be morally responsible towards the society. While observing *panca sīla* one has to live according to the eight-fold path as a second step to *nibbāna*. Therefore, one should abstain from making one's living through a wrong way.¹⁶⁹ According to Buddhist discourse, there shall be no violation of state law in acquiring private property. This is specified as *adan-āraho*. Such acquisition shall not be questionable under good public opinion. This is *ananuvajjo*. As will be seen later in this Chapter¹⁷⁰ wealth gives happiness to the owner. Such happiness can be gained when wealth is acquired by not violating the social order.

¹⁶⁶ Vacā Sutta of Anguttara Nikāya, secret of blameless speech at <http://www.accesstoinight.org/canon/sutta/anguttara/an05-198.html> (Accessed: 01.12.2004).

¹⁶⁷ Magga-vibhanga Sutta of Smyutta Nikāya states that "And what is right speech? Abstaining from lying, from divisive speech, from abusive speech, and from idle character: This is called right Speech" at <http://www.accesstoinight.org/canon/sutta/samyutta/sn45-008.html> (Accessed: 01.12.2004). Also Abhaya Sutta of Majjhima Nikāya for right speech at <http://www.accesstoinight.org/canon/sutta/majjhima/mn058.html> (Accessed: 01.12.2004).

¹⁶⁸ Brahmajala Sutta of Digha Nikāya for wrong livelihood at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/1Digha-Nikaya/Digha1/01-brahmajala-e.htm#q%20001> (Accessed: 01.12.2004).

¹⁶⁹ *dhammikehi dhammaladdhehi bhōgehi* - Mundajavagga of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara3/5-pancakanipata/005-mundarajavaggo-p.htm> (Accessed:01.12.2004).

¹⁷⁰ Para 2.9.(F)(II).

2.9.(E) Four noble truths (*chathurārya sathyaya*)

The third step of the path is the realisation of four fundamental truths pertaining to ones life, ones existence, known as *Chathurārya sathyaya*¹⁷¹ or four noble truths.¹⁷² Thus when a person observe *sīla* (morality) and lives according to the eight-fold noble path and when one realizes the four noble truths then he or she can attain the ultimate happiness or *nibbāna*.¹⁷³

The forgoing discussion emphasised that morality is an essential factor throughout the Path to *nibbāna*. Hence, it seems that the Buddhist way of life is focused more toward the morality of the society.

2.9.(F) Notion of private property

Since the concept of private property and intellectual property is the subject matter of this study an examination of Buddhist understanding of property and related matters is required. Economic stability is essential for man's welfare and happiness. Thus, material wealth is not a foreign concept to Buddhism. It is understood that the attainment of prosperity and happiness through material wealth in an ethical manner ensures one's gradual progress on the path of *nibbāna*. On several occasions, Buddha addressed the issue of material wealth, right modes of acquisition, and the way to use wealth and benefit from it.

2.9.(F)(I) Acquisition

According to Buddhist teaching, one of the four cardinal wishes of an individual is "may wealth by lawful means come to me" (*bhōghā me uppajjantu saha dhammena*).¹⁷⁴ This emphasises that Buddhism strongly rejects the acquisition of wealth by wrong means.

¹⁷¹ Saccavibhanga Sutta of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn141.html> (Accessed: 01.12.2004).

¹⁷² The first is *dukkha satyaya*. This means that our life is impermanent and is attended with conflicts, sufferings, and dissatisfactions both physical and psychological. The second one is *samudaya satyaya*. This means that the cause of all these sufferings, conflicts and dissatisfactions, is our own selfish desire due to our false idea of self. The third, *nirodha satyaya*, declares that by getting rid of selfish desire, of the idea of self, one can get rid of these conflicts and sufferings, can attain perfect freedom, harmony and peace, and realize the absolute truth or *nibbāna* here and now, in this very life. Lastly, the fourth *mārga satyaya* teaches the way, the path, to attain the state of peace through our own efforts, through our moral, spiritual, and intellectual discipline and perfection. Also Sammaditthi Sutta of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn009.html> (Accessed: 01.12.2004).

¹⁷³ In theory, the goal of *nibbāna* is attainable by anyone who follows the path. For those unable to pursue the ultimate goal, the proximity goal of better rebirth through improved karma is an option.

¹⁷⁴ Pattakamma Sutta of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara2/4-catukkanipata/007-pattakammavaggo-p.htm> (Accessed: 01.12.2004).

Thus, *bhōgehi dhammikehi dhammaladdehi*-wealth should be earned by lawful means.¹⁷⁵ In Smayutta Nikāya, the Buddha recommended the earning by lawful means without violence.¹⁷⁶ On many occasions, Buddha gave a comprehensive prescription for attainment of prosperity and happiness without ever deprecating the lives of sensuous enjoyment that laymen like to lead.¹⁷⁷

According to Buddhism, wealth acquired by energetic striving¹⁷⁸ is commendable.¹⁷⁹ This emphasises the value of one's labour. Thus, no one can justify the wealth acquired by wrong means. For instance, Venerable Sāriputtha, one of the two chief *bhikku*-disciples of Buddha, states that no one can escape the dreadful results of unlawful and non-righteous methods of livelihood by giving reason that one is engaged in them to perform his duties and fulfil obligation.¹⁸⁰ Thus, it is stated on another occasion that, 'let one dutifully maintain his parents and practice honourable trade'.¹⁸¹ Thus, Buddhist concepts do not accept non-righteous livelihood and acquisition of property under any circumstances.

2.9.(F)(II) Merits of lawful acquisition

The foundation of one's economic life is referred to in Buddhism as *bhōga* or wealth. Happiness derived from wealth are four kinds namely *attisukha*, *anavajjasukha*, *ananasukha* and *bhōgasuka*. The first happiness is *attisukha*. This means the happiness of ownership or enjoying means of economic security acquired by just and righteous means. The second is *bhōgasuka*. This means the happiness of meaningful use of means

¹⁷⁵ Mundaraja Vagga of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara3/5-pancakanipata/005-mundarajavaggo-p.htm> (Accessed: 01.12.2004).

¹⁷⁶ Samyutta Nikāya (Gamani Samyutta-12-ii Rasiyo Sutta). Feer M.Leon (ed), *Samyutta Nikaya* (Oxford University Press: Pali Text Society, 1894), 331.

¹⁷⁷ Vyagghapajja Sutta (Dighajanu Sutta) of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an08-054a.html> (Accessed: 01.12.2004).

¹⁷⁸ *bāhā bala paricitehi*-Mundaraja Vagga of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara3/5-pancakanipata/005-mundarajavaggo-p.htm> (Accessed: 01.12.2004).

¹⁷⁹ Alavaka Sutta (Sutta Nipāta) of Samyutta Nikāya at <http://www.accesstoinight.org/canon/sutta/samyutta/sn10-012.html> and <http://www.metta.lk/tipitaka/2Sutta-Pitaka/5Khuddaka-Nikaya/05Suttanipata/01-uragavagga-e.htm> (Accessed: 01.12.2004).

¹⁸⁰ Dhananjani Sutta of Majjhima Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/2Majjhima-Nikaya/Majjhima2/097-dhananjani-e1.htm> (Accessed: 01.12.2004).

¹⁸¹ Dhammika Sutta, Khuddaka Nikāya of Sutta Nipātha at <http://www.accesstoinight.org/canon/sutta/khuddaka/suttanipata/snp2-14.html> (Accessed: 01.12.2004).

of living.¹⁸² The third is *ananasukha* or the happiness derived from not being in debt. The fourth is *anavajjasukha*. This means the happiness leading a blameless, pure, moral and spiritual life. In other words, joy of wealth gained by the judicious expenditure. This emphasises that the happiness of wealth is derived when the entire process of earning is legitimate.

Furthermore, the legitimacy of private property is upheld only where neither state law could prosecute nor public opinion finds room for censure with regard to the mode of acquisition (*yattha paro kammamkaritam - apajjanto adandaraho anupavajjo hoti*).¹⁸³ Thus, the Buddha said that the wealth of those who amass it without intimidating others, like a roving bee that gathered honey without damaging flowers; will increase in the same way, as does an anthill.¹⁸⁴ Again, this emphasises the worthiness of acquiring property by lawful means.

As has been seen previously, right livelihood (*sammā-ājīva*) figures prominently in the Buddha's teaching. Though right livelihood, traditionally, was addressed only to five trades it does not necessarily exclude other wrong ways of earning a livelihood.¹⁸⁵ Thus, trades or professions that do not harm others can be considered an ethical means of livelihood. It is clear that the precept about right livelihood was designed to bring true happiness to the individual and society and to promote unity and proper relationship among people. Thus, the word "livelihood" implies not only a pure means of earning one's living but it also means that one has to be morally responsible towards society.

¹⁸² Anana Sutta, Paththakama Vagga of Anguttara Nikāya, <http://www.accesstoinight.org/canon/sutta/anguttara/an04-062.html> (Accessed: 01.12.2004).

¹⁸³ Nidhi Kanda Sutta, Kuddhaka Pāli of Kuddhaka Nikāya at <http://www.accesstoinight.org/canon/sutta/khuddaka/khp/khp.html#8> (Accessed: 01.12.2004).

¹⁸⁴ The wise and virtuous shine like blazing fire. He who acquires wealth in harmless ways is like a bee that gathers honey. Riches mount up for him like an anthill's rapid growth. With wealth acquired in this way, a layman fit for household life in portions four divides his wealth. Thus will he win friendship. One portion for his wants he uses (including charity). Two portions he spends on his business. A fourth he keeps for times of needs. Singalovāda Sutta of Digha-Nikāya <http://www.accesstoinight.org/canon/sutta/digha/dn31.html> (Accessed: 01.12.2004).

¹⁸⁵ Vānija Sutta or Business (Wrong Livelihood) of Anguttara Nikāya at <http://www.accesstoinight.org/canon/sutta/anguttara/an04-079.html> (Accessed: 01.12.2004) according to this sutta the following five trades, which ought not to be practised by a layman. (1) Trade in weapons, (2). Trade in living being, (3). Trade in flesh, (4). Trade in intoxicating material, (5). Trade in poison. It is understood that the Buddha was addressing Indian society in the sixth century BC. However, Majjhima Nikāya mentions some category of occupations as recommended since lawful and non-violent. Those are archery (*issattha*), calculation (*gananā*), trade (*vānija*), cattle breeding (*gorakkha*), and government service (*rājaporisa*).

2.9.(G) The concept of government and property protection in Buddhism

The origin of the universe, development of human society and the form of government are also subject matters in the Buddhist discourse. The *Agganna Sutta*, *Cakkavatti Sihanāda Sutta*, and *Kūṭadanta Sutta* of the *Dīgha Nikāya* are important in this regard. The *Agganna Sutta* traces the history of human society while giving an account of the development of the concept of private property. According to this Sutta people gathered them together at a time when private property and the family were no longer respected and selected a king by giving him powers, that means right to warn for indignation and censure and right to banish in return for a proportion of their earnings.¹⁸⁶ Here the Sutta emphasises that the king should be rightly indignant (*sammākhīpitabbam*), should rightly censure (*sammāgarahitabbam*) and should rightly banish (*sammāpabbājetabbam*). Thus, the Kingship was established based upon a contract between the elector and elect.¹⁸⁷

Buddhist concerns on good governance and thus *Chakkavatti Sihanāda Sutta* emphasises the quality and the duty of a ruler of a country. Accordingly, one of the prime and foremost duties of the ruler is to take necessary steps to ensure life of all living beings in his kingdom and guaranteeing them security of the property, which is acquired by lawful means.¹⁸⁸

Moreover, Buddhist teaching concerns the professional skills of a person as well. Thus, *Kūṭadanta Sutta* states that the State should do necessary things ensuring maximum utilisation of labour resources at State level recognising the basis of professional skills and personal aptitude and temperament.¹⁸⁹

As discussed earlier, the main theme of Buddhism is to live without harming others. This includes religious tolerance as well. From the above discussion it is clear that the Buddhist economic system is basically interested in stabilising the economy both of the individual and the state with a view to giving maximum happiness without bringing into conflict those around and without damaging the moral fabric of the society at large.

¹⁸⁶ Agganna Sutta of Dīgha Nikāya, at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/1Digha-Nikaya/Digha3/27-agganna-p.htm> (Accessed: 01.12.2004). It seems that this share later evolved into taxes, direct and indirect, with the development of administrative machinery.

¹⁸⁷ This shows that the modern idea of 'social contract theory' has its roots in Buddhism.

¹⁸⁸ Cakkavatti Sihanāda Sutta of Dīgha Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/1Digha-Nikaya/Digha3/26-cakkavatti-sihanada-p.htm> (Accessed: 01.12.2004). It is submitted that this emphasis the fact that modern theories propounded by Locke and Hobbs have their roots in Buddhism.

¹⁸⁹ Kutadanta Sutta of Dīgha Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/1Digha-Nikaya/Digha1/05-kutadanta-e.htm> (Accessed: 01.12.2004).

PART D

The theorisation process

2.10 Introduction

Addressing the infringement of intellectual property rights in the ever-growing digital media entails an academic search for an appropriate conceptual methodology to interpret the terms in a global electronic environment. Identifying the mode of infringement that arises from time-to-time as a result of the development of technology and identifying purported infringer will suffice. The challenge of the protection of intellectual property in the digital age entails more than a process whereby the legal text applies as it is to a certain event, yet what is required is a justificatory rationale sufficient for assertion of infringement of intellectual property rights with a due consideration of values that underlie Sri Lankan society.

As can be seen in the later part of the study, an examination of judicial decisions of the country in relation to intellectual property reveals that the focus of the judiciary was made on the result of an action to ascertain whether a particular action would amount to an infringement of rights. They had never considered the moral aspect of such an infringement and impact of such conduct on the moral fabric of the country. Paradoxically, it seems that, this has been happening from the day when statutory protection was given to intellectual property right in Sri Lanka, to date.

Admittedly, legal reasoning in the process of delivering justice includes not only just analysing the text but also sophisticated appreciation of the goals underlying the text and the consequences of adoption of different interpretation without considering the values of the society in which the law applies. Hence, it is submitted that, focusing on morality as a significant component within an infringement analysis would, in theory, avoid the tendency to seek new laws as technology changes. Thus, the aim of this part of the study is to propose a theoretical framework for the ascertainment of infringement of intellectual property rights in Sri Lanka.

In theory, it is poor practice to have excessively frequent changes in the realm of intellectual property law, especially in a country like Sri Lanka where little guidance by way of available case law exists. Hence, it is submitted that the following methodology for the interpretation and application of intellectual property law would help the judges in Sri Lanka to apply law to new situations to fill the gap at a given time and hence avoid

the need for constant change to the intellectual property law to comply with Sri Lanka's international obligations.

It is submitted that, the validity of the proposed theoretical framework should be understood upon the following considerations.

(a) Sri Lanka is an oriental society, which holds conservative views on morality and which is not disposed to tolerate permissiveness in any measure. In that social perspective a person who tries to infringe others rights in whatsoever manner is not accepted and is socially condemned.

(b) The Constitution of Sri Lanka is considered as a source of law and source of insight. The Preamble to the Constitution of Sri Lanka declares that:

The PEOPLE OF SRI LANKA having, by their mandate freely expressed and granted on the day of the waxing moon in the month of Adhi Nikini in the year two thousand five hundred and twenty-one of the Buddhist era (emphasis added by the researcher)...entrusted to and empowered their representatives elected on that day to draft and operate a new Republican constitution in order to achieve the goals of a DEMOCRATIC SOCIALIST REPUBLIC,... and assuring to all people FREEDOM, EQUALITY, JUSTICE, FUNDAMENTAL HUMMAN RIGHTS and the INDEPENDENCE OF THE JUDICIARY the intangible heritage that guarantee the dignity and well being of succeeding generations of the people of SRI LANKA, ...who come to share with those generations the effort of working for the creation and preservation of a JUST AND FREE SOCIETY.

Thus, the underlying theme of the Constitution is the establishment of a just and free society. It is therefore essential that all the laws promulgated under the Constitution reflect the same aspiration of the people.

(c) Being a non-secular country, the Sri Lankan Constitution declares that the foremost place should be given to Buddhism. Furthermore it declares that it is the duty of the State to protect and foster the Buddha Sāsana while assuring to all religions the rights granted by Art.10 and 14(1)(e).¹⁹⁰ As seen in Chapter One, a referendum is needed to alter the Constitutional position given to Buddhism. Buddhism being the religion of the State and professed by the majority of the population in Sri Lanka, it can be argued that the country's morality is derived from Buddhism or at least should be consistent with Buddhism.

¹⁹⁰ Art.10 deals with the freedom of thoughts and consciousness and Art.14(e) deals with the freedom to profess of religion.

(d) Moreover, Art.15 (7) of the Constitution states that the exercise and operation of all the fundamental rights declared and recognised by Art.12, 13(1) and 13(2) and 14 are subject to the restriction, among other things, in the interest of the public order, and the protection of public health or morality. Here, the concept of morality is taken as one of the criteria to restrict the fundamental rights of the people in Sri Lanka. This signifies the constitutional recognition of the morality of the country and it should be reflected in intellectual property system balanced as between creators and the wider society.

(e) The judges of the country abide by the Constitution to protect the values of the country. For instance in Art.107(4) the Constitution of Sri Lanka provides for an oath/affirmation for the judges to uphold and defend the Constitution of Sri Lanka.¹⁹¹ Thus, the judges are constitutionally bound to look at the basic values underlying the Constitution and recognise the Constitution while delivering justice to litigants.

(f) Since the Sri Lankan Constitution is the primary source of law of the country, every piece of legislation promulgated by the Parliament of Sri Lanka must have a legitimate ground in the Constitution. Accordingly, any legislation inconsistent with the Constitution is not law. It is therefore obvious that the Intellectual Property Act, No.36 of 2003 derived its validity from the Constitution and the application of the said law must uphold Constitutional values.

(g) Interpretation of statute has acquired attention from time to time due to the development of new concepts such as eclecticism and specific intent, purposive interpretation, post-legal process theories etc.¹⁹² However, it is commonly accepted that legislation and adjudication must be evaluated by its contribution to the principled integrity of the community. Thus, the role of the court is to interpret authoritative statement of law in the light of underlying principles of the community. The best interpretation is the one that is most consonant with the underlying values of the society. In other words interpretation of statutes (where possible) should be in conformity with the Constitution. This is not proposing judicial legislation. While recognising the independence of the judiciary and separation of powers it is suggested, it must consider Sri Lanka's Common Law/Roman Dutch Law heritage along with other values.

¹⁹¹ The Art.107 of the Constitution of Sri Lanka and the Fourth Schedule of the Constitution. It states that "... I will to the best of my ability uphold and defend the Constitution of the Democratic Socialist Republic of Sri Lanka."

¹⁹² P.B. Maxwell, *Maxwell on the Interpretation of Statutes*, 12th (edn) (London: Sweet and Maxwell, 1969), Ch.2 for general principles of interpretation such as literal rule, mischief rule, golden rule, etc.

Accordingly, the court of Sri Lanka has to interpret the law, including the Intellectual Property Act, No.36 of 2003, in a way, which is consistent with moral values derived from Buddhism or the cultural norms of the majority of the society.

(h) It is axiomatic that the concept of morality plays a significant role in the process of granting protection to the subjects of intellectual property. This is a universally accepted principle. Conventions and national legislations underscore the importance of the concept of moral standard as part of the process of evaluating the applications for the protection of intellectual property rights. The best example of a patent system that considers morality is Art.53(a) of the European Patent Convention 1973, which does not allow the grant of patent for inventions, the publication or exploitation of which would be contrary to 'order public' or 'morality'.¹⁹³ Sri Lankan legislations on the subject also reflect the same view.¹⁹⁴

(i) Since the manner in which intellectual property regimes determine eligibility for protection recognises morality as a factor, it is submitted that there is no prohibition to use the same concept in the case of infringement of those rights granted by such regime. In other words, the very protection of intellectual property rights starts with the consideration of morality, hence the question why should morality not be considered when there is an infringement of the protection.¹⁹⁵

(j) Up to now, Sri Lankan courts have not attempted to apply Buddhist principles to Intellectual Property Laws, though there are many occasions where Buddhist principles are applied in the process of adjudication.¹⁹⁶ Hence, it is submitted that it would be a coherent endeavour to interpret the boundaries of intellectual property laws in Sri Lanka when Buddhist principles apply. Furthermore, Justice C.G. Weeramantry, the Vice-Chairman of International Court of Justice (ICJ), in the Danube case (*Hungary v. Slovakia*)¹⁹⁷ applied Buddhist principles in the ICJ to justify his decision.¹⁹⁸ Moreover,

¹⁹³ Further, Art.17 of the Berne Convention, which reserved the right of individual countries among other things to prohibit the circulation, or exhibition of any work or production. Though the Convention does not provide circumstances where a country can use this right, it is logical to think that individual countries are free to consider morality as a criteria to provide protection. This is affirmed by Art.9 of the TRIPs as well. Art.6^{quinquies}(B)1 of the Paris Convention states that trade marks registration denied when they are contrary to morality or public order. Art.15(2) of the TRIPs affirms this position.

¹⁹⁴ Sec.29(b), 79 and 103 of Act deal with morality aspect of Intellectual property.

¹⁹⁵ Spycatcher Case i.e. *Attorney-General (UK) v Heinemann Publishers Aust. Pty. Ltd.* (1987) 8 NSWLR 341.

¹⁹⁶ *Premalal Perera v. Weerasuriya and Others* [1985] 2 S.L.R 177.

¹⁹⁷ The Dunbee Case 1997, General list N.92. 25.09.1997.

this judgment was cited in the Supreme Court of Sri Lanka while discussing Environmental Law.¹⁹⁹ Therefore, as there is a legal precedent in Sri Lanka, there is a no bar to applying Buddhist principles to intellectual property law.

2.11 Theory to be applied

The framework has five steps. STEP 1 derives its validity from the present law. It is the duty of the Sri Lankan judiciary to utilise to the maximum those intrinsic merits of the current law (on its own). Hence, the general rules of interpretation should be extensively used to interpret present provisions of local legislation. However, the court has to look into local case law and similar provisions of law in abolished legislation while interpreting legislation by referring to other rights and defences. If it is convinced that the present law is sufficient and provides explicitly for those problems that arise due to developments in technology, then there is no need for any further guide to interpretation. When there is a gap, STEP 2 should be applied.

STEP 2 is the application of Constitutional norms. When the current law is unclear or practically insufficient to deal with new situations, then the court has to explore the possibility of using a constitutional mandate. The above mentioned factors should be considered in this regard. The Constitution of Sri Lanka is the '*grundnorm*' or the ultimate and basic legal norm²⁰⁰ for the legal system of the country and thereby a valid and consistent ground to interpret the present law. Hence, the court should explore the possibility of applying constitutional norms, which they are bound to follow. If this is proved, STEP 2 would be sufficient and there would be no necessity to proceed further. Otherwise STEP 3 has to be applied.

STEP 3 is the use of Buddhist principles. Once it is realised that STEP 2 is insufficient, or the combined application of STEPS 2 and / or 3 is more justified, the next step should be the exploration of the applicability of Buddhist principles to interpret the present law and thereby bridge the gap of the application of present law. Such approach would be a

¹⁹⁸ "The notion of not causing harm to others and hence '*sic utere tuo ut alienum non laedas*' was a central principle of Buddhism. It translated well into environmental attitudes. 'Alienum' in this context would be extended by Buddhism to future generations as well, and to other component elements of the natural order beyond man himself, for the Buddhist concept of duty had an enormously long reach."

¹⁹⁹ *Bulunkulama and Others v. Secretary, Ministry of Industrial Development and Others* (2000)3 Sri L.R.243.

²⁰⁰ According to Kelson, '*grundnorm*' is the basic norm, which determines the content and gives validity to other norms derived from it. Generally, H.L.A. Hart, *The Concept of Law*, Oxford, 2nd (edn) 1994 (Clarendon, 1961) and MacCormick, *HLA Hart*, Edinburgh University Press, Edinburgh, 1981.

classic example of an expression of constitutional mandate upon the judiciary. On the other hand, application of Buddhist principles are very pragmatic in a country like Sri Lanka where there are precedents of applying Buddhist norms to other areas of law²⁰¹ in order to justify the judgement of the court.²⁰² Furthermore, Buddhism, which is protected by the Constitution,²⁰³ highly condemns the taking of property belonging to another and the jeopardy of others' interests.²⁰⁴ As mentioned above the judiciary is constitutionally obliged to uphold the Constitution. Admittedly, one of the roles of the judiciary is to interpret the law according to the intended purpose of the concerned legislation. Commendably, Sri Lankan courts have shown themselves to be conscious of the constitutional mandate given to them to uphold the Constitution while interpreting statutes in this process of adjudication. For instance, in the *Gaffoor v. Wilson and another*²⁰⁵ Dr. Amarasinghe, J., observed, in detail, the Buddhist aspects of the moral duty to support one's parents.²⁰⁶ This precedent shows that the Buddhist principles can be applied to justify the verdict of the courts since the power for such justification stems from the Constitution itself.

As observed in Part C of this chapter, the Buddhist scriptures do indicate the general direction of Buddhist social thinking, and to that extent, they are suggestive for our own times. Accordingly, one of the objectives of this research is to interpret perennial

²⁰¹ E.g. *Premalal Perera v. Weerasuriya and Others* [1985]2 S.L.R.177(fundamental rights) *Gaffoor v. Wilson and Another* [1990]1 S.L.R.142 (maintenance), *Bulunkulama and Others v. Secretary, Ministry of Industrial Development and Others* (2000)3 Sri L.R.243 (environmental law).

²⁰² More over, this will be more realistic in Sri Lankan society where every full moon day of a month is declared as a public holiday to observe religious activities. For instance for 2004 holiday visit the Official website of the Government of Sri Lanka at <http://www.priu.gov.lk/Holidays2004.htm> (Accessed: 01.12.2004).

²⁰³ Art.9 of the Constitution, 1978.

²⁰⁴ For instance, Mahātanhāsankhaya Sutta of Majjhima Nikāya at <http://www.geocities.com/Tokyo/6774/mn38.htm> and also Ambaltikā Rāhulovada Sutta of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 01.12.2004).

²⁰⁵ [1990] 1 Sri L.R.142.

²⁰⁶ [1990] 1 Sri L.R.142 at pp.146-147 the Hon. Judge observed that "The moral duty to support one's parents is also a part of our own oriental traditions. In the *Parabhavasutta* which was a dialogue between a deity and Buddha on the things by which a man loses and those by which he gains in this world, in response to the question of the Deity to name the fourth loser, Bhagavat replies: "He who being rich does not support mother or father who are old or past their youth -that is the cause of loss to the losing man." In the *Vasalasutta* Bhagavat in his reply to Aggikabharadvage's question as to who is an outcast replies: "whoso-ever being rich does not support mother or father when old and past their youth, let one know him as an outcast". And in the *Dhammikasutta* the Buddha in discussing what the life of a householder should be says: "Let him dutifully maintain his parents and practice an honourable trade; the householder who observes this strenuously goes to the gods by the name Sayampabhas.".... And the *Grihya-sutra* of Hiranyakesin the student who returns after his education is told that "he should support his father and mother."

Buddhism in terms of the needs of industrial society under present conditions and to demonstrate its acute and urgent relevance to the protection of intellectual property.

It is obvious that religious values, directly or through the conduct of moral sensibility, influence legal tradition. Nevertheless, values unlike facts change from time to time. Unlike facts, values cannot be proved true or false. However, the distinction between belief of fact (factual belief) and belief relating to values entail a brief examination for the understanding of the proposed theory of this Chapter.

Factual belief changes from time to time and depends on empirical investigation people have made into the nature of things. Likewise, belief relating to values also can change over time. Furthermore, value at one time may not be a value at another time, but a fact at one time remains as a fact at other times too.

Nevertheless, according to Buddhism, there are certain facts about the world, certain laws (*niyamas*) which have remained the same without depending on what people have discovered. In Chakkavattisīhanada Sutta, the Buddha observed that the social value changes from time to time. Now the subtle question arises as to whether there are some values that can be recognised as core values by which human beings must live if they are to lead a life of happiness. The answer is in the affirmative. There is a system of core values, which can be discovered by human intelligence and experience. These values shall uphold at all times if human beings are to lead a decent form of life.

In Kālāma Sutta of Anguttara Nikāya²⁰⁷ the question was how one could discover the difference between right and wrong. The Buddha said that:

Do not go upon tradition, nor upon what has been acquired by repeated hearing, nor upon rumour; nor upon what is in a scripture, nor upon surmise, nor upon speculative metaphysical theories, reasons and argument, nor upon point of view, nor upon specious reasoning, nor upon surmise, nor upon an axiom, nor upon a bias towards a notion that has been pondered over; nor upon another's seeming ability; nor upon the consideration.

This emphasises the ability to judge what is good or bad by a rational person, who acts with consistency. Accordingly, the Sutta observed that

When you yourselves know these things are good; these things are not blameable; and praised by the wise; undertaken and observed. When you yourselves know these things lead to benefit and happiness, enter on and abide in

²⁰⁷ <http://www.accesstoinight.org/canon/sutta/anguttara/an03-065.html> (Accessed: 01.12.2004).

them. But when you yourselves know these things are bad, blameable, censured by the wise, these things lead to harm and ill, abandon them.²⁰⁸

From the above quotation, it is clear that reflecting on one's experience one can discover right and wrong. It is clear that the justificatory standard of an action is the harm of that action. Thus, one needs to consider the results of the action whether it will be harmful to oneself, to other or to both. Thus, it appears that what Buddhist value system has tried to establish is based on this criterion. The consequences to oneself are common others have been accepted as the basis. What is morally praiseworthy and what is morally blameworthy are to be distinguished primarily by this criterion. Moreover, one should do an act reflecting oneself. Therefore, the logical conclusion would be that if one (A) thinks that it would be no harm according to Buddhist morality to do a particular act to another (B), then it is assumed that it would be no harm to do the similar act to the former (A) in similar circumstances. Thus, as a rational person if one (A) believes that it would morally be accepted to do a particular act to another (B), then it is assumed that the former (A) would consent to a third person (C) to do the same act to (A) under relevantly similar condition.

In order to effectively understand this moral framework one must look at the particular action in question in neutral terms. Thus, the above framework is to be used in order to justify one's act. If any act violates the above criteria, it would amount to an immoral act and thereby violate the rights of the other. Accordingly, the proposed methodology should apply along with the second and fourth precept of *panca sīla* to ascertain whether there is an infringement of intellectual property rights.

Hence, it is submitted that where there are gaps or lack of clarity in law, Buddhist principles can offer a sufficient, coherent and conceptually methodical paradigm.

When STEP 3 is insufficient or it is not practical, then the judiciary has to call for principles derived from international treaties (STEP 4). However, this step should be followed keeping in mind the factors mentioned in Para 1.2.6 and 1.2.7 of Chapter One. As discussed earlier, Sri Lanka being a party to international treaties makes no difference

²⁰⁸ Also Ambalatthikā Rāhulovadasutta, of Majjhima Nikāya at <http://www.accesstoinight.org/canon/sutta/majjhima/mn061.html> (Accessed: 27.10.2004) for similar recommendation. "..., when a desire arises to do some bodily action, you should reflect. Doing this bodily action, will I be troubled, will others be troubled, will both be troubled? Is this bodily action demerit? Is it unpleasant? When reflecting if you know this bodily action will bring trouble to me, to others and to both, it is demerit; it is unpleasant, give up such bodily actions."

in the domestic law.²⁰⁹ Hence, provisions of those treaties do not legally bind in the same way as an Act of Parliament. Nevertheless, the principles embodied in those treaties represent the minimum standard that requires to be maintained to achieve the objectives of the treaty. Hence, the Sri Lankan court can use these principles to realize the difference between 'what the law is, and what the law ought to be' and to interpret present intellectual property law in Sri Lanka in accordance with those treaties to extend the present law to address the new situations in the information age.²¹⁰ This step can be more effective in syntheses with STEP 1 and STEP 2.

When the court finds that such obligations are not present, or is not realistic under a given situation, then consideration should be based on other areas of law. (STEP 5). For instance, Law of Delict, which is based on Roman Dutch Law and has been ingrained, in the Sri Lankan legal system can be relied on. As has been observed in Chapter One, Roman Dutch Law applies to many areas and constitutes the Common law of Sri Lanka. This means that the Roman Dutch Law applies to all sections of the community as a residuary law. The previous intellectual property legislation refers to the term common law.²¹¹ Nevertheless, no court has attempted to examine the relativity of this term with regard to intellectual property rights. Hence, it is important to explore the possibilities of using Roman Dutch Law to address infringement of intellectual property rights in Sri Lanka. In this regard, *lex Aquilia* is important.

The delict known as *damnum injuria datum* created by the *lex Aquilia* or *actio legis Aquiliae* or *Aquilian Action* has become a general remedy for loss wrongfully caused by another under Roman Dutch Law. In contrast, under English Law, the common law has developed a specific delict of negligence. The followings are the requisites for an action under the *lex Aquilia*.

1. Plaintiff must show *dolus* (intentional wrongful act: deceit, fraud) or *culpa* (negligence or fault) on the part of the defendant.
2. Pecuniary loss resulting thereby to the plaintiff and
3. Fault on the part of the defendant.²¹²

²⁰⁹ Para 1.2.6.

²¹⁰ There are some instances where Sri Lankan Court referred to international instruments such as European Convention for the Protection of Human Rights and Fundamental Freedoms in *Sunila Abeysekera v. Ariya Rrubasinghe, Competent Authority and Others* [2000]1 S.L.R.314, and UDHR in *Joseph Perera alias Brutten Perera v The Attorney-General and Others* [1992]1 S.L.R.199.

²¹¹ Sec.24 of the Code.

²¹² R. G. McKerron, *Law of Delict*, 7th (edn) (Cape Town: Juta and Co. Ltd., 1971), 13.

The first requirement means that the act complained of must involve the violation of a right vested in the plaintiff, which means the violation of a legally protected interest pertaining to the plaintiff. Whilst the second requirement speaks for itself, the third requisite means that the loss must be imputable to the defendant; that means that the defendant must have either intended the loss or else that by the exercise of reasonable care he could have prevented it. In other words, he must be guilty of *dolus* or *culpa*. Likewise, *dolus* denotes not merely intention, but intentional and wrongful infliction of harm. For *dolus* to be actionable there has also to be a duty to refrain from doing the act, which caused the harm. It is therefore clear that whether liability is based on *culpa* or *dolus*, the plaintiff must establish that the act, which resulted in pecuniary loss to him, was the result of a wrong done by the defendant; that it was the breach of a duty, which the defendant owed.

As observed by the South African court that once all the requirements are met,²¹³ the act complained of will be viewed as a delict, despite the fact that it has not previously been recognised as such by the courts.²¹⁴ As Weermanrty J observed in *Bank of Ceylon v De Costa*²¹⁵

The relief for undue enrichment in the Roman Dutch Law has not in the past and should not in the future be confined strictly to the various specific enrichment actions evolved by the system to meet specific classes of situations.

Hence, the analogy of Justice Weermanrty's observation can be applied to the above South African Court's observation in order to incorporate that into Sri Lanka jurisdiction.

An examination of the above elements of the *lex Aquilia* action reveals the suitability of the *Aquilian action* for the subject matter of the present study since an act of infringement of intellectual property right fulfils all the elements of an *Aquilian action*. Not only that, as will be seen the Roman Dutch Law maxim that 'no person ought to be enriched at the expense of another' (*nemo cum damno alterius locupletior fieri debet*) coupled with *Aquilian action* can be applied to challenge an act of unfair competition as well.

²¹³ (a) *dolus* (intentional wrongful act: deceit, fraud) or *culpa* (negligence or fault) on the part of part of the defendant. (b) pecuniary loss resulting thereby to the plaintiff and (c) fault on the part of the defendant. R.G. McKerron, supra n.212, p.13.

²¹⁴ *Dun & Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty P Ltd 1968 1 Sa 209 C at 218.*

²¹⁵ (1969) 72 N.L.R.457 at 539.

Thus, it is suggested that, *lex Aquilia* can be appropriately applied to infringement of intellectual property rights in Sri Lanka in a situation where there is actual pecuniary loss. In theory, the court would award compensation only where it is satisfied that there is loss in respect of property, business, or prospective gain capable of pecuniary assessment. Thus, it is submitted, when a rights holder can prove that all the above requisites are satisfied, then irrespective of the technical mode of infringement the court should grant an award.

Finally, if all steps have failed then the Sri Lanka legislature has to call for new law. However, it is submitted, such new law should be technology neutral to ensure continuing effective protection in an arena where technology rapidly changes. Otherwise, the law will become obsolete very often.

The whole framework discussed above can be visualised in the following diagram.

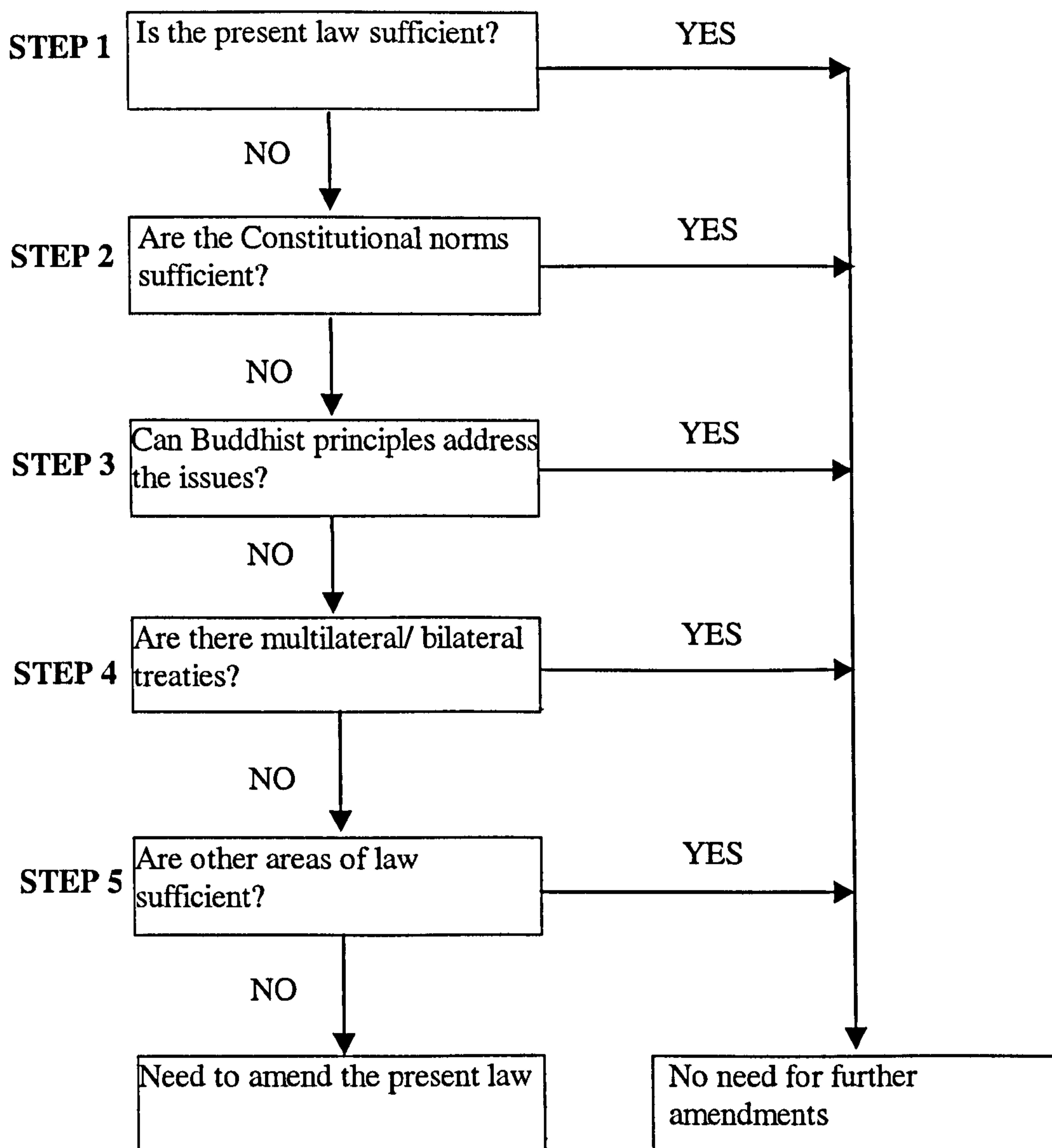


Diagram two- procedural steps of methodology

As will be seen, the Part Two of this study tests the hypothesis/method for practicability by reference to specific laws and specific fact situation.

2.13 Conclusion

The emerging issues in the digital media have created many problems in protecting intellectual property rights. Though different countries and international bodies have made many attempts, none could fully provide a permanent solution. The failure of those attempts shows the fact that consideration has been made only to the media rather than the philosophical justification of protection of intellectual property. In other words, one must be concerned with the basic principles behind the protection of the subject matter instead of attempting to deal with technological issues in the process of promulgation of law. However, as will be seen in the forth-coming Chapters of the study, the researcher

strongly contends that, indeed, there is no need to call for new laws from time to time to cope with new technologies, but be conscious of the constitutional mandate and expand the application of the present law along with the proposed theoretical framework of this study.

CHAPTER THREE

Laws relating to Trade Marks, Trade Names, and Geographical Indications in Sri Lanka and their application within the information age

3.1 Introduction

The traditional function of a trade mark is the indication of the origin, or trade source, of goods.¹ It was never necessary that the identity of the proprietor of a trade mark should be known.² Sri Lanka is not an exception to this phenomenon. As will be seen, Sri Lanka is witness to many legislative changes throughout its history in order to expand the scope of the protection of laws relating to marks.

The main objective of this Chapter is to examine the trade mark law of Sri Lanka and its application within the digital environment, and to evaluate the efficacy of the theoretical framework proposed in Chapter Two to deal with new challenges.

This Chapter is divided into four parts. Part A sketches the development of trade mark law in Sri Lanka before promulgation of the present laws in 2003. Part B explores and explains the application of present trade mark law of Sri Lanka in general, which gives an idea of the specific situation under which existing problems are to be addressed. Part C addresses the specific issues that have emerged due to the technological nature of the information society and identifies those issues that are yet to be addressed by the prevailing intellectual property law in Sri Lanka. Finally, in Part D an attempt is made to test the efficacy of the proposed theoretical framework by applying it to the issues identified in Part C.

PART A

Historical development of trade mark law in Sri Lanka

3.2 Pre British era

As pointed out earlier,³ the available historical evidence in Sri Lanka suggests that there were practices in the country to protect marks on goods even before the Western notion

¹ Frank Schechter, "The Rational Basis of Trade Mark Protection" *Harv.L.Rev.* 40 (1927),813, G. Ruston, "On the Origin of Trade Marks," *TMR* 45 (1955),127, B.G. Paster, "Trade Marks: Their Early History," *TMR* 59 (1969),551, Sidney A. Diamond, "The Historical Development of Trade Mark Law," *TMR* 65 (1975),265, T. D. Drescher, "The Transformation and Evolution of Trade Marks: From Signals to Symbols to Myths," *TMR* 82 (1992),301.

² *Birmingham Vinegar Brewery v Powell* [1897] AC 710 at 715.

³ Para 2.6.

of trade marks was introduced.⁴ Likewise, it is observed that the Portuguese made no impact on intellectual property system in Sri Lanka. Hence it is important to consider whether the Dutch influenced the then existing intellectual property system in the country.

As observed the Dutch introduced many western legal concepts into the legal system of Sri Lanka from 1656-1799.⁵ A subtle question arises as to why the Dutch did not attempt to introduce either the guild system⁶ which at the time regulated quality of merchandise and craftsmanship and the use of marks, or some other system for recognition of marks into Sri Lanka given their monopolisation of the export trade during their period in Sri Lanka. However, an insight can be found from the judgement of *Kapadia v Mohamad*.⁷ In this case, Shaw J. observed that

The right to a trade name or trade mark, and its protection against other traders, does not appear to have been considered by the writers on Roman Dutch Law, probably because the necessity for such consideration had in those days not arisen. Neither does it appear to have been considered in England until comparatively recent times, and it is not until the commencement of the nineteenth century that we find the English Courts of Equity interfering at the suit of one trader against another to prevent a person from "passing off" his goods as the goods of another.⁸

Hence, attention should be given to the British period to trace the legislative history of trade mark law in Sri Lanka and examine the application of trade mark law in the country. Though the British gained full control over Sri Lanka in 1818 and the application of Sinhalese Law and Roman Dutch Law was restricted in favour of English law as explained in Chapter Two,⁹ no attempt was made to promulgate intellectual property law until 1859.¹⁰ However, there is no evidence of its application to trade marks although Trade Marks Registration Act, 1875 might have extended to Sri Lanka.¹¹

⁴ The use of trade marks possibly dates back to the last millennium when craftsmen in India, China and ancient Rome used special marks to distinguish their products: WIPO(1998), No.476(E), p.60. Obviously, Sri Lanka was greatly influenced by the Indian culture and thus it could be argued that this document supports the information of stone inscriptions in Sri Lanka. Para 2.7.2 for some evidence in this regard.

⁵ Para 2.8(D)(I).

⁶ Para 2.4 for evidence of the existence of guild system in Sri Lanka.

⁷ (1918) 20 N.L.R.314.

⁸ Ibid. at 316.

⁹ Para 2.8.(E)(I).

¹⁰ Exclusive Privileges to Inventors Ordinance, No.6 of 1859 was the first legislation in relation of intellectual property in Sri Lanka.

¹¹ There was no provision in this Act that refers to such extension. Infra Para 3.4 and n.38.

The evolution of legislation relating to marks in Sri Lanka can be viewed in five generations. The first generation came into force in 1865 with the promulgation of Merchandise Marks Ordinance, No.5 of 1865 and the second with the Trade Marks Ordinance, No.14 of 1888.¹² The third began in 1925 with the Trade Marks Ordinance, No.15 of 1925¹³ whereas the fourth came into force with the enactment of the Code of Intellectual Property Act, No.52 of 1979. The last began with the promulgation of the Intellectual Property Act, No.36 of 2003.

3.3 First generation

The Merchandise Marks Ordinance, No.5 of 1865 (hereinafter 'MMO-1865') was the first legislation of the country in relation to marks. No reason was given while presenting the Bill to the Legislative Council, the then Parliament. Nevertheless, the Preamble of the Ordinance states that the main purpose of the promulgation was to make provision to prevent the fraudulent marking of merchandise and the sale of merchandise falsely marked for the purpose of fraud. This Ordinance was not meant to regulate the legitimate use of trade marks in the course of business, but to prohibit the falsification and forging of trade marks¹⁴ and trade descriptions.¹⁵ Any false indication, description, statement as to the quality of goods or quantity was prohibited.¹⁶ It is clear from the wordings of sec.2 of the MMO-1865 that intention to defraud was necessary to constitute an offence.¹⁷ Furthermore, the same section covered a situation where a person enabled another to defraud.

The Merchandise Marks Ordinance, No.13 of 1888 (hereinafter 'MMO-1888') amended the MMO-1865 and the objective was not declared in the Legislative Council.¹⁸ The preamble to the MMO-1888 merely stipulated that 'it is expedient to amend the law relating to fraudulent marks on merchandise' but no reason was given. Moreover, some sections relating to trade marks in the Criminal Procedure Code and the Penal Code were repealed by this amendment.¹⁹

¹² The Ordinance, No.4 of 1890, No.6 of 1904, No.15 of 1908, and No.23 of 1918 amended this Ordinance.

¹³ The Ordinance, No.23 of 1932 amended this Ordinance.

¹⁴ Sec.1 provided a list of what constitutes a trade mark.

¹⁵ Sec.3.

¹⁶ Sec.7 and 8.

¹⁷ Sec.2: "Every person who, with intent to defraud, or to enable to defraud any person, shall forge or counterfeit..."

¹⁸ Proceedings on 14.11.1888.

¹⁹ Sec.2.

The then sec.467 of Penal Code of Sri Lanka, No.2 of 1883, defined a trade mark as 'a mark used for denoting that goods have been made or manufactured by a person or at a particular time or place, or that they are of a particular quality or quantity.'²⁰ Though the definition of trade mark was expunged from the Penal Code, sec.3(4) of the MMO-1888 made reference to Trade Marks Ordinance, No.14 of 1888²¹ for a definition of trade marks.²²

Unlike the MMO-1865, under the MMO-1888 sellers who sold goods bearing forged trade marks etc and persons who made dies, blocks, machines etc for the purpose of forging were exempted from an offence after proving innocence.²³

The MMO-1888 also dealt with fraudulent intention. The court discussed the application of sec.3(2) of the MMO-1888,²⁴ in *K. Thyagarajah v D.M.R.Perera*.²⁵ In this case, the appellant, a manufacturer of aerated water and mineral water, refilled certain bottles belonging to another two companies. The names of those companies were embossed on the bottles, but the appellant sold them with attached labels bearing his name and address. The Court held that the words 'acted innocently' pointed to an absence of an intention to infringe the Ordinance. Such intention can only exist where such infraction was committed by inadvertence or by mistake of fact and hence the re-filler was liable.

On another occasion the court looked into the application of sec.3(2) of the MMO-1888 in *Cader Saibo and Co., v Mowlana*.²⁶ In this case, the defendant, whose name was 'Maulana', was accused of using the word on paper bags, printed in the same style as plaintiff in which customers of his shop took away their goods. The court held that this use did not amount to infringement of plaintiff's trade mark (Maulana for bags). To sustain a conviction for falsely applying a trade mark to goods, the trade mark must be applied *qua* trade mark for bags. Here the bags were merely adjunct to the defendant's goods, indicating purchase from his shop.

Under sec.5 of the MMO-1888, forging of a trade mark can take place either where a person without the assent of the proprietor of the trade mark makes that trade mark or a

²⁰ Repealed sec.467 of the Penal Code of Sri Lanka. Though all types of misuse of trade marks and property marks were severely dealt with by the Penal Code before amendments, it was confined only to property marks due to this amendment.

²¹ Para 3.4.

²² The term "trade description" was defined for the first time by this Ordinance.

²³ Sec.3(2) and sec.7.(cf. sec.186(2)of 2003 Act).

²⁴ Sec.3.

²⁵ (1961) 62 N.L.R.308.

²⁶ (1938) 39 N.L.R.370.

mark so nearly resembling that marks as to be calculated to deceive; or falsifies any genuine trade mark, whether by alteration, effacement, or otherwise; and any trade mark or mark so made or falsified is in the Ordinance referred to as a forged trade mark.

Thus, the question arises as to whether same mark used on different materials is deemed to be forged under the MMO-1888. Sri Lankan Court in *Abdul Azeez v Seyed Mohamad Buhary*²⁷ held that where a device was registered as a trade mark in respect of Silver medals, the registration could not be taken as extending to the use of the same device on medals made of other metals. Abraham CJ observed that

Now, section 3(1)(b) of the Merchandise Marks Ordinance penalizes any person who falsely applies to goods any trade mark, or any mark so nearly resembling a trade mark, as to be calculated to deceive, as it seems to me, on analysis, to mean this, that a person applies to goods the trade mark of another person or some marks which appears to be the trade mark of another person in such a way as to lead the public to believe that that mark has been applied to the goods *qua* trade mark, that is to say, to indicate that the goods on which the mark appears are the goods of some particular person...Looked at another way, the device and the tablet upon which it is engraved combine to form a 'charm' or an ornament, and the device loses its distinguishing characteristic of a trade mark and becomes a part of goods to which it is applied.²⁸

In *Sahib v Mutalip*²⁹ the court dealt with the sec.3(1) and the meaning of "calculated to deceive". The court held that to establish that a trade mark is calculated to deceive within the meaning of sec.3(1)(b) of the MMO-1888, it is not necessary to prove that there was any intent on the part of the person using the trade mark to deceive any one. What is necessary is that there must be something objective in the mark itself, which is likely to deceive buyers or user of the article on which it is placed. Furthermore, in *Macpherson v Brown & Co.*,³⁰ the court held that sec.3(1)(d) of the MMO-1888 did not apply where the description was fully oral.

Since all proceedings under the Ordinance were to be commenced before a Police Court, which had power to forfeit the goods,³¹ in *Queen v Vaiyapuri*,³² the court examined as to whether a District Court had jurisdiction to inquire into and determine an offence punishable under the MMO-1888 when the accused had elected, at the Magisterial

²⁷ (1938) 39 N.L.R.364.

²⁸ It seems that Sri Lankan Courts have adopted the narrower meaning of the sec.5 of the MMO-1888.

²⁹ (1933) 34 N.L.R.231.

³⁰ (1906) 8 N.L.R. 333.

³¹ In *Hassim v Musa* (1919) 20 N.L.R.15 the court held that it cannot order the forfeiture of the articles in relation to which the offence was alleged to have been committed when a person was acquitted from this charge.

³² (1895) 1 N.L.R. 92.

inquiry, to be tried by the District court according to laws made under sec.3(5) of the same Ordinance.³³ The court held that the District court has the jurisdiction to inquire into and determine the matter of the prosecution.

Furthermore, sec.15 protected the rights of Sri Lankan and British traders by regulating importation of goods.³⁴ An implied condition as to genuineness was recognised which could be waived by agreement with the buyer. Nevertheless, when such waiver was not in written form signed by the vendor and accepted by the vendee, the latter could claim damages in respect of non-genuine goods.³⁵

An amendment to the MMO-1888 by Merchandise Mark Ordinance, No.14 of 1892 did not bring major changes, except some provisions in relation to goods sold by length or by piece. While introducing this bill, consideration was given to local cloth manufacture by hand. An exemption was included since it was thought that hand made cloth would never compete with imported goods, nor would they be exported.³⁶

The MMO-1888 as amended was in force until the Code of Intellectual Property Act, No.52 of 1979.³⁷ As observed, the main idea behind the Ordinance was to prevent fraudulent marking of merchandise and sale of merchandise falsely marked. MMO-1888 did not establish a local trade mark system.

3.4 Second generation

There was no domestic legislation directly applied to trade marks until 1888. Nevertheless, the initial British legislation on trade marks, the Trade Marks Act of 1875, which provided for establishment of a register of trade marks and the creation of trade mark rights by registration probably became the country's first legislation on trade

³³ As of the date of this litigation, the District court was higher than the Police court.

³⁴ According to sec.15, all goods not made or produced in the United Kingdom or in Sri Lanka to which is applied any name or trade mark, being or purporting to be, the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom or Sri Lanka, must have added to the name or mark in letter as large and conspicuous as any letter in the name or trade mark, of the place and country in which the goods were made or produced. Importation of goods without such name or trade marks was prohibited.

³⁵ Sec.16 provided that in the case of sale or contract for sale of any goods to which a trade mark or mark or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied. This is an implied warranty as to the genuineness of the trade mark. This can be waived by the agreement with buyer.

³⁶ Proceedings on 21.09.1891.

³⁷ The MMO-1888 was repealed by sec.190 of the Code.

marks. According to Kithsiri Jayasinghe, (the Registrar of Patent, and Trade Marks in 1982) the first registration of a trade mark took place in 1886.³⁸

The second generation of trade mark law started in 1888 when the Legislative Council of the country promulgated an ordinance for the registration of trade marks in the island: the Trade Marks Ordinance, No.14 of 1888³⁹ (hereinafter '1888 Ordinance'). While introducing the Bill to the Legislative Council, no rationale was given.⁴⁰ The Preamble to the 1888 Ordinance stipulates that the objective was to provide a law for the registration of trade marks in the island. According to the 1888 Ordinance, it was made impossible to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless it was registered under the 1888 Ordinance.⁴¹

Even though this enactment did not provide a definition for the term 'trade mark',⁴² for the first time, characteristics of eligible signs were provided⁴³ and the requirement of distinctiveness was recognised. The 1888 Ordinance provided a dual system of registration in relation to trade marks, which had already been registered in Great Britain.⁴⁴ Thus, any person who had registered a trade mark in Great Britain was entitled to register their trade mark in Sri Lanka, which gave retrospective effect to the registration.⁴⁵

More importantly, restrictions on registration were recognised where a mark was scandalous or registration would be calculated to deceive⁴⁶ or be contrary to law or morality.⁴⁷ The 1888 Ordinance was amended in 1890,⁴⁸ 1904,⁴⁹ 1906,⁵⁰ 1908,⁵¹ 1915,⁵²

³⁸ Kithsiri Jayasinghe, "Trade Marks in Sri Lanka," WIPO Colombo Symposium, (1982), 179. The accuracy of this statement could not be verified since the researcher could not get access to these documents.

³⁹ This Ordinance was amended by the following Ordinances: No.4 of 1890, No.6 of 1904, No.15 of 1908, and No.23 of 1918.

⁴⁰ Proceedings on 14.11.1888.

⁴¹ Sec.20.

⁴² Nevertheless, the MMO-1865 provided a definition.

⁴³ Sec.2.

⁴⁴ Sec.41.

⁴⁵ In *Stewart v Silva* (1914) 17 N.L.R.179, the Court held that "when a trade mark is duly registered in Ceylon under the 1888 Ordinance, its proprietor, so far as Ceylon is concerned, is the person who has so registered it, and its use by anybody else without his sanction is obnoxious to the Ordinance. The same trade mark has been registered in England under the Patent, Design and Trade Marks Act, 1883, inasmuch as the provisions of sec.103 of that Act have been extended to Ceylon, it is open to the person in whose favour it is so registered to obtain priority by registration of the same mark in Ceylon under our Ordinance; but so long as no steps have been taken to obtain such priority, and no proprietorship aliunde is established by anybody, the rights accruing from local registration remain unaffected."

⁴⁶ Sec.15 and 16.

⁴⁷ Sec.24.

1918,⁵³ and 1919.⁵⁴ Nevertheless, most of these amendments did not bring major changes to the trade mark jurisprudence of Sri Lanka.

3.5 Third generation

The 1888 Ordinance was repealed and a separate Ordinance was presented to the Legislative Council of Ceylon on 29th January 1925. This enactment was the Trade Marks Ordinance, No.15 of 1925 (hereinafter 'TMO-1925').⁵⁵ The Attorney General made the rationale of the Ordinance as follows.

....The origin of this Bill was the representation made by the Federation of British industries, that certain trade marks were being granted in this Colony which were alleged by this Federation to be colourable imitations of British trade marks ...As a result of this an examination of the Ordinance was made, and it was discovered that Ceylon had allowed herself to lag behind the United Kingdom by twenty years or more. This Ordinance is therefore now being introduced...In England the law was completely recast in 1899. Our law is therefore hopelessly out of date and it is for that reason that this Ordinance has been prepared....While it bears a few small modifications, it really reproduces *in toto* the English law...⁵⁶

By this Ordinance, the register of trade mark had been divided into two parts. The rationale behind this division was that certain marks were unable to meet the stringent

⁴⁸ Trade Mark Ordinance, No.4 of 1890. This Ordinance expanded the essential character of trade mark by adding some other particulars to the list. In *Shaw, Wallace & Co. v The Egyptian Phosphate Co., Ltd* (1923)25 N.L.R.75 the Court held that as an invented word is allowed to be registered as a trade mark not as a reward on merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. Furthermore, the Court held that 'Radiophos' and 'Teraphos' were invented words.

⁴⁹ The Trade Marks Amendment Ordinance, No.6 of 1904. By this amendment an extension of sec.103 of the Patent Design and Trade Marks Act, 1883 (United Kingdom) was made. Thus international protection and inter colonial arrangements were provided. Further, Ceylon Legislative Council debate on 16.03.1904.p.30.

⁵⁰ The Trade Marks and Designs Ordinance, No.9 of 1906. This Ordinance made provisions to substitute the term Colonial Secretary with Registrar. The Hansard-Ceylon (1905-1906) on 07.02.1906 and 14.02.1906. (P.64 and p.78).

⁵¹ The Trade Marks (Amendment) Ordinance, No.15 of 1908. This Ordinance provided some restriction on registration for cotton piece goods. Ceylon Legislative Council debates on 09.09.1908.p.50.

⁵² The Patents, Designs and Trade Marks (Temporary Rules) Ordinance, No.10 of 1915. This amendment allowed the Governor in Council to make rules and regulations. Hansard- Ceylon (1913-1916) on 17.03.1915.p.291.

⁵³ The Trade Marks (Amendment) Ordinance, No.23 of 1918. This declared that no person had exclusive right to the use of any word, letter, numeral, line heading or any combination thereof due to the registration of Cotton mark under the previous Ordinances. Ceylon Legislative Council minutes on 20.11.1918, p.262 and debates on 27.11.1918.

⁵⁴ The Alien Enemy (Vesting of Trade Marks) Ordinance, No.5 of 1919. This provided certain trade mark vested in the Custodian of Enemy Property. Ceylon Legislative Council Record on 12.02.1919, p.26.

⁵⁵ The TMO-1925 was amended by the Ordinances, No.23 of 1932, No.14 of 1941, No. 32 of 1942, No.34 of 1949, No.55 of 1949, No.56 of 1949, No.4 of 1952, and No.47 of 1953.

⁵⁶ Debates 29.01.1925,p.28.

requirement for registration but it was nevertheless felt that they deserved some protection. Thus, Part B was added to the register. In terms of sec.7 and sec.65 the criteria for registrability in Part B were less onerous than for part A. To be qualified into Part A, a trade mark had to be 'adapted to distinguish' the applicant's good. Nevertheless to be accepted into Part B it was sufficient that the trade mark be 'capable of distinguishing' the goods of the applicant from those of others.⁵⁷

Section 65 dealt with the situation where a person was liable for false representations and sections 42 and 45 stated that registration was a mandatory requirement to constitute any civil action in the court but this did not affect passing off action. In terms of sec.22, associated trade marks were allowed to be registered under TMO-1925. This Ordinance also made provisions to restrict registration of a trade mark, which would be contrary to law or morality.⁵⁸ In addition to the laws contained in the TMO-1925, some rules were made by the Governor under the sec.59(1) of the Ordinance.⁵⁹

The State Council passed an amendment to the TMO-1925 from time to time.⁶⁰ The main objective of the amendment made 1932⁶¹ was to substitute sec.61 of the TMO-1925 to give priority to some applications.⁶² An amendment made in 1942⁶³ 'to meet any emergency which may arise as a result of war'. Again, in 1949 the TMO-1925 was amended to give effect to the provisions of the Neuchatel Agreement for the preservation and restoration of rights of industrial property affected by the war.⁶⁴ In 1953, another amendment was made to TMO-1925.⁶⁵ This was a very significant amendment since it prohibited the use of religious pictures as trade marks.

What can be deduced from the above discussion is that the law relating to marks introduced by the TMO-1925 focused on trade mark jurisprudence developed in the

⁵⁷ Sec.7 and 65(2) of the TMO-1925. Cf. *York Trailer Holdings v Registrar of Trade Marks* [1982] F.S.R 111.

⁵⁸ Sec.9 of the TMO-1925.

⁵⁹ Hansard (Ceylon) Vol.iii, 1926, p.1336. These rules mainly dealt with procedural aspect of registration of trade marks. These rules were amended in 1962.

⁶⁰ This chapter consider only the important amendments.

⁶¹ The Trade Marks (Convention) Amendment Ordinance, No.23 of 1932.

⁶² The effect of Ordinance 1932 was that any person who had applied for protection of any trade mark in the United Kingdom, (or in any foreign state with the Government of which His Majesty has made an arrangement under the sec.91 of the Patents and Design Act, 1907, for the mutual protection of trade mark) could apply for the registration of trade mark in Sri Lanka in priority to other applicants. Such application should be made within six months from the date of application in the United Kingdom of Great Britain or in the foreign state with which the arrangement is in force. Sec.2 of the Ordinance, No.23 of 1932 and cf. Art. 6^{quinquies} of Paris Convention.

⁶³ Patent, Designs, Copyright and Trade Marks (Emergency) Ordinance, No. 32 of 1942.

⁶⁴ Patents, Designs and Trade Marks (Neuchatel Agreement) Act, No.32 of 1949.

United Kingdom at that time. The TMO-1925 was designed for an industrial economy whereas local industry was still small-scale and domestic. Hence, it is submitted, the third generation of trade mark laws in Sri Lanka did consider foreign interests rather than local needs.

It is important to note that the first attempt made in 1964 to introduce a new law for trade marks. This was the Trade Marks Act, No.30 of 1964 (hereinafter "1964 Act"). Even though this Act was based on Trade Marks Act, 1938 of England it was the first attempt to introduce laws relating to intellectual property by the Sri Lankan legislature since Sri Lanka's independence. Paradoxically, this Act did not come into force due to the delay of formulating necessary legislation, but the said Act had its own commendable features e.g. certification marks.

3.6 The fourth generation

As noted in Chapter One, realising the necessity of expansion of the Sri Lankan economy led her to introduce an open market system in the late 1970s. Consequently, the country's trade and industry strategies changed in order to attract more investors. As a part of this effort, the government changed some of her laws to face the new era, of which Intellectual property law is one.

The fourth generation of trademarks law began in 1979 with the promulgation of the Code of Intellectual Property Act, No.52 of 1979 (hereinafter 'the Code').⁶⁵ The preamble to the Code stated:

An act to revise, consolidate, amend and embody in the form of a code the law relating to copyright, industrial designs, patents, marks, trade names and unfair competition and provide for the better registration, control and administration thereof and for matters connected therewith or incidental thereto.

While introducing the bill into the Parliament of Sri Lanka, the Minister of Trade and Shipping, Hon. Lalith Athulathmudali said that:

The Bill governs trademarks, patents, designs, copyrights and the merchandise marks ordinance. This is part of our program to update all commercial law in this country. There is no point in our talking about improving our economy, having more exports and imports if our legal structure is as ancient as the hills and does not keep up with modern development. One of the things we started on was trying to reform and bringing up to date all commercial law in this country. This is the first step...⁶⁷

⁶⁵ Trade Marks (Amendment) Ordinance, No.47 of 1953.

⁶⁶ This was based on WIPO Model Law.

⁶⁷ Hansard of the Parliament of Sri Lanka on 25.05.1979, Column 500.

Furthermore, he added that

...for the first time for marks for service, for any kind of service. You are not producing any thing, but say you are having a kind of hotel chain service - I suppose cinema distribution might come under that. The service marks are protected for the first time.⁶⁸

The above statements indicate that the intention of the legislature was to fill gaps in the existing law of the country.⁶⁹

3.6.1 Salient feature in relation to marks

The Code provided the law, among other things, for the protection of trade marks, service marks, collective marks, associated marks, trade names and to protect against an act of unfair competition. Section 97 defined the terms 'mark' and 'trade mark' amongst other things. Section 98 of the Code, provided that marks may consist, in particular, of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedges, borders and edgings, combinations or arrangements of colours and shapes of goods or containers. The Code contained a provision covering, in particular, three-dimensional and colour marks⁷⁰ and shape of goods or containers. Section 98(3) provided that a mark may consist of a combination or arrangement of colours.

3.6.2 Objective grounds and third party rights

Section 99 provided twelve situations where marks were inadmissible to the register on objective grounds. Those are functional shapes or forms,⁷¹ descriptive signs or indication,⁷² generic signs or indications,⁷³ other incapacity to distinguish,⁷⁴ morality and public order,⁷⁵ marks likely to mislead,⁷⁶ name of an individual or

⁶⁸ Ibid., Column 506.

⁶⁹ Sec.190 of the Code repealed all the previous legislation in relation to trademarks, i.e. TMO-1925 and the MMO-1888.

⁷⁰ Case comment on colour marks: Norma Dawson, "The Power of Colour in Trade Mark Law," *E.I.P.R.*, (2001), 383.

⁷¹ Sec.99(1)(a), imposed by the inherent nature of goods or service or by their industrial functions. Alison Firth, E. Gredley and S. Maniatis, "Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception," *E.I.P.R.*, (2001),86.

⁷² Sec.99(1)(b) Signs or indications which may serve to designate the kind, quantity, value etc.

⁷³ Sec.99(1)(c).

⁷⁴ Sec.99(1)(d).

⁷⁵ Sec.99(1)(e). This section has its own criteria as to marks which are likely offend the religious or racial susceptibility and differs from the corresponding provision of the Model Law. cf. sec.3(3)(a) in the British Trade Marks Act, 1994 prohibits registrability of trade mark which are contrary to public policy or accepted principles of morality.

⁷⁶ Sec.99(1)(f).

enterprise,⁷⁷ geographical names and surnames,⁷⁸ armorial bearings, flags etc,⁷⁹ official signs and hallmarks of a State,⁸⁰ marks resembling expired, removed, nullified etc.⁸¹ prescribed words or definition.⁸²

Furthermore, sec.100 dealt with six situations where a mark was not admissible because of third party right. Those were namely a mark already validly filed or registered by a third party,⁸³ unregistered mark,⁸⁴ trade names,⁸⁵ well known marks,⁸⁶ other rights or contrary to prevention of unfair competition,⁸⁷ and an unauthorized agent.⁸⁸

During the last 23 years of application of the Code, Sri Lankan courts had the opportunity to discuss only one out of the above eighteen grounds i.e. a mark likely to mislead the public.⁸⁹

3.6.3 Exclusive rights

Section 117 stipulated that the registered owner of a mark shall have exclusive rights in relation to the mark such as right to use the mark,⁹⁰ right to assign or transmit the registration of the mark and right to conclude license contracts. These rights were not absolute.⁹¹ Sections 118 and 142 provided limitations on registered owner's rights. These limitations are dealt with in detail in the next part of this Chapter.

3.6.4 Certification Marks

The Code did not categorically mention certification marks and Geographical Indications. However, the Standard Institute of Sri Lanka, was empowered⁹²

⁷⁷ Sec.99(1)(g). When the name of an individual or enterprise does not represent in a special or particular manner.

⁷⁸ Sec.99(1)(h).

⁷⁹ Sec.99(1)(i).

⁸⁰ Sec.99(1)(j).

⁸¹ Sec.99(1)(k).

⁸² Sec.99(1)(l).

⁸³ Sec.100(1)(a).

⁸⁴ Sec.100(1)(b).

⁸⁵ Sec.100(1)(c).

⁸⁶ Sec.100(1)(d).

⁸⁷ Sec.100(1)(e).

⁸⁸ Sec.100(1)(f).

⁸⁹ This will be dealt in the next section. Para 3.7.2.(b).

⁹⁰ These rights were extended to prohibit an application or the affixing in Sri Lanka by a third party, of a mark or any sign resembling such mark in such a way as to be likely to mislead the public, on or in connection with, goods in respect of which such mark has been registered. Sec.117(3) as amended by Act No.40 of 2000.

⁹¹ Sec.118 and 142.

⁹² By the Sri Lanka Standard Institution Act, No.06 of 1984.

To make arrangements or provide facilities for the examination and testing of products, commodities and materials, including food and drugs, locally manufactured or imported, in order to determine whether they comply with the Code of Intellectual Property Act, or any other written law dealing with standards of quality or otherwise, as well as the examination of processes and practices used in the manufacture of locally produced products, commodities and materials.⁹³

Section 17(2) of the Sri Lanka Standard Institution Act, declares that

No mark which is identical with any trade mark registered in respect of any commodity or product under the Trademarks Ordinance and the Code of Intellectual Property Act, as the case may be or which so nearly resembles any such trade mark as to be, likely to be mistaken for it, shall under subsection (1)⁹⁴ be declared a certification mark in respect of that commodity or product or any similar commodity or product or in respect of the manufacture, production, processing or treatment of that commodity or product or any similar commodity or product.

Furthermore, sec.18 of the Sri Lanka Standard Institution Act prohibits any person from registering a mark as a trade mark, which is identical to a certification mark, or so nearly resemble as likely to be mistaken for a certification mark.⁹⁵ Hence, it is clear that there was recognition of certification marks under the Code.

3.6.5 Protection of trade names

While defining the term 'trade name' by sec.96, sec.104(1) provided protection for trade names irrespective of registration.⁹⁶ Furthermore, trade names were protected from any subsequent use by a third party likely to mislead the public.⁹⁷

3.6.6 Unfair Competition

The Code made provisions for unfair competition. Accordingly, any act of competition contrary to honest practices in industrial or commercial matters is deemed to constitute an act of unfair competition.⁹⁸ Subsection 142(2) gave an inclusive definition of acts of

⁹³ Sec.3 of the Sri Lanka Standard Institution Act, No.6 of 1984.

⁹⁴ Sec.17(1) states that 'subject to the provisions of subsec.(2), the Institution may, with the approval of the Minister, by notice published in the Gazette, declare any mark which has been accepted by the Institution in respect of a standard specification approved by it for any commodity or product, or for the manufacture, production, processing or treatment of any commodity or product, to be a certification mark in respect of that commodity or product or of the manufacture, production, processing or treatment of that commodity or product, and may in like manner abolish or amend any such mark'.

⁹⁵ The application of the Sri Lanka Standard Institution Act cannot be neglected although there are no statistics as to whether any marks have been declared as certification mark under the Act.

⁹⁶ Sec.140(1) of the Code.

⁹⁷ Sec.140(2).

⁹⁸ Sec.142. It seems that subsec.(a),(b) and of 142(2) is a verbatim reproduction of subsec.(3)1 and 2 of the Art.10^{bis} of Paris Convention though 142(2)(c) slightly differs from subsec.(3)3 of Art.10^{bis}. Nevertheless, 142(2)(d) and (e) are novel provisions.

unfair competition by specifying certain acts, which were included within the meaning of that term.

In terms of sec.142(2) the creation of confusion by any means with the establishment, the goods, service, or the industrial or commercial activities of a competitor will be deemed as an act of unfair competition.⁹⁹ Likewise, false allegation in the course of trade of such a nature as to discredit the establishment, the goods, service, or the industrial or commercial activities of a competition will be deemed as an act of unfair competition.¹⁰⁰

Similarly, false indication of source or appellation of origin as to the nature, manufacturing process, characteristics, suitability for the purpose or the quality of goods¹⁰¹ and false or deceptive indication of the source of the goods or service or the identity of their producer, manufacturer, or supplier is deemed to be an act of unfair competition.¹⁰² Furthermore, sec.142 stipulated that making direct or indirect use of a false or deceptive appellation of origin or imitating an appellation of origin be deemed to be an act of unfair competition.¹⁰³

Examining the application of sec.142 in *Sumeet Research and Holdings Ltd. v Elite Radio & Engineering Co., Ltd.*¹⁰⁴ the Court referred to *Hexagon Pty Ltd. v Australian Broadcasting Commission*¹⁰⁵ and observed that:

... 'unfair competition' is an extension of the passing off, or, possibly, is a new, and independent cause of action. It consists of misappropriation of what equitably belongs to a competitor... in all these cases, English and American, the court has found an element of fraud or inequitable conduct on the part of the defendant. The very description of the tort "unfair competition" leads one to a conclusion that there must be something underhand or sharp in the conduct of the defendant.

Furthermore in *Societe Des Produits Nestle S.A. v Multitech Lanka (Pvt) Limited*¹⁰⁶ the question was whether the use of defendant's 'get-up' was an act of unfair competition under sec.142 of the Code. In this case, the Plaintiff Company had been selling its chocolate beans in Sri Lanka under the registered trade mark of "Smarties" in a gaily-coloured cylindrical container. The defendant company started to sell similar chocolate beans imported from Australia as "Sweeties" (an unregistered/ descriptive trademark)

⁹⁹ Sec.142(2)(a).

¹⁰⁰ Sec.142(2)(b).

¹⁰¹ Sec.142(2)(c).

¹⁰² Sec.142(2)(d).

¹⁰³ Ibid. Sec.142(2)(e).

¹⁰⁴ [1997] 2 Sri.L.R.393.

¹⁰⁵ (1975) ALR 233, 251-252.

and was sold in a coloured oblong box. After considering all the facts, the court concluded that defendant's act was contrary to honest practice in industrial or commercial matter and thus there was at least an act of unfair competition.

Dheeraratne, J. observed in *Malhotra International (Pvt.) Ltd., v. Anglo-Asian Distributors Ltd., and Another*¹⁰⁷ that in order to determine the existence of unfair competition, it would not be adequate to consider only the form in which the propounded mark is applied for, but a consideration of the actual use of that mark becomes necessary in given circumstances; the form in which a propounded mark is applied for, by itself, may look 'quite innocuous'.¹⁰⁸

In *Laugfs Lanka Gas (Private) Ltd v Mundogas Lanka (Private) Ltd*¹⁰⁹ the High Court in Sri Lanka considered whether it amounts to an unfair act when the defendant can use plaintiff's containers bearing Plaintiff's trade mark to refill its gas and sell to a customer even if the consumer is aware that it contains the defendant's product. The court held that in terms of sec.142, the defendant's act was an act contrary to honest practice. Hence, they issued an enjoining order.

PART B

Application of present trade mark law-An overview

3.7 The fifth generation

The fifth generation of trademarks law began when the Intellectual Property Act, No.36 of 2003 (hereinafter 'the 2003 Act') was promulgated in September 2003. While introducing the Bill into the Parliament of Sri Lanka, no reason was given as to the necessity of the new law. The rationale of the new law can only be inferred from the Preamble to the Act.

The preamble to the 2003 Act states that

An act to provide for the law relating to Intellectual Property and for an efficient procedure for the registration, control and administration thereof, to amend the Customs Ordinance and the High Court of the Provinces (Special) Provisions Act... and to provide for matters connected therewith or incidental thereto.

¹⁰⁶ [1999] 2 Sri.L.R.298.

¹⁰⁷ [2000] 3 Sri.L.R.117.

¹⁰⁸ [2000] 3 Sri.L.R.117 at 120. In this case, plaintiff was the owner of the trade mark TOPAZ for safety razors and safety blades whereas the defendant was the applicant for the registration of '2PAS', '2-PAS' and 'FOBAS' in respect of safety razors and safety blades. The Registrar's decision was challenged in this case.

¹⁰⁹ H.C (CIVIL) 58/2003(01).

Hence, at the outset it is clear that one of the main objectives of the new law is to provide for efficient procedure for registration, control, and administration of intellectual property. As will be seen, the 2003 Act does not provide new trade mark jurisprudence except in few cases but often reproduces its predecessor verbatim. Hence, earlier case law under the Code is clearly applicable.

3.7.1 Definition of marks

The basic philosophy of trade mark law lies in the term 'mark'. Marks can be divided into different categories because some marks are inherently distinctive in nature. Accepting this principle, sec.101 of the 2003 Act defines the term 'mark' and 'trade mark' amongst other things. In terms of sec.101, 'mark' means 'a trade mark or service mark'. 'Trade mark' means 'any visible sign serving to distinguish the goods of one enterprise from those of other enterprise'. 'Service mark' means 'any visible sign serving to distinguish the service of one enterprise from those of other enterprises'.¹¹⁰

Unlike the Code, the 2003 Act does not provide a list of types of sign, which are capable of operating as trade marks.¹¹¹ It is submitted this can be seen as a negative feature of the 2003 Act when there is no developed case law regarding this matter to guide the concerned authority in the process of determining the eligibility of a sign for registration.

3.7.2 Admissibility of marks

In order to be protected under the law, a sign should be admitted to the register as a trade mark. It is proposed to examine the requirements pertaining to admissibility of marks under the 2003 Act. All the previous legislation in Sri Lanka had mentioned pre-requisites for a mark to be registered. It seems that unless one of those positive particulars had been fulfilled, a mark could not be registered under any of those legislations.

Section 102(3) of the 2003 Act gives a non-exhaustive list of possible forms. Section 103 provides twelve grounds for refusal of registration under the heading "marks inadmissible on objective grounds." As with the Code, they are functional shapes or forms,¹¹² descriptive signs or indications,¹¹³ generic signs or indications,¹¹⁴ other reasons

¹¹⁰ cf. Art.15 of TRIPS.

¹¹¹ Para 3.6.1 for the list of types of signs.

¹¹² Sec.103(1)(a).

¹¹³ Sec.103(1)(b). Sri Lankan court discussed this matter under the previous law in *Lipton Ltd. v Stassen Exports Ltd.*, C.A.No.602/92(F). The Court held that the mark was not admissible since it

for lack of distinctiveness,¹¹⁵ morality and public order,¹¹⁶ marks likely to mislead,¹¹⁷ name of an individual or enterprise for lack of distinctiveness,¹¹⁸ geographical names and surnames,¹¹⁹ armorial bearings, flags etc,¹²⁰ official signs and hallmarks of a State,¹²¹ marks resembling expired, removed, nullified etc.,¹²² marks prescribed words or definition.¹²³

Furthermore, sec.104 deals with six situations where a mark is not admissible because of a third party right. Those are namely a mark already validly filed or registered by a third party,¹²⁴ a third party's unregistered mark,¹²⁵ trade names,¹²⁶ well known marks¹²⁷ other rights and unfair competition,¹²⁸ unauthorized agent.¹²⁹

consists of words "Pure Ceylon Tea" and "Packed in Ceylon." Thus in terms of sec.99(1)(b) and (h) of the previous law, the Code, the marks concerned was descriptive and thus was not registrable.

¹¹⁴ Sec.103(1)(c).

¹¹⁵ Sec.103(1)(d).

¹¹⁶ Sec.103(1)(e).

¹¹⁷ Sec.103(1)(f).

¹¹⁸ Sec.103(1)(g).

¹¹⁹ Sec.103(1)(h).

¹²⁰ Sec.103(1)(i).

¹²¹ Sec.103(1)(j).

¹²² Sec.103(1)(k).

¹²³ Sec.103(1)(l): "a mark shall not be registered which consists of any other words or definitions as may prescribed". However, the 2003 Act does not provide any prescription and the Court has not made any prescription yet for the same.

¹²⁴ Sec.104(1)(a): "a mark shall not be registered which resembles, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a third party, or subsequently filed by a person validly claiming priority in respect of the same goods or services or of other goods or services in connection with which use of such mark may be likely to mislead the public". This section covers third party rights in three situations;

(a) a mark already validly filed :-

This means that a mark shall not be registered which resembles, in such a way as to be likely to mislead the public, a mark already validly filed for registration by a third party in respect of the same goods or service or of other goods or services.

(b) a mark already registered by a third party:-

This means that a mark shall not be registered, which resembles in such a way as to be likely to mislead the public, a mark registered by a third party in respect of the same goods or service or of other goods or services.

(c) Subsequently filed by a person validly claiming priority in respect of the same goods or service or of other goods or services. This means that a mark shall not be registered, which resembles with a priority claimer's goods or service in such a way as to be likely to mislead the public.

Not all the three situations covered under this section are confined only to the same goods or service. It does cover the goods or service, which resemble in such a way as to be likely to mislead the public. In terms of sec.102(2) registration of a mark be granted only to the person who has first fulfilled the condition for valid application or who is the first validly to claim the earliest priority for his application. Thus the sec.104(1)(a) provides to cover both the situations contain in sec.102(2). While applying the sec.104(1)(a) the Director General has to consider whether that the third parties have consented to the registration of such mark. Thus, Director General cannot refuse registration on any relative grounds if the third party (the proprietor) of the earlier trade mark consents to the registration.

¹²⁵ Sec.104(1)(b).

¹²⁶ Sec.104(1)(c). Hence, when the applicant is not aware or could have been unaware, then the mark can be admitted under the 2003 Act. However, this sec. does not cover a situation where a mark resembles too closely a trade name not used in Sri Lanka but well known in Sri Lanka.

Among these eighteen grounds, two require special attention. The first one is 'morality and public order' and the second is 'marks likely to mislead the public'.

3.7.2.(a) Morality and the public order

Morality and the public order play a vital role in any society in the world. One should not be given opportunity to make use of a trade practice, which is capable of harming the social fabric of the society. For the harmonization of the different values of a society, the law passes different directives from time to time. Accordingly, the 2003 Act also provides guidance in this regard. Accordingly sec.103(1)(e) covers five situations.

- (a) a scandalous design.
- (b) a mark which is contrary to morality.
- (c) a mark which is contrary to public order.¹³⁰
- (d) a mark which is likely to offend the religious susceptibility of any community.
- (e) a mark which is likely to offend the racial susceptibility of any community.

However, it is obvious that it is not possible to define the term 'morality' and 'public order'. Since the 2003 Act is silent on this while providing a ground for inadmissibility of a mark, the Director General, or the courts must exercise their judgment on each case.¹³¹

3.7.2.(b) Marks likely to mislead

Section 103(1)(f) states that a mark shall not be registered, which is likely to mislead trade circles or the public.¹³² It covers two classes (i.e. trade circles and the general public) from likely to mislead as to

- (a) the nature of the goods or services concerned.
- (b) the source of the goods or services concerned.

¹²⁷ Sec.104(1)(d). Sec.104(2) provides eight criteria that are to be taken into account in determining whether a mark is well known.

¹²⁸ Sec.104(1)(e): "a mark shall not be registered which infringes other third party rights or is contrary to the provisions of Ch.XXXII relating to the prevention of unfair competition".

¹²⁹ Sec.104(1)(f). The rationale behind this section seems to be the protection of the public as well as rights of the trade mark owner who is in another country. Thus, the unauthorized act of an agent would result in inadmissibility of a mark under the 2003 Act.

¹³⁰ Also sec.142(6)(b)(ii) stipulates that a certification mark shall not be registered unless, the conditions governing the use of the mark are not contrary to public policy or accepted principles of morality.

¹³¹ PART C of Chapter Two.

¹³² Sec.3(3)(b) of the British Trade Marks Act, 1994 provides that "a trade mark shall not be registered if it is of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(c) the manufacturing process of the goods or services concerned.

(d) the characteristics of the goods or services concerned.

(e) the suitability for their purpose of the goods or services concerned.¹³³

This concept arises not only under sec.103(1)(f) but also (k) (expired marks), 104(1)(a)-(d) (third party rights) and sec.121 (infringement).

'Likely to mislead' has been recognized by all the trade mark enactments. MMO-1888 employed the phrase "calculated to deceive" in sec.3(1)(b). The same phrase was employed by sec.16 of the 1888 Ordinance. TMO-1925 employed the phrase "calculated to deceive"¹³⁴ while the 1964 Act employed the phrases "calculated to deceive" and "likely to deceive or cause confusion."¹³⁵ The Code dealt with "likely to mislead."¹³⁶ The 2003 Act mentions 'likely to mislead'. Since one of the main objectives of trade mark law is to protect the public from deceptive marks, it is worth considering the judgments of the Sri Lankan courts in this regard.

Though until now there are no judgments under the 2003 Act, it is useful to consider judgments delivered under the previous laws to ascertain judicial interpretation.

In *Lukmunjee v Aktibalage*¹³⁷ the court considered the device "Three Cups" and "Three Stars" and Lascelles A.C.J. pointed out that in trade mark cases the important principle is that the trade mark must be looked at as a whole, and regard must be had for what has been termed as 'the net impression'. Considering the meaning of 'calculated to deceive' the court observed in *John Gonsell & Co. Ltd. v Sivaprakasam*¹³⁸ that colourable imitation of a trade mark could be considered as calculated to deceive. In this case, the plaintiff marketed soap known as 'Famora' toilet soap, and it was held that the mark 'Farina' used by the defendant was colourable imitation of the plaintiffs' trade mark and thus could be considered as calculated to deceive. Furthermore, the court held that the opinion of a witness was irrelevant and inadmissible in deciding whether a mark resembled another.

¹³³ c.f. sec.15(a) Sale of Goods Ordinance, No.11 of 1896, (this Ordinance is still in force) provides that the seller is bound by an implied condition as to the suitability for the purpose of the goods concerned.

¹³⁴ Sec.17.

¹³⁵ Sec.12 and 13.

¹³⁶ Sec.99(1)(f),(k) and sec.100(1)(a)-(d).

¹³⁷ (1911) 14 N.L.R.414.

¹³⁸ (1910) 15 N.L.R.33.

Mac Donall, C.J., in *Sahib v Muthalip*¹³⁹ observed that:

To establish calculated to deceive it is not necessary to show that there was any intent on the part of the person using the mark to deceive anyone, though this may be an element in question. What is meant is that there is something in the mark itself, something objective, which is apt to deceive? You look to the mark itself, to what it is, to what it looks like, to what it contains, and to how it compares with the other trade mark put forward, and if there is in the mark itself something that is likely to deceive buyers or users of the article on which it is placed, then the mark is calculated to deceive, whatever may have been the intent or absence of one on the part of the person using it.

Dalton A.C.J. in *Lipton Ltd. v Rawther*¹⁴⁰ interpreting the words 'calculated to deceive' in sec.19 of TMO-1925 said that a customer can only contrast the mark on the goods offered to him with his recollection of the marks as seen and remembered in the article and not necessarily in the form as they appear in the register. Considering a device consisting of a battle cruiser with the words 'Enterprise Brand' below and a device of a steamship with the words 'Steamship brand' it was held that device of "ship" was a prominent feature in both marks and that confusion would result and deception would follow.

In *Veeravagoopillai v Saibo*¹⁴¹ Akbar, J. considering the choice of a figure of a monkey in a standing position similar to strong man in a standing position for flour observed that it was a choice calculated to deceive. Furthermore, his Lordship citing the words of Lord Cranworth in *Seixo v Provezende*¹⁴² observed that what degree of resemblance is necessary from the nature of things, is a matter incapable of definition *a priori*. All that the court of justice can do is to say that no trader can adopt a trade mark so resembling that of a rival, as those ordinary purchasers, purchasing with ordinary caution, are likely to be misled.¹⁴³ Maartensz, J. in *Lever Brothers v R.M Ranganathan Pillai*¹⁴⁴ observed that the name 'Rex' on soap was calculated to deceive in relation to the plaintiff's trade mark 'Lux'. Considering further the size and shape of the commodity it was held that there was a possibility of deception.

¹³⁹ Supra note 28 and (1933) 34 N.L.R.231 at 235.

¹⁴⁰ (1933) 35 N.L.R. 129.

¹⁴¹ (1934) 36 N.L.R.317.

¹⁴² (1866)L.R.1 Ch.192.

¹⁴³ (1934) 36 N.L.R.317at 320.

¹⁴⁴ (1937) 39 N.L.R.332.

Furthermore in *S.H.M. Mohideen et.al., v Registrar of Trade Marks*¹⁴⁵ the Court considered the term 'calculated to deceive' with the meaning of sec.17 of TMO-1925.

Basnayake, A.C.J. observed that:

No standard test of what is likely to deceive the purchaser can be laid down...In the circumstances of this case we think the test to apply is not whether if a person is looking at the trademarks side by side there would be a possibility of confusion; but whether the average person who sees the applicants' trade mark in the absence of the registered trade mark and in view only of his general recollection of the registered trade mark would mistake the applicants' trade mark for the registered trademark.¹⁴⁶

Similarly, in *Suby v Suby*¹⁴⁷ the court dealt with the meaning of phrase contained in TMO-1925 but did not interpret the term differently. The court was of the opinion that:

The words "calculated to deceive" have been held by English courts in interpreting the self same words in the English enactments of 1888 as meaning not more than likely to deceive. The English Act of 1938 has replaced the word "calculated" with the word "likely" bringing it into line with judicial interpretation. Our Ordinance, however, continued to use the same words "calculated to deceive" and it seems to me that the interpretation given in the judgments of our courts to the words "calculated to deceive" as meaning "likely to deceive" derives further justification from the use of the latter words in the new English Act.

Rodrigo, J. observed that 'likely to mislead' and 'likely to cause confusion' are interchangeable and do not substantively alter the law.¹⁴⁸ However, the rationale prohibiting registration of identical or similar marks, which are likely to mislead the public, was expressed in *M.S. Hebtullabhoy and Company Ltd., v Stassen Exports Ltd., and another*.¹⁴⁹ The court considering the comment in Callmann's Treatise on Unfair Competition, 4th Edition, Vol.3 observed that:

A boundless choice of words, phrases, and symbols is available to one who wishes a mark to distinguish his product or service from others. When a defendant selects from this practically unlimited field a trade mark confusingly similar to the mark publicly associated with the plaintiff's product, then it would appear that the defendant made the particular choice in order to trade upon the plaintiff's established reputation. If there is no reasonable explanation for the defendant's choice of such a mark though the field of his selection was so broad the inference is inevitable that it was chosen deliberately to deceive.¹⁵⁰

¹⁴⁵ (1955) 57 N.L.R.535.

¹⁴⁶ Ibid.at 537.

¹⁴⁷ (1980) 2 S.L.R 65.

¹⁴⁸ Ibid.at 70.

¹⁴⁹ (1989) 1 S.L.R.183.

¹⁵⁰ Ibid.at 191.

In the same case, the court held that 'the public' is very properly the public present, prospective, local, and foreign. Thus Palikdnar, J. observed that:

The word "public" it was strenuously contended was the public at large and not the public of any particular destination. The public was not merely the consumer public but the members of the business community as well. We do not think that it is in accord or harmony with the concept of Trademarks law to take a restrictive view of the public and contain them in geographically defined areas, or political divisions or countries.¹⁵¹

Furthermore, in *James Fernando v OIC, SCIB, Negombo*¹⁵² the court held that:

It is not possible to lay down any standard as to the amount of resemblance, which may suffice to mislead the public or cause confusion in their minds. Two marks when placed side by side may exhibit many differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark and not having the two side by side for comparison might well be deceived, if the goods are allowed to be impressed with a similar mark, into the belief that he was dealing with goods, which bore the mark with which he was acquainted. A critical comparison of the two marks might disclose numerous points of difference and yet the idea which would remain with any person seeing them apart at different times might be the same.

The foregoing discussion underlies the facts the Sri Lankan court has considered in determining the situations a mark is likely to mislead the public. Although each case is decided on its own facts, judges appear consistently to apply a market-based standard in deciding what is 'likely to mislead' customers. Although the objective is not a particularly high standard, the fact that they pay attention to public interest is a realistic approach. This means that the consideration was given to the Sri Lankan market behaviour. It is submitted that the wisdom of these judges equally applies to the information age and hence new techniques can be added to these precedential materials by explicitly considering morality and Buddhist principles. Accordingly judges should comply with the principles in determining future cases in Sri Lanka.

Nevertheless, until now no court has attempted to explicitly consider the immoral aspect of such an act, which misleads the public and the possibility to harm the moral fabric of the society. It is submitted that the Court could have considered the morality of the Sri Lankan society while delivering judgments in the above-mentioned litigations since they are constitutionally bound to uphold the constitutional values.

¹⁵¹ Ibid.at 193.

¹⁵² [1994] 3 Sri.L.R.35 at 39.

Had the judiciary considered phrases like 'calculated to deceive' and 'likely to mislead' since they are making inference to defendant's breach of '*sīla*'¹⁵³ and dishonest practices in the marketplace (which contradict the basic moral principles of the country) it would have enhanced the intellectual property jurisprudence in Sri Lanka.

3.7.3 Limits to trade mark rights

Limitation of registered owners' rights has not been substantially changed throughout the trade mark history in Sri Lanka. Examining the provisions in relation to the effect of registration in *Abdul Aziz v Mohamad Buhary*,¹⁵⁴ the court held that when the registration was taken for silver medal, the owners exclusive rights did not extend to medals made of any other metal.¹⁵⁵ In *Kumaravel Nadar et al., v Sokkalal Ram*¹⁵⁶ the court held that the proprietor of a trade mark was not entitled to prevent the use of a similar trade mark by a person who had been a continuous user of it from an anterior date within the meaning of sec.40 of the TMO-1925. This means that rights of prior user and honest concurrent user are not precluded by virtue of the registration of a trade mark by another.

Pursuant to sec.122 of the 2003 Act trade mark owner's rights is not absolute. The registered owner cannot preclude third parties from using *bona fide* their names, addresses, pseudonyms, or geographical name or from using exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production or supply of their goods or services, in so far as such uses are confined to the good and services. Thus third parties can *bona fide* use names, addresses etc., for the purpose of identification or information, but not to mislead the public. Likewise a registered trade mark owner cannot preclude third parties from using the mark in relation to the goods lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka under that mark, provided such goods have not undergone any change.

A further limitation in the right of a trade mark owner is unfair competition. According to sec.160(2) of the 2003 Act, any act or practice carried out or engaged in the course of industrial or commercial activities that causes, or is likely to cause, confusion¹⁵⁷ with

¹⁵³ Para 2.9(c) for the contents of '*sīla*'.

¹⁵⁴ (1937) 39 N.L.R.364.

¹⁵⁵ Sec.117(2)(a) of the Code and sec.121(2)(a) of the 2003 Act extended protection to similar goods and services.

¹⁵⁶ (1939) 47 N.L.R.149.

¹⁵⁷ According to sec.160(2)(b) confusion may, in particular, be caused with respect to, among other things, a mark, whether registered or not.

respect to another's enterprise or activities, in particular, the products or services offered by such enterprise, would constitute unfair competition and thereby be prohibited regardless of any registered rights proved. Likewise, the rights of the registered owner of a trade mark are subject to the provisions in relation to trade names. According to sec.144(2) any subsequent use of a trade name by a third party, whether as a trade name or as a trade mark, service mark or collective mark or any such use of similar trade name, trade mark, service mark or collective mark likely to mislead the public is considered unlawful. Registration is no defence to these provisions.

3.7.4 Exclusive rights, their infringement and remedies

Judges have insisted time and again that the function of the legislature is to make law and the only legitimate function of the court in relation to Acts of Parliament is to interpret them.¹⁵⁸ In construing a piece of legislation the court traditionally searches for "the intention of the legislature" or "legislative intent." There is no exemption of the application of this theory to interpretation of trade mark legislation in Sri Lanka. As far as trade mark legislations are concerned the intention of the legislature in Sri Lanka would be protection of the public from deception while protecting the proprietary interest of trademark owners. Hence, the duty of the court would be to interpret the law to achieve the purpose of the legislation when the Sri Lankan trade mark law is not clear. Case law may be used for judicial guidance but there are comparatively few reported cases in Sri Lanka. Hence, it is sensible to consider foreign case law when Sri Lankan law is broader or similar to corresponding provisions of foreign law.

It is obvious that the court has to consider essentially two factors in relation to trade mark law while considering infringement action. Firstly, the limitations of the application of trade mark law. Trade mark law is territorial in nature. As a consequence of local registration, a registered trade mark owner has exclusive right to the use of that mark on the goods or services for which it is registered¹⁵⁹ within the geographical boundary of the country in which the mark is registered.¹⁶⁰ The main consequence of this is that the domestic court would only be able to award remedy for an infringement in the case of domestic rights being infringed.

¹⁵⁸ E.g. *Hatwan and Others v. Rahaman and Others* [1993] 1S.L.R.201, *Manawadu v. OIC, Police Station, Udapussellawa* [1985] 2 S.L.R.261, *Jinawathie v. Emalin Perera* [1986] 2 S.L.R.121.

¹⁵⁹ Sec.121.

¹⁶⁰ The exceptions as to international protection are made Art.6^{bis}, Art.8 and 10^{bis} of the Paris Convention.

Secondly, the jurisdiction of the domestic court has to be considered. In order for the court to determine any action against infringement of trade mark, first the court has to affirm jurisdiction.¹⁶¹ It is obvious that no person should be required to answer a case before an incompetent forum. Thus, an infringement action would have to be brought before a competent court. Otherwise, the infringement action would be a failure in the first instance due to the lack of jurisdiction of the domestic court.

After asserting the jurisdiction of court, while keeping in mind the territorial application of trade mark, the court has to determine whether there is an infringement of trade mark since not every use of a protected trade mark would be deemed an infringing use.¹⁶²

A natural person or a legal person may obtain protection of trade mark by registration.¹⁶³ Historically application for registration was deemed to be equivalent to public use of the trade mark.¹⁶⁴ Registration of a person as proprietor gives rise to exclusive rights over the trade mark.¹⁶⁵ However, the Sri Lankan courts have not defined the term 'exclusive use of trademark' under the 1888 Ordinance. Under the TMO-1925, the person who was registered as proprietor of a trade mark had power to assign the same¹⁶⁶ and such registration gave exclusive rights to the use of such trade mark upon or in connection with the goods in respect of which it is registered.¹⁶⁷ There was no similar provision under the 1964 Act although it provided for the assignment and transmission.¹⁶⁸ The Code contained provisions regarding the scope of protection granted by the right to a trade mark owner.¹⁶⁹

¹⁶¹ Jurisdiction over civil cases in Sri Lanka: In terms of sec.9 of the of the Civil Procedure Code of Sri Lanka, No.2 of 1889 as amended by No.14 of 2000 subject to the pecuniary or other limitation prescribed by any law, action shall be instituted in the court within the local limits of whose jurisdiction-

- 1.a party defendant resides [sic]; or
- 2.the land in respond of which the action is brought lies or is situated in whole or in partly; or
- 3.the cause of action arises; or
4. the contract sought to be enforced was made.

However, as mentioned in Para 1.2.3.Chapter One, jurisdiction in relation to intellectual property matters is vested in the Provincial High Courts except in few cases. Given that potential trade mark infringement and damage to consumers is spread throughout the country, it is regrettable the jurisdiction is limited to the Provincial High Court. It is submitted that this inhibits achieving the purpose of trade make law.

¹⁶² E.g. sec.121 of the 2003 Act.

¹⁶³ Sec.101 read with sec.106 of 2003 Act.

¹⁶⁴ Sec.18 of the 1888 Ordinance as amended by Ordinance, No.4 of 1890.

¹⁶⁵ Ibid. sec.19.

¹⁶⁶ Sec.37(a) of TMO-1925.

¹⁶⁷ Ibid. sec.38.

¹⁶⁸ Sec.23-26 of the Trade Marks Act, 1964. Sec.7 of the Act dealt with infringement.

¹⁶⁹ Para 3.6.3.

Under the 2003 Act the rights of a registered owner are exclusive but not absolute¹⁷⁰ and are both positive and negative in nature. The rights operate in a positive way and entitle the owner to use the mark, to assign or to transmit the registration of the mark, or to conclude licence contracts.¹⁷¹ The negative aspect of the right is that third parties are precluded from doing certain acts in relation to the trademark.

Under sec.121 of the 2003 Act unauthorised use of the mark by a third party is precluded in five situations. Firstly, any use of the mark itself for the same goods or service in respect of which the mark is registered. This situation is relatively simple since it involves identity of the mark and of the goods or service concerned.¹⁷² It seems that the trade mark owner is not required to demonstrate that such use is likely to mislead the public.

Secondly, any use of a sign resembling the mark, in such a way as to be likely to mislead the public on the same goods or services, in respect of which the mark is registered. Here the law requires a degree of resemblance, which tends to mislead the public.¹⁷³ Thus, the owner must establish the fact that it is likely to mislead the public.

Thirdly, any use of the mark itself or a sign resembling it (in such a way as to be likely to mislead the public) for the goods or services other than those in respect of which the trade mark is registered or similar goods or services, provided such use is likely to mislead the public.¹⁷⁴ In this situation, though the use of mark is taking place for different goods and services such use of mark is likely to mislead the public. In terms of the above second and third situations, it can be said that there is no need of actual confusion to constitute trade mark infringement. Hence, likely to mislead the public is enough.¹⁷⁵

The fourth situation is declared by sec.121(2)(b) of the 2003 Act. According to this section it is clear that trade mark is protected against any other use of the mark itself or of a sign resembling it, if the use is made without just cause and is effected in conditions likely to be prejudicial to the interest of the registered owner of the mark.¹⁷⁶ Under this provision, 'likely to mislead the public' is not required. It is clear that the uses of well-known marks¹⁷⁷ are protected under sec.121(2)(b) in a situation where well known

¹⁷⁰ Sec.122 (limitation of rights) and sec.160(unfair competition) of the 2003 Act.

¹⁷¹ Sec.121(1)(a),(b)and (c).

¹⁷² Sec.121(2)(a).

¹⁷³ Sec.121(2)(a).

¹⁷⁴ Sec.121(2)(a).

¹⁷⁵ Table One.

¹⁷⁶ Ibid. sec.121(2)(b).

¹⁷⁷ Norma Dawson, 'Famous and Well-Known Trade Marks -Usurping a Corner of the Giant's Robe', *IPQ*, 4 (1998), 350-382.

marks are used in respect of different goods.¹⁷⁸ Furthermore, the same section precludes third parties from using trade names resembling the mark without just cause and under conditions likely to be prejudicial to the interest of the registered owner of the mark.

It is submitted, as the following table shows that overall the application of sec.121(2)(b) of the 2003 Act is arguably broader than corresponding provisions of the United Kingdom/EU and USA law.

	Sri Lanka	UK	USA	TRIPS	COMMENTS ON SRI LANKAN LAW
Provision	Sec.121(2)(b) of 2003 Act (registered trade marks) ¹⁷⁹	Sec.9(1) and 10(3) of TM Act, 1994 (registered trade marks) ¹⁸⁰	Sec.1125(c)(1) & (2) of Lanham Act (independent of registration)	Art 16 and 6 ^{bis} of Paris Convention	Roman Dutch Law can also be applied
Consent	...without consent...	Sec. 9(1)	lack of consent implied by equity	Art.16 (1)	Comparable
Type of useany other use...	use in the course of trade	commercial use	use in the course of trade	broadest ¹⁸¹
Sign or mark	...mark or of a sign or trade name resembling...	sign identical with or similar to	already famous mark (does not have to be registered)	identical or similar signs Art.16(1)	-
Products	no limit	goods or services for which the mark is not registered (case law ¹⁸² also similar products)	no limit	no similar-provided connection when it is not similar Art.16(3)	no limitation on products

¹⁷⁸ This type of infringement is similar to the United States concept of trade mark dilution. Dilution can occur in two situations i.e. blurring and tarnishment. Blurring occurs when companies use the plaintiff's trade mark on other kinds of goods and service. Because of this, unique and distinctive significance of the mark to identify and distinguish, one source may be diluted and weakened. Tarnishment occurs when the defendant uses the trade mark in a way that degrades the positive associations with the mark, thus diluting the quality of the mark. *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 42 (2d Cir.1994), *Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir.1989). Also J Thomas McCarthy, *McCarthy on Trade Marks and Unfair Competition* 4th (edn) (USA: Thomson West, 2004) § 24:68, 24:95.

¹⁷⁹ Unregistered mark as trade name or under unfair competition.

¹⁸⁰ Sec.56 unregistered well-known foreign marks, but local presence.

¹⁸¹ Since there is no requirement of use in commerce or similar, it gives wider opportunity to the application of this section.

¹⁸² E.g. *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* [2004] E.T.M.R. 10 and *Davidoff & Cie SA v Gofkid Ltd (C292/00)* [2003] 1 C.M.L.R.

Reason	without just cause	without due cause, sec. 10(3)	wilfulness to damage	.	.
Effect on whom or what	conditions likely to be prejudicial to the interest of the registered owner	unfair advantage or detriment to the distinctive character or reputation of the trade mark	dilution, ¹⁸³ no effect against registered trade mark owner (sub sec.3) ¹⁸⁴	interests of the owner of registered trade mark likely to be damaged	broader ¹⁸⁵ than UK but similar to TRIPS
Marks with a reputation	implicit	Sec.10(3)-yes	famous marks ¹⁸⁶	"well-known marks" Art.16(2)	broadest
On the part of the public	not specific	case law ¹⁸⁷ says that confusion is not necessary for sec.10(3)-Art. 5(3) of Directives	confusion is not necessary for injunction sec.43(c)+ wilfulness for compensation/ destruction 43(c)(2), (15 USCA 1125)	Art.16(3) "connection"	broader ¹⁸⁸ than TRIPS and UK

Table One- Comparison of specific provision in Sri Lanka, UK and USA law

The fifth situation is sec.121(3). All the above instances of infringing use by implication involve activity in Sri Lanka. However, application¹⁸⁹ or affixing in Sri Lanka by a third party, of a mark or any sign resembling such mark in such a way as to be likely to mislead the public, on or in connection with, goods (whether intended for sale in Sri Lanka or for export) in respect of which such mark has been registered is also prohibited.¹⁹⁰

¹⁸³ McCarthy, sec.45 [App.A1-88] for the meaning of dilution.

¹⁸⁴ Defences of fair use, comparative advertising and news reporting. Sec. 43(c)(4) [App.A1-75].

¹⁸⁵ This part is broader than UK and USA law for two reasons. Firstly, though it is not explicit in sec.160, it can be argued that 'prejudicial to the interest of the registered owner' can be interpreted to include Roman Dutch law principles such as undue enrichment, *aquilian action* and to include Buddhist principles, which condemn such conduct. Secondly, sec.22(2)(b) provides that damages in the case of infringement of copyright should be calculated by referring to loss suffered as a consequence of the act of infringement. When apply the analogy of this application to trade mark, it is submitted, Sri Lanka law is broader than that of UK and USA law.

¹⁸⁶ In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to - (A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. (Sec.1125(c)(1).

¹⁸⁷ E.g. *Pfizer Ltd v Eurofood Link (UK) Ltd* [2001] F.S.R. 17, ECJ in *Sabel BV v Puma AG* [1998] R.P.C.99.

¹⁸⁸ Since there is no necessary public to be confused, it is submitted this provision is broader than US.

¹⁸⁹ Sec.192 lists situations, which are deemed to be application of marks.

¹⁹⁰ Sec.121(3).

The 2003 Act further provides that any person who wilfully infringes the rights of any registered owner, assignee, or licensee of a mark shall be guilty of an offence and would be liable to a fine and imprisonment.¹⁹¹ Similar to sec.158 of the Code,¹⁹² 2003 Act includes a provision to exempt certain persons from the offence.¹⁹³

3.7.5 Certification Marks

Chapter XXIX of the 2003 Act deals with Certification marks.¹⁹⁴ Section 142 of the 2003 Act provides that provisions relating to marks shall apply to certification marks. In terms of sec.101 'certification mark' means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods, or performance of service, quality, accuracy or other characteristics. According to sec.142(2), a certification mark is any visible sign serving to distinguish the goods or services which are certified from those which are not certified.

Section 142 of the 2003 Act creates a complicated situation since it has not abolished or amended the relevant provisions of the Sri Lanka Standard Institution Act.¹⁹⁵ One could argue that since the Code has been repealed by the 2003 Act, Sri Lanka Standard Institution Act has no effect. It is submitted that had the legislature intended to abolish the application of those provisions in the Sri Lanka Standard Institution Act, they would have done so in the same manner as the 2003 Act made amendments to other legislations such as Customs Ordinance, High Court of the Provinces (Special) Provisions Act. Since it is doubtful as to who has the legal authority to certify marks, the position of certification marks remains unclear.

The 2003 Act provides registration of certification mark including sign or indication, which may serve in trade to designate the geographical origin of the goods and services¹⁹⁶ while extending the application of the general provisions to certification marks.¹⁹⁷

¹⁹¹ Sec.184.

¹⁹² This provision is similar to that of first generation trade marks law cf. sec.3(2) and 7 of the MMO-1888.

¹⁹³ Sec.186(2)-innocent infringers who have taken all reasonable precautions and cooperated with the prosecution.

¹⁹⁴ Para 3.6.4. Generally, Norma Dawson, *Certification Trade Marks - Law and Practice* (London: IPP, 1988).

¹⁹⁵ Para 3.6.4.

¹⁹⁶ Sec.142(3).

¹⁹⁷ Sec.142(1).

3.7.6 Collective Marks

Similar to its predecessor, the 2003 Act provides protection for collective marks. Chapter XXVIII deals with collective marks. In terms of sec.101 'collective marks' means 'any visible sign designated as such and serving to distinguish the origin or any other common characteristic of goods or services of different enterprises which use the mark under the control of the registered owner'. Furthermore, sec.138(2) states that sec.101 shall be construed as to distinguish goods and services of the enterprise which use the collective marks from those of other enterprises.

Though sec.103 prohibits registration of sign or indication, which may serve, in the course of trade, to designate place of origin of goods or services, sec.138(3) allows registration of such signs when it constitutes a collective mark. Nevertheless, the owner of such mark is not entitled to prevent others from using such signs or indications in accordance with honest practice in industrial and commercial matters. The application of these provisions is yet to be seen.

3.7.7 Trade names

Three legislation namely, the Business Names Act, No.7 of 1987¹⁹⁸, the Companies Act, No.17 of 1982, and the 2003 Act governing the law relating to trade names in Sri Lanka. Section 2 of the Business Names Act provides for the compulsory registration of a business name, where such name does not consist of the true full names of all persons carrying on the business individually or as partners. In terms of sec.45 of that Act, 'business name' means the name or style under which any business is carried on, whether in partnership or otherwise, and includes a vilasam.¹⁹⁹

Section 21(1) of the Business Names Act provides that the Registrar of Business Names should refuse registration of a trade name, which is contrary to any law for the time being in force, or is a business name the use of which is prohibited under sec. 8 such as

¹⁹⁸ This is a successor of Business Names Ordinance, No.6 of 1918 as amended by Ordinances, No.27 of 1919 and No.8 of 1938.

¹⁹⁹ 'Vilasam' has been used by some members of the business community in Sri Lanka from early days. As observed by Lascelles CJ in *Somasundaram Chetty v Arunasalam Chetty* (1914)17 N.L.R.257, 'it is true that our court have frequently recognized the custom of Natucottu Chetties trading in Ceylon with regard to signing commercial documents. The firm has a vilasam or trade style consisting usually of the initials of the firm, and an agent signing in Ceylon on behalf of his firm usually prefixes these initials to his own name'. *Wass v Samarasinghe* (1917)19 N.L.R.29, *The Chartered Bank of India, Australia and China Ltd. v Palniappa Chetty* (1917)19 N.L.R.417, *Arunasalam v Somasundaram* (1918)20 N.L.R.321.

misleading the public.²⁰⁰ Nevertheless, the same section provides that the registration of a business name under this Act shall not be construed as authorizing the use of that name if apart from such registration the use thereof could be prohibited.

Incorporation of business is voluntary under Sri Lanka law except in the situations contemplated under sec.426.²⁰¹ Section 19(1) of the Companies Act precludes registration of a company “by a name which is identical with that by which a company in existence is already registered, or so nearly resembles that name as to be calculated to deceive.” Hence, it only applies to the case of taking names of subsisting company already registered.

According to sec.101 of the 2003 Act ‘trade name’ means “the name or designation identifying the enterprise of a natural or legal person.” However, a name or designation is not admissible as a trade name if it is contrary to morality or public order²⁰² or likely to offend religious or racial susceptibility of any community or likely to mislead trade circles or the public as to the nature of the enterprise identity by name.²⁰³

The 2003 Act specifically provides protection for trade names even prior to or without registration against “any unlawful act committed by a third party.”²⁰⁴ Furthermore any subsequent use of a trade name (whether as a trade name, trade mark, service mark or certification mark) by a third party likely to mislead the public will be deemed unlawful.²⁰⁵ Since the 2003 Act does not provide infringement provision or confer any criminal or civil sanctions against ‘unlawful act’, it could be argued that this would amount to breach of statutory duty. In the absence of infringement provisions, it is submitted that infringement provision of the Business Names Act should therefore be applied to unregistered business names.²⁰⁶

²⁰⁰ Sec.8(1)(b) prohibits, among other things, carrying on business in Sri Lanka under a business name if by reason of its nature or the use to which it would be put is contrary to morality or public order and is likely to offend the religious or racial susceptibility of any community or is likely to mislead trade or business circles or the public as to the nature of the trade or business identified by that name.

²⁰¹ Sec.426(1)“No company, association, or partnership consisting of more than twenty persons shall be formed outside Sri Lanka, for the purpose of carrying on any business that has for its object the acquisition of gain by the company, association or partnership, or by the individual members thereof, unless it is registered as a company under this Act or under some other enactment.”

²⁰² Again this emphasises the moral character.

²⁰³ Sec.143.

²⁰⁴ Sec.144(1). See Art.8 of Paris.

²⁰⁵ Sec.144(2).

²⁰⁶ It is submitted that it could be argued that trade names in Sri Lanka can be protected by analogy with sec.8 of the Business Names Act. Moreover, since the ‘unlawful act’ might be contrary to the Buddhist principles and also meet the requirements of *Aquilian action*, it is possible to apply Buddhist principles and Roman Dutch Law to protect trade names in Sri Lanka. Para 2.11.

In terms of sec.145 of the 2003 Act, a trade name may be assigned or transmitted together with the assignment or transmission of the enterprise or part of the enterprise identified by that name. Nevertheless, such assignment or transmission is deemed to be invalid if the purpose or effect thereof is to mislead the public, in particular in respect of the nature, source, manufacturing process, characteristics or suitability for their purpose of goods or services to which the name is applied.²⁰⁷

According to the above mentioned provisions of the 2003 Act, it would seem that a trade name is afforded protection simply on priority of use without any need for registration even where registration is compulsory under Business Names Act or Companies Act.²⁰⁸ As yet, there is no judicial opinion or academic clarification made available in Sri Lanka as to the interaction of these provisions in the legal system.

3.7.8 Geographical Indications

Chapter XXXIII of the 2003 Act provides for the protection of agricultural products, foods, wines, and spirit under Geographical indication.²⁰⁹ Nevertheless, the Act does not define the term. Hence, it is submitted that Sri Lanka should follow TRIPs definition.²¹⁰ Section 161 stipulates that any interested party is entitled to prevent the use of geographical indications to mislead the public, prevent any use which constitute an act of unfair competition, and use to identify goods etc not originating in the place indicated by the geographical indication in question. The interested party is entitled to injunction and any other appropriate relief.²¹¹

Although, sec.161 deals specifically with wines and sprits, in practice such is not produced in Sri Lanka. Apart from fulfilling TRIPS obligation,²¹² the legislator could have emphasised other products more important to Sri Lanka such as 'Ruhunu curd' (comes from down South), 'Ambalangoda masks' (comes from a place in the south) and 'Dumbara juggery' (comes from a hilly area of the country). This is another clear example for incorporation of provisions of foreign law into Sri Lankan law without due consideration to the local situation.

²⁰⁷ Sec.123(2) read with sec.141(2).

²⁰⁸ Sec.144(1): "Notwithstanding the provision of any written law providing for the registration of a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party." Sec.144(2) deems as unlawful uses of trade name likely to mislead the public.

²⁰⁹ Norma Dawson, 'Locating Geographical Indications? Perspectives from English Law', *TMR*, 90 (2000), 590-614.

²¹⁰ Art.22.

²¹¹ Sec.161(4).

3.7.9 Passing off

The concept of passing off has been recognized by Sri Lankan courts from the beginning of trade mark law. It has never been introduced by statute. In *Kapadia v Mohamad*²¹³ the Court held that, although passing off actions were not especially reserved in the Trade Mark Ordinance, such an action could be maintained under the law of Sri Lanka. Furthermore, the Court held that in passing off actions it is not necessary to prove actual fraud; all that is needed is to show that the defendant has represented his goods to be the goods of the plaintiff.²¹⁴

In *Hollandia and Anglo-Swiss Condensed Milk Co. v The Nestle and Anglo-Swiss Condensed Milk Co*²¹⁵ the court held that even though both marks had the figure of a female, the mere possibility of deception by passing off is not a sufficient ground for refusing registration of the mark. In *Cheseborough Manufacturing Co. v Kudhoos*²¹⁶ the Court, referring to Kerly on Trademarks, 5th (edn), p.472, observed that in an action for infringement, the plaintiff can rely only upon the imitation of his registered mark, while in an action for passing off he may rely on other things, or on additional things, which are connected with his trade or goods.

For example, in *Lever Brothers v R.M. Ranganathan Pillai*²¹⁷ the plaintiff was the proprietor of the trade mark "LUX" in respect of perfumed toilet soap. The soap imported by the defendants was contained in a wrapper with the word "REX." Since the salient features of the wrappers were the same, the court held that the marks of the wrapper on the soap imported by the defendant were calculated to deceive and hence to pass off.

In *Little Oriental Balm & Pharmaceuticals Ltd. v Ussen Saibo*²¹⁸ the Court citing the observation made by Cotton, L.J. in *Lever v Goodwin*,²¹⁹ held that

There may be no monopoly for the individual things, but if they are so combined by the defendant as to pass off the defendant's goods as plaintiff's, then defendants have brought themselves within the old common law doctrine in

²¹² Art.23.

²¹³ (1918) 20 N.L.R.314.

²¹⁴ (1918) 20 N.L.R.314 at 315.

²¹⁵ (1923) 24 N.L.R.396.

²¹⁶ (1928) 30 N.L.R.161 at 163. In this case an appeal was made to expunge a trade mark from the register on the ground that it resembled the respondent's trade mark so clearly that it was calculated to deceive.

²¹⁷ (1937) 39 N.L.R. 332.

²¹⁸ (1939)XIV C.L.W.152.

²¹⁹ (1887) 36 Ch.D 1.

respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs.

All above-mentioned cases show that recognition of passing off in Sri Lanka developed before the introduction of the Code in 1979, in parallel with its development in the United Kingdom.

However, during the 23 years of application of previous law, the Code,²²⁰ the Sri Lankan court referred to passing off only in three occasions.²²¹ Importantly, in the *Sumeet Research and Holdings Ltd. v Elite Radio & Engineering Co., Ltd*²²² the court referred to *Hexagon Pty Ltd. v. Australian Broadcasting Commission*²²³ where the Australian court held that unfair competition is an extension of the doctrine of passing off, or, possibly, is a new and independent cause of action.²²⁴

The Sri Lankan court concluded that

...it is premature for this Court to attempt a definitive interpretation of section 142, and its relationship to section 117; but it is quite clear that serious questions, of mixed fact and law, arise for consideration in the District Court, with little assistance from local precedents.²²⁵

Neither judicial decisions nor academic opinion being available in Sri Lanka as to whether unfair competition was an extension of passing off action, it remains open as to whether the 2003 Act expressly recognized the concept of passing off. Hence, it warrants examining provisions relating to unfair competition under the 2003 Act to determine whether the concept of passing off is extended under the concept of unfair competition. However, it is submitted whether or not unfair competition is broader than passing off it must include passing off and consequently old cases are relevant for the interpretation of new law.

3.7.10 Unfair Competition

According to the 2003 Act, any act or practice carried out or engaged in, in the course of industrial or commercial activities that is contrary to honest practice is deemed to

²²⁰ The Code was based on WIPO Model Law. Para 3.6.

²²¹ *Ceylon Tea Marketing Ltd. v Prepacked Exports (Pvt) Ltd. and Others* (1998)2 S.L.R.146, *Suby v Suby* (1980)2 S.L.R.65 and *Sumeet Research and Holdings Ltd. v Elite Radio & Engineering Co., Ltd.* (1997) 2 S.L.R.393.

²²² (1997) 2 S.L.R.393.

²²³ (1975) ALR 233.

²²⁴ Para 3.6.6.

²²⁵ Sec.142 dealt with unfair competition whereas sec.117 dealt with the exclusive rights of a trade mark owner.

constitute an act of unfair competition.²²⁶ Furthermore, the 2003 Act stipulates that the provisions of unfair competition apply independently of, and in addition to, other provisions of the Act protecting trade marks.²²⁷

Subsection (2),(3) and (4) of sec.160 give an inclusive definition of acts of unfair competition by specifying certain acts, which it included within the meaning of that term. Accordingly, any act or practice carried out or engaged in, in the course of industrial commercial activities:

(a) that causes or is likely to cause confusion with respect to a mark, a trade name, a business identifier other than a mark or trade name, the appearance of products or services, a celebrity or a well-known character.²²⁸

(b) that damages or is likely to damage the goodwill or reputation of another's enterprise, whether or not such practice actually causes confusion.²²⁹

(c) that misleads or is likely to mislead, the public with respect to manufacturing process, suitability of a product or service for a particular purpose, the quality, quantity, or other characteristic of products or service, the geographical indication of products or service, the conditions on which products or services are offered or provided, the price of the product or service²³⁰ constitutes an act of unfair competition.

Moreover, false or unjustifiable allegation in the course of industrial commercial activities that discredits, or is likely to discredit, an enterprise of another or the activities of such enterprise is deemed as an act of unfair competition.²³¹ The application of these provisions is yet to be seen. However, it can be argued that when these provisions are applied with *Aquilianaction* it would provide proper protection.²³²

As observed by the English Court in *Reckitt & Colman Ltd v Borden Inc*²³³ three elements that a plaintiff must show in order to prove passing off i.e. goodwill or reputation attached to the goods or services, misrepresentation by the defendant to the

²²⁶ Sec.160. See Art.10^{bis} of Paris Convention. Also, Ch.IV of WIPO, *Protection Against Unfair Competition* (Geneva: WIPO, 1994).

²²⁷ Sec.160(1)(b).

²²⁸ Sec.160(2)(b).

²²⁹ Sec.160(3)(a). Here the Act stipulates that damage to the good will or reputation of another's enterprise may result from the dilution of good will or reputation attached to a mark, trade name etc. Para 3.8.3.(a) for dilution.

²³⁰ Sec.160(4)(b).

²³¹ Sec.160(5)(a).

²³² Para 2.11 for the requirement for an *aquilian action*.

²³³ [1990] 1All ER 875.

public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are goods or services of the plaintiff and loss or damage as a consequence. Though the 2003 Act does not expressly provide protection for passing off, sec.160 seems to be an extended form of passing off since sec.160(2), (3) and (4) are dealing with, among other things, all requirements that constitute an act of passing off. Since these provisions are broader than protection given against passing off, for example not all forms requires misrepresentation, it is submitted that unfair competition provisions of the 2003 Act can be considered as an encompassing or integration of the passing off action with the unfair competition provisions introduced by the previous law, the Code.²³⁴

PART C

Application of trade mark law in cyberspace

3.8 Introduction

As noted in Chapter One, the rapid emergence of Internet technologies and cyberspace's exponential growth has created many novel issues in relation to application of traditional laws such as contract, banking and evidence promulgated in a society where almost all transactions took place offline.²³⁵ As far as intellectual property is concerned, the application of trade mark law in cyberspace is one of the main issues which created problems for law-makers nationally and internationally as well. Since Sri Lanka is becoming a "Cyber Island" and "Telecommunications Hub" in South Asia by developing information communication systems, it is vitally important to examine the application of trade mark laws in the information age.

3.8.(I)(a) Methodology to be applied

The five-step methodology proposed in Chapter two should be applied to the application of trade mark law in Sri Lanka to determine whether the present law is adequate to address special issues arising in the information age or whether Sri Lanka requires a new law. However, in this process the court should not confine itself to the application of a single step but to synthesise more steps to provide proper protection. Especially STEP 1 should be considered along with STEP 5 where there is more latitude to apply Roman Dutch Law principles and other areas of law²³⁶ to protect trade marks.

²³⁴ cf. sec.142 of the Code.

²³⁵ Para 1.1.

²³⁶ E.g. application of sec.160 of 2003 Act along with *Aquilian Action*. Para 3.8.9.

3.8.(I)(b) Potential infringement of trade marks in Cyberspace²³⁷

As discussed earlier in this Chapter, the essential function of trade mark is to identify the source of goods or service one from another.²³⁸ Nevertheless, the rationale of trade mark law is to protect the trade mark owner while protecting the public from deceptive and misleading trade marks practices as well. To achieve the former objective, the trade mark law has given the right to trade mark owner to exclude others from using marks belonging to him without his consent. The economic object of such protection would be to protect the promotional aspect of the trade mark known to consumers and thereby prevent consumers from confusion while preventing unfair practices that would amount to misappropriation of another's good will. The concept of protection of trade marks is focused on the notion of 'use of mark'. Hence, the subtle question arises as to whether 'new use' of trade mark in cyberspace would tend to harm the value of the mark to the original owner. On the other hand, as far as consumers are concerned the question arises as to whether such use on the Internet would be deceptive and misleading since the 'use' is not perceived by consumers in many instances.

Admittedly, clashes of trade marks rights are unavoidable on the Internet. Possible clashes of trade mark on the Internet can arise in many situations, such as where the same trade mark is owned and used by different persons in respect of different goods or services offered via the Internet. Another situation arises where the same mark is owned by different persons in different countries in relation to the same goods or services offered via the Internet.

Nevertheless, these situations can be considered as unintentional clashes of trade marks, which arise only due to the specific technicality of cyberspace. It is obvious that both situations are not confined to the Internet and may occur in offline transaction as well.²³⁹ In practice, the first situation does not create important issues since many websites contains disclaimer notices. The second situation also can be avoided by simply stating in a notice that the goods in question are not available for sale in that country. The efficacy of this will depend on two factors: the laws of individual countries involved and facts of

²³⁷ Cyberspace is a metaphor for describing the non-physical terrain created by computer system. Webopedia at <http://webopedia.com/TERM/c/cyberspace.html> (Accessed: 01.12.2004).

²³⁸ Sec.101.

²³⁹ A same trade mark can be used in different country for the same goods or service. In *Pitman Training Ltd v Nominet UK* [1997] F.S.R 797 the court looked into this matter and concluded that no passing off arose since they were concurrent users.

any particular case. What use of a trade mark in one country may amount to trade mark infringement may be different in another country.²⁴⁰

Having understood the general problematic areas of use of trade marks on the Internet, the rest of this Chapter will focus on those issues, which arises as a result of intentional use of trade mark in different ways: as domain names, as meta tags, spamming, linking and framing, sale of trade marks as keywords, pop-up advertisements and mousetrapping. More importantly, mouse trapping is also very much related to the present discussion. As will be seen these kinds of use arise not just because of the special character of the medium but due to the intention behind the use.

3.8.2 Domain Names

It is well known that there are two ways to get access to a website. One way is to use keywords and search engines. The other way is to use a domain name. In contrast to use of trade mark as meta tag, use of a trade mark in a domain name is visible to the web surfer. Thus, a brief examination of network system that allows creating domain names assists in the proper understanding of the legal consequences of domain name system.

As discussed, the Internet is a interconnection of computers spanning the globe, which allows communicating and sharing information.²⁴¹ These computers are capable of communicating with each other since they share a common set of data transmission protocol known as Transport Control Protocol/ Internet Protocol (TCP/IP). In general, this is known as an IP address (Internet protocol address). Every host and router on the Internet has an IP address, which encodes its network number and host number. Due to its uniqueness, no two machines have the same IP address. All IP addresses are 32 bits long.²⁴² Since the use of this binary network address is difficult, the DNS (Domain Name System) was designed. This mechanism associates domain names with an IP address. Thus, it is obvious that Domain Names are alphanumeric combinations that serve as marks for the Internet Protocol address.²⁴³

Every domain name is divided into two hierarchical levels such as Top Level Domains (TLDs) and Second Level Domains (SLDs). TLD is the general root system under which the individual SLDs are allocated to individual users. Generally, TLDs come in two types

²⁴⁰ c.f. *Euromarket Designs Incorporated v. Peters & ANR* 2000 WL 1274057 (Ch D),[2000] E.T.M.R.1025,[2001] F.S.R. 20.

²⁴¹ Webopedia at <http://www.webopedia.com/TERM/H/HTML.html> (Accessed: 01.12.2004).

²⁴² Andrew S. Tanenbaum, *Computer Networks*, 3rd (edn), (Prentice-Hall International Inc., 1996), 416.

²⁴³ Ibid pp.622-630.

i.e. generic and countries. Thus, every domain name includes a suffix and this suffix indicates which TLD the domain belongs to and SLD refer as identifiers linked to the Internet.²⁴⁴

A domain name can function as a trade mark or service mark if it functions as a source identifier. It may also perform other trade mark functions such as the advertising or promotional function. Consequently, the greater legal problem associated with the domain arises when it is used as source identifier. Nevertheless, it should be understood that, in theory, not every domain name necessarily leads to disputes though it is associated with a trade mark. For instance, one can distinguish one top-level domain (TLD) from another by mere comparison. However, since Internet users are not sophisticated enough in a country like Sri Lanka where information society is emerging to distinguish between subtle differences of two similar domain names, specially in the case of Second Level Domains (SLDs), it could create confusion among web users due to the fact that the functional difference of similar domain names such as a hyphen between words does not mitigate the likelihood of misleading the public.

When can a domain name infringe trade marks rights of another? In the usual course of events, legal disputes in relation to domain name can arise in the following situations (I) conflicting interest disputes (II) "palming off" disputes (III) competitor disputes (IV) Cybersquatting or domain name hijacking (V) cyber griping or parody disputes. A brief examination provides an insight whether such use really amount to infringement of trade marks.

3.8.2.(I) Conflicting interest disputes

These types of dispute arise when two persons each have a legitimate interest over the same domain name and one had already registered the domain name. This situation is similar to honest concurrent user in the real world. In theory, whoever is quick enough to register the name first would be in a better position.²⁴⁵

²⁴⁴ At http://www.webopedia.com/TERM/d/domain_name.html (Accessed: 01.12.2004) and also <http://www.icann.org/tlds/> (Accessed: 01.12.2004).

²⁴⁵ This situation is not considered further.

3.8.2.(II) Palming off disputes

This type of disputes arise when one registers a domain name with the intent to “palm off” the fame and good will of someone else’s trade mark²⁴⁶ i.e. uses web address for trade in similar products. As a result, the registrant generates new customers it never would have previously obtained. Sometimes this may happen between two competing companies when one company registers a domain name of its competitor and then links that domain name to their own company website.²⁴⁷

3.8.2.(III) Competitor disputes

In this situation, people register domain names that contain the company name or trade marks of their competitors. The motive is either to block the competitor from using the domain name, or to lure customers away from the competitor where customers would be told how his products are better than competitor’s products.²⁴⁸ Hence, such an act may constitute trademark infringement or an act of unfair competition.

3.8.2.(IV) Cybersquatting

Cybersquatting is generally defined as the act of registering an Internet domain name in bad faith. Though they do not use web address/ domain name diverting for trade, most often registered with the intent to sell the name to the owner of a trade mark or service mark, or otherwise harm the trade mark owner through use of the name.²⁴⁹ Since domain name registration is operated on the basis of accepting the first application for the registration of a particular domain name it is open to anyone to utilise. This practice created many legal disputes around the world.²⁵⁰

²⁴⁶ *Kazmaier v. Wooten*, 761 F.2d 46,52(1stCir.1985) (quoting *Remco Industries v. Toyomenka, Inc.*, 286 F. Supp. 948, 954 (S.D.N.Y.1968), aff’d, 397 F.2d 977(2d Cir.1968). Also *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, 40 U.S.P.Q.2d 1479(W.D.Wash.1996), *Toys “R” Us v. Akkaoui*, 40 U.S.P.Q.2d 1836(N.D. Cal.1996).

²⁴⁷ E.g. *Roho, Inc. v. Marquis*, 902 F.2d 356, 359(5thCir.1990); *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403,1406 (9thCir.1988).

²⁴⁸ *Green Prods. Co. v. Independence Corn By-Prods. Co.* 992 F.Supp.1070 (N.D.Iowa 1997).

²⁴⁹ *Virtual Works, Inc. v. Volkswagen of America Inc.*, 238 F.3d 264,267(4thCir.2001).

²⁵⁰ A variant of cybesquatting is typosquatting. It is the registration of a domain name that is likely to be a typographical error entered by someone attempting to go to a specific website. Some time this involves mousetrapping. When a user misspelled a domain name and opens the webpage. Upon reaching website finds he is barraged with advertisement. The user is unable to leave the website they originally accessed since he was trapped. *Electronics Boutique Holdings Corp. v. Zuccarini*, 56 U.S.P.Q.2d 1705(E.D.Pa.2000), *Shield v. Zuccarini* 254 F.3d 476 C.A.3 (Pa.), 2001, *Victoria’s Cyber Secret Limited Partnership v. V Secret Catalogue, Inc.*, 161 F.Supp.2d 1339,(S.D.Fla.2001).

3.8.2.(V) Cyber griping/parody²⁵¹ or Commentary²⁵²

This a situation where a consumer or former employee maintains a website devoted to criticising a commercial entity.²⁵³ The website uses, more often, the commercial entity's trade mark or the domain name on the webpage. Generally, this is done by creating a domain name that consists of the commercial entity's mark, followed by sucks.com. Though such uses are non-commercial, it has been challenged under many theories of trade mark law such as trade mark infringement, unfair competition and cybersquatting etc.²⁵⁴

Having understood different types of domain name disputes, the following section examines the position of US, UK and Sri Lanka.

3.8.2.(a) Position in the USA

In the famous cybersquatter case, *Panavision International, L.P. v Toepfen*²⁵⁵ the court held that the business of registering and then offering to sell domain names to the trade mark owner at a profit, is commercial use and can constitute dilution of a famous mark and infringe the Trade Mark Dilution Act 1995 .²⁵⁶

In *Brookfield Communications Inc. v West Coast Entertainment Corp.*,²⁵⁷ one of the issues was whether the defendant's parody site would constitute trade mark infringement and unfair competition. The court held that the defendant's domain name was essentially identical to the plaintiff's registered mark and the activities were likely to constitute trade mark infringement because they were likely to confuse the public about the source or

²⁵¹ Spyros Maniatis, and Gredley, E., "Parody, A Fatal Attraction? Part II-Trade mark Parodies," *E.I.P.R.*, (1997), 412-420.

²⁵² Nevertheless, it is doubtful whether there is a possibility to apply the concepts such as fair use and comparative advertising under Sri Lankan trade mark law. Firstly, as will be seen in Para 4.1, in practice there is no comparative advertisements in Sri Lanka though no law explicitly prohibit such practice. Secondly, one could argue parody sites could be covered by Art.14(1) of the Constitution where freedom of expression is guaranteed. Nevertheless, Art.14(1) is restricted by Art.15(7) to protect individuals rights and also fundamental rights could only be claimed against the State. However, it is submitted, in interpretation of private rights and their limitations, constitutional freedoms may be prayed in aid.

²⁵³ *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp.2d 1161 (C.D.Cal.1998).

²⁵⁴ E.g. *Lucent Technologies Inc. v. lucentucks.com*, 95 F.Supp. 2d 528 (E.D.Va.2000); *CPC International Inc. v. Skippy Inc.*, 2000 US App. LEXIS 12104 (4thCir.2000); *Name.Space Inc. v. Network Solutions Inc.*, 202 F.3d 573 (2ndCir.2000). cf. *Taubman Co. v. Webfeats*, 319 F.3d 770 (6thCir.2003), where the court held that a domain name that added the word "sucks" to a trade mark does not create a likelihood of confusion, and was protected speech under the First Amendment.

²⁵⁵ 141 F.3d 1316(9thCir.1998).

²⁵⁶ Also *Intermatic Inc. v. Toepfen*, 947 F. Supp.1227 (N.D.Ill.1996).

²⁵⁷ 174 F.3d CA.9 (Cal) 1999.

sponsorship of West Coast's "moviebuff.com" website. The tests of trade mark infringement and unfair competition were met.

Furthermore, in *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*,²⁵⁸ the court held that where a party registers and uses a domain name, in which is contained an identical or confusingly similar version of the distinctive trade mark of another, such person is liable in a civil action by the trade mark owner, if such person in bad faith intends to profit from that distinctive mark.²⁵⁹

3.8.2.(b) Position in the United Kingdom

In *British Telecommunication plc, Virgin Enterprises Ltd. J Sainsbury plc, Mark & Spencer plc and Ladbroke Group plc v One in a Million*²⁶⁰ the court discussed in detail the use of domain names. The defendant dealt in Internet domain names and registered and sold well-known names and trade marks as domain names without the consent of the company or person, which owned the established trading goodwill in the name. Thus, the plaintiff companies alleged that the defendant's conduct constituted acts of passing off and trade mark infringement. The Court observed that

Whether any name is an instrument of fraud will depend upon all circumstances. A name, which will, by reason of its similarity to the name of another, inherently lead to passing off, is such an instrument. If it would not inherently lead to passing off, it does not follow that it is not an instrument of fraud. The court should consider the similarity of the names, the intention of the defendant, the type of trade and all the surrounding circumstances. If it be the intention of the defendant to appropriate the goodwill of another or enable others to do so, I can see no reason why the court should not infer that it will happen, even if there is a possibility that such an appropriation would not take place. If, taking all the circumstances into account the court should conclude that the name was produced to enable passing off, is adapted to be used for passing off and, if used, is likely to be fraudulently used, an injunction will be appropriate.²⁶¹

Furthermore, the Court of Appeal held that by registering the distinctive names of the plaintiffs the defendants had made a false representation of association with and ownership of goodwill in the names (with the intention of threatening dishonest use and disposal) which constituted passing off, and a threat to pass off. By registering the

²⁵⁸ 202 F.3d 489(2d Cir.Conn.2000).

²⁵⁹ *Schmidheiny v. Weber* 2003 WL 288437 C.A.3 (Pa.), 2003; *Shields v. Zuccarini* 254 F.3d 476 C.A.3 (Pa.), 2001; *Electronics Boutique Holdings Corp. v. Zuccarini* 2000 WL 1622760 E.D.Pa.,2000; *Virtual Works, Inc. v. Volkswagen of America, Inc.* 238 F.3d 264 C.A.4 (Va.), 2001; *Ford Motor Co. v. Greatdomains.Com, Inc.* 177 F.Supp.2d 635 E.D.Mich.,2001; *E. & J. Gallo Winery v. Spider Webs Ltd* 129 F.Supp.2d 1033 S.D.Tex.,2001. Also the application of Anticybersquatting Consumer Protection Act of 1999, 15 U.S.C. § 1125(d) and *People for the Ethical Treatment of Animals, Inc. v. Doughney*, 263 F.3d 359(4th Cir.2001).

²⁶⁰ [1998] F.S.R. 265, Ch.D[1999] F.S.R.1[1998] 4 All E.R.476 C.A.

domain names, the defendant had also created instruments of fraud since any realistic use except by trade mark owner would result in passing off.

In *Euromarket Designs Incorporated v. Peters & ANR*²⁶² an American company ran a chain of stores under the name "Crate and Barrel" which traded in the United Kingdom. The American Company brought an action for trade mark infringement against an Irish company who had a shop in Dublin and a website in the United Kingdom using that name. The question was whether the advertisement in a magazine circulating in Ireland and the United Kingdom and the website of defendant infringed the plaintiff's UK registered trade mark, which was the same as defendant's.²⁶³ After considering the factual circumstances of the case, the court held the relevant test to apply was whether the reasonable trader would regard the use concerned as "in the course of trade in relation to goods" within the Member State concerned. Thus, there was no infringement because (1) the advertisement was intended to address only clientele local to the shop premises; (2) anyone visiting the website from anywhere other than Ireland would understand that the site was not directed at them; (3) P had not acted dishonestly, and (4) the own name defence could apply to company names. This case emphasised the fact that when a domain name clearly indicates the sources then there would be no misleading of the public, hence no infringement of trade marks rights.

In *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd*²⁶⁴ the question was whether the name of a book used in non trade mark sense constituted trade mark infringement. The court held that use of a trade mark as the descriptive title of a book does not constitute trade mark infringement.²⁶⁵

However, subtle questions arise if a person registers a domain name in a non-UK ccTLD, which is identical to a well-known mark in United Kingdom; is this sufficient to constitute use or threatened use within the United Kingdom? Although legal opinion in

²⁶¹ [1999] F.S.R.1at 8.

²⁶² 2000 WL 1274057 (Ch D),[2000] E.T.M.R.1025,[2001] F.S.R.20.

²⁶³ The claimant has a UK registered trade mark consisting of the words "Crate & Barrel" and also has a community trade mark registration.

²⁶⁴ [1996] F.S.R 205,1996 S.L.T.597.

²⁶⁵ The difficulties arise in deciding non-trade mark use in *Arsenal Football Club Plc v. Matthew Reed* Court of Appeal [2003] EWCA Civ 96. Also, *Metalrax Group Plc v Vanci* (Ch.D)31.01.2002, 2002 WL 347054; *French Connection Ltd v Sutton (t/a Teleconexus Email)* [2000] E.T.M.R.341; *Musical Fidelity Ltd v Vickers (t/a Vickers Hi-Fi)*(CA) Court of Appeal 2002 WL 31599678; *Bonnier Media Ltd v Smith*(OH) Outer House [2002]E.T.M.R.86; *Canal & Image UK Limited v. Vanitymail Services, Inc*, WIPO Arbitration and Mediation Center ,18.07.2000,[2001] E.T.M.R.40 ; *Winterson v. Hogarth*, WIPO Arbitration and Mediation Center, 22.05.2000,[2000] E.T.M.R.783; and *Radio Taxicabs (London) Ltd (t/a Radio Taxis) v Owner*(Ch D)2001 WL 1135216.

this regard is not available it is important to consider telescope analogy was made by Justice Jacob in the above *Euromarket* case. His Lordship observed that Internet is an electronic telescope which allows the user to look into the focus on the activities of a trader via that trader's website without having physical access to the goods or services provided. Hence, it is clear if the visitor could identify non-UK ccTLD, he would know the location of the trader.

It should be emphasised that most of the cases discussed above show that the intention in registering the domain name is of crucial importance.²⁶⁶ The general effect of these decisions would seem that the opportunistic registration and subsequent offer for the sale of domain names, reflecting the good will of other trader's business and trade marks, is an unlawful activity and thereby entitled to legal redress.²⁶⁷

3.8.2.(c) Sri Lankan domain name policy

LK Domain Registrar (LKNIC) administers the Internet domain .lk registration.²⁶⁸ Earlier assignment of domain names and registration including additions and deletions of names under domain names under the .lk domain was handled by the Department of Computer and Engineering, University of Moratuwa, Sri Lanka, under the purview of the Council for Information Technology (CINTEC) Internet Committee.²⁶⁹ However, the CINTEC was repealed by the Information Communication Technology Act, No.27 of 2003 (hereinafter ICT Act) and transferred all rights to Information Communication Technology Agency (ICTA). Nevertheless, ICT Act does not mention the role of ICTA in relation to .lk domain name registration. Hence it can be argued that under the present law all powers are vested in the Domain Name Registrar LKNIC which is handled by the above University department.

²⁶⁶ Despite the fact that the United Kingdom has no law of unfair competition, the common law remedy of passing off applied in many situations to redress trade mark misuse. In *British Telecommunication plc, Virgin Enterprises Ltd. J Sainsbury plc, Mark & Spencer plc and Ladbrokes Group plc v One in a Million*[1999] F.S.R 1 the Court of Appeal decided that there was clear evidence of systematic registration by the appellants of well-known trade names as blocking registrations and a threat to sell them to others. Secondly, the availability of the domain names registration details on a WHOIS search were sufficient to constitute passing off. Thirdly, holding of the domain name in question were instrument of fraud in the hands of the defendant.

²⁶⁷ However, it is submitted that the situation of Sri Lanka is much broader than that of UK since the application of constitutional principles, e.g. right to livelihood-Art.14(1)(g) and *aquilian action* give more latitude to protect domain names.

²⁶⁸ <http://www.nic.lk/howto.html> (Accessed: 01.12.2004).

²⁶⁹ This body was established under Science and Technology Development Act, No.11 of 1994.

The structure of domain names in Sri Lanka mirrors the worldwide system. The top-level domain name in Sri Lanka is .lk.²⁷⁰ Under .lk ccTLD, two types of second level domains, namely closed second level domains and open second level domains can be registered.²⁷¹ The closed second level domains are handled directly by LKNIC whereas the registered agents of LKNIC handle the open second level domains.²⁷²

In order to register a domain name in Sri Lanka, the applicant must be an organisation. This includes corporations, firms, and associations. However, application of individuals for the registration of domain name may be accepted under special circumstances.²⁷³ The rationale for this policy seems to prevent individuals from defrauding consumers through the misrepresentation that this person is actually a company. Organisations outside Sri Lanka can reserve²⁷⁴ domain names in the Sri Lankan Domain Name Registry. However, they cannot activate them unless they have a presence in Sri Lanka. A presence may be a branch office, subsidiary, dealer, agent, or representative, which has established an office in Sri Lanka.²⁷⁵

²⁷⁰ <http://www.nic.lk/howto.html> (Accessed: 16.09.2004).

²⁷¹ <http://www.nic.lk/seclevpr.html> (Accessed: 01.12.2004). Starting from 01.05.2002 the following closed Second level domains can be registered with LKNIC-.gov.lk (for Sri Lanka Governmental organization),.sch.lk (for registered school in Sri Lanka), .net.lk (for licensed Internet Service Providers in Sri Lanka), .int.lk (for International Treaty Organizations). The following open Second Level domains can be registered with agent of LKNIC- .com.lk (for commercial entities), org.lk (for registered organization in Sri Lanka), .edu.lk (for educational sites), .ngo.lk (for non governmental organizations), .soc.lk (for societies in Sri Lanka), web.lk (for websites), .ltd.lk (for limited liability companies), .assn.lk (for associations),.grp.lk (for group of companies), .hotel.lk (for hotels)

²⁷² <http://www.nic.lk/seclevpr.html> (Accessed: 01.12.2004).

²⁷³ <http://www.nic.lk/faq.html> (Accessed: 01.12.2004). Domain names may be registered by individuals for purposes similar to the following: Professionals, Artistes, Political Candidates- Letter signed by the candidate should be submitted. <http://www.nic.lk/guidelines.html> (Accessed: 01.12.2004).

²⁷⁴ A request for domain name reservation should supply name of the organization, name of domain name to be reserved, reason for choosing name and name, designation, address, telephone, fax and e-mail of the person to contact regarding this domain name. However, this does not consider whether such reservation is done in good or bad faith. Hence, still it is possible to create problems.

²⁷⁵ <http://www.nic.lk/guidelines.html> last updated on 18.05.2004 (Accessed: 01.12.2004). Domain names will be registered on a first come, first served basis. All applications must be forwarded with a *clear justification* (emphasis added) that the applicant is entitled to the domain name. The application should be accompanied with a *declaration* (emphasis added) that the applicant is entitled to the name. This provision seems to be very important in relation to domain name litigation. As a policy, the following names will not be allowed in the registry.

- (1). The name Sri Lanka in any form (but anything preceding lanka and following lanka will be allowed i.e. ABClanka.lk, lankaABC.lk.
- (2). Top level domains (e.g. Com.lk, org.lk, net.lk etc.).
- (3). Towns, Provinces and abbreviations thereof (e.g. Colombo.lk, kandy.lk, western.lk, cmb.lk etc).
- (4). Generic names- Professions (e.g. lawyer.lk, doctor.lk).
Internet services (e.g. mail.lk, www.lk, web.lk. etc.).
Generic products (e.g. tea.lk, coconut.lk, toffee.lk etc).
Generic services (e.g. isp.lk, hosting.lk etc.).
Names of sports (e.g. cricket.lk, tennis.lk).
Other generic names.

In terms of guidelines, one has to produce a clear justification of entitlement to the domain name.²⁷⁶ However, it is not clear what amounts to justification to entitlement since the Registry provides no details. Nevertheless, the basic practical question arises when a person submits a forged document to justify his entitlement. The guidelines are silent in this regard. Hence still, it is possible to cybersquat in Sri Lanka.

It is noteworthy that under the declared policy, names that may be offensive to any accepted religion, race, culture, or tradition of Sri Lanka may not be registered.²⁷⁷ This suggests that the guidelines are in compliance with the present trade mark law.

The above mentioned domain name policy in Sri Lanka appears to be a restrictive approach. It is submitted that this restrictive approach to domain name registration, in theory, is vitally important to a country like Sri Lanka. Firstly by limiting domain name applicants to legal entities (except above mentioned special circumstances in relation to applications by individual persons) the country is able to monitor more easily the people who engage in the transactions under domain names.²⁷⁸

Secondly, it is important from a trade mark point of view. This means that commercial exploitation of trade mark through domain name registration, which is commonly known as cybersquatting, can be avoided or minimised. Therefore, it can be safely said that cybersquatting problem, which was a main legal issue in the West, would be a minimal legal issue in the court of law of Sri Lanka.

Nevertheless, following situations may create problems. (a) when a company uses someone's trade name or trade mark which was not well known to the general public in Sri Lanka, by producing forged documents and getting a registered domain name. (b) when the application conceals the registrant's identity by providing false or incomplete contact details of the business entity, which actually does not exist, or of a fictitious person as registrant. The present registration policy does not provide an answer to these situations since the Domain Name Registry only asks for a letter from the organisation requesting the domain to confirm that they have a right to that name. However, such an event can be challenged since bad faith has incentives to conceal identity.²⁷⁹

²⁷⁶ <http://www.nic.lk/guidelines.html> (Accessed: 01.12.2004).

²⁷⁷ <http://www.nic.lk/guidelines.html> (Accessed: 01.12.2004).

²⁷⁸ An online system is being built in the Registrar of Companies office to check existence of companies.

²⁷⁹ Though it is not binding, the Sri Lanka court can be guided by EU/UK bad faith cases. For instance *Canal & Image UK Ltd v Vanitymail Services Inc*[2001] E.T.M.R.40 2000 WL 33201453, *Caixa D'Estalvis y Pensions de Barcelona v Namezero.com*[2001] E.T.M.R.107 2001 WL 1422976,

Furthermore, the basic question arises as to whether sec.121 of the 2003 Act would be able to protect trade marks owners from cybersquatting since they do not “use” the trade mark to distinguish their goods and services, but rather ‘stockpile’ them, awaiting payment from the trade mark owners.²⁸⁰

However, application of STEP 3 would provide a better solution since a cybersquatter has an intention to make profit out of someone’s property right since it breaches the right livelihood or *sammā ājīva* of Buddhist life.²⁸¹ This is an important feature compared to the European situation where the judges consider the intention of the cybersquatter. In contrast, the cybersquatter’s conduct itself is challenged by applying the proposed interpretative methodology. On the other hand, STEP 5 also can be applied since elements comprising the *Aquilian action* i.e. *dolus* (intentional wrongful act: deceit, fraud) on the part of part of the defendant, pecuniary loss resulting thereby to the plaintiff and fault on the part of the defendant²⁸² are met by the conduct of cybersquatter.

In fact, it is ironically true that the domain name policy of Sri Lanka will create more legal issues in the field of trade mark law since Domain Name Registry is not obliged to investigate whether an applicant’s chosen domain name would infringe third party rights.²⁸³ Since there are some dispute resolution mechanisms such as ICANN, WIPO etc., available in this regard, it is submitted that Sri Lanka should recommend one of them without leaving disputing parties without a forum.

Thus, it is questionable whether the need of the day is to work on producing more formalities to handle domain names or to seek a formula, which can address the questions raised by wrongful practices in relation to domain names. Otherwise, the fundamental trade mark principle of consumer protection will be weakened by cybersquatting.

The concept of passing off has been recognized by Sri Lankan courts from the beginning of the trade mark law in the country.²⁸⁴ However, though the subject of passing off has not come up to the court in relation to the Internet, on the basis of the above practice, it

Magazijn De Bijenkorf BV v Accelerated Information BV [2002]E.T.M.R.62 2002 WL1311063, *Amazon.com Inc v Citi Services Inc* [2001]E.T.M.R.95 1999 WL 33232698.

²⁸⁰ Though it is not binding Sri Lanka court can be guided by the argument of *British Telecommunication plc, Virgin Enterprises Ltd. J Sainsbury plc, Mark & Spencer plc and Ladbrooke Group plc v One in a Million*[1999] F.S.R 1 in this regard.

²⁸¹ Para 2.9.(D)(II).

²⁸² Para 2.11.

²⁸³ <http://www.nic.lk/instruct.html> (Accessed: 01.12.2004).

²⁸⁴ Para 3.7.9.

is submitted that passing off taking place through the digital media also can be addressed when extended to such situations.

3.8.3. Use of trade marks as meta tags

Most webpages on the Internet²⁸⁵ are designed using HTML (hypertext mark-up language).²⁸⁶ Meta tags are keywords or phrases embedded in the HTML of a website.²⁸⁷ These meta tags are tools that allow the owner of a website to use terms and phrases that are not visible to normal users on the website itself.²⁸⁸ However, they enable the user to receive data retrieved by search engines²⁸⁹ such as Google, Alta Vista, and Excite.²⁹⁰

Several types of meta tags are important for search engine indexing but the most important two are the descriptive and keyword tags.²⁹¹ The first type specifies a list of terms that the webpage designer wants a search engine to associate with the webpage while the second often varies in length and usually contains a description of a webpage's

²⁸⁵ The Internet "is a global network of interconnected computers which allows individuals and organizations around the world to communicate and share information with one another". One of the most important parts of the Internet is the World Wide Web. World Wide Web is largely made up of "webpages" i.e. computer data files written in Hyper Text Markup Language (HTML) that contain text, pictures, sounds, graphics, video and links to other webpages. Since these webpages contains vast amount of information it is difficult to surf to find information. Hence, there are several ways to access these websites. One is to enter the website's address or domain name. Another way is to use search engines such as Yahoo, Alta Vista, Google, Lycos, and WebCrawler to navigate the web. The user can enter one or more keywords to the search engine to describe the subject of surf. Then the search engine will compile a list of websites that matches the surfer's key words and post them in a list known as a search result. *Brookfield Communications, Inc., v W. Coast Entm't Corp.* 174 F.3d 1036,1044 (9thCir, 1999) and *Playboy Enterprises. v. Netscape Communications Cop.*, 55 F.Supp.2d 1070.1072 (C.D.Cal.1999).

²⁸⁶ HTML defines the structure and layout of a Web document by using tags and attributes. Thus, HTML allows users to produce Webpages that include text, graphics, and pointers to other webpages. Webopedia at <http://www.webopedia.com/TERM/H/HTML.html> (Accessed: 01.12.2004).

²⁸⁷ Webopedia at <http://www.webopedia.com/TERM/H/HTML.html> (Accessed: 01.12.2004).

²⁸⁸ Nevertheless, they can be viewed with the "view source" function. Meta tags inserted by a website builder which help search engines either because it provides a clear description of the contents of the web page or because they contains key words relating to the content of the site.

²⁸⁹ Search engine is a software program that searches its own collection of Webpages. http://www.webopedia.com/TERM/s/search_engine.html (Accessed: 01.12.2004). Also <http://searchenginewatch.com/links/article.php/2156221> (Accessed: 01.12.2004).

²⁹⁰ Michael Blakeney, "Interfacing Trade Marks and Domain Names," *Murdoch Uni.E.J.L.*, 6,2 (March, 1999), at http://www.murdoch.edu.au/elaw/issues/v6n1/blakeney61_text.html, (Accessed: 11.09.2004), Graham J H Smith, *Internet Law and Regulation*, 3rd (London: Sweet & Maxwell, 2002), pp104-106, Lilian Edwards & Charlotte Waelde (ed) *Law & the Internet*, 2nd (Oxford-Portland Oregon: Hart Publishing, 2000), p.174; Terrell W. Mills, "META TAGS: Seeking to Evade User Detection and the Lanham Act," 6 *RICH.J.L&TECH* 22 (Spring, 2000) at <http://law.richmond.edu/jolt/v6i5/article1.html> (Accessed:14.09.2004); Veronica Tucci, "The Case of the Invisible Infringer : Meta tags, Trade Mark Infringement and False Designation of Origin," *J.Tech.L. & Pol'y*, (University of Florida College of Law) 5, 2 (summer 2000) at <http://journal.law.ufl.edu/~techlaw/vol5/invisible.htm> (Accessed: 01.12.2004).

²⁹¹ How to use HTML Tags at <http://searchenginewatch.com/webmasters/article.php/2167931> (Accessed: 01.12.2004).

content. Though both types of meta tags are invisible to web users, the search engines use these meta tags to identify and rank the relevance of webpages.

Obviously, website owners like to increase their search engine ranking and thereby get more income through advertising.²⁹² Thus, website owners often include popular words, including registered and unregistered trade marks belonging to others, in their meta tags with a view to getting a higher rank. When trade marks are placed in meta tags, the search engine sees that trade mark considers that the site is related to a search on this trade mark, and returns that site in the search results. Therefore, it seems that the user is directed to the web designer's site as a result of the use of trade mark as meta tags.²⁹³ However, such conduct would create frustration to consumers.

A fundamental question arises concerning source identification since customers do typically not see meta tags. Thus, concerns arise as to whether trade mark use as meta tags would amount to "use" of trade mark in the legal sense and would such use amount to infringement of trade mark or at least some form of unfair competition? Another important question is whether such use is in relation to same/different goods or services. Furthermore, can such act be considered as imparting knowledge to consumers about analogous products/ services at better price? Would it be capable of influencing consumer's choice? To understand the Sri Lankan position on whether use of trade mark as meta tags would amount to infringement of trade marks rights recognised under the 2003 Act entails a brief examination of established principles in this regard in other countries such as the United Kingdom and United States of America.

3.8.3.(a) Position in the USA

Under the trade mark law of United States of America, an action for misuse of trade mark can be brought under many concepts such as likelihood of confusion, dilution, unfair competition or passing off.²⁹⁴ Section 32(1) of Lanham Act prohibits the use in commerce of any reproduction, counterfeit, copy or colourable imitation of a registered trade mark in connection with the sale, distribution, or advertising of goods or service where such use is likely to cause confusion or to cause mistake or to deceive. Likewise,

²⁹² At <http://www.searchenginewatch.com/webmasters/rank.html> (Accessed: 06.05.2003) and <http://searchenginewatch.com/webmasters/article.php/2167961> (Accessed: 01.12.2004).

²⁹³ <http://www.searchenginewatch.com/webmasters/rank.html> (Accessed: 01.12.2004). and <http://searchenginewatch.com/webmasters/article.php/2167961> (Accessed: 01.12.2004).

²⁹⁴ Sec.32(1) and 43(a)(1)(A) of the Lanham Act.

sec.43(a)(1)(A) provides essentially the same protection for unregistered marks.²⁹⁵ One more protection is given to trade marks under the Federal Trade Mark Dilution Act of 1995.²⁹⁶ According to this, the owner of a famous trade mark has right of action when the mark has been diluted²⁹⁷ by the use of the mark by a separate party.

On many occasions, the United States courts have discussed whether use of trade marks as meta tags amounts to infringement of rights protected under the laws. In *Insituform Technologies, Inc. v. National Envirotech Group, L.L.C.*,²⁹⁸ the plaintiff specializes in repairing damaged underground pipes and sewers without excavation and owns the federally registered trademarks INSITUFORM and INSITUPIPE. National Envirotech, performed services similar to Insituform Technologies and billed itself as a replacer of underground pipes without re-trenching. It operated this business under the name National Liner. Hence, a competitor, allegedly used Insituform's registered trade marks in meta tags on its own web site so that users utilising search engines would find National Envirotech's web site instead of Insituform's web site. The defendant's Web site made no overt reference to Insituform Technologies or its trademarks in a way that would be visible to users, nevertheless this designation would lead keyword searches on search engines to return National's Web site as well as Insituform's, thereby potentially showing an association between the Insituform and National Web sites.

Insituform, alleged that National Envirotech Group's unauthorized use of these marks in its web site's meta tags constituted federal trademark infringement, federal unfair competition, and state unfair competition including false designation of origin under Section 43(A) of the Lanham Act. According to the complaint, National Envirotech's use of plaintiffs' trademarks "Insituform" and "Insitupipe" as metatags was "a cynical scheme to trade upon the renown and goodwill of [those] marks [as] defendants purposefully designed their Web-site in such a way that persons using search engines to look on the Internet for Web-sites referring to "Insituform" or "Insitupipe" are led to defendants' Web-site."

²⁹⁵ Nevertheless, such conduct is commonly referred to as state unfair competition or reverse passing off.

²⁹⁶ This Act expanded the scope of rights granted to famous and distinctive trademarks under the Lanham Act. Accordingly it protects famous marks from uses that dilute their distinctiveness, even in the absence of any likelihood of confusion or competition.

²⁹⁷ Supra note 178 for dilution.

²⁹⁸ Civ.No.97-2064 (E.D.La.1997). The plaintiff operates a web site, "www.insituform.com," where it advertises its products and expertise. The defendant operates the National Liner web site, "www.curedinplace.com," which also similarly advertises expertise in the repair of damaged pipe without excavation.

It is argued that National Envirotech falsely suggested an affiliation between the two companies and that it "further confused visitors by decorating its Web site with slogans, photographs, and illustrations copied from Insituform. Moreover, Insituform argued that the defendant's conduct was analogous to their having altered a database maintained by a telephone company's directory assistance service; people calling "411" and requesting the number for "Insituform" would be given defendant's phone number instead.

Nevertheless, before proceeding further, the case was settled. As part of a settlement agreement, the court issued a consent decree barring the defendant from using the plaintiff's trademarks as meta tags in the defendant's Web site and to resubmit its corrected Internet sites to the major search engines to purge the allegedly infringing references. Because it was a consent judgment, the court did not reach the meta tag issue on its merit. However, the defendant's agreement to remove all references to the plaintiff's trademark infer that the defendant felt such use would amount to infringement of the plaintiff's trade mark.

In *Playboy Enterprises v. Calvin Designer Label*,²⁹⁹ the court considered, among other things, whether the use of "PLAYBOY" and "PLAYMATE" in defendant's website amounted to infringement of trade mark. The court granted an injunction to bar the defendant's use of the trade marks "in buried code or meta tags on their home page or Webpages or in connection with the retrieval or data or information...or in connection with the advertising or promotion of their goods, services, or Web sites"³⁰⁰

In *Oppedahl & Larson L.L.P. v Advanced Concepts*³⁰¹ the plaintiff, an intellectual property law firm, alleged the defendant³⁰² improperly placed the terms "Oppedahl" and "Larson" in its web site's meta tags numerous times to attract the plaintiff's customers by

²⁹⁹ 985 F.Supp.1220, 44 U.S.P.Q. 2d (BNA) 1156(N.D.Cal.1997). Here the Plaintiff was the owner of the federally registered trademark PLAYMATE and several federal registrations for the PLAYBOY trademark and for the marks PLAYBOY and <http://www.playboy.com> for computer services including providing on-line magazines, and for the mark PLAYBOY for magazines (Exhibit A). The defendants were adult entertainment Web site operators that used Playboy Enterprises' trademark in connection with their Web site.

³⁰⁰ A similar judgment was given in *Playboy Enterprises Inc. v Asia Focus International, Inc.*(1998 U.S. Dist. LEXIS 10459(E.D.Va.1998). *Niton Corp. v. Radiation Monitoring Devices, Inc.* 27 F. Supp. 2d 102 (D.Mass.1998) provides the first instance in which a defendant was preliminarily enjoined from using meta tags comprising of the plaintiff's trade name, as well as terms relevant only to the plaintiff's business.

³⁰¹ Civ. A. 97-Z-1592, 1998 (D.Col.1998).

³⁰² The defendant was a web-hosting services company.

being positioned high on a list of hits generated by a search engine.³⁰³ The court granted an injunction.³⁰⁴

3.8.3.(b) Position in the United Kingdom

Under trade mark law of the United Kingdom, proprietor of a registered mark has exclusive rights, which are infringed by its use without his consent.³⁰⁵ A person infringes a registered trade mark in three ways if he uses it in the course of trade. First, an identical sign is used in relation to identical products. Second, an identical sign is used in relation to similar products; or a similar sign is used in relation to identical or similar products and there is the likelihood of confusion in the minds of the public. Third, an identical or similar sign is used in relation to products that are not similar and the use of the sign takes advantage of or is detrimental to the distinctive character or the repute of the trademark.³⁰⁶

The courts of the United Kingdom considered in *Roadtech Computer System Ltd. v. Mandata (Management and Data Services) Ltd.*,³⁰⁷ whether use of trade marks as meta tags constituted trade mark infringement. In this case, both companies were involved in the supply of computer software and related goods and services to the road haulage industry. Roadtech Computer System Ltd. is the registered proprietor of the trade mark for "ROADRUNNER" in respect of computer software and programs and had used the name "ROADTECH" as its trading name. After discovering that the defendant was using the marks "ROADRUNNER" and "ROADTECH" on its website as meta tags, Roadtech

³⁰³ As it is mentioned traffic is important to website owner since he gets more hits and thereby higher chance to get more advertising revenue.

³⁰⁴ In *Brookfield Communications Inc. v West Coast Entertainment Corp.*, 174 F.3d CA.9(Cal)1999 the issue was whether using a competitor's trade mark in the meta tags of one's website was an infringement of trade mark. Brookfield Communications Inc. gathered and sold information about the entertainment industry and marketed searchable database containing entertainment industry related information under the mark "MovieBuff". West Coast Entertainment Corp. began marketing a database similar to that of MovieBuff at the domain name <www.moviebuff.com>. In addition to using, Brookfield's trade mark in its domain name, the West Cost also placed the trade mark in its website. The court held that defendant's parody site constituted "use in commerce" and "in connection with goods and service" as defined by the Lanham Act and thus use of competitor's trade mark in its meta tags by another party infringed the competitors trade marks rights. Also *SNA, Inc. v. Array*, 51 F.Supp.2d 554(E.D.Pa.1999), *Netbula, LLC., v. Distinct Corporation* 2003 WL 2204056. In *J.K. Harris & Co. v. Kassel* 2002 WL 1303124 (N.D.Cal. 22.03.2002) the Court refused to apply the fair use doctrine to allow the use of another's mark that unfairly manipulated search engines, and found that these uses diverted consumers away from the plaintiff's services. However, there are contradictions on judgments in this issue in USA. For instance in *Playboy Enterprises Inc. v. Wells* 78 F.Supp.2d 1066(S.D.Cal.,1999) and in *Playboy Enterprises v. Netscape Communications*, 55 F.Supp.2d.1070(C.D.Cal.,1999) use of trade marks meta tags was considered as fair use.

³⁰⁵ Sec.9 of the Trade Marks Act, 1994.

³⁰⁶ Sec.10.

commenced proceedings for trade mark infringement. The court held that the use of trade marks as meta tags for the sole purpose of diverting business away from a trade mark owner's site may constitute trade mark infringement and passing off.

In *Reed Executive Plc v Reed Business Information Ltd*³⁰⁸ the Plaintiff objected to their mark being used in the defendants' website's HTML codes as a meta tag as part of the defendants' name. Although this was not visible to visitors to the defendants' website, the word "REED" was used in meta tags to maximise exposure of the defendants' website on a search by a user. The court regarded that use as "visible" and held that even if the word "REED" did not appear in the search hits (or in the website); it was still an infringing use.

Hence it can be argued, use of a mark in the form of meta tag to confuse or to divert consumers can be considered as "use in the course of trade" which undermines essential function of trade marks, in particular that of the guarantee of origin.³⁰⁹ Though the misdirected customer does not make a purchase, the act of purposefully generating pre sale confusion³¹⁰ by attracting or diverting potential customers while using another's trade mark is sufficient to constitute trade mark infringement.

Thus it seems that although traditionally trade mark law protected against consumer confusion by barring the use of visible infringing marks, the focus has been extended to protect consumers from non visible use of marks to prevent those unauthorized uses that may not be visible to consumers and that may not even result in a likelihood of consumer confusion, but nonetheless give competitors an unfair advantage.

3.8.3.(c) Sri Lankan position

No Sri Lankan case has been reported to date in which trade mark use as a meta tags has been pertinently considered.³¹¹ In the absence of specific judicial authority or body of

³⁰⁷ [2000]E.T.M.R. 970, 2000 WL 824052, [2001] E.B.L.R. 17.

³⁰⁸ [2003]R.P.C.12; 2002, WL819968. The claimants, Reed Executive plc and Reed Solutions plc, were operators of reed.co.uk and proprietors of the trade mark "REED", registered in respect of employment agency services. The defendants, Reed Business Information Ltd., Reed Elsevier (UK) Ltd. and totaljobs.com Ltd. were publishers, which advertised job opportunities.

³⁰⁹ *Arsenal Football Club plc v Reed* [2002] EWHC 2695 (Ch) for wider meaning of use High Court, Chancery Division, judgment of 12.12.2002, [2003]1 CMLR 13.

³¹⁰ Likelihood of confusion or generating a situation, which is likely to mislead the public.

³¹¹ This does not necessarily imply that no disputes have arisen in Sri Lanka. Nevertheless, as discussed in Para 1.2.3, the power regarding intellectual property is given to the Commercial High Court (except in few cases) which is not a court of record and hence no recorded cases are available to the researcher.

jurisprudence,³¹² the relevant legislation must be examined in order to draw some conclusions as to whether the Sri Lankan trade mark law protects the public from likelihood of misleading when a trade mark is used as a meta tag while protecting the legitimate interest of the trade mark owner.

As observed,³¹³ there are five situations that preclude third parties from using of trade mark or sign. Only in three situations,³¹⁴ the trade mark owner must establish the fact that use of trade mark by a third party is 'likely to mislead the public'. However, all of those situations employ the word 'use' though there is no guidance existing in Sri Lanka regarding whether such use should be 'in a trade mark sense'.

Moreover, as discussed previously in this Chapter sec.160 of the 2003 Act provides protection against unfair competition. Section 160(2)(a) stipulates that act of unfair competition shall include any act or practice carried out or engaged in, that *causes or is likely to cause, confusion* with respect to another's enterprise or its activities, in particular, the product or services. (Emphasis added). This confusion may be caused with respect to a mark, a trade name, business identifier other than mark or trade name etc.³¹⁵

Moreover, in terms of sec.160(4) of the 2003 Act, misleading arise out of advertising or promotion would constitute an act of unfair competition. Hence, it is submitted that, despite the fact that there is no direct authority on the use of trade mark as meta tags in Sri Lanka, present law can be applied to cover the use of trade mark but not trade names as meta tags under sec.121, 160 and 192(1)(d)³¹⁶ of the 2003 Act.

Nevertheless, it is submitted that the term 'any unlawful act' used in sec.144(1) is sufficiently broad to apply the concept of passing off or *Aquilianaction*, unjust enrichment under Roman Dutch Law to protect from misuses of trade names in Sri Lanka.

Should the law prohibit the use of meta tags on the Internet and thereby eradicate trade mark infringements? As it is known, the web designer can simply place the competitor's trade mark in the area that the search engine checks, without using trade marks as meta

³¹² Chapter One.

³¹³ Para 3.7.4.

³¹⁴ Second, third and fifth situations. Para 3.7.4.

³¹⁵ Sec.120(2)(b).

³¹⁶ Sec.192(1)(d) stipulates that application of marks means to use a mark in any manner likely to lead to the belief that the goods in connection with which it is used are designated or described by that mark.

tags or the web designer can use someone's trade marks in doorway pages³¹⁷ and after achieving high rank replace the doorway page with the real page which the designer wants the web surfers to visit and repeat the same process to maintain the rank. Consequently, it would seem that specially prohibiting the use of trade marks as meta tags would not reduce the unauthorised use of trade marks. Hence, there is a lacuna in the present law. However, since the term 'use' is not limited in any way in the 2003 Act, it can be interpreted along with Buddhist principles to give wider meaning. It is submitted that such interpretation of the present law would handle the above situation.

In cyberspace, consumers often search for a particular product or service. Should the law allow someone to use the trade mark sought by the consumer to divert to his own product? Does this lead to undue enrichment to wrongdoer or giving information to consumer that he does not want? Does this would amount to violation of the moral code of the country?

As with the development of information society in Sri Lanka, some commercial entities expressly prohibit use of trade marks as meta tags.³¹⁸ However, since there is a lacuna in the present law it is submitted that this has given an opportunity to apply STEP 3 of the formula. Application of STEP 3 could be more appropriate since the intention of the meta tag user is to mislead the public and thereby gain some financial benefit. Such conduct (making false representation and unjust livelihood) breaches Buddhist morality principles. Additionally, there is a possibility to apply STEP 5 where *Aquilian action* fills the lacuna. Furthermore, these arguments are equally suited to prohibit use of trade names as meta tags.

3.8.4 Spamming

With the advent of new technologies, new marketing systems emerge, spamming is just one. In general, spam means junk mail or junk newsgroup posting. Such messages are variously referred to as unsolicited commercial e-mail ("UCE"), unsolicited bulk e-mail ("UBE"), junk e-mail, and "spam." However, junk mail is not considered as spam when it does not carry commercial advertisements.³¹⁹

³¹⁷ A doorway page (jump page, an entry page or a bridge page) is a generic page, primarily designed for search engines, which contain some key words and phrases. In general doorway pages contains "enter" image, which takes the web surfer to the real page that the site owner wants the surfer to visit. webopedia at <http://www.pcwebopedia.com/TERM/d/doorway.html> (Accessed: 01.12.2004).

³¹⁸ E.g., Sri Lankan Telecom Webpage at http://directory.slt.lk/real/inpages/eteleshop_pages/warranty.htm (Accessed: 01.12.2004).

³¹⁹ <http://www.webopedia.com/TERM/s/spam.html> (Accessed: 01.12.2004).

The problem arises in relation to spam when it carries trade marks and disguises or conceals the sender or gives a forged identity. Furthermore, generally, the sender of commercial spam sends it to targeted recipients who have not requested information in advance. This means that spam targets "a stranger" with whom it had no previous contact. Likewise, recipients' e-mail addresses are collected from the public spaces of the Internet: news scripts, mailing lists, directories, websites etc. Thus, the question arises as to whether such use of trade marks constitutes trade mark infringement according to the laws of a given country.

3.8.4.(a) Position in the USA

The US position is clarified in *Classified Ventures, L.L.C. v. Softcell Marketing, Inc.*³²⁰ In this case, the court held that consumers are likely to associate Softcell and its pornographic spam e-mails with Classified Ventures and its famous cars.com Service Marks, lessening the distinctive value of the cars.com Service Marks. The Court held that use of the service mark "cars.com" in the sender's address of the "spam" e-mail message was likely to and actually did cause confusion to recipients that "cars .com" was the actual sender of the solicitation. Hence, injunction granted against fraudulent use of another company's domain name in unsolicited commercial e-mail messages.³²¹

In *Allstate Ins. Co. v. Mathison*³²² Mathison the defendant acting on behalf of and with full knowledge of NAPAA³²³ and AMS³²⁴, sent, from an Earthlink, Inc. e-mail account, unsolicited bulk e-mails to Allstate agents. The e-mails were falsely designated such that they appeared to originate from "ELiddy@allstate.com," the e-mail address of the Chief Executive Officer and Chairman of Allstate, Edward M. Liddy ("Liddy"). The fraudulent e-mails were configured so that they would automatically transmit a receipt notification whenever a recipient opened the e-mail. These receipt notifications were sent to Liddy's e-mail account at Allstate. The court allowed Allstate to proceed under the Illinois Trade mark Registration and Protection Act³²⁵ for infringement of trade mark under that Act.

³²⁰ 109 F.Supp.2d 898 N.D.Ill.,2000.

³²¹ Also *America Online, Inc. v. LCGM, Inc.*, 46 F. Supp.2d 444(E.D.Va.1998).

³²² No.02 C419, 2002 U.S. Dist. LEXIS 11541 (N.D. Ill. 25.06.2002).

³²³ National Association of Professional Allstate Agents.

³²⁴ Association Management Specialists, LLC.

³²⁵ Also, application of Federal Legislation on spam. i.e. the Controlling the Assault of Non-Solicited Pornography and Marketing Act 2003 ("CAN-SPAM Act") which come into force on 01.01.2004.

3.8.4.(b) Position in the United Kingdom

Though the matter was settled out of court in *Virgin Net v Adrian Paris*,³²⁶ it showed that there was room for a test on the subject. However, one should look to other areas of law such as Consumer Protection, Data Protection Law, and European Directives such as Directive 95/46 on the protection of individuals with regard to the processing of personal data and on the free movement of such data.

3.8.4.(c) Sri Lankan Position

Though it seems that, in theory, sec.121 and 160 of the 2003 Act can be used to address spam, it is doubtful whether such use would amount to an infringement of trade mark rights under the present wording of those sections. Hence it seems there is a lacuna in the law.

Should the law allow use of someone's trade marks in order to mislead the public by way of sending unsolicited mails? Would it not violate privacy since e-mail addresses are collected without the consent of the owner? Does infringement of trade mark take place when unsolicited e-mail carries trade mark but does not divert the recipient?

Now the question that arises is: can spam sender seek constitutional protection such as freedom of expression? ³²⁷ Pursuant to Art.15(7) of the Constitution, freedom of expression is to be used according to the limitations that are made to protect, among other things, to secure due recognition and respect for the rights and freedoms of others, and to meet the just requirements of the general welfare of a democratic society. Hence, it is clear that STEP 2 would provide two grounds i.e. rights and freedoms of others, and meet the just requirements of the general welfare of the Sri Lanka society under which spamming can be prohibited.

Moreover, while sending spam by using trade marks belonging to some one else, the sender breaches the second (appropriating what is not given) and fourth precept (making false representations) of Buddhist moral code and thereby challenges the fabric of society. Hence, STEP 3 of the formulae is also applicable in this regard.

On the other hand, while using STEP 3 and STEP 5 along with STEP 1 there is a greater possibility fills the lacunae in the present law. Spamming involving trade marks may be

³²⁶ The Register published on 20.04.1999 at http://www.theregister.co.uk/1999/04/20/virgin_sues_customer_for_spamming/ (Accessed: 01.12.2004).

³²⁷ Art.14(1).

prejudicial to the interest of the registered trade mark owner. For that course of action, Buddhist principles and *Aquilian action* can be used to define the term prejudicial. Does prejudice mean the injury caused by spamming? Arguably, it can be prejudice when Buddhist principles and Roman Dutch Law concept of damage are applied to interpret it. Hence, it seems by applying Buddhist principles *Aquilian action* sec.121(2)(b) can be interpreted to cover spamming. Furthermore in the case of unregistered trade marks *Aquilian action* can be use since it is independent of the use of trade mark.

3.8.5 Linking

Another trade mark and unfair competition problem on the Internet can arise when a person makes a link to materials to which he does not have rights. Thus, a brief examination of how links work is required for better understanding of trade marks issues on the Internet. Links are made using attributes and tags within HTML, which allows information to be “hyperlinked”³²⁸ or “hypertext reference linked” within the same website or in between different websites.³²⁹

Generally, linking from one website to another is normal practice on the web since it eases surfing the web. In general, a link from one website to the home page of another website does not raise concern. Nevertheless, some types of linking may account for the infringement of trade mark.

Deep linking refers to linking to an internal page of a website, bypassing the home page of web user that generally includes the basic introduction to and identification of the site. In contrast to linking, deep linking can lead to problems. Firstly, it tends to cause consumer confusion, as viewers do not see the identifying information on the home page. Secondly, it can create revenue problems since advertisements on the bypassed page are included. Thirdly, it creates problems for the bypassed webpage owner’s contractual terms with other companies, which pay for advertising.³³⁰

The problem of infringement of trade marks rights arises when such link categorically or by inference suggest an authorised association between the linking and linked sites and thereby diverts consumers from the source or origin. However, this would only be to the extent that such a suggestion, which made as result of link, leads the web user to believe

³²⁸ Webopedia for hyperlink at <http://www.webopedia.com/TERM/H/hyperlink.html> (Accessed: 07.03.2004). Also *Bensusan Restaurant Corp v. King* 126 F.3d 25(2d. Cir.1997) and *Intermatic Inc. v. Toeppen* , 947 F.Supp.127,1232(N.D.III.1996).

³²⁹ For categories of links: Ignacio Javier Garrote, "Linking and Framing: A Comparative Law Approach," *E.I.P.R.*, 24, 4 (2002), 184-198.

that an unassociated webpage belongs to a certain trade mark owner. This is possible in the case of deep linking. Thus, an issue arises as to whether such links would amount to infringement of trade marks.

3.8.5.(a) Position in the USA

In OBH, Inc. v. Spotlight Magazine, Inc.,³³¹ the plaintiffs owned the "The Buffalo News" registered trademark used by the newspaper of the same name and operated a web site utilizing the Internet domain name "www.buffnews.com" and also operated another web site using the domain name "www.buffalo.com," which contains, *inter alia*, an on-line version of The Buffalo News.

The Defendant owns and operates, for commercial purposes, an apartment rental guide called Apartment Spotlight Magazine, which advertises available apartments located in the cities including Buffalo city and operate on-line versions of Apartment Spotlight Magazine at "www.aptspotlight.com" and www.buffalonyapartments.com. After becoming aware, that the Buffalo News was operating a web site under the domain name www.buffnews.com, the defendants registered the domain name thebuffalonews.com and created a website parodying the Buffalo News and providing a public forum for criticism of the newspaper. Defendants also registered the domain names "www.thebuffalonews.org" and www.thebuffalonews.net.

Although the overall appearance and content of the defendant's website are same, it includes a disclaimer, which states *inter alia* that it is not affiliated with or endorsed by the Buffalo New, OBH Inc. Moreover, defendant's website contains disparaging comments about the Buffalo News and hyperlinks to other web pages containing negative opinions and stories about The Buffalo News. (The Buffalo News published an advertising periodical known as Apartment Finder, which is in direct competition with defendants' Apartment Spotlight Magazine.)

Since the defendant did not stop using "thebuffalonews.com" domain name and refused to transfer the domain name, the plaintiff commenced the action, asserting among other things the following causes of action: (1) trademark infringement in violation of the Lanham Act, (2) trademark dilution in violation of the Federal Trademark Dilution Act, (3) false designation of origin, false description and unfair competition in violation of the Lanham Act.

³³⁰ Ibid.

Firstly, applying the provisions of the Lanham Act³³² the Court held that that defendants' use of the "thebuffalonews.com" domain name causes a likely to cause consumer confusion. The court applied the eight *Polaroid* factors³³³ to affirm the likelihood of confusion. The defendant argued that their website cannot possibly confuse the visitors since it contains disclaimers informing the site is not affiliated with or endorsed by the Buffalo News or the plaintiffs. However, the visitors, who are presumably looking for the news services provided by the plaintiffs on their web site, may instead opt to select one of the several other news-related hyperlinks contained in defendants' web site. Moreover, those news-related hyperlinks will directly link the user to other news-related web sites that are in direct competition with plaintiffs in providing news-related services over the Internet. Hence, the court held that when the visitors arrive they cannot help being confused—even if only momentarily. Hence, the court rejected the defendant's arguments including parody defence without merit and defendant was found liable for trade mark infringement linking away from the plaintiff's website.

Secondly, the Court held that defendants' use of plaintiffs' mark constituted dilution under the Trademark Dilution Act³³⁴ by considering delusion factors such as famous of the senior mark, its distinctiveness, commercial use of junior mark etc since it lessens the mark's capacity to identify and distinguish plaintiff's goods and services its own website. Thirdly, the Court upheld that plaintiff's claim of unfair competition under the Lanham Act.³³⁵

³³¹ 86 F.Supp.2d 176 W.D.N.Y,2000

³³² 15 U.S.C. § 1114(1)(a) provides that "a plaintiff-trademark holder must show defendant's "use in commerce," without plaintiff's consent, of a "reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion...."

³³³ Polaroid factors are (1) the strength of the plaintiff's mark; (2) the similarity of plaintiff's and defendant's marks; (3) the competitive proximity of their products; (4) the likelihood that plaintiff will "bridge the gap" and offer a product like defendant's; (5) actual confusion between products; (6) defendant's good faith; (7) the quality of defendant's product as compared to plaintiff's; and (8) the sophistication of the purchasers *Polaroid Corp. v. Polarad Elect. Corp.*, 287 F.2d 492 (2d Cir. 1961).

³³⁴ 15 U.S.C. § 1125(c) which provides that "the owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark...." 15 U.S.C. § 1127 defined as "the lessening capacity of a famous mark to identify distinguish goods or services , regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception.

³³⁵ 15 U.S.C. § 1125(a)(1)(A) provides: "[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which ... is likely to cause confusion...". Also, *Digital Equipment Corp. v. Altavista Technology*, 960 F.Supp.456, 461(D.Mass.1997) where the Court

However, in *Ford Motor Company v 2600 Enterprises*,³³⁶ the defendant used the Ford mark in its programming code, which is invisible to the Internet user but which creates an automatic hyperlink to the ford.com site. The court denied Ford's motion since the creation of an unseen, programmatic link to Ford's site was not a commercial use or a use in connection with goods or services of the mark within the meaning of the Lanham Act.

3.8.5.(b) Position in the United Kingdom

There is currently no reported case on this matter. However, there are some judgments in Europe that support the US position. For instance, *Estee Lauder Cosmetics Ltd v Fragrance Counter Inc*³³⁷ where the Court held that defendant had knowingly exploited the good reputation and advertising potential of the plaintiff to promote its own commercial interests to the detriment of competition including those of German retailers licensed by the plaintiff.

3.8.5.(c) Sri Lankan position

Under sec.142(d) of the Code deep linking could have been challenged since the Code provided that 'making direct or indirect use of a false or deceptive indication of the source of goods or services would constitute an act of unfair competition'. As discussed above in practice confusion could arise by deep linking when the contents of the linked page suggest a non-existent relationship or association. Hence, such conduct would constitute unfair conduct under the Code.

Nevertheless, the significance of sec.142(d) of the Code might have been disregarded by the drafters of the 2003 Act which provides 'any act or practice carried out or engaged in the course of industrial or commercial activities causes or is likely to cause confusion with respect to another's enterprise shall constitute act of unfair competition.'³³⁸ Section 101 of 2003 Act defines the term 'false trade description' whereas sec.185 provides false representation regarding trade marks. Nevertheless, it deals only with alteration, effacement of trade description but not making direct or indirect, false or deceptive indication of the source of the goods or services. Thus, it seems that there is a lacuna in the 2003 Act.

preliminarily enjoined a hypertext link of a trade mark because it gave the false impression that the linked page was the linker's.

³³⁶ 117F.Supp.2d 661, 2001US (E.D Michigan, 20.12.2001).

³³⁷ [2000] E.T.M.R.843. European Court of Justice, (Fifth Chamber).

³³⁸ Sec. 160(2)(a) of 2003 Act.

One could argue that linking is protected by the Constitution, which protects freedom of expression.³³⁹ Nevertheless, the limitation provided by Art.15(7) of the Constitution can be used to rebut such claim and protect trademarks. Firstly, the conduct of the deep linker would breach morality of the Sri Lankan society. Secondly, it violates rights and freedoms of others. Thirdly, such claim can be rebutted since the conduct of the deep linker would obstruct the basic requirements of the general welfare of a democratic society. Hence, STEP 2 would be more applicable.

Moreover, conduct of the deep linker would violate the freedom to engage any lawful occupation, profession, trade, business, or enterprise.³⁴⁰ Hence, it is submitted that linking can be challenged under STEP 2 since it affects rights and freedom of others.

As discussed above, a question arises when a link suggests association between the linking and linked sites, would this amount to false representation? The intent behind such an act is to make web users believe that an unassociated webpage belongs to a certain trade mark owner and thereby ultimately make money. Such conduct can be challenged under STEP 3 since such conduct is prejudicial and breaches the second precept of Buddhist *panca sīla*. Alternatively, STEP 5 could be used since an *Aquilian action* can be used to interpret the meaning of prejudice and also can be used independently. Such approach would protect unregistered trade marks. Finally, the Roman Dutch Law concept of unjust enrichment can be used to address linking.

3.8.6 Framing

Framing is a command in HTML that enables a viewer to see the screen split in several smaller windows or frames.³⁴¹ The viewer can see all those frames on the same screen since those are spread over the screen and displayed on a separate portion of the screen. At the same time, all these frames function independently to display an individual webpage.³⁴²

From the trade mark point of view, the problem is the ability to confuse the viewer as to the origin of the site and the goods and service it displays. The user is still able to see the entire framed site using the scroll bar without knowing the different origins of different sub-frames. Since the framed URL is not displayed the viewer can be misled as to the source/ origin of the site. Thus, potential trade mark liability can be raised. Moreover,

³³⁹ Art.14(1)(a).

³⁴⁰ Freedom of trade etc is guaranteed by Art.14(1)(g).

³⁴¹ Webopedia at <http://www.webopedia.com/TERM/f/frames.html> (Accessed: 01.12.2004).

framing becomes problematic when used to replace margins, generally consisting of advertisements, of the framed site with margins of the framing site. This would divert advertising revenue derived from selling advertisement slots placed within framed site to the framing site.

3.8.6.(a) Position in the USA

In *The Washington Post v. Total News Inc.*,³⁴³ the defendant had framed news content from the plaintiff's sites with advertisements that it had itself sold. The contentions were, among other things, whether defendant's conduct would amount to infringement of the trademark of the plaintiff. The case was settled upon an agreement to permit the defendant to maintain its link to the news sites but to cease framing the plaintiff's material in association with any third party advertising or its URL.³⁴⁴

3.8.6.(b) Position in the United Kingdom

There are currently no reported cases in this regard. However, it could be argued that an act of framing would be covered by sec.10(4)(d) of the Trade Marks Act 1994. This matter is open to be decided by the court.

3.8.6.(c) Sri Lankan Position

As noted above, framing might not reveal the ownership of the page called up and might wrongly suggest a non-existent association between framing and framed page. Hence, the question arises as to whether present law is capable of addressing this issue. Section 121(3) of the 2003 Act prohibits '*application or affixing*' of marks in a way likely to mislead the public. Nevertheless, it restricts its application only to goods. Hence, it does not protect service marks in this regard. However, sec.121(2)(b) can be applied in this regard since such conduct is likely to be prejudicial to the interest of the owner of the mark.

Section 160 of the 2003 Act *per se* does not deal with the act of framing. Nevertheless, it is submitted that unfair competition law can be extended to cover framing since sec.160(1) prohibits any act or practice carried out or engaged in, in the course of business that is contrary to honest and commercial practice. Though Sri Lankan courts

³⁴² Ignacio Javier Garrote, *supra* n.329.

³⁴³ No.97Civ.1190(PKL)(S.D.N.Y.)at

http://people.hofstra.edu/faculty/peter_j_spiro/cyberlaw/totalset.html (Accessed: 01.12.2004).

³⁴⁴ Also *Hard Rock Café v. Morton*, 1999 U.S. Dist .LEXIS 8340 (S.D.N.Y.).

have not defined the term 'contrary to honest and commercial practice', it is submitted application of Buddhist principles would guide the court.

Once again, intention of the creator of frame is questionable. The ulterior motive of the creator of the frame is to make wealth by confusing the consumers. Would it be a proper means of acquiring wealth? If not, would it violate the moral conduct expected by the society?

The above-mentioned USA case demonstrates that the ulterior motive of framing is to gain some financial benefit by misleading the public when using or exploiting someone's trade mark. From the Buddhist point of view, this breaches two precepts of *panca sīla*. It breaches the Second precept, which safeguards everyone's right to ownership of property by 'taking / appropriating' what is not given. It breaches the third precept by making false representation. Hence, it is submitted that the Sri Lanka courts would find the answer to framing in STEP 3. On the other hand, it can be argued that framing would amount to infringement of right to livelihood and hence STEP 2 would be appropriate.

3.8.7 Sale of trade marks as keywords

As noted above, web users use specific words/ terms or phrases while searching a website to locate information online. At the same time, most web owners seek to maximise their income through advertisement. The higher volume of users to the website necessarily gives opportunity to get more advertising revenue. Thus, some search engines sell key words and terms to advertisers who want to do their marketing in cyberspace. Consequently, advertisers use these keywords along with their advertisements in order to get more chances to be displayed. Thus, when a trade mark becomes the subject matter of these sales of key words, it may divert customers to the advertising website. The question is whether such practice would amount to infringement of trade mark.

3.8.7.(a) Position in the USA

The position of sale of trade marks as keyword was challenged in *Playboy Enterprises v. Netscape Communications*.³⁴⁵ The court considered the use of the word "Playboy" and "Playmate" as keywords by the searchers and held that use of common or generic words does not amount to an infringement. Hence, the use of the term 'Playboy' did not amount to infringement of rights since it has not been used in 'trade mark sense'.

³⁴⁵ 55 F. Supp.2d. 1070(C.D.Cal).

3.8.7.(b) Position in the United Kingdom

There is currently no case law in United Kingdom in this regard. However, as discussed above relative rankings in search engine results would bring more revenue to the advertiser. Hence, it can be argued that if as a result of keyword sales a competitor appeared above the proprietor of the trade mark in search engine results, in theory it could be actionable.

Section 2 of the Trade Marks Act 1994, which declares, “a registered mark is a property right obtained by the registration” and sec.9 stipulates that ‘the proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in the United Kingdom without his consent’. Considering these two sections along with sec.10(6) it can be argued that the sale of trade marks as keywords would amount to use other than in accordance with honest practices in industrial or commercial matters and hence would amount to infringement of trade mark rights.

3.8.7.(c) Sri Lankan position

Pursuant to sec.121(2)(b) of the 2003 Act it is clear that a trade mark is protected against any use of the mark itself or of a sign resembling it, if the use is made without just cause and is effected in conditions likely to be prejudicial to the interest of the registered owner of the mark. Since likelihood of misleading the public is not required under this provision, it can be argued that a sale of key word would be ‘prejudicial to the interest of the trade mark owner’. Hence, STEP 1 would be sufficient to address the issue.

In an early case,³⁴⁶ the Court held the use of a mark as a trade mark confers rights of property in it. However, statutory provisions throughout the history do not support this view. Paradoxically, the present trade mark legislation in Sri Lanka does not explicitly recognize trade mark as a property right in contrast to other jurisdictions. Hence, can it be argued that the sale of trade mark as key words does not amount to infringement of trade marks? It is submitted, since registered mark can be assigned they arguably have the nature of property. Nevertheless, the subtle question in the international legal order remains to be answered is how one could “sell” rights that do not belong to him.

On the other hand, by selling trade marks as keywords the seller misappropriates property rights of another. Misappropriation of property is highly condemned by

³⁴⁶ *Swamipillai v Manuelpillai* (1890) 1 C.L.W.15.

Buddhism. If a seller acquires wealth by selling what does not belong to him and hence he/she breaches the second precept and right livelihood or *sammā ājīva* or of Buddhist life. (STEP 3).

On the other hand, under STEP 5 an *Aquilian action* can be used as a remedy to sale of trade marks as key words since all elements i.e. *dolus* (intentional wrongful act), pecuniary loss to the trade marks owner, fault on the part of the seller that are necessary to constitute *Aquilian action* is satisfied by the sellers conduct.

3.8.8 Pop-up and pop-under advertisements

Pop-up advertisements are a type of window that appears on top of the browser window of a website that a user has visited. Generally, these types of windows are used to advertise on websites. These advertisements appear on top of the content page of a website without any initiation by the web user and disappear after some time.³⁴⁷ Once it appears and is clicked by the user the user will be directed to the advertiser's website. The software, which creates pop-up advertisements, is designed to monitor users' online activity. The main objective of this monitoring process is to understand users' likes and dislikes and then to deliver targeted advertisement to the selected users.

In contrast to pop-up advertisements, pop-under advertisements appear behind the browser window of a website that a user has visited. Hence, issues arise when the advertisements make unauthorised use of trade marks.

3.8.8.(a) Position in the USA

The US court looked into the matter of pop-up advertisement in *Washingtonpost .Newsweek Interactive Company LLC., et. al, v. Gator Corp.*,³⁴⁸ Here the defendant used software to cause pop-up advertisements to appear on computer screens over and/or under pages from websites owned by plaintiff without permission from plaintiff. The court held that these pop-up advertisements violated the plaintiff's trade mark and issued an injunction prohibiting the defendant from enabling third party advertising to appear on a web user's computer screen when the web user was viewing websites owned or affiliated with the plaintiffs'. Furthermore, the defendant was enjoined from making any designations of origin, descriptions, representations, or suggestions that plaintiffs are the

³⁴⁷ Webopedia at http://www.webopedia.com/TERM/p/pop_up_window.html (Accessed: 01.12.2004).

³⁴⁸ CA No.02-909-A (E.D.Va.,16.07.2002).

source, sponsors or anyway affiliated with defendant's advertisers or their websites, services and product.³⁴⁹

3.8.8.(b) Position in the United Kingdom

Since there is no general unfair competition law apart from passing off action in the United Kingdom, it is arguable whether such an act would amount to infringement of trade mark. Nevertheless, it can be argued that there is a possibility to apply passing off since pop-ups make a false impression. However, this matter has not come before the court.

3.8.8.(c) Sri Lankan position

The popular practice of pop-up and pop-under advertisements is to attract more customers. However, there are no decided cases in Sri Lanka on this matter.

Once pop-up advertisements appear and clicked by the user the user will be directed to the advertiser's website. Would it amount to misdirecting the customer since the customer can see where he/she has ended up? Can it be considered an act of unfair competition or unfair attempt to earn? Should a lacuna in the law allow the practice to prevail?

In terms of sec.121 and 160 of the 2003 Act, it would seem that pop-up advertisements can infringe trade marks and can amount to unfair competition since they create confusion of the establishment or of the goods or services. Hence, such conduct would undermine Buddhist values since the ulterior motive of the pop-up advertiser is to earn by appropriating someone's property. Thus, STEP 3 provides an answer.

3.8.9 Mousetrapping

Mousetrapping is a technique, which forces the web users to remain on a certain website.³⁵⁰ This can be seen in different ways. Some mousetrapping disables the users' ability to move from one window to another while flooding with pop-up advertisements. Some open new windows repeatedly as the user tries to leave the website either using functional button or closing windows. More often, the mouse is disabled. There is no alternative and therefore the user has to continue viewing unwanted pop-up advertising

³⁴⁹ Also *Six Continents Hotels Inc. and Inter-Continental Hotels Corp. v. The Gator Corp.*, No.1:02 cv3065(N.D.Ga. complaint filed 12.11.2002) and cf. *1-800 Contacts, Inc. v. WhenU.com*, 2003 WL 22999270, S.D.N.Y.,22.12. 2003; *U-Haul Int'l, Inc. v. WhenU.com* (E.D. Va. 05.09.2003) (No.Civil 02-1469-A).

³⁵⁰ Webopedia at <http://www.webopedia.com/TERM/m/mousetrapping.html> (Accessed: 01.12.2004).

or switch off³⁵¹ to get out of the trap, which ends the task or reboots the computer if that fails.

The question is whether there can be trade marks infringement when these transactions take place in conjunction with trade marks. Thus, an examination of United Kingdom, USA would provide an understanding of the legality of such use of trade marks.

3.8.9.(a) Position in the USA

In *Federal Trade Commission v Carlos Pereira d/b/a/ atariz.com, et al*,³⁵² the court discussed the application of sec.5(a) of the Federal Trade Commission Act ("FTC Act"),³⁵³ which prohibits unfair or deceptive acts or practices in or affecting commerce. In this case, the defendants engaged in mousetrapping by disabling the browser's functional command keys such as "back" and "exit" so that Internet surfers were faced with a flood of advertisements for adult sites. The Federal Trade Commission (FTC) alleged that the mousetrapping constituted illegal and unfair practices, hence court issued a preliminary injunction.

On another occasion, the FTC alleged the defendant was registering Internet domain names that were misspelt or versions of legitimate domain names. Once consumers arrived on the defendant's site, they were unable to exit because of mousetrapping.³⁵⁴ The court issued a permanent injunction.

3.8.9.(b) Position in the United Kingdom

Mousetrapping has not become a subject of trade mark infringement cases in the United Kingdom. It remains to be answered by a court of the United Kingdom whether such act would come under the purview of sec.10 of the Trade Marks Act 1994. It seems that in terms of sec.10(3) mousetrapping can be challenged since it gives unfair advantage to the person who makes mousetrapping or it is detrimental to the distinctive character or the repute of the trade mark. On the part of the user it creates a situation of exasperation, antipathy, or frustration while looking for a trade mark on the Internet.

³⁵¹ Press + hold CTL-ALT-DEL to close windows but not many users know.

³⁵² No.99-1367-A (E.D.Va.21.09.1999).

³⁵³ 15 U.S.C. § 45(a),

³⁵⁴ *FTC v Zuccarini*, Civil Action No.01-CV-4854; ED.Pe.2002, U.S.Dist.LEXIS 13324; at <http://www.ftc.gov/os/1999/09/atarizpreliminaryinjunction.htm> (Accessed: 01.12.2004).

3.8.9.(c) Sri Lankan position

No case has been reported up to now regarding mousetrapping. However, a question arises as to whether it can be considered under traditional doctrines of fraud and/ or unfair competition.

Redirecting consumers to other sites and not allowing them to surf the web undermines the values of the consumers' time. It may defeat the consumers' confidence in the Internet. Can it constitute an act of unfair competition?

Nevertheless, under the ambit of sec.160(3) (b) of the 2003 Act it can be argued that such use of trade mark would damage the trade mark owner's goodwill or reputation.³⁵⁵ In addition, the conduct of the mousetrapper would be prejudicial to the registered trade mark owner. Hence, STEP 1 would suffice to address the issue. On the other hand, it can be argued since mousetrapping would challenge the freedom of trade guaranteed by the Constitution, STEP 2 can be used. Above all, since the conduct of the mousetrapper meets the requirements of an *Aquilian action* (STEP 5), there is a possibility to use Roman Dutch Law principles in this regard.

PART D

Applicability and the efficacy of the proposed theory

3.9 Introduction

The foregoing discussion demonstrates that the 2003 Act has its loopholes, and hence it does not provide 'better protection' to the owner of trade marks, trade names etc while protecting interest of consumers. As mentioned in Chapter one, though Sri Lanka is a party to many international and bilateral treaties including treaties on trade marks protection, mere ratification of a treaty, does not give effect to the treaty in domestic law. Thus in order to give effect to the content of a treaty, domestic legislation is required. However, up to now there are only a few provisions in domestic trade mark legislation giving effect to this. Hence, the minimum standard of protection contained in the international treaties makes no great impact on Sri Lankan trade marks law.

Furthermore, as seen in the foregoing Chapter, traditional trade mark law has faced mismatched with the novel application of trade marks in the digital environment and the

³⁵⁵ Sec.160(3) stipulates that any act or practice carried out or engaged in, in the course of business that damages the goodwill or reputation of another's enterprise shall constitute an act of unfair competition.

present trade marks law in Sri Lanka is not equipped to address some of those issues. Once again, a subtle question arises as to whether Sri Lanka needs a new law to address the issues arising in the digital environment.

Admittedly, either creating new rights or generously interpreting the ambit of its law can expand intellectual property law of a country. Sri Lanka has to adopt a way to face the above-mentioned problem i.e. either creates new rights or use the existing law. In a country like Sri Lanka where there are comparatively few reported cases available from the courts it is unwise to seek constant legislative changes in an attempt to keep up with developments and comply with Sri Lanka's international obligations. As seen in Part C, it is more promising to adopt the latter way than promulgating new law that may become obsolete with the change of technology in the exploitation of trade marks.

3.9.1 Application of the theory

As mentioned before, there is a dearth of judicial guidance on the subject matter in Sri Lanka. Hence, it is difficult to promulgate new laws from time to time to fill the gaps in the law or to cover new situations, which were not predicted at the time of promulgation of law. The need of the day is to apply the proposed theory / methodology. Such approach has a broader ramification on passing off action and unfair competition principles and in controlling the conduct of defendants in trade mark infringement cases.

Sri Lankan judiciary should be aware that any lacunae of the present law may be filled applying constitutional principles and Buddhist moral code while interpreting the present laws in compliance with international obligations of the country.

As seen in Part C, most of the trade mark cases draw attention to the following three basic things:

- (1) the defendant does not have legitimate right over the disputed mark,
- (2) the technique in which he used the trade mark (domain name, mousetrapping, metataging, pop-up advertising, linking and framing etc)
- (3) the purpose of the use (to deceive customers and earn money).

Admittedly, there is no difference in these elements in the case of infringement of trade marks in the digital world. However, the above elements are to be examined in order to fit into the proposed theory.

As has been seen in Chapter Two, in order to breach the second precept of *panca sīla* five requirements should be satisfied.³⁵⁶ In the case of infringement of trade mark, the challenging factor is the unauthorized use of trade marks by the defendant. Hence, it is obvious that the defendant has no legitimate right over the trade marks and he knows that the trade marks do not belong to him. Then he employs a device or performs an act of “appropriating it.” Here the defendant utilizes a method such as hidden embedded text (meta tags etc) through the electronic media. The ultimate motive of the defendant is to acquire ‘something’ he does not own. As pointed in *Anguttara Nikāya*, *bhogā me uppajjantu sahadhammenāti*³⁵⁷ one of the four cardinal wishes of an individual should be “may wealth by lawful means come to me.” Again, the same Nikāya points that *bogehi dhammikehi dhamaladdehi*³⁵⁸ - wealth should be earned by lawful means. Hence, the conduct of defendant can be challenged.

In many situations discussed in Part C of this Chapter, the defendant breaches the fourth precept as well since he makes false representations as to the source of goods. The cumulative effect of this conduct would amount to breach of second and third precepts and breach of two paths in the eight fold paths, namely right words (*sammā vāchā*) and right livelihood (*sammā ājīva*). Hence, the whole chain of the act would amount to breach of Buddhist morality, and hence challenge the constitutional obligation of the State to uphold Buddhism.

Moreover, to justify whether an act of a defendant does not harm the plaintiff, ‘do as you would be done by’ formulae should be applied.

Application of Buddhist rationale does not depend upon the medium to which it is applied. It does consider whether the basic element to breach *panca sīla*, is satisfied. Hence, if anyone appropriates another’s property without the consent of the owner with a view to make profit he/she breaches the second precept of *panca sīla*, irrespective of the medium that is used to appropriate property. Hence, it is submitted that, this justification can be properly applied in the future irrespective of the medium or mode that will be used to ‘use’ marks in the technology world. As seen in Part C the judiciary is given more opportunity to extend the present law when it applies the proposed formula.

³⁵⁶ Para 2.9.(c)(I).

³⁵⁷ Pattakamma Sutta of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara2/4-catukkanipata/007-pattakammavaggo-p.htm> (Accessed: 01.12.2004).

³⁵⁸ Mundaraja Vagga of Anguttara Nikāya at <http://www.metta.lk/tipitaka/2Sutta-Pitaka/4Anguttara-Nikaya/Anguttara3/5-pancakanipata/005-mundarjavaggo-p.htm> (Accessed: 01.12.2004).

3.9.2 Conclusion

Once again, the applicability of the formula suggested in Chapter two of this thesis should be considered. The formula suggest that there is ample opportunity available to Sri Lankan judiciary to protect rights of trade marks owners and to protect interest of the consumer without seeking new law with the rapid development of information society.

As seen in Part C, STEPS 3 and 5 give more advantage than other steps of the formulae. For instance, all above discussion relating to the use of trade mark as meta tags, domain names and the practice of cybersquatting, reverse hijacking and cyber-gripping etc., underlies two important facts. The first is the intention to acquire wealth by illegitimate means. This means methods of using someone's goodwill, which was created by investing money and labour. The second fact is the use of methods that mislead the public. Thus, it is obvious that the first situation violates the second precept of *panca sīla* and the second situation violates the fourth precepts of *panca sīla*. Accordingly, it breaches the moral code of the country. In STEP 5, judges are more equipped with Roman Dutch Law principles and capable of giving justice to the owner of a mark.

As demonstrated in Part C, it is submitted that, one has to give importance to the intention of a wrongdoer and the impact of such conduct. Hence, it is the duty of the judges in Sri Lanka to interpret trade marks and unfair competition laws not by considering the medium in which the infringement takes place but by considering the impact of such conduct. The techniques that are used for such acts will change as a result of the ever-growing pace of technological development. Hence, the focus should be made on the rationale behind the protection of trade marks and especially to complete the moral obligation to establish a "JUST" society as undertaken when the constitution is made.

CHAPTER FOUR

Laws relating to copyright and related rights in Sri Lanka and their application in the information age:

Historical, philosophical and legal perspective

Cethanahan bhikkave kammam vadāmi

-The Buddha

(Every action is a creation of thoughts)

4.1 Introduction

It is axiomatic that a thought can be understood only when expressed by words or displayed by means of a physical action. The creative thoughts of man are displayed in multiple forms of aesthetic expression. These expressions are, in one sense, the expression of the ethos of the people of a given country due to absorption of the surrounding environmental factors. Sri Lanka, as amply demonstrated throughout her history, is not an exception to this.

As discussed in Chapter Two,¹ throughout the pre-colonial era in Sri Lanka, people shared cultural references to express themselves and to define their relationship with their world and each other. Moreover, ancient Sri Lankans regarded literary and artistic work as an embodiment of society.² Hence, the societal benefit derived from a work, rather than material gain, was the incentive for creativity. As discussed,³ this is mostly due to Buddhist values deeply ingrained in Sri Lankan society.

Nevertheless, it can be argued that despite considerable Buddhist influence on the societal behaviour of Sri Lankans and irrespective of the fact that historically Sri Lankans have not considered the subject matter of intellectual property in purely economic terms; there may have been instances of misuse of subject matters that presently belong to the copyright regime. For instance, there is a term '*kukavi*' in Sinhala, added to the language from the early literature. *Kukavi* is a term given to a person who copies someone else's

¹ Para 2.6.

² Thousands of ancient temples wall paintings, woodcarvings, sculptures, dances, and musical works would constitute protectable subject matter under modern copyright law. Some of these works are preserved in secular form compatible with Buddhism. John Paxton and Sheila Fairfield, *Calendar of Creative Man* (London: The Macmillan Press Ltd., 1979), 196 acknowledged the existence of Kandyan Dances, which were seen in 1591 A.D. These dances are still seen as a part of Buddhist festivals throughout the country performed during August every year at the most sacred Buddhist temple in Sri Lanka.

poetry⁴ and claims authorship as his own.⁵ This suggests that there may have been 'unauthorised' use or 'misappropriation' of work in those days. However, there is no written evidence of sanctions for this behaviour, unlike those who effaced marks.⁶

There was an incident in early history as early as 38-66 A.D in Sri Lanka when a Buddhist monk brought a beaker made of coconut shell with carvings from one temple and faced a trial for theft. This beaker was made by another monk and was kept in the former temple for the benefit of monks living in that temple.⁷ According to *Vinaya*⁸ or monastic rules, a monk could be disrobed if he committed a theft in which the value of stolen property exceeded five *massaka*.⁹ In order to decide whether the monk had committed such a theft, the Buddhist council had to consider the value of a coconut in the village from where the vessel was brought, and the value of the vessel because of its carvings. This story emphasised the fact that there was recognition of economic value of artistic creation in those times in Sri Lanka.

As seen in Chapter two,¹⁰ the right to use one's intellectual creations were gifted to the society in early Sri Lanka. This means that those creations were not absolutely free to use before they were gifted. Hence, it could be argued that the conduct of those creators necessarily suggests that there would have existed a possible recognition of some kind of exclusive rights of a creator.

³ Ch.Two.

⁴ Sri Lanka has a rich collection of ancient poems/verses. *Nikāya Sangrahaya* mentions twelve poets during the time of King Agbo II, about 2nd Century B.C. *Siyabaslakara* (948 A.D), *Dhampiya-atuwa Gatapadaya* (908-918 A.D). Newton Pinto, *A Short History of Sinhalese Literature* (Colombo: M.D Gunasena, 1954). Most were used in specific occasions, e.g. while ploughing, guarding the crop from beasts, harvesting, collecting honey, fishing, mining (gems and graphite) and while performing dance (*balikavi* and *thovil kavi*).

⁵ Harishchandra Wijetunge, *Sinhala Shabdakoshaya (Practical Sinhala Dictionary)* (Colombo: Ministry of Cultural Affairs, 1982), 533. *Perakumbasiritha*, (1450-1460) attributed to Ven. Totagamuwe Rahula suggest that the word 'kukavi' entered into the Sinhala poetry as early as the 15th Century as evidenced by the verse no.7 shown below:

"*viyatun idiriye - nohobee kukavi diriye*
divayuru idireye - kese bebedda kanamediriye"

The appearance of a 'fake-poet' in the midst of proper intellectuals is similar to the inability of a firefly to glare in the presence of the shining sun'. Ven. Totagamuwe Rahula, *Perakumba Sirita*, ed. by Charles De Silva, (Colombo: M.D Gunasena, 1954), 1.

⁶ Para 2.7.2.

⁷ Buddhagosha, *Samantapasadika* (London: Pali Text Society, 1947), 306-307. See further Oscar VonHinuber, 'Buddhist Law according to the Theravada- Vinaya: A Survey of Theory and Practice', *JIAS*, 18. 1 (1995), 7-45 for detail discussion of the application of *Vinaya* rules and the Law.

⁸ Para 2.9(A) and for detail at <http://www.metta.lk/tipitaka/1Vinaya-Pitaka/index.html> (Accessed: 01.11.004).

⁹ A type of money used in the old days in Sri Lanka.

¹⁰ Para 2.7.2.

Thus it is submitted that all of these evidence i.e. gifting creations, *kukavi* and the stealing of carved coconut shell beaker, suggest that before the influence of the Western concept of justification of intellectual property as a means of encouraging authors and artists to create (thereby promoting, enriching, and disseminating a nation's cultural heritage), early societies in Sri Lanka saw the value of giving due recognition to intellectual property rights and protection of the subject matter of copyright.

The economic aspect and protection of moral rights embodied in Western jurisprudence of intellectual property is also enshrined in the international instruments in relation to human rights. For instance, Art.27(2) of the Universal Declaration of Human Rights¹¹ (hereinafter "UDHR") states that, "Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author".¹² However, Art.27(1) of UDHR emphasises the public interest aspect,¹³ "Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and share in scientific advancement and its benefits."¹⁴

The International Covenant on Economic, Social, and Cultural Rights¹⁵ (hereinafter "ICESCR") also recognises the material interest of the creator. Art.15(1)(c) of the ICESCR requires countries that have ratified the instrument, to recognise the right of everyone "to benefit from the protection of the moral and material interests resulting from any scientific, literary, or artistic production of which he is the author."¹⁶

Importantly some of the international instruments emphasise the balance to be maintained between scientific development and its misuse. For instance, Art.6 of the Declaration on the use of Scientific and Technological Progress in the Interests of Peace and for the Benefit of Mankind¹⁷ declares that

¹¹ Adopted and proclaimed by United Nations' General Assembly resolution 217A(III) of 10.12.1948. Sri Lanka made her accession on the same day.

¹² Art.27(2).

¹³ Gerald Dworkin and Richard D.Taylor, *Blackstone's Guide to the Copyright, Designs and Patents Act 1988* (London: Blackstone Press Limited, 1994), 3.

¹⁴ Art.27(1). Importantly, Art.19 of UDHR stipulates that "Everyone has the right to freedom of opinion and expression; this right includes freedom to hold opinions without interference and to seek, receive and impart information and ideas through any media and regardless of frontiers."

¹⁵ Adopted and opened for signature, ratification and accession by United Nations' General Assembly resolution 2200A(XXI) of 16.12.1966 and entry into force 03.02.1976, in accordance with Art.27.

¹⁶ Also Art.5(1) of ICESCR. Sri Lanka acceded to ICESCR and International Covenant on Civil and Political Rights (ICCPR) in 1980.

¹⁷ United Nations' General Assembly Resolution 3384(XXX) of 10.11.1975. Sri Lanka is a UN Member since 1955. <http://www.un.org> (Accessed: 01.12.2004).

All States shall take measures to extend the benefits of science and technology to all strata of the population and to protect them, both socially and materially, from possible harmful effects of the misuse of scientific and technological developments, including their misuse to infringe upon the rights of the individual or of the group, particularly with regard to respect for privacy and the protection of the human personality and its physical and intellectual integrity.

Even though this instrument is directly related to scientific and technological progress, yet it categorically recognises protection of intellectual integrity and human personality.

The Sri Lankan Constitution does not expressly provide for copyright protection, but it enshrines basic principles, which is necessarily associated with creation of literary and artistic works. For instance, the Constitution guarantees freedom of expression as a fundamental right. Art.14(1)(a) provides that every citizen is entitled to “the freedom of speech and *expression including publication* (emphasis added).”¹⁸ As observed in *Joseph Perera Alias Brutten Perera v. The Attorney-General and Others*:

Freedom of speech and expression means the right to express one’s convictions and opinions freely by word of mouth, writing, printing, pictures or any other mode. It includes the expression of one’s ideas through banners, posters, signs etc. It includes the freedom of discussion and dissemination of knowledge. It includes freedom of the press and propagation of ideas ...¹⁹

Copyright does not protect ideas but the expression of ideas. A medium is required when these expressions are to be made public. When those media through which people exercise their freedom of expressions are protected by copyright (i.e. supporting the infrastructure of press, publishing and broadcasting etc.,) it encourages the dissemination of literary, artistic and scientific works, hence it underpins the freedom of expression guaranteed by the Constitution. Otherwise, the people of Sri Lanka would only be able to enjoy the freedom of expression per se but not the ‘material and moral interest’ of the outcomes of such freedom. Hence, there is no reason not to protect medium of expression if the guarantee of freedom of expression is to be protected and advanced.

Copyright is a property right. Property rights are not guaranteed by the Constitution. Nevertheless, it guarantees rights of the people to engage in a lawful occupation, profession, trade, etc.²⁰ In Sri Lanka many people earn their livelihood on cultural industries. When the law deprives them of their means of livelihood by not protecting cultural industries, it appears that the right to engage in lawful occupation etc., would

¹⁸ According to Art.15(2) this fundamental right is not absolute.

¹⁹ [1992] 1 S.L.R.202.

²⁰ Art.14(1)(g).

become meaningless.²¹ Hence, it is clear that when copyrights are protected it fosters the fullest exercise of not only Art.14(1)(a) but also 14(1)(g) of the Constitution. Thus, the understanding of the scope and content of freedom of expression is inextricably linked with the concept of the right to livelihood. Hence, it is submitted that under the present law copyright is an essential prerequisite for successfully preserving the rights guaranteed by the Constitution.

Moreover, freedom of expression is protected along with the other freedoms, such as freedom of thought, which necessarily gives meaning to the freedom of expression. The Supreme Court of Sri Lanka observed that

Article 14(1)(a) of the Constitution is not to be interpreted narrowly. Not only does it include every form of expression, but its protection may be invoked in combination with other express guarantees (such as the right to equality); and it extends to and includes implied guarantees necessary to make the express guarantees meaningful.²²

This also means that copyright law must be interpreted to achieve the Constitutional norms.

The Constitution also guarantees the freedom to promote culture and language.²³ This is a vitally important provision for Sri Lanka, where expressions of thoughts have been moulded by culture throughout her history. It is evident that the above provisions give recognition to 'expressions of thoughts' while recognising their impact on culture by ordering the right to expression as one of the highest rights of the people of the country.

Nevertheless, the Constitution recognises the need to maintain balance between rights of individuals and rights of the society. Hence, the Constitution provides some limitations on the rights guaranteed under Art.14(1)(a) and 14(1)(f). Pursuant to Art.15(7) of the Constitution, those limitations are made to protect the morality of Sri Lankan society, to secure due recognition and respect for the rights and freedoms of others, and to meet the just requirements of general welfare of a democratic society. There is no evidence to date

²¹ In *Prasanna Withanage v Sarath Amunugama* [2000]1 S.L.R.391 held that arbitrary refusal to release a film seriously affected Petitioner's right to livelihood-Art.14(1)(g) and also violates Art.14(1)(a).

²² Fernando J in *Fernando v. The Sri Lanka Broadcasting Corporation and Others* [1996] 1 Sri L.R.157 at 179.

²³ Art.14(1)(f).

as to the extension of these principles to commercial speech,²⁴ e.g. comparative advertisements.²⁵

More importantly, while recognising rights in relation to expression, publication etc. the Constitution draws attention to the fact that the exercise and enjoyment of rights and freedoms is inseparable from the performance of duties and obligations of individuals. Accordingly, it is the fundamental duty of every person in Sri Lanka to uphold the Constitution and to respect the rights and freedoms of others.²⁶ Hence, people in Sri Lanka (whether its citizens or not) are constitutionally obliged to respect the rights and freedoms of others including freedom of expression. Moreover, freedom of expression itself and respect for rights of others also requires appropriate exemption and limitation to copyright. Hence, it is submitted that courts, in interpreting scope and effect of copyright, must have regard to the constitution.

The Constitution does not evade the duty of State by unilaterally imposing duties on people, but also emphasises the State's duties. Accordingly, the Constitution stipulates that the State is pledged to raise cultural and moral standard of the people and to develop culture and language.²⁷

The Constitution recognises the importance of the rights guaranteed by it, hence the fundamental rights jurisdiction is given to the Supreme Court of Sri Lanka.²⁸ An action can be instituted in the Supreme Court against the state or state agent for an infringement or imminent infringement of fundamental rights by an executive or administrative action.²⁹ Since fundamental rights can be claimed against the State, the same remedy is not available against a private individual and one has to resort to civil remedy only. However, this does not mean that those guaranteed rights can not be used as a basic standard/ norm in interpreting private rights.

According to the preamble to the Constitution, it is the duty of the State to promulgate necessary laws in order to achieve the goals of the country and assure fundamental human rights and well-being to succeeding generations of Sri Lanka.³⁰ Moreover, it is the duty of the organs of the government to respect, secure and advance these

²⁴ cf. Para 3.8.(2)(c).

²⁵ Personal communication with Sunil D.B Abeyarathne, Chairman, ICT Law Committee and the Assistant Secretary, the Bar Association of Sri Lanka, on 12.07.2004.

²⁶ Art.28(a) and (e).

²⁷ Art.27(2)(g)and 27(10).

²⁸ Art.126(1).

²⁹ Art.17.

fundamental rights and not abridge, restrict or deny them except in the manner stipulated by the Constitution.³¹ Hence, the duty of the court is to interpret and apply legislation in accordance with the Constitution. The question that arises is whether the failure by the State to promulgate balanced legislation to protect copyrights and related rights constitutes an imminent infringement of fundamental rights giving right to individuals to institute legal action against the State or State agencies. The courts have not yet been called upon to decide upon this issue. If this claim were tenable then a logical argument would be that the concerned authority in relation to intellectual property protection in Sri Lanka should be liable for not taking necessary action to protect freedom of expression including publication³² and the court should make necessary guidance under its jurisdiction.

Pursuant to Art.78(1) of the Constitution, 'every Bill shall be published in the Gazette at least seven days before it is placed on the Order Paper of Parliament'. In terms of Art.121(1) of the Constitution any citizen (including a body, whether incorporated or unincorporated, if not less than three-fourths of the members of such body are citizens) can make a petition to the Supreme Court seeking a determination of the consistency of the provisions of such a Bill with the Constitution. This should be done within one week of the Bill being placed on the Order Paper of Parliament.³³ The rationale behind those articles is to give opportunity to the public to challenge the constitutionality of proposed legislation since sovereignty lies with the People.³⁴ However, when no challenge is made during the prescribed time, would the Bill necessarily be considered as being consistent with the Constitution? It is submitted that the duty of the court still would be to interpret and apply the law in consistence with constitutional norms.

The rights recognized as copyrights under the Intellectual Property Act, No.36 of 2003 are statutory rights and the aggrieved party can seek legal redress under the general law as a civil matter, with the right being exercised by an aggrieved party not only against an individual but also against the State.³⁵

³⁰ Para.2.10.

³¹ Art.4(d).

³² The concerned authority for intellectual property protection is the National Intellectual Property Office (NIPO), which is under the Ministry of Trade, Commerce, and Consumer Affairs.

³³ Art.121(1).

³⁴ Art.3.

³⁵ Sec.3(1) of the State (Liability in Delict) Act, No.22 of 1969 states that where any officer or agent of the State infringes, among other things, any copyright and the infringement is committed with the authority of the State then, subject to the provisions of this Act, civil proceedings in respect of the infringement shall lie against the State.

The above-mentioned Constitutional provisions relating to freedom of expression and culture, together with the copyright and related rights embodied in Intellectual Property Act, No.36 of 2003, suggest that copyright and related rights occupy a lower level than fundamental rights, but higher than other statutory rights. When compared to other intellectual property rights protected under the Act such as trade marks, patents and designs, it is submitted that copyright has a higher position, with constitutional backing in the form of freedom of expression. Hence, it is submitted that Sri Lankan society, including the courts have a more prominent duty to protect copyrights than other intellectual property rights.

As discussed in Chapter One,³⁶ the development and diffusion of digital technology coupled with information communication technology permits unauthorised creation of unlimited, perfect and costless copies, and the almost instantaneous worldwide distribution of protected works. The situation is rendered more complicated with rapid growth of communications technology in Sri Lanka during the last decade.³⁷ Since the term 'property' has not been defined under Sri Lankan law³⁸ whether these binary codes are to be considered as property becomes a question. The Penal Code addresses the issue of theft, but it fails to address intangible property matters.³⁹ An attempt to include

³⁶ Para 1.2.

³⁷ The following statistics shows the growth in the information communication industry

(a) Internet subscribers in Sri Lanka.

Table two- Growth of Internet subscribers in Sri Lanka

Year	1994	1995	1996	1997	1998	1999	2000	2001	2002	2003
Number of Internet Connections	-	-	2,504	10,195	18,984	25,535	40,497	61,532	70,082	85,500

(Source- Annual Report of Central Bank of Sri Lanka-2003). Statistical Appendix Table (Table 33) at <http://www.lanka.net/centralbank/Ar2003/AR03-Appendix-tables.pdf> (Accessed: 01.12.2004).

(b) Land Phone Connections increased from 1,57,774 to 9,39,013 during the last decade. The Table 15 of special statistical appendix to the above annual report at <http://www.lanka.net/centralbank/Ar2003/AR03-Special-App-Tables.pdf> (Accessed: 01.12.2004).

(c) Number of subscribers for cellular phone in year 1994 was 29,182 and in 2003 was 667,662. <http://www.lanka.net/centralbank/Ar2003/AR03-Appendix-tables.pdf> (Accessed: 01.12.2004).

³⁸ Although, most legislation in relation to Marriage and Divorce in Sri Lanka deals with tangible property including some intangible property, none of them define the term "property". E.g. Jaffna Matrimonial Rights and Inheritance Ordinance, No.01 of 1911, Married Women's Property Ordinance, No.18 of 1923.

³⁹ Ch..XVII of the Penal Code deals with offences against property but this is confined to tangible property only.

intangible property in the definition of property in *Nagayya v Jayasekera*⁴⁰ failed when the Court held that electricity was not a property within the meaning of the Penal Code.⁴¹ Consequently, the legal community in Sri Lanka, as elsewhere, is being forced to address novel issues in order to protect authors' rights in the digital age⁴² while recognizing the obligations of Sri Lanka under international treaties.⁴³

This Chapter is divided into four parts. Part A sketches the development of copyright and related rights in Sri Lanka before the introduction of present laws, to provide a background to the situation that has given rise to the new legal order. This will provide an insight as to whether older legislation and cases may assist with the interpretation of new law. Part B explores, explains and criticises the application of present law relating to copyright and related rights of Sri Lanka in general. Part C examines specific issues that have emerged in the information society. Here, the Chapter identifies the specific issues yet to be addressed by the present copyright law of Sri Lanka and suggests how the courts may apply the proposed methodology.

An endeavour is made in Part D to evaluate the efficacy of the theoretical framework proposed by Chapter Two. Conclusions are drawn as to whether Sri Lankan Courts are already sufficiently equipped to address copyright issues in the digital age or whether they require new legislation.

PART A

Historical development

4.2 Pre British era

As seen in Chapter Two,⁴⁴ historically the creativity of the people was aimed at the benefit of society rather than commercialization because of the influence of Buddhism.⁴⁵ Hence, many aesthetic creations as well as other creations with regard to literary and

⁴⁰ (1927) 28 N.L.R. 467.

⁴¹ cf. 'abstraction of electricity'-sec.13 of the Theft Act 1968 (UK).

⁴² Sri Lankan Telecom (SLT) is the controlling body of telecommunication system in Sri Lanka under which Internet Service Providers get licences to provide a service. Until now, there were technical difficulties to get fast access to Internet due to low bandwidth. Now SLT introduced ADSL or Asymmetric Digital Subscriber Line, which allows users to download and upload faster and easily. This would increase the accessibility of the Internet in Sri Lanka. Island at <http://www.island.lk/2003/06/20/> (Accessed: 01.12.2004).

⁴³ Para 1.2.6 for Sri Lanka's membership to International treaties.

⁴⁴ Para.2.7.

⁴⁵ The concept of *parichariā dāna* or gift of works described in Para 2.6.

artistic works contributed to the common heritage of mankind in Sri Lanka.⁴⁶ However, available epigraphic records and literature⁴⁷ evidenced that society respected those 'works' and their proper use suggests that the people developed a body of intellectual property principles in Sri Lanka before the introduction of copyright legislation into the country.

4.3 During and after the British regime

Sri Lankan copyright law passed through four generations to reach its present status. Hence, the present copyright law belongs to the fifth generation. The first generation started with the enactment of the Telegram Copyright Ordinance, No.19 of 1898. The second began in 1908 with the promulgation of Copyright Ordinance, No.12 of 1908 whereas the third started with the introduction of the Imperial Copyright Act, 1911. The fourth generation was promulgated as an independent country in 1980 with the introduction of the Code of Intellectual Property Act, No.52 of 1979 (hereinafter the Code). The fifth began in September 2003 with the promulgation of Intellectual Property Act, No.36 of 2003 (hereinafter "2003 Act").

4.3.1 The first generation

The Telegram Copyright Ordinance, No.19 of 1898 (hereinafter "TCO") was promulgated to secure, in certain cases, the right of property in telegraphic press messages.⁴⁸ As declared at the time of the introduction of the bill to the Ceylon Legislative Council, the main goal of the TCO was to protect the 'right of property' in telegraphic messages.⁴⁹ The TCO prohibited publication of telegraphic messages received from outside Sri Lanka before expiration of forty-eight hours without the consent of the recipient.⁵⁰

⁴⁶ One of the best examples is Sigiriya, which is declared as one of the world cultural heritage by the UNESCO. Sigiriya is a complex of buildings which were constructed on a central rock, rising 200 metres above the surrounding plain and has pictorial arts as those similar to Ajanta in India. There are some exegetical works written on the gallery wall at Sigiriya in manner of folk poetry and verses in the eighth and ninth century. There was theatre (*ranga-mandapa*) where dancers and actors exhibited their performance (*karanas*), dramas of the *prakarana* (dramatical work with fictitious plot) type and *prahasanas* (a farce) in front of the King Kashyapa. S. Paranavithana, *Sigiri Graffiti, being Sinhala Verses of the Eighth, Ninth and Tenth Centuries*, (Oxford University Press for the Government of Ceylon, 1956); Senarat Paranavitana, *The Story of Sigiri* (Colombo, Sri Lanka: Lake House Investment Limited Book Publishers, 1972), 125-126.

⁴⁷ Para 2.6 and 2.7.

⁴⁸ The subtitle to the Ordinance. Generally, Lionel Bently, *Making of Modern Intellectual Property Law: The British Experience, 1760-1911*, (Cambridge: Cambridge University Press, 1999).

⁴⁹ Debates on 02.12.1898, p.28. According to the Hon. Attorney General, who moved the first reading in the Ceylon Legislative Council, the TCO was adopted from South Australian Act, No.10 of 1872.

⁵⁰ Sec.2.

In *Capper v Wayman*⁵¹ the Court looked into the meaning of sec.2 of the TCO. In this case, the question was whether the wilful printing and publishing of a telegram before a lapse of forty-eight hours from time of first publication would amount to infringement of the TCO. The court held that the conduct of the sub-editor of the '*Ceylon Standard*' amounted to wilfulness, thus he was found in violation of sec.2 of the TCO.

However a question also arose as to whether a third party was liable for violation of the TCO where 'A' and 'B' received the same message by electric telegraph and a third party (C) obtained B's consent to publish the same message before 48 hours from the first time of publication. This matter was discussed in *Capper v Silva*.⁵² The court held that 'B' cannot deprive 'A' of the right of maintaining a prosecution against such third party (C), provided 'A' had published in accordance with the TCO and had not consented to the publication by the third party and when such a third party had published the same message within forty-eight hours of its publication by 'A'.

Furthermore, in *Times of Ceylon v Marcus*⁵³ the Court considered whether *mens rea* was applicable as to the knowledge of the accused. The accused in this case was charged under sec.2 of the TCO with having wilfully printed and published in "*The Ceylonese*" an item of telegraphic news, which was published in the "*Times of Ceylon.*" The court held that it is the duty of the publisher to trace whether the news is protected under the TCO or not before printing and publishing.

The above cases suggest that the parties' concerns were to protect copyright in the message received by the telegraph and thereby protect the financial benefit resulting from the publication of current news before competitors. Hence, the rationale of the first law relating to copyright in Sri Lanka reflected the justification of copyright protection in economic terms.⁵⁴

Even though the Code of Intellectual Property Act, No.52 of 1979 expressly abolished the previous laws in relation to copyright⁵⁵ and common law rights,⁵⁶ it did not expressly abolish the TCO. The present law does not refer in this regard. Hence, it is submitted

⁵¹ (1902) 6 N.L.R.58.

⁵² (1904) 8 N.L.R.30.

⁵³ (1913) 16 N.L.R.225.

⁵⁴ As will be seen moral rights were given protection in 1979.

⁵⁵ Sec.187.

⁵⁶ *Ibid.*, sec.24.

that, although the TCO⁵⁷ has not been used in recent time, it still is part of Sri Lankan law and can be used to supplement general copyright provisions, which do not protect news of the day.⁵⁸ As far as the competitiveness of the media industry is concerned, it can be argued that even today TCO can be effectively applied to protect copyright in messages that contain time sensitive information received by e-mail, fax, or other mode of communication.⁵⁹

4.3.2 The second generation

The first ever legislation aimed at regulating copyright in general in Sri Lanka came in to force when the Copyright Ordinance, No.12 of 1908 was enacted in 1908 (hereinafter "1908 Ordinance"). According to the Ceylon Legislative Council Debates, the object of the Ordinance was to provide for the registration of copyright in literary and artistic works⁶⁰ whereas the preamble of the 1908 Ordinance stipulated the objective of the Ordinance was to secure the right of property in literary and artistic works. This emphasises the rationale of copyright protection was the economic benefit of the author.

Part III of the 1908 Ordinance provided protection for literary works whereas Part IV provided protection for artistic works.⁶¹ However, under the 1908 Ordinance no protection was provided for dramatic and musical works but for oral works,⁶² translations, or abridgments.⁶³

⁵⁷ As amended in 1926 by Telegram Copyright Ordinance, No.1 of 1926. The main idea of the amendment was to delete some words and add a section to the Ordinance. Thus, the word "electric" in sec.1 and sub-sec.(1) of sec.4 of the TCO was deleted by this Amendment. The term 'by Submarine Telegraph' in sec.3 of the TCO was substituted with 'Telegram Copyright Ordinance 1898'. Furthermore, added new section 6A which aimed to define the term 'telegraph' to mean telephone and wireless telegraph or telephone.

⁵⁸ Sec.8 (c) of 2003 Act.

⁵⁹ cf. *Times Newspapers Limited and Another v. MGN Limited* [1993] E.M.L.R. 443 CA.

⁶⁰ Debates on 02.10.1908 at p.41. According to the recording of the same page, 1908 Ordinance was an adaptation of the Australian Commonwealth Act relating to Copyright. As per the General European Member " I do not say that there has been much literary or book piracy in the past in Ceylon of any importance; but hardworking local photographers, who get little enough rewards for their labour have suffered persistent and severe loss for a long number of years from the want of such Ordinance." p.61. This shows the recognition of creative contribution of photographers. Interestingly the protection provided by this Ordinance was forward looking when compared to other jurisdictions. Recital 17 Council Directives 93/98/EEC on harmonising the term of protecting of copyright and certain related rights.

⁶¹ Though 1908 Ordinance did not define the term "literary" sec.2 stipulated that the term 'artistic work' includes any painting, drawing, or sculpture and any engraving, etching, print, lithograph, wood cut, photograph, or other work of art produced by any process, mechanical or otherwise, by which impressions or representations of works of art can be taken or multiplied. This definition could have been used by the legislature while drafting the 2003 Act since it is wide enough to apply in the information age.

⁶² Sec.10.

⁶³ Sec.26.

Importantly, the 1908 Ordinance expressly refused copyright or lecturing right in any blasphemous, indecent, seditious, or libellous work or matter.⁶⁴ This is a very significant provision compared to the present copyright law where such a provision is not interpolated.

The Common Law of England relating to proprietary rights in unpublished literary compositions was extended to Sri Lanka by sec.5 of the 1908 Ordinance. This was also a commendable feature, which had become a part of present copyright law.⁶⁵

Under the 1908 Ordinance, registration was a prerequisite for copyright protection.⁶⁶ Section 64 stipulated that the owner of any copyright under the Ordinance or of any interest therein by licence⁶⁷ should not be entitled to bring any action or suit or institute any proceedings for any infringement of the copyright, unless such right or interest had been registered.

Exclusive rights were given to the owner of literary work.⁶⁸ Section 28 stipulated that 'copyright of an artistic work' means 'the exclusive right of the owner of the copyright to reproduce or authorise another person to reproduce the artistic work, or any material

⁶⁴ Sec.4. cf. *AG (UK) v Heinemann Publishers Australia Pty. Ltd* (1988) 165 CLR.30. Also Para 4.11.

⁶⁵ This right was abolished by sec.31 of Copyright Act, 1911. *Infra* Para 4.3.3. Sec.24 of 1911 Act substituted statutory copyright for pre-existing common law copyright. However, sec.24 of the Code (the successor of the 1911 Act) provides that 'rights acquired hereinbefore under the common law or any other law should not affect'. By that time, 'common law' was used in Sri Lanka to refer to Roman Dutch Law. Para 2.8(F)(I).

Table three - Comparison of Common law(CL) and Statutory copyrights

	<i>Unpublished</i>	<i>Published</i>
CL copyright merges with statutory copyrights upon publication Statutory copyright : <i>Donaldson v Beckett</i> , 1 Eng. Rep.837 (H.L.1774)		
1908 Ordinance	CL copyrights principles applied to Sri Lanka (sec.5)	Sec.9, 17, etc
1911 Act	Pre-existing CL copyright abrogated (sec.31)	Substituted with statutory copyrights by sec.24. and schedule I
1912 Ordinance incorporated 1911 as a schedule	As 1911	As 1911

1911 Act in force at least from 1912 and thereafter no common law copyright existed in Sri Lanka. Since all rights are converted into statutory copyrights there was no distinction needed to be made between unpublished and published works except qualification of foreigners for Sri Lanka copyrights under Berne convention.

⁶⁶ There was a time limit for registration. In terms of sec.54 register of literary copyright and register for fine art were to be kept. However, use of this register cannot be ascertained, records being unavailable in Sri Lanka.

⁶⁷ As will be seen the present copyright law does not provide a detailed code for licensing.

⁶⁸ Sec.9(1) provided exclusive rights to make copies, to abridge, to translate books. An exclusive right to deliver lectures was given to authors by sec.10.

part of it, in any manner, form, or size, in any material, or by any process, or for any purpose'. Once more, this is a commendable feature of the 1908 Ordinance because the exclusive right to reproduce a work was more elaborate than the present copyright legislation in Sri Lanka. Hence, it left no lacuna for interpretation of the term 'reproduction of work'. Arguably, even today this provision could be used as a guidance to interpret the new law. Hence, it is submitted, this definition is more suited to the digital era and could have been added to the new copyright law⁶⁹ during promulgation had the drafters been conscious of this.

The author of a lecture was given exclusive right to deliver it, or to authorise its delivery, in public.⁷⁰ All these exclusive rights recognised under the Ordinance were protected until the expiration of a specific period.⁷¹ The 1908 Ordinance recognised the licensing of copyright and under sec.21⁷² and 37⁷³ the owner of copyright work was given the right to assign copyright work to another. There was no section expressly providing for licensing after repealing the 1908 Ordinance until the new copyright law came in to force in 2003.⁷⁴

Section 39 of the 1908 Ordinance provided that if any person infringes any right in respect of copyright in a book, lecturing right in lecture or copyright of an artistic work, the owner of the right infringed may maintain an action. According to sec.50 whoever aids, abets, counsels, procures (by act or omission, directly or indirectly) is deemed to have infringed the copyright. Again, this was another commendable feature of the 1908 Ordinance, which could have become a part of the new copyright law in Sri Lanka to give wider application. Lamentably, the drafters neglected a valuable guidance that could

⁶⁹ The application of new law will be examined in Part B of this Chapter.

⁷⁰ Sec.13(2).

⁷¹ Table four- Duration of Copyrights under Ordinance 1908

<i>Copyright in</i>	<i>Duration</i>
Books	42 years or author's life time + 7 years, whichever is longer
A lecture (lecturing right)	Same as above
Posthumous work	42 years
Joint authorship	42 years or their joint lives and the life of the survivor of them and seven years, whichever last longer
Artistic work	42 years or author's life time and seven years, whichever is longer

⁷² Assignment of copyright of a book, lecture.

⁷³ Assignment of copyright of an artistic work.

⁷⁴ There was compulsory licensing provided by sec.4 of the 1911 Act and sec.16 of the Code. Sec.16 of the 2003 Act refers to licensing by the copyright owner.

have been considered. Had it been included it would have immense impact in the information age, for example in the case of file sharing.⁷⁵

The 1908 Ordinance also recognised fair dealing with literary works: pursuant to sec.23, making an abridgement or translation of a book for private use did not infringe copyright. Likewise, making fair extracts or otherwise, fairly dealing with contents of the book for the purpose of a new work or the criticism, review, or refutation, or in the course of reporting scientific information was allowed. The 1908 Ordinance made no reference to fair use in relation to education.⁷⁶

Even though there are no available cases brought under the 1908 Ordinance, it is obvious from its provisions that the Ordinance could have had great impact on moulding Sri Lankan copyright laws.

4.3.3 The third generation

As discussed,⁷⁷ general principles of English law were introduced into Sri Lanka by direct extension of Imperial Laws and Statutes of the United Kingdom, because of Sri Lanka's position as a colony of Great Britain. Accordingly, the 1911 British Copyright Act came into force in Sri Lanka as a consequence of the extension of the application of Imperial Copyright Act, 1911, to His Majesty's dominions'.⁷⁸ The effect was to repeal all existing laws in relation to copyright in Sri Lanka, with the exception of the Telegram Copyright Ordinance, No.19 of 1898 and to abolish copyright under English common law.

The Governor of Sri Lanka, with the advice and consent of the Legislative Council, enacted Copyright Ordinance, No.20 of 1912 (hereinafter "1912 Ordinance") to expressly repeal the then existing laws and to modify the operation of sec.14 of the British Copyright Act, 1911, in Sri Lanka. Section 3 of the 1912 Ordinance provided penalties for dealing with infringing copies. Though amendments were made to the 1912 Ordinance in 1915,⁷⁹ 1918,⁸⁰ and 1919,⁸¹ no substantial changes were made to copyright

⁷⁵ Para 4.19.

⁷⁶ cf. sec.12 of 2003 Act.

⁷⁷ Para.2.8 (F)(III).

⁷⁸ This had not been "specially" adopted in Sri Lanka. cf. sec.25(1) of the British Copyright Act, 1911.

⁷⁹ The Copyright (Amendment) Ordinance, No.21 of 1915. In terms of sec.2 of the Copyright (Amendment) Ordinance prohibits the importation of copies made out of Sri Lanka, which if made in Sri Lanka would infringe copyright.

⁸⁰ The Copyright (Amendment) Ordinance, No.11 of 1918. The main idea behind this amendment was to add a new subsection to sec.14 of the Copyright Act, 1911. The added subsec.6 stipulated that all

law. Hence, it continued in effect until the Code of Intellectual Property Act, No.52 of 1979 was promulgated in 1979.

4.3.3.(a) Constitutional recognition of Copyrights

More importantly, provisions were made regarding copyrights in the Ceylon Independence Act, 1947 when Sri Lanka became an independent country in 1948.⁸² The second schedule to the Ceylon Independence Act dealt with copyright laws. Section 10 of the said Act provided that

If the Parliament of Ceylon repeals or amends the Copyright Act, 1911, as it forms part of the law of Ceylon, then

(a) except by virtue of sub-paragraph (b) of this paragraph, that Act shall no longer apply in relation to Ceylon as a part of His Majesty's dominions to which the Act extends, so, however, that this provision shall not prejudicially affect any legal rights existing at the time of the repeal or amendment;

(b) Ceylon shall be included in the expression 'self governing dominion' for the purposes of subsection (2) section twenty-five and subsection (3) of section twenty-six of that Act (which relate to reciprocity with self-governing dominions having their own copyright law), and the said subsection (2) shall have effect in relation to Ceylon as if that Act, so far as it remains part of the law of Ceylon, had been passed by the Parliament thereof.

This section is important since it gave constitutional recognition to one of the subjects of intellectual property for the first time in the Sri Lankan history. This state of affairs remained unchanged until the new constitution came into force in 1972 even though the copyright law was changed in the United Kingdom. It is important to examine in brief the application of the 1912 Ordinance since it was applicable for sixty-six years under the Sri Lankan legal system.

4.3.3.(b) Copyright works

Copyright protection was granted to literary, dramatic, musical,⁸³ and artistic works.⁸⁴ Furthermore, the Copyright Act, 1911 also made provision to protect oral works.⁸⁵ In

regulations made under sec.14 should be subject to the approval of the Governor in Executive Council.

⁸¹ The Copyright (Amendment) Ordinance, No.6 of 1919. The objectives were to repeal Copyright (Amendment) Ordinance, No.21 of 1915, application of the Copyright (Amendment) Ordinance, No.11 of 1918 and make provisions for the application of sec.14 of the Copyright Act, 1911. Pursuant to sec.3 of this amendment, Principal Collector of Customs shall perform duties imposed on or given to Commissioners of Customs and Excise in the United Kingdom.

⁸² This is important in another sense that though India and Pakistan gained independence around the same time they did not have any reference to copyright in their Constitutions. It is believed that this may have happened because of the influence of the Ceylon Independence Act drafter Sir Ivor Jennings, who himself was an author.

⁸³ Sec.35.

terms of sec.1(2) derivations were given copyright protection.⁸⁶ All of these works were protected for a limited period.⁸⁷ However, sound recordings, films, broadcasting, cable programmes, typographical arrangements of published editions etc were not subject matters of the Act. Unlike the 1908 Ordinance, no registration was required as a precondition of protection. Section 2 recognised the author's exclusive right to reproduce; perform or deliver to the public, and the right to make derivatives of work.

4.3.3.(c) Infringements and fair use etc.

According to sec.2, any person who, without the consent of the owner of copyright, did anything which infringed the sole right of the owner was deemed to have committed an infringement of copyright. The same section provided for fair use as well. Only one reported case is available under the Copyright Act, 1911. That is *Wijesinghe Mahanamahewa and another v Austin Cantor*.⁸⁸ In this case, the allegation centred upon an infringement of a system of shorthand. However, the court did not look into the many aspects of copyright law in the country while deciding this case.⁸⁹

Apart from the Copyright Act, 1911, there was another important Ordinance, which also protected copyrights in Sri Lanka i.e. the Telecommunications Ordinance, No.50 of 1944.⁹⁰ This Ordinance provided criminal and civil liabilities for anyone who violated copyright in any message by reproducing or publishing, causing to be reproduced or published in the press, disseminating, or causing to be disseminated by other similar means.⁹¹ Lamentably, the Sri Lanka Telecommunications Act, No.25 of 1991⁹² repealed

⁸⁴ Sec.1.

⁸⁵ The similar provision can be seen in the 2003 Act but was not in its predecessor (Code).

⁸⁶ Sec.1(2)(a),(b),(c) and (d).

⁸⁷ Table five- Duration of Copyrights under Ordinance 1912

Copyright in	Duration
Copyright in general	author's life + 50 years
Joint authorship	life time of the author who first dies + 50yrs after his death, or during life time of the author who dies last, whichever period is the longer
Photograph	50 years from the making of the original negative from which the photograph was directly or indirectly derived.
Govt. publications	50 years from the date of first publication of work
Posthumous work	50 years

⁸⁸ [1986] 2 Sri L.R.154, Para 4.9.

⁸⁹ Though this case was decided in 1986 when the Code was in force, the court considered the provision of the Copyright Act, 1911 since the case was filed before the Code come into force.

⁹⁰ As amended by Ordinance, No.07 of 1948, and Amendment Acts, No.10 of 1970, No.17 of 1974, No.67 of 1979.

⁹¹ Sec.33(2) of the Telecommunications Ordinance, No.50 of 1944.

the Telecommunications Ordinance without providing such protection as its predecessor.⁹³ Had the said provision not been deleted, it could have had a great impact upon copyright protection in Sri Lanka in the digital era.

4.4 The fourth generation

As noted,⁹⁴ with the advent of the open economy in Sri Lanka in 1978, an act was enacted, among other things, to revise, consolidate, amend, and embody in the form of a Code the law relating to copyright in 1979.⁹⁵

Hence, the fourth generation of Copyright law evolved in the 1980s. The Code was based on Tunis Model Law on Copyright for developing countries (hereinafter "Model Law"). Chapter II of Part II of the Code dealt with copyright. However, there were some features in the Code, which were not in the Model Law. These features were peculiar to Sri Lanka.⁹⁶ Several amendments were made to the Code⁹⁷ but paradoxically, only one amendment was made in relation to copyright⁹⁸ during its 24 year history though there were many opportunities to introduce novel principles from international instruments such as TRIPS and WIPO Copyright Treaty.

4.4.(1) Salient features of the Code

Under the Code, copyright law protection was not contingent on registration of the work and was given to (a) works of authors⁹⁹ who were nationals of, or had their habitual residence in Sri Lanka, (b) works first published in Sri Lanka,¹⁰⁰ irrespective of the

⁹² As amended by the Sri Lanka Telecommunications (Amendment) Act, No.27 of 1996.

⁹³ Newly enacted Information Communication Technology Act, No.27 of 2003 also does not provide same protection.

⁹⁴ Para 1.1.

⁹⁵ However, it is doubted whether the Code fulfilled its object to consolidate the laws. For the discussion in this regard *Suby v Suby* (1980)2 S.L.R.65 and *M.S. Hebtullabhoy and Company Ltd v Stassen Exports Ltd and another* (1989)1 S.L.R.183.

⁹⁶ Sec.16(1) limitation of right of sound recording and broadcasting.

⁹⁷ Amendment Act, No.30 of 1980 on patent, No.2 of 1983 on Registrar's duty, No.17 of 1990 on appointment of advisory committee, No.13 of 1997 on change of the name of office bearer etc.

⁹⁸ Sec.3 of the Code of Intellectual Property (Amendment) Act, No.40 of 2000. By this amendment Computer programmes were included as protectable subject matter.

⁹⁹ Nowhere in the Code is the term "author" defined. However, sec.17 provides that the ownership of copyright shall be owned in the first instance by the author or the authors who created the work. Hence, it can be inferred from sec.17 an author is the creator of work. Pursuant to subsec.3 of sec.17, an author could be a natural person as well as a legal person.

¹⁰⁰ According to sec.6 the term 'work first published' means works first published in Sri Lanka, or works first published abroad but also published in Sri Lanka within thirty days of the earlier publication.

nationality or residence of their authors, (c) all works which, by virtue of treaties entered into by Sri Lanka are to be protected,¹⁰¹ and (d) works of Sri Lankan folklore.¹⁰²

The Code provided protection for literary, artistic, and scientific work, while not defining those terms, but sec.7(2) listed examples of works.¹⁰³ This list of protected works is non-exhaustive as it uses the expression "...literary, artistic, and scientific works shall include in particular..." Since the list of protected works in sec.7(1) was only illustrative, it is submitted, copyright protection could have extended to other categories of expressions of works. Hence, it is submitted, that, compilations, songs, graphics, tables, diagrams, kinetic expressions, films¹⁰⁴ databases, collages, sound recordings (when sec.7 is read with sec.16¹⁰⁵ and sec.20¹⁰⁶) computer games/ multimedia works, typographical arrangements¹⁰⁷ could have been protected under the Code. Therefore, it can be argued that there was no urgency to amend the Code.

The Code provided protection for derivative works as if they were original works.¹⁰⁸ While protecting folklore in Sri Lanka¹⁰⁹ the works derived from Sri Lankan folklore such as translations, adaptations, arrangements and other transformations were also entitled to protection.¹¹⁰ Though the protection was not given as such for broadcasting, copyright in the subject matter of broadcasts was protected. In terms of sec.9, the laws

¹⁰¹ This would have been effectively used without any new legislation. Para 1.2.6 for Sri Lankan membership of international treaties.

¹⁰² Sec.22. Lamentably, as will be seen, the present law does not contain similar provision to give wide protection to folklore.

¹⁰³ This included sketches; the meaning of sketches can be derived from sec.27 of the Official Secrets Act, No.32 of 1955. Accordingly, "sketch" includes any drawing, map, plan, tracing, blue-print or other print, or painting, or other pictorial representation. Moreover, to comply with international practice, the scope of sec.7 was expanded by an amendment and included 'computer programmes'. Sec.3 of the Amendment Act. Interestingly, according to sec.7(2)(h) protection was given to photographic works (including works expressed by analogous to photography) and hence the still pictures transmitted by television or Internet which produces the same effect as photographs though not fixed in any material form were protected under the Code. This is a commendable feature of the Code when compared to the 2003 Act.

¹⁰⁴ The arguments of *Norowzian v Arks Ltd* (No.2) [2000] F.S.R 363 can be applied in this regard: a film may be protected as a dramatic work.

¹⁰⁵ Limitations on sound recordings.

¹⁰⁶ Provides exclusive right to reproduce or authorise to do the same.

¹⁰⁷ The arguments of *Newspaper Licensing Agency Ltd. v Marks & Spencer plc.* [2003] 1 AC 551.

¹⁰⁸ Sec.8 provided that translations, adaptations, arrangements and other transformation of literary, artistic or scientific works; collection of literary, artistic or scientific works such as encyclopaedias and anthologies which by reason of the selection and arrangement of their contents, constitute intellectual creations; and works derived from Sri Lanka folklore are given copyright protection as original works.

¹⁰⁹ Sec.12 and 22.

¹¹⁰ It is important that import and distribution of copies of Sri Lankan folklore works made abroad and copies of their translations, adaptations, arrangements, or other transformations made abroad were prohibited without the authorisation of the Minister in charge of the subject of culture.

and decision of courts and administrative bodies and official translations thereof¹¹¹ and news of the day published, broadcast, or publicly communicated by any other means were not protected.¹¹²

There was no prerequisite for copyright protection¹¹³ and fixation was not required.¹¹⁴ Section 18(5) of the Code clearly provided that transfer of ownership of the only copy or of one or several copies of a work was not deemed to imply transfer of copyright in the work. As will be seen, this feature is absent from the present law. It is submitted this provision can be used as an aid to interpret new law.

Duration¹¹⁵ of copyright protection under the Code varied according to type of work. In terms of sec.10 the author of a protected work had an exclusive right: to reproduce the work, to make derivative works (such as translation, adaptation, arrangement, or other transformation of the work) to communicate the work to the public by performance, broadcasting, television or any other means.¹¹⁶ Section 6 of the Code defined the term 'reproduction' as making of one or more copies of literary, artistic, or scientific works in any material form including any sound or visual recording.

According to the wording of sec.6 it seems that, the definition of 'reproduction' was a non-exhaustive one as it used the term 'in any material form including...'¹¹⁷ Hence, it can

¹¹¹ Sec.9(a). This is a verbatim of sec.3(i) of Model Law.

¹¹² Sec.9(b). This is a verbatim of sec.3(ii) of Model Law.

¹¹³ It is important to note that the 1908 Ordinance sought formalities in order to grant copyright protection.

¹¹⁴ E.g. Art.2(2) of Berne Convention and sec.3(2) of the United Kingdom Copyright, Designs, and Patent Act,1988. As will be seen no change is made under the new law.

¹¹⁵ Table Six- Duration of Copyrights under Code

<i>Copyrights in</i>	<i>Duration</i>
Literary, artistic and scientific works	Lifetime + 50years
Joint authorship	Lifetime of the last surviving author + 50 years
Anonymous or work published under a pseudonym	Until the expiration of 50 years from the date on which such work was first lawfully published.
Cinematography, audiovisual or radio- phonic	50 years from the date of making. If it is made available to the public with the consent of the author then 50 years from the date of communication.
Photographic or work of applied art	25 years from the making.
Sound recording	50 years from the first publication.
Folklore	Protects without time limitation.

¹¹⁶ As seen, this right is necessarily attached to the freedoms guaranteed by the Constitution.

¹¹⁷ According to sec.12 of the Evidence (Special Provisions) Act, No.14 of 1995 "duplicate" means a counterpart, produced by the same impression as the original, or from the same matrix or by means of photography (including enlargements, reductions, and miniatures), or by electronic, mechanical or chemical reproduction or re-recording, or by other equivalent techniques which accurately reproduces the original. Hence it can be argued that when one reproduces the original, irrespective of the mechanism used, it would amount to reproduction under the Code. However, this would be

be argued by reading sec.6 together with sec.10 that the term 'right to reproduce the work' could be interpreted to include all mechanisms that can be used for reproduction of a 'work' not only in the analogue world but also in the digital world.¹¹⁸ Hence, it is submitted, there was no need to introduce new law in this regard.

Section 10 provided exclusive right to the owner of copyright work to make a translation of work. This was an admirable provision since such an act would give more access to the work in Sri Lanka's multilingual society, which ultimately enhances the Sri Lankan literature. However, if an author of the work failed to make translations to Sinhala or Tamil (the National Languages of the country¹¹⁹) within reasonable time, it could hamper the community's access to work. Hence, it maintained the balance between the parties by providing permission to translate works without the permission from the author¹²⁰ where any works had not been published in Sinhala or Tamil within ten years from its first publication in its original language.¹²¹

Although, on the face of it, the said section of the Code seemed to be a provision that infringes in a flagrant manner the legitimate right of the author, the rationale behind this would probably be found in the realm of public policy. However, considering the moral right of an author of a work, the Code provided that the limitation made on translation should not be affected by the moral right of the author.¹²² Nevertheless, a question arises as to whether it would amount to an infringement of copyright under the Code if a person were to translate a work to any language other than Sinhala or Tamil, for instance Pali or Sanskrit in Sri Lanka.¹²³ It is suggested that the answer would be affirmative. As will be seen,¹²⁴ lamentably, there is no similar provision in the new law.

Before the enactment of the Code, the copyright law in Sri Lanka had always conceived of copyright in purely economic terms. Nevertheless, the situation changed with the

subject to fair use. In *Joe Abeywicrama et al v Torana Video Movies* (Unreported, Commercial High Court, Colombo. Daily News, at <http://www.dailynews.lk/2003/06/23/new25.html> (Accessed: 01.12.2004). The Court issued enjoining order restraining the defendants from reproduction (in the form of videocassette) and selling the tele-drama '*Saki Sanda Eliyas*'.

¹¹⁸ This is examined in part C of this Chapter.

¹¹⁹ The official language in Sri Lanka is Sinhala (Art.18 of the Constitution). The National Languages are Sinhala and Tamil (Art.19 of the Constitution).

¹²⁰ Even without any payment to the author. Sec.15 of the Code.

¹²¹ Sec.15. cf. Art.8 of Berne.

¹²² Sec.15.

¹²³ Most Buddhist scriptures are written in these languages.

¹²⁴ Part B of this Chapter.

Code, enforced in 1980, recognizing the moral rights of the author of a protected work.¹²⁵ This was a commendable feature of the Code.

Moreover, sec.14 allowed any broadcasting or television organisation to make an ephemeral recording for the purpose of its own broadcast or television broadcast.¹²⁶ This was an important provision, which gave no liability to the broadcasting/ television organisation. Lamentably, this feature is not in the 2003 Act. Hence, it closes a door, which might have been used to resolve problems of transmission over the Internet in the digital age.¹²⁷

4.4.(2) Compulsory licensing

The Code invoked limitations for sound recording and broadcasting rights. Since these sections were not in the Model Law, it seems that these provisions were based on repealed mechanical recording provisions in UK Law. According to sec.16

when the owner of the copyright of musical works has already authorised a person to make a sound recording of the performance of the work, any other person may, if he can not agree with the owner to make sound recording of a performance of the same work, make a new sound recording of a performance of the said work without the authorisation of the owner...¹²⁸

However, this was qualified by two other factors. Firstly, this applied without prejudice to the moral right of the author. Secondly, the other person must pay the owner an equitable remuneration fixed by the Secretary to the Ministry of the Minister in charge of the subject of culture.¹²⁹ There are no similar provisions in the present law.

Furthermore, public broadcasting or television organisations operating in and from Sri Lanka were entitled to broadcast or televise without the permission of owner of copyright when they could not agree with the owner of copyright in any work, which the organisation wishes to transmit on the condition on which the work may be broadcast or

¹²⁵ Sec.11.

¹²⁶ Furthermore, some other conditions must be satisfied. Namely the ephemeral recording must be made by the broadcasting organisation themselves by means of their own facilities, the ephemeral recording must be used for its own broadcasting or television, the recording must contain only the work that the organisation is authorised to broadcast or televise. However, these copies should be destroyed within six months of the making thereof or within any longer period agreed to by the author. When the recording has an exceptional documentary character, one copy can be kept in official archive.

¹²⁷ Part B for further discussion.

¹²⁸ Sec.16(1).

¹²⁹ Again, this section also recognises the impact of musical work on the Sri Lankan culture.

televised.¹³⁰ However, this was again subject to payment of equitable remuneration fixed by the previously mentioned Secretary and without prejudice to the moral rights of the author of works.¹³¹ There is no similar provision in the present copyright law.

It seems that all the above provisions, namely sec.16(1) and (2), represented some form of compulsory licensing¹³² It could be argued that these two provisions indirectly challenged the basic philosophy of copyrights. On the other hand, it could be argued that the objective of these provisions was to achieve the balance between the author's right and the access to works by the public.

4.4.(3) Fair use and infringement

While the Code did not provide a definition for the term 'infringement of copyright', it expressly mentioned the relief for an infringement of copyright.¹³³ Section 13 of the Code provided a number of circumstances in which the use of work would amount to "fair use" such as use of work for private and domestic purposes, government use, use for purposes such as criticism, comment,¹³⁴ news reporting, teaching, scholarship and research, artistic work on public display.¹³⁵ In contrast to the new Copyright law, no distinctions were maintained between face-to-face teaching and distance teaching under the Code. Hence, it was commendable since distance education plays an important role in a country where only 14.13% of eligible candidates are admitted to the conventional Universities.¹³⁶

According to sec.21 any person who was aggrieved by an infringement of copyright had two remedies: namely, they could seek an injunction to prohibit the infringer from

¹³⁰ In terms of this section, it seems that private broadcasting such as cable networks, educational broadcasting etc., or television organisations are not entitled to this benefit.

¹³¹ cf. The Educational Recording Agency Licensing Scheme in the United Kingdom at <http://www.ers.org.uk/> (Accessed: 01.12.2004).

¹³² cf. Art.11^{bis}(2) and 13 of the Berne.

¹³³ Sec.21 stipulated that any person who infringes any of the right protected under the Code be prohibited by injunction from continuing such infringement and be liable in damage.

¹³⁴ Since freedom of expression is not absolute according to Art.15(2) it can be argued even though a criticism or a comment may fall within the 'fair use' in terms of copyright provisions but may violate the restriction made by Art.15(2) of the Constitution. E.g. respect for others rights and freedoms of others. Para 4.1.

¹³⁵ Subsec.(a) to (f) of sec.13.

¹³⁶ University Grant Commission of Sri Lanka at <http://www.ugc.ac.lk/statistics.html> (Accessed: 01.12.2004).

continuing such infringement and could claim for damages.¹³⁷ This was in contrast to the present law under which injunctions are discretionary.¹³⁸

PART B

Application of present laws: An overview

4.5 Introduction

A new law was introduced by the Sri Lankan legislature to repeal the Code and hence the Intellectual Property Act, No.36 of 2003 (hereinafter “2003 Act” or “the Act”) came in to force in September 2003. This is the fifth generation of copyright law in Sri Lanka.

The preamble to 2003 Act states, *inter alia*, that the aim of the Act is to provide law for an efficient procedure for registration, control, and administration.¹³⁹ No rationale was indicated while proposing the Bill to Parliament.¹⁴⁰ Unfortunately, the second and third readings of the Bill appear to offer no indication on this point either.¹⁴¹ The ulterior motive of 2003 Act in providing for efficient registration to industrial property was not relevant to copyright protection in Sri Lanka.¹⁴² It is submitted that the logical consequence of the structure and wording of the preamble to 2003 Act amply demonstrate that the new law did not result from the challenges arising from the development of new technologies in the field of copyright law.

A somewhat detailed appraisal of application of the present copyright law in Sri Lanka is required for three reasons. Firstly, it is important to understand the scope of the present copyright law in order to conduct an evaluation and assessment of its efficacy. Secondly, such an examination would allow conclusions to be drawn as to whether the present law

¹³⁷ Sec.144(1). Sec.144(2) for powers of the Magistrate in this regard.

¹³⁸ Sec.22(1) of 2003 Act. In the present law, the aggrieved party cannot seek an injunction as a statutory right along with other remedies such as delivery up, such remedy is governed by the discretion of the Court. Ch.XLVIII of Civil Procedure Code, No.2 of 1889 as amended by No.38 of 1998. Also Para 4.13.

¹³⁹ Preamble is as follows “An act to provide for the law relating to intellectual property and for an efficient procedure for the registration, control, and administration thereof: to amend the Customs Ordinance (Ch.235) and the High Court of the Provinces (Special) Provisions Act, No.10 of 1996; and to provide for matters connected therewith or incidental thereto.”

¹⁴⁰ The Hansard Report on 21.05.2003,p.2361 of No.26, vol.147.

¹⁴¹ The Hansard Report on 18.06.2003,p.3417-3423 of No.13, vol.148 and on 25.07.2003,p.1423-1464 of No.8, vol.149.

¹⁴² Promulgation of this act was controversial due to many reasons. Firstly, some provisions of the draft Bill were against fundamental rights and hence the Supreme Court has directed Parliament to pass the law with two-third majority unless it is changed. Secondly, the opposition party reported and registered with the speaker its dissatisfaction with the manner in which the committee stage of Intellectual Property Bill was passed in the parliament. Sunday Times on 03.08.2003 at <http://www.sundaytimes.lk/030803/index.html> (Accessed: 01.12.2004).

is capable of addressing those novel issues arising from the digital media as well as future needs of the information age. Thirdly, if it is found that there are no express provisions dealing with such issues, then one need to explore whether the Sri Lankan judiciary is suitably equipped to stretch the boundaries of existing copyright law, in their duty to discharge their constitutional obligation in the court of law.¹⁴³

4.5.1 Scope of the protection

Chapter I of Part II of the Act deals with copyright. In order for a work to qualify for copyright protection in Sri Lanka, it has to fit into one of the three categories stipulated in sec.26 of the Act, namely:

- (a) Works of authors who are nationals of, or have their habitual residence in Sri Lanka.
- (b) Works first published in Sri Lanka, works first published in another country and hereupon published in Sri Lanka, within thirty days from such publication, irrespective of the nationality or residence of their authors.
- (c) Works that are protected in Sri Lanka by virtue of, and in accordance with, an international convention or any agreement to which Sri Lanka is a party.¹⁴⁴

The application of category (c) of sec.26 is questionable. It suggests that when a copyright treaty is signed, it automatically becomes part of the body of domestic law. However, as discussed in Chapter One¹⁴⁵ this situation conflicts with the normal practice of Sri Lanka since the mere fact of being party to international convention is not sufficient to extend the field of application to national law. It requires specific domestic legislation. Although the Sri Lankan courts have not had an opportunity to interpret this section to date, it is submitted that this section may be strong enough to incorporate the copyright law based on an international treaty based into the domestic law without further legislation.¹⁴⁶

¹⁴³ This will be dealt with in the Part C of this Chapter.

¹⁴⁴ This section is similar to sec.22 of the Code. However, folklore has been removed from the scope of the application and less protection is given to it under sec.6 of the Act. Para 4.7.

¹⁴⁵ Para 1.2.6.

¹⁴⁶ cf. *Bulankulama and Others v Secretary, Ministry of Industrial Development and Others (Eppawala case)* (2000) 3 S.L.L.R.243 at pp.274-275 where Amarasinghe J observed that laws contained in the international treaty can be part of domestic law 'if they have been either expressly enacted or become a part of the domestic law by adoption by the superior Courts of record and by the Supreme Court in particular, in their decisions.'

4.5.2 Works

Departing from the tradition of previous legislation, the Act makes a distinction between copyright and related rights.¹⁴⁷ Following the tradition of previous copyright legislations in Sri Lanka, the Act does not exhaustively indicate what constitutes a literary, artistic, and scientific work, but instead provides an inclusive list of works. Classification in this regard is needed for two reasons.

Firstly, classification as to whether a work belongs to a particular category of work is one of the most important aspects that demarcate the boundaries of the protection available to work under the Act. The works that are listed in the Act fall into more than one category and theoretically, it is conceivable to protect one subject matter by two categories. Since the duration of the protection afforded by the Act depends on the category of work, when a work belongs to more than one category the Court has to decide whether to give protection under both categories or not.

Secondly, such classification also strikes the balance between the rights of the owner of a work and the rights of the users since it demarcates the boundaries of fair use of a work. Hence, the following diagram suggested by the researcher for the clarification of this study is needed for future analysis of the application of present law.

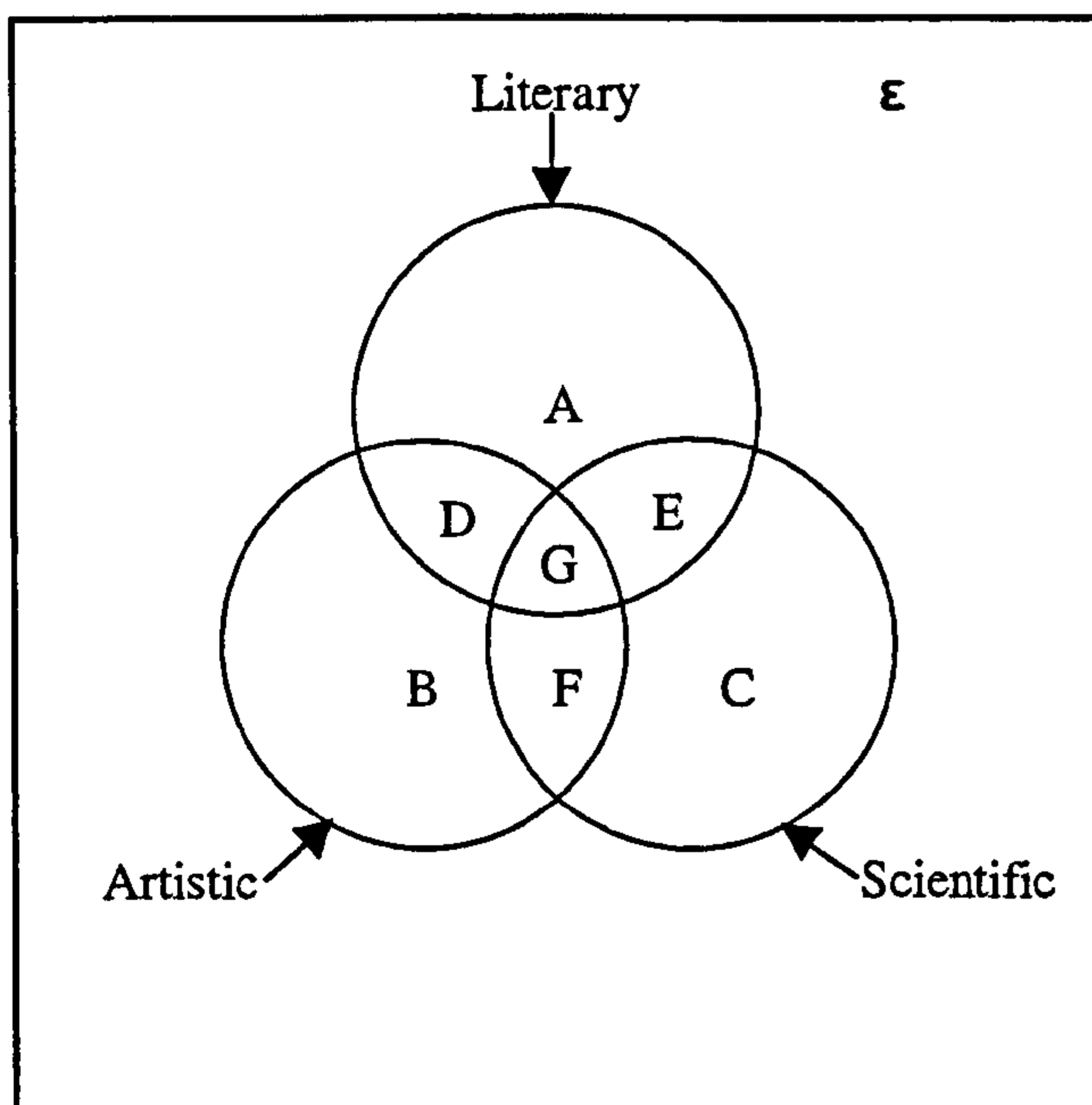


Diagram three - Copyright protection under the Act

¹⁴⁷ Ch.I of the Act deals with Copyright whereas Ch.II deals with related rights.

Key for the diagram:

E - Works eligible for copyright protection. (Definitions are open-ended).

A -Subject matters covered under literary works (books, pamphlets, articles, computer programs¹⁴⁸ and other writings,¹⁴⁹ speeches, lectures, address, sermons, and other oral works,¹⁵⁰ expression of folklore¹⁵¹).

B- Subject matters covered under artistic works (works of drawing, painting, sculpture, engravings, lithography, tapestry, and other works of fine arts,¹⁵² architecture, illustrations, maps, plans, sketches,¹⁵³ and three-dimensional works relating to geography, topography or science,¹⁵⁴ works of applied art¹⁵⁵).

C- Subject matters covered under scientific works (photographic works¹⁵⁶).

D- Subject matters covered under both literary and artistic works (musical works, with or without accompanying words,¹⁵⁷ choreographic works, pantomimes, dramatic works, dramatic-musical work, and other works created for stage production¹⁵⁸ expression of folklore¹⁵⁹).

E- Subject matters covered under both scientific and literary works (computer programme,¹⁶⁰ expression of folklore¹⁶¹).

F- Subject matters covered under both scientific and artistic works (photographic works,¹⁶² for instance digital photographs and expression of folklore¹⁶³).

G- Subject matters covered under literary, artistic, and scientific works (audiovisual works,¹⁶⁴ expression of folklore- for instance production of folk arts¹⁶⁵).

¹⁴⁸ *Soft System (Pvt) Ltd v Visualtech Microsystems (Pvt) Ltd.* (unreported) Unfortunately the first ever software piracy case in Sri Lankan copyright law history (came under the Code) was dismissed by the Commercial High Court due to the absence of the plaintiff's witness. Daily News at <http://www.dailynews.lk/2003/06/16/bus05.html> (Accessed: 01.12.2004).

¹⁴⁹ Sec.6(1)(a).

¹⁵⁰ Sec.6(1)(b).

¹⁵¹ Sec.6(1)(d).

¹⁵² Sec.6(1)(h).

¹⁵³ The meaning of sketches can be derived from sec.27 of the Official Secrets Act, No.32 of 1955 which stipulates that the term "sketch" include any drawing, map, plan, tracing, blue-print or other print, or painting, or other pictorial representation.

¹⁵⁴ Sec.6(1)(l).

¹⁵⁵ Sec.6(1)(k).

¹⁵⁶ Sec.6(1)(j).

¹⁵⁷ Sec.6(1)(e).

¹⁵⁸ Sec.6(1)(c).

¹⁵⁹ Sec.6(1)(d).

¹⁶⁰ Sec.6(1)(a).

¹⁶¹ Sec.6(1)(d).

¹⁶² Sec.6(1)(j).

¹⁶³ Sec.6(1)(d).

Section 6(1) of the Act gives the enumeration of works protected. The list illustrates works included in the definition, and is non-limitative and non-exhaustive as it uses the expression "...literary, artistic, and scientific works..., including and in particular..." This does not mean that only those works listed in sec.6(1) are entitled to protection. Nevertheless, in principle, it constitutes the actual or potential subject matters of copyright protection. In contrast to the United Kingdom's "pigeon-hole" approach,¹⁶⁶ as observed by intellectual property law scholars, the Sri Lankan approach gives a broader opportunity to accommodate new forms of expression, which emerges in the digital era as a consequence of the convergence of technologies.

Since the list of protected works in sec.6(1) is only illustrative, there is no prohibition or limitation made by the Act to extend the copyright protection to other categories of expressions of works. Hence, it is submitted that the following works can be protected under the present copyright law in Sri Lanka provided such works fulfil the basic requirements such as originality etc. Collages/sculpture/placement art—under artistic works,¹⁶⁷ compilations—under literary works;¹⁶⁸ computer games/multimedia works—under artistic and scientific works,¹⁶⁹ databases—under literary works¹⁷⁰ and maybe scientific work when they use scientific methods,¹⁷¹ diagrams—under artistic work,¹⁷² films—dramatic and cinematographic work,¹⁷³ graphics—under literary.¹⁷⁴

Moreover, kinetic expressions—under artistic and scientific works, maps— literary and artistic work,¹⁷⁵ songs—the words/lyrics as literary works and music as artistic work,¹⁷⁶

¹⁶⁴ Sec.7(2)(f). Penal Code (Amendment) Act, No.22 of 1995 inserted sec.286A(2) to define the term "films" to include any form of video recording.

¹⁶⁵ Sec.6(1)(d).

¹⁶⁶ E.g. Jeremy Phillips and Alison Firth, *Introduction to Intellectual Property Law*, 4th (edn) (London: Butterworths, 2001),138. Here the authors observed the disadvantages of such pigeonhole approach.

¹⁶⁷ *Creation Records Ltd v. News Groups* [1994] E.M.L.R 444.

¹⁶⁸ The arguments of *Ladbroke (Football) Ltd. v William Hill (Football) Ltd.*[1964] 1 W.L.R. 273 would be persuasive.

¹⁶⁹ *Re Copyright Protection for Computer Games* (Case 4St RR 64/92) [1994] E.C.C. 354.

¹⁷⁰ *Waterlow Directories Ltd. v Reed Information Services Ltd* [1992] F.S.R 409, *British Horseracing Broad Ltd v William Hill Organisation Ltd (No.2)*[2001] 2 C.M.L.R 12,[2001] R.P.C 31.

¹⁷¹ However, sec.7(1)(a) of the Act provide protection for database under derivative works. Para 4.6.2.

¹⁷² *Anacon Corporation Limited and Another v. Environmental Research Technology Limited and Another* [1994] F.S.R.659, *Aubrey Max Sandman v. Panasonic UK Limited and Another* [1998] F.S.R 651, *Interlego AG v. Tyco Industries Inc.* [1988] R.P.C. 343.

¹⁷³ The arguments of *Norowzian v Arks Ltd (No.2)* [2000] F.S.R 363 can be applied in this regard.

¹⁷⁴ *British Leyland Motors Corpn. Ltd and another v Armstrong Patents Co.Ltd.* [1983] F.S.R 50 (Ch.D) and also *Macmillan Publishers Ltd v Thomas Reed* [1993] F.S.R 455, *Anacon v Environmental Research* (above n.172)

¹⁷⁵ *Geographia Ltd. v Penguin Books Ltd* [1985] F.S.R 208.

¹⁷⁶ *Redwood Music Ltd. v B. Feldman & Co. Ltd.* [1980] All ER 817 where two separate copyrights of song is considered and *Chappell & Co Ltd v Redwood Music Ltd* [1981] R.P.C 337, HL.

tables-under literary work¹⁷⁷ sound recording-when sec.6 read with sec.18,¹⁷⁸ and sec.19¹⁷⁹ it is clear that sound recordings are protected as scientific and artistic work under the Act.

4.5.2.(a) Literary works

In order to qualify for copyright protection under sec.6 of the Act the subject matter must be original intellectual creation in the literary, artistic, or scientific domain. While providing protection for books, articles, other writings, the Act protects oral works such as lectures, addresses, sermons under sec.6(1)(b). This is a commendable feature of the new legislation since it categorically includes oral works by referring to “other oral works.”¹⁸⁰ Moreover, this protection is not qualified by requiring the work to be recorded before copyright actually subsists.

Under sec.6(1) of the Act, computer programs are protected. The Act defines a computer programme as ‘a set of instructions expressed in words, acts, schemes or in any other form, which is capable, when incorporated in a medium that a computer can read, of causing the computer to perform or achieve a particular task or result’. Hence, it seems that, whether expressed in source code or object code, computer programmes are protected by the Act.¹⁸¹

4.5.2.(b) Scientific works

The Act contains no definition for the term ‘scientific work’ nevertheless the Act provides, among other things, that authors of scientific works shall be entitled to protect their works. There is no judicial guidance as to what constitute scientific work.

4.5.2.(c) Artistic works

The Act does not categorically separate works as to what constitutes an artistic work. However, as seen in the above diagram, artistic works can be separated from works listed in sec.6(1) of the Act.

¹⁷⁷ *Johnstone v Bernard Jones Publications Ltd* [1938] 1Ch.599.

¹⁷⁸ Exclusive right of producers of sound recording.

¹⁷⁹ Equitable remuneration for the use of sound recording.

¹⁸⁰ This was a reflection of sec.10 of the 1908 Ordinance and the Copyright Act of 1911 and sec.7(2) of the Code.

¹⁸¹ Sec.5.

Furthermore, the Act does not define the term 'dramatic work'¹⁸² though it protects dramatic works, dramatic-musical works, pantomimes, choreographic works and other works *created for stage production*. (Emphasis added). The works 'created for stage production' requires further attention. It seems that those works created not for the stage but for other places such as '*kamatha*' (a place specially made to remove paddy from its plant), temple, and other religious places etc is not protected. Moreover, the question arises as to the protection of street drama, which is a part of Sri Lankan culture.¹⁸³ In the face of this section, it seems that there is a denial of intellectual property rights to support the right to free expression of thoughts through these media.

As seen, Art.14(1) of the Constitution does not qualify its protection.¹⁸⁴ Hence, it protects the freedom in choosing the form as well as the substance of the ideas to be conveyed. That is to say, Art.14(1) covers both the message and the medium under the freedom of speech and expression including publication. Hence, it is submitted, subordinate legislation cannot contradict this position guaranteed by the Constitution.

Moreover, Art.12(1) of the Constitution guarantees the right to equality.¹⁸⁵ This means the right to equal treatment when similar circumstances are prevailing allowing no discrimination between two persons who are similarly circumstanced. Art.12(1) guarantees protection not only from the executive, but also from the legislature. As observed by Amarasinghe J in *Abeywardene v. Inspector General of Police and others*

... the law should be equal and should be equally administered, the like being treated alike, and that, subject to this, all persons should be entitled to pursue their happiness and enjoy their property, and have equal access to the Courts in Sri Lanka for the protection of their persons and property.¹⁸⁶

Hence, owners of dramatic works deserve to protection irrespective of whether their works are made for stage play or not. Therefore, it is submitted that the said provision of

¹⁸² An insight to the meaning can be taken from the judgment of the Court of Appeal in the United Kingdom in *Norowzian v. Arks Ltd.*(No.2) [2000] F.S.R 363, as per Nourse LJ at 367 "Dramatic work is work of action, with or without words or music, which is capable of being performed before an audience".

¹⁸³ Street drama has been used for ages in Sri Lanka as a mode of expression. In the year 2000, the then government used street drama to convey the message of the proposed Constitution throughout the country.

¹⁸⁴ Art.14(1) of the Constitution which stipulates that "every citizen is entitled to (a) the freedom of speech and expression including publication" and Art.15(1) which declares that Art.14(1)(a) shall be subject to such restrictions as may be prescribed by law in the interests of racial and religious harmony or in relation to parliamentary privilege, contempt of court, defamation or incitement to an offence.

¹⁸⁵ Art.12(1) stipulates that 'All persons are equal before the law and are entitled to the equal protection of the law'.

¹⁸⁶ [1991] 2 Sri L.R 349 at 355-356.

the Act contradicts the fundamental rights guaranteed under Art.12(1) of the Constitution.

Importantly, Art.27 of the Constitution of Sri Lanka declares directive principles of state policy, which shall guide, among other things, the President and the Cabinet of Ministers in the enactment of laws. One such directive principle is that the 'state shall assist the development of the cultures and the languages of the people'.¹⁸⁷ Accordingly, there should be no discrimination between the works not meant for stage, and those works made for stage for the development of culture. It is obvious from consideration of sec.6(1)(c) of the 2003 Act along with Art.27(10) of the Constitution, that the former provision violates the Constitutional directives.

In addition, the above said provision of the Act contradicts universally accepted norms embodied in Art.27(2) of the UDHR,¹⁸⁸ which recognizes that 'everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author'. No attention has been paid to this matter by the Sri Lankan legislators while promulgating the new Act.

Even though the new law has been challenged on different grounds in its Bill stage, no attempt was made to draw attention to these grounds at the Supreme Court of Sri Lanka. There is no case law in Sri Lanka in this regard to date.

Furthermore, sec.6 of the Act, by restricting protection only to dramatic works created for stage production, contradict the Public Performance Ordinance, No.7 of 1912.¹⁸⁹ Section 2 of the Public Performance Ordinance stipulates that public performance include 'every public dramatic representation.' It is submitted that sec.6 of the Act is inconsistent with the rights of performers generally protected under sec.17 of the Act. Until now, the judiciary or academia has given no opinion in this regard.

The Act does not define the term "dramatic work," but the Entertainment Tax Ordinance, No.12 of 1946, as amended,¹⁹⁰ gives useful guidance in this regard. Section 16 of the Entertainment Tax Ordinance stipulates that "stage play" include any tragedy, comedy, farce, opera, burletta, interlude, melodrama, pantomime, or other entertainment

¹⁸⁷ Art.27(10).

¹⁸⁸ Sri Lanka is signatory to UDHR.

¹⁸⁹ As amended by Ordinance, No.7 of 1919 and Act No.23 of 1951, No.40 of 1961, No.26 of 1964, No.11 of 1969.

of the stage or any part thereof. Hence, it is submitted, in the light of these sections the subject area of play/ drama can be determined.

The Act protects musical works under the category of artistic work, irrespective of whether or not they are accompanied by words. Section 17(a) has given a performer¹⁹¹ the right to broadcast or other communication to the public of his performance, fixation of his unfixed performances and the reproduction of a fixation of his performances. Moreover, a Broadcasting Organization is also given the rights of re-broadcasting, communication to the public, fixation and the reproduction of its broadcasts.¹⁹²

Photographic works are protected under “artistic work.” In terms of sec.27(i) of the Official Secrets Act,¹⁹³ the term ‘photograph’ includes a photographic film, plate, any developed or processed negative, and any printed or other pictorial representation or diagram produced in whole or part by photographic means. Though 2003 Act defines “photographic work” as ‘the recording of light or other radiation on any medium on which an image is produced, irrespective of the technique...by which such recording is made,’ it could have taken some features of the definition in the Official Secrets Act in order to give wider meaning.

4.6 Derivative works

4.6.1 Translations, adaptation etc

The Act provides copyright protection for derivative works. Pursuant to sec.7(a) of the Act, translations, adaptations, arrangements and other transformations of works, are protected. Equally, in terms of sec.7(b) collections of works such as encyclopaedias and anthologies are protected. However, collections are protected only when original by reason of the selection, coordination, or arrangement of their contents.

¹⁹⁰ Amended by Ordinance No.43 of 1947, No.2 of 1952, No.45 of 1961, and Act No.37 of 1984. This is an ordinance, which enables the local authorities to impose and levy a tax on payments for admission to public entertainments held within their administrative areas.

¹⁹¹ Sec.5 defines “performers.” Lamentably, actors are not included to the definition. This indirectly violates the Constitutional norms by denying the freedom of expression and freedom to engage in occupation, profession. In contrast one could argue that the language of sec.5 i.e. ‘other persons who ...deliver,...or otherwise perform’ is sufficient to include actors. The wording is confined only to ‘literary and artistic works’ and hence it is submitted that this section be interpreted using sec.6(1) of 2003 Act and Art. 2 of Berne so as to include dramatic works.

¹⁹² Sec.20(1).

¹⁹³ No.32 of 1955. This is an act to restrict access to official secrets and secret documents and to prevent unauthorized disclosure thereof.

4.6.2 Database

Databases are eligible for copyright protections under the category of derivative work.¹⁹⁴ Section 7(1)(b) confers protection on ‘collections of works and collections of mere data (*data bases*)’ (emphasis added). The Act does not otherwise define the term ‘database’ and there is no Sri Lankan case law or other relevant Sri Lanka authority. Hence, it is appropriate to examine whether the present provision is appropriate to protect databases in the era of technological convergence.

In order for a database to be protected under the Act, it would have to meet only one condition: original by reason of the selection, co-ordination or arrangement of contents.¹⁹⁵ A question arises as to whether Sri Lanka requires a different standard than the UK for the protection of databases. This seems a logical consequence from the structure and wording of sec.7.

Firstly, wording of the Act does not include ‘compilations’ of data but only collections. Secondly, the Act does not require that data be ‘individually accessible’.¹⁹⁶ Thirdly, the Act is silent on the protection of collections of material other than works or “mere data.” For instance non-stage drama. Non-stage drama is not work and is not mere data either. Hence, it seems that although when a person exercises skill, labour, judgment, or intellectual creativity in creating a collection or preparing a compendium of street drama, such compendium would not be protected under the Act since it is not a collections of ‘works’. Moreover, although works derived from Sri Lankan folklore such as translations, adaptations etc. are entitled to protection under 2003 Act, it is silent on protection of collection of folklore.

As a matter of policy, such collections should get copyright protection. Nevertheless, rejection of protection to those collections not only excludes intellectual and economic effort necessary for creating the prosperity of street drama and folklore in Sri Lanka but

¹⁹⁴ Sec.7(1)(a).

¹⁹⁵ Table Seven- Comparison of protection of collection/database

	Berne	WCT	TRIPs	UK Copyright, Designs and Patents Act 1988, (CDPA)		Sri Lanka
Provision	Art.2(5)	Art.5	Art.10(2)	Sec.3A	Sec.3	Sec.7(b)
Selection (S) or/ and arrangement (A)	S <u>and</u> A	S <u>or</u> A	S <u>or</u> A	S <u>or</u> A	original compilations	S <u>or</u> A

This comparison shows that sec.7(b) complies with Berne, TRIPs, WCT, and comparable with sec.3A of CPDA. Arguably, in more generously, it comparable with non-database compilations provisions of sec.3 of CPDA.

also infringes constitutionally guaranteed fundamental rights such as right to equally¹⁹⁷ and right to livelihood.¹⁹⁸

It seems that the contents of a database, unlike in EU law, are not protected against unfair extraction or utilization of content (including repeated and systematic extraction or re-utilisation of insubstantial parts). One could argue that unfair competition provisions in Part VI of the 2003 Act would enable to address the issue of unfair extraction or re-utilisation. However, there are no elaborative provisions as with the case of other areas such as trade marks etc.

Hence, it seems that the new provision made for databases raises a number of questions, so far unanswered, which might conflict with the practice of other jurisdictions. This means that decisions from other jurisdictions will be of less persuasion or assistance to Sri Lanka courts.¹⁹⁹

¹⁹⁶ Unlike sec.3A of CDPA.

¹⁹⁷ Art.12(1) and 14(1)(g).

¹⁹⁸ Art.14(1)(g). Further, Para 4.5.2.(c) for street drama.

¹⁹⁹ Table Eight - Comparative table of database protection

	TRIPs	WCT	Sri Lanka	Directives 96/9/EC and CDPA	CDPA(UK)	Comments on Sri Lankan law
	Art.10(2)	Art.5	Sec.7(1)(b)	Sec.3A	Sec.3	
compilation or collection	compilations	compilations	collections	collections	compilations	-
subject matter	data, other materials	data, other material (singular)	works, mere data	independent works data, other materials	other than a data base	Sri Lankan law does not provide protection for intermediate category e.g. street drama ¹⁹⁹
other requirements	-	-	-	arranged in a systematic or methodical way, and individually accessible by electronic or other means.	-	-

4.6.2.(a) Intellectual creativity vs. originality of derivative works

Intellectual creativity or originality could be a prerequisite in order to protect collections of works. Section 8(1)(b) of Code stipulated that a collection of works must display 'intellectual creativity' in the selection and arrangement of pre-existing works incorporated in or utilised for, the making of such a work before it can receive copyright protection by applying the originality test.²⁰⁰ In contrast, sec.7(2) of 2003 Act provides protection for collection when such collections are 'original' by reason of the selection, co-ordination, or arrangement of their content. Hence, as far as derivative works are concerned it would seem that new law has come down from intellectual creativity, a higher standard (i.e. where originality is conferred when the collection of works manifest the exercise of intellectual skills) to a somewhat lower standard of originality (i.e. where credit is given, to the author of the collection of works, regardless of the fact that that effort may not have the application of any significant intellectual skills).

Protection of all derivative works is without prejudice to any protection of a pre-existing work incorporated in, or utilized for the making of derivative works.²⁰¹ Hence, the consent of the author of the original works must be obtained in order to create a derivative work. Nevertheless, until now there is no case law or academic opinion in Sri Lanka in this regard.

The Antiquities Ordinance, No.9 of 1940,²⁰² and Cultural Property Act, No.73 of 1988 are relevant in this regard. Pursuant to sec.42 of the Antiquities Ordinance, a person can make drawings, and take photograph etc of antiquities,²⁰³ but cannot sell those works

originality/ intellectual creations	selection arrangement constitute intellectual creations	selection arrangement constitute intellectual creations	original by reason of selection, coordination, or arrangement	original by reason of selection or arrangement and the author's own intellectual creation	original (author's own intellectual creation)	does not deals with intellectual creativity
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²⁰⁰ cf. Art.10.2 of TRIPS. Both the Code and TRIPS use '...constitute intellectual creations'.

²⁰¹ Sec.7(2).

²⁰² This is an ordinance to provide for the better preservation of the antiquities of Sri Lanka and amended by the Ordinance, No.2 of 1955, No.22 of 1955 and Antiquities (Amendment) Act, No.24 of 1998.

²⁰³ *Antiquesportfolio.com plc. v Rodney Fitch & Co. Ltd* [2001] F.S.R 345 for copyright protection for a photograph of an antique piece of furniture.

without the consent of the person in possession of the antiquity.²⁰⁴ Section 24(1) of the Cultural Property Act provides law for the same.²⁰⁵ Interestingly, it seems that the owner of this intangible right is the possessor of the tangible object. This seems to be an extension of the exclusive rights in relation to cultural property. There is no provision in relation to architecture and ancient monuments, which could have come under the same Act if the same logic was applied.

4.7 Folklore

Folklore is an important aspect of life especially in a country like Sri Lanka where a multicultural society has existed for centuries. Hence, the recognition and protection of folklore will enhance the rich cultural heritage derived from such a diverse society. The Act defines the term 'expression of folklore' as

'group oriented and tradition based creation of groups or individuals reflecting the expectation of the community as an adequate expression of its cultural and social identity, its standards and values as transmitted orally, by imitation or by other means'.²⁰⁶

Though previous legislation provided protection for folklore without any restriction,²⁰⁷ the Act expressly does not provide protection for expression of folklore per se, but for the 'expressions of folklore' that are apt for stage production.²⁰⁸ Hence, it is submitted that, a grave injustice has been done to the protection of Sri Lankan folklore.

More importantly the new Act has implicitly undermined the initiatives taken by the Sri Lankan government by establishing the Institute of Indigenous Medicine under the Ministry of Medicine to protect indigenous medicine including folk healing traditions such as '*shanthi karma*', '*yantra and mantra*' (which are mostly based on rituals) while

²⁰⁴ Sec.42 stipulates that "the Archaeological Commissioner or any officer authorized by him in writing for the purpose may at all reasonable times inspect any antiquity in the possession of any person ; and it shall be the duty of every such person to permit such inspection and further to give to the Archaeological Commissioner or such officer all reasonable facilities to study such antiquity and to make drawings, photographs or reproductions thereof by the making of casts or by any other means : Provided that no such drawings, photographs or reproductions shall be sold without the consent of the person in possession of the antiquity.

²⁰⁵ Sec.24(1):"The Archaeological Commissioner or any officer authorized by him in writing for the purpose may, at all reasonable times, inspect any cultural property in the, possession of any person and it shall be the duty of every such person to permit such inspection and to give to the Archaeological Commissioner or such officer all reasonable facilities to study such cultural property and to make drawings, photographs or reproductions thereof by the making of casts or by any other means: Provided that no such drawings, photographs or reproductions shall be sold without the consent of the person in possession of the cultural property : Provided further that, in the making of casts the prior consent of the person in possession of the cultural property shall be obtained."

²⁰⁶ Sec.5.

²⁰⁷ Sec.12 of the Code.

defining the term folklore in sec.6 of the Act. This seems to be another departure from the international definition of folklore.²⁰⁹

Lamentably, unlike the previous law,²¹⁰ the Act does not provide moral rights of expression of folklore but only provides economic rights, which are to be exercised by a competent authority. The logical outcome of this protection, it is submitted, would allow anyone to infringe moral rights, specially by distortion, mutilation, and other modification, of the folklore in Sri Lanka. It is submitted, this lacuna in the law is a serious impediment to the protection of folklore in Sri Lanka.²¹¹ Hence, the present law should be amended to give powers to competent authority as the custodian of folklore who exercise economic rights on behalf of the society/community to protect the public use of distorted or mutilated folklore creations which is violation of 'collective moral rights' or 'communal moral right' of the community concerned as was the case under sec.12(1) of the Code.

Though derivative works of folklore are entitled to copyright protection,²¹² the Act prohibits making of derivative works of folklore outside of their traditional customary context.²¹³

The Act recognises some exceptions to the economic rights of folklore.²¹⁴ Ironically, the Act deprives the Sri Lanka community from using the expression of folklore for distance teaching/learning. Again, this is a negative aspect of the new law, which is supposed to be applicable in the information age.²¹⁵

It is important that the previous law provided that there was a prohibition on the import and distribution of copies of works of Sri Lankan folklore made abroad and copies of translations, adaptations, arrangements, or other transformations of works of Sri Lankan

²⁰⁸ Sec.6(1)(c). Para 4.5.2.(c) and 4.6.2. which exhaustively dealt with this point.

²⁰⁹ Sec.2 of the WIPO-UNESCO Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and other Prejudicial Actions, 1982 (the "Model Provisions") explicitly mentions, among other things, that the "expression by action" (of the human body) such as artistic forms or rituals. Model Provisions at <http://www.wipo.int/tk/en/documents/pdf/1982-folklore-model-provisions.pdf> (Accessed: 01.12.2004).

²¹⁰ Sec.12(1) of the Code.

²¹¹ The researcher is aware of the fact that much folklore are being used to make derivative works while distorting the original work, but none of the authorities have taken any action to protect moral rights of author of folklore from the day of copyright protection given to folklore in Sri Lanka

²¹² Sec.24(1)(c).

²¹³ Sec.24(1)(c).

²¹⁴ Sec.24(2).

²¹⁵ Para 4.12.

folklore made abroad without the authorisation of the Minister in charge of Culture.²¹⁶ In theory, this seems a correct manner in which to protect exploitation of Sri Lankan folklore, and so was commendable.²¹⁷ Since 2003 Act does not provide for the same, there is a lacuna in the present law.

4.8 Works excluded from copyright protection

Section 8 of the Act contains three provisions, which explicitly exclude certain kinds of subject matter from copyright protection.

Firstly, ideas, procedures, systems, methods of operation etc are not given copyright protection.²¹⁸ This seems to be the first ever documentation in Sri Lanka which stipulates that copyright purports not to protect ideas or information as such, only the expression of ideas or information.

Secondly, official texts of a legislative, administrative, and legal nature and official translations thereof are not protected under the Act. Thirdly, news of the day published, broadcast, or publicly communicated by any other means for instance posters, handbills etc are also not protected.²¹⁹

Although news of the day is not given copyright protection under the Act, it is obvious that many methods are being used to communicate the news in the competitive media industry. In order to do so probably cinematographic works, photographs etc can be more effectively used. It can be argued that, these works are not excluded from the protection and eligible for protection but only the news items, they contain.

Furthermore, informative publications published by governmental authorities, such as annual reports, circulars etc are protected. For instance, the annual report issued by the Central Bank of Sri Lanka explains overall performance of finance which required creativity, is eligible for copyright protection under the Act.²²⁰

4.9 Requirements for protection

Like most Berne Convention countries, no registration or deposit procedure is required for copyright protection in Sri Lanka. Furthermore, it seems that the Act follows the

²¹⁶ Sec.12(1) of the Code.

²¹⁷ Nevertheless, in practice it is doubtful whether the concerned authorities such as customs are aware of this provision of law.

²¹⁸ Sec.8(a), following TRIPs Art.9(2).

²¹⁹ c.f. Art.10^{bis} of Berne.

²²⁰ Annual Reports at http://www.lanka.net/centralbank/Ar_index.html (Accessed: 01.12.2004).

tradition of Berne Convention, in which Art.2.2 makes it clear that national laws need not require fixation in some material form as a general condition for protection.

In terms of sec.6 of the Act, copyright protection is given to literary, artistic, and scientific works. All works falling under sec.6 of the Act are protected irrespective of their mode or form of expression, as well as of their content, quality, and merit.²²¹ The purpose for which the works were created is also immaterial when a decision is taken on its eligibility for copyright protection. Thus, it seems that when a work is original it is protected under the Act. Although, 1911 Act scheduled to 1912 Ordinance referred to copyright 'subsisting', neither the Code nor the Act mentioned when copyrights are subsists. Hence, it can be argued that copyright subsists automatically in a work if and when the conditions for subsistence are met.

However, there is no statutory definition of 'originality' in relation to copyright in Sri Lanka.²²² As was discussed above²²³ the Court had an opportunity to examine the meaning of originality in *Wijesinghe Mahanamahewa and another v Austin Cantor*.²²⁴

4.10 Duration of economic rights and moral rights

Duration of copyright protection varies according to the types of work.²²⁵ In history, no limitation was made on works of folklore,²²⁶ but there is a lacuna in the present law since

²²¹ Sec.6(2).

²²² The concept of originality in copyright seems to be novel to Sri Lankan copyright law until 1912; the requirement of originality did not appear in the 1908 Ordinance. Sec.1 of the Imperial Copyright Act, 1911.

²²³ Para 4.3.3(c).

²²⁴ [1986]2 Sri.L.R.154. Here the Plaintiff alleged infringement of a system of Sinhala shorthand devised by him from Gregg system. While looking the meaning of 'originality' with the help of *University of London Press Ltd v Universal Tutorial Press Ltd* [1916] 2 Ch 601 the Court held that even there had been copying, Defendant's system could not form a substantial part of plaintiff's work, owing to its lack of originality because he had copied it from Gregg. It is submitted though the court considered *Holland v Van Damm* (Oscar Wilde case) [1939-45] MacG Cop Cas 69 in this regard.

²²⁵ Table Nine - Duration of Copyrights under the Act

<i>Copyrights in</i>	<i>Duration of economic and moral right</i>
Works in general	Life time + 70 years
Joint authorship	Life of the last surviving author and 70 years from his death
Collective work	70 years from the date on which the work was first published, if it is not published then 70 years of the making the work
Anonymous or pseudonyms	70 years from the date on which the work was first published
Applied art	25 years from date of the making the work
Broadcasting organisation	From the moment broadcasting takes place until the end of 50 th calendar year.
Performers	From the performance until 50 th calendar year
Sound recording	From the date of publication until 50 th calendar year , if not published from the date of fixation until 50 th calendar year

it does not expressly states that folklore is protected indefinitely. It is submitted that clear words would be required to change the term of protection of folklore.

4.10.(a) Economic rights

Section 9 of the Act provides that the author of a protected work has the exclusive right to carry out or to authorise the following acts in relation to the work. (a) reproduction of the work, (b) translation of the work, (c) adaptation, arrangement, or other transformation of the work, (d) the public distribution of the original and each copy of the work by sale, rental, export or otherwise, (e) rental of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer programme, a data base or a musical work in the form of notation, irrespective of the ownership of the original or copy concerned, (f) importation of copies of the work, (g) public display of the original or a copy of the work, (h) public performance of the work, (g) broadcasting of the work, (i) other communication to the public of the work.

The same provision of the Act provides that the author of a protected work has exclusive rights to authorise any other person to do the above-mentioned acts. These rights will be dealt in Part C of this Chapter.

4.10.(b) Moral rights

In terms of sec.10 of the Act, the author of a protected work has the right to claim authorship of his work in connection with exercising economic rights and the right to object to and seek relief in connection with, any distortion, mutilation, other modification, or derogation of protected work. Similarly, the author of a protected work has the right to object to and seek relief in connection with any other derogatory action, which would be prejudicial to his honour or reputation. Recognising the inalienable character of moral rights of an author, sec.10(2) of the Act provides that the moral right shall not be transferable *inter vivos* but upon the author's death as a testamentary disposition or by operation of law.

4.11 Limitations of the protection

The 1908 Ordinance provided that 'no copyright shall subsist in any blasphemous indecent, seditious, or libellous work or matter'.²²⁷ The Copyright Act 1911 did not

²²⁶ Sec.12(2) of the Code.

²²⁷ Sec.4. *George v Velupillai* 08 NLR.67; *De Bruin v Dharmabanu* 32 N.L.R 88(obscene book) and *Perera v Kitto* 61N.L.R.439 (obscene pamphlets).

expressly provide a similar provision to that of 1908. However, the English Court held that libellous, immoral, obscene, or irreligious works are not entitled to copyright protection.²²⁸ The Code was also silent in this regard. The 2003 Act does not qualify protection of copyright by considerations of public morality.

Nevertheless, the Penal Code of Sri Lanka²²⁹ imposes penalties for possession of obscene books etc. for sale or public exhibition or singing of obscene songs.²³⁰ The Obscene Publication Ordinance, No.4 of 1927 as amended by Obscene Publication (Amendment) Act, No.22 of 1988 provides penalties for obscene publication in many media.²³¹ Furthermore, anyone who writes, prints, publishes, sells etc. any profane writing would be punishable under the Profane Publication Act, No.41 of 1958.

Nowhere does the 2003 Act mentions software (computer programmes), which has produced harmful effects to other software or hardware such as computer viruses. Hence, the absurd conclusion would be that such software is protected as a literary work under Sri Lankan copyright law.

There is no provision of law, which restricts or denies copyright protection for a work, which involves public deception. Moreover Sri Lankan law is not clear as to whether a work which itself is a result of an infringement of existing works would be protected under the copyright law.²³² Hence, it is submitted that copyright protection would be refined in Sri Lanka as in the United Kingdom e.g. for misuse or deceptive works.

4.12 Infringements and fair use

An act would amount to an infringement of copyright only when one violates the protected rights of an author. It is clear from reading sec.5 with sec.9(1) that a person infringes copyright in protected subject matter under two situations. Firstly, if he himself exercises one of the exclusive rights of an author in relation to the whole work or a substantial part thereof, without the consent of the owner of copyright. Secondly, if he authorises any other person to exercise one of the exclusive rights of the copyright

²²⁸ *Baschet v London Illustrated Standard Co.* [1900] 1 Ch.73, *Glyn v Weston Feature Film Co., Ltd.*, [1916] 1 Ch.261, (no copyright) *A.G v Guardian Newspaper (No2)* [1988] All ER 545 (if copyright subsists, not enforceable). R.G. Howell, "Copyright and Obscenity: Should Copyright Regulate Content?" *IPJ* 8(1994), 139.

²²⁹ No.2 of 1883.

²³⁰ Sec.285 and 286.

²³¹ Sec.2.

²³² *Redwood Music v. Chapell & Co. Ltd* [1982] R.P.C.109 (music publishers who had unwittingly infringed the copyright in a song held entitled to a liberal allowance for their skill and labour) and also *ZYX Music GmbH v King* [1995]; [1995] 3 All ER1.

owner, in relation to the whole work or a substantial part thereof, without the consent of the owner of copyright.²³³

In this regard 'a substantial part thereof'(sec.9(2)) entails attention. As it is accepted, the concept of 'a substantial part' is not determined merely by consideration of quantity but quality as well. Indeed the word 'substantial' was not used in the Code ('a part thereof'). It is submitted that taking an insubstantial part would not have constituted an infringement under the Code.²³⁴ Since there is no judicial opinion in Sri Lanka in this regard, experiences of other jurisdictions are persuasive.²³⁵

Question: Does Sri Lanka recognise the notion of implied licensing? It is a matter of contract law. In Sri Lanka English law and Roman Dutch law govern the law of contracts. Though the implied licence doctrine is a figure of contract law (essentially an estoppel doctrine), sec.16 does not support such approach. Hence, it seems that it does not fit into present copyright law. However, in order to minimise the hardships that arise when adhered to the present law, it is submitted the Court should interpret the present copyright law in line with other jurisdictions.²³⁶

Though sec.11 and 12 of 2003 Act deal with fair use, it does not distinguish between published and unpublished works.²³⁷ Whether a work is published or unpublished should be a crucial element to determine the application of fair use under the Act. Application of 'fair use' for unpublished work is not clear under the 2003 Act.²³⁸

²³³ The argument of *CBS Songs Ltd v Amstrad Consumer Electronics plc* (1988) R.P.C 567 would be guided. Also *Microsoft Corporation v ComputerFuture Distribution Limited* [1998] ETMR 597. In this case, the defendant was found liable under CDPA for having authorised others to copy Microsoft software. Warren R Shiell, "Viral Online Copyright Infringement in the United States and the United Kingdom: The End of Music or Secondary Copyright Liability? Part 1 and 2," *Ent. L.R.* 15, 3 & 4 (2004), 63-71 & 107-13.

²³⁴ Sec.10. cf. *Spelling Goldberg Productions Inc. v BPC Publishing Ltd* 1981] R.P.C 283.

²³⁵ E.g. in *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1WLR 273, 'the question whether [a infringer] has copied a substantial part depends much more on the quality than on the quantity of what he has taken' at 469 as per Lord Reid. In *Warwick Film Production Ltd v Eisinger* [1963] 2 All ER 292 and [1969] 1Ch 508, Plowman J observed that those portions that have been copied were unoriginal parts and hence there was no infringement. *Designers Guild Ltd. v Russell Williams(Textiles)Ltd.*[2000] F.S.R.121. In this case, a fabric design that employed an impressionistic style was found to infringe copyright in another fabric design, which used the same style and the same design elements of stripes and flowers and held that the designs were so similar that a substantial part of the first design had been copied by the second. Hence, it seems that it is up to the court to consider on the facts and the degree to determine what constitutes 'a substantial part'.

²³⁶ E.g. *Brighton v. Jones* [2004] E.M.L.R.26.

²³⁷ Sec.12.

²³⁸ E.g. *British Oxygen Co. v. Liquid Air Ltd.*, [1925] Ch. 383; *Beloff v Pressdram Ltd* [1973] 1 All ER 241.

More importantly, sec.12(4) provides law for the utilisation of works for educational purposes. Nevertheless, sec.12(4)(b) delimits the application of reprographic reproduction only for face-to-face teaching. This is a serious threat for access and dissemination of knowledge. Sri Lanka, being a developing country with a distributed population, should have access to important knowledge-based products as the country seeks to bring education to all, facilitate research, improve competitiveness, protect cultural expressions, and reduce poverty.

It is therefore submitted that 2003 Act deeply compromises the principles of “fair use” in relation to education in Sri Lanka by restricting it only to face-to-face teaching and hence negates the proper balance between the rights of the author and the public user, in a country where distance learning is an integral part of the education.²³⁹ Moreover, this provision ultimately challenges the validity of the directive principles of state policy embodied in the Constitution where the state is pledged to assure to all persons the right to universal and equal access to education at all levels.²⁴⁰ Hence, legislative amendment is required.

Under the present provisions of the Act, it is not clear whether reverse engineering, especially in the area of computer software, would amount to fair use. Section 12(7) only provides that it is not an infringement of the author’s right to adapt a computer programme by the lawful owner of a copy of that programme, when such adaptation is necessary for the use of the computer programme.²⁴¹ Hence, this would allow anyone to render a computer programme compatible with a particular computer. Likewise, it allows correction of program design errors that are obvious and prevent the intended purpose of a work. It is too early to see the impact of this provision on the Sri Lankan software industry.

Finally, four factors are to be considered in order to determine whether an act would amount to fair use, as opposed to an infringement of copyright: namely, purpose and character of the use, the nature of copyrighted work, the amount and substantiality of the portion used, the effect of the use for the potential market, or value of copyright.²⁴²

²³⁹ Dearth of sufficiently equipped libraries throughout the country forced use of reprographic reproduction of published articles, other short works, or short extracts of work in the process of dissemination of knowledge through distance teaching in Sri Lanka.

²⁴⁰ Art.27(2)(h).

²⁴¹ Sec.12(7)(a)(i).

²⁴² Sec.11(2).

Since the language of this provision is identical to that of the U.S. law,²⁴³ it is submitted that as far as fair use is concerned, US case law would be more persuasive than other jurisdictions.

4.13 Remedies for infringement of copyright

Section 22(1) refers to cause of action while providing right to basic damages i.e. profit, loss, royalty and injunction. Section 22(2) provides discretionary remedies such as (a) injunction, seizure,²⁴⁴ (b) damages for consequences of loss (c) destruction of copies etc. (d) disposal or surrender of (e) order to prevent further infringement. Moreover, sec.22(2)(f) and 22(3) grant powers to Director General to decide infringement matters. Section 22(g) provides criminal liabilities.²⁴⁵ All proceedings other than the proceedings required to be taken in terms of the Act in the Magistrate Court should now be instituted in the High Court established under Art.154P of the Constitution (Commercial High Court in Colombo in the case of Western Provision). This creates some hardship to litigants outside the Western Province due to the geographical conditions.

In terms of sec.23, it is an infringement of copyright when one abuses the technical means, which are meant to provide copy protection.²⁴⁶ Hence, manufacture or importation for sale, rental of any device or means specially designed or adapted to circumvent copy protection or copy management device is rendered criminal.²⁴⁷ Moreover, this is extended to the circumventing of devices or means intended to prevent or restrict reproduction of a work or to impair the quality of copies made.²⁴⁸

This provision causes an unresolved problem between two contradictory provisions of the 2003 Act. Computer programs are protected as literary works under sec.6. Nevertheless, there are some computer programs, used to decode copyright protection of other forms of works. For instance, a program such as DeSCC (Content Scrambling

²⁴³ Sec.107 of US Copyright Act, 1976.

²⁴⁴ Interestingly the defendant's profits may be considered in calculating damages.

²⁴⁵ According to sec.178(1) Magistrate courts have jurisdiction over criminal procedure. Hence it provides that any person who wilfully infringes any of the rights protected under the copyright law shall be guilty of an offence and liable on conviction after a trial to a fine not exceeding Rs. 5,00,000 which is equal to Pound Sterling 2500 (as per the exchange rate on 01.12.2004) or to imprisonment for a term not exceeding 10 years or both.

²⁴⁶ However, it can be argued that application of such measures could lead to inhibition of freedom of expression, which includes right to information. Moreover, such measures would challenge the balance of fair use. Since this protection applies without any time limitation, it may prevent 'work' entering the public domain on expiry of rights.

²⁴⁷ However, the Act is silent about situation where technological protection measures prevent fair use of the work by the public. Moreover, the situation is not clear whether government can break such measures in the interest of national security.

System Decryption). The present law *per se* does not deny copyright protection for such programmes. However, it is submitted there should be explicit provisions in the Act for the non-enforcement of copyright protection.²⁴⁹

Moreover, act of circumvention itself is not prohibited by the Act. It only prohibits dealing with circumvention devices but not with services.²⁵⁰ Hence, it is submitted that, 2003 Act allows the following acts: removal or alteration of copy protection, supply of services circumvention, and making a circumvention device available online (broadcast or communicates to the public), promotion of circumvention (for instance free distribution of circumventing software) and exhibition of a circumvention device in public.

Chapter XXXII of Part VI of 2003 Act deals with unfair competition and undisclosed information. Nevertheless, sec.160(1)(b) of the Chapter XXXII stipulates, among other things, that 'the provisions of Part VI applies independently and in addition to the other provisions of the Act protecting literary, scientific and artistic works'. Part VI of the 2003 Act does not make any provision in relation to copyrights and also the Hansard report on debate of the Bill does not reveal any intention behind the inclusion of such provision. Although the wording of the Act express that those provision do apply independently, there is no guidance on how they apply to literary and artistic work (contrast details given in sec.160(1)(b)(2)-(5) for trade marks and 160(1)(b)(2)(6) for undisclosed information). Hence, it remains unclear as to the applicability of provisions of Part VI for the protection of copyright in Sri Lanka.

PART C

Application of copyright law in the information age

4.14 Introduction

The traditional notion of copyright is largely based on the form of the work. Consequently, the protection varies according to the form of expression. Since the proliferation of digital technology and information communication technology opens doorways not only to the expression of thoughts in different forms²⁵¹ but also to speed

²⁴⁸ Sec.23(1)(i) of the Act.

²⁴⁹ Para 4.11.

²⁵⁰ Except those situations where it would results in infringing copies being made.

²⁵¹ For instance combination of forms, i.e. convergence of forms and new forms.

and reliable dissemination of works over the globe, it has created unforeseen issues within the realm of copyright in Sri Lanka as everywhere. Accommodating laws to new technologies and expression of thoughts in different forms can be achieved in two ways (a) by creating new laws or/and (b) by expanding the boundaries of existing law (e.g. interpret the existing definitions). Hence, it is apt to examine the Sri Lankan approach in the information age.

Many concepts with regard to expressions of thought are deeply rooted in parts of the Constitution of Sri Lanka.²⁵² For instance, the Constitution guarantees the freedom of expression of thoughts including publication as a fundamental right. This reflects not only the notion of natural justice but also human rights, which justify copyright protection.

Moreover, the Constitution of Sri Lanka guarantees the freedom to promote culture and language.²⁵³ This is also a commendable feature, which recognizes the inseparable nexus between the freedom of thoughts/ expression and culture of the country. Nevertheless, unlike the US Constitution,²⁵⁴ the Sri Lankan Constitution does not refer to utilitarian considerations to justify the protection given to expression of thoughts, publication, and culture.

As mentioned,²⁵⁵ the legality of all legislations derives from the Constitution since it is the sole source of law of the country. All legislation promulgated by the Parliament of Sri Lanka must have legitimate grounding in the Constitution. Therefore, every piece of legislation should satisfy the “consistency” test with the Constitution in order to become valid law. It is submitted that each piece of legislation validly passed by the Parliament of Sri Lanka must be assumed to reflect the Constitutional norms. This would equally apply to Copyright legislation. Hence, it could be argued that the copyright law of Sri Lanka should act as a promoter of the Constitutional norms by providing necessary protection to the expression of thoughts, which would appear in different forms from time to time. It is therefore vitally important to examine the application of the present Sri Lankan Copyright law in the information age while considering the above-mentioned environment.

²⁵² Art.14(1)(f),27and 28.

²⁵³ Art.14(1)(f) provides that “every citizen is entitled to the freedom by himself or in association with others to enjoy and promote his own culture and to use his own language.”

²⁵⁴ The rationale of copyright protection is reflected in the Art.1, sec.8 of the Constitution of United States of America, which stipulates that “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries”.

²⁵⁵ Para 2.10.

It is felt that two important issues should be kept in mind while examining whether the present Copyright law in Sri Lanka is sufficient to protect expression of thoughts and publication enshrined in the Constitution.

Firstly, a subject matter of Copyright law of another one country would not automatically be a subject matter of Sri Lankan Copyright law. Hence, an act of infringement in another country would not necessarily be an act of infringement of copyright law in Sri Lanka.²⁵⁶

Secondly, the jurisdiction of a country is limited to certain territory. Copyrights protected in Sri Lanka are not necessarily protected under the copyright law of another country unless multilateral or bilateral treaties are made for the same effect.²⁵⁷ Consequently, Sri Lankan courts are not empowered to address the novel issues arising globally unless they are initiated in Sri Lankan territory.²⁵⁸

It is the main objective of this part of the Chapter to examine in detail those issues arising in the digital age in order to evaluate the efficacy of the present copyright law in Sri Lanka. This endeavour is necessary for two reasons.

Firstly, it is necessary to ascertain whether the present copyright law in Sri Lanka is wide enough for the better protection of copyrights in the digital age when it is interpreted in accordance with the theoretical formulae proposed in the Second Chapter of this study.²⁵⁹

Secondly, it is necessary to ascertain whether Sri Lankan copyright law should be amended, only insofar as it does not comply with the interpretative methodology, for better protection in the digital media.

Above all, the issue that is to be addressed at this juncture is to identify which types of act, taking place via digital media, would amount to the exercise of exclusive rights of an author of a work within the domestic jurisdiction.

4.15 Methodology to be applied

In theory, it is poor practice to have excessively frequent changes in the realm of intellectual property law, especially in a country like Sri Lanka where little or a dearth of

²⁵⁶ Extraterritorial matters including enforcement of judgement in another country are beyond this study.

²⁵⁷ E.g. Sri Lanka and the USA signed a Bilateral Agreement for the Protection of Intellectual Property Rights in 1991. Para 1.2.6 for Sri Lanka's membership to International treaties.

²⁵⁸ As it is already mentioned, the second reason is out of the purview of this study.

guidance is available in case law. It is submitted that the framework suggested in Chapter Two would help the judges in Sri Lanka to apply law to new situations and hence avoid the need for constant change to the intellectual property law to comply with Sri Lanka's international obligations.

As seen,²⁶⁰ freedom of expression, the most basic cause that is necessary to create works that are eligible for copyright protection, is guaranteed by the present Constitution of Sri Lanka. As seen²⁶¹ the copyright law in Sri Lanka has tacitly acquired an eminent position among other subject matter of intellectual property due to this Constitutional guarantee. Protection of copyright has constitutional patronage and thereby compels the judiciary to abide by the constitutional norms.

Hence, it is submitted that since the constitutional provisions provide a valid and consistent ground to interpret the present law, the Sri Lankan courts should explore the possibility of applying constitutional norms for which the judges are bound by the law of the country. Moreover, as will be seen the applicability of principles of Buddhism and Roman Dutch Law to interpret the present law and thereby bridge the gap of the application of present law.

Moreover, as seen in Chapter Two, the intention of a person is the crucial element to determine whether one has breached the second precepts of *panca sīla* (refrain from taking what is not given). Hence, as shown in chapter three it is submitted that an important implication of applying such formulae along with sec.9(1) of the 2003 Act is that it would permit an avoidance of absurd results which might otherwise be given by the application of literal interpretation of some provisions of 2003 Act in the information age. For instance, RAM copy.²⁶²

Furthermore, as seen in Para 4.13 the application of Chapter XXXII of Part VI of 2003 Act, which deals among other things with unfair competition. However, there is no guidance on how they apply to literary and artistic work. Hence, reference should be made to Roman Dutch Law norms as guide to interpretation. Applying principles of *lex Aquilia* as applied by the South African court could fill this interpretative lacuna.²⁶³ Such

²⁵⁹ Part D of Chapter Two.

²⁶⁰ Para 4.1.

²⁶¹ Para 4.1.

²⁶² Para 4.19.(1).

²⁶³ E.g *Matthews v Young* 1922 AD 492, *Geary and Son (Pty) Ltd v Gove* 1964 SA 1 432(A), *Atlas Organic Fertilizers (Pty) Ltd v. Pikkewyn Gwhano (Pty) Ltd* 1981 (2) SA 173(T) 186 where the Court recognised action *legis Aquiliae* as the basis for protection against unfair competition. Also

approach would allow Sri Lankan courts not only to find what unfair competition means in the context of work but also to develop new forms of protection against unfair competition within the ambit of *lex Aquilia* even in the absence of a direct precedent in case law in Sri Lanka. Hence, it is submitted that Sri Lankan courts should follow the South African case law (as it is done in other area of law- for instance other case in Delict) in order to give effective protection to intellectual works in Sri Lanka. If it provides no solution, then the judiciary has to call for a new legislation.

4.16 Potential copyright conflicts in the information age

Obviously, copyright issues in the digital environment arise in the same way as in the real world; when one infringes copyright by exercising the exclusive rights of the copyright's owners. However, this can vary from country to country depending on the declared exclusive rights of an author and fair use provisions under the national law.

Exploitation of copyrights in the information age can be divided into two categories. Firstly, issues not specific to e-commerce but due to the development of digital technology. For instance, it is clear that when a work is digitised it can easily be manipulated to create a variety of works and it is easy and inexpensive to create an unlimited number of perfect number of copies of such works. Likewise, digitisation eases the ability to upload to the Internet and can thereby make works available to an unlimited number of users across the globe. Secondly, the issues that are necessarily related to e-commerce²⁶⁴ e.g. online trading of pirated music.

In order to ascertain when and under what circumstances infringement of copyright occurs, a brief examination of the works on the Internet, which may have copyright protection, is required. Such examination will shed light on whether the present copyright law of Sri Lanka, as it is, suffices to address such issues.

Union Wine Ltd v E. Snell and Co Ltd 1990(2) SA 189(c) at 200-202, *Aetiology Today CC t/a Somerset School v Van Aswegen* 1992 (1) SA 807(W) at 816-20.

²⁶⁴ Electronic commerce is a broad concept that covers any commercial transaction that is effected via electronic means and would include such means as facsimiles, telex, electronic data interchange (EDI), Internet, and telephone. For the purpose of this study, the term is limited to those trade and commercial transactions involving computer to computer communications whether utilising an open or closed network. Webopedia at http://www.webopedia.com/TERM/e/electronic_commerce.html (Accessed: 01.12.2004).

4.17 Works on the Internet and copyright

It is understood that the Internet consists of individual machines²⁶⁵ and the communication infrastructure that connects them.²⁶⁶ One of the most important protocols of the Internet is the World Wide Web,²⁶⁷ which consists of webpages or computer data files. Webpages contain text,²⁶⁸ graphics (e.g. logos), diagrams, layout,²⁶⁹ animated pictures, moving images, banners, sound, music, and photographs etc., laid out using HTML code.²⁷⁰ Most of these works²⁷¹ are eligible for copyright protection when each one satisfies the requirements of copyright law.

There is no specific provision in the Sri Lankan copyright law dealing with works on the Internet or exploitation of works on the Internet. It can be argued that applying the existing copyright laws in Sri Lanka by analogy to the copyright issues raised in the Internet would be a logical and sound way of addressing those issues.²⁷² However, in this analogising process, the Constitutional mandate and the rationale of copyright protection should be kept in mind along with applicability of the theoretical framework suggested in Chapter Two of the present study.

4.17.(a) Text and verbal contents

Text and verbal content of a website are eligible for copyright protection. For instance, Art.9 of the TRIPS Agreement makes it obligatory for its members to comply with Art.1 to 21 of the Berne Convention. Article 1(4) of the WIPO Copyright Treaty (hereinafter referred to as WCT) make it obligatory for its members to comply with Art.1 to 21 and

²⁶⁵ These are called 'Host' and 'routers'. Hosts (sometimes called "end system") are the machines intended for running user programs (i.e. application programs). Hosts are connected by communication net. Routers (sometimes called packets switching nodes, intermediate system, and data switching exchangers) are specialised computers used to connect two or more transmission lines, which receive and forward packets of data. Andrew S. Tanenbaum., *Computer Networks*, 3rd (edn) (Prentice-Hall International Inc.,1996),11-12.

²⁶⁶ Ibid p.229.

²⁶⁷ Other protocols used in the Internet are File Transfer Protocol (FTP), Usenet, instant massaging etc. Webopedia at <http://www.webopedia.com/TERM/p/protocol.html> (Accessed: 27.10.2004).

²⁶⁸ Titles of webpages and hypertext links as literary works: *Exxon Corporation v Exxon Insurance Consultants International Limited* [1981] 3 All E R 241 the court was reluctant to accept that mere titles or slogans embody the minimal element of skill, judgement and labour to constitute originality for copyright purpose. However *Shetland Times Limited v Dr Jonathan Wills et al* [1997] F.S.R 604 Lord Hamilton accepted that a headline of 'eight or so words .put together for the purpose of imparting information' might be protected by copyright.

²⁶⁹ Layout of a webpage attracts copyright protection if sufficiently original. *Ladbroke (Football) Limited v William Hill (Football)Ltd* [1964] 1WLR 273 for protection of layout as literary work.

²⁷⁰ Webpages are written in a language called HTML (HyperText Mark-up Language). This is a language for describing how documents are to be formatted. Webopedia at <http://www.webopedia.com/TERM/H/HTML.html> (Accessed: 01.12.2004).

²⁷¹ Even aspect of webpages such as mark-up and design alone are eligible for copyright.

Appendix of the Berne Convention. Furthermore, the preamble to the WCT recognises, among other things, the need for a clarification of the interpretation of certain existing rules in order to provide adequate solutions to the question raised by new technological developments. Hence, it can be argued that those text and verbal contents on the web are eligible for copyright protection under the International copyright instruments.

As seen,²⁷³ in terms of sec.6(1) literary works are protected.²⁷⁴ The Act does not refer to the digital format of those literary works. Moreover, there is no fixation requirement under the Act. Hence, a pertinent question arises as to whether one can argue that sec.5²⁷⁵ and sec.9 of the 2003 Act²⁷⁶ are broad enough to cover literary works in digital form. It is submitted that the cumulative effect of the above provisions can be interpreted to confer protection to those works in digital format. Hence, works on the web such as articles, books, e-mails, and other verbal content etc., are protected under Sri Lanka law.²⁷⁷

4.17.(b) Computer programs

Computer programs are protected as literary works. For instance, Art.10 of the TRIPS agreement²⁷⁸ and Art.4 of the WCT provide protection for computer programs as literary works whatever may be the mode or form of their expression.

As seen,²⁷⁹ under Sri Lankan copyright law computer programs are protected as literary works provided they are original. The Act defines a computer programme as 'a set of instructions expressed in words, codes, schemes or in any other form, which is capable, when incorporated in a medium that a computer can read, of causing the computer to perform or achieve a particular task or result'.²⁸⁰ This definition seems to be wide enough to cover different forms of expression. In other words, this definition covers the source code as well as the object code. Hence, by analogising this provision of the Act to the web, works that consist of computer programme, it can be argued that, the present

²⁷² E.g. the Agreed Statement Concerning the WIPO Copyright Treaty related to Art.1(4).

²⁷³ Para 4.5.2(a).

²⁷⁴ The protection afforded from this section of the Code is similar to that of Art.2 of the Berne and Art.9 of the TRIPS.

²⁷⁵ Where reproduction is defined as to cover 'any material form'.

²⁷⁶ Where reproduction rights of the author has given without limiting to the analog world.

²⁷⁷ cf. the Agreed Statement Concerning the WIPO Copyright Treaty related to Art.1(4).

²⁷⁸ Art.10 stipulates that computer programs is to be protected as literary works under the Berne Convention, irrespective of whether it is a source code or object code.

²⁷⁹ Para 4.5.2.

²⁸⁰ Sec.5.

sec.6(1)(a) of the Act can be applied to protect web works which include computer programmes.

4.17.(c) Databases

Websites can contain works of databases as well. Databases are protected under the TRIPS Agreement²⁸¹ but this does not provide guidance on the nature of the database. Art.5 of the WCT provides protection for databases.²⁸²

Section 7(1)(c) of the Act expressly provides protection for collections of works, and collection of data, which by reason of the selection and arrangement of their content constitute intellectual creations. Moreover, though the term database is used in some other pieces of legislation in Sri Lanka none of those legislations has defined the term 'database'.²⁸³ There is no provision of the Act to provide *sui generis* rights in database.²⁸⁴ There is no judicial opinion or opinion of academia in Sri Lanka with regard to these matters.

However, it can be argued that Sri Lankan courts will be guided by the understanding of the meaning of database in other jurisdictions when the matter arises in the courts. Moreover, it could be suggested that the Sri Lankan court would tend to follow the interpretations of the English Courts on this matter.²⁸⁵

²⁸¹ Arti.10.2 of the TRIPS.

²⁸² Art.5 provides that compilation of data or other materials, in any forms, which by reason of selection or arrangement of their contents constitute intellectual creations, are protected as such. Sec.3A of the UK Copyright, Design and Patent Act 1988 provides that database means a collection of independent works, data or other materials arranged in a systematic or methodical way and individually accessible by electronic or other means.

²⁸³ E.g. sec.14 of the National Child Protection Authority Act, No.50 of 1998, sec.3 of the Sri Lanka Society for Numismatic Studies (Incorporation) Act, No.39 of 1998. Some of the legislations used the term data bank to mean collection of data, which stored in the computer. E.g. sec.54 of the Sri Lanka Bureau of Foreign Employment Act, No.21 of 1985, sec.10 of the National Education Commission Act, No.19 of 1991, sec.16(2)(f) of the National Human Resources Development Council of Sri Lanka Act, No.18 of 1997.

²⁸⁴ This will become more serious in cyberspace since computers and the Internet have made the extraction and re-utilisation of the whole or of a substantial part of the contents of the database and rearrange them to form a new database possible. This reflects the weakness of copyright protection of the database, especially on the Internet, in Sri Lanka.

²⁸⁵ E.g. *Vogon International Ltd v Serious Fraud Office* [2003] EWHC 1739 2003 WL 21990399 2003 WL 21990399 and 2004 WL 62146. (The appeal was concerned the meaning in its context in a written agreement of the word "database" or "databases." Also *British Horseracing Board Ltd v William Hill Organisation Ltd* [2001] EWCA Civ.1268 [2002] E.C.C.24 [2002] E.C.D.R. 4(2001)24(9) I.P.D. 24059 2001 WL 825162 2001 WL 825162.

4.17.(d) Artistic works

Artistic works on webpages are entitled to copyright protection provided they are original. As seen above these works can be protected in terms of Art.9 of the TRIPS Agreement and Art.1(4) of the WCT.

As seen,²⁸⁶ the Act does not exhaustively define the term 'artistic work'. Nevertheless, sec.6 of the Act lists works that include artistic works such as works of drawings, paintings, architecture etc, photographic works, illustrations, maps, plans, and sketches. It is well understood that webpages contain more artistic works with different expressions. The list of works in the Act is non-exclusive and the undefined term 'artistic work' seems to be enough to cover the expression of artistic work in the digital form as well. It is therefore clear that the layout of webpages, backdrop to a webpage and all other artistic works in or on websites can be protected under the present copyright law of Sri Lanka since the provisions of the Act are adequate to extend the application to the expressions of artistic works in the digital form as well.

4.17.(e) Dramatic works

Dramatic and dramatico-musical works are entitled to copyright protection under the Act.²⁸⁷ Moreover, audiovisual works are also given protection under the Act.²⁸⁸ The sec.286A(2) of the Penal Code define the term "films" to include any form of video recording.²⁸⁹ In the light of these sections, it can be argued that screen display of a moving image and of a computer video and many works that include a series of visuals including sound (audiovisual works) such as visual presentation of a work by power point presentation; animations etc can also obtain protection under the Act.

4.17.(f) Musical works

As seen,²⁹⁰ musical work whether or not they are in written form and whether or not they include accompanying words, are entitled for copyright protection under the Act.²⁹¹ Hence, this protection can be applied to the digital world to protect music in the form of Compact Disk (CD), cassettes including DAT (Digital Audio Tape), as well as to online

²⁸⁶ Para 4.5.2(c).

²⁸⁷ Sec.6(1)(c).

²⁸⁸ Ibid, sec.6(1)(f). According to sec.5 'audiovisual work' means work that consist of a series of related images which impart the impression of motion, with or without accompanying sounds, susceptible of being made visible, and where accompanied by sound susceptible of being made audible.

²⁸⁹ Sec.2 of the Penal Code (Amendment) Act, No.22 of 1995.

²⁹⁰ Para 4.5.2(c).

²⁹¹ Sec.6(1)(e).

music including in the form MP3.²⁹² Different types of application of music on the web such as opening music of webpages, background music, and closed program music etc are entitled to copyright protection under the present copyright law in Sri Lanka.

The foregoing paragraphs demonstrate that present copyright law in Sri Lanka can be interpreted to cover the new forms of subject matter on the Internet. Hence, it is vital to examine under what circumstances authors' rights could be infringed on the web.

4.18 Extension of exclusive rights to the digital world and especially to the Internet

Either all of the content of webpages can be created digitally in the first instance or by conversion of works that already existed in analog form to digital form with placement on the web. Sometimes it could be both. However, the question arises as to whether conversion of work in analog form to digital form as such would amount to exercise of exclusive rights.²⁹³ The answer depends on the factual situation of the case. Copyright legislation in Sri Lanka recognizes the fair use defence²⁹⁴ and hence, first it is to be decided whether an act in question infringes copyright by applying the factors provided by sec.11(2) of the 2003 Act in order to determine whether digitisation of work as such would amount to infringement of copyright.

Admittedly, infringement of copyright occurs when one of the exclusive rights granted to a copyright holder by the law of a given country is violated. There are three main exclusive rights given to the copyright owner under the category of economic rights²⁹⁵ while giving moral rights²⁹⁶ under the copyright law of Sri Lanka. An examination of those rights along with activities on the Internet is required to ascertain what types of conduct would amount to infringement of copyright and to what extent an act would fall into the category of fair use under Sri Lankan law.

4.18.(a) Reproduction right

The wording of the Agreed Statement Concerning the WCT categorically declared that reproduction right in Art.9 of the Berne Convention applies to works in digital form.²⁹⁷

²⁹² MP3 stands for a subcategory of Motion Pictures Experts Group (MPEG) for audio compression. Andrew S. Tanenbaum, *Computer Networks*, 3rd Ed. (Prentice Hall Inc.,1996),738-744.

²⁹³ Sec.9 provides author of a work exclusive right to transformation of work.

²⁹⁴ Sec.11 of the 2003 Act.

²⁹⁵ Sec.9.

²⁹⁶ Sec.10.

²⁹⁷ Art.1(4) of Agreed Statement provides "The reproduction right, as set out in Art.9 of the Berne Convention, and the exceptions permitted thereunder, fully apply in the digital environment, in particular to the use of works in digital form. It is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Art.9 of the

Art.9 of the Berne Convention defined the right of reproduction as “the exclusive right of authorising the reproduction of these works, in any manner or form.” Since the WCT does not specifically mention the right of reproduction, it seems that this wording of WCT can be interpreted to cover reproduction of works on the Internet. Moreover, the WCT adopts the right of reproduction by reference to Art.9 of the Berne Convention²⁹⁸ hence by implication; the WCT applies the right of reproduction to digital technology. A similar provision can be seen in the Agreed Statement Concerning Art.7, 11 and 16 of the WIPO Performance and Phonograms Treaty (hereinafter referred to as WPPT). The above international norms demonstrate that the right of reproduction for an author of a work applies to the digital world as well.

According to the Act, reproduction means the “making of one or more copies of a work or sound recording in any material form including any permanent or temporary storage of a work or sound recording in electronic form.”²⁹⁹ Nevertheless, the new definition of reproduction leaves more questions unanswered than answered in the Sri Lanka legal system.

Firstly, does it mean displaying a work on a computer screen would amount to reproduction in material form? Secondly, does temporary storage in a computer RAM memory amount to reproduction? Thirdly, making temporary copies of works, copying a recording of performance in the system (which is an integral and essential part in the process) when a work is transmitted via Internet amount to reproduction? Fourthly, would making copies of even a part of the work in the above three situations amount to reproduction?

This matter is yet to appear before the Sri Lankan court even though the reproduction right is very significant in the digital age. There is no Sri Lankan judicial opinion on the amount or the portion that can be reproduced without infringing copyright.

Nevertheless, according to the wording it seems that, the definition of the term ‘reproduction’ is a non-exhaustive one as sec.5 uses the term ‘...in any material form, including any permanent or temporary storage...in electronic form’ Hence, it could be argued that this definition can be interpreted to cover reproduction in digital form as

Berne Convention.” It is submitted that though Sri Lanka is not a party to WCT, Sri Lankan courts are entitled to have regard to the agreed statement as an interpretative method for Berne.

²⁹⁸ Art.1(4) of WCT provides “Contracting Parties shall comply with Art.1 to 21 and the Appendix of the Berne Convention”. Also the Agreed Statement Concerning Art.1(4).

²⁹⁹ Sec.5.

well. Hence, it is submitted that reproduction on the Internet is in a strict sense, covered by the Act.

4.18.(b) Translation, adaptation, and transformation

Art.12 of the Berne Convention provides the author of a work "exclusive right of authorizing adaptations, arrangements, and other alterations of their works." The second paragraph of the preamble to the WCT expresses, among other things, intention to provide adequate solutions to the new issues raised by technology. Moreover, Art.1(4) of the WCT makes it obligatory for its members to comply with Art.1-21 of the Paris Act of Berne Convention. Consequently, it can be argued that any transformation from one form to another form would amount to infringement of copyright if it were done without the consent of the author.

US experience demonstrates that such an act could amount to a new form of exploitation. In *The New York Times, Co. v Tasini*³⁰⁰ Freelance writers wrote articles for newspapers and a magazine published by petitioners New York Times Company (Times), Newsday, Inc. (Newsday), and Time, Inc. (Time). Though the Times, Newsday, and Time (Print Publishers) engaged the Authors as independent contractors in no instance secured express transfer of rights though they negotiate due-dates, word counts, subject matter and price.

When the Articles were published, the Print Publishers had an agreement with LEXIS/NEXIS, an electronic database that stores information in a textual format. The agreement granted LEXIS/NEXIS the right to copy and sell any article that appeared in the Print Publishers' periodicals. Thus, LEXIS/NEXIS places these articles on its electronic database, and a subscriber to LEXIS/NEXIS may perform a computerized search for articles and can then view, print, or download articles.

The New York Times had a separate licensing agreement with University Microfilms International ("UMI"). The agreement allowed for the reproduction of New York Times articles on two CD-ROM products, the New York Times OnDisc ("NYTO") and General Periodicals OnDisc ("GPO").

The Authors alleged that their copyrights in articles were infringed when, as permitted and facilitated by the Print Publishers, LEXIS/NEXIS and UMI (Electronic Publishers)

³⁰⁰ (00-201)206 F. 3d 161, 93 Civ.8678 (SS)1997.

placed the Articles in NEXIS, NYTO, and GPO (Databases). In response, the Print and Electronic Publishers raised the privilege accorded collective work copyright owners by section 201(c) of the Copyright Act. Further, they argued that transferring work to a different form of media does not alter the character of that work.

In determining whether the Authors' Articles were part of a collective work, the Court examined whether, the Authors' Articles could be perceived as individual articles on the Electronic Databases. The Court held if the Authors' Articles could be viewed as individual articles, it would infringe the Authors' exclusive rights under 106 of the Copyright Act.

The Print and Electronic Publishers position was that transferring work to a different form of media does not alter the character of that work and therefore it would not amount to an infringement. The Court found that the transfer of the Authors' articles from periodicals to the Electronic Databases did not characterize a "mere conversion" but a reproduction.

The Court held that electronic and CD-ROM databases containing individual articles from multiple editions of periodicals were not reproduced and distributed "as part of" "revisions" of individual periodical issues from which articles were taken. Hence, publishers of periodicals could not relicense individual articles to databases in the absence of transfer of copyright or any rights there under from authors of individual articles.

Again in *National Geographic Society et al. v Jerry Greenberg, et al*³⁰¹ the court considered whether authors had rights to reproduction of works (here freelance photographers' work) in a searchable CD-ROM collection of past magazine editions. The court held it involved a new form of use hence there was a need to grant relief to the owner of the photographs.

Moreover, in *Douglas Faulkner, et al., v National Geographic Society, et al.*,³⁰² the plaintiffs' photographs were included in CD form by defendants. The court held that the defendants did not infringe the photographer's work by including them in CD-ROM since the photographer granted the publisher "all rights" in published photographs.

Right to adaptation, arrangement or other transformation is given under sec.9(1)(c) of the 2003 Act. Though the application of this provision has not arisen until now, the Sri

³⁰¹ 122 S.Ct.347; 151 L.Ed.2d 262; 2001 U.S. LEXIS 9493; 20 U.S.L.W.3267. 2001.

Lankan court has considered a similar matter under the previous law in *Wijesiri Prathapasinghe Ramanayake v Home Finance Limited*³⁰³. The Plaintiff alleged that the defendant violated his rights by reproducing and distributing his film “*Aradhana*” in the medium of Video Cassette and lending it to the public. The Court awarded damages to the Plaintiff.

In another case, while the District Court has not discussed the matter in detail, especially the use of copyright works in an electronic context, the court accepted that the Defendant’s conduct (reproducing of tele-drama in CD format) was a violation of the Plaintiff’s right protected under the previous law, the Code.³⁰⁴ Though these cases are not directly related to Internet, it can be argued that the analogy of this judgment to digital world, especially to the Internet, would accommodate the protection of the authors’ right on the Internet under Sri Lankan copyright law.

In light of the above-mentioned law, it could be argued that if a work is digitised, in other words when a work is transformed from analog form into digital form, reproduction takes place provided substantive changes are not made during the conversion. If substantive change is made then, the right of adaptation may also be infringed. It seems that present law can be interpreted to cover such situations.

4.18.(c) Communication to the public of the work

The exclusive right to communication of the work to the public has been seriously tested in the information age due to the obvious reason of the development of new communication technology. The Berne Convention, to which Sri Lanka is a party, recognises the right of communication. Article 11(1)(ii) of the Berne Convention provides that authors of dramatic, dramatico-musical and musical works shall enjoy the exclusive right of authorising “any communication to the public of the performance of their works”. Furthermore, the Berne Convention provides rights to authorise communication of works³⁰⁵ and a right to authorise recitation to the public.³⁰⁶ Art.9 of the TRIPS Agreement adopts the Berne position by reference.

³⁰² 211 F Supp.2d 450(2002).

³⁰³ D.C.Colombo No.4679/Z, 02.10.1985(Unreported).

³⁰⁴ *Joe Abeywicrama et al v Torana Video Movies*. (Unreported), Commercial High Court, Colombo. Daily News on 23.06.2003 at <http://www.dailynews.lk/2003/06/23/new25.html> (Accessed: 01.12.2004).

³⁰⁵ Art.11^{bis}(1)(ii) provides that authors of literary and artistic works shall enjoy the exclusive right of authorising “any communication to the public by wire or by rebroadcasting of the broadcast of the work, when this communication is made by an organization other than the original one”.

The WCT provides that authors of literary and artistic works shall enjoy the exclusive right of authorising any communication to the public of their works, by wire or wireless means. This includes making available to the public of their works in such a way that members of the public may access these works from a place and at a time individually chosen by them.³⁰⁷ Art.14 of the WPPT also provides the same rights to producers of phonograms.

Under Sri Lankan copyright law, the author of a work is given the right to authorise the communication of the whole work or part thereof to the public by performance, broadcasting, and other communication.³⁰⁸ According to sec.5 'broadcasting' means 'the communication of a work,...to the public...'. This definition is ambiguous due to many reasons. Firstly, it implies that the 'work' which is 'transmitted' must itself be protected by the Act before it can be broadcasted. This is not correct in a situation where information that is transmitted cannot attract copyright protection under the Act, the broadcasts of such works still attract copyright protection under sec.20. Secondly, the language in the Act mentions only communication by means of wireless. Hence, it excludes on-demand services and creates confusion with the definition of 'communication to the public'. Finally, the definition does not show whether it includes any Internet transmission or not. Since this situation is not amenable to the proposed interpretative methodology, it is recommended that clarification by the judiciary or by the legislature as an amendment be made.

Nevertheless, it is obvious that the exclusive right to communicate would not be meaningful if it were not protected. The freedom of expression including publication is guaranteed as a fundamental right under the present Constitution of Sri Lanka. Hence, it can be argued, since the exclusive right to communication of the author has Constitutional patronage it has assumed a greater position than the other exclusive rights declared under the Act.

Nevertheless, the question arises as to whether these provisions are sufficient to cover communication through the Internet. Section 5 of the Act defines the term 'broadcasting' to cover communication of a work, a performance or a sound recording to public by wire

³⁰⁶ Art.11^{ter}(1)(ii) provides that authors of literary works shall enjoy the exclusive right of authorising "any communication to the public of the recitation of their works".

³⁰⁷ Art.8 of the WCT.

³⁰⁸ Sec.9(h),(j)and(k) of the Act.

or wireless means including transmission by satellite.³⁰⁹ Section 5 defines the term 'communication to the public' to include making available to the public in such a way that members of the public may access them from a place and at a time individually chosen by them. Hence, transmission of a work, performance, and sound recording irrespective of the mode of communication or receipt by the general public would amount to broadcast and it is submitted, the cumulative affect of above-mentioned provisions would necessarily accommodate communication through cable, electronically or via the internet.³¹⁰ Since this is not amenable to the proposed interpretative methodology, clarification of law is required.

Section 5 of the Act stipulates that 'published' means that copies of works or sound recordings have been made available to the public for sale, rental, public lending, or by means of an electronic system with the consent of the owner of copyright work.³¹¹ Moreover, according to sec.11 of the Penal Code³¹² the word 'public' includes any class of the public or any community.³¹³

Web broadcasting or web casting means the delivery of live or delayed version of sound or video broadcasts.³¹⁴ Web castings also attract copyright protection. From the cumulative affect of sec.5 and sec.9 of the Act, it is submitted that the right to communication of a work to the public is not capable of covering web casting since its narrow definition, which excludes broadcasting through means of wire. Once again, there is no Sri Lanka case law or academic opinion available in this regard and this situation is not amenable to the proposed interpretative methodology, clarification of law is required.

4.19. Potential infringement activities on the Internet

After ascertaining that the exclusive rights of an author under Sri Lankan copyright law can be extended to the digital world, the preceding parts of this chapter focused on situations where those rights of authors' could be violated.

³⁰⁹ However, according to sec.48 of the Sri Lanka Broadcasting Corporation Act, No.37 of 1966 as amended by Acts No.5 of 1974, No.11 of 1977 "broadcasting" include the broadcasting of television programmes. According to sec.32 of the Sri Lanka Rupavahini Corporation Act, No.6 of 1982 as amended by Act No.43 of 1988 "television broadcasting" includes cable television but excludes the broadcasting of radio.

³¹⁰ Making available on the Internet differs from broadcasting since the recipient selects the material. In other words, interactive transmission takes place via Internet.

³¹¹ In the case of sound recording the producer.

³¹² No.2 of 1883 as amended.

³¹³ *Jennings v Stephens* [1936] 1Ch. 469 for meaning of 'public' under 1911 Act.

³¹⁴ Webopedia at <http://www.webopedia.com/TERM/W/Webcast.html> (Accessed: 01.12.2004).

As far as infringements of copyright on the Internet is concerned, it is important to understand the key player on the Internet and the activities (whether automatic or human involved) which would potentially violate the exclusive rights. In this regard, Internet Service Provider (hereinafter "ISP")/Online Service Provider (hereinafter referred to as OSP) (sometimes called 'access provider'),³¹⁵ Internet Content Provider (hereinafter "ICP") and the user³¹⁶ (sometimes called 'client' or 'end user') are more important. However, the liabilities of all the parties are not dealt with in this study due to the restriction on the word limit.³¹⁷

4.19.(1) Browsing

It is understood that many copies of works are being made while uploading, transmitting, and browsing the web. In general, browse means the viewing of a formatted web document.³¹⁸ As seen in Chapter Three, a web user can gain access to the web through an access provider. However, in order to gain access to a website the user would enter the web address through a programme called the browser.³¹⁹ The browser brings up the page requested, interprets the text formatting commands and displays it on the screen.

Whenever the user open a webpage, the user's computer will operate by temporarily storing the contents of that page in its random access memory ("RAM").³²⁰ This is done automatically to facilitate browsing or reviewing of work and to display the page on the computer screen. This is a form of temporary copying since the copy erases when the computer is switched off.³²¹ Hence, in particular, a question arises as to whether browsing the Internet would constitute an infringement of author's exclusive right or be covered under implied licence.

4.19.(1)(a) Position in USA

In terms of the US Copyright Act 1976, a copy is created on a computer system when it is "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise

³¹⁵ Webopedia at <http://www.webopedia.com/TERM/I/ISP.html> (Accessed:01.12.2004).

³¹⁶ The term users will include individuals, small business end users and large corporations, all of whom will be contacting with ISP on a retail basis. Webopedia at <http://www.webopedia.com/TERM/u/user.html> (Accessed: 01.12.2004).

³¹⁷ R. Eugene, "Lost in Cyberspace: A Closer Look at ISP Liability," *Ent.L.R.* 12, 6 (2001),192-195, Luca Tiberi, "Liability of Service Providers," *Comp. & Telecom. L. R.* 9, 2 (2003),49-58.

³¹⁸ Webopedia at <http://www.webopedia.com/TERM/b/browse.html> (Accessed: 01.12.2004).

³¹⁹ E.g. Microsoft Internet Explorer. Webopedia at <http://www.webopedia.com/TERM b/browse.html> (Accessed: 27.10.2004).

³²⁰ howstuffworks at <http://computer.howstuffworks.com/ram.html> (Accessed: 01.12.2004). Para 4.19.(2) for caching which makes temporary copies.

³²¹ Sec.5 of the 2003 Act for meaning of 'reproduction'.

communicated for a period of more than transitory duration.”³²² Hence, it can be argued that RAM copy satisfies the requirements in the 102(a). The US Court held in many instances that RAM copy constitutes copying under the US Copyright Act.³²³

4.19.(1)(b) Position in the United Kingdom

According to sec.17(2) of CPDA reproduction includes storing the work in any medium by electronic means and hence can be argued that this section covers RAM copies. However, sec.17(6) of CPDA provides that “copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work”. Section 28(A) exempt making of copies which are transient or are incidental to some other lawful use of the work.³²⁴ The transient copies of the work stored in the RAM of the user's computer would be within the exception, since browsing cannot function without them. Hence, when a user can prove that the sole purpose of such copying is to enable him a lawful use of the work and it has no independent economic significance then there will be no infringement of copyright.³²⁵ Otherwise, he would not be liable if he can prove that either there is some form of licence for that act, or the act can be brought under one of the statutory permitted acts.³²⁶

4.19.(1)(c) Position in Sri Lanka

As seen³²⁷ under the present copyright law in Sri Lanka ‘making of one or more copies ... in any material form including any permanent or temporary storage...in electronic form’ would amount to infringement of copyright when carried out without the consent of the author.³²⁸

³²² Sec.102(a) of the USA Copyright Act.

³²³ *MAI System Corp v Peak Computer Inc* 1999 F 2d 511, 517-519 (9th Cir.1993), 510 US 1033, *Advanced Computer Services of Michigan, Inc. v. MAI Systems Corp.*, 30 U.S.P.Q.(2d) 1443 (E.D. Va 1994). *Triad System v Southeastern Express Co.* 64F 3d 1330, 1333-7 (9th Cir.1995), 516 US 1145 (1996), *Stenograph LLC v Bossard Associations Inc* 144 F. 3d 96, 101-02 (D.C.Cir.1998).

³²⁴ They must be an “integral and essential” part of a technological process and the sole purpose must be to “enable” (not merely e.g. facilitate) the permitted purpose.

³²⁵ Other than a computer program or a database, or in a dramatic, musical or artistic work, the typographical arrangement of a published edition, a sound recording or a film.

³²⁶ Art.2 of the Directive 2001/29/EC of the European Parliament and of the Council on the harmonisation of certain aspect of copyright and related rights in the information society (hereinafter referred to as Copyright Directives) provides the exclusive right of reproduction to “prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part”. However, Art.5.1 of the Copyright Directives permits temporary acts of copying ‘...which are transient or incidental [and] an integral and essential part of technological process... and which have no economic significance’.

³²⁷ Para 4.18(a).

³²⁸ Sec.5 of the Act.

Hence, the question of whether browsing a work for the purpose of reading or otherwise visualizing the contents of a webpage will constitute an infringement of copyright will depend upon whether the temporary copying of information into RAM memory will be regarded as a reproduction of the work. No court decision or statutory legislation clarifies this. It is submitted that in strict sense, a RAM copy would amount to a 'copy'³²⁹ within the meaning of the Act and such unauthorised reproduction can be considered as an infringement of copyright under the Act.³³⁰

Nevertheless, it could be argued that such approach would give the copyright owner an unprecedented degree of control over the work, and thus would shift the balance of the Act merely for technical reasons. Hence, it is submitted that temporary reproduction of a copyright work in RAM would not amount to infringement of copyright for three reasons. Firstly, RAM copying acts as an integral part of the computer system that allows its efficient operation, hence such copying would be exempted from liability. Such exemption can be justified by applying STEP 3 (Buddhist principles) of the formulae where 'intention' is a determinative factor.

Secondly, even though this process makes copies, it can be argued that, it would fall under the category of personal use, which is not a commercial use.³³¹ On the other hand, it would amount to infringement of copyright when the fair use defence failed. The determining factor of an infringement of copyright, it is suggested, should be the intention of the user rather than act of infringement as such. This argument has a statutory patronage since sec.11 of the Act provides four factors that should be considered in determining whether the use of a work in any particular case would amount to fair use. One of those factors is the purpose and character of the use, including whether such use is of a commercial nature. Hence, application of STEP 1 (present law) along with STEP 3 of proposed theoretical formulae where the intention has more prominent place would provide answer to RAM copying.

Thirdly, it can be suggested that implied licence theory would cover browsing and allied acts. Therefore, it is submitted that, it is more practical that Sri Lanka should follow the principles of other jurisdictions.³³²

³²⁹ Sec.5 of the Act.

³³⁰ Unless it falls under the category of fair use stipulated in sec.11 of the Act.

³³¹ Sec.11 of the Act for fair use and the determining factors of fair use.

³³² Para 4.12.

However, an important question arises as to whether, when a work is displayed on the computer monitor of the recipient as a result of browsing, it would amount to an act of communication to the public. In terms of present law, it is *per se* an infringement.³³³ This would be the absurd result of the literal interpretation of the Act. The irrationality of such application can be removed by applying STEP 3 along with STEP 1.

4.19.(2) Caching

Admittedly, many copies are made in the process of dissemination and accessing the works on the web. Another such copying is caching.³³⁴ Caching is a high speed process of storage mechanism in the peripherals. In the Internet, caching occurs on the user's computer³³⁵ as well as on the servers³³⁶ when a user surfs the web. This process helps to prevent unnecessary traffic on the Internet and thereby maintains retrieval speed because the browser can retrieve the visited webpages from the caching memory instead of fetching them from the original website.³³⁷

Caching raises copyright issues when it adversely affects the exclusive rights of the copyright owner. For instance, if one supposes that the cache keeps copies of documents for a long time and supplies them to the user upon request. Nevertheless, this would not count for royalties when it is calculated on a per-hit or per download basis since the retrieval is done from the cache, not from the original webpage.

4.19.(2)(a) Position in the USA

Under the Digital Millennium Copyright Act (hereinafter referred to as DMCA), the service provider is not liable for copyright infringement "by reason of the intermediate and temporary storage of material on a system or network controlled or operated by or

³³³ Sec.5 reading with sec.9(1)(k) of the Act.

³³⁴ Caching refers to the process of making a copy of a file or set of files on different devices connected to the network for a more convenient retrieval. howstuffworks at <http://computer.howstuffworks.com/cache.html> (Accessed: 01.12.2004).

³³⁵ This is known as client caching. It will be stored in RAM and the hard drive of the user's computer. Client caching mere facilitate consumptive usage. The material cached on hard disk will be automatically erase when the allocated space for caching is exceeded or newer version of materials caches are downloaded. Webopedia at <http://www.webopedia.com/TERM/c/cache.html> (Accessed: 23.09.2004).

³³⁶ This is referred as proxy (web) caching or system caching or server caching. The copyright problem would arises when the service provider copy substantially all of the contents of another server to meet subscriber requests for information on a timely basis and to conserve scarce technological resources. This process (mirroring or mirror caching) would infringe reproduction rights of the copyright owner. For detail discussion of caching P. Brent Hugenholtz, "Caching and Copyright: The Right of Temporary Copying," *E.I.P.R.*, (2000), 482-493.

³³⁷ howstuffworks at <http://howstuffworks.com/cache2.html> (Accessed: 01.12.2004).

for the service provider”³³⁸ This is subject to conditions laid down by the DMCA.³³⁹ Hence, it is obvious under the US copyright law proxy caching³⁴⁰ is exempt from liability.³⁴¹ Nevertheless, it is unsettled about client caching.³⁴²

4.19.(2)(b) Position in the United Kingdom

According to the present copyright law of the United Kingdom, copying includes the making of copies, which are transient or are incidental to some other use of the work.³⁴³ In terms of sec.28(A) of the CDPA ‘copyright of literary work, other than a computer program... is not infringed by the making of a temporary copy which is transient or incidental, which is an integral and essential part of a technological process’. And, when it is made for the sole purpose of which is to enable (a) a transmission of the work in a network between third parties by an intermediary; or (b) a lawful use of the work; and which has no independent economic significance.

Hence, it seems that under the law of the United Kingdom caching in both RAM (temporary) and hard disk (permanently) could amount to reproduction since the sole purpose of caching is not to enable browsing but to speed it up.³⁴⁴ Moreover, though it could be argued that proxy caching would be exempt under sec.28(A) it is doubtful whether mirroring would be exempt since it is not an integral and essential part of a technological process.

4.19.(2)(c) Position in Sri Lanka

In a strict sense, there would be no change in the position as discussed under browsing above. However, it is still questionable whether caching on RAM (client caching) is covered by the meaning of ‘reproduction’ under the Act, without any court decision or academic opinion yet clarifying the question. It is submitted that, since client caching is an integral part of the user’s computer, such copying would be exempted from liability.

³³⁸ According to sec.512(b)(1) of DCMA in order not to be liable for storing information in proxy caching /system caching such function should be automatic, intermediate, and temporary.

³³⁹ Sec.512(b)(2) of DCMA.

³⁴⁰ Supra n.336.

³⁴¹ Hence, for instance, mirror caching which involve long-term storage of entire websites would not be eligible for exemption since it is neither automatic nor intermediate.

³⁴² Supra n.335.

³⁴³ Sec.17(6) of the CDPA 1988.

³⁴⁴ A browser still works with its caching switched off.

Once again, attention is drawn not to the mere act of infringement of exclusive right of the copyright owner but to the intention of the user. Admittedly, the developer of the motherboard of the computer determines the cache memory that is required for keeping record. Hence, would it be fair to render the user liable for such caching?

It is submitted that application of STEP 3 while interpreting the present infringement provisions of the Act would provide a logical answer to client caching problem.

With regard to mirroring, arguably it is obvious that it is a reproduction under the Act since it creates an entire and permanent copy of the original work since mirror caching is based on specific choices made for technical or commercial reasons by the Internet service providers. Thus, it is submitted, mirroring clearly infringes the reproduction right of the owner of the original website under sec.5 of the Act. This would be strengthened when the present law applies with STEP 3 (Buddhist principles) where intention plays a significant role.

4.19.(3) Hyper linking and deep linking

As noted,³⁴⁵ webpages are written, among other things, in HMTL. More often, the author of the webpage allows information to be “hyperlinked”³⁴⁶ or “hypertext reference linked (HREF link)” and image (IMG) or ‘in-lining’ link within the same website or in between different websites.³⁴⁷ The reason for making this link is to ease the process of surfing on the web. When clicking on the link on the creator’s website, the user’s browser retrieves the data from the copyright owner’s URL³⁴⁸ to the user’s server and displays it on the user’s screen. As seen³⁴⁹ deep-linking is a process of directing the web user to an internal part of a certain webpage bypassing the home page of the web user.³⁵⁰

As a result, no matter whether it is normal, deep link or image link, copyright problems arise when links fetch content of another external webpage and in making RAM copies in the user’s computer. Hence, the result of linking could be an infringement of copyright

³⁴⁵ Para 4.17.

³⁴⁶ Webopedia for hyperlink at <http://www.webopedia.com/TERM/H/hyperlink.html> (Accessed: 01.12.2004).

³⁴⁷ For categories of links Ignacio Javier Garrote, "Linking and Framing: A Comparative Law Approach," *E.I.P.R.*, 24, 4 (2002), 184-198.

³⁴⁸ Uniform Recourse Locator. Webopedia at <http://www.webopedia.com/TERM/U/URL.html> (Accessed: 27.10.2004).

³⁴⁹ Para 3.8.5.

³⁵⁰ Deep linking lead to problems Firstly, viewers do not see the identifying information on the home page. Secondly, it bypasses the home page on which advertisements are encompassed and hence create revenue problem. Thirdly, it bypasses contractual terms and condition for access to the website.

owner's reproduction rights, public display of the work and other communication to the public. However, this will not rule out the applicability of 'implied licence' and 'fair use' to linking.

4.19.(3)(a) Position in the USA

In the United States, deep linking was challenged in *Ticketmaster Corporation v Tickets.com Incorporation*.³⁵¹ In this case, Ticketmaster, an online ticket seller, sued Tickets.com, a data aggregator, for unauthorised deep linking and use of information contained in those pages. The Ticketmaster alleged copyright infringement by downloading and reproducing its webpages. The Court stated that the use of information did not constitute copyright infringement and held that hyperlinking, including deep linking did not itself involve a violation of the Copyright Act because the Web address, or uniform resource locator (URL) itself is not copyright protected material.³⁵² However, in *Intellectual Reserve, Inc. v Utah Lighthouse Ministry, Inc*³⁵³ the court held that providing links to a website that contains infringing copies constitutes contributory infringement since the link provider supplies the user with the means to commit primary infringement.

More importantly, *Universal Studios, Inc. v Reinmerdes*³⁵⁴ the US court granted a permanent injunction against a website which linked to sites that automatically downloaded a computer programme (DeCSS- which decrypts DVD technology protection measures). However, under DMCA, information location tools providers are exempt from liability from linking under certain circumstances.³⁵⁵

4.19.(3)(b) Position in the United Kingdom

The UK position was demonstrated by *Shetland Times Ltd v Dr Jonathan Wills et al.*³⁵⁶ In this case the Shetland News' web service provided links to online newspaper the

³⁵¹ (2000) US Dist. LEXIS 4553, 6 (C.D.Cal.27.03.2000). Also *Leslie A Kelly v Arriba Soft Corporation* No 00-55521, 280 F. 3d 934 (9th Cir., February 6, 2002) In this case it was held that the use of copyright images by operator of visual search engine, whereby search engine imported full-sized images (though it appeared as 'thumbnail; pictures) directly from owner's website into frame on operator's website without permission amounted to infringement of right to public display of work .

³⁵² However, this is not the case of database. Infringement of database are challenged in *eBay Inc. v Bidder's Edge Inc.*, 100F Supp. 2d 1058 (N.D.Cal.2000). In this case, use of Web bots to extract data about auction from an auction site amounted to trespass. Since there is no *sui generis* database, law in the US the parties had to seek remedies under copyright law and trespass law.

³⁵³ 75 F.Supp.2d.1290(D.Utah 2000).

³⁵⁴ 82 F.Supp. 2d 211 (S.D.N.Y.2000) and 111F. Supp.2d 294(S.D.N.Y.2000).

³⁵⁵ Sec.512(d) of DMCA .

³⁵⁶ [1997] F.S.R 604.

Shetland Times. This was done by copying the titles of articles in the Shetland Times News paper onto the Shetland News's web service, making direct links to the articles, and allowing the user to bypass the home page of Shetland Times. This is a deep link situation. The Court considered the headlines as literary works. Hence, copying of those works arguably infringed copyright under sec.17 of the CDPA 1988. Furthermore, headlines available on the Shetland Times News paper's website are a cable programme within the meaning of sec.7 of the CDPA and hence copying such headlines were an infringement of the copyright on a cable programme service owned by the Shetland Times.³⁵⁷ However, this case has only a historical impact after the Copyright and Related Rights Regulations 2003 come into force, abolishing cable programmes as a species of work.

In terms of sec.28(A) of the CDPA it seems that making a temporary copy of a database is not exempt from infringement of authors rights. A webpage may qualify as a database,³⁵⁸ and be eligible for copyright protection under the CDPA. Hence, it can be argued that, since the use of deep-linking retrieves pages from the linked website, it would amount to infringement of rights of the owner of the database.

4.19.(3)(c) Position in Sri Lanka

There is yet no court decision, statutory legislation, or academic opinion on this matter. Hence, it is debatable as to whether hyper-linking and deep-linking are copyright infringements under the Act. Moreover, there is no court decision as to whether a webpage owner is deemed to grant an 'implied licence' for its home page to be hyperlinked to another site by use of the URL (Universal Resource Locator) of the home page or some other simple link.

Section 16(2) of the Act expressly provides that licence should be made in writing by the licensor and the licensee. Such formalities are often reserved to exclusive licence where licensees may have rights of action. Nevertheless, sec.16(2) is not so limited. However, it can be argued that an action informally authorised by copyright owner would not be a

³⁵⁷ Since the case was settled during trial. Under the terms of the settlement, the Shetland News can deep link to articles on the Shetland Times website, but all headings of these articles must have the words "A Shetland Times Story" printed below.

³⁵⁸ According to sec.3A CDPA database means a collection of independent works, data, or other materials which (a) are arranged in a systematic or methodical way, and (b) are individually accessible by electronic or other means.

violation of economic rights³⁵⁹ hence informal licence will operate as a defence to infringement regardless of record in writing.

As with other copyrights, copyrights in material appearing online can be assigned or licensed in whole or in part by the copyright owner. Nevertheless, it is submitted that there must be an implied licence, as linking is the very essence of the Internet and hence it may be open to the owner of the home page to explicitly refuse a licence to hyperlink.

A complication arises in relation to deep linking (deep hyper linking) which bypasses the home page and links to sub pages. This raises question as to whether such linking would amount to infringement of exclusive communication right.

As explained above, it seems that the existing provisions of the Act provide a possibility to address this issue. Section 9(1)(h),(j) and (k) of the Act provides the author with an exclusive right to communicate his work to the public by performance, broadcasting and other communication. Hence, the author can decide to whom the work should be communicated.

It is suggested that by placing a work on the web without explicit limitation would amount to implied licence to use the work.³⁶⁰ On the other hand, if there are certain conditions made by the webmaster/author to get access to the webpage, the person who seeks to access should comply with it, otherwise it violates communication rights of the author.³⁶¹

On the other hand, if a website was deemed, under the Act, to be a collection of works and data in such a way that those collections are original by reasons of the selection, coordination or arrangement of their content, it would constitute a database.³⁶² Hence, the question arises as to whether linking would amount to infringement of copyright in the database. Section 12(2)(c) provides that the fair use exemption does not apply in the case of reproduction of databases. Thus if linking involves reproduction of a database it will be an infringement unless implied licence can be inferred. On the other hand, when content of website is viewed as a database, it can be argued that such database may be protected by unfair competition.³⁶³

³⁵⁹ When sec.5 is read along with sec.(9)(1).

³⁶⁰ http://www.intellectual-property.gov.uk/std/faq/copyright/IMPLIED_COPY_LICENCE.htm (Accessed: 01.12.2004).

³⁶¹ Para 3.7.10.

³⁶² Sec.7(1)(b) of the Act does not clearly define database.

³⁶³ There is no judicial guidance or detailed provision as to how those provisions of Part VI of the Act could apply to protect copyright works including databases in Sri Lanka. Para 4.13 and 4.15.

The next issue is when a link refers to infringed materials. However, in Sri Lanka, whether it is a violation of the Act to create a link that contributes to infringed materials is not clear.³⁶⁴

Under these circumstances, it is submitted that, linking would amount to infringement of copyright under Sri Lankan copyright law.³⁶⁵ However, this would give illogical result in the use of Internet.³⁶⁶ Hence, it is submitted that implied licence theory can be applied. When implied licence theory is constructed not only with the guidance of English and Roman Dutch Law which govern the law of contract of the country, but also with the application of Buddhist principles under STEP 3, it would provide an opportunity to consider the intention of the user rather than the intention of the creator. Considering sec.16, commercial necessity of linking and the duty of the court to regard Buddhist principles in interpreting the law it can be argued that linking can be taken away from copyright infringement in Sri Lanka.

When a person makes a link to the webpage of another he knows that he is giving access to another's work. Would it be moral to access somebody's property? Hence, the practice of the webmaster can be questioned if he had made links to deep pages of another website without the consent of the author of the linked webpage.

In the light of above discussion it can be argued that web master is liable in relation to deep linking. The intention of the webmaster gives an advantage to apply STEP 3 of the formulae.

4.19.(4) Framing

Framing is a command in HTML enabling a viewer to see the screen split in several smaller windows or frames³⁶⁷ and each displayed within a separate portion of the Web browser's screen. Each window functions independently and operates as a separate Webpage within the originating Website. Because of framing, one website fetches content from another into a window that appears on the original framing site. In this event the location in the browser, which points to the current uniform resource locator

³⁶⁴ cf. Para 4.10.(a).

³⁶⁵ This would be an infringement of economic rights as well as moral rights (specially in the case of deep linking) if and when the user cannot distinguish what parts of the internet site actually derive from other internet sites. Unless some notice is being posted.

³⁶⁶ This is, in the opinion of Tim Berners-Lee, the founding father of WWW, a "serious misunderstanding". T. Berners-Lee, "Links and Law", available at <http://www.w3.org/DesignIssues/LinkMyths.html> (Accessed: 01.12.2004).

³⁶⁷ Webopedia at <http://www.webopedia.com/TERM/f/frames.html> (Accessed: 01.12.2004).

(URL), remains the same. Thus, it is possible for the user to think that the framed article belongs to the same website to which the user originally visited. This would amount to false attribution of authorship and hence infringe the moral right of an author.

4.19.(4)(a) Position in the USA

As seen,³⁶⁸ in *The Washington Post v. Total News Inc.*,³⁶⁹ the defendant had framed news content from the plaintiff's sites. Thus, the contentions were, among other things, that those frames infringed copyright. The case was settled upon an agreement to permit the defendant to maintain its link to the news sites but to cease framing the plaintiff's material in association with any third party advertising on its URL. However, this case demonstrates that framing could be actionable under US copyright law since framing creates derivative work without the consent of the author.³⁷⁰

4.19.(4)(b) Position in the United Kingdom

It can be argued under the CPDA that framing would amount to the creation of a derivative work and hence infringe copyright. There have been no reported decisions in the United Kingdom relating to framing. However, *Haymarket v. Burmah Castrol*³⁷¹ would be important in this regard. In this case the plaintiff Haymarket, UK publisher sued the defendant, oil firm Burmah Castrol, for alleged infringement of copyright as the defendant's website framed content from two of plaintiff's websites.³⁷² It seems that under the CDPA framing can be challenged as infringement of copyright.

4.19.(4)(c) Position in Sri Lanka

As seen³⁷³ webpages are written in a certain programming code such as HTML, XML etc. Under sec.6(1)(a) of the Act, computer programmes are protected irrespective of whether source code or object code. Under sec.7(1) of the Act the author of a work is

³⁶⁸ Para 3.6.7(a).

³⁶⁹ No.97 Civ.1190 (PKL) (S.D.N.Y.20.02.2000).

³⁷⁰ In an earlier occasion framing was challenged in *Journal Gazette Co. v. Midwest Internet Exchange*.98-CV0130(N.D.Ind 1998). Here two newspapers sued the developer of a free community website and the ISP since the site linked to the newspaper's article using frames. However, this case settled without decision. Moreover, in *Futurodantics, Inc. v. Applied Anagramatics, Inc.*1998 U.S. Dist.Lexis 2265, the court held that placing a frame around the plaintiff's webpage did not constitute a reproduction or copy of the copyrighted content since there was no sufficient evidence as to framed link created derivative work. Hence, the court refused to grant preliminary injunction. The Court of Appeals for the Ninth Circuit upheld this decision by finding that the plaintiff had failed to show that it was or would be injured by the defendant's conduct.

³⁷¹ <http://www.theregister.co.uk/content/6/15978.html> (Accessed: 01.12.2004). Reported existence of lawsuit but outcome unknown.

³⁷² Websites belong to Haymarket (whatcar.com and autosport.com) are framed in a Castrol-branded border. Unfortunately, the outcome of this case is not known yet.

given exclusive right to make derivatives of his work. Hence, if a person makes a derivative of a work without the consent of the author, he would be liable for copyright infringement under the Act.

In theory, to create a framed page it is necessary to reproduce the object code of the original page and then add those to create the frame. In this process, the original object code is transformed to another object code. Hence, derivative work of the original work is made. The framed page is something else that the author did not create or authorise to create. Since unauthorised framing of a website would violate the reproduction rights of an author and make unauthorised derivative work, it is submitted that the creator of frame page is liable for infringement of sec.7(1) as well as sec.9(1)(a) of the Act.

Moreover such conduct would violate moral rights of the author protected under sec.10 of the Act. This means that the answer to STEP 1 (present law) of the above diagram is affirmative.

Most authors would like to see their authorship acknowledged while others are using their work for private use etc. As seen³⁷⁴ in early Sri Lankan society, due recognition was given to creator while recognizing and protecting intellectual creations. There is no hurdle to accepting and practising continuously those norms irrespective of the fact whether there is law or there is lacuna in the law. While framing a part of another's work to one's website, he breaches the second (appropriation without consent) and fourth precept (false representation) of Buddhist moral code and there by challenges the social fabric. Hence, STEP 3 of the formulae is also applicable in this regard.

4.19.(5) Peer-to-Peer (P2P) file sharing

Admittedly, music can easily be exploited when it is digitised. As seen digitisation is the process of converting information, which is incomprehensible to humans but can be understood by a computer. When music is digitised (converted into binary form) it is easy to disseminate without deteriorating quality and allows to make unlimited perfect copies.

Peer-to-peer allows the user to be both a spoke and a hub and thereby allowing the dissemination and receipt of information simultaneously. In essence, each user's

³⁷³ Para 4.17.

³⁷⁴ Para 2.7.

computer becomes a server itself hence no need for large servers to distribute information to others. Unlike normal search engines, peer-to-peer networks provides the capability to provide “real time” searches. Napster,³⁷⁵ Gnutella³⁷⁶ Freenet,³⁷⁷ and Grokster³⁷⁸ are examples of these.³⁷⁹

4.19.(5)(a) Position in the USA

The File sharing system has been challenged in many cases in the US. In *UMG Recordings, Inc. v MP3. Com, Inc.*³⁸⁰ the defendants created a service called “My.MP3.Com” which allowed subscribers to store and listen to copies of their CDs anywhere with a Internet connection. In order to do this the subscriber had to prove that he/she owned the CD by inserting it into the CD-ROM of his access computer or by purchasing the CD from defendant’s company. The court held the defendant liable i.e. the use did not amount to fair use.

In *A&M Records, Inc. v Napster, Inc*³⁸¹ P2P file sharing was challenged. Here the defendant allowed users to make MP3 files from an individual’s hard drive available to other users for copying, search for MP3 files stored on other users’ computers and transfer copies of MP3 files from one user to another while on-line. The user could access these facilities by downloading software from the defendant’s website free of charge. The question was whether Napster users directly infringed copyrights or if their use amounted to fair use. The court held that Napster’s use did not amount to fair use and hence an injunction was granted.³⁸²

³⁷⁵ Napster uses a centralised server system, where a user logs on to a server, connecting that user to others.

³⁷⁶ Though Gnutella is more or less similar to Napster it has no centralised server system, but instead connects its users with each other directly without using intermediary. Unlike Napster, Gnutella is not confined to MP3 or Windows Media files but users are able to search for any type of files such as word processing documents, movies, software etc. How stuff works at <http://howstuffworks.com/file-sharing3.html> (Accessed: 01.12.2004).

³⁷⁷ In contrast to Napster and Gnutella, Freenet system allows to pass information absolutely anonymously. How stuff works at <http://howstuffworks.com/file-sharing3.html> (Accessed: 01.12.2004).

³⁷⁸ www.grokster.com (Accessed: 12.10.2003).

³⁷⁹ For instance, to get an idea how many file sharing website exists on the web visit to <http://www.zeropaid.com> (Accessed: 01.12.2004).

³⁸⁰ 92 F.Supp.2d 349 (S.D.N.Y., 2000) and also *UMG Recordings, Inc. v MP3. Com, Inc.* 109 F.Supp.2d.233 (S.D.N.Y., 2000).

³⁸¹ 239 F.3d 1004 (9th Cir.2001).

³⁸² Thought Napster argued that it falls under the protection of safe harbour of DMCA, but the Court rejected.

To address this issue the US Government drafted Peer-to Peer Piracy Bill.³⁸³ The main aim of this Bill is to use technology to prevent infringement of copyright on Peer-to-Peer computer networks. The Bill provides safe harbour liability for actions designed to prevent unauthorised distribution of works³⁸⁴ by P2P file sharing/ trading network. This would apply only to decentralised³⁸⁵ P2P networks and hence it would not apply to other actions on Websites such as file transfer protocol sites, Internet remote chatting channels.

4.19.(5)(b) Position in the United Kingdom

There is no available judicial opinion in this regard.³⁸⁶ However, it is obvious under the present copyright law of the United Kingdom that file-sharing systems necessarily infringe copyrights since such use could not fall under the category of fair use under the CDPA 1988.³⁸⁷ Moreover, P2P could be challenged under sec.182(A)(1) since user of P2P copies/uploads a file to a folder which is publicly available to other users of the network which violates reproduction rights.

4.19.(5)(c) Position in Sri Lanka

Until now in Sri Lanka, there are no cases like MP3.com, Napster or other later versions of P2P service, challenging the file sharing system. Admittedly, while transmitting material on the web, the server³⁸⁸ does reproduce materials in the file sharing system. However, it can be argued that, in a strict sense, it would amount to infringement of copyright under the Act since it is done without the owner of copyright (automatic/non-human intervention).³⁸⁹ It can be argued on the other hand that even though the service provider would not be liable for direct infringement of copyright, he would be liable for indirect infringement, provided that he knows or should have known that he facilitated

³⁸³ Findlaw at http://writ.news.findlaw.com/commentary/20021001_berman.html (Accessed: 01.12.2004).

³⁸⁴ This would do by disabling, interfering with, diverting or otherwise impairing or blocking the unauthorised use of work with help of technology.

³⁸⁵ Decentralised network is one that does not use a client-server relationship to trade files.

³⁸⁶ Nevertheless, e.g. Mark Haftke, and Philip Daniels, 'Napster in the UK', *Ent.L.R.* 12. 4 (2001), 107-111, 107-11, Warren R Shiell, "Viral Online Copyright Infringement in the United States and the United Kingdom: The End of Music or Secondary Copyright Liability? Part 1 and 2," *Ent. L.R.* 15, 3 & 4 (2004): 63-71 & 107-13 and c.f. *Sony Music Entertainment (UK) Limited & Others -v- Easyinternetcafe Limited* [2003] F.S.R. 48.

³⁸⁷ Sec.29-76.

³⁸⁸ howstuffworks at <http://computer.howstuffworks.com/web-server1.htm> for how server works (Accessed: 27.10.2004). Also webopedia at <http://webopedia.com/TERM/S/server.html> and at http://webopedia.com/TERM/p/proxy_server.html (Accessed: 01.12.2004).

³⁸⁹ Sec.5.

the infringement of copyright materials. Moreover, unlike other jurisdictions³⁹⁰ there are no provisions relating to liability of service providers in Sri Lankan copyright law, which required them to have a financial gain by the server out of his servers activities in order to be liable. However, it could be argued that the server's activities would prejudicially affect the author in any event.

Paradoxically, the above logical conclusion has no value in the face of file sharing system provided by Guntella, KaZaA, Grokster and MusicCity etc since they do not store the infringing files in the server for which the service provider would be liable.³⁹¹ Moreover, those services do not either store the lists of the infringing files on their central servers. Hence, it would be difficult to make the server liable.

Can Sri Lankan copyright law allow society to use the infrastructure facilities of the network to infringe authors' rights? Will the established moral norms of the country support such conduct? Would it be an unauthorised appropriation of property belonging to someone else and thereby violate the basic rights recognised under the Constitution?

It is submitted that applying STEP 2 (constitutional principles) and along with Buddhist values (STEP 3) would provide satisfactory answer to this situation.

In contrast to content provider's activities as a content provider, the users in the file sharing system directly distribute the infringing files between themselves through the network. Hence, it is submitted that this problem can directly be addressed by applying STEP 2, 3 along with STEP 5 (Roman Dutch Law- especially undue enrichment).

PART D

Applicability and the efficacy of the proposed theory

4.20 Introduction

The foregoing discussion amply demonstrates that the application of copyright law has been seriously challenged in the wake of the digital age. Technology has changed the mode of application of copyright. Evidently, the history of copyright law does react to new technologies. Even though new technologies have changed the balance between copyright holder and the users of copyright works, it has not changed the rationale

³⁹⁰ E.g., sec.512(c)(i)(B) of DMCA of USA (does not receive a financial benefit directly attribute to the infringement activity) and also the Art.5.1 of the Copyright Directives (no independent economic significance).

³⁹¹ howstuffworks at <http://webopedia.com/TERM/s/server.html> for the definition of server. (Accessed: 01.12.2004).

behind the copyright law. Hence, the basic concepts of copyright law remain unchanged whatever may be the technological changes in the society.

Since copyright law has been faced with new forms of exploitation of work due to convergence of technology and easy dissemination of works through the Internet, the Government of Sri Lanka promulgated a new intellectual property law. Having discussed the status quo of the copyright law in Sri Lanka, the need for such a new law is seriously questioned.

Admittedly, intellectual property law of a country can be expanded in two ways. Firstly, by creating new rights. Secondly, by expanding the ambit of incumbent law. At this point the researcher strongly recommends the latter option. The following section is devoted to an explanation of the way in which the present law could be expanded to address the novel issues and thereby achieve the objective of copyright protection.

4.21 Application of the proposed theory: an evaluation

As seen in Chapter two and in this Chapter, early societies in Sri Lanka recognised and protected works, which are eligible for copyright protection under the present copyright regime. This demonstrates how the people recognised authors' intellectual labour and refrained from unauthorised appropriation of such property. As far as the legislative history of Sri Lanka is concerned, it is evident that the Sri Lankan legislature has categorically expressed from time to time its intention to protect the proprietary rights of the author.³⁹²

Even though the present copyright law in Sri Lanka recognises the owner of the copyright,³⁹³ nowhere does the Act expressly declare copyright as the property right of the author. Nevertheless, the Companies Act,³⁹⁴ and Inland Revenue Act³⁹⁵ recognise copyright as property. Until now, the Sri Lankan judiciary has not expressed their justification for copyright protection throughout its history. It can be deduced from the above provisions that the rationale behind the justification of copyright in Sri Lanka seems to be the protection of property rights of authors'.³⁹⁶

³⁹² Title of TCO, No.19 of 1898, and preamble to the Ordinance, No.12 of 1908.

³⁹³ Sec.14 of the Act provides that the author who created the work shall be the original owner of economic right'.

³⁹⁴ Sec.91(2)(i) of the Companies Act, No.17 of 1982 recognises copyright and a licence under a copyright as a property for the registration of charge.

³⁹⁵ Sec.451(i) of the Inland Revenue Act, No.28 of 1979 as amended mentions about copyright under the title of 'certain property to be excluded from wealth'.

³⁹⁶ Obviously, this is subject to right to access the work by the public under the principle of fair use.

It is difficult to promulgate a law broad enough to cover future innovations in technology, but the law should not be captive to the ever-shifting growth of technology. If the determining factor of Sri Lankan copyright law is technology, then such law will often become obsolete. Hence, the adverse impact of such incremental legislation on Sri Lanka society should be taken into account.

As seen throughout this chapter, many pieces of legislation were promulgated by the Sri Lankan legislature from time to time to address copyright issues. However, it is evidenced that none of those attempts were completely successful. The inability to understand how to deal with new issues further emphasises the need to have a basic theory that would apply to protect the authors' rights and to maintain the balance between authors' rights and the rights of the public.

As discussed, it is possible to interpret the present copyright law to cover any types of exploitation (appearing in different forms) present and future by keeping in mind the rationale behind the protection of copyright, intention of the user and the constitutional mandate given to the Court. This would be further viable if the present copyright law is applied along with the proposed theory in Chapter Two of this study along with the aforementioned methodological diagram.³⁹⁷

As seen in the foregoing discussion,³⁹⁸ most copyright issues discussed above draw attention to the following three basic issues:

- (1) the defendant has exercised the exclusive rights of the author.
- (2) the technique which the defendant used to exploit the work (for instance converting the work from analog form to digital form, deep linking, framing etc).
- (3) the intention of the use (private use, to evade royalties etc).³⁹⁹

Obviously, there is no difference between an infringement of copyright in the real world and the 'digital world' since in both cases are acts of unfair appropriation of the labour of the author.

Buddhism deals with the deliberate misappropriation of property. As seen in Chapter Two,⁴⁰⁰ five precepts are recognized as part of the moral conduct of the Buddhist layman. In order to breach the second precept of *panca sīla*, five requirements should be

³⁹⁷ Para 2.11.

³⁹⁸ Specially Part C of this Chapter.

³⁹⁹ This is legally supported by sec.11(2) of the Act.

satisfied.⁴⁰¹ As far as infringement of copyright is concerned, it is clear that the defendant fulfils all the requirements, which are necessary to breach the second precept of *panca sīla*. Firstly, the defendant knows that the property (i.e. authors' work) does not belong to him/her. Then the defendant employs a device or performs an act of "taking it."⁴⁰² Here the defendant utilizes a method such as framing, linking, downloading, or use a mechanism to circumvent technological measures⁴⁰³ and also transforms one form to another with the help of digital technology along with the Internet to appropriate the work. The ultimate motive of the defendant is to make profit and/or evade royalty to which the author is entitled.

It is, therefore, obvious that the cumulative effect of this conduct would amount to a breach of the second precept of *panca sīla*,⁴⁰⁴ and would breach one of the paths in the eight fold paths, namely right livelihood (*sammā ājīva*). Hence, the whole chain of the act would amount to a breach of Buddhist morality, and hence challenges the constitutional obligation of the State to uphold Buddhism. It is obvious that the conduct of the defendant can be assessed by using this theory irrespective of the medium, which has been used for the unauthorised exploitation of the work. It is submitted that where possible copyright law should be interpreted in this light. Such interpretation would not create uncertainty in the legal order rather it would build certainty by providing a coherent, logical, and consistent outcome on the court.

Moreover, to justify whether the defendant's act does not harm the plaintiff, the following formulae should be applied. If one (A) thinks that it would cause no harm according to Buddhist morality to do a particular act to another (B), then it is assumed that it would cause no harm to do the similar act to the former (A) in similar circumstances. Thus, as a rational person, if one (A) believes that it would be morally acceptable to do a particular act to another (B), then it is assumed that the former (A)

⁴⁰⁰ Para 2.9 (c)(I).

⁴⁰¹ (1) There must be a thing (2) You must know that the thing belong to another (3) You must have the intention to take/ appropriate it.(4) You must employ a device or perform an act of taking/ appropriating it (5) The thing must be taken/ appropriated.

⁴⁰² This provides a latitude to challenge the circumvention of technological protection measures (TPMs), including access and copy controls, used by right holders to protect their works against unauthorised uses, as well as the protection against the manufacture and trafficking of devices and offering of services/information that enable the circumvention of such technological measures; and illegal removal and altering of rights management information.

⁴⁰³ For instance Serial Copy Management System (SCMS), Content Scramble System (CSS), Digital Transmission Content Protection (DTCP).

⁴⁰⁴ Refrain from taking what has not been given.

would consent to a third person (C) to do the same act to A under similar relevant conditions.⁴⁰⁵

Applying the above theory of justification of one's conduct to already examined examples of unauthorised appropriation of copyrighted works such as deep linking, framing, making RAM copy, caching etc., demonstrates that the determining factor of an infringement of copyright seems to be the intention and/ or knowledge of user/ participant but not the unauthorised use of the work. For instance, the international instruments in relation to copyright exempt certain activities such as system caching, hosting, and transmitting of the work under some circumstances.⁴⁰⁶ Hence, when there is an alleged copyright infringement, then the court has to look into the application of proposed method, which is a synthesis of exclusive rights and defences.

Interpretation of present copyright law in Sri Lanka to be compliant with the methodology suggested in Chapter Two is the necessity of the day, because as experienced in the past, the law always stands one-step behind the technology and provides no better protection for the works of authors. Hence, it is submitted that proposed methodology can be properly applied to address the present copyright issues in addition to those that will emerge in the future. The applicability of this methodology will be perpetual since it does not depend on the changes that take place in the technological world.

Nevertheless, there are some instances in the non-digital world where the methodology is not amenable because the policy is too clear. E.g. (1) street drama (denial of right to livelihood and equality before law).⁴⁰⁷ (2) translation of works without the permission of the author where any works had not been published in constitutionally recognised languages i.e. Sinhala or Tamil within reasonable time from its first publication in its original language (this deny access to education).⁴⁰⁸ (3) use in distance education (this deny access to education when considered with factors such as few universities available in the country and geographical conditions etc.). Although these situations are coherent with constitutional protection for the culture and religion of the people and the Buddhist principles, it seems that the interpretative methodology is unlikely to work with them in the face of clear legislation intent of 2003 Act.

⁴⁰⁵ It is suggested that this would allow to apply the concept of implied licence as well.

⁴⁰⁶ Art.12-14 of the E-commerce Directives. (Directive 2000/31/EC of the European Parliament), Art.5 of the Copyright Directives (Directive 2001/29/EC of the European Parliament).

⁴⁰⁷ Para 4.5.2.

Hence, it is submitted that the proposed methodology demonstrated that it is not universally applicable. Application of such methodology by the court would not amount to bypassing the 2003 Act or legislature rather it provides an interpretative methodology to which it applies while maintaining the separation of power.

4.22 Conclusion

As seen through the forgoing Chapter, the Sri Lankan legislature has experimented with different models of copyright laws to accommodate new issues that have arisen from time to time. Nevertheless, it also demonstrates its failure. This is not only because of the lacuna of the law. It is mainly due to misunderstanding and unconsciousness of the social values.

Ideally, law consolidates and confirms existing developed social consensus. Nevertheless, none of those pieces of copyright legislation considered the existing values of the society based on Buddhist principles. In the ideal world, the legislature considers the interest of the parties and establishes the balance between them taking into account such factors as ethics, morality and practicality. However, until now this has not been done by the Sri Lankan legislature in relation to copyright law.

As seen,⁴⁰⁹ this may be due to the ignorance of the basic rationale behind the subject. For instance in 1983 the Parliament of Sri Lanka passed the 13th Amendment to the Constitution of 1978. The objective of the amendment was to create provincial councils to decentralise power between the central government and the provincial councils. Accordingly, the three lists were made, among other things, to demarcate the power between the central government and provincial councils.⁴¹⁰ According to these lists, the power relating to intellectual property matters was kept with the central government. Paradoxically these lists are themselves evidence of the ignorance of the subject matters of intellectual property since it stipulates “patents, inventions and designs, copyright, trade marks and merchandise marks” in a country where invention as such is not protected.⁴¹¹

Therefore, it can be argued that due to the discussed Constitutional understanding along with most of the reasons discussed in Chapter One of this study, a situation may have been created in which the Roman Dutch Law principle *spolitus ante omnia vestituendus*

⁴⁰⁸ Para 4.4.1.

⁴⁰⁹ Para 1.2.

⁴¹⁰ Those lists are Central Government List, Provincial Council List, and the Concurrent List.

est ad (a wrong doer-spoliator would not be entitled to benefit by his wrongful act) may not have prevailed throughout the history of copyright law in Sri Lanka. Hence, it is submitted that, it is the duty of the lawmakers and the judiciary to recognize the importance of local values and to enshrine them in legislation. Such an approach would necessarily accommodate the concept of 'implied licence' since Buddhist principles do not restrict innocent/harmless uses of 'work' or unintentional uses of work e.g. making copies while browsing.

Moreover, the legislature should not consider the medium in which the infringement takes place to be of central importance while drafting new laws, for the obvious reason that technology oriented law will become obsolete very quickly. Hence, future legislation should be made on technologically neutral principles rather than reactive legislation that respond to particular technological challenges.

The present copyright law has given wider latitude to the Sri Lankan judiciary to accommodate new forms of expressions. Hence, the imperative need of the hour is to interpret the present copyright law in accordance with the proposed theory in the process of adjudication while maintaining the balance between the rights of the owners and the public, a principle, which has been recognised by international copyright treaties.

⁴¹¹ Reserved List Entry (d) of the Thirteenth amendment to the Constitution.

CHAPTER FIVE

Conclusions and Recommendations

5.1. Introduction

This study began with a proposition that Intellectual property rights in Sri Lanka should be protected by interpreting legislation according to the values and the needs of the country as recognised in the constitution and legal system. Hence, an attempt has been made in Chapter One to emphasis specific issues that are unique to Sri Lankan society under which the proposition of the thesis should be tested. Chapter one demonstrated that there are 'problems within the problems' yet to be solved such as lack of indigenous cases, academic literature etc.¹ These problems show the need for a coherent and conceptually methodical paradigm to interpret intellectual property law in Sri Lanka but also have constrained this study.

Second Chapter explored the historical background of civil society and pre-statutory foundations of Sri Lankan intellectual property protection while tracing the rationale behind such protection. It depicted different methods that acted as mechanisms to protect intellectual creations of the people. The examination of those long recognised concepts in relation to intellectual property in Sri Lanka revealed that they are not alien to Sri Lankan society but instead are deep rooted. By examining Sri Lanka's juridical history, Roman Dutch Law and Constitution together with constitutionally recognised Buddhist principles, it suggested further sources of guidance for judges. Accordingly, Chapter two presented a conceptual framework or interpretative methodology/ technique comprising the main proposition of the thesis.

The proposed methodology was tested in the third and fourth chapters, which dealt with specific issues of trade mark, unfair competition, and copyright law that have caused difficulties in Sri Lanka and other jurisdictions. Historical exploration of the development of trade mark and copyright laws in Sri Lanka demonstrated two things. Firstly, it confirmed that the recognised concepts of modern intellectual property law are consistent with the pre statutory era and have been developed in Sri Lankan society and tested over time. Secondly, it established how a particular socio-economic and political context has given rise to the current state of intellectual property law in Sri Lanka.

¹ Para 1.2.

Textual analysis of previous statutes, old case law, and judicial dicta explicitly confirm that those statutes, cases etc. are examples for the recognition of well-accepted principles and concepts, e.g. in the case of trade marks concepts such as 'likely to be misleading', 'calculated to deceive'. This means that protection of the interests of the proprietor/creators and of the community has been explicitly acknowledged by the old legislation and case law of the country. Thus, many cases decided under earlier statutes remain relevant and available for interpretation of current law. However, this can be supplemented by reference to the constitution and especially to Buddhist principles.

The fourth chapter dealt with copyright and related rights. It exhibited that the rationale behind the protection of copyright has not changed throughout history though changes have taken place on protectable subject matter. For instance, there is no protection for street drama under 2003 Act. However, Chapter four exhibited that the relationship between fundamental rights and copyright is strengthened by principles embodied in the constitution.

Moreover, enquiry of historical development of trademark and copyright law manifested that some of those concepts have remained unchanged. The recognition and value placed by society on intellectual creations/works are entirely consistent not only with e-commerce era but also with traditional and modern values of Sri Lanka and hence can be used in today's situations and are still relevant to interpret new law.

It is proven that many provisions of old legislation are still useful to interpret the present law in order to give effective protection in the information age. As far as old case law is concerned, it is evident that some of those cases decided under old legislations are still applicable whereas some are relevant as showing up the gaps of the present law. For instance *Carder Saibo and Co., v Mowlana, K. Thyagarajah v D.M.R Perera, Times of Ceylon v Marcus*. More importantly, *Swamipillai v Manuelpillai* recognised that a trade mark confers right of property. As observed in the foregoing trade mark law chapter, had the Sri Lankan judiciary taken into consideration the dicta of *Swamipillai v Manuelpillai* while delivering justice in the past the situation of trade mark protection in the country would have been better.

The application of the proposed interpretative methodology to specific issues in the field of trade marks and copyright demonstrates that justice could be delivered more efficiently and effectively without promulgating incremental legislation in a country

where there are comparatively few reported cases available for guidance under the doctrine of *stare decisis*.

5.2. Implications for policy and practice

It is the imperative need of the day to take necessary action for the following by the policy makers of the country. These steps are not confined to the information age but are generally necessary for the sustainable development of intellectual property in the country,

1. to improve awareness of intellectual property among the public including the making available Intellectual Property legislation and judgments in Sinhala and Tamil languages;
2. to give a basic understanding of intellectual property to schoolchildren for their secondary education as is done in relation to human rights. This is more practical since the government provides free textbooks from grade one to university entry-level education on which 'copyright reserved' is printed though in general no one knows the meaning of that phrase;
3. to educate/ train authorities such as officers in the department of Police, Customs etc. to give wider knowledge in relation to the infringement of intellectual property rights;
4. to adopt a policy to promulgate technology-neutral legislation when necessary;
5. to protect moral rights of folklore;
6. to protect the rights of the producers of street drama;
7. to educate judges of courts in first instances on subject of intellectual property and provide guidance for their interpretation of its laws;
8. to create an accessible database of judicial decisions at least of courts of records;
9. to have regard to the constitutional mandate and local values and needs whilst proposing new intellectual property laws. Apparently, in history, this has not been the case. The recent Supreme Court case is evident that challenged specifically provisions relating to the registration, ownership and licensing of patents as inconsistent with Articles 3, 4, 12(1) and 14(1)(g) of the Constitution.

5.3. Implications for further research

Though this study tested the interpretative methodology only with regard to trade marks and copyrights due to length of restriction, this does not imply that the application of the

proposed methodology is limited to these areas. The proposed methodology can be tested in the field of undisclosed information/ trade secrets since Internet activities such as hacking, sniffing /cookies may require similarly informed interpretation of the 2003 Act.

Furthermore, since the application of the interpretative methodology is not confined to e-commerce transactions it provides opportunities for further research in other areas of intellectual property protection law as well as other disciplines such as traditional knowledge and misappropriation of property.

5.6. In conclusion

The purpose of this thesis was to explore the possibility of formulation of interpretative methodology based on multiple sources, which deep rooted in the legal social culture in Sri Lanka.

Throughout this thesis, it has been argued that intellectual property law in Sri Lanka can be better applied by using the proposed methodology rather than mere application or by giving literal interpretation to the present law or by promulgating new laws to face ever-changing modes of exploitation. Moreover, it has been demonstrated that applying one or two steps alone or synthesis of steps in the proposed methodology is usually sufficient to achieve this objective, although a small number of instances are not available to the methodology, e.g. translations, distance learning, linking.

Hence it is submitted that by using a relatively new methodology in intellectual property law, by using the methodology in the country where it has not been used before and using interpretative techniques that has not been made before, undoubtedly the body of Sri Lankan intellectual property jurisprudence would be developed. This may prove more stable and effective than incremental legislation.

BIBLIOGRAPHY

1. Sri Lankan Statutes

- 1799 Proclamation of 23rd September 1799
- 1801 Charter of Justices
- 1806 Tesawalamai Regulations, No.18
- 1806 The Code of Muslim Law
- 1815 Proclamation of 2nd March 1815
- 1816 Proclamation of 31st May 1816
- 1818 Proclamation of 21st November 1818
- 1819 Proclamation of 18th September 1819
- 1820 Proclamation of 28th October 1820
- 1821 Proclamation of 3rd January 1821
- 1821 Proclamation of 14th July 1821
- 1821 Proclamation of 25th September 1821
- 1833 Charter of Justice
- 1840 Encroachment upon Crown Land Ordinance, No.12
- 1840 Prevention of Fraud Ordinance, No.7
- 1852 Civil Law Ordinance, No.5
- 1852 Proclamation, No.5
- 1852 Prevention of Fraud (Amendment) Ordinance, No.16
- 1859 Exclusive Privileges to Inventors Ordinance, No. 6
- 1863 Land Registration Ordinance, No.8
- 1865 Colonial Laws Validity Act
- 1865 Fraudulent Marks on Merchandise Ordinance, No.5
- 1865 Merchandise Marks Ordinance, No.5
- 1866 Civil Law (Amendment) Ordinance, No.22
- 1866 Proclamation, No.22
- 1866 Sannas and Old Deed Ordinance, No.6
- 1869 Tesawalami Ordinance, No.5
- 1870 Extradition Act (UK)
- 1871 Prescription Ordinance, No.22
- 1871 Exclusive Privileges to Inventors (Amendment) Ordinance, No.12
- 1873 Extradition Act (UK)
- 1876 Ordinance, No.15
- 1877 Land Registration (Amendment) Ordinance, No.5
- 1883 Charter of Justice
- 1883 Penal Code, No.2
- 1887 Land Registration (Amendment) Ordinance, No.4
- 1888 Merchandise Marks Ordinance, No.13
- 1888 Trade Marks Ordinance, No.14
- 1889 Civil Law (Amendment) Ordinance, No.2
- 1889 Civil Procedure Code of Sri Lanka, No. 2
- 1889 Prescription (Amendment) Ordinance, No.2
- 1889 Merchandise Marks Regulation (under the Section 14 of No.13 of 1888)

1890	Trade Marks (Amendment) Ordinance, No. 4
1892	Exclusive Privileges to Inventors (Amendment) Ordinance, No.16
1892	Merchandise Marks (Amendment) Ordinance, No.14
1896	Prevention of Fraud (Amendment) Ordinance, No.11
1896	Sale of Goods Ordinance, No.11
1897	Exclusive Privileges to Inventors (Amendment) Ordinance, No.6
1898	Telegram Copyright Ordinance, No.19
1898	Exclusive Privileges to Inventors (Amendment) Ordinance, No.6
1900	Council of Legal Education Ordinance, No.2
1904	Design Ordinance, No.7
1904	Inventions (Amendment) Ordinance, No. 5
1904	Trade Marks (Amendment) Ordinance, No.6
1904.	Exclusive Privileges to Inventors (Amendment) Ordinance, No.5
1906	Patent Ordinance, No.15
1906	Trade Marks and Designs Ordinance, No. 9
1907	Land Registration (Amendment) Ordinance, No.3
1908	Copyright Ordinance, No.12
1908	Trade Marks (Amendment) Ordinance, No.15
1911	Jaffna Matrimonial and Inheritance Ordinance, No.1
1912	Copyright Ordinance, No.20
1912	Public Performance Ordinance, No. 7
1914	Civil Law (Amendment) Ordinance, No.18
1914	Design (Amendment) Ordinance, No. 23
1915	Copyright (Amendment) Ordinance, No.21
1915	Patents, Designs and Trade Marks (Temporary Rules) Ordinance, No.10
1917	Patent Rules
1918	Registration of Business Names Ordinance, No. 6
1918	Copyright (Amendment) Ordinance, No.11
1918	Patent, Design, and Trade Marks Ordinance, No. 23
1918	Trade Marks (Amendment) Ordinance, No.23
1919	Alien Enemy (Vesting of Trade Marks) Ordinance, No.5
1919	Business Names (Amendment) Ordinance, No. 27
1919	Copyright (Amendment) Ordinance, No.6
1919	The Alien Enemy (Vesting of Trade Marks) Ordinance, No. 5
1919	Public Performance (Amendment) Ordinance, No.7
1920	Air Navigation Acts (Imperial)
1923	Married Women's Property Ordinance, No.18
1925	Trade Marks Ordinance, No.15
1926	Indian and Colonial Divorce Jurisdiction Act
1926	Telegram Copyright Ordinance, No.1
1926	Trade Marks Rules (Operation from 01.01.1927)
1927	Bills of Exchange Ordinance, No.25
1927	Civil Law (Amendment) Ordinance, No.25
1927	Obscene Publications Ordinance, No.4
1929	Muslim Marriage and Divorce Registration Ordinance, No.27

1931	Land Settlement Ordinance, No.20
1931	Wakfs Ordinance, No.10
1932	Design (Amendment) Ordinance, No. 24
1932	Trade Marks (Convention) Amendment Ordinance No.23
1935	Land Development Ordinance, No.19
1932	Fauna and Flora Protection Ordinance, No.2
1938	Business Names (Amendment) Ordinance, No.8
1938	Civil Law (Amendment) Ordinance, No.51
1938	Companies Act, No.51
1940	Antiquities Ordinance, No.9
1940	Entertainment Tax Ordinance, No.12
1940	Indian and Colonial Divorce Jurisdiction Act
1942	Fauna and Flora Protection (Amendment) Ordinance, No.31
1942	Patent, Design, Copyrights and Trade Marks (Emergency) Act, No. 32
1944	Civil Law (Amendment) Ordinance, No.17
1944	Telecommunications Ordinance, No.50
1944	Fauna and Flora Protection (Amendment) Ordinance, No.12
1945	Fauna and Flora Protection (Amendment) Ordinance, No.12
1946	Irrigation Ordinance, No.32
1946	Entertainment Tax Ordinance, No.12
1947	Entertainment Tax (Amendment) Ordinance, No.43
1947	Air Navigation Acts (Imperial Act)
1947	Ceylon (Independence) Orders in Council
1947	Ceylon Independence Act
1947	Crown Lands Ordinance, No.8
1947	Tesawalmi Pre-emption Ordinance, No.59
1947	Prevention of Fraud (Amendment) Ordinance, No.60
1948	Telecommunications (Amendment) Ordinance, No.7
1949	Fauna and Flora Protection (Amendment) Act, No.38
1949	Patents, Designs and Trade Marks (Neuchatel Agreement) Act, No.34
1951	Muslim Marriage and Divorce Act, No.13
1951	Public Performance (Amendment) Ordinance, No. 23
1952	Entertainment Tax (Amendment) Ordinance, No. 2
1953	Trade Marks (Amendment) Ordinance, No.47
1955	Official Secrets Act, No.32
1955	Antiquities (Amendment) Ordinance, No.2
1955	Antiquities (Amendment) Ordinance, No.22
1958	Profane Publication Act, No. 41
1961	Entertainment Tax (Amendment) Ordinance, No.45
1961	Public Performance (Amendment) Ordinance, No. 40
1964	Fauna and Flora Protection (Amendment) Act, No.44
1964	Trade Marks Act, No. 30
1964	Public Performance (Amendment) Ordinance, No. 26
1966	Sri Lanka Broadcasting Corporation Act, No. 37
1969	Public Performance (Amendment) Ordinance, No. 11

1969	State (Liability in Delict) Act, No.22
1970	Fauna and Flora Protection (Amendment) Act, No.1
1970	Telecommunications (Amendment) Ordinance, No.10
1972	The first Republican Constitution of Sri Lanka
1973	Administration of Justice Law, No.44
1974	Telecommunications (Amendment) Ordinance, No.17
1974	Sri Lanka Broadcasting Corporation (Amendment) Act, No.5
1977	Sri Lanka Broadcasting Corporation Act, No.11
1978	The Constitution of Democratic Socialist Republic of Sri Lanka, 1978
1978	University Act, No.16
1978	The Constitution of Sri Lanka
1979	Telecommunications (Amendment) Act, No.67
1979	Inland Revenue Act, No.28
1979	Consumer Protection Act, No.1
1979	Sri Lankan Inventors Incentive Act, No.53
1979	The Code of Intellectual Property Act, No. 52
1979	Code of Intellectual Property Act, No. 52
1980	Code of Intellectual Property (Amendment) Act, No.30
1982	Companies Act, No.17
1982	Sri Lanka Rupavahini Corporation Act, No.6
1983	Code of Intellectual Property (Amendment) Act, No.2
1983	Obscene Publications (Amendment) Act, No.22
1984	Sri Lanka Standard Institution Act, No.6
1984	Entertainment Tax (Amendment) Act, No.37
1985	Sri Lanka Bureau of Foreign Employment Act, No. 21
1987	Business Names Act, No.7
1987	Fair Trading Commission Act, No.1
1988	Cultural Property Act, No.73
1988	Antiquities (Amendment) Act, No.24
1988	Sri Lanka Rupavahini Corporation (Amendment) Act, No.43
1989	Open University of Sri Lanka Order, No.1
1990	Code of Intellectual Property (Amendment) Act, No.17
1991	National Education Commission Act, No.19
1991	Sri Lanka Telecommunications Act, No. 25
1993	Fauna and Flora Protection (Amendment) Act, No.49
1994	Science and Technology Development Act, No.11
1995	Evidence (Special Provisions) Act, No.14
1995	Penal Code (Amendment) Act, No. 22
1996	High Court of the Provinces (Special Provisions) Act, No.10
1996	Telecommunications (Special Provisions) Act, No.25
1996	Sri Lanka Telecommunications (Amendment) Act, No.27
1997	National Human Resources Development Council of Sri Lanka Act, No.18
1979	Code of Intellectual Property (Amendment) Act, No.13
1997	Unfair Contract Terms Act, No.26
1998	National Child Protection Authority Act, No. 50

1998	Sri Lanka Society for Numismatic Studies (Incorporation) Act, No. 39
1998	Code of Civil Procedure (Amendment) Act, No.38
2000	Code of Intellectual Property (Amendment) Act, No.40
2003	Consumer Affairs Authority Act, No. 9
2003	Information Communication Technology Act, No.27
2003	Intellectual Property Act, No.36

2. British Statutes

1624	Statute of Monopolies
1862	Fine Arts Copyright Act
1875	Trade Mark Registration Act
1883	Patent, Design, and Trade Marks Act
1887	Merchandise Marks Act
1905	Trade Marks Act
1907	Patents and Design Act
1911	Copyright Act
1914	Anglo-Portuguese Commercial Treaty Act
1916	Anglo-Portuguese Commercial Treaty Act
1919	Patent and Designs Act
1925	Dramatic and Musical Performers' Protection Act
1938	Trade Marks Act
1949	Patents Act
1949	Registered Design Act
1956	Copyright Act
1958	Dramatic and Musical Performers Protection Act
1964	Plant Varieties and Seeds Act
1968	Trade Descriptions Act
1968	Theft Act
1972	Dramatic and Musical Performers Protection Act
1973	Fair Trading Act
1976	Restrictive Trade Practises Act
1977	Patents Act
1977	Patent Act Rules
1977	Unfair Contract Terms Act
1980	Competition Act
1983	Copyright (Amendment) Act
1984	Trade Marks (Amendment) Act
1984	Cable and Broadcasting Act
1985	Films Act
1985	Copyright (Computer Software) Amendment Act
1987	Consumer Protection Act
1988	Copyright, Designs, and Patents Act
1990	Broadcasting Act
1994	Trade Marks Act
1998	Competition Act

3. Other Countries Statutes

1909	German Unfair Competition Law
1946	Lanham Act (USA)
1992	Audio Home Recording Act (USA)
1995	Federal Trade Mark Dilution Act (USA)
1998	Digital Millennium Copyright Act (USA)
1999	Anti cyber squatting Consumer Protection Act (USA)

4. Conventions

1883	Paris Convention for the Protection of Industrial Property
1886	Berne Convention for the Protection of Literary and Artistic Works
1900	Paris Industrial Property Convention (Brussels)
1911	Paris Industrial Property Convention (Washington)
1925	Paris Industrial Property Convention (The Hague)
1928	Berne Convention (Rome)
1934	Paris Industrial Property Convention (London)
1948	Berne Convention (Brussels Revision)
1952	Universal Copyright Convention (UCC)
1958	Paris Industrial Property Convention (Lisbon)
1961	Rome Convention for the Protection of Performers, Phonograms and Broadcasting Organisations (Rome)
1967	Berne Convention Stockholm Revision
1967	Paris Industrial Property Convention (Stockholm)
1968	Brussels Convention on Jurisdiction and the Enforcement of Judgement in Civil and Commercial Matters
1967	The Convention Establishing the World Intellectual Property Organisation
1968	Paris Convention for the Protection of Industrial property
1971	Geneva Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of their Phonograms
1971	Berne Convention Paris Revisions
1971	Universal Copyright Convention Paris Revisions
1973	European Patent Convention
1973	European Patent Convention Rules
1973	Vienna Convention on Typeface
1974	Satellites Convention
1975	Community Patent Convention (CPC)
1978	Convention for the Protection of New Varieties of Plants (UPOV)
1980	Rome Convention
1991	Rio Convention on Bio-Diversity

5. International Treaties, Agreements, Model Laws, declaration, directives etc.

1891	Madrid Agreement for the Repression of False or Deceptive Indication of Source on Goods
------	---

1948	Universal Declaration of Human Rights
1966	International Covenant on Economic, Social, and Cultural Rights
1966	International Covenant on Civil and Political Rights
1970	Patent Co-operation Treaty
1975	Declaration on the use of Scientific and Technological Progress in the Interests of Peace and for the Benefit of Mankind
1976	Tunis Model Law on Copyright for Developing Countries
1977	Budapest Treaty –Treaty on the International Recognition of the Deposit of Micro- organisms for the Purpose of Patent Procedure
1981	The Nairobi Treaty for the Protection of Olympic Symbol
1982	WIPO-UNESCO Model Provisions for National Laws on the Protection of Expressions of Folklore against Illicit Exploitation and other Prejudicial Actions
1994	Trade Mark Law Treaty
1994	Agreement on Trade-Related Aspects of Intellectual Property Rights
1995	South Asian Preferential Trade Area (SAPTA)
1996	WIPO Copyright Treaty
1996	Agreed statements concerning the WIPO Copyright treaty
1996	WIPO Performances and Phonograms Treaty
1996	Agreed statements concerning the WIPO Performances and Phonograms Treaty
1996	United Nations Commission on International Trade Law (UNCITRAL) Model Law on Electronic Commerce with Guide to Enactment
2000	E-commerce Directives (Directive 2000/31/EC of the European Parliament)
2000	Copyright Directives (Directive 2001/29/EC of the European Parliament)
2001	Directive 2001/29/EC of the European Parliament and of the Council on the harmonisation of certain aspect of copyright and related rights in the information society
2004	Agreement on South Asian Free Trade Area (SAFTA)

6. Bilateral investment treaties

1963	Bilateral Agreement between Sri Lanka and Federal Republic of Germany
1980	Bilateral Agreement between Sri Lanka and the United Kingdom of Great Britain Northern Ireland
1980	Bilateral Agreement between Sri Lanka and Republic of Korea
1980	Bilateral Agreement between Sri Lanka and Republic of France
1980	Bilateral Agreement between Sri Lanka and Republic of Singapore
1981	Bilateral Agreement between Sri Lanka and Republic of Romania
1981	Bilateral Agreement between Sri Lanka and Switzerland
1982	Bilateral Agreement between Sri Lanka and Japan
1982	Bilateral Agreement between Sri Lanka and Belgo-Luxembourg
1982	Bilateral Agreement between Sri Lanka and Malaysia
1982	Bilateral Agreement between Sri Lanka and Sweden
1982	Bilateral Agreement between Sri Lanka and Canada
1984	Bilateral Agreement between Sri Lanka and the Kingdom of Netherlands
1985	Bilateral Agreement between Sri Lanka and Republic of Finland

- 1985 Bilateral Agreement between Sri Lanka and the Kingdom of Denmark
 1985 Bilateral Agreement between Sri Lanka and Norway
 1985 Bilateral Agreement between Sri Lanka and People's Republic of China
 1986 Bilateral Agreement between Sri Lanka and Republic of Italy
 1987 Bilateral Agreement between Sri Lanka and the United States of America
 1991 Bilateral Agreement between Sri Lanka and Thailand
 1996 Bilateral Agreement between Sri Lanka and Egypt
 1996 Bilateral Agreement between Sri Lanka and Republic of Indonesia
 1996 Bilateral Agreement between Sri Lanka and Egypt
 1997 Bilateral Agreement between Sri Lanka and the Republic of India
 1997 Bilateral Agreement between Sri Lanka and the Islamic Republic of Pakistan

7. Selected text and monographs

- Abeynayake, Oliver. *Fundamentals of Buddhist Polity* (Singapore: Ti-Sarana Buddhist Association, 1995)
- Abeysekere, I. N. *Sri Lankan Copyright and the TRIPS Agreement*; (Colombo: Mahapola Higher Education Scholarship Trust Fund, 1999)
- Abeyasinghe, T. *Portuguese Rule in Ceylon* (Colombo: Lake House Investment Limited, 1966)
- Adikaram, E. W. *Early History of Buddhism in Ceylon* (Migoda, Ceylon: D. S. Puswella, 1946)
- Alford, W.P. *To Steal a Book Is an Elegant Offense: Intellectual Property Law in Chinese Civilisation* (Stanford: Stanford University Press, 1995)
- Amerasinghe, A.R.B. *The Legal Heritage of Sri Lanka* (Sri Lanka: Sarvodaya Vishvaleka, 1999)
- Annand, R, and H. Norman. *Blackstone's Guide to the Trade Mark Act 1994* (London: Blackstone Press Ltd., 1999)
- Antons, Christopher. *Intellectual Property Law in Indonesia* (London: Kluwer Law International, 2000)
- Ariyadasa Kumarasinghe, *Vaidyaka Sarartha Sangraha* (Colombo: Department of Museums, 1986),
- Ariyapala, M.B. *Society in Medieval Ceylon (The State of Society in Ceylon as Depicted in the Saddharma -Ratnavaliya and Other Literature of the Thirteenth Century* (Colombo: The Colombo Apothecaries Co. Ltd, 1956)
- Armour, John, *Grammar of the Kandyan Law* (Colombo: Ceylon Times Press Co., 1880)
- Belson, Jeffery. *Special Report-Certification Marks* (London: Sweet and Maxwell, 2002)

- Bently, L and B. Sherman. *Intellectual Property 2nd* (edn) (Oxford: Oxford University Press, 2001)
- Bently, L and B. Sherman, *Making of Modern Intellectual Property Law the British Experience (1760-1911)* (Cambridge: Cambridge University Press, 1999)
- Blakeney, M (ed). *Intellectual Property Aspects of Ethnobiology* (London: Sweet & Maxwell, 1999)
- Blakeney, M. *Trade Related Aspects of I.P. Rights: a Concise Guide to TRIPS Agreement* (London: Sweet & Maxwell, 1996)
- Blakeney, M. (ed). *Border Control of Intellectual Property Rights* (London: Sweet & Maxwell, 2003)
- Blakeney, M. *Legal Aspects of Technology Transfer to Developing Countries.* (Oxford: Oxford: ESC, 1989)
- Blanco, White, T.A., & Robin Jacob (ed). *Kerly's Law of Trade Marks and Trade Names.* 10th (edn) (London: Sweet & Maxwell, 1972)
- Bone, R. 'Exploring the Boundaries of Competitive Secrecy: An Essay on the Limits of Trade Secret Law', in *Law, Information and Information Technology*, E. Lederman and R. Shapira (ed) (The Hague: Kluwer)
- Bowman, Gilfillan John & Midrand Kernic. *South Africa, Trade Marks & Names* (Pretoria - West: Gutenberg Book Printers, 1984)
- Brohier, R.L. *Ancient Irrigation Works in Ceylon* (Colombo: Ceylon Government Press, 1935)
- Campbell, D (ed). *Unfair Trade Practices* (London: Kluwer, 1997)
- Campbell, Dennis and Susan Cotter, (eds). *International Intellectual Property Law: Global Jurisdictions* (United Kingdom: Jhon Wiley & Sons, 1996)
- Cantuarina Martin, P.L. *Providing Protection for Plant Genetic Resources. Patents, Sui Generis Systems and Biopartnerships* (The Hague: Kluwer, 2002)
- Caves, Richard, E. *Creative Industries: Contracts Between Art and Commerce* (Harvard Univ. Press: 2000)
- Chandradasa Kahandawa Arachchi (ed.). *Deepawansaya* (Sri Lanka: S. Godage Brothers, 1997)
- Chissick, M and A. Kelman. *Electronic Commerce Law & Practice.* (London: Sweet & Maxwell, 2002)

- Chissick, Michael and Alistair Kelman. 'Data Protection, Webvertising'. Chap. in *Electronic Commerce Law and Practice*. Chapter 7 and 8. (London: Sweet & Maxwell, 1999)
- Chisum, Donalds, S., and Michael A Jacobs. *Understanding Intellectual Property Law*. (New York: Matthew Bender & Co., Inc., 1992)
- Codrington, H.W. *Ceylon Coins and Currency*. (Colombo: 1924, Reprint New Delhi 1994).
- Cooray, L.J.M. *An Introduction to the Legal System of Ceylon* (Colombo: Lake House Investment Ltd, 1972)
- Cooray, M.J.A. *Judicial Role under the Constitutions of Ceylon/Sri Lanka- A Historical and Comparative Study*, (Sri Lanka: Lake House Investment Ltd, 1982)
- Copinger and Skone James. *Law of Copyright*, E.P. Skone James et al (ed). 14th (edn) (London: Sweet & Maxwell, 2001)
- Cornish, W. *Cases and Materials on Intellectual Property* (London: Sweet & Maxwell, 2003)
- Correa, Carlos M. *Intellectual Property Rights, the WTO and Developing Countries: The TRIPS Agreement and Policy Options* (Malaysia: Zed Books, 2000)
- Correa, C.M. *Intellectual Property Rights, the WTO and Developing Countries* (London: Zed Books, 1999)
- Davy, John. *An Account of the Interior of Ceylon* (Dehiwala, Sri Lanka: Tisara Prakasakayo, 1969)
- Dawson, Norma. *Certification Trade Marks - Law and Practice* (London: IPP, 1988)
- de Kroon A.M.E. 'Protection of Copyright Management Information,' in *Copyright and Electronic Commerce. Legal Aspects of Electronic Copyright Management*, ed. by P.B. Hugenholt (Kluwer Law International, 2000)
- De Silva, Colin. *Ceylon Under the British Occupation, 1795-1833* (Colombo: Colombo Apothecaries' Co, 1953)
- De Silva, K.M (ed). *Sri Lanka- A Survey* (London: C. Hurst & Company, 1977)
- De Silva, K.M. *A History of Sri Lanka* (Delhi: Oxford University Press, 1981)
- Dissanayake, T.B., and A.B.de Soysa. *Kandyan Law and Buddhist Ecclesiastical Law*. (Maradana, Sri Lanka: Dharmasamaya Press, 1963)
- D'Oyly, John. *A Sketch of the Constitution of the Kandyan Kingdom*. Turner., L.J.B., 2nd (edn) (Sri Lanka: Department of Statistics and Office Systems, 1929; Tisara Prakasakayo Ltd, 1975)

- Drahos, P., and Braithwaite. *Information Feudalism: Who Owns the Knowledge Economy?* (London: Earthscan, 2002)
- Drahos, P. *A Philosophy of Intellectual Property*, (Aldershot, 1996)
- Dreyfuss, Rochelle Cooper, Diane Leenheer Zimmerman and Harry First. *Expanding the Boundaries of Intellectual Property: Innovation Policy for the Knowledge Society* (Oxford: Oxford University Press, 2001)
- Dworkin, Gerald and Richard D Taylor. *Blackstone's Guide to the Copyright, Designs and Patents Act 1988* (London: Blackstone Press Limited, 1994)
- Edwards, Lilian and Charlotte Waelde (ed). *Law and the Internet- A Framework for Electronic Commerce*, 2nd (edn) (Oxford: Hart Publishing, 2000)
- Elawala, H. *Social History of Early Ceylon* (Colombo: Department of Cultural Affairs, 1969)
- Endeshow, A. *Intellectual Property Policy for Non-Industrial Countries* (Dartmouth: Aldershot, 1996)
- Feer M. Leon (ed). *Samyutta Nikaya* (Oxford University Press: Pali Text Society, 1894)
- Firth, A. (ed.). *The Prehistory and Development of Intellectual Property Systems*, (London: Sweet & Maxwell, 1997)
- Firth, A., and E. Barendt (ed). *Yearbook of Copyright and Media Law VI 2001-2* (Oxford: Oxford University Press, 2002)
- Firth, Alison, and D. M. Raybould. *Law of Monopolies: Competition Law and Practice in the USA, EEC, Germany and the UK*. (Kluwer Law International, 1991)
- Firth, Alison. 'Collectivity, Control and Joint Adventure: Observations on Marks in Multiple Use', in *Trade Marks Retrospective*, ed. by Alison Firth and Norma Dawson (London: Sweet & Maxwell, 2000)
- Firth, Alison and E. Barendt (ed). *Yearbook of Copyright and Media Law IV 1999* (Oxford: Oxford University Press, 1999)
- Firth, Alison, *Copyright, Designs and Patents Act 1988* (London: Sweet & Maxwell, 1988)
- Firth, Alison. *Trade Marks: the New Law* (London: Jordans, 1995)
- Firth, Alison., Shelley Lane, and Yvonne Smyth, (ed). *Reading in Intellectual Property*. (London: Sweet and Maxwell, 1998)

- Fiscor, Mihaly. *The Copyright and The Internet: The WIPO Treaties and Their Implementation* (Oxford: Oxford University Press, 2002)
- Fitzgerald, Anne., Brian Fitzgerald, Peter Cook, and Cristina Cifuentes (ed). *Going Digital, Legal Issues for Electronic Commerce, Multimedia and the Internet* (New South Wales: Prospect Media Pty Ltd, 1998)
- Flint, Michael, F., Nicholas Fitzpatrick and Clive D. Thorne. *A User's Guide to Copyright*. 5th. (London: Butterworths, 2000)
- Geiger, Wilhelm (ed.). *Culavamsa, Being the More Recent Part of the Mahavamsa*. (London: Pali Text Society, 1980)
- Geiger, Wilhelm (trans). *The Mahavasa or the Great Chronicle of Ceylon* (Colombo: The Ceylon Government Information Department, 1950)
- Geiger, Wilhelm (trans. to English). *The Mahavamsa or the Great Chronicle of Ceylon*. (London: The Pali Text Society, 1912)
- Gendreau, Y, A. Nordemann and R. Oesch. *Copyright and Photographs: an International Survey* (Kluwer Law International, 1999)
- Gendreau, Ysolde. 'A Technologically Neutral Solution for the Internet: Is it Wishful Thinking' in *Copyright in the New Digital Environment: The Need to Redesign Copyright*, ed. by Torremans, P and I. Stamatoudi (London: Sweet & Maxwell, 2000)
- Gervais, D. *The TRIPs Agreement. Drafting History and Analysis* (London: Sweet & Maxwell, 1998)
- Gombrich, Richard F. *Precept and Practice: Traditional Buddhism in the Rural Highlands of Ceylon* (Oxford: Clarendon Press, 1971)
- Gooneratne, Camena, S. Tiitawella. et al, in *Constitution Law (Devolution)*, ed. by Tissa Hemaratne and Sunehtra Goonetilleke (Sri Lanka: Open University of Sri Lanka, 2000)
- Govaere, I. *The Use and Abuse of Intellectual Property Rights in EC Law* (Sweet & Maxwell, 1996)
- Grewlich, K.W. *Governance in Cyberspace. Access and Public Interest in Global Communications* (Kluwer, 1999)
- Gringras, C. *The Laws of the Internet*, (London: Butterworths, 2003)
- Groom, John., Recharad Abnett, Jeremy Pennant, and Adrian Spencer. *UK Trade Marks Act 1994: A Practical Guide*. (London: Longman Group Ltd., 1994)

- Gunawardana, R.A.L.H. *Robe and Plough, Monasticism and Economic Interest in Early Medieval Sri Lanka*. (Tucson: University of Arizona Press, 1989)
- Guruge, Ananda W.P (ed.). *Mahavamsa (The Great Chronicle of Sri Lanka)*. (Sri Lanka: Associate News Papers of Ceylon Limited, 1998)
- Hart, H.L.A. *Law, Liberty, and Morality*. (Oxford: Oxford University Press, 1963)
- Hart, H.L.A. *The Concept of Law*. (Oxford. 2nd 1994. Clarendon, 1961)
- Hayley, F.A. *Laws, and Customs of Sinhalese*. (Colombo: H.W.Cave and Co, 1923)
- Heath, Christopher., and Anslem Kamperman Sanders. *Intellectual Property in the Digital Age, Challenge for Asia* (Netherlands: Kluwer Law International, 2001)
- Heath, K and Liu, Kung-Chung (eds.). *The Protection of Well-Known Trademarks in Asia*. (Kluwer Law International, 2000)
- Hemaratne, Tissa. 'Introduction to the Legal System in Sri Lanka', in *Understanding Law* (Sri Lanka: Open University of Sri Lanka, 200)
- Hettiaratchi, S. B. *Social and Cultural History of Ancient Sri Lanka*. (Delhi: Sri Satguru Publications, 1988)
- Heyley, Fedric Austin. *A Treaties on the Laws and Customs of Sinhalese*. (Colombo: H.W.Cave and Co., 1923)
- Hodgson, Geoffrey M. *Economics and Institutions*. (Cambridge: Polity Press, 1998)
- Hoffman, Barbara (ed). *Exploiting Images and Image Collections in the New Media- Gold Mine or Legal Minefield ?* (United Kingdom: Kluwer Law International, 1999)
- Hugenholtz, B (ed). *The Future of Copyright in A Digital Environment* (The Hague: Kluwer Law International, 1996)
- Hugenholtz, Brent P (ed). *Copyright and Electronic Commerce- Legal Aspects of Electronic Copyright Management* (London: Kluwer Law International, 2000)
- Hugenholtz, B. *The Future of Copyright in A Digital Environment* (The Hague: Kluwer Law International, 1996)
- Inoue, Shinchi. *Putting Buddhism to Work A New Approach to Management and Business*, (Tokyo: Kodansha International Ltd., 1977)

- Jayabahu Devarakkhita of Gadaladeniya., C. M. Fernando (trans) and W. F. Gunawardhana (ed). *Nikaya Sangrahaya: Being a History of Buddhism in India and Ceylon* (Colombo: H. Ross Cottle, Govt. Printer, 1908)
- Jayasekera, M.L.S. *Customary Laws of Sri Lanka in Their Historical and Cultural Background* (Colombo: Ministry of Cultural Affairs, 1984)
- Jayasuriya, W.F. *The Psychology and Philosophy of Buddhism (Being an Introduction of Abhidhamma)*. (Colombo: Y.M.B.A. Press, 1963)
- Jayatillake, K.N. *Early Buddhist Theory of Knowledge* (London: George Allen & Unwin Ltd, 1963)
- Jenson, Eric. *Introduction to International Law in Sri Lanka*. (Colombo: The Open University of Sri Lanka, 1989)
- Kahandawa Arachchi, Chandradasa (ed.). *Deepawansaya* (Sri Lanka: S. Godage Brothers, 1997)
- Kamperman Sanders, A. *Unfair Competition Law*. (Oxford: Clarendon Press, 1997)
- Karunaratna, D.M. *A Guide to Law of Trade Marks and Service Marks in Sri Lanka*. (Colombo: Vishva Lekha, 1997)
- Keown, D. *Buddhism and Bioethics* (London: Macmillan, 1995)
- Khaw Lake Tee. *Copyright Law in Malaysia* (Singapore: Butterworths Asia, 1994)
- Kidder, Robert, *Towards an Integrated Theory of Imposed Law*, ed. by Sandra Burman and Barbara E. Harrell Bond (New York: Academic Press, 1979)
- Kitchin, David., and James Mellor. *The Trade Marks Act 1994 - Text and Commentary*. (London: Sweet & Maxwell, 1995)
- Knighton, William. *The History of Ceylon from the Earliest Period to the Present Time*. (London: Longman, Brown, Green, 1845)
- Knox, Robert. *An Historical Relation of Ceylon(1681)*, ed. by James Ryan (Glasgow: 1911)
- Koelman, K.J and N. Helberger. 'Protection of Technological Measures,' in *Copyright and Electronic Commerce. Legal Aspects of Electronic Copyright Management*, (Kluwer Law International, 2000)
- Koelmman, K.J. 'Online Intermediary Liability', in *Copyright and Electronic Commerce. Legal Aspects of Electronic Copyright Management*,, ed. by P.B. Hugenholtz (Kluwer Law International, 2000)

- La Vina, A.G.M. 'Intellectual Property Rights and Indigenous Knowledge of Biodiversity in Asia' in *International Trade Regulation*, ed. by J. Kelsey (Ashgate, Dartmouth, 2001)
- Laddie, H., Peter Prescott. et al. *The Modern Law Copyright of and Designs*. 3rd (edn). (London: Butterworths, 2000)
- Le Mesurier C.R.J, and T.B. Panabokke (Trans). *Niti-Nighanduwa or the Vocabulary of Law. As it Existed in the Days of the Kandyan Kingdom*, (Colombo: Government Printer, 1880; repr. Navarang, New Delhi, 1994)
- Leach, E (ed.). *Aspects of Caste in South India, Ceylon and North-West Pakistan* (Cambridge: Cambridge University Press, 1960)
- Lee, R.W. *An Introduction to Roman Dutch Law*, 5th (edn) (Colombo: Government Press, 1953)
- Lippert, O. *Competitive Strategies for Intellectual Property Protection*, (Vancouver: The Fraser Institute, 1999)
- Liyanratne, Jinadasa. *Bhesajjamanjusa*. (Oxford: Pali Text Society, 1996)
- Liyanratne, Jinadasa. *Buddhism and Traditional Medicine in Sri Lanka*. (Sri Lanka: Kelanya University Press, 1999)
- Lloyd, Ian J. *Information Technology Law*. 3rd (edn). (London: Butterworths, 2000)
- McCarthy, Thomas, J. *McCarthy on Trade Marks and Unfair Competition* (USA: Thomson West, 2004)
- Mac Cormick. *H.L.A.Hart*. (Edinburgh: Edinburgh University Press, 1981)
- Main, H.S. *Village Communities in the East and West*, 7th (edn) (London: J. Murray, 1895)
- Makeen, M.F. *Copyright in a Global Information Society. The Scope of Copyright Protection Under International, US, UK and French Law* (Kluwer Law, 2000)
- Malalasekera G.P (ed). in *Encyclopaedia of Buddhism* (Colombo: The Government of Ceylon, 1960)
- Malloy, R.P. *Law and Market Economy: Reinterpreting the Values of Law and Economics*. (Cambridge: Cambridge University Press, 2000)
- Marshall, J.N. *Guide to the Nice Agreement Concerning the International Classification of Goods and Services*. (Dobbs Ferry, New York: Oceana Publications, 2000)
- Maxwell, P.B. *Maxwell on the Interpretation of Statutes*, ed. by Langan, P St. J, 12th (edn) (London: Sweet and Maxwell, 1969)

- McKeough, Jill., and Andrew Stewart. *Intellectual Property in Australia*. 2nd (edn) (Sydney: Butterworths, 1997)
- McKerron, R.G. *Law of Delict*. 7th (edn) (Cape town: Juta and Co. Ltd., 1971)
- Mendis, Garrett Champness. *The Early History of Ceylon*. (Calcutta: Y.M.C.A. Publishing House, 1932)
- Merges, R.P., P.S. Menell and M.A. Lemley. *Intellectual Property in the New Technological Age* (New York, New York: Aspen, Gaithesburg, 2000)
- Mirando, A. H. *Buddhism in Sri Lanka in the 17th and 18th Centuries, with Special Reference to Sinhalese Literary Sources*. (Dehiwala, Sri Lanka: Tisara Prakasakayoo, 1985)
- Mirando, B.V. *Critical Analysis of the Trade Marks under the Code of Intellectual Property Act, No.52 of 1979* (Colombo: Vijitha Yapa Publications, 1999)
- Morcom, Christopher. *Service Marks A Guide to the New Law* (Oxford: ESC Publishing Limited, 1987)
- Nadaraja, T. *The Legal System of Ceylon in Its Historical Setting*, (Brill: Leiden, 1972)
- Narayanan, P. *Copyright Law*. (Calcutta: Eastern Law House, 1986)
- Narayanan, P. *Trade Mark Trade Name and Passing off Cases. Vol.1 & 2*. 2nd (edn) (London: Sweet & Maxwell, 1997)
- Needham, Joseph. *Science and Civilisation in China-Physics and Physical Technology* (Cambridge: Cambridge University Press, 1974), Vol. 4
- North, Douglass C. *Institutions, Institutional Change, and Economic Performance*. (Cambridge: Cambridge University Press, 1990.)
- Paranavitana, S. *Civilization of the Polonnaru Period: Religion, Literature and Art.*, ed. by H. C. Ray, Vol. 1, pt. I, History of Ceylon (Colombo: Ceylon University Press, 1960), 563
- Paranavitana, S., and C.W.A. Nicholas. *A Concise History of Ceylon: From the Earliest Times to the Arrival of the Portuguese* (Colombo: Ceylon University Press, 1961)
- Paranavitana, S. *Inscriptions of Ceylon* (Colombo: The Department of Archaeology, 1970, 1983), Vol. I and II
- Paranavitana, Senarat. *The Story of Sigiri*. (Colombo, Sri Lanka: Lake House Investment Limited Book Publishers, 1972)

- Paranavithana, S. *Sigiri Graffiti, Being Sinhala Verses of the Eighth, Ninth and Tenth Centuries*. (Oxford: Oxford University Press for the Government of Ceylon, 1956)
- Paxton, John, and Sheila Fairfield. *Calendar of Creative Man*. (London: The Macmillian Press Ltd., 1979)
- Peiris, G.L. *Background Reading Material on the Intellectual Property System of Sri Lanka*. (Geneva: World Intellectual Property Organisation, 1991)
- Phang Boon Leong, Andrew. *The Development of Singapore Law*. (Singapore: Butterworths, 1990)
- Phear, John. *The Aryan Village in India and Ceylon* (New Delhi: Asian Publishing Service, 1890 Reprint 1995)
- Phillips, J. *Trade Mark Law. A Practical Anatomy*. (Oxford: Oxford University Press, 2003)
- Phillips, Jeremy and Alison Firth. *Introduction to Intellectual Property Law*, 4th (edn) (London: Butterworths, 2001)
- Pickering, C.D.G. *Trade Marks in Theory & Practice*. (Oxford: Hart Publishing, 1998)
- Pierce, J and I. Purvis. *Working with Technology: Law & Practice*. (London: Sweet & Maxwell, 2001)
- Pieris, R. *Sinhalese Social Organisation the Kandyan Period* (Colombo: Ceylon University Press, 1960)
- Pinto, Newton. *A Short History of Sinhalese Literature*. (Colombo: M.D.Gunasena, 1954)
- Pollaud-Dulian, Frederic. *Internet and Authors' Rights(Perspectives on Intellectual Property)* (London: Sweet & Maxwell, 1999)
- Rahula, W. *What the Buddha Taught*. Reprint. (London: The Golden Fraser Gallery Ltd., 1982)
- Rahula, Walpola. *History of Buddhism in Ceylon*. (Colombo: M.D. Gunasena, 1956)
- Rahula, Walpola. *History of Buddhism in Ceylon: The Anuradhapura Period, 3rd Century B.C.-10th Century A.D.* (Colombo: M.D. Gunasena, 1966)
- Ralapanawe, Mahinda. *Decided Copyright Cases in Sri Lanka*.(Sri Lanka :Saman & Madara Publishers, 1988)
- Ramappa, T. *Intellectual Property Rights Under WTO-Tasks Before India*. (New Delhi: Wheeler Publishing, 2000)

- Ratnapala, Nandasena. *Sinhalese Folklore, Folk Religion, and Folk Life*. (Dehiwala, Sri Lanka: Sarvodaya Research, 1980)
- Raven-Hart, R. *Ceylon - History in Stone*. (Colombo, Sri Lanka: The Associated Newspapers of Ceylon, Ltd. Lakehouse, 1964)
- Ray, H.C (ed). *History of Ceylon* (Colombo: Ceylon University Press, 1960)
- Raz, Joseph. *The Authority of Law Essays on Law and Morality*. (Oxford: Clarendon Press, 1979)
- Raz, Joseph. *The Concept of a Legal System- An Introduction to the Theory of Legal System*. 2nd. (Oxford: Clarendon Press, 1980)
- Ricketson, S. *The Berne Convention:1886-1986*. (London: Centre for Commercial Law Studies, Queen Mary, University of London, 1987)
- Richard O'Dair and Andrew Lewis (ed). *Law and Religion- Current Legal Issues*. Vol 4. (Oxford: Oxford University Press, 2001)
- Reed, C. *Internet Law 2nd* (edn) (Cambridge: Cambridge University Press, 2004)
- Ricketson, Staniforth. *The Law of Intellectual Property* (Sidney: The Law Book Company Limited, 1984)
- Riis,Thomas. *Intellectual Property Law in Denmark* (Hauge: Kluwer Law International, 2000)
- Robertson, G and A. Nicol. *Media Law* (Sweet & Maxwell, 2002)
- Ryan, B. *Caste in Modern Ceylon* (New Brunswick: Rutgers University Press, 1953)
- Saddhatissa, H. *Buddhist Ethics: Essence of Buddhism*. (London: George Allen & Unwin Ltd, 1970)
- Savage, Nigel C, and Ian Walden. *Information Technology and the Law*. (Hampshire, England: Palgrave Macmillan, 1990)
- Sherman, Brad. 'Remembering and Forgetting: The Birth of Modern Copyright Law', in *Comparing Legal Cultures*, ed. by David Nelkin (Aldershot: Dartmouth Press, 1997)
- Smith, Graham J.H. *Internet Law and Regulation*. 3rd (edn) (London: Sweet & Maxwell, 2002)
- Snodgrass, Donald R. *Ceylon: An Export Economy in Transition* (Homewood, Illinois: Richard D. Irwin, 1966.)

- Sodipo, B. *Piracy and Counterfeiting: GATT TRIPS and Developing Countries*. (London: Kluwer Law International, 1997)
- Somaratne, G.P.V. *The Political History of the Kingdom of Kotte, 1400-1521* (Nugegoda, Sri Lanka: Deepanee Printers, 1975)
- Southwold, Martin. *Buddhism in Life: The Anthropological Study of Religion and the Practice of Sinhalese Buddhism*. (United Kingdom: Manchester University Press, 1983)
- Stamatoudi, I.A. *Copyright and Multimedia Products. A Comparative Analysis* (Cambridge: Cambridge University Press, 2002)
- Stechter, M. *Webvertising: Unfair Competition and Trademarks on the Internet*. (Hague: Kluwer Law International, 1999)
- Sterling, J.A.L. *World Copyright Law 2nd* (edn) ((London: Sweet & Maxwell, 2003)
- Sterling, J.A.L. *Intellectual Property Rights in Sound Recordings, Film and Video* (London: Sweet & Maxwell, 1992)
- Stewart, S.M. *International Copyright and Neighbouring Rights 2nd* (edn) (London: Butterworths, 1989)
- Tambiah, H.W. *Principles of Ceylon Law* (Colombo: Cave & Co., 1972)
- Thambiah, H.W. *Sinhala Laws and customs* (Colombo: Lake House Investment Limited Co., 1968)
- Tanenbaum, Andrew, S. *Computer Networks. 3rd* (edn) (Prentice Hall Inc., 1996)
- Tennent, Sir James Emerson. *Ceylon: An Account of the Island*. (London: Longman, Green, Longman, and Roberts, 1860)
- Torremans, P., and I. Stamatoudi. *Copyright in the New Digital Environment: The Need to Redesign Copyright* (London: Sweet & Maxwell, 2000)
- Von Lewinski, S., and J. Reinbothe. *WIPO Treaties 1996: the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty. Commentary and Legal Analysis*, (London: Butterworths, 2002)
- Wadham, John., Johnathan Griffiths and Bethan Rigby. *Blackstone's Guide to the Freedom of Information Act 2000(Blackstone's Guide Series)* (Blackstone Press, 2001)
- Wadlow, C. *Enforcement of Intellectual Property in Europe and International Law*. (London: Sweet and Maxwell, 1998)

Wadlow, C. *The Law of Passing Off*. (London: Sweet & Maxwell, 1995)

Watal, Jayashree. 'Implementing the TRIPS Agreement on Patents: Optimal Legislative Strategies for Developing Countries', in *Competitive Strategies for the Protection of Intellectual Property*, ed. by Lippert, Owen (Canada: The Fraser Institute, 1999)

Watal, Jayashree. *Intellectual Property Rights in the WTO and Developing Countries*. (Netherlands: Kluwer Law International, 2001)

Watt, R. *Copyright and Economic Theory: Friends or Foes?*. (Celtenham: Edward Elgar, 2000)

Webster, G C., and N.S. Page. *South African Law of Trade Marks, Unlawful Competition, Company Names and Trading Styles*. 3rd. (Durban: Butterworths, 1986)

Wellman, Carl. *An Approach to Rights- Studies in the Philosophy of Law and Morals*. (Netherlands: Kluwer Academic Publishers, 1997)

Wickremasinghe, Don Martino De Silva (Ed. & trans.). *Epigraphia Zelanica Being Lithic and Other Inscriptions of Ceylon*. (London: Oxford University Press, 1912)

Wijesinghe, L.C (trans). *Mahavansa- Part II*. (Colombo: Government Printers, 1889)

Wijetunge, Harishchandra. *Sinhala Shabdakoshaya (Practical Sinhala Dictionary)*. (Colombo: Ministry of Cultural Affairs, 1982)

WIPO, *Protection Against Unfair Competition* (Geneva: WIPO, 1994)

Yalman, Nur. 'The Structure of Sinhalese Healing Rituals', in *Religion in South Asia*, ed. by E. B. Harper (Seattle: Asian Society, 1964)

York, S. *E-Commerce: A Guide to the Law of Electronic Busines*. (London: Butterworths, 1999)

8. Selected journal articles and papers

Abeleda, Lamberto, O. 'Digital Compensation: Recording Artists' Collective Fight for True and Fair Compensation', *Sw.U.L.Rev.*, 31 (2002), 701

Abeysekera, I.N. 'Copyright Law and Practice in Sri Lanka', *IIC*, 28. 1 (1998), 27

Acharya, R. 'Intellectual Property Rights and Information Technology: The Impact of the Uruguay Round on Developing Countries', *I. & C.T.L.5*. 2 (1996), 146

Adams, J.N. 'Trespass in A Digital Age', *I.P.Q.*, (2002), 1

- Addor, F and A. Grazioli, Geographical Indications beyond Wines and Spirits. A Roadmap for a Better Protection for Geographical Indications in the WTO/TRIPs Agreement, *J.W.I.P.* (2002), 865
- Adrian, Angela, 'Who Owns the Copyright in Multi Author Interactive Works?', *Ent.L.Rev.*, 14. 2 (2003), 35
- Akester, Patricia. 'Survey of Technological Measures for Protection of Copyright', *Ent.L.Rev.*, 12. 1 (2001), 36
- Amrozowicz, Paul D. 'When Law, Science and Technology Worlds Collide: Copyright Issues on the Internet', *JPTOS*, February (1999), 81
- Athanasekou, P. Eve. 'Internet and Copyright: An Introduction to Caching, Linking and Framing', *JILT*, 2 (1998)
- Azmi, I.M. 'Domain Names and Cyberspace: the Application of Old Norms to New Problems', *I.J.L & I.T.*, (2000), 193
- Band, Jonathan. 'The Digital Millennium Copyright Act: A Balance Result', *E.I.P.R.*, (1999), 92
- Barcelo, R.J. 'On Line Intermediary Liability Issues: Comparing E.U. and U.S. Legal Frameworks', *E.I.P.R.*, (2000), 105
- Barnhart, Michael G. 'Nature, Nature and No-Self Bioengineering and Buddhist Values', *J. Budd.Ethics*, 7 (2000), 126
- Bath, U. 'Access to Information v. Intellectual Property Rights', *E.I.P.R.*, (2002), 138
- Belson, Jeffrey. 'Certification Marks, Guarantees and Trust', *E.I.P.R.*, (2002), 342
- Benson, C. 'Fair Dealing in the United Kingdom', *E.I.P.R.*, (1995), 304
- Bettinger, T. 'Trade Mark Law in Cyberspace- The Battle for Domain Names', *I.I.C.*, 28 (1997), 508
- Bettinger, Torsten, and Dorothee Thum. 'Territorial Trade Mark Rights in the Global Village- International Jurisdiction, Choice of Law and Substantive Law for Disputes on the Internet, Part I & II.', *I.I.C.*, 31 (2000), 162
- Blair, Jonathan & Bamford. Mark, 'Sounds Unlimited Music and Copyright in Cyberspace-', *Copyright World*, May/June, (1998), 20
- Blakeney, M. 'Bioprospecting and the Protection of Traditional Medical Knowledge of Indigenous Peoples: An Australian Perspective', *E.I.P.R.*, (1997), 298

- Blakeney, M. 'Proposals for the International Regulation of Geographical Indications', *J.W.I.P.*, 4 (2001), 629
- Blakeney, M. 'The Protection of Traditional Knowledge Under Intellectual Property Law', *E.I.P.R.*, (2000), 251
- Blakeney, Michael, 'Geographical Indications and Trade', *Int. TLR*, (2000), 48
- Blakeney, Michael. 'The Impact of the TRIPs Agreement in the Asia Pacific Region', *E I PR*, (1996), 544
- Blakeney, Michael. "Interfacing Trade Marks and Domain Names," *Murdoch University Electronic Journal of Law*, 6,2 (March,1999)
- Bogsch, Arpad. 'Trademarks in 2017: Their Creation and Protection', *TMR*, 82 (1992), 880
- Booton, D. 'Framing Pictures: Defining Art in UK Copyright Law', *I.P.Q.*, (2003), 38
- Bowrey, Kathy. 'Who's Writing Copyright's History', *E.I.P.R.*, (1996), 322
- Breyer, S. 'Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs', *Harv.LR*, 84 (1970), 281
- Bronckers, M.C.E.J. 'The Impact of TRIPS: Intellectual Property Protection in Developing Countries', *C.M.L.R.*, 31 (1994), 1245
- Brown, A.L. 'The Increasing Influence of Intellectual Property Cases on the Principles of Statutory Interpretation', *E.I.P.R.*, (1996), 526
- Brudenall, Peter. 'The Future of Fair Dealing in Australian Copyright Law', *J.I.L.T.*, 1 (1997)
- Brunel, Andre, and May Liang. 'Trade Mark Troubles with Internet Domain Names and Commercial Online Service Screen Names: Roadrunning Right Into the Frying Pan', *I.J.L & I.T.*, 5. 1 (Spring 1997), 1
- Bugge, J.J and E.P. Greegersen. 'Requirement of Use of Trademarks', *E.I.P.R.*, (2003), 309
- Burk, Dan L. 'Trade Mark Doctrines for Global Electronic Commerce', 49 *S.C.L. Rev.* (1998) 695
- Burkitt, D. 'Copyrighting Culture - The History and Cultural Specificity of the Western Model of Copyright', *I.P.Q.*, (2001), 146
- Burrell, Robert. 'Reining in Copyright Law: Is Fair Use the Answer', *I.P.Q.*, 4 (2001), 361

- Bygrave, Lee A. 'The Technologisation of Copyright: Implications for Privacy and Related Interests', *E.I.P.R.*, (2002), 51
- Cabe, MC. Dilution-By-Blurring: A Theory Caught in the Shadow of Trademark Infringement, *Fordham Law Rev.*, (2000), 1827
- Campbell, K. 'Copyright on the Internet The View from Shetland', *E.I.P.R.*, (1997), 255
- Carter, S.L. 'The Trouble with Trademark', *Yale Law J* (1990), 759
- Carty, H, 'Registered Trade Marks and Permissible Advertising', *E.I.P.R.*, (2002), 294
- Cendali, D.M., C.E. Forssander, and R.J. Turiello, Jr. 'An Overview of Intellectual Property Issues Relating to the Internet', *TMR*, 89 (1999), 529
- Chalton, C. 'Database Right: Stronger Than it Looks?', *E.I.P.R.*, (2001), 296
- Chandrasahana, N. 'Roman Dutch in Ceylon-A Comment on De Costa v Bank of Ceylon', *Colom.L.R.*, 3 (1972), 74
- Chandran, Ravi. 'Copyright in Cyberspace: A Singapore Perspective', *JBL* (Mar. 2000), 192
- Chapman, A.R. 'The Human Rights Implications of Intellectual Property Protection', *JIEL*, 5 (2001), 861
- Chatterjee, Neel. and Adams Steve, 'The Ghost in the Machine: Trademark Liability Resulting from Meta Tags', *W.I.P.R.*, 16 (2002), 27
- Cheval, Davis, S. 'Copyright Protection in the Digital Age: The Case Against Napstar', *WVJOLT.*, 6. 1 (December 2001)
- Chissick, Michael. 'Data Protection in the Electronic Commerce Era', *Comp. & Telecom. L. R.*, 5. 4 (1999), 109
- Chong, Stephanie. 'Internet Meta-Tags and Trade Mark Issue', *E.I.P.R.*, (1998), 275
- Christie, A. 'Reconceptualising Copyright in the Digital Era', *E.I.P.R.*, (1995), 522
- Christie, A. 'The ICANN Domain Name Dispute Resolution System as a Model for Resolving Other Intellectual Property Disputes on the Internet', *J.W.I.P.*, 5 (2002), 105
- Clive, Thorne., and Simon Bennett. 'Domain Names- Internet Warehousing: Has Protection of Well-Known Names on the Internet Gone Too Far?', *E.I.P.R.*, (1998), 468
- Cohen, Julie E. 'WIPO Copyright Treaty Implementations in the United States: Will Fair Use Survive?', *E.I.P.R.*, (1999), 236

- Cohen, S. 'Jurisdiction Over Cross Border Internet Infringements', *E.I.P.R.*, (1998), 294
- Conrad, Albrecht. 'The Protection of Geographical Indications in the TRIPS Agreement', *TMR*, 86 (1996), 11
- Coombe, R.J. 'Intellectual Property, Human Rights & Sovereignty: New Dilemmas in International Law Posed by the Recognition on Indigenous Knowledge and the Conservation of Biodiversity', *Int. J. of Global Legal Studies*, 6 (1998), 59
- Cooray. L.J.M. 'Common Law of Ceylon', *C.L.S.J.*, X (1972), xlv-xlvii
- Cornish, W.R. 'Copyright across the Quarter-Century', *IIC* (1995), 801
- Correa, C.M. 'Fair Use in the Digital Era,' *IIC*, 33 (2002), 570
- Crews, K.D. 'Harmonization and the Goals of Copyright: Property Rights or Cultural Progress', *Int. J. of Global Legal Studies*, 6 (1998), 117
- Davies, G. 'Copyright and the Public Interest', *IIC*, 14 (1994), 220
- Dawson, Norma. 'Trade Mark Infringement by Referential Advertising', *JBL*, November (1987), 456
- Dawson, Norma. 'Advertising and the Legal Protection of Trade Marks: a Case Study of Ever Ready', *Comms L*, 6 (2001), 3
- Dawson, Norma. 'English Trade Mark Law in the Eighteenth Century: Blanchard v Hill Revisited Another Case of Monopolies?', *JLH.*, 24. 2 (2003), 111
- Dawson, Norma. 'Famous and Well-Known Trade Marks -Usurping a Corner of the Giant's Robe', *I.P.Q.*, 4 (1998), 350
- Dawson, Norma. 'Locating Geographical Indications? Perspectives from English Law', *TMR*, 90 (2000), 590
- Dawson, Norma. 'The Power of Colour in Trade Mark Law', *E.I.P.R.*, (2001), 383
- De Silva, K.M. 'Buddhism and the British Government in Ceylon, 1840-1855', *CJHSS.*, 10:1-4 (1960-61), 91
- Denicola, Robert, C. 'Copyright in Collections of Facts: A Theory of Protection of Nonfiction Literary Works', *Col LR.*, 81 (1981), 516
- Depoorter, B., and F. Parisi. 'Fair Use and Copyright Protection: a Price Theory Explanation', *Int. Rev. Law & Econ.*, 21 (2002), 453

- Diamond, Sidney A. 'The Historical Development of Trade Mark Law', *TMR*, 65 (1975), 265
- Dietz, Adolf. 'The Protection of Intellectual Property in the Information Age-The Draft E.U. Copyright Directive of November 1997', *IPQ*, 4 (1998), 335
- Diotalevi, Robert N. 'Copyrighting Cyberspace: Unweaving A Tangled Web', *Computer L. Rev. & Tech. L.J.*, Spring (1998), 105
- Dixon, Allen N. 'Legitimate Versus Illegitimate Commerce in Copyrighted Material', *Copyright World*, September (2000), 16
- Doellinger, Chad, J. 'Trade Marks, Metatags, and Initial Interest Confusion:A Look to the Past to Re-Conceptualize the Future', *IDEA*, 41. 2 (2001), 173
- Doherty, Michael and Ivor Griffiths. 'The Harmonisation of European Union Copyright Law for the Digital Age', *E.I.P.R.*, (2000), 17
- Douglas, Jennifer. 'Too Hot to Handle? Copyright Protection of Multimedia', *AIPJ.*, 8. May (1997), 96
- Dreier, T. 'Adjustment of Copyright Law to the Requirements of the Information Society', *IIC* (1998), 623
- Dreier, Thomas. 'Copyright in the Digital Technology', *IIC*, 14 (1993), 481
- Drescher, T D, 'The Transformation and Evolution of Trade Marks: From Signals to Symbols to Myths', *TMR*, 82 (1992), 301
- Duran, E., and Michalopoulos. C, 'Intellectual Property Rights and Developing Countries in the WTO Millennium Round', *J.W.I.P.*, 2. 6 (1999), 853
- Dyrberge, P and M. Skyly. Does Trade Mark Infringement Require That Infringing Use be Trade Mark Use and if so, What Is "Trade Mark Use"?, *E.I.P.R.*, (2003), 229
- Echerou, I.O. 'Linking to Trouble: Legal Liability Emanating from Hyperlinks on the World Wide Web', *Journal of Proprietary Rights*, 2 (1998), 2
- Edward, D. 'Trade Marks, Descriptions of Origin and the Internal Market', *I.P.Q.*, (2001), 135
- Elliott, C., and B. Gravatt. 'Domain Names Disputes in a Cross- Broader Context', *E.I.P.R.*, (1999), 417
- Espinell, Victoria A. 'The U.S. Recording Industry and Copyright Law: An Overview, Recent Developments and the Impact of Digital Technology', *E.I.P.R.*, (1999), 53

- Eugene R. 'Lost in Cyberspace: A Closer Look at ISP Liability', *Ent. L. Rev*, 12. 6 (2001), 192
- Fessenden, Giovanna. 'Peer- to-Peer Technology: Analysis of Contributory Infringement and Fair Use', *IDEA*, 42. 3 (2002), 391-416
- Fesser, Andrea D. 'The Next Frontier: Film Distribution Over the Internet', *Ent. L. Rev*, 11. 8 (2000), 183
- Firth, Alison and Jeremy Phillips. 'The Typographical Lacuna', *J.B.L*, Mar (1990), 147
- Firth, Alison. 'Case Comment: Authorship, Ownership and Infringement in Music Copyright', *Ent. L.Rev*, 3. 6 (1992), 211
- Firth, Alison, E. Gredley, and M. Maniatis. 'Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception', *E.I.P.R*, (2001), 86
- Fitzgerald, Anne and Cristina Cifuentes. 'Copyright Protection for Digital Multimedia Works', *Ent. L.Rev*, 10. 2 (1999), 23
- Fitzgerald, Brian. 'Intellectual Property Rights in Digital Architecture (Including Software) :the Question of Digital Diversity', *E.I.P.R*, (2001), 121
- Fitzgerald, J and A. Firth. 'Equitable Assignments in Relation to Intellectual Property', *I.P.Q.*, (1999), 228
- Fitzpatrick, Simson. 'Copyright Imbalance U.S. and Australian Responses to the WIPO Digital Copyright Treaty', *E.I.P.R*, (2000), 214
- Foged, Terese. 'How Internet Radio Plays in Accordance with U.S. and Danish (E.U) Copyright Laws: Part 2', *Ent. L.Rev*, 13. 8 (2002), 165
- Frame, Russell. 'The Protection and Exploitation of Intellectual Property Rights on the Internet: The Way Forward for the Music Industry', *Intellectual Property Quaterly*, 4 (1999), 443
- Friedrich-Karl Beier. 'The Development of Trademarks in the Last Twenty-Five Years', *IIC*, 26. 6 (1984), 1
- Garnett, K. 'Copyright in Photographs', *E.I.P.R*, (2000), 229
- Garrote, Ignacio Javier. 'Linking and Framing: A Comparative Law Approach', *E.I.P.R*, (2002), 184
- Gasparek, K. 'Applying the Fair Use Defense in Traditional Trade Mark Infringement and Dilution Cases to Interenet Meta Tagging or Linking Cases', *George Manson Law Review*, 7 (1999), 787

- Gendreau, Ysolde. 'Copyright Ownership of Photographs in Anglo-American Law', *E.I.P.R.*, (1993), 207
- Gendreau, Ysolde. 'Digital Technology and Copyright: Can Moral Rights Survive the Disappearance of the Hard Copy?', *Ent. L.Rev.*, 6. 6 (1995), 212
- Ginsburg, J. 'Creation and Commercial Value: Copyright Protection of Works of Information', *Columbia L. Rev.*, (1995), 1865
- Ginsburg, J.C. 'Berne Without Borders: Geographic Indiscretion and Digital Communications', *I.P.Q.*, (2002), 111
- Goonathilake, Tharika. "Genetic piracy threatens 'wild relatives' of agri crops" *Daily News*, 20th March 2003
- Gordon, Jeffrey I. 'Copyright. Protection @Internet.Net', *WVJOLT.*, 1. 3 (January 24, 1999)
- Graznak, Paul C. 'From Atoms to Bits and Back :DVD Technology and Copyrighted Content', *Ent. L.Rev.*, 9. 2 (1998), 76
- Griffiths, A. Modernising Trademark Law and Promoting Economic Efficiency: An Evaluation of the Baby-Dry Judgement and Its Aftermath, *I.P.Q.*, (2003), 1
- Griffiths, J and Tom Lewis. 'The Human Rights Act, Section 12-Press Freedom Over Privacy', *Ent. L.Rev.*, (1999), 36
- Griffiths, John. 'What Is Legal Pluralism?', *JLP.*, 24 (1986), 1
- Griffiths, Jonathan. 'Copyright Law after Ashdown - Time to Deal Fairly with the Public', *I.P.Q.*, 3 (2002), 240
- Grosheide, F.W. 'Copyright from a User's Perspective: Access Right for Users *E.I.P.R.*, (2001), 321
- Gross, M. 'Contributory and Vicarious Liability *Sega Enterprises V MAPHIA*', *Berkeley Tech. L.J.*, 13 (1998), 101
- Guadamuz, A. 'The "New Sharing Ethic" in Cyberspace', *J.W.I.P.*, 5 (2002), 129
- Haftke, Mark, and Philip Daniels. 'Napster in the UK', *Ent. L.Rev.*, 12. 4 (2001), 107
- Haixia Jia, Jessica. 'Tom and Jerry: New Information Technologies Keep Teasing Copyright Law', *C.T.L.R.*, 9. 2 (2003), 41
- Hanbidge, Nick. 'DRM: Can it Deliver', *Ent. L.Rev.*, 12. 5 (2001), 138

- Hardy, Trotter I. 'Contracts, Copyright and Preemption in a Digital World,' *RICH. J.L. & TECH.*, 1 (1995), 2
- Hart, Michael. 'The Copyright in the Information Society Directive: an Overview', *E.I.P.R.*, (2002), 58
- Heath, C and S. Weidlich, 'Intellectual Property: Suitable for Protecting Traditional Medicine?', *I.P.Q.*, (2003), 69
- Heath, Christopher. 'Intellectual Property Rights in Asia-An Overview', *IIC*, 28. 3 (1997), 303
- Heide, Thomas. 'the Approach to Innovation Under the Proposed Copyright Directive: Time for Mandatory Exceptions', *I.P.Q.*, 3 (2000), 215
- Hemaratne, Tissa. 'Freedom of Expression and Defamation', *Lankadeepa*, 25th February 1993, 6
- Hepler, David A. 'Dropping Slugs in the Celestial Jukebox: Congressional Enabling of Digital Musci Piracy Short-Changes Copyright Holders', *San Diego L. Rev.*, 37 (Fall 2000), 1165
- Hoeren, Thomas and Ute Decker. 'Electronic Archives and the Press: Copyright Problems of Mass Media in the Digital Age', *E.I.P.R.*, (1998), 256
- Hoffman., Markus. 'Internet Domain Names- Legal Disputes and Challenges Under U.K. Law', *ICCLR.*, 13. 6 (2002), 241
- Holderness. Mike, 'Moral Rights and Author's Rights: The Keys to the Information Age', *JILT* (1998)
- Howell, R.G. 'Copyright and Obscenity: Should Copyright Regulate Contnet?', *IPJ.*, 8 (1994), 139
- Hugenholtz, P, Bernt. 'Caching and Copyright: The Right of Temporary Copying', *E.I.P.R.*, (2000), 482
- Hughes, Justin. 'The Philosophy of Intellectual Property', *Geo. L.J.*, 77 (1988), 287
- Hunter, D. Cyberspace as Place and the Tragedy of the Digital Anticommons, *Cal.L.Rev.*, 91 (2003), 431
- Hurdle, H. 'Domain Names-the Scope of a Trade Marks Proprietor's Monopoly *AvenetInc. v Isoact Ltd*', *E.I.P.R* (1999), 74
- Huxley, Andrew. 'Buddhist Case Law on Theft: the Viniitavatthu on the Second Paaraajika,' *J.Budd.Ethics* 6 (1999), 313
- Jayasinghe, Kithsiri. "Trade Marks in Sri Lanka," *WIPO Colombo Symposium*, (1982),179

- Jeffery R. Kuester & Peter A. Nieves. 'Hyperlinks, Frames and Metatags: An Intellectual Property Analysis', *IDEA.*, 38 (1998), 243
- Jehoram, Herman Cohen. 'The Future of Copyright Collecting Societies', *E.I.P.R.*, (2001), 134
- Jones, Lucinda. 'An Artist's Entry Into Cyberspace: Intellectual Property on the Internet', *E.I.P.R.*, (2000), 79
- Jones, S. 'A Child's First Steps: The First Six Months of Operation-the ICANN Dispute Resolution Procedure for Bad Faith Registration of Domain Names', *E.I.P.R.* (2001), 66
- Julia-Barcelo. Rosa. 'on-Line Intermediary Liability Issues: Comparing E.U and U.S Legal Frameworks', *E.I.P.R.*, (2000), 105
- Kalupahana, David J. 'Schools of Buddhism in Early Ceylon', *Cey.J.Hum.*, 1 (1970), 159
- Karlen, Peter H. 'Intellectual Property in Aesthetic Creations', *Copyright World*, April (1999), 14
- Katz, Laurence. 'Jurisdiction and E-Commerce Disputes', *J.W.I.P.*, 3. 2 (2000), 289
- Keeling, D.T. 'About Kinetic Watches, Easy Banking and Nappies That Keep a Baby Dry: a Review of Recent European Case Law on Absolute Ground for Refusing to Register a Trade Mark', *I.P.Q.*, (2003), 131
- Kemp, Deborah. 'Preemption of State Law by Copyright Law', *COMP.L. J.*, 9 (1989), 375
- Knopf, Howard, P. 'Copyright and the Internet in Canada and beyond: Convergence, Vision and Division', *E.I.P.R.*, (2000), 262
- Koelman, Kamiel, J. 'A Hard Nut to Crack: The Protection of Technological Measures', *E.I.P.R.*, (2000), 272
- Kohil, Vinita. 'Mutilating Music A Critical Look at the Copyright and Business Issues in Online Music Distribution', *Ent.L.Rev.*, 12. 1 (2001), 15
- Kohler, Claus and Burmeister, Kai, 'Copyright Liability on the Internet Today in Europe (Germany, France, Italy and the E.U)', *E.I.P.R.*, (1999), 485
- Kuester, J.R., and, P.A. Nieves. 'Hyperlinks, Frames and Meta- Tags: an Intellectual Property Analysis', *IDEA.*, 38 (1998), 243
- Kur, A. 'Use of Trademarks on the Internet - the WIPO Recommendations', *IIC*, 33 (2002), 41
- Kur, Annette. 'Identical Marks Belonging to Different Owners in Different Countries (How) Can They Coexists in Cyberspace?', *J.W.I.P.*, 3. 2 (2000), 307

- Lai, Stanley. 'Digital Copyright And Watermarking', *E.I.P.R.*, (1999), 171
- Landes, W, Copyright Protection of Letters, Diaries and Other Unpublished Works: An Economic Approach, *JLS.*, 21 (1992), 79
- Landes, W., and R. Posner. 'An Economic Analysis of Copyright Law', *JLS.*, 18 (1989), 325
- Lane, Shelley and Richard McDBridge. 'The Protection of Formats Under English Law Part I and Part II', *Ent.L.Rev* Vol 1. 3 and 4 (1990), Part I, 96-102, Part II, 4, 96 and 131
- Langdon Jorgensen, and Mary McIntyre-Cecil. 'The Evolution of the Preemption Doctrine and Its Effect on Common Law Remedies,' *Idaho L. Rev.*, 19. 85 (1983), 100
- Lastowka, Gregory F. 'Search Engines, HTML< and Trade Marks: What's the Meta for?', *Va. L. Rev.*, 86 (2000), 835
- Lawson, Euan and Andrew Steed. 'Sounds Unlimited 2: Music and Copyright in Cyberspace- An Update', *Copyright World*, May (1999), 16
- Leval, P.N. 'Towards a Fair Use Standard', *Harv.L.Rev*, 103 (1990), 1137
- Lipton, J. 'Data Bases as Intellectual Property: New Legal Approaches', *E.I.P.R.*, (2003), 139
- Litman, Jessica. 'The Exclusive Right to Read', *Cardozo Arts & Ent.LJ.*, 13 (1994), 29
- Liyanratne, Jinadasa. 'Some Sri Lankan Medical Manuscripts of Importance for the History of South Asian Traditional Medicine', *Bulletin of SOAS*, 64. 3 (2001), 392
- Loubser, M.M. 'Principles and Policy in Unlawful Competition: An Aquilian Mask?', *Acta Juridica* (2000), 168
- Loughlan, P. Looking at the Matrix: Intellectual Property and Expressive Freedom, *I.E.P.R.*, (2002), 30
- Lucas, Andre. 'Exploitation and Liability in the Light of Media Convergence', *E.I.P.R.*, (2001), 275
- Luria, M. 'Controlling Web Advertising: Spamming, Linking, Framing, And Privacy', *The Computer Lawyer*, 14. 1 (1997), 10
- Macmillan, Fiona and Michael Blakeney. 'The Copyright Liability of Communications Carriers', *JILT*, 3 (1997)
- Macmillan, Fiona, and Michael Blakeney. 'The Internet and Communications Carriers' Copyright Liability', *E.I.P.R.*, (1998), 52

- Macmillan, Fiona. 'Striking the Copyright Balance in the Digital Environment', *ICCLR*, 10. 12 (1999), 350
- Maniatis, S.M. 'Trade Mark Law and Domain Names: Back to Basics?', *E.I.P.R.*, (2002), 397
- Maniatis, S.M. Trademark Rights - A Justification Based on Property, *I.P.Q.*, (2002), 123
- Maniatis, Spyros., and E. Gredley. 'Parody, A Fatal Attraction? Part I - The Nature of Parody and Its Treatment in Copyright', *E.I.P.R.*, (1997), 339
- Maniatis, Spyros., and E. Gredley. 'Parody, A Fatal Attraction? Part II - Trademark Parodies', *E.I.P.R.*, (1997), 412
- Mankowski, Peter. 'Particular Kinds of Unfair Competition on the Internet and Conflict of Laws', *IIC*, 32. 4 (2001), 390
- Marks Dean S. and H. Bruce Turnbull. 'Technical Protection Measures The Intersection of Technology, Law and Commercial Licences', *E.I.P.R.*, (2000), 198
- Marsoof. S. 'Common Law in Ceylon', *Colom L.Rev.*, 2 (1971), 83
- Mathews, C. 'The Constitutional Power of the President to Conclude International Agreements', *YaleLJ* (1955), 345
- McClure, Daniel M. 'Trademarks and Unfair Competition: A Critical History of Legal Thought', *TMR*, 69 (1979), 305
- McEvedy, Victoria. 'The DMCA and the E-Commerce Directives', *E.I.P.R.*, (2002), 65
- Meyer-Rochow R. 'The Application of Passing Off as a Remedy Against Domain Name Piracy.', *E.I.P.R.* (1998), 405
- Mille, Antonio. 'Copyright in the Cyberspace', *E.I.P.R.*, (1997), 570
- Mills, Terrell W. 'METATAGS: Seeking to Evade User Detection and the Lanham Act', *RICH. J.L. & TECH.*, VI. 5 (Spring 2000)
- Mitchiner, J.P. 'Intellectual Property in Image - A Mere Inconvenience?', *IPQ* (2003), 163
- Monotti, A.L. 'University Copyright in the Digital Age: Balancing and Exploiting Rights in Computer Programs, Web-Based Materials, Databases and Multimedia in Australian Universities', *E.I.P.R.*, (2002), 251
- Morrison, Alex. 'Securing Webcast Content in the European Union: Copyright, Technical Protection and Problems of Jurisdiction', *E.I.P.R.*, (2002), 74

- Murray, A.D. 'Internet Domain Names The Trade Mark Challenge', *I.J.L & I.T.*, 6. 1 (1998), 285
- Murray, A.D. 'The Use of Trade Markas Meta Tags: Defining the Boundaries', *I.J.L & I.T.*, 8. 3 (2000), 263
- Nachbar, T.B. *Intellectual Property and Constitutional Norms*, *Columbia Law Review*, 104 (2004), 272
- Nathenson, I. 'Internet Infoglut and Invisible Ink: Spamdexing Search Engines with Meta Tags', *Harv. J.L. & Tech.*, 12 (1998), 60
- Nawaratne, Tilaka. 'Hela Osuwe Aythiya es Wasa Ahimikarana Jagath Patent Kollaya (Alienation of Rights of Sinhalese Medicine by International Patent Robbery)', *Subasetha*, 11.10.2002, p. 8-9.
- Netanel, N.W. 'Copyright and a Democratic Civil Society', *Yale L. J*, 106 (1996), 283
- Nicholas C.W. 'A Short Account of the History of Irrigation Works up to the 11th Century', *Journal of the Ceylon Branch of the Royal Asiatic Society-New Series*, VII Part I (1960), 6
- Niranjan, David C. 'Internet Domains and Trade Mark Claims: First Amendment Considerations.' *IDEA.*, 41. 1 (2001), 127
- Nogues, J. 'Patents and Pharmaceutical Drugs: Understanding the Pressures on Developing Countries', *J.W.T.L.*, 6 (1990), 81
- Nwauche, E.S. 'A Critical Evaluation of the Provisions of Nigerian Copyright Law in Folklore', *IIC*, 33 (2002), 599
- Odekiji, R. 'Toward an International Fair Use Doctrine', *Col. J. Trans. Law.*, 39 (2000), 75
- O'Sullivan, Michael J. 'International Copyright: Protection for Copyright Holders in the Internet Age', *NYILR.*, 13 (Summer 2000), 1
- Paster, B.G. 'Trade Marks: Their Early History', *TMR*, 59 (1969), 551
- Paylago, Stanley U. 'Search Engine Manipulation: Creative Use of Metatags or Trademark Infringement?', *IDEA.*, 40. 3 (2000), 451
- Perlmutter, Shira. 'Convergence and the future of copyright', *E.I.P.R.*, (2001), 111
- Perry, Amanda. 'An Ideal Legal System for Attracting Foreign Direct Investment? Some Theory and Reality', *Am. U. Int'l L. Rev.*, 15 (2000), 1627
- Pessach, G. 'The Author's Moral Right of Integrity in Cyberspace - A Preliminary Normative Framework', *IIC*, 34 (2003), 250

Phillips, Jeremy. 'Copyright In Spoken Words - Some Potential Problem', *E.I.P.R.*, (1989), 231

Picciotto, S. 'Copyright Licensing: The Case of Higher Education Photocopying in the UK', *E.I.P.R.*, (2002), 438

Pinto, T. 'The Influence of the European Convention on Human Rights on Intellectual Property Rights', *E.I.P.R.*, (2002), 209

Presson, T.F., and Barney, J.R. 'Trademarks as Meta Tags: Infringement or Fair Use?', *AIPLA Quarterly Journal*, 26. 2 (1998), 147

Primo Braga, C.A., and C. Fink. 'Reforming Intellectual Property Rights Regimes: Challenges for Developing Countries', *JIEL.*, 1. 4 (1998), 537

Reed, C. 'Copyright in WWW Pages, News from Shetland Copyright in Links to World Wide Web Pages', *Computer Law & Security Report*, 13. 3 (1997), 167

Reed, C. 'Controlling World Wide Web Links: Property Rights, Access Rights and Unfair Competition', *Ind. J. Global Legal Stud.*, 6 (1998), 179

Reichman, J.H. 'Legal Hybrids Between the Patent and Copyright Paradigms,' *Columbia L. Rev.*, 94 (1994), 2432

Reinbothe, J, M., Martin Prat, Von Lewinski. 'New WIPO Treaties: A First Resumé,' *E.I.P.R.*, (1997), 171

Reinbothe, Jorg and Silke Von Lewinsky. 'The WIPO Treaties 1996: Ready to Come Into Force', *E.I.P.R.*, (2002), 199

Ricketson, Sam. 'The Boundaries of Copyright: Its Proper Limitations and Exceptions: International Conventions and Treaties', *I.P.Q.*, 1 (1999), 56

Rimmer, Matthew. 'A Creature of Statute: Copyright Law and Legal Formalism', *Ent.L. Rev.*, 13. 2 (2002), 31

Rizzi, Steven J. 'The Digital Millennium Copyright Act: Y2K Compliant or Bugged?', *Copyright World*, 85 November (1998), 18

Roatry, A. 'Link Liability: the Argument for Inline Links and Frames as Infringements of the Copyright Display Right', *Fordham Law Rev.*, 3 (1999), 1011

Rose, Richard D. 'Connecting the Dots: Navigating the Laws and Licensing Requirement of the Internet Music Revolution', *IDEA.*, 42. 3 (2002), 332

- Rushton, M. 'An Economic Approach to Copyright in Works of Artistic Craftsmanship', *I.P.Q.*, (2001), 255
- Ruston, G. 'On the Origin of Trade Marks', *TMR*, 45 (1955), 127
- Salango, C., Benjamin. 'Copyright Infringement in Cyberspace: Untangling the Web with Existing Law', *WVJOLT.*, 1. 4 (1997)
- Samaraweera, Vijaya. 'An "Act of Truth" In a Sinhala Court of Law: On Truth, Lies and Judicial Proof among the Sinhala Buddhists', *Cardozo J. Int'l & Comp. L.*, 5 (Spring 1997), 133
- Samaraweera, Vijaya. 'Judicial Administration of the Kandyan Provinces of Ceylon, 1815-1833', *CJHSS.*, 1:2 (1971), 123
- Samuelson, P and S. Scotchmer. 'Law and Economics of Reverse Engineering,' *Yale L.J.*, 111 (2002), 1575
- Samuelson, P. 'Economic and Constitutional Influences on Copyright Law in the US', *E.I.P.R.*, (2001), 409
- Saunders, K.M. 'Confusion Is the Key: A Trademark Law Analysis of Keyword Banner Advertising', *Fordham Law Rev* (2001), 543
- Schechter, Frank. 'The Rational Basis of Trade Mark Protection', *TMR.*, 60 (1970), 334
- Schmidt, H.K.S. 'Likelihood of Confusion" in European Trademarks - Where Are We Now?,' *E.I.P.R.*, (2002), 463
- Schricker, Gerhard. 'Twenty-Five Years of Protection against Unfair Competition', *IIC*, 26. 6 (1995), 782
- Selby, John. 'The Legal and Economic Implications of the Digital Distribution of Music Part 2', *Ent.L.Rev*, 11. 2 (2000), 25
- Sherwood, R. 'The TRIPs Agreement: Implementations for Developing Countries', *IDEA.*, 37 (1997), 491
- Sherwood, Robert M. 'Intellectual Property Systems and Investment Stimulation: The Rating of Systems in Eighteen Developing Countries', *IDEA.*, 37. 2 (1997), 261-370
- Shiell, Warren R. 'Viral Online Copyright Infringement in the United States and the United Kingdom: The End of Music or Secondary Copyright Liability?', *Ent. L.R.*, 15. 3 & 4 (2004), Part 1: 63, Part 2:107
- Silvia Plenter. 'Choice of Law Rules for Copyright Infringements in the Global Information Infrastructure a Never -Ending Story', *E.I.P.R.*, (2001), 313

- Sims, Alexandra. 'Rethinking One in a Million', *E.I.P.R.*, (2004), 442
- Sirisoma, M.H. 'Conis', *Ancient Ceylon- Journal of the Archaeological Survey Department of Ceylon*, II (1972), 147
- Siriweera, W.I. 'Land Tenure and Revenue in Medieval Ceylon (AD1000-1500)', *CJHSS. New Series*, II. January-June (1972), 11
- Sookman, Barry B. 'Copyright and the Information Superhighway: Some Issues to Think about - Part II', *IPJ.*, 11 (1997), 265
- Souza, Lionel De. 'Moral Rights and the Internet Squaring the Circle', *I.P.Q.*, 3 (2002), 265
- Spurgeon, C., Paul. 'Digital Network and Copyright: Licensing and Accounting for Use -The Role of Copyright Collectives Evolution or Revolution', *IPJ.*, 12. September (1998), 226
- Staffin, Elliot. 'The Dilution Doctrine: Towards a Reconciliation with the Lanham Act', *Fordham Intell. Prop. Media & Ent. L.J.*, 6 (1995), 106
- Sterling, J.A.L. 'Harmonisation of Usage of the Terms "Copyright," "Author's Rights" and "Neighbouring Rights"', *E.I.P.R* (1989), 14
- Stoodley, Jonathon. 'Internet Domain Names and Trade Marks', *E.I.P.R.*, (1997), 509
- Subramanian, Arvind and Jayashree Watal. 'Can TRIPS Serve as an Enforcement Device for Developing Countries in the WTO', *JIEL.*, (2000), 403
- Sullivan, Eugene R. 'Lost in Cyberspace: A Closer Look at ISP Liability', *Ent.L.Rev.*, (2001), 192
- Tambiah, H.W. 'Buddhist Ecclesiastical Law', *Journal of the Ceylon Branch of the Royal Asiatic Society*, 8:1 (1962), 71
- Tasar, M.F. 'Intellectual Property in the Global Marketplace: Enforcement in Developing Countries-Is There an Effective Way?', *Patent World*, December :128 (2000), 29
- Teubner, G. 'Two Faces of Janus: Rethinking Legal Pluralism', *Cardozo Law Review*, 13 (1992), 1443
- Thambiah H.W. 'Roman Dutch Law in Ceylon', *Ceylon Law Students Review*, XIII (1951), 36
- Throne, C., and S. Bennett. 'Domain Names -Internet Warehousing: Has Protection of Well-Known Names on the Internet Gone Too Far?', *E.I.P.R* (1998), 468
- Tiberi, Luca. 'Liability of Service Providers', *C.T.L.R.*, 9. 2 (2003), 49

Tucci, Veronica. 'The Case of the Invisible Infringer: Metatags, Trade Mark Infringement and False Designation of Origin', *J. Tech. L. & Pol'y.*, 5. 2 (Summer 2000)

Sirisoma, M.H. "Conis," *Ancient Ceylon- Journal of the Archaeological Survey Department of Ceylon* (Colombo) II (1972), 147

Vassallo, Edward., & Dickey, Maryanne. 'Protection in the United States for "Famous Marks": The Federal Trade Mark Dilution Act Revisited.', *Fordham Intell. Prop. Media & Ent. L.J.*, 9 (1999), 503

Vergani, Giorgio Nicolo. 'Electronic Commerce and Trade Marks in the United States: Domain Names and the "Use in Commerce Requirement" on the Internet.', *E.I.P.R* (1999), 450

Verma, Surinder Kumar. 'Protection of Trade Secrets under the TRIPS Agreement, and Developing Countries', *J.W.I.P.*, (1998), 723

Verma, Surinder Kumar. 'TRIPs and Plant Variety Protection in Developing Countries', *E.I.P.R.*, 6 (1995), 281

Vinje, Thomas C. 'Copyright Imperilled', *E.I.P.R.*, (1999), 192

Vinje, Thomas C. 'The New WIPO Copyright Treaty A Happy Result in Geneva', *E.I.P.R.*, (1997), 230

Vivas Eugui, D. 'Negotiations on Geographical Indications in the TRIPs Council and Their Effect on the WTO Agricultural Negotiations - Implications for the Developing Countries and the Case of Venezuela', *J.W.I.P.*, 4 (2001), 703

Von Lewinski, S. 'WIPO Diplomatic Conference Results in Two New Treaties', *IIC* (1997), 203

Von Lewinski, S. "The New WIPO Treaties: A first resume", *E.I.P.R.*, (1997), 171

Von Lewinski, S. 'A Successful Step Towards Copyright and Related Rights in the Information Age: The New EC Proposal for a Harmonisation Directive', *E.I.P.R.*, (1998), 135

Von Lewinski, S. 'The WIPO Diplomatic Conference on Audiovisual Performances: A First Résumé', *E.I.P.R.*, (2001), 333

Wanigasundara, Mallika. 'Supreme Court Rules Bill to Incorporate Christian Missionary Body Unconstitutional', *Daily News*, 04.03.2003

Watal, Jayashree. 'The TRIPS Agreement and Developing Countries- Strong, Weak or Balanced Protection?', *J.W.I.P.*, 1(1998), 281

- Watal, Jayashree. 'TRIPS and the 1999 WTO Millennium Round -Some Reflections on Future Issues Related to IPRs in the WTO and the Way Forward for Developing Countries', *J.W.I.P.*, 3 (2000), 3
- Watts, J. 'Trade Marks for the Shape of Goods', *E.I.P.R.*, (1998), 147
- Weiser, P. 'The Internet, Innovation, and Intellectual Property Policy', *Columbia L.R.*, 103 (2003), 534
- Wendland, W. 'Intellectual Property, Traditional Knowledge and Folklore: WIPO's Exploratory Program, I and II,' *IIC*, 33 (2022), 485 and 606
- Wiese, Henning. 'The Justification of the Copyright System in the Digital Age', *E.I.P.R.*, (2002), 387
- Wilkof, Neil J. 'Trade Marks and the Domain: Generic Marks and Generic Domain Names', *E.I.P.R.* (2000), 571
- Williams, Alan and Duncan Carlow. 'News from the Front: Practical Legal Issues in the Digital Revolution', *Ent.L.Rev*, 8. 8 (1997), 290
- Williams, Petra. 'Stopping the Cyberspace Cowboys: Protecting Music on the Internet- the UK Perspective', *Copyright World*, September (2000), 19
- Willis, M. 'A Survey of Enforcement Measures for International Intellectual Property Rights Under the WTO: Compliance Issues for Developing Countries', *Int.T.L.R.*, 6. 6 (2000), 180
- Wing, Mark and Ewan Kirk. 'European/ U.S. Copyright Law Reform: Is a Balance Being Achieved', *IPQ*, 2 (2000), 138
- Yakobson, Miriam. 'Copyright Liability of Online Service Providers After the Adoption of the E.C. Electronic Commerce Directive: A Comparison to U.S.Law', *Ent.LR*, 11. 7 (2000), 144
- Yan, David. 'Virtual Reality.', *Fordham Intell. Prop. Media & Ent. L.J.*, 10 (2000), 773
- Yee, Kenton K. 'Location.Location.Location: a Snapshot of Internet Address as Evolving Property', *JILT* (1997) at http://elj.warwick.ac.uk/jilt/intprop/97_1yee/
- Youn, M.Y. 'Neither Intellectual nor Property', *Yale L.J* (1997), 267
- Zwart, Melissa De. 'The Future of the Internet: Content Regulation and Potential Impact of the Shape of Cyberspace', *Ent.L.Rev*, 9. 2 (1998), 86

9. Selected cases (full reference are given with citation in text or footnote)

<i>I-800 Contacts, Inc. v. WhenU.com</i> -----	166
<i>A&M Records, Inc. v Napster, Inc.</i> -----	244
<i>Abdul Azeez v Seyed Mohamad Buhary</i> -----	104
<i>Abdul Rahiman v Ussan Umma</i> -----	65
<i>Abeywardene v. Inspector General of Police and others</i> -----	201
<i>Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd.</i> -----	126
<i>Advanced Computer Services of Michigan, Inc. v. MAI Systems Corp</i> -----	233
<i>Aetiology Today CC t/a Somerset School v Van Aswegen</i> -----	220
<i>AG(UK) v Heinemann Publishers Australia Pty. Ltd.</i> -----	184
<i>Allstate Ins. Co. v. Mathison</i> -----	155
<i>Amazon.com Inc v Citi Services Inc.</i> -----	146
<i>America Online, Inc. v. LCGM, Inc.</i> -----	155
<i>Anacon Corporation Limited and Another v. Environmental Research Technology Limited and Another</i> -----	199
<i>Antiquesportfolio.com plc. v Rodney Fitch & Co. Ltd</i> -----	206
<i>Arsenal Football Club plc v Matthew Reed</i> -----	142,152
<i>Arunasalam v Somasundaram</i> -----	129
<i>Atlas Organic Fertilizers (Pty) Ltd v Pikkewyn Gwhano (Pty) Ltd</i> -----	219
<i>Attorney-General (UK) v Heinemann Publishers Aust. Pty. Ltd.</i> -----	90
<i>Aubrey Max Sandman v. Panasonic UK Limited and Another</i> -----	199
<i>Azrak-Hamway International Inc's Licence of Right</i> -----	34
<i>Bally Total Fitness Holding Corp. v. Faber</i> -----	140
<i>Bank of Ceylon v De Costa</i> -----	96
<i>Baschet v London Illustrated Standard Co.</i> -----	212
<i>Beloff v Pressdram Ltd.</i> -----	213
<i>Bensusan Restaurant Corp v. King</i> -----	157
<i>Birmingham Vinegar Brewery v Powell</i> -----	100
<i>Bonnier Media Ltd v Smith (OH) Outer House</i> -----	142
<i>Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd</i> -----	142
<i>Brighton v. Jones</i> -----	213
<i>British Horseracing Board Ltd v William Hill Organisation Ltd.</i> -----	223
<i>British Horseracing Broad Ltd v William Hill Organisation Ltd (No.2)</i> -----	199
<i>British Leyland Motors Corpn. Ltd and another v Armstrong Patents Co.Ltd.</i> -----	199
<i>British Oxygen Co. v. Liquid Air Ltd.</i> -----	213
<i>British Telecommunication plc, Virgin Enterprises Ltd. J Sainsbury plc, Mark & Spencer plc and Ladbroke Group plc v One in a Million</i> -----	141, 143,146
<i>Brookfield Communications Inc. v West Coast Entertainment Corp.</i> -----	147,151
<i>Bulankulama and Others v Secretary, Ministry of Industrial Development and Others</i> ----	33, 91, 92, 196

<i>Cader Saibo and Co. v Mowlana</i>	103
<i>Caixa D'Estalvis y Pensions de Barcelona v Namezero.com</i>	145
<i>Campbell v Hall</i>	71
<i>Canal & Image UK Limited v. Vanitymail Services, Inc.</i>	142,145
<i>Capper v Silva</i>	182
<i>Capper v Wayman</i>	182
<i>Carder Saibo and Co. v Mowlana</i>	254
<i>CBS Songs Ltd v Amstrad Consumer Electronics plc.</i>	213
<i>CCH Canadian Ltd. v. Law Society of Upper Canada</i>	36
<i>Chanmugam v Kandiah</i>	64
<i>Chappell & Co Ltd v Redwood Music Ltd.</i>	199
<i>Cheseborough Manufacturing Co. v Kudhoos</i>	132
<i>Classified Ventures, L.L.C. v. Softcell Marketing, Inc.</i>	155
<i>CPC International Inc. v. Skippy Inc.</i>	140
<i>Creation Records Ltd v. News Groups</i>	199
<i>Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.</i>	126
<i>Davidoff & Cie SA v Gofkid Ltd.</i>	126
<i>De Bruin v Dharmabanu</i>	211
<i>De Costa v Bank of Ceylon</i>	73
<i>Deere & Co. v. MTD Prods., Inc.</i>	126
<i>Digital Equipment Corp. v. Altavista Technology,</i>	160
<i>Douglas Faulkner, et al., v National Geographic Society, et al.,</i>	228
<i>Dun & Bradstreet (Pty) Ltd v SA Merchants Combined Credit Bureau (Cape) (Pty P Ltd.</i>	96
<i>E. & J. Gallo Winery v. Spider Webs Ltd.</i>	141
<i>EBay Inc. v Bidder's Edge Inc.</i>	238
<i>Ekanayaka v Attorney General</i>	33, 213
<i>Electronics Boutique Holdings Corp. v. Zuccarini</i>	139, 141
<i>Estee Lauder Cosmetics Ltd v Fragrance Counter Inc.</i>	160
<i>Euromarket Designs Incorporated v. Peters & ANR</i>	137, 142, 143
<i>Exxon corporation v Exxon insurance consultants International Limited</i>	221
<i>Federal Trade Commission v Carlos Pereira d/b/a/ atariz.com, et al</i>	167
<i>Fernando v. The Sri Lanka Broadcasting Corporation and Others</i>	176
<i>Ford Motor Co. v. Greatdomains.Com, Inc.</i>	141
<i>Ford Motor Company v 2600 Enterprises</i>	160
<i>French Connection Ltd v Sutton (t/a Teleconexus Email)</i>	142
<i>FTC v Zuccarini</i>	167
<i>Futurodonics, Inc. v Applied Anagramatics, Inc.</i>	242
<i>Gaffoor v. Wilson and Another</i>	92
<i>Geary and Son (Pty) Ltd v Gove</i>	219
<i>Geographia Ltd. v Penguin Books Ltd.</i>	199

<i>George v Velupillai</i> -----	211
<i>Glyn v Weston Feature Film Co., Ltd.</i> -----	212
<i>Green Prods. Co. v. Independence Corn By-Prods. Co.</i> -----	139
<i>Hard Rock Café v. Morton,</i> -----	162
<i>Hasbro, Inc. v. Internet Entertainment Group, Ltd.</i> -----	139
<i>Hassim v Musa</i> -----	104
<i>Hatwan and Others v. Rahaman and Others</i> -----	123
<i>Haymarket v Burmah Castrol</i> -----	242
<i>Hexagon Pty Ltd. v Australian Broadcasting Commission</i> -----	113, 133
<i>Holland v Van Damm (Oscar Wilde case)</i> -----	210
<i>Hollandia and Anglo-Swiss condensed milk Co. v The Nestle and Anglo-Swiss condensed milk Co</i> ---	132
<i>Hong Kong and Shanghai Bank v Krishnapillai</i> -----	74
<i>Hungary v. Slovakia</i> -----	90
<i>Insituform Technologies, Inc. v. National Envirotech Group, L.L.C</i> -----	149
<i>Intellectual Reserve, Inc. v Utah Lighthouse Ministry, Inc.</i> -----	238
<i>Interlego AG v. Tyco Industries Inc.</i> -----	199
<i>Intermatic Inc. v. Toeppen</i> -----	140, 157
<i>J.K. Harris & Co. v. Kassel</i> -----	151
<i>James Fernando v OIC, SCIB, Negombo</i> -----	121
<i>James Finlay and Company Ltd. vs. Stassen Exports Ltd. and another</i> -----	32
<i>Jennings v Stephens</i> -----	231
<i>Jinawathie v. Emalin Perera</i> -----	123
<i>Joe Abeywicrama et al v Torana Video Movies</i> -----	192, 229
<i>John Gognell and Co. Ltd., v Sivaprakagam</i> -----	75, 118
<i>Johnstone v Bernard Jones Publications Ltd.</i> -----	199
<i>Joseph Perera alias Bruten Perera v The Attorney-General and Others</i> -----	95, 175
<i>Journal Gazette Co. v Midwest Internet Exchange</i> -----	242
<i>K.Thyagarajah v D.M.R.Perera</i> -----	103
<i>Kapadia v Mohamad</i> -----	101, 132
<i>Karonchihamy v Angohamy</i> -----	40, 66
<i>Kazmaier v. Wooten</i> -----	139
<i>Kelly v Arriba Soft Corporation</i> -----	238
<i>Kodeeswaran v Attorney General</i> -----	41, 72
<i>Korossa Rubber Company v Silva</i> -----	72
<i>Krishanan Chetty v Kandesamy</i> -----	75
<i>Kumaravel Nadar et al., v Sokkalal Ram</i> -----	122
<i>Ladbroke (Football) Limited v William Hill (Football) Ltd.</i> -----	199, 221
<i>Lamothe v. Atlantic Recording Corp.</i> -----	139
<i>Laugfs Lanka Gas (Private) Ltd v Mundogas Lanka (Private) Ltd</i> -----	114
<i>Leslie A Kelly v Arriba Soft Corporation</i> -----	238

<i>Lever Brothers v R.M Ranganathan Pillai</i> -----	119, 132
<i>Lever v Goodwin</i> -----	132
<i>Lily M De Costa v Bank of Ceylon</i> -----	72
<i>Lipton Ltd. v Rawther</i> -----	119
<i>Lipton Ltd. v Stassen Exports Ltd.</i> -----	115
<i>Little Oriental Balm & Pharmaceuticals Ltd. v Ussen Saibo</i> -----	132
<i>Lucent Technologies Inc. v. lucent sucks.com</i> -----	140
<i>Lukmunjee v Aktibalage</i> -----	118
<i>M.R.Leelawathie v. The Minister of Defense and External Affairs</i> -----	33
<i>M.S. Hebtullabhoy and Company Ltd v Stassen Exports Ltd and another</i> -----	120, 189
<i>Macmillan Publishers Ltd v Thomas Reed</i> -----	199
<i>Macpherson v Brown & Co.</i> -----	104
<i>Magazijn De Bijenkorf BV v Accelerated Information BV</i> -----	146
<i>MAI System Corp v Peak Computer Inc.</i> -----	233
<i>Malhotra International (Pvt.) Ltd. v. Anglo-Asian Distributors Ltd. and Another</i> -----	114
<i>Manawadu v. OIC, Police Station, Udapussellawa</i> -----	123
<i>Manikkan v Peter</i> -----	68
<i>Matthews v Young</i> -----	213, 219
<i>Metalrax Group Plc v Vanci</i> -----	142
<i>Microsoft Corporation v Computer future Distribution Limited</i> -----	213
<i>Mitchel v Fernando</i> -----	74
<i>Musical Fidelity Ltd v Vickers (t/a Vickers Hi-Fi)</i> -----	142
<i>Nagayya v Jayasekera</i> -----	180
<i>National Geographic Society et al. v Jerry Greenberg, et al</i> -----	228
<i>Netbula, LLC., v. Distinct Corporation</i> -----	151
<i>Newspaper Licensing Agency Ltd. v Marks & Spencer plc.</i> -----	190
<i>Niton Corp. v. Radiation Monitoring Devices, Inc.</i> -----	150
<i>Norowzian v Arks Ltd (No.2)</i> -----	190, 199,200
<i>OBH, Inc. v. Spotlight Magazine, Inc.</i> -----	158, 160
<i>Oppedahl & Larson L.L.P. v Advanced Concepts</i> -----	150
<i>Panavision International , L.P. v Toeppen</i> -----	140
<i>People for the Ethical Treatment of Animals, Inc. v. Doughney</i> -----	141
<i>Perera v Kitto</i> -----	211
<i>Pfizer Ltd v Eurofood Link (UK) Ltd.</i> -----	127
<i>Pitman Training Ltd v Nominet UK</i> -----	136
<i>Playboy Enterprises Inc. v Asia Focus International, Inc.</i> -----	150
<i>Playboy Enterprises Inc. v. Wells</i> -----	151
<i>Playboy Enterprises v. Calvin Designer Label</i> -----	150
<i>Playboy Enters. v. Netscape Communications Cop</i> -----	147
<i>Prasanna Withanage v Sarath Amunugama</i> -----	176

<i>Premalal Perera v. Weerasuriya and Others</i> -----	90, 92
<i>Queen v Vaiyapuri</i> -----	104
<i>Radio Taxicabs (London) Ltd (t/a Radio Taxis) v Owner</i> -----	142
<i>Re Copyright Protection for Computer Games</i> -----	199
<i>Reckitt & Colman Ltd v Borden Inc.</i> -----	134
<i>Redwood Music Ltd. v B. Feldman & Co. Ltd.</i> -----	199
<i>Reed Executive Plc v Reed Business Information Ltd.</i> -----	152
<i>Remco Industries v. Toyomenka, Inc</i> -----	139
<i>Roadtech Computer System Ltd. v. Mandata (Management and Data Services) Ltd.</i> -----	151
<i>Roho, Inc. v. Marquis</i> -----	139
<i>S.H.M.Mohideen et.al., v Registrar of Trade Makrs</i> -----	120
<i>Sabel BV v Puma AG</i> -----	127
<i>Sahib v Mutalib</i> -----	104, 119
<i>Sameed v Segutamby</i> -----	72
<i>Schmidheiny v. Weber</i> -----	141
<i>Seixo v Provezende</i> -----	119
<i>Seven Seas Computers Lanka (Pvt.) Ltd. v. Qsoft Software Development Company</i> -----	20
<i>Shanghai Bank v Krishnapillai</i> -----	74
<i>Shaw, Wallace & Co. v The Egyptian Phosphate Co., Ltd.</i> -----	107
<i>Shetland Times Limited v Dr Jonathan Wills et al</i> -----	221, 238
<i>Shield v. Zuccarini</i> -----	139,141
<i>Six Continents Hotels Inc. and Inter-Continental Hotels Corp. v. The Gator Corp.</i> -----	166
<i>SNA, Inc. v. Array</i> -----	151
<i>Societe Des Produits Nestle S.A. v Multitech Lanka (Pvt) Limited</i> -----	113
<i>Soft System (Pvt) Ltd v Visualtech Microsystems (Pvt) Ltd.</i> -----	198
<i>Somasundaram Chetty v Arunasalam Chetty</i> -----	129
<i>Sony Music Entertainment (UK) Limited & Others -v- Easyinternetcafe Limited</i> -----	245
<i>Spelling Goldberg Productions Inc. v BPC Publishing</i> -----	213
<i>Sporty's Farm L.L.C. v. Sportsman's Market, Inc.</i> -----	141
<i>Stassen Exports Ltd. and Others vs. M.S.Hebtulabhoy & Co. Ltd.</i> -----	26
<i>Stenograph LLC v Bossard Associations Inc.</i> -----	233
<i>Stewart v Silva</i> -----	106
<i>Suby v Suby</i> -----	120, 133, 189
<i>Sultan v Peiris</i> -----	41, 72
<i>Sumeet Research and Holdings Ltd. v Elite Radio & Engineering Co., Ltd.</i> -----	113, 133
<i>Sunila Abeysekera v.Ariya Rrubasinghe, Competent Authority and Others</i> -----	95
<i>Swamipillai v Manuelpillai</i> -----	164
<i>Taubman Co. v. Webfeats</i> -----	140
<i>The Chartered Bank of India, Australia and China Ltd. v Palniappa Chetty</i> -----	129
<i>The New York Times, Co. v Tasini</i> -----	227

<i>The Washington Post v. Total News Inc.</i> -----	162,242
<i>Thyagarajah v D.M.R Perera</i> -----	254
<i>Ticketmaster Corporation v Tickets.com Incorporation</i> -----	238
<i>Times Newspapers Limited and Another v. MGN Limited</i> -----	183
<i>Times of Ceylon v Marcus</i> -----	182, 254
<i>Toys "R" Us v. Akkaoui</i> -----	139
<i>Triad System v Southeastern Express Co.</i> -----	233
<i>U-Haul Int'l, Inc. v. WhenU.com</i> -----	166
<i>UMG Recordings, Inc. v MP3. Com Inc.</i> -----	244
<i>Union Wine Ltd v E. Snell and Co Ltd</i> -----	220
<i>Universal Studios, Inc. v Reinmerdes</i> -----	238
<i>University of London Press Ltd v Universal Tutorial Press Ltd</i> -----	210
<i>University of New South Wales v. Moorehouse and Angus & Robertson (Publishers) Pty. Ltd</i> -----	36
<i>Veeravagoopillai v Saibo</i> -----	119
<i>Victoria's Cyber Secret Limited Partnership v. V Secret Catalogue, Inc.</i> -----	139
<i>Virgin Net v Adrian Paris</i> -----	156
<i>Virtual Works, Inc. v. Volkswagen of America Inc.</i> -----	139, 141
<i>Vogon International Ltd v Serious Fraud Office</i> -----	223
<i>Washingtonpost.Newsweek Interactive Company LLC., et. al., . v. Gator Corp.</i> -----	165
<i>Wass v Samarasinghe</i> -----	129
<i>Waterlow Directories Ltd. v Reed Information Services Ltd.</i> -----	199
<i>Wijesinghe Mahanamahewa and another v Austin Cantor</i> -----	188, 210
<i>Wijesiri Prathapasinghe Ramanyake v Home Finance Limited</i> -----	229
<i>Winterson v. Hogarth</i> -----	142
<i>York Trailer Holdings v Registrar of Trade Marks</i> -----	108

APPENDIX (A)
COUNTRY PROFILE

Location: Southern Asia, island in the Indian Ocean, south of India
Geographic coordinates: 7 00 N, 81 00 E
Population: 19,905,165
Nationality: *noun:* Sri Lankan(s)
adjective: Sri Lankan
Ethnic groups: Sinhalese 74%, Tamil 18%, Moor 7%, Burgher, Malay, and Vedda 1%
Religions: Buddhist 70%, Hindu 15%, Christian 8%, Muslim 7% (1999)
Languages: Sinhala (official and national language) 74%, Tamil (national language) 18%, other 8%
note: English is commonly used in government and is spoken competently by about 10% of the population
Literacy: *definition:* age 15 and over can read and write
total population: 92.3%
male: 94.8%
female: 90%
Country name: *conventional long form:* Democratic Socialist Republic of Sri Lanka
conventional short form: Sri Lanka
former: Serendib, Ceylon
Government type: Republic,
Capital: Colombo; note – Sri Jayewardenepura Kotte is the legislative capital
Administrative divisions: 8 provinces; Central, North Central, North Eastern, North Western, Sabaragamuwa, Southern, Uva, Western; note - North Eastern province may have been divided in two - Northern and Eastern
Independence: 4 February 1948 (from UK)
Constitution: adopted 16 August 1978

(SOURCE: Department of Census and Statistics –Sri Lanka)

APPENDIX (B)

**EXTRACTS OF THE CONSTITUTION OF THE DEMOCRATIC SOCIALIST
REPUBLIC OF SRI LANKA -1978**

EXTRACTS OF THE CONSTITUTION OF THE DEMOCRATIC SOCIALIST REPUBLIC OF SRI LANKA -1978

CHAPTER I THE PEOPLE, THE STATE AND SOVEREIGNTY

The State

1. Sri Lanka (Ceylon) is a Free, Sovereign, Independent and Democratic Socialist Republic and shall be known as the Democratic Socialist Republic of Sri Lanka.

Unitary State

2. The Republic of Sri Lanka is a Unitary State.

Sovereignty of the People

3. In the Republic of Sri Lanka sovereignty is in the People and is inalienable. Sovereignty includes the powers of government, fundamental rights and the franchise.

Exercise of Sovereignty

4. The Sovereignty of the People shall be exercised and enjoyed in the following manner:-

(a) the legislative power of the People shall be exercised by Parliament, consisting of elected representatives of the People and by the People at a Referendum;

(b) the executive power of the People, including the defense of Sri Lanka, shall be exercised by the President of the Republic elected by the People;

(c) the judicial power of the People shall be exercised by Parliament through courts, tribunals and institutions created and established, or recognized, by the Constitution, or created and established by law, except in regard to matters relating to the privileges, immunities and powers of Parliament and of its Members, wherein the judicial power of the People may be exercised directly by Parliament according to law;

(d) the fundamental rights which are by the Constitution declared and recognized shall be respected, secured and advanced by all the organs of government, and shall not be abridged, restricted or denied, save in the manner and to the extent hereinafter provided; and

(e) the franchise shall be exercisable at the election of the President of the Republic and of the Members of Parliament, and at every Referendum by every citizen who has attained the age of eighteen years, and who, being qualified to be an elector as hereinafter provided, has his name entered in the register of electors.

Territory of the Republic

5. The territory of the Republic of Sri Lanka shall consist of the [twenty –five] administrative districts, the names of which are set out in the First Schedule, and its ****[territorial waters.**

Provided that such administrative districts may be subdivided or amalgamated so as to constitute different administrative districts, as Parliament may by resolution determine].

The National Flag

6. The National Flag of the Republic of Sri Lanka shall be the Lion Flag depicted in the Second Schedule.

The National Anthem

7. The National Anthem of the Republic of Sri Lanka shall be “Sri Lanka Matha”, the words and music of which are set out in the Third Schedule.

The National Day

8. The National Day of the Republic of Sri Lanka shall be the fourth day of February.

CHAPTER II BUDDHISM

Buddhism

9. The Republic of Sri Lanka shall give to Buddhism the foremost place and according to it shall be the duty of the State to protect and foster the Buddha Sasana, while assuring to all religions the rights granted by Articles 10 and 14(1)(e).

CHAPTER III FUNDAMENTAL RIGHTS

Freedom of thought, conscience and religion

10. Every person is entitled to freedom of thought, conscience and religion, including the freedom to have or to adopt a religion or belief of his choice.

Freedom from torture.

11. No person shall be subjected to torture or to cruel, inhuman or degrading treatment or punishment.

Right to equality

12. (1) All persons are equal before the law and are entitled to the equal protection of the law.

(2) No citizen shall be discriminated against on the grounds of race, religion, language, caste, sex, political opinion, place of birth or any one of such grounds : personal liberty except upon and in terms of the order of such judge made in accordance with procedure established by law.

(3) ...

(4) ...

Freedom from arbitrary arrest, detention and punishment, and prohibition of retroactive penal legislation.

13....

Freedom of speech, assembly, association, occupation, movement,

14. (1) Every citizen is entitled to-

(a) the freedom of speech and expression including publication;

(b) the freedom of peaceful assembly;

(c) the freedom of association;

(d) the freedom to form and join a trade union;

(e) the freedom, either by himself or in association with others, and either in public or in private, to manifest his religion or belief in worship, observance, practice and teaching;

(f) the freedom by himself or in association with others to enjoy and promote his own culture and to use his own language;

(g) the freedom to engage by himself or in association with others in any lawful occupation, profession, trade, business or enterprise;

- (h) the freedom of movement and of choosing his residence within Sri Lanka; and
- (i) the freedom to return to Sri Lanka.

(2) A person who, not being a citizen of any other country, has been permanently and legally resident in Sri Lanka immediately prior to the commencement of the Constitution and continues to be so resident shall be entitled, for a period of ten years from the commencement of the Constitution, to the rights declared and recognized by paragraph (1) of this Article.

Restrictions on fundamental rights

15. (1) The exercise and operation of the fundamental rights declared and recognized by Article 13 (5) and 13 (6) shall be subject only to such restrictions as may be prescribed by law in the interests of national security. For the purposes of this paragraph "law" includes regulations made under the law for the time being relating to public security.

(2) The exercise and operation of the fundamental rights declared and recognized by Article 14 (1) (a) shall be subject to such restrictions as may be prescribed by law in the interests of racial and religious harmony or in relation to parliamentary privilege, contempt of court, defamation or incitement to an offence.

(3) The exercise and operation of the fundamental right declared and recognized by Article (14) (1) (b) shall be subject to such restrictions as may be prescribed by law in the interests of racial and religious harmony.

(4) The exercise and operation of the fundamental right declared and recognized by Article 14 (1) (c) shall be subject to such restrictions as may be prescribed by law in the interests of racial and religious harmony or national economy.

(5) The exercise and operation of the fundamental right declared and recognized by Article 14 (1) (g) shall be subject to such restrictions as may be prescribed by law in the interests of national economy or in relation to-

(a) the professional technical, academic, financial and other qualifications necessary for practicing any profession or carrying on any occupation, trade, business or enterprise, and the licensing and disciplinary control of the person entitled to such fundamental right, and

(b) the carrying on by the State, a State agency or a public corporation of any trade, business, industry, service or enterprise whether to the exclusion, complete or partial, of citizens or otherwise.

(6) The exercise and operation of the fundamental right declared and recognized by Article 14 (1) (h) shall be subject to such restrictions as may be prescribed by law in the interests of national economy.

(7) The exercise and operation of all the fundamental rights declared and recognized by Articles 12, 13 (1), 13 (2) and 14 shall be subject to such restrictions as may be prescribed by law in the interests of national security, public order and the protection of public health or morality, or for the purpose of securing due recognition and respect for the rights and freedoms of others, or of meeting the just requirements of the general welfare of a democratic society. For the purposes of this paragraph "law" includes regulations made under the law for the time being relating to public security.

(8) The exercise and operation of the fundamental rights declared and recognized by Articles 12 (1), 13 and 14 shall, in their application to the members of the Armed Forces, Police Force and other Forces charged with the maintenance of public order, be subject to such restrictions as may be prescribed by law in the interests of the proper discharge of their duties and the maintenance of discipline among them.

Existing written law and unwritten law to continue in force

16. (1) All existing law and unwritten law shall be valid and operative notwithstanding any inconsistency with the preceding provisions of this Chapter.

(2) The subjection of any person on the order of a competent court to any form of punishment recognized by any existing written law shall not be a contravention of the provisions of this Chapter.

Remedy for the infringement of fundamental rights by executive action

17. Every person shall be entitled to apply to the Supreme Court, as provided by Article 126, in respect of the infringement or imminent infringement, by executive or administrative action, of a fundamental right to which such person is entered under the provisions of this Chapter.

CHAPTER IV LANGUAGE

Official Language

18. The Official Language of Sri Lanka shall be Sinhala.

National Languages

19. The National Languages of Sri Lanka shall be Sinhala and Tamil.

CHAPTER VI DIRECTIVE PRINCIPLES OF STATE POLICY AND FUNDAMENTAL DUTIES

27. (1) The Directive Principles of State Policy herein contained shall guide Parliament, the President and the Cabinet of Ministers in the enactment of laws and the governance Sri Lanka for the establishment of a just and free society.

(2) The State is pledged to establish in Sri Lanka a democratic socialist society, the objectives of which include-

- (a) the full realization of the fundamental rights and freedoms of all persons;
- (b) the promotion of the welfare of the People by securing and protecting as effectively as it may, a social order in which justice (social, economic and political) shall guide all the institutions of the national life;
- (c) the realization by all citizens of an adequate standard of living for themselves and their families, including adequate food, clothing and housing, the continuous improvement of living conditions and the full enjoyment of leisure and social and cultural opportunities;
- (d) the rapid development of the whole country by means of public and private economic activity and by laws prescribing such planning and controls as may be expedient for directing and co-ordinating such public and private economic activity towards social objectives and the public weal;
- (e) the equitable distribution among all citizens of the material resources of the community and the social product, so as best to sub serve the common good;
- (f) the establishment of a just social order in which the means of production, distribution and exchange are not concentrated and centralized in the State, State agencies or in the hands of a privileged few, but are dispersed among, and owned by, all the People of Sri Lanka;
- (g) raising the moral and cultural standards of the People, and ensuring the full development of human personality; and
- (h) the complete eradication of illiteracy and the assurance to all persons of the right to universal and equal access to education at all levels.

- (3) The State shall safeguard the independence, sovereignty, unity, and the territorial integrity of Sri Lanka.
- (4) The State shall strengthen and broaden the democratic structure of government and the democratic rights of the People by decentralizing the administration and by affording all possible opportunities to the People to participate at every level in national life and in government.
- (5) The State shall strengthen national unity by promoting co-operation and mutual confidence among all sections of the People of Sri Lanka, including the racial, religious, linguistic and other groups, and shall, take effective steps in the fields of teaching, education and information in order to eliminate discrimination and prejudice.
- (6) The State shall ensure equality of opportunity to citizens, so that no citizen shall suffer any disability on the ground of race, religion, language, caste, sex, political opinion or occupation.
- (7) The State shall eliminate economic and social privilege and disparity, and the exploitation of man by man or by the State.
- (8) The State shall ensure that the operation of the economic system does not result in the concentration of wealth and the means of production to the common detriment.
- (9) The State shall ensure social security and welfare.
- (10) The State shall assist the development of the cultures and the languages of the People.
- (11) The State shall create the necessary economic and social environment to enable people of all religious faiths to make a reality of their religious principles.
- (12) The State shall recognise and protect the family as the basic unit of society.
- (13) The State shall promote with special care the interests of children and youth, so as to ensure their full development, physical, mental, moral, religious and social, and to protect them from exploitation and discrimination.
- (14) The State shall protect, preserve and improve the environment for the benefit of the community.
- (15) The State shall promote international peace, security and co-operation, and the establishment of a just and equitable international economic and social order, and shall endeavour to foster respect for international law and treaty obligations in dealings among nations.

Fundamental duties

28. The exercise and enjoyment of rights and freedoms is inseparable from the performance of duties and obligations and accordingly it is the duty of every person in Sri Lanka-

- (a) to uphold and defend the Constitution and the law;
- (b) to further the national interest and to foster national unity;
- (c) to work conscientiously in his chosen occupation;
- (d) to preserve and protect public property, and to combat misuse and waste of public property;
- (e) to respect the rights and freedoms of others; and
- (f) to protect nature and conserve its riches.

Principles of State Policy and fundamental duties not justifiable

29. The provisions of this Chapter to not confer or impose legal rights or obligations, and are not enforceable in any court or tribunal. No question of inconsistency with such provisions shall be raised in any court or tribunal.

CHAPTER XI THE LEGISLATURE

Procedure and Powers

70. ...

Legislative Power

75. Parliament shall have power to make laws, including laws having retrospective effect and repealing or amending any provision of the Constitution, or adding any provision to the Constitution:

Provide that Parliament shall not make any law-

- (a) suspending the operation of the Constitution or any part thereof, or
- (b) repealing the Constitution as a whole unless such law also enacts a new Constitution

Delegation of Legislative Power

76. (1) Parliament shall not abdicate or in any manner alienate its legislative power, and shall not set up any authority with any legislative power.

(2) It shall not be a contravention of the provisions of paragraph (1) of this Article for Parliament to make, in any law relating to public security, provision empowering the president to make emergency regulations in accordance with such law.

(3) It shall not be a contravention of the provisions of paragraph (1) of this Article for Parliament to make, in any law containing any provision empowering any person or body to make subordinate legislation for prescribed purposes, including the power-

- (a) to appoint a date on which any law or any part thereof shall come into effect or cease to have effect;
- (b) to make by order any law or any part thereof applicable to any locality or to any class of persons; and
- (c) to create a legal person, by an order or an act.

In sub paragraph (a) and (b) of this paragraph, "law" includes existing law.

(4) Any existing law containing any such provision as aforesaid shall be valid and operative.

Duties of Attorney - General in regard to published Bills

77. (1) It shall be the duty of the Attorney - General to examine every Bill for any contravention of the requirements of paragraphs (1) and (2) of Article 82 and for any provision which can not be validly passed except by the special majority prescribed by the Constitution; and the Attorney - General or any officer assisting the Attorney - General in the performance of his duties under this Article shall be afforded all facilities necessary for the performance of such duties.

(2) If the Attorney - General is of the opinion that a Bill contravenes any of the requirements of paragraphs (1) and (2) of Article 82 or that any provision in a Bill cannot be validly passed except by the special majority prescribed by the Constitution, he shall communicate such opinion to the President:

Provided that in the case of an amendment proposed to a Bill in Parliament, the Attorney - General shall communicate his opinion to the Speaker at the stage when the Bill is ready to be put to Parliament for its acceptance.

Publication of Bills and passing of Bills and resolutions

78. (1) Every Bill shall be published in the Gazette at least seven days before it is placed on the Order Paper of Parliament.

(2) The passing of a Bill or a resolution by Parliament shall be in accordance with the Constitution and the Standing Orders of parliament. Any one or more of the Standing

Orders may be suspended by Parliament in the circumstance and in the manner prescribed by the Standing Orders.

Certificate of Speaker

79. The Speaker shall endorse on every Bill passed by Parliament a certificate in the following form:-

"This Bill (here state the short title of the Bill) has been duly passed by Parliament."

Such certificate may also state the majority by which such Bill was passed:

Provided that where by virtue of the provisions of Article 82 or Article 83 or Article 84 or Article 123 (2) a special majority is required for the passing of a Bill, the Speaker shall certify such Bill only if such Bill has been passed with such special majority:

Provided further that where by virtue of Article 83, the Bill or any provision thereof requires the approval of the people at a Referendum, such certificate shall further state that the Bill or such provision shall not become law until approved by the People at a Referendum.

When Bill becomes law

80. (1) Subject to the provisions of paragraph (2) of this Article, a Bill passed by Parliament shall become law when the certificate of the Speaker is endorsed thereon.

(2) Where the Cabinet of Ministers has certified that any Bill or any provision thereof is intended to be submitted for approval by the People at a Referendum or where the Supreme Court has determined that a Bill or any provision thereof required the approval of the People at a Referendum or where any Bills submitted to the People by Referendum under paragraph (2) of Article 85, such Bill or such provision shall become law upon being approved by the People at a Referendum in accordance with paragraph (3) of Article 85 only when the President certifies that the Bill or provision thereof has been so approved. The President shall endorse on every Bill so approved a certificate in the following form:

"This Bill/provision has been *[duly approved by the People at a Referendum]."

No such certificate shall be endorsed by the President on Bill-

* Substituted by the Fourteenth Amendment to the Constitution Sec. (4) "duly approved by the People at a Referendum".

(a) in any case where no petition is filed challenging the validity of the Referendum at which such Bill was approved by the People, until after the expiration of the period within which a petition may be filed, under the law applicable in that behalf, challenging the validity of such referendum;

(b) in any case where a petition is filed challenging the validity of the Referendum at which such Bill was approved by the People, until after the Supreme Court determines that such Referendum was valid.]

Every such certificate shall be final and conclusive, and shall not be called in question in any court.

(3) Where a Bill becomes law upon the certificate of the President or the Speaker, as the case may be, being endorsed thereon, no court or tribunal shall inquire into, pronounce upon or in any manner call in question, the validity of such Act on any ground whatsoever.

**CHAPTER XII
THE LEGISLATURE
AMENDMENT OF THE CONSTITUTION**

Approval of certain Bills at a Referendum

83. Notwithstanding anything to be contrary in the provisions of Article 82-

(a) a Bill for the amendment or for the repeal and replacement of or which is inconsistent with any of the provisions of Article 1, 2, 3, 6, 7, 8, 9, 10 and 11 or of this article, and

(b) a Bill for the amendment or for the repeal and replacement of or which is inconsistent with the provisions of paragraph (2) of Article 30 or of, paragraph (2) of Article 62 which would extend the term of office of the President or the duration of Parliament, as the case may be, to over six years,

shall become law if the number of votes cast in favour thereof amounts to not less than two-thirds of the whole number of Members (including those not present), is approved by the People at a Referendum and a certificate is endorsed thereon by the President in accordance with Article 80.

Bills inconsistent with the Constitution

84. (1) A Bill which is not for the amendment of any provision of the Constitution or for the repeal and replacement of the Constitution, but which is inconsistent with any provision of the Constitution may be placed on the Order Paper of Parliament without complying with the requirement of paragraph (1) or paragraph (2) of Article 82.

(2) Where the Cabinet of Ministers has certified that a Bill is intended to be passed by the special majority required by this Article or where the Supreme Court has determined that a Bill requires to be passed by such special majority, such Bill shall become law only if the number of votes cast in favour thereof amount to not less than two-thirds of the whole number of Members (including those not present) and a certificate by the President or the Speaker, as the case may be, is endorsed thereon in accordance with the provisions of Article 80 or 79.

(3) Such a Bill when enacted into law shall not, and shall not be deemed to, amend, repeal or replace the Constitution or any provision thereof, and shall not be so interpreted or construed, and may thereafter be replaced by a majority of the votes of the Members present and voting.

**CHAPTER XVI
THE SUPERIOR COURTS
THE SUPREME COURT**

Ordinary exercise of constitutional jurisdiction in respect of Bills.

121.(1) The jurisdiction of the Supreme Court to ordinarily determine any such questions as aforesaid may be invoked by the President by a written reference addressed to

the Chief Justice, or by any citizen by a petition in writing addressed to the Supreme Court. Such reference shall be made, or such petition shall be filed, within one week of the Bill being placed on the Order Paper of Parliament, and a copy thereof shall at the same time be delivered to the Speaker. In this paragraph U citizen n includes a body, whether incorporated or unincorporated, if not less than three-fourths of the members of such body are citizens.

(2) Where the jurisdiction of the Supreme Court has been so invoked no proceedings

shall be had in Parliament in relation to such Bill until the determination of the Supreme Court has been made, or the expiration of a period of three weeks from the date of such reference or petition, whichever occurs first.

Determination of Supreme Court in respect of Bills.

123. (1) The determination of the Supreme Court shall be accompanied by the reasons therefore, and shall state whether the Bill or any provision thereof is inconsistent with the constitution and if so, which provision or provisions of the Constitution.

(2) Where the Supreme Court determines that the Bill or any provision thereof is inconsistent with the Constitution, it shall also state-

(a) whether such Bill is required to comply with the provisions of paragraphs (1) and (2) of Article 82; or

(b) whether such Bill or any provision thereof may only be passed by the special majority required under the provisions of paragraph (2) of Article 84; or

(c) whether such Bill or any provision thereof requires to be passed by the special majority required under the provisions of paragraph (2) of Article 84 and approved by the People at a Referendum by virtue of the provisions of Article 83, and may specify the nature of the amendments which would make the Bill or such provision cease to be inconsistent.

(3) In the case of a Bill endorsed as provided in Article 122, if the Supreme Court entertains doubt whether the Bill or any provision thereof is inconsistent with the Constitution, it shall be deemed to have been determined that the Bill or such provision of the Bill is inconsistent with the provisions of paragraphs (1) and (2) of this Article.

(4) Where any Bill, or the provision of any Bill, has been determined, or is deemed to have been determined, to be inconsistent with the Constitution, such Bill or such provision shall not be passed except in the manner stated in the determination of the Supreme Court:

Provided that it shall be lawful for such Bill to be passed after such amendment as would make the Bill cease to be inconsistent with the Constitution.

Fundamental rights jurisdiction and its exercise

126. (1) The Supreme Court shall have sole and exclusive jurisdiction to hear and determine any question relating to the infringement or imminent infringement by executive or administrative action of any fundamental right or language right declared and recognized by Chapter III or Chapter IV.

(2) Where any person alleges that any such fundamental right or language right relating to such person has been infringed or is about to be infringed by executive or administrative action, he may himself or by an attorney-at-law on his behalf, within one month thereof, in accordance with such rules of court as may be in force, apply to the Supreme Court by way of petition in writing addressed to such Court praying for relief or redress in respect of such infringement. Such application may be proceeded with only with leave to proceed first had and obtained from the Supreme Court, which leave may be granted or refused, as the case may be, by not less than two Judges.

(3) Where in the course of hearing in the Court of Appeal into an application for orders in the nature of a writ of habeas corpus, certiorari, prohibition, procedendo, mandamus or quo warranto, it appears to such Court that there is prima-facie evidence of an infringement or imminent infringement of the provisions of Chapter III or Chapter IV by a party to such application, such Court shall forthwith refer such matter for determination by the Supreme Court.

(4) The Supreme Court shall have power to grant such relief or make such directions as it may deem just and equitable in the circumstance in respect of any petition or reference referred to in paragraphs (2) and (3) of this Article or refer the matter back to

the Court of Appeal if in its opinion there is no infringement of a fundamental right or language right.

(5) The Supreme Court shall hear and finally dispose of any petition or reference under this Article within two months of the filing of such petition or the making of such reference.

Power to grant injunctions

143. The Court of Appeal shall have the power to grant and issue injunctions to prevent any irremediable mischief, which might ensue before a party making an application for such injunction could prevent the same by bringing an action in any Court of First Instance:

Provided that it shall not be lawful for the Court of Appeal to grant an injunction to prevent a party to any action in any court from appealing to or prosecuting an appeal to the Court of Appeal or to prevent any party to any action in any court from insisting upon any ground of action, defence or appeal, or to prevent any person from suing or prosecuting in any court, except where such person has instituted two separate actions in two different courts for and in respect of the same cause of action, in which case the Court of Appeal shall have the power to intervene by restraining him from prosecuting one or other of such actions as to it may seem fit.

CHAPTER XX GENERAL

International Treaties and Agreements

157. Where Parliament by resolution passed by not less than two-thirds of the whole number of Members of Parliament (including those not present) voting in its favour, approves as being essential for the development of the national economy, any Treaty or Agreement between the Government of Sri Lanka and the Government of any foreign State for the promotion and protection of the investments in Sri Lanka of such foreign State, its nationals, or of corporations, companies and other associations incorporated or constituted under its laws, such Treaty or Agreement shall have the force of law in Sri Lanka, and otherwise than in the interests of national security no written law shall be enacted or made, and no executive or administrative action shall be taken, in contravention of the provisions of such Treaty or Agreement.

APPENDIX (C)

TABLE OF BILATERAL INVESTMENT TREATIES

TABLE OF BILATERAL INVESTMENT TREATIES

Country	Objectives/ salient features	Date of Signature	date of entry into force
Federal Republic of Germany	to foster and strengthen economic co-operation between the two states and intended to encourage investments by nationals and companies , encouragement and contractual protection of such investments for the mutual benefit of the two states were amongst the treaty's objectives. Article 8 of the agreement provides that investment shall comprise all categories of assets including categories of rights and interests.	08.11.1963	07.12.1966
The United Kingdom of Great Britain and Northern Ireland	Article 1 (a) of the said agreement provides that "For the purpose of this agreement investment means every kind of asset and in particular, though not exclusively, includes copyrights, industrial property rights (such as patents for inventions, trademarks, and industrial designs), know-how, trade names, and good will".	13.02.1980	18.12.1980
Republic of Korea	There is a special provision to protect Intellectual Property rights.	28.03.1980	15.07.1980
Republic of France		10.04.1980	19.04.1980
Republic of Singapore		09.05.1980	30.09.1980
Republic of Romania		09.02.1981	03.01.1982
Switzerland,		23.09.1981	12.02.1982
Japan		01.03.1982	07.08.1982
Belgo-Luxembourg		05.04.1982	26.04.1984
Malaysia		16.04.1982	31.10.1995
Sweden		30.04.1982	30.04.1982
Canada		17.01.1982	17.06.1982
the Kingdom of Netherlands		26.04.1984	01.05.1985
Republic of Finland		27.04.1985	25.10.1987

the Kingdom of Denmark		04.01.1985	04.07.1985
Norway		13.01.1985	13.01.1985
People's Republic of China		13.03.1986	25.03.1987
Republic of Italy		25.03.1987	20.03.1990
the United States of America		20.09.1991	01.05.1993
Thailand		03.01.1996	14.05.1996
Egypt		11.03.1996	10.03.1998
Republic of Indonesia		10.01.1996	21.07.1997
the Republic of India		22.01.1997	13.02.1998
the Islamic Republic of Pakistan		20.12.1997	-

APPENDIX (D)

MERCHANDISE MARKS ORDINANCE, NO. 05 OF 1865

Ordinance enacted by the Governor of Ceylon, with the advice and consent of the Legislative Council thereof.

No. 5.—1865.

Repealed (in sections 6, 16 to 19) 1.

HERCULES G. R. ROBINSON.

An Ordinance relating to the Fraudulent Marking of Merchandise.

Preamble.

WHEREAS it is expedient to make provision relating to the Fraudulent Marking of Merchandise, and to the Sale of Merchandise falsely marked for the purpose of Fraud: IT IS THEREFORE ENACTED BY THE GOVERNOR OF CEYLON, with the advice and consent of the Legislative Council thereof, as follows:—

Construction of words.

1. IN the construction of this Ordinance the following words and expressions shall have the meanings hereby assigned to them unless there be something in the subject or context repugnant to such construction:—

THE word "Person" shall include any person, whether a subject of Her Majesty or not, and any Body corporate or Body of the like nature, whether constituted according to the Law of the United Kingdom of Great Britain and Ireland or any of Her Majesty's Colonies or Dominions, or according to the Law of any Foreign Country, and also any Company, Association, or Society of persons, whether the members thereof be subjects of Her Majesty or not, or some of such persons subjects of Her Majesty and some of them not, and whether such Body corporate, Body of the like nature, Company, Association, or Society be established or carry on business within Her Majesty's dominions or elsewhere, or partly within Her Majesty's dominions and partly elsewhere.

THE word "Mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description.

THE expression "Trade Mark" shall include any and every such name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark as aforesaid lawfully used by any person to denote any chattel, or any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, production, or merchandise of such person, or to be an article or thing of any peculiar or particular description made or sold by such person, and shall also include any name, signature, word, letter, number, figure, mark, or sign which in pursuance of any Law for the time being in force relating to registered designs is to be put or placed upon or attached to any chattel or article during the existence or continuance of any copyright or other sole right acquired under the provisions of any law.

Forging a trade mark or falsely applying any trade mark with intent to defraud, an offence.

2. EVERY person who, with intent to defraud, or to enable another to defraud any person, shall forge or counterfeit, or cause or procure to be forged or counterfeited, any trade mark, or shall apply, or cause or procure to be applied, any trade mark or any forged or counterfeited trade mark to any chattel or article not being the manufacture, workmanship, production, or merchandise of any person denoted or intended to be denoted by such trade mark, or denoted or intended to be denoted by such forged or counterfeited trade mark; or not being the manufacture, workmanship, production, or merchandise of any person whose trade mark shall be so forged or counterfeited, or shall apply, or cause or procure to be applied, any trade mark or any forged or counterfeited trade mark to any chattel or article, not being the particular or peculiar description of manufacture, workmanship, production, or merchandise denoted or intended to be denoted by such trade mark or by such forged or counterfeited trade mark; shall, in addition to the punishment hereinafter prescribed for such offence, also forfeit to Her Majesty

every chattel and article belonging to such person to which he shall have so unlawfully applied, or caused or procured to be applied, any such trade mark or forged or counterfeited trade mark as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade mark, or forged or counterfeited trade mark as aforesaid, shall have been so applied, and every instrument in the possession or power of such person for applying any such trade mark or forged or counterfeit trade mark as aforesaid, shall be forfeited to Her Majesty; and the Court before which any such offence shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such Court shall think fit.

Applying a forged trade mark to any vessel, case, wrapper, &c., in or with which any article is sold or intended to be sold, an offence.

3. EVERY person who, with intent to defraud, or to enable another to defraud, any person, shall apply or cause or procure to be applied any trade mark or any forged or counterfeited trade mark to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, on, or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or intended for any purpose of trade or manufacture, or shall enclose or place any chattel or article, or cause or procure any chattel or article to be enclosed or placed, in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeited trade mark shall have been applied, or shall apply or attach or cause or procure to be applied or attached to any chattel or article any case, cover, reel, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeited trade mark shall have been applied, or shall enclose, place, or attach any chattel or article, or cause or procure any chattel or article to be enclosed, placed, or attached, in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing having thereon any trade mark of any other person, shall, in addition to the punishment hereinafter prescribed for such offence, also forfeit to Her Majesty every such chattel and article, and also every such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid in the possession or power of such person; and every other similar cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing made to be used in like manner as aforesaid, and every instrument in the possession or power of such person, and by means of which any such trade mark or forged or counterfeited trade mark as aforesaid shall have been applied, and also every instrument in the possession or power of such person for applying any such trade mark or forged or counterfeit trade mark as aforesaid, shall be forfeited to Her Majesty; and the Court before which any such offence shall be tried may order such forfeited articles as aforesaid to be destroyed or otherwise disposed of as such Court shall think fit.

Selling articles with forged or false trade marks after 31st December 1865, penalty equal to value of article sold, and a sum not exceeding 5*l.* nor less than 10*s.*

4. EVERY person who, after the Thirty-first day of December, One thousand eight hundred and sixty-five, shall sell, utter, or expose either for sale or for any purpose of trade or manufacture, or cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade mark, which he shall know to be forged or counterfeited, or together with the trade mark of any other person applied or used falsely or wrongfully or without lawful authority or excuse, knowing such trade mark of another person to have been so applied or used as aforesaid, and that whether any such trade mark or forged or counterfeited trade mark as aforesaid, together with which any such chattel or article shall be sold, uttered, or exposed for sale or other purpose as aforesaid, shall be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall be so sold or uttered or exposed for sale or other purpose as aforesaid, shall for every such offence forfeit and pay to Her Majesty a sum of money equal to the value of the chattel or article so sold, uttered, offered, or exposed for sale or other purpose as aforesaid, and a further sum not exceeding Five pounds and not less than Ten shillings.

Additions to and alterations of trade marks made with intent to defraud to be deemed forgeries.

5. EVERY addition to and every alteration of, and also every imitation of any trade mark which shall be made, applied, or used with intent to defraud, or to enable any other person to defraud, or which shall cause a trade mark with such alteration or addition, or shall cause such imitation of a trade mark to resemble any genuine trade mark so or in such manner as to be calculated or likely to deceive, shall be and be deemed to be a false, forged, and counterfeited trade mark within

the meaning of this Ordinance, and every act of making, applying, or otherwise using any such addition to or alteration of a trade mark or any such imitation of a trade mark as aforesaid done by any person with intent to defraud, or to enable any other person to defraud, shall be and be deemed to be forging and counterfeiting a trade mark within the meaning of this Ordinance.

Any person who, after 31st December 1865, shall have sold an article having a false trade mark to be bound to give information where he procured it.

6. WHEN any person at any time after the Thirty-first day of December One thousand eight hundred and sixty-five, shall have sold, uttered, or exposed for sale or other purpose as aforesaid, or shall have caused or procured to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article, together with any forged or counterfeited trade mark, or together with the trade mark of any other person used without lawful authority or excuse as aforesaid, and that whether any such trade mark, or such forged or counterfeited trade mark as aforesaid be in, upon, about, or with such chattel or article, or in, upon, about, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing in, upon, about, or with which such chattel or article shall have been sold or exposed for sale, such person shall be bound upon demand in writing delivered to him or left for him at his last known dwelling-house or at the place of sale or exposure for sale by or on the behalf of any person whose trade mark shall have been so forged or counterfeited, or used without lawful authority or excuse as aforesaid, to give to the person requiring the same, or his attorney or agent, within forty-eight hours after such demand, full information in writing of the name and address of the person from whom he shall have purchased or obtained such chattel or article, and of the time when he obtained the same; and it shall be lawful for any Police Magistrate having local jurisdiction on information on oath of such demand and refusal, to summon before him the party refusing, and on being satisfied that such demand ought to be complied with, to order such information to be given within a certain time to be appointed by him; and any such party who shall refuse or neglect to comply with such order shall for every such offence forfeit and pay to Her Majesty the sum of Five pounds, and such refusal or neglect shall be *prima facie* evidence that the person so refusing or neglecting had full knowledge that the trade mark, together with which such chattel or article was sold, uttered, or exposed for sale or other purpose as aforesaid, at the time of such selling, uttering, or exposing was a forged, counterfeited, and false trade mark, or was the trade mark of a person which had been used without lawful authority or excuse, as the case may be.

Power to Magistrates to summon parties refusing to give information.

Penalty for refusal £5.

Marking any false indication of quantity, &c., upon an article with intent to defraud, —penalty, a sum equal to the value of the article and the further sum not exceeding 5*l.* and not less than 10*s.*

7. EVERY person who, with intent to defraud or to enable another to defraud, shall put or cause or procure to be put upon any chattel or article, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which any chattel or article shall be intended to be or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture, or upon any case, frame, or other thing in or by means of which any chattel or article shall be intended to be or shall be exposed for sale, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article, or any part thereof, or of the place or Country in which such chattel or article shall have been made, manufactured, or produced, or shall put or cause or procure to be put upon any such chattel or article, cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing as aforesaid, any word, letter, figure, signature, or mark for the purpose of falsely indicating such chattel or article, or the mode of manufacturing or producing the same, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent, privilege, or copyright, shall for every such offence forfeit and pay to Her Majesty a sum of money equal to the value of the chattel or article so sold, or uttered, or exposed for sale, and a further sum not exceeding Five pounds and not less than Ten shillings.

Selling or exposing for sale after the 31st December, 1865, articles with false statement of quantities, &c., —penalty, not more than 5*l.* or less than 5*s.*

8. EVERY person who, after the Thirty-first day of December One thousand eight hundred and sixty-five, shall sell, utter, or expose for sale or for any purpose of trade or manufacture, or shall cause or procure to be sold, uttered, or exposed for sale or other purpose as aforesaid, any chattel or article upon which shall have been, to his knowledge, put, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing, together with which such chattel or article shall be sold or uttered or exposed for sale or other purpose as aforesaid, shall have been so put, or upon any case, frame, or other thing used or employed to expose or exhibit such chattel or article for sale shall have been so put, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article or any part thereof, or the place or

Country in which such chattel or article shall have been made, manufactured, or produced, shall for every such offence forfeit and pay to Her Majesty a sum not exceeding Five pounds and not less than Five shillings.

Proviso that it shall not be an offence to apply names or words known to be used for indicating particular classes of manufactures.

9. PROVIDED always, that the provisions of this Ordinance shall not be construed so as to make it any offence for any person to apply to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing with which such chattel or article shall be sold or intended to be sold, any name, word, or expression generally used for indicating such chattel or article to be of some particular class or description of manufacture only, or so as to make it any offence for any person to sell, utter, or offer or expose for sale any chattel or article to which, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing sold therewith, any such generally used name, word, or expression as aforesaid shall have been applied.

Description of trade marks and forged trade marks in indictments, &c.

10. IN every indictment, pleading, proceeding, and document whatsoever, in which any trade mark shall be intended to be mentioned, it shall be sufficient to mention or state the same to be a trade mark without further or otherwise describing such trade mark, or setting forth any copy or fac-simile thereof; and in every indictment, pleading, proceeding, and document whatsoever in which it shall be intended to mention any forged or counterfeit trade mark, it shall be sufficient to mention or state the same to be a forged or counterfeit trade mark without further or otherwise describing such forged or counterfeit trade mark, or setting forth any copy or fac-simile thereof.

Conviction not to affect any right or civil remedy.

11. THE provisions in this Ordinance contained of or concerning any act, or any proceeding, judgment, or conviction for any act hereby treated as an offence, shall not nor shall any of them take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such act may be entitled to at Law, or otherwise, and shall not nor shall any of them exempt or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories, or otherwise, in any suit or other Civil proceeding; provided always, that no evidence, statement, or discovery which any person shall be compelled to give or make shall be admissible in evidence against such person in support of any indictment for an offence or otherwise, or of any proceeding under the provisions of this Ordinance.

Intent to defraud, &c., any particular person, need not be alleged in an indictment, &c., or proved.

12. IN every indictment, information, conviction, pleading, and proceeding against any person for any offence against the provisions of this Ordinance, in which it shall be necessary to allege or mention an intent to defraud, or to enable another to defraud, it shall be sufficient to allege or mention that the person accused of having done any act which is hereby made an offence did such act with intent to defraud, or with intent to enable some other person to defraud, without alleging or mentioning an intent to defraud any particular person; and on the trial of any such indictment, or information for any such offence, and on the hearing of any information, or charge of or for any such other offence as aforesaid, and on the trial of any action against any person to recover a penalty for any such other offence as aforesaid, it shall not be necessary to prove an intent to defraud any particular person, or an intent to enable any particular person to defraud any particular person, but it shall be sufficient to prove with respect to every such offence that the person accused did the act charged with intent to defraud, or with intent to enable some other person to defraud, or with the intent that any other person might be enabled to defraud.

Persons who aid in the commission of an offence to be also guilty.

13. EVERY person who shall aid, abet, counsel, or procure the commission of any offence under this Ordinance, shall also be guilty of an offence.

Punishment.

14. EVERY person who shall be convicted or found guilty of any offence under this Ordinance shall be liable, at the discretion of the Court, and as the Court shall award, to suffer punishment by imprisonment for not more than Two years, with or without hard labour, or by fine, or both.

Limitations of Actions, &c.

15. NO action or proceeding for the recovery of any penalty, or procuring the conviction of any offender in manner hereinbefore provided shall be commenced Three years next after the committing of the offence.

After 31st December 1865, vendor of an article with a trade mark to be deemed to contract that the mark is genuine.

After 31st December 1865 Vendor of an article with description upon it of its quantity to be deemed to contract that the description was true.

In actions against persons for using forged trade marks, Court may order article to be destroyed, and may award injunction, &c.

Persons aggrieved by Forgeries may recover damages against the guilty parties.

16. IN every case in which at any time after the Thirty-first day of December One thousand eight hundred and sixty-five any person shall sell or contract to sell (whether by writing or not) to any other person any chattel or article with any trade mark thereon, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that every trade mark upon such chattel or article, or upon any such cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing as aforesaid, was genuine and true, and not forged or counterfeit, and not wrongfully used, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

17. IN every case in which at any time after the Thirty-first day of December One thousand eight hundred and sixty-five, any person shall sell or contract to sell (whether by writing or not) to any other person any chattel or article upon which, or upon any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing together with which such chattel or article shall be sold or contracted to be sold, any description, statement, or other indication of or respecting the number, quantity, measure, or weight of such chattel or article or the place or country in which such chattel or article shall have been made, manufactured, or produced, the sale or contract to sell shall in every such case be deemed to have been made with a warranty or contract by the vendor to or with the vendee that no such description, statement, or other indication was in any material respect false or untrue, unless the contrary shall be expressed in some writing signed by or on behalf of the vendor, and delivered to and accepted by the vendee.

18. IN every action or criminal proceeding against any person for forging or counterfeiting any trade mark, or for fraudulently applying any trade mark, to any chattel or article, or for selling, exposing for sale, or uttering any chattel or article with any trade mark falsely or wrongfully applied thereto, or with any forged or counterfeit trade mark applied thereto, or for preventing the repetition or continuance of any such wrongful act, or the committal of any similar act, in which judgment shall be given against the defendant, the Court shall have power to direct every such chattel and article to be destroyed or otherwise disposed of; and in every such action or proceeding the Court shall or may upon giving judgment against the defendant award a Writ of Injunction or Injunctions on the defendant commanding him to forbear from committing and not by himself or otherwise to repeat or commit any offence or wrongful act of the like nature as that of which he shall or may have been convicted by such judgment; and any disobedience of any such Writ of Injunction or Injunctions shall be punished as a Contempt of Court; and in every such action or proceeding it shall be lawful for the Court or the Judge thereof to make such order as such Court or Judge shall think fit for the inspection of every or any manufacture or process carried on by the defendant in which any such forged or counterfeit trade mark, or any such trade mark as aforesaid, shall be alleged to be used or applied as aforesaid, and of every or any chattel, article, and thing in the possession or power of the defendant alleged to have thereon or in any way attached thereto any forged or counterfeit trade mark, or any trade mark falsely or wrongfully applied, and every or any instrument in the possession or power of the defendant used or intended to be or capable of being used for producing or making any forged or counterfeit trade mark, or trade mark alleged to be forged or counterfeit or for falsely or wrongfully applying any trade mark; and any person who shall refuse or neglect to obey any such order shall be guilty of a Contempt of Court.

19. IN every case in which any person shall do or cause to be done any of the wrongful acts following; (that is to say,) shall forge or counterfeit any trade mark; or for the purpose of sale, or for the purpose of any manufacture or trade, shall apply any forged or counterfeit trade mark to any chattel or article, or to any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or thing in or with which any chattel or article shall be intended to be sold or shall be sold or uttered or exposed for sale, or for any purpose of trade or manufacture; or shall inclose or place any chattel or article in, upon, under, or with any cask, bottle, stopper, vessel, case, cover, wrapper, band, reel, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeit trade mark shall have been applied; or shall apply or attach to any

chattel or article any case, cover, reel, wrapper, band, ticket, label, or other thing to which any trade mark shall have been falsely applied, or to which any forged or counterfeit trade mark shall have been applied; or shall inclose, place, or attach any chattel or article in, upon, under, with, or to any cask, bottle, stopper, vessel, case, cover, reel, wrapper, band, ticket, label, or other thing having thereon any trade mark of any other person; every person aggrieved by any such wrongful act shall be entitled to maintain an action for damages in respect thereof against the person who shall be guilty of having done such act or causing or procuring the same to be done, and for preventing the repetition or continuance of the wrongful act and the committal of any similar act.

Short title.

20. THE expression "The Merchandise Marks Act, 1865," shall be a sufficient description of this Ordinance.

Passed in Council, the Eighteenth day of October, One Thousand Eight Hundred and Sixty-five.

JAMES SWAN,
Acting Clerk to the Council.

Assented to by His Excellency the Governor, the Twentieth day of October, One thousand Eight Hundred and Sixty-five, and published by his Order.

W. C. GIBSON,
Colonial Secretary.

APPENDIX (E)

MERCHANDISE MARKS ORDINANCE, NO.13 OF 1888

No. 13.—1888.

An Ordinance to amend the Law relating to Fraudulent Marks on Merchandise.

ARTHUR GORDON.

Preamble.

WHEREAS it is expedient to amend the law relating to fraudulent marks on merchandise: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:—

Short title.

Commencement.

1 This Ordinance may be cited as "The Merchandise Marks Ordinance, 1888"; and it shall come into operation at such time as the Governor shall appoint by Proclamation to be published in the *Government Gazette*.

Repeal of Ordinance 5 of 1865 and of certain sections of the Ceylon Penal Code.

2 The Ordinance No. 5 of 1865, intituled "An Ordinance relating to the fraudulent marking of Merchandise," so far as the same has not been repealed by the Criminal Procedure Code, 1883, and sections 467 and 469 and so much of sections 471, 472, 474, and 475 of the Ceylon Penal Code as relate to trade marks, are hereby repealed; and any unrepealed enactment referring to any enactment so repealed shall be construed to apply to the corresponding provisions of this Ordinance: Provided that this repeal shall not affect—

- (a) any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment hereby repealed; nor
- (b) the institution or continuance of any proceeding or other remedy under any enactment so repealed for the recovery of any penalty incurred, or for the punishment of any offence committed, before the commencement of this Ordinance; nor
- (c) any right, privilege, liability, or obligation acquired, accrued, or incurred under any enactment hereby repealed.

Offences as to trade marks and trade descriptions.

3 (1) Every person who—

- (a) forges any trade mark; or
- (b) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or
- (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade mark; or
- (d) applies any false trade description to goods; or
- (e) disposes of, or has in his possession, any die, block, machine, or other instrument for the purpose of forging a trade mark; or
- (f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Ordinance, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Ordinance.

(2) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false

trade description is applied, or to which any trade mark, or mark so nearly resembling a trade mark as to be calculated to deceive, is falsely applied, as the case may be, shall, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence against this Ordinance he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and
 - (b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or
 - (c) that otherwise he had acted innocently;
- be guilty of an offence against this Ordinance.

(3) Every person charged with an offence against this Ordinance may be tried by the district court or police court, and shall be liable—

- (i) on conviction by the district court, to simple or rigorous imprisonment for a term not exceeding two years; or to fine not exceeding one thousand rupees, or to both imprisonment and fine; and
- (ii) on summary conviction by the police court, to simple or rigorous imprisonment for a term not exceeding three months, or to a fine not exceeding one hundred rupees; and in the case of a second or subsequent conviction to simple or rigorous imprisonment for a term not exceeding six months, or to a fine not exceeding five hundred rupees; and
- (iii) in any case, to forfeit to Her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4) The court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the court thinks fit.

(5) It shall be lawful for a police court, in the case of a second or subsequent summary conviction, to inflict the full amount of fine hereinbefore provided, anything in section 16 of the Criminal Procedure Code, 1883, to the contrary notwithstanding: Provided that a person charged with an offence under this section before a police court shall, on appearing before the court, and before the charge is gone into, be informed of his right to be tried by the district court, and, if he requires, be so tried accordingly.

4 (1) For the purposes of this Ordinance—

The expression "trade mark" means a trade mark registered in the register of trade marks kept under "The Trade Marks Ordinance, 1883," and includes any trade mark which is registered in the register of trade marks kept under the Patents, Designs, and Trade Marks Act, 1883 (46 and 47 Victoria, chapter 57), and any trade mark which, either with or without registration,

Definitions.

is protected by law in any British possession or foreign State to which the provisions of the one hundred and third section of the Patents, Designs, and Trade Marks Act, 1883, are, under Her Majesty's Order in Council, for the time being applicable :

The expression "trade description" means any description, statement, or other indication, direct or indirect—

- (a) as to the number, quantity, measure, gauge, or weight of any goods, or
- (b) as to the place or country in which any goods were made or produced, or
- (c) as to the mode of manufacturing or producing any goods, or
- (d) as to the material of which any goods are composed, or
- (e) as to any goods being the subject of an existing patent, privilege, or copyright ;

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Ordinance ;

The expression "false trade description" means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect ; and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Ordinance :

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise :

The expressions "person," "manufacturer, dealer, or trader," and "proprietor" include any body of persons corporate or unincorporate :

The expression "name" includes any abbreviation of a name.

(2) The provisions of this Ordinance respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3) The provisions of this Ordinance respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description ; and for the purpose of this

enactment the expression false name or initials means, as applied to any goods, any name or initials of a person which—

- (a) are not a trade mark, or part of a trade mark, and
 - (b) are identical with, or a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials, and
 - (c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.
- (4) A trade description which denotes or implies that there are contained in any goods to which it is applied more yards, feet, or inches than there are, contained therein, standard yards, standard feet, or standard inches, is a false trade description.

5 A person shall be deemed to forge a trade mark who either—

Forging trade mark.

- (a) without the assent of the proprietor of the trade mark makes that trade mark or a mark so nearly resembling that mark as to be calculated to deceive; or
 - (b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise;
- and any trade mark or mark so made or falsified is in this Ordinance referred to as a forged trade mark.

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

6 (1) A person shall be deemed to apply a trade mark, or mark, or trade description to goods who—

Applying marks and descriptions

- (a) applies it to the goods themselves; or
- (b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture; or
- (c) places, encloses, or annexes any goods which are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied; or
- (d) uses a trade mark, or mark, or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark, or mark, or trade description.

(2) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression "label" includes any band or ticket. A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed, stamped,

branded, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing.

(3) A person shall be deemed to falsely apply to goods a trade mark or mark who, without the assent of the proprietor of a trade mark, applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive; but in any prosecution for falsely applying a trade mark or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.

Exemption of certain persons employed in ordinary course of business.

7 Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in this Colony, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b) that he took reasonable precautions against committing the offence charged; and

(c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the trade mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

Application of Ordinance to watches.

8 Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall, *prima facie*, be deemed to be a description of that country within the meaning of this Ordinance; and the provisions of this Ordinance with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for, sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly; and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case.

9 In any indictment, charge, proceeding, or document in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark.

Trade mark
how described
in pleading.

10 In any prosecution for an offence against this Ordinance,—

Rules as to
evidence.

(1) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.

(2) in the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced.

11 Any person who, being within this Colony, abets the commission, without this colony, of any act which, if committed in this Colony, would under this Ordinance be an offence, shall be deemed guilty of that offence, and be liable to be indicted, proceeded against, tried, and convicted in any district or place in this Colony in which he may be, as if the offence had been there committed.

Punishment of
accessories.

12 (1) Where, upon information of an offence against this Ordinance, a magistrate has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said magistrate on or after issuing the summons or warrant, or any other magistrate, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to, which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control, in any place, such magistrate may issue a warrant under his hand, by virtue of which it shall be lawful for any police officer, or other person named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a Police Court for the purpose of its being determined whether the same are or are not liable to forfeiture under this Ordinance.

Search warrant.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Ordinance, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a police court may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such

time and place the court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows sufficient cause to the contrary, may order such goods or things, or any of them to be forfeited; and every such order shall be subject to appeal.

(3) Any goods or things forfeited under this section, or under any other provision of this Ordinance, may be destroyed or otherwise disposed of in such manner as the court by which the same are forfeited may direct; and the court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

Costs of defence
and of
prosecution.

13 On any prosecution under this Ordinance the court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by, and the conduct of, the defendant and prosecutor respectively, and the sum so awarded as costs shall be recoverable as if it were a fine.

Limitation of
prosecution.

14 No prosecution for an offence against this Ordinance shall be commenced after the expiration of three years next after the commission of the offence or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.

Prohibition on
importation.

15 Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Ordinance: Be it therefore enacted as follows:—

(1) All such goods, and also all goods made or produced beyond the limits of the United Kingdom and this Colony, and having applied thereto any name or trade mark being, or purporting to be, or being a colourable imitation of, the name or trade mark of any manufacturer, dealer, or trader in the United Kingdom or this Colony, unless such name or trade mark is accompanied by a definite indication, indicated in letters as large and conspicuous as any letter in the name or trade mark, of the place and country in which the goods were made or produced, are hereby prohibited to be imported into this Colony, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were referred to in section thirty-six of the Customs Ordinance, No. 17 of 1869, and included in Schedule C to the Ordinance No. 14 of 1871.

(2) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Collector of Customs, or other officer specially

appointed in this behalf by the Governor, may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

- (3) The Principal Collector of Customs may from time to time, with the sanction of the Governor in the Executive Council, make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture; and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.
- (4) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in the United Kingdom of this Colony, that name, unless accompanied in equally large and conspicuous letters by the name of the country in which such place is situate, shall be treated, for the purposes of this section, as if it were the name of a place in the United Kingdom or this Colony.
- (5) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.
- (6) The regulations may provide for the informant reimbursing the Collector of Customs all expenses and damages incurred in respect of any detention made on his information and of any proceedings consequent on such detention.
- (7) All regulations under this section shall be published in the *Government Gazette*.

16 On the sale or in the contract for the sale of any goods to which a trade mark, or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark, and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Ordinance, unless the contrary is expressed in some 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.

17 Where, at the passing of this Ordinance, a trade description is lawfully and generally applied to goods of a

Provisions as to
false description

not to apply in certain cases.

particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Ordinance with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced and the goods are not actually made or produced in that place or country,—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, with that name, 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.

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

(2) Nothing in this Ordinance 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 against this Ordinance.

(3) Nothing in this Ordinance shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in this Colony who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

False representation as to royal warrant

19 Any person who falsely represents that any goods are made by a person holding a royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government Department, shall be liable, on summary conviction, to a penalty not exceeding one hundred rupees.

Offences cognizable and bailable

20 All offences under this Ordinance are hereby declared to be "cognizable" and "bailable," within the meaning of those terms as defined in section 3 of the Criminal Procedure Code, 1883.

Passed in Council the Twenty-first day of December, One thousand Eight hundred and Eight-eight.

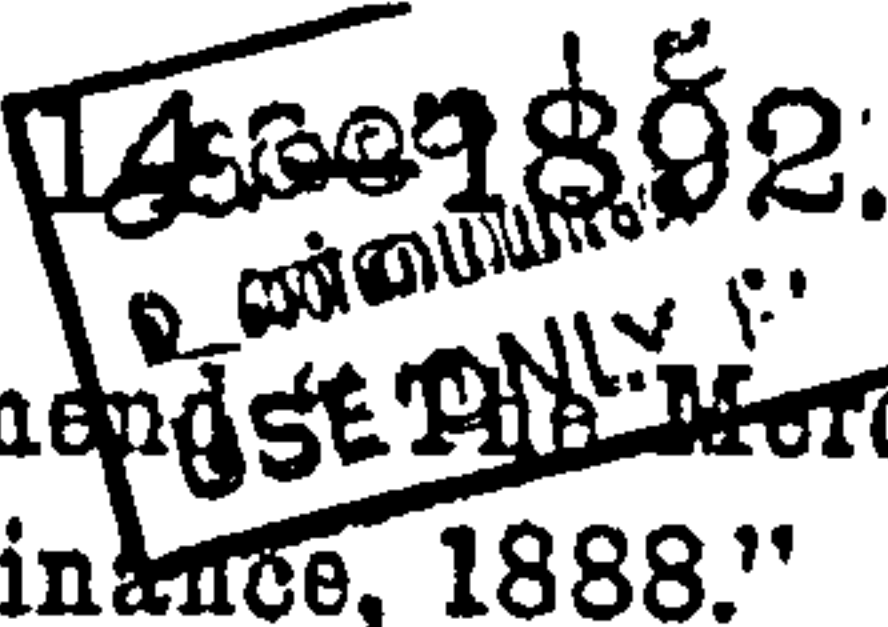
A. M. ASHMORE,
Acting Clerk to the Council.

Assented to by His Excellency the Governor the Twenty-second day of December, One thousand Eight hundred and Eighty-eight.

E. NOEL WALKER,
Colonial Secretary.

APPENDIX (F)

MERCHANDISE MARKS ORDINANCE, NO.14 OF 1892



An Ordinance to amend "The Merchandise Marks Ordinance, 1888."

A. E. HAVELOCK.

WHEREAS it is expedient to amend "The Merchandise Marks Ordinance, 1888," hereinafter referred to as the principal Ordinance: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:—

Preamble.

1 After sub-section (2) of section 3 of the principal Ordinance, and before sub-section (3) of the same section, the following sub-section shall be inserted and numbered (2 a), namely:—

Amendment of Ordinance No. 13 of 1888.

"Every person who imports any piece goods ordinarily sold by length or by the piece, manufactured beyond the limits of the Colony, or who sells, or exposes for, or has in his possession for sale or any purpose of trade any piece-goods ordinarily sold as aforesaid, whether manufactured within or beyond the limits of the Colony, which have not conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece, shall be guilty of an offence against this Ordinance.

Section 3, as to offences as to trade marks and trade descriptions.

"Provided always that nothing in this sub-section contained shall apply to any piece-goods manufactured within the limits of the Colony by hand labour only."

2 In the twelfth line of sub-section (1) of section 15 of the principal Ordinance, after the words "or produced" and before the words "are hereby prohibited" shall be inserted the words "and also all piece-goods such as are ordinarily sold by the length or by the piece, which have not conspicuously stamped in English numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, according to the real length of the piece."

Section 15, as to prohibition in importation.

3 This Ordinance shall come into operation from and after such date as the Governor shall appoint by Proclamation published in the *Government Gazette*, and may be cited as "The Merchandise Marks Ordinance, 1892," and this Ordinance and the principal Ordinance may be cited collectively as "The Merchandise Marks Ordinances, 1888 and 1892."

Short title.

Passed in Council the Twenty-sixth day of October, One thousand Eight hundred and Ninety-two.

H. L. CRAWFORD,
Clerk to the Council.

Assented to by His Excellency the Governor the Second day of November, One thousand Eight hundred and Ninety-two.

E. NOEL WALKER,
Colonial Secretary.

APPENDIX (G)

TRADE MARKS ORDINANCE, NO. 14 OF 1888

No. 14.—1888.

An Ordinance providing for the Registration of Trade Marks.

ARTHUR GORDON.

WHEREAS it is expedient to provide for the registration of trade marks in this Island: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:—

Preamble.

1 This Ordinance may be cited as "The Trade Marks Ordinance, 1888"; and it shall come into operation at such time as the Governor shall appoint by Proclamation to be published in the *Government Gazette*.

Short title.

Commencement.

Preliminary.

2 In and for the purposes of this Ordinance, unless the context otherwise requires—

Interpretation clause:

"Person" includes a body corporate.

"Person."

"Colonial Secretary" includes any assistant to the Colonial Secretary to the extent to which he may be authorised by general or special order of the Governor to discharge the functions of the Colonial Secretary under this Ordinance.

"Colonial Secretary."

"Prescribed" means prescribed by the Schedule to this Ordinance or by general rules under or within the meaning of this Ordinance.

"Prescribed."

"The Court" means the District Court of Colombo.

"The Court."

A "trade mark" must consist of, or contain at least, one of the following essential particulars:—

"Trade mark."

(a) A name of an individual or firm printed, impressed, stamped, branded, or woven in some particular and distinctive manner; or

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

(c) A distinctive device, mark, stamp, brand, heading, label, ticket, or fancy word or words not in common use.

There may be added to any one or more of these particulars, any letters, words, or figures, or combination of letters, words, or figures, or any of them.

Registration of Trade Marks.

3 (1) Any person claiming to be the proprietor of a trade mark may by himself or his agent apply to the Colonial Secretary for an order for the registration thereof.

Application for registration.

(2) The application must be made in the prescribed form, and must be accompanied by not less than three representations of the trade mark.

(3) The applicant must state the particular goods or classes of goods in connection with which he desires the trade mark to be registered.

(4) The application must be left with, or sent by post to, the Colonial Secretary.

(5) The date of the delivery or receipt of the application shall be endorsed thereon, and recorded in the Colonial Secretary's Office.

Colonial Secretary may make order for registration.

4 (1) Upon such application as aforesaid, the Colonial Secretary may, after such inquiry as he thinks fit, and subject to the provisions hereinafter contained, make an order authorising the registration of the trade mark.

(2) When an order has been made under this section, the Colonial Secretary shall cause the trade mark to be registered in a book to be kept by him for that purpose, and to be called the Register of Trade Marks.

(3) The date of registration shall be recorded in the said register.

Limit of time for proceeding with application.

5 Where registration of a trade mark shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned.

Connection of trade mark with goods. Registration of a series of marks.

6 A trade mark must be registered for particular goods or classes of goods.

7 When a person claiming to be the proprietor of several trade marks, which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade marks may be registered in any colour.

8 A trade mark may be registered in any colour, and such registration shall, subject to the provisions of this Ordinance, confer on the registered owner the exclusive right to use the same in that or any other colour.

Advertisement of application.

9 Every application for registration of a trade mark under this Ordinance shall, as soon as may be after its receipt, be advertised by the Colonial Secretary in the *Government Gazette* and in one or more of the local newspapers.

Opposition to registration.

10 (1) Any person may within two months of the advertisement of the application, give notice in duplicate to the Colonial Secretary of opposition to registration of the trade mark, and the Colonial Secretary shall send one copy of such notice to the applicant.

(2) Within two months after receipt of such notice, or such further time as the Colonial Secretary may allow, the applicant may send to the Colonial Secretary a counter-statement in duplicate of the grounds on which he relies for his application; and if he does not do so shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Colonial Secretary shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Colonial

Secretary may require for such costs as may be awarded in respect of such opposition ; and if such security is not given within fourteen days after such requirement was made or such further time as the Colonial Secretary may allow, the opposition shall be deemed to be withdrawn.

(4) If the person who gave notice of opposition duly gives such security as aforesaid, the Colonial Secretary shall inform the applicant thereof in writing, and thereafter the case shall be deemed to stand for the determination of the court.

11 (1) When a case stands for the determination of the court under the provisions of the last preceding section, the Colonial Secretary shall require the applicant, within one month or such further time as the Colonial Secretary may allow, to make a written application to the court for an order that, notwithstanding the opposition of which notice has been given, the registration of the trade mark be proceeded with by the Colonial Secretary, or to take such other proceedings as may be proper and necessary for the determination of the case by the court.

Case how brought before court.

(2) The applicant shall thereupon make his application or take such other proceedings as aforesaid, within the period of one month above-named, or such further time as the Colonial Secretary may allow, and shall also within the like period give notice thereof to the Colonial Secretary.

(3) If the applicant shall fail to make such application or to take such other proceedings, of which failure the non-receipt by the Colonial Secretary of the said notice shall be sufficient proof, the applicant shall be deemed to have abandoned his application.

12 A trade mark when registered shall be assigned and transmitted only in connection with the good-will of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that good-will.

Assignment and transmission of trade mark.

13 Where each of several persons claims to be registered as proprietor of the same trade mark, the Colonial Secretary may refuse to register any of them until their rights have been determined according to law ; and the Colonial Secretary may require the claimants to submit their rights to the court.

Conflicting claims to registration.

14 The manner in which the rights of such claimants may be submitted to the court shall, unless the court otherwise order, be by a special case, and such special case, which shall be subject to a stamp duty of one rupee, shall be filed and proceeded with in like manner as any other special case submitted to the court, or in such other manner as the court may direct. The special case may be agreed to by the claimants, or if they differ may be settled by the Colonial Secretary on payment of the prescribed fee.

Submission to court of conflicting claims.

Settlement of special case.

15 (1) Except where the court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Colonial Secretary shall not register

Restrictions on registration.

in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

(2) The Colonial Secretary shall not register with respect to the same goods or description of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Further restriction on registration.

16 It shall not be lawful to register as part of, or in combination with, a trade mark any words the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Power to provide for entry on register of common marks as addition to trade marks.

17 (1) Nothing in this Ordinance shall be construed to prevent the Colonial Secretary entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(a) in the case of an application for registration of a trade mark used before the coming into operation of this Ordinance—any distinctive device, mark, stamp, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) in the case of an application for registration of a trade mark not used before the coming into operation of this Ordinance—any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made.

(2) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same ; and a copy of the disclaimer shall be entered on the register.

(3) Any device, mark, stamp, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the coming into operation of this Ordinance, publicly used by more than three persons on the same or a similar description of goods, shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

18 Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

Registration equivalent to public use.

Right of first proprietor to exclusive use of trade mark.

19 The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Ordinance.

20 A person shall not be entitled to institute any proceeding in a civil court to prevent or to recover damages for the infringement of a trade mark, unless, in the case of a trade mark capable of being registered under this Ordinance, it has been registered in pursuance of this Ordinance; or, in the case of any other trade mark in use before the coming into operation of this Ordinance, registration thereof, under this Ordinance, has been refused. The Colonial Secretary may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Restrictions on actions for infringement, and on defence to action in certain cases.

Register of Trade Marks.

21 There shall be kept at the Colonial Secretary's office a book called the register of trade marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments, and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Register of trade marks.

22 (1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the Colonial Secretary shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the Colonial Secretary before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, the Colonial Secretary shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

Removal of trade marks after fourteen years unless fee paid.

(2) If such fee be not paid before the expiration of such fourteen years, the Colonial Secretary may, after the end of three months from the expiration of such fourteen years, remove the mark from the register; and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Colonial Secretary may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the Colonial Secretary may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5) Where a trade mark has been removed from the register for non-payment of the fee, or otherwise, such trade mark shall, nevertheless, for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered.

General.

23 There shall not be entered in the register kept under this Ordinance, or be receivable by the Colonial Secretary, any notice of any trust expressed, implied, or constructive.

Trust not to be entered in register.

Refusal to register in certain cases.

24 The Colonial Secretary may refuse to register a trade mark of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in register.

25 Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, the Colonial Secretary shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the trade mark in the register of trade marks. The person for the time being entered in the register of trade marks as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such trade mark may be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from register.

26 The register kept under this Ordinance shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Colonial Secretary's office, of any entry in any such register shall be given to any person requiring the same, on payment of the prescribed fee.

Sealed copies to be received in evidence.

27 Printed or written copies or extracts purporting to be certified by the Colonial Secretary, and sealed with the seal of the Colonial Secretary's office, of or from any document, register, and other book filed or kept under this Ordinance in the said office, shall be admitted in evidence in all courts in this Colony, and in all proceedings, without further proof or production of the originals.

Rectification of register by court.

28 (1) The court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person from the register kept under this Ordinance, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry as the court thinks fit; or the court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the court thinks fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the court rectifying a register shall direct that due notice of the rectification be given to the Colonial Secretary.

Power to correct clerical errors.

29 The Colonial Secretary may, on request in writing, accompanied by the prescribed fee—

(a) correct any clerical error in or in connection with an application for the registration of a trade mark: or

- (b) correct any clerical error in the name, style, or address of the registered proprietor of a trade mark ; or
- (c) cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by an affidavit made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

30 (1) The registered proprietor of any registered trade mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Ordinance ; and the court may refuse or grant leave, on such terms as it may think fit.

Alteration of registered trade mark.

(2) Notice of any intended application to the court under this section shall be given to the Colonial Secretary by the applicant ; and the Colonial Secretary shall be entitled to be heard on the application.

(3) If the court grants leave, the Colonial Secretary shall, on proof thereof, and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

31 Every application made to the court under section 11, 28, or 30 shall be subject to a stamp duty of one rupee, and all proceedings thereunder shall be conducted in such manner as the court may direct.

Applications to be stamped.

32 The minimum stamp duties chargeable in the district courts in civil proceedings under the provisions of the Ordinance for the time being in force relating to stamps shall, so far as the same may be applicable and except as herein otherwise provided, be charged in all proceedings in the court under this Ordinance. But in no case shall the Colonial Secretary be required to use any stamp or be charged with any stamp duty.

Stamp duties.

33 Every judgment or order by the district court under this Ordinance shall be subject to an appeal to the Supreme Court, and such appeal shall be subject to the same rules which govern interlocutory appeals from district courts ; and the minimum stamp duties chargeable in the Supreme Court under the provisions of the Ordinance for the time being in force relating to stamps shall, so far as the same may be applicable, be charged in all proceedings relating to or in connection with such appeal.

Appeal.

34 Where any discretionary power is by this Ordinance given to the Colonial Secretary, he shall not exercise that power adversely to the applicant for registration of a trade mark without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Exercise of discretionary power by Colonial Secretary.

35 The Colonial Secretary may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Ordinance, apply to the Attorney-General or Solicitor-General for directions in the matter.

Colonial Secretary may take directions of law officers.

Certificate of Colonial Secretary to be evidence.

36 A certificate purporting to be under the hand of the Colonial Secretary as to any entry, matter, or thing which he is authorised by this Ordinance, or any general rules 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 left undone.

Applications and notices by post.

37 (1) Any application, notice, or other document authorised or required to be left with or sent to the Colonial Secretary, or to any other person under this Ordinance, may be sent by a registered letter through the post; and if so sent shall be deemed to have been so left or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and registered at the post office.

Provision as to public holidays.

38 Whenever the last day fixed by this Ordinance, or by any rule for the time being in force, for leaving any document with, or paying any fee to the Colonial Secretary, shall fall on a public holiday, it shall be lawful to leave such document or to pay such fee on the day next following such public holiday, or holidays if two or more of them occur consecutively.

Case of infant, lunatic, &c.

39 If any person is, by reason of infancy, lunacy, or other inability, incapable of making any affidavit or doing any thing required or permitted by this Ordinance, or by any rules made under the authority of this Ordinance, then the guardian of such incapable person, or if there be none, any person appointed by any court possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making of such affidavit or doing such thing, may make such affidavit, or an affidavit as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person; and all acts done by such substitute shall, for the purposes of this Ordinance, be as effectual as if done by the person for whom he is substituted.

Governor may make rules, &c., under this Ordinance.

40 (1) The Governor in Executive Council may from time to time make such general rules, prescribe such forms, and do such things as he thinks expedient, subject to the provisions of this Ordinance—

(a) for regulating the practice of registration under this Ordinance;

(b) for classifying goods for the purposes of trade marks;

(c) for prescribing the fees payable in respect of applications and registration and other matters under this Ordinance, and the mode of payment of the same.

(d) generally for regulating all things by this Ordinance placed under the direction or control of the Colonial Secretary.

(2) Any rules made in pursuance of this section shall be published in the *Government Gazette*, and it shall be lawful for the Governor, in Executive Council, by proclamation to be published in the *Government Gazette*, to alter, amend, or revoke any such rules.

Protection of Trade Marks registered in Great Britain.

41 (1) Any person who has registered a trade mark in Great Britain shall be entitled to registration of his trade mark under this Ordinance in priority to other applicants; and such registration shall have the same date as the date of the application for registration in Great Britain.

Registration of British trade marks.

Provided that his application is made within four months from his applying for protection in Great Britain.

Provided that nothing in this section contained shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the date of the actual registration of his trade mark in this Colony.

(2) The use in this Colony during the period aforesaid of the trade mark shall not invalidate the registration of the trade mark.

(3) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under the Ordinance.

Provided that any trade mark, the registration of which has been duly applied for in Great Britain, may be registered under this Ordinance.

Offences.

42 (1) If any person makes or causes to be made a false entry in the register kept under this Ordinance, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false, he shall be guilty of an offence, and punished with simple or rigorous imprisonment for a term not exceeding seven years.

Offences.
Falsification of entries in register.

(2) Any person who describes any trade mark applied to any article sold by him as registered, which is not so, shall be guilty of an offence, and liable on conviction to a fine not exceeding fifty rupees. A person shall be deemed, for the purposes of this section, to describe that a trade mark is registered, if he sells the article with the word "registered," or any word or words expressing or implying that registration has been obtained for the article, stamped, engraved, or impressed on, or otherwise applied to, the article.

Falsely describing trade mark as registered.

(3) Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government department, assumes or uses in connection with any trade, business, calling, or profession the royal arms or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be guilty of an offence, and liable on conviction to a fine not exceeding one hundred rupees.

Unauthorised assumption of royal arms.

43 All offences under this Ordinance are hereby declared to be "non-cognizable" and "bailable," within the meaning of those terms as defined in section 3 of the Criminal Procedure Code, 1883.

Offences non-cognizable and bailable.

SCHEDULE.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

You are hereby requested to register the accompanying trade mark [*in Class —, Iron in bars, sheets, and plates; in Class —, Steam Engines and Boilers; and in Class —, Warming Apparatus*] in the name of —(a), who claims to be the proprietor thereof.

Registration Fees enclosed, Rs. —

To the Hon. the Colonial Secretary,
Colonial Secretary's Office, Colombo.

(Signed) _____

(a) Here insert legibly the name, address, and business of the individual or firm.

Note.—State whether the trade mark has or has not been in use before the coming into operation of this Ordinance.

Passed in Council the Twenty-first day of December, One thousand Eight hundred and Eighty-eight.

A. M. ASHMORE,
Acting Clerk to the Council.

Assented to by His Excellency the Governor the Twenty-second day of December, One thousand Eight hundred and Eighty-eight.

E. NOEL WALKER,
Colonial Secretary.

APPENDIX (H)

TRADE MARKS ORDINANCE, NO. 4 OF 1890

SANCTIONED. No. 4.—1890.

An Ordinance to amend "The Trade Marks' Ordinance, 1888."

ARTHUR GORDON.

Preamble.

WHEREAS it is expedient to amend "The Trade Marks Ordinance, 1888," hereinafter referred to as the principal Ordinance: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:—

Amendments
of Ordinance
No. 14 of 1888.

1 For the definition of "a trade mark" in section 2 of the principal Ordinance beginning with the words "a trade

mark must consist of" and ending with the words "any of them" shall be substituted the following:—

"(1) A 'trade mark' must consist of or contain at least one of the following essential particulars:—

Section 2, as to
trade mark.

"(a) a name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(b) a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(c) a distinctive device, mark, stamp, brand, heading, label, or ticket; or

"(d) an invented word or invented words; or

"(e) a word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2) There may be added to any one or more of the essential particulars mentioned in sub-section 1 any letters, words, or figures, or combination of letters, words, or figures, or any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered in the register.

"(3) Provided as follows:—

"(a) A person need not under sub-section 2 disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

"(b) Any special and distinctive word or words, letter, figure, or combination of letters and figures used as a trade mark before the coming into operation of this Ordinance may be registered as a trade mark under this Ordinance."

Section 3, as to
application for
registration.

2 To section 3 of the principal Ordinance the following sub-section shall be added:—

"(6) When an applicant for the registration of a trade mark is out of the Island at the time of making the application, he shall give the Colonial Secretary an address for service in the Island, and if he fails to do so the application shall not be proceeded with until the address has been given."

3 In section 5 of the principal Ordinance, for the words "the application shall be deemed to be abandoned" shall be substituted the words "the Colonial Secretary shall give notice of the non-completion to the applicant or to his agent, and if at the expiration of fourteen days from that notice, or of such further time as the Colonial Secretary may in special

Section 5, as to
limit of time for
proceeding with
application.

cases permit, the registration is not completed, the application shall be deemed to be abandoned."

Section 8, as to colour of trade marks.

4 In section 8 of the principal Ordinance, the words "or colours" shall be added after the word "colour" in each place where that word occurs.

Section 9, as to advertisement of applications.

5 In section 9 of the principal Ordinance, after the words "local newspapers" shall be added the words "unless the Colonial Secretary refuse to entertain the application."

Section 10, as to opposition to registration.

6 (1) (a) In sub-section 1 of section 10 of the principal Ordinance, for the words "two months" shall be substituted the words "one month, or such further time not exceeding three months as the Colonial Secretary may allow."

(b) In sub-section 2 of the same section, for the words "two months" shall be substituted the words "one month."

(2) To the same section of the principal Ordinance the following sub-sections shall be added :—

"(5) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Colonial Secretary may determine to be reasonable.

"(6) Where the opponent is out of the Island he shall give the Colonial Secretary an address for service in the Island."

Section 15, as to restrictions on registration.

7 In sub-section 2 of section 15 of the principal Ordinance the following words shall be added at the beginning of the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

Section 16, as to restriction on registration.

8 In section 16 of the principal Ordinance the word "exclusive" shall be omitted.

Section 17, as to trade marks.

9 For sub-section 2 of section 17 of the principal Ordinance the following sub-section shall be substituted, namely :—

"(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register."

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

10 For section 18 of the principal Ordinance, the following section shall be substituted, namely :—

Section 18, as to effect of application for registration.

“Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall, for the purposes of this Ordinance, be deemed to be, and as from the twenty-second day of December, one thousand eight hundred and eighty-eight, to have been the date of the registration.”

11 After section 20 of the principal Ordinance the following section shall be added and numbered 20 (a); namely :—

Certificate as to exclusive use, and costs thereon.

“In an action for infringement of a registered trade mark the court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the court so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between proctor and client, unless the court trying the subsequent action certifies that he ought not to have the same.”

12 (1) In sub-section 5 of section 22 of the principal Ordinance, for the words “the five years” shall be substituted the words “one year.”

Section 22, as to removal of trade mark from the register.

(2) To the same sub-section the following words shall be added; namely, “unless it is shown to the satisfaction of the Colonial Secretary that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.”

13 In section 25 of the principal Ordinance, after the words “subject to” shall be added the words “the provisions of this Ordinance and to.”

Section 25, as to entry of assignments, &c.

14 In section 26 of the principal Ordinance, after the words “subject to” shall be added the words “the provisions of this Ordinance and to.”

Section 26, as to inspection.

15 To section 29 of the principal Ordinance, the following sub-section shall be added; namely, “(d) Permit an applicant for registration of a trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade mark to be registered.”

Section 29, as to correction of errors.

16 After section 39 of the principal Ordinance, the following section shall be added and numbered 39 (a), namely :—

Fees.

There shall be paid, in respect of applications and registration and other matters under this Ordinance, such fees as may from time to time be prescribed by the Governor in Executive Council.

o

Construction of principal Ordinance.

17 The principal Ordinance shall as from the commencement of this Ordinance take effect subject to the additions, omissions, and substitutions required by this Ordinance, but nothing in this Ordinance shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Ordinance.

Commencement of Ordinance.

18 This Ordinance shall commence and come into operation on the first day of July, one thousand eight hundred and ninety.

Short title.

19 This Ordinance may be cited as "The Trade Marks Ordinance, 1890," and this Ordinance and the principal Ordinance may be cited collectively as "The Trade Marks Ordinances, 1888 and 1890."

Passed in Council the Sixteenth day of April, One thousand Eight hundred and Ninety.

A. R. DAWSON,
Acting Clerk to the Council.

Assented to by His Excellency the Governor the Twentieth day of April, One thousand Eight hundred and Ninety.

E. NOEL WALKER,
Colonial Secretary.

APPENDIX (I)

TRADE MARKS AMENDMENT ORDINANCE, NO. 6 OF 1904

No. 6 of 1904.

Ordinance to amend the Law relating to the Registration of Trade Marks in Ceylon.

WHEREAS it is expedient to amend the law relating to the registration of trade marks in Ceylon: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

Preamble

1. This Ordinance may be cited as "The Trade Marks Amendment Ordinance, 1904," and shall be read and construed as one with "The Trade Marks Ordinance, 1888" (hereinafter referred to as "the principal Ordinance"), and this Ordinance and the principal Ordinance and the Ordinance No. 4 of 1890 may be cited together as "The Trade Marks Ordinances, 1888 to 1904."

Short title.

2. In lieu of section 41 of the principal Ordinance the following sections shall be substituted, and shall be numbered respectively 41 A and 41 B:

Addition to principal Ordinance of section regarding international arrangements for protection of trade marks.

41 A. If His Majesty is pleased by Order in Council to apply the provisions of section 103 of "The Patent Designs and Trade Marks Act, 1883," to Ceylon, then any person

who has applied for protection for any trade mark in the United Kingdom or in any foreign state with the Government of which His Majesty has made an arrangement under the said section for the mutual protection of trade marks shall be entitled to registration of his trade mark under this Ordinance in priority to other applicants; and such registration shall have the same date as the application in the United Kingdom or such foreign state, as the case may be.

(2) Such application shall be made within four months from such person applying for protection in the United Kingdom or in the foreign state with which the arrangement is in force.

(3) Nothing in this section contained shall entitle the proprietor of a trade mark to recover damages for infringements happening prior to the date of the actual registration of his trade mark in this colony.

(4) The use in Ceylon of a trade mark during the period aforesaid shall not invalidate the registration of the trade mark.

(5) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under this Ordinance, but any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Ordinance.

(6) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council shall have declared the provisions of the aforesaid section 103 of the above recited Imperial Act to be applicable, and so long only, in the case of each state, as such Order continues in force with respect to that state.

Provision for
intercolonial
arrangements.

41 B Whenever it appears to the Governor in Executive Council that the Legislature of any British Possession has made satisfactory provision for the protection in such possession of trade marks registered in Ceylon, the Governor in Executive Council may by Proclamation apply all or any of the provisions of the last preceding section relating to the protection of trade marks registered in the United Kingdom, with such variations or additions (if any) as to the Governor in Executive Council shall seem fit, to trade marks registered in such British Possession.

(2) An Order in Council under this section shall from a date to be mentioned in the Order take effect as if its provisions had been contained in this Ordinance, but the Governor in Executive Council may revoke any such Order.

APPENDIX (J)

TRADE MARKS AND DESIGNS ORDINANCE, NO. 9 OF 1906

No. 9 of 1906.

An Ordinance to transfer to the Registrar-General the duties assigned to the Colonial Secretary by "The Trade Marks Ordinances, 1888 to 1904," and by "The Designs Ordinance, 1904."

Preamble.

WHEREAS it is expedient that the duties assigned to the Colonial Secretary by "The Trade Marks Ordinances, 1888 to 1904," and by "The Designs Ordinance, 1904," should be transferred to the Registrar-General: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

Short title.

1 This Ordinance may be cited as "The Trade Marks and Designs Ordinance, 1906," and shall come into operation

at such date as the Governor, by Proclamation in the *Government Gazette*, shall appoint.

2 For the definition of the term "Colonial Secretary" in section 2 of "The Trade Marks Ordinance, 1888," and in section 2 of "The Designs Ordinance, 1904," there shall be substituted the following definition, namely:

Amendment of section 2 of both Ordinances with regard to definition of "Colonial Secretary."

"Registrar" means the Registrar-General, and includes any officer in the Registrar-General's Department to the extent to which he may be authorized by general or special order of the Governor to discharge the duty of the registrar under this Ordinance.

3 For the terms "the Colonial Secretary" and "the Colonial Secretary's Office" wherever they occur in either of the two above-named Ordinances or in any marginal note or schedule thereto, or in any amending Ordinance, there shall be respectively substituted the terms "the registrar" and "the registrar's office."

Substitution of "Registrar-General" for "Colonial Secretary" throughout Ordinances.

14th March, 1906.

APPENDIX (K)

TRADE MARKS (AMENDMENT) ORDINANCE, NO. 15 OF 1908

No. 15 of 1908.

REVOKED.

An Ordinance to amend in certain particulars "The Trade Marks Ordinance, 1888."

WHEREAS it is expedient to amend the law relating to the registration of trade marks in Ceylon: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows; Preamble.

1 This Ordinance may be cited as "The Trade Marks (Amendment) Ordinance, 1908," and shall be read and construed as one with "The Trade Marks Ordinance, 1888" Short title.

(hereinafter referred to as "the principal Ordinance"), and this Ordinance, the principal Ordinance, the Ordinance No. 4 of 1890, and "The Trade Marks (Amendment) Ordinance, 1904," may be cited together as "The Trade Marks Ordinances, 1888 to 1908."

Commencement. 2 This Ordinance shall come into force on such date as the Governor shall, by Proclamation in the *Government Gazette*, appoint.

3 The following sub-section shall be inserted in section 2 of the principal Ordinance, as amended by section 1 of Ordinance No. 4 of 1890, and shall be numbered (4):

(4) Provided that—

(a) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods.

(b) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods.

(c) No registration of a cotton mark, that is to say, a trade mark in respect of cotton goods constituting classes 23, 24, and 25 in schedule 3 of the rules made under section 40 (1) of the principal Ordinance, as amended by Ordinances Nos. 4 of 1890, 6 of 1904, and 9 of 1906, dated June 1, 1906, and published in the *Government Gazette* of June 1, 1906, shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

20th October, 1908.

APPENDIX (L)

**THE PATENTS, DESIGNS, AND TRADE MARKS
(TEMPORARY RULES) ORDINANCE, NO.10 OF 1915**

Ordinance enacted by the Governor of Ceylon, with the advice
and consent of the Legislative Council thereof.

No. 10 of 1915.

An Ordinance to extend the Powers of the Governor in Council,
during the continuance of the present hostilities, to make
Regulations and Rules under "The Patents Ordinance,
1906," "The Designs Ordinance, 1904," and "The
Trade Marks Ordinance, 1888."

ROBERT CHALMERS.

Preamble.

WHEREAS it is expedient to extend the powers of the
Governor in Council, during the continuance of the
present hostilities, to make regulations and rules under
"The Patents Ordinance, 1906," "The Designs Ordinance,
1904," and "The Trade Marks Ordinance, 1888": Be it
therefore enacted by the Governor of Ceylon, by and with the
advice and consent of the Legislative Council thereof, as
follows:

Short title.

1 This Ordinance may be cited as "The Patents, Designs,
and Trade Marks (Temporary Rules) Ordinance, No. 10 of
1915."

Extension of
powers of
Governor in
Council to make
temporary
regulations and
rules.

2 (1) The power of the Governor in Council under section
52 of "The Patents Ordinance, 1906," section 33 of "The
Designs Ordinance, 1904," and section 40 of "The Trade Marks
Ordinance, 1888," to make regulations and rules, shall include
power to make regulations and rules and to do such things as
he thinks expedient for avoiding or suspending, in whole or
in part, any patent or license, the person entitled to the benefit
of which is the subject of any State at war with His Majesty;
for avoiding or suspending the registration and all or any
rights conferred by the registration of any design or trade
mark the proprietor whereof is a subject as aforesaid; for
avoiding or suspending any application made by any such
person under any of the said Ordinances; for enabling the
Registrar to grant in favour of persons other than such persons
as aforesaid, on such terms and conditions, and either for the
whole term of the patent or registration or for such less period
as the Registrar may think fit, license to make, use, exercise,
or vend patented inventions and registered designs so liable
to avoidance or suspension as aforesaid; and for extending
the time within which any act or thing may or is required to
be done under those Ordinances.

(2) If the rules made under this Ordinance so provide, the
rules or any of them shall have effect as from the passing of
this Ordinance.

(3) This Ordinance shall apply to any person resident or
carrying on business in the Territory or State at war with His
Majesty as if he was a subject of that State; and the expression
"subject of any State at war with His Majesty" shall, with
reference to a company, include any company the business
whereof is managed or controlled by such subjects, or is carried
on, wholly or mainly, for the benefit or on behalf of such
subjects, notwithstanding that the company may be registered
within His Majesty's Dominions; and where a patent has been
granted to any person in respect of an invention declared in
the application or any specification to have been communicated
to him by some other person, that other person shall, for the
purposes of this Ordinance, be deemed to be the person entitled
to the benefit of the patent, unless the contrary is proved.

Passed in Council the Twenty-fourth day of March, One
thousand Nine hundred and Fifteen.

A. G. CLAYTON,
Clerk to the Council.

Assented to by His Excellency the Governor the Fourteenth
day of April, One thousand Nine hundred and Fifteen.

R. E. STUBBS,
Colonial Secretary.

APPENDIX (M)

THE TRADE MARKS (AMENDMENT) ORDINANCE, NO. 23 OF 1918

Ordinance No. 23 of 1918.

An Ordinance to amend "The Trade Marks Ordinance, 1888."

[Date of Governor's assent: December 10, 1918.]

[Date of commencement: to be fixed by Proclamation.]

W. H. MANNING.

WHEREAS it is expedient to amend "The Trade Marks Ordinance, 1888": Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

Preamble.

1 This Ordinance may be cited as "The Trade Marks (Amendment) Ordinance, No. 23 of 1918," and shall come into operation on such date as the Governor shall by Proclamation appoint.

Short title.

2 For clause (c) of sub-section (4) of section 2 of the principal Ordinance the following clause shall be substituted:

Substitution of new clause (c) for clause (c) of sub-section (4) of section 2 of the principal Ordinance.

(c) No registration of a cotton mark, that is to say, a trade mark in respect of cotton piece goods or cotton yarn in classes 23 and 24 in schedule 3 of the rules made under section 40 (1) of the principal Ordinance, as amended by Ordinances Nos. 4 of 1890, 6 of 1904, and 9 of 1906, dated June 1, 1906, and published in the *Government Gazette* of June 1, 1906, shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

Passed in Council the Twenty-seventh day of November, One thousand Nine hundred and Eighteen.

C. H. COLLINS,
Clerk to the Council.

Assented to by His Excellency the Governor the Tenth day of December, One thousand Nine hundred and Eighteen.

R. E. STUBBS,
Colonial Secretary.

APPENDIX (N)

**THE ALIEN ENEMY (VESTING OF TRADE MARKS)
ORDINANCE, NO.5 OF 1919**

Ordinance No. 5 of 1919.

An Ordinance to vest in the Custodian of Enemy Property certain Trade Marks belonging to Alien Enemies.

[Date of Governor's assent : March 7, 1919.]

[Date of commencement : to be fixed by Order in Council.]

W. H. MANNING.

WHEREAS it is expedient to vest in the Custodian of Enemy Property certain trade marks belonging to alien enemies: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

Preamble.

1 This Ordinance may be cited as "The Alien Enemy (Vesting of Trade Marks) Ordinance, No. 5 of 1919," and shall come into operation on such date as the Governor in Executive Council may, by order in the *Government Gazette*, appoint.

Short title and commencement.

2 In this Ordinance, unless the context otherwise requires—

Definitions.

"Trade mark" means a trade mark registered under "The Trade Marks Registration Ordinance, 1888."

"Custodian of Enemy Property" means the person for the time being discharging the duties of the Custodian of Enemy Property under "The Enemy Firms Liquidation Ordinance, No. 20 of 1916."

3 (1) Every trade mark which is the property of any enemy person, firm, or company not having a fixed place of business in the Colony shall be and the same is hereby declared to be vested in the Custodian of Enemy Property.

Vesting of trade marks and goodwill in Custodian of Enemy Property.

(2) Any goodwill existing in connection with the use of any such trade mark in this Colony shall also be vested in the said Custodian.

4 All trade marks now vested in any liquidator or in any persons deemed to be liquidators under "The Enemy Firms Liquidation Ordinance, No. 20 of 1916," and not disposed of at the commencement of this Ordinance, shall be and the same are hereby declared to be vested in the Custodian of Enemy Property.

Vesting of trade marks now vested in liquidators in the Custodian of Enemy Property.

Passed in Council the Nineteenth day of February, One thousand Nine hundred and Nineteen.

C. H. COLLINS,
Clerk to the Council.

Assented to by His Excellency the Governor the Seventh day of March, One thousand Nine hundred and Nineteen.

R. E. STUBBS,
Colonial Secretary.

APPENDIX (O)

TRADE MARKS ORDINANCE, NO. 15 OF 1925

S. K. HEMARATNE, LL. B.

CHAPTER 121.

TRADE - MARKS.

Ordinances Nos. 15 of 1925, 23 of 1932.

AN ORDINANCE TO AMEND AND CONSOLIDATE THE LAW RELATING TO TRADE MARKS.

[1st January, 1927.]

Short title.

1. This Ordinance may be cited as the Trade Marks Ordinance.

PART I.

REGISTER OF TRADE MARKS.

Register of trade marks.

2. (1) There shall be kept at the Registrar's office for the purposes of this Ordinance a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed.

Division of register into two parts.

(2) The register shall be divided into two parts, to be called respectively Part A and Part B.

Part A.

(3) Part A of the register shall comprise all trade marks which may be registered or are incorporated in Part A of the register under the provisions of this part of this Ordinance.

Part B.

(4) Part B of the register shall comprise all trade marks registered under Part III. of this Ordinance, and all trade marks entered on or removed thereto under Part III. of this Ordinance.

(5) The register shall be kept under the control and management of the Registrar.

Trust not to be entered on register.

3. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Incorporation of existing register.

4. The register of trade marks existing at the date of the commencement of this Ordinance shall be incorporated with and form part of Part A of the register. Subject to the

provisions of sections 34 and 40 of this Ordinance, the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the law in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Ordinance.

5. The register kept under this Ordinance shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection of
and extract
from register.

REGISTRABLE TRADE MARKS.

6. A trade mark must be registered in respect of particular goods or classes of goods.

Trade marks
must be for
particular goods.

7. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

Registrable
trade marks.

- (a) the name of a company, individual, or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark; but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (a), (b), (c), and (d), shall not be registrable under the provisions of this paragraph, except upon evidence of its distinctiveness:

Provided always that—

- (i) any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the twenty-fifth day of March, one thousand eight hundred and eighty-nine, which has

continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Ordinance ;

(ii) in respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods ;

(iii) no registration of a cotton mark, that is to say, a trade mark in respect of cotton yarn, sewing cotton, or cotton piece goods in classes 23 and 24 in the third schedule of the rules made under this Ordinance and published in the *Gazette* of the tenth day of December, one thousand nine hundred and twenty-six, shall give any exclusive right to the use of any letter, numeral, line heading, or any combination thereof.

For the purposes of this section " distinctive " shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the Registrar or the court may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

Coloured
trade marks.

8. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by the Registrar or the court having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Restriction on
registration.

9. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or which in the opinion of the Registrar or the court is likely to offend the religious or racial susceptibilities of any community, or any scandalous design.

REGISTRATION OF TRADE MARKS.

10. (1) Any person claiming to be the proprietor of a trade mark, who is desirous of registering the same, must apply in writing to the Registrar in the prescribed manner. Application for registration.

(2) Subject to the provisions of this Ordinance, the Registrar may after such inquiry as he thinks fit refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the court.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, or to what limitations, if any, as to mode or place of user or otherwise, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those stated by him, except by leave of the court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or court, as the case may be, may think fit.

11. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions and limitations, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement Advertisement of application.

shall set forth all conditions and limitations subject to which the application has been accepted :

Provided that an application for the registration of a trade mark under section 7 (5) of this Ordinance may be advertised by the Registrar on receipt of such application and before acceptance.

Opposition to registration.

12. (1) Any person may, within the prescribed time from the date of the advertisement of an application for registration of a trade mark, give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required and considering the evidence, decide whether, and subject to what conditions, or what limitations as to mode or place of user or otherwise, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the court.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, or what limitations, if any, as to mode or place of user or otherwise, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as hereinabove provided except by

leave of the court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the court may, after hearing the registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) If a party giving notice of opposition or of appeal neither resides nor carries on business in Ceylon, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

13. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration :

Provided always that no disclaimer upon the register shall affect any right of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

14. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed, the opposition has been decided in favour of the applicant, the Registrar shall, unless the mark has been accepted in error, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of receipt by the Registrar, of the application for registration, and such date shall be deemed for the purposes of this Ordinance to be the date of registration.

Disclaimers

Date of registration.

Certificate of registration.

15. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form, of the registration of such trade mark under the hand of the Registrar.

Non-completion of registration.

16. Where registration of a trade mark is not completed within twelve months from the date of receipt by the Registrar, of the application, by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion, to the applicant in writing in the prescribed manner, treat the application as abandoned, unless it is completed within the time specified in that behalf in such notice.

IDENTICAL TRADE MARKS.

Identical marks.

17. Except by order of the court or in the case of trade marks in use before the twenty-fifth day of March, one thousand eight hundred and eighty-nine, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor, which is already on the register with respect to such goods or description of goods or so nearly resembling such a trade mark as to be calculated to deceive.

Rival claims to identical marks.

18. (1) Where each of several persons claims to be the proprietor of the same trade mark or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the court or have been settled by agreement in any manner approved by him or by the court.

(2) (a) Such rights shall, unless it shall otherwise order, be submitted to the court for determination by a special case.

(b) Such special case shall be subject to a stamp duty of two rupees, and shall be filed and proceeded with in like manner as any other special case submitted to the court, or in such other manner as the court may direct.

(c) The special case may be agreed to by the claimants or, if they differ, may be settled by the Registrar on payment of the prescribed fee.

Concurrent user.

19. In case of honest concurrent user or of other special circumstances which, in the opinion of the court or Registrar,

make it proper so to do, the court or Registrar may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor, subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as the court or Registrar may think it right to impose.

ASSIGNMENT.

20. A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in the United Kingdom of Great Britain and Northern Ireland or any British possession or protectorate or foreign country in connection with any goods for which it is registered, together with the goodwill of the business therein in such goods; and the assignment of such right to use the same shall constitute the assignee a proprietor of a separate trade mark for the purpose of section 19 of this Ordinance, subject to such conditions and limitations as may be imposed under that section.

Assignment and transmission of trade marks.

21. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Ordinance as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, and to such limitations, if any, as to mode or place of user, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the court.

Apportionment of marks on dissolution of partnership.

ASSOCIATED TRADE MARKS.

22. If application be made for the registration of a trade mark identical with or so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the

Associated trade marks.

Registrar or the court may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

Combined trade marks.

23. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portions of such trade mark separately, he may apply to register the same as separate trade marks. Each such separate trade mark shall satisfy all conditions and shall have all the incidents of an independent trade mark, except that when registered, it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall, for the purposes of this Ordinance be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

Series of trade marks.

24. When a person claiming to be the proprietor of several trade marks for the same description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statements of the goods for which they are respectively used or proposed to be used ; or
- (b) statements of number, price, quality, or names of places ; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark ; or
- (d) colour.

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

Assignment and user of associated trade marks.

25. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks :

Provided that where under the provisions of this Ordinance user of a registered trade mark is required to be proved for any purpose, the Registrar or the court may, if and so far as is considered right, accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

RENEWAL OF REGISTRATION.

26. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Ordinance.

Duration of registration.

27. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last registration."

Renewal of registration.

28. At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner, to the registered proprietor at his registered address, of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

Procedure on expiry of period of registration.

29. Where a trade mark has been removed from the register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there had been no bona fide trade user of such trade mark during the two years immediately preceding such removal.

Status of unrenewed trade mark.

CORRECTION AND RECTIFICATION OF THE REGISTER.

30. The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name—

Correction of register.

- (a) correct any error in the name, address, or description of the registered proprietor of a trade mark; or
- (b) enter any change in the name, address, or description of the person who is registered as proprietor of a trade mark; or

- (c) cancel the entry of a trade mark on the register ; or
- (d) strike out any goods or classes of goods from those for which a trade mark is registered ; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the court.

Registration of assignments, &c.

31. (1) Where a person becomes entitled by assignment, transmission, or other operation of law, to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. Any decision of the Registrar under this section shall be subject to appeal to the court.

(2) Except in cases of appeals under this section and applications made under section 33 of this Ordinance, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) aforesaid shall not be admitted in evidence in any court in proof of the title to a trade mark, unless the court otherwise directs.

Alteration of registered trade mark.

32. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of user, as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the court. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Rectification of register.

33. Subject to the provisions of this Ordinance—

- (a) the court may on the application in the prescribed manner, of any person aggrieved by the non-insertion in or omission from the register, of any entry, or by

any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the 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 it may be necessary or expedient to decide in connection with the rectification of the register;

(c) in case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the court under the provisions of this section;

(d) any order of the court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon receipt of such notice rectify the register accordingly;

(e) in any proceedings for the rectification of the register under this section, the court shall have power to direct a trade mark entered in Part A of the register to be removed to Part B of the register.

34. No trade mark which is upon the register at the commencement of this Ordinance, and which under this Ordinance is a registrable trade mark, shall be removed from the register on the ground that it was not registrable under the Ordinances in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Ordinance to which he would not have been subject under the Ordinances then in force.

Trade marks registered under previous Ordinances.

35. A registered trade mark may, on the application to the court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any bona fide intention to use the same in connection with such goods, and there has in fact been no bona fide user of the same in connection therewith, or on the ground that there has been no bona fide user of such trade

Non-user of trade mark.

mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Removal from register of word trade marks used as names of patented articles.

36. (1) Where in the case of an article or substance manufactured under any patent in force at or granted after the commencement of this Ordinance, a word trade mark registered under this Ordinance is the name or only practicable name of the article or substance so manufactured, all rights to the exclusive use of such trade mark, whether under the common law or by registration (and notwithstanding the provisions of section 40 of this Ordinance), shall cease upon the expiration or determination of the patent, and thereafter such words shall not be deemed a distinctive mark, and may be removed by the court, from the register on the application of any person aggrieved.

(2) No word which is the only practicable name or description of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark, and any such word now or hereafter on the register may, notwithstanding section 40 of this Ordinance, be removed by the court, from the register on the application of any person aggrieved :

Provided that—

(a) the provisions of this subsection shall not apply where the mark is used to denote only the proprietor's brand or make of such substance, as distinguished from the substance as made by others, and in association with a suitable and practicable name open to the public use; and

(b) in the case of marks registered before the commencement of this Ordinance, no application under this section for the removal of the mark from the register shall be entertained until after the expiration of four years from the commencement of this Ordinance.

(3) The power to remove a trade mark from the register conferred by this section shall be in addition to and not in derogation of any other powers of the court in respect of the removal of trade marks from the register.

EFFECT OF REGISTRATION.

37. Subject to the provisions of this Ordinance—

Powers of
registered
proprietor.

(a) the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment;

(b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

38. Subject to the provisions of section 40 of this Ordinance and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connection with the goods in respect of which it is registered:

Rights of
proprietor of
trade mark.

Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

39. In all legal proceedings relating to a registered trade mark (including applications under section 33 of this Ordinance) the fact that a person is registered as proprietor of such trade mark shall be prima facie evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

Registration
to be prima
facie evidence
of validity.

40. In all legal proceedings relating to a registered trade mark (including applications under section 33 of this Ordinance) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Ordinance, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 9 of this Ordinance:

Registration to
be conclusive
after seven
years.

Provided that nothing in this Ordinance shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or by his predecessors in business, continuously used such trade mark from a date anterior to the user or registration, whichever is the earlier of the first-mentioned trade mark, by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section 19 of this Ordinance.

Unregistered
trade mark.

41. No person shall be entitled to institute any proceeding in any civil court to prevent, or to recover damages for, the infringement of an unregistered trade mark unless such trade mark was in use before the twenty-fifth day of March, one thousand eight hundred and eighty-nine, and has been refused registration under this Ordinance. The Registrar may, on request, grant a certificate that such registration has been refused.

Infringement.

42. In any action or proceeding relating to a trade mark or trade name, the court shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

User of
name, address,
or description
of goods.

43. No registration under this Ordinance shall interfere with any bona fide use by a person, of his own name or place of business or that of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods.

"Passing-off"
action.

44. Nothing in this Ordinance contained shall be deemed to affect rights of action against any person for passing-off goods as those of another person, or the remedies in respect thereof.

LEGAL PROCEEDINGS.

Certificate of
validity.

45. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the court may certify the same, and if it so certifies, then in any subsequent legal proceeding in which such validity comes into question, the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have

his full costs, charges, and expenses as between proctor and client, unless in such subsequent proceeding the court certifies that he ought not to have the same.

46. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar 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 Registrar 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 issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Registrar to have notice of proceeding for rectification.

47. Every application made to the court under section 33, 35, or 36 shall be subject to a stamp duty of two rupees.

Applications to be stamped.

48. The minimum stamp duties chargeable in the District Courts in civil proceedings under the provisions of the Ordinance for the time being in force relating to stamps shall, so far as the same may be applicable and except as herein otherwise provided, be charged in all proceedings in the court under this Ordinance. But in no case shall the Registrar be required to use any stamp or be charged with any stamp duty.

Stamp duties.

49. Every judgment or order by the District Court under this Ordinance shall be subject to an appeal to the Supreme Court, and such appeal shall be subject to the same rules which govern interlocutory appeals from District Courts; and the minimum stamp duties chargeable in the Supreme Court under the provisions of the Ordinance for the time being in force relating to stamps shall, so far as the same may be applicable, be charged in all proceedings relating to or in connection with such appeal.

Appeal.

COSTS.

50. (1) In all proceedings before the court under this Ordinance, the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Costs of proceedings before court and Registrar.

(2) In all proceedings before the Registrar under this Ordinance, the Registrar shall have power to award to any

party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be filed in court, and thereupon such order may be enforced as if it were an order of the court.

EVIDENCE.

Mode of giving evidence.

51. (1) In any proceeding under this Ordinance before the court or the Registrar, the evidence shall be given by affidavit in the absence of directions to the contrary, but, in any case in which the court or the Registrar shall think it right so to do, the court or the Registrar may take evidence viva voce in lieu of or in addition to evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the Registrar may exercise the powers conferred on Commissioners appointed under the provisions of the Commissions of Inquiry Ordinance for compelling the attendance of witnesses and the production of documents and for administering oaths to all persons who shall be examined before them.

Provided that the requirements of the proviso to section 3 of that Ordinance shall not apply to proceedings under this Ordinance.

Certified copies to be evidence.

52. Printed or written copies or extracts purporting to be certified by the Registrar, of or from any document register, and other book filed or kept under this Ordinance in the said office, shall be admitted in evidence in all courts in this Island, and in all proceedings, without further proof or production of the originals.

Certificate of Registrar to be evidence.

53. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Ordinance or rules 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.

PART II.

POWERS AND DUTIES OF THE REGISTRAR OF TRADE MARKS.

Exercise of discretionary power by Registrar.

54. Where any discretionary or other power is given to the Registrar by this Ordinance or rules made thereunder, he shall not exercise that power adversely to the applicant for

registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor, an opportunity of being heard.

55. Where by this Ordinance any act has to be done by or to any person in connection with a trade mark or proposed trade mark, or any procedure relating thereto, such act may under and in accordance with rules made under this Ordinance be done by or to an agent of such party duly authorised in the prescribed manner.

Recognition
of agents.

56. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Ordinance, apply to the Attorney-General or Solicitor-General for directions in the matter.

Registrar may
take directions
of law officers.

RULES.

57. (1) The Governor may from time to time make such rules, prescribe such forms, and generally do such things as he thinks expedient—

Power to
make rules.

(a) for regulating the practice and procedure under this Ordinance;

(b) for classifying goods for the purposes of registration of trade marks;

(c) for prescribing the fees payable in respect of applications and registrations and other matters under this Ordinance, and the mode of payment of the same;

(d) for making or requiring duplicates of trade marks and other documents;

(e) for securing and regulating the publishing and selling or distributing of copies of trade marks and other documents;

(f) for regulating the business of the office in relation to trade marks and all things by this Ordinance placed under the direction or control of the Registrar;

(g) generally, for the purpose of carrying out the provisions of this Ordinance.

(2) Rules made under this section shall be published in the *Government Gazette*, and shall thereupon be of the same effect as if they were contained in this Ordinance.

(3) Any rules made in pursuance of this section shall be laid as soon as conveniently may be before the State Council and may, at any of the three meetings of the Council next succeeding such date, by resolution of the Council be annulled but without prejudice to anything that may have been done thereunder.

SPECIAL TRADE MARKS.

Special trade marks.

58. Where any association or person undertakes to certify the origin, material, mode of manufacture, quality, accuracy or other characteristic of any goods, by mark used upon or in connection with such goods, the Registrar, if and so long as he is satisfied that such association or person is competent to certify as aforesaid, may, if he shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Registrar.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International arrangements for protection of trade marks.

(7Edw. 7, c. 29.)

59. (1) Any person who has applied for protection for any trade mark in the United Kingdom of Great Britain and Northern Ireland or in any foreign state with the Government of which His Majesty has made an arrangement under, or which has force as if it had been made under section 91 of the Patents and Designs Act, 1907, for the mutual protection of trade marks, shall, on application by himself or his heirs, executors, administrators, or assigns (subject to the provisions of this Ordinance as to the admissibility of trade marks to registration), be entitled to registration of his trade mark under this Ordinance in priority to other applicants; and such registration shall have the same date as the application in the United Kingdom of Great Britain and Northern Ireland or such foreign state, as the case may be.

[§ 2, 23 of 1932.]

(2) Such application shall be made within six months from such person applying for protection in the United Kingdom of Great Britain and Northern Ireland or in the foreign state with which the arrangement is in force.

(3) Nothing in this section contained shall entitle the proprietor of a trade mark to recover damages for infringements happening prior to the date of the actual registration of his trade mark in Ceylon.

(4) The use in Ceylon, during the period specified in this section as that within which the application may be made, of a trade mark during the period aforesaid shall not invalidate the registration of the trade mark.

(5) The application for the registration of a trade mark under this section shall be made and dealt with in the same manner as an ordinary application under this Ordinance.

[§ 2, 23 of 1932.]

(6) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council shall have declared that the provisions of section 91 of the Patents and Designs Act, 1907, or the corresponding provisions of any enactment repealed by such Act are to be applicable, and so long only, in the case of each state as such Order continues in force with respect to that state.

(7 Edw. 7, c. 29.)

60. (1) Whenever it appears to the Governor that the Legislature of any British possession or protectorate has made satisfactory provision for the protection in such possession, of trade marks registered in Ceylon, the Governor may, by Proclamation to be published in the *Government Gazette* apply all or any of the provisions of the last preceding section relating to the protection of trade marks registered in the United Kingdom of Great Britain and Northern Ireland, with such variations or additions, if any, as to the Governor shall seem fit, to trade marks registered in such British possession.

Provision for intercolonial arrangements.

(2) A Proclamation under this section shall from a date to be mentioned in the Proclamation take effect as if its provisions had been contained in this Ordinance, but the Governor may revoke any such Proclamation.

OFFENCES.

61. If any person makes or causes to be made a false entry in the register kept under this Ordinance, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing

Falsification of entries in register.

to be false, he shall be guilty of an offence, and punished with simple or rigorous imprisonment for a term not exceeding seven years.

Penalty
on falsely
representing
trade mark
as registered.

62. (1) Any person who represents a trade mark as registered, which is not so, shall be guilty of an offence, and liable on summary conviction to a fine not exceeding fifty rupees.

(2) A person shall be deemed for the purposes of this Ordinance to represent that a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any word or words expressing or implying that registration has been obtained for the trade mark.

Unauthorised
assumption of
Royal Arms.

63. (1) If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by, or supplies goods to, His Majesty or such member of the Royal Family, he shall be guilty of an offence, and liable on summary conviction to a fine not exceeding one hundred rupees.

Unauthorised
assumption of
arms of the
Ceylon
Government.

(2) If any person, without the authority of the Governor, uses in connection with any trade, business, calling, or profession, the arms of the Ceylon Government (or arms so closely resembling the same as to be calculated to deceive) in such a manner as to be calculated to lead to the belief that he is duly authorised to use such arms, or if any person, without the authority of the Governor, uses in connection with any trade, business, calling, or profession, any device, emblem, or title in such a manner as to be calculated to lead to the belief that he is employed by or supplies goods to the Governor or any member of the Governor's family or the Ceylon Government, he shall be guilty of an offence and liable on summary conviction to a fine not exceeding one hundred rupees.

Saving.

(3) Nothing in this section contained shall be construed as affecting the rights, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

64. All offences under this Ordinance are hereby declared to be "non-cognizable" and "bailable," within the meaning of those terms as defined in section 2 of the Criminal Procedure Code.

Offences non-cognizable and bailable.

PART III.

REGISTRATION OF CERTAIN TRADE MARKS WHICH ARE NOT REGISTRABLE UNDER PART I. OF THIS ORDINANCE.

65. (1) Where any trade mark has for not less than two years been bona fide used in Ceylon upon or in connection with any goods (whether for sale in Ceylon or exportation abroad), for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, the person claiming to be the proprietor of the mark may apply in writing to the Registrar, in the prescribed manner, to have the mark entered as his registered trade mark, in Part B of the register, in respect of such goods.

Registration of trade marks in Part B.

(2) The Registrar shall consider every such application for registration of a trade mark in Part B of the register, and if it appears to him, after such search, if any, as he may deem necessary, that the application is inconsistent with the provisions of section 9 or section 17 of this Ordinance, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application, or may accept it subject to conditions, amendments, or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application.

(3) Every such application shall be accompanied by an affidavit verifying the user, including the date of first user, and such date shall be entered on the register.

(4) Any such refusal or conditional acceptance shall be subject to appeal to the court, and, if the ground for refusal is insufficiency of evidence as to user, such refusal shall be without prejudice to any application for registration of the trade mark under the provisions of Part I. of this Ordinance.

(5) Every such application shall, if accepted, be advertised in accordance with the provisions of Part I. of this Ordinance.

(6) A mark may be registered in Part B notwithstanding any registration in Part A, by the same proprietor of the same mark or any part or parts thereof.

Application of certain provisions of Parts I. and II. of the Ordinance to trade marks in Part B of the register.

66. The provisions of Parts I. and II. of this Ordinance with the exception of those set out in the Schedule, shall subject to the provisions of this Part of this Ordinance apply in respect of trade marks to which this Part of the Ordinance applies as if they were herein re-enacted and in terms made applicable to this Part of the Ordinance.

Effect of registration in Part B.

67. The registration of a person as the proprietor of a trade mark in Part B of the register shall be prima facie evidence that that person has the exclusive right to the use of that trade mark, but, in any action for infringement of a trade mark entered in Part B of the register, no injunction or other relief shall be granted to the owner of the trade mark in respect of such registration, if the defendant establishes to the satisfaction of the court that the user of which the plaintiff complains is not calculated to deceive or to lead to the belief that the goods the subject of such user were goods manufactured, selected, certified, dealt with, or offered for sale by the proprietor of the registered trade mark.

Power to treat applications for registration in Part A as applications for registration in Part B.

68. If any person applies for the registration of a trade mark under Part I. of this Ordinance in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application treat it as an application for registration in Part B of the register under this Part of the Ordinance and deal with the application accordingly.

Interpretation.

69. In this Ordinance, unless the context otherwise requires—

“ court ” means the District Court of Colombo ;

“ mark ” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof ;

“ prescribed ” means prescribed by this Ordinance or by any rules duly made thereunder ;

“ register ” means the register of trade marks kept under the provisions of this Ordinance ;

"Registrar" means the Registrar-General, and includes any officer in the Registrar-General's Department to the extent to which he may be authorised by general or special order of the Governor to discharge the duty of the Registrar under this Ordinance;

"registrable trade mark" means a trade mark which is capable of registration under the provisions of this Ordinance;

"registered trade mark" means a trade mark which is actually upon the register;

"trade mark" means a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale.

SCHEDULE

PROVISIONS OF PARTS I. AND II. OF THE ORDINANCE
NOT APPLIED TO MARKS REGISTERED IN PART B
OF THE REGISTER.

No. of Section.	Subject-matter.
4	.. Incorporation of existing register
7	.. Registrable trade marks
10	.. Application for registration
12 (9)	... Modification of trade mark on appeal
13	.. Disclaimers
22	.. Associated trade marks
23	.. Combined trade marks
25	.. Assignment and user of associated trade marks
29	.. Status of unrenewed trade mark
34	.. Trade marks registered under previous Ordinances
38 (except proviso)	.. Rights of proprietor of trade mark
40 (down to the words "against the provisions of section 9 of this Ordinance")	Registration to be conclusive after seven years
41	.. Unregistered trade marks
55	.. Standardization, &c., trade marks

APPENDIX (P)

**TRADE MARKS (CONVENTION) AMENDMENT
ORDINANCE, NO.23 OF 1932**

Ordinance No. 23 of 1932.

An Ordinance to amend "The Trade Marks Ordinance, No. 15 of 1925".

[Date of Governor's assent : September 21, 1932.]

[Date of commencement : September 21, 1932.]

GRAEME THOMSON.

BE it enacted by the Governor of Ceylon, with the advice and consent of the State Council thereof, as follows:—

1 This Ordinance may be cited as the Trade Marks (Convention) Amendment Ordinance, No. 23 of 1932.

Short title.

2 Section 61 of "The Trade Marks Ordinance, No. 15 of 1925", is hereby amended as follows:

Amendment of section 61 of Ordinance No. 15 of 1925.

- (1) by the substitution of the word "six" for the word "four" in the first line of sub-section (2) thereof;
- (2) by the insertion of the words "and dealt with" between the word "made" and the word "in", in the second line of sub-section (5) thereof.

Passed in Council the Sixth day of September, One thousand Nine hundred and Thirty-two.

V. COOMARASWAMY,
Clerk of the Council.

Assented to by His Excellency the Governor the Twenty-first day of September, One thousand Nine hundred and Thirty-two.

C. C. WOOLLEY,
Secretary to the Governor.

APPENDIX (Q)

THE COPYRIGHT ORDINANCE, NO.12 OF 1908

SANC 11/12

No. 12 of 1908.

N. 72

An Ordinance relating to Copyright.

Preamble.

WHEREAS it is expedient to secure the right of property in literary and artistic works: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

PART I.—PRELIMINARY.

Short title.

1 (1) This Ordinance may be cited as "The Copyright Ordinance, 1908," and shall come into operation at such date as the Governor shall, by Proclamation in the *Government Gazette*, appoint.

Commencement.

Division into parts.

(2) This Ordinance is divided as follows:—

Part I.—Preliminary.

Part II.—Administration.

Part III.—Literary Copyright.

Part IV.—Artistic Copyright.

Part V.—Infringement of Copyright.

Part VI.—Registration of Copyright.

Part VII.—Miscellaneous.

2 In this Ordinance, unless the contrary intention appears—

Interpretation.

"Artistic work" includes—

- (a) Any painting, drawing, or sculpture; and
- (b) Any engraving, etching, print, lithograph, woodcut, photograph, or other work of art produced by any process, mechanical or otherwise, by which impressions or representations of works of art can be taken or multiplied.

"Author" includes the personal representatives of an author.

"Book" includes any book or volume, and any part or division of a book or volume, and any article in a book or volume, and any pamphlet, periodical, sheet of letterpress, map, chart, diagram, or plan separately published, and any illustration therein.

"Lecture" includes a sermon.

"Periodical" means a review, magazine, newspaper, or other periodical work of a like nature.

"Pirated artistic work" means a reproduction of an artistic work made in any manner without the authority of the owner of the copyright in the artistic work.

"Pirated book" means a reproduction of a book made in any manner without the authority of the owner of the copyright in the book.

"Portrait" includes any work the principal object of which is the representation of a person by painting, drawing, engraving, photography, sculpture, or any form of art.

"Publish" and "publication" in relation to a book refer to offer for sale or distribution in each case with the privity of the author so as to make the book accessible to the public.

"The Registrar" means the Registrar of Copyrights.

3 For the purposes of this Ordinance, publication or delivery in Ceylon shall be deemed to be simultaneous with publication or delivery elsewhere, if the period between the publications or deliveries does not exceed fourteen days.

What is simultaneous publication.

4 No copyright or lecturing right shall subsist under this Ordinance in any blasphemous, indecent, seditious, or libellous work or matter.

Blasphemous, &c., matter not protected.

5 Subject to this Ordinance, the Common Law of England relating to proprietary rights in unpublished literary compositions shall, after the commencement of this Ordinance apply in Ceylon.

Application of the Common Law.

PART II.—ADMINISTRATION.

6 The Registrar-General shall be the Registrar of Copyrights, unless the Governor shall by Proclamation appoint some other person to be the Registrar of Copyrights, which

Registrar.

appointment the Governor is hereby empowered to make from time to time as occasion may require.

Copyright office.

7 For the purposes of this Ordinance, an office shall be established, which shall be called the "copyright office." The office of the Registrar-General shall be the copyright office unless and until the Governor otherwise directs.

Seal of copyright office.

8 There shall be a seal of the copyright office, and impressions thereof shall be judicially noticed.

PART III.—LITERARY COPYRIGHT.

Copyright in books.

9 (1) The copyright in a book means the exclusive right to do, or authorize another person to do, all or any of the following things in respect of it:

- (a) To make copies of it;
- (b) To abridge it; and
- (c) To translate it.

(2) Copyright shall subsist in every book, whether the author is a British subject or not, which has been printed from type set up in Ceylon or plates made therefrom, or from plates or negatives made in Ceylon in cases where type is not necessarily used, and has, after the commencement of this Ordinance, been published in Ceylon before or simultaneously with its first publication elsewhere.

Lecturing right in lectures.

10 (1) The lecturing right in a lecture means the exclusive right to deliver it, or authorize its delivery, in public, and, except as hereinafter provided, to report it.

(2) Lecturing right shall subsist in every lecture, whether the author is a British subject or not, which has, after the commencement of this Ordinance, been delivered in public in Ceylon before or simultaneously with its first delivery in public elsewhere.

Commencing of copyright and lecturing right.

11 (1) The copyright in a book shall begin with its first publication in Ceylon.

(2) The lecturing right in a lecture shall begin with its first delivery in public in Ceylon.

Term of copyright and lecturing right.

12 (1) The copyright in a book and the lecturing right in a lecture shall subsist for the term of forty-two years or for the author's life and seven years, whichever shall last the longer.

(2) Where the first publication of a book, or the first delivery in public of a lecture, takes place after the death of the author, the copyright shall subsist for the term of forty-two years.

(3) Where a book is written by joint authors the copyright shall subsist for the term of forty-two years or their joint lives and the life of the survivor of them and seven years, whichever shall last the longer.

(4) If a lecture is published as a book with the consent in writing of the owner of the lecturing right, the lecturing right shall cease.

<p>13 (1) The author of a book shall be the first owner of the copyright in the book.</p>		<p>Ownership in copyright and lecturing right.</p>
<p>(2) The author of a lecture shall be the first owner of the lecturing right in the lecture.</p>		<p>Ownership in the case of joint authors.</p>
<p>14 Where there are joint authors of a book or of a lecture, the copyright or the lecturing right, as the case may be, shall be the property of the authors.</p>		<p>Separate authors.</p>
<p>15 Where a book is written in distinct parts by separate authors, and the name of each author is attached to the portion written by him, each author shall be entitled to copyright in the portion written by him in the same manner as if it were a separate book.</p>		<p>Encyclopædia and similar works.</p>
<p>16 The proprietor or projector of an encyclopædia or other similar permanent work of reference who employs some other person for valuable consideration in the composition of the whole or any part of the work shall be entitled to the copyright in the work in the same manner as if he were the author thereof.</p>		<p>Copyright in articles published in periodicals.</p>
<p>17 (1) The author of any article contributed for valuable consideration to, and first published in, a periodical shall be entitled to copyright in the article as a separate work, but so that—</p>		<p>(a) He shall not be entitled to publish the article or authorize its publication until one year after the end of the year in which the article was first published; and</p> <p>(b) His right shall not exclude the right of the proprietor of the periodical under this section.</p>
<p>(2) The proprietor of a periodical in which an article which has been contributed for valuable consideration is first published shall be entitled to copyright in the article, but so that—</p>		<p>(a) He shall not be entitled to publish the article or authorize its publication except in the periodical in its original form of publication; and</p> <p>(b) His right shall not exclude the right of the author of the article under this section.</p>
<p>18 The author of any article contributed without valuable consideration to, and first published in, a periodical shall be entitled to copyright in the article as a separate work.</p>		<p>Copyright, &c., to be assigned.</p>
<p>19 The copyright in a book and the lecturing right in a lecture shall be capable of assignment and of transmission by operation of law.</p>		<p>Copyright and other rights to be separate properties.</p>

Assignment of
copyright.

21 The owner of the copyright in a book or of the lecturing right in a lecture may assign his right either wholly or partially and either generally or limited to any particular place or period, and may grant any interest therein by license; but an assignment or grant shall not be valid unless it is in writing signed by the owner of the right in respect of which it is made or granted.

New editions.

22 Any second or subsequent edition of a book containing material or substantial alterations or additions shall be deemed to be a new book, but so as not to prejudice the right of any person to reproduce a former edition of the book or any part thereof after the expiration of the copyright in the former edition.

Provided that, while the copyright in a book subsists, no person, other than the owner of the copyright in the book or a person authorized by him, shall be entitled to publish a second or subsequent edition thereof.

Making of
abridgment, &c.,
for private use.

23 Copyright in a book shall not be infringed by a person making an abridgment or translation of the book for his private use (unless he uses it publicly or allows it to be used publicly by some other person), or by a person making fair extracts from or otherwise fairly dealing with the contents of the book for the purpose of a new work, or for the purposes of criticism, review, or refutation, or in the ordinary course of reporting scientific information.

Translations or
abridgments.

24 Where the author has parted with the copyright in his book and a translation or abridgment of the book is made with the consent of the owner of the copyright by some person other than the author, notice shall be given in the title page of every copy of the translation or abridgment that it has been made by some person other than the author.

Failure of
author to make
or cause
translation of
book.

25 Where a translation of a book into a particular language is not made within ten years from the date of the publication of the book by the owner of the copyright or by some person by his authority—

(a) Any person desirous of translating the book into that language may make an application in writing to the Governor for permission so to do.

(b) The Governor may thereupon by notice in writing under the hand of the Colonial Secretary inform the owner of the copyright of such application and request him to make or cause to be made a translation of the book into that language within such time as the Governor deems reasonable, or to show cause why such application should not be granted.

(c) If the owner of the copyright fails to comply with such notice, the Governor may grant such application.

Copyright in
translations.

26 Copyright shall subsist in a lawfully produced translation or abridgment of a book in like manner as if it were an original work.

27 (1) Unless the reporting of a lecture is prohibited by a notice as in this section mentioned, the lecturing right in a lecture shall not be infringed by a report of the lecture in a newspaper.

Report of lecture in a newspaper.

(2) The notice prohibiting the reporting of a lecture may be given—

(a) Orally at the beginning of the lecture; or

(b) By a conspicuous written notice affixed, before the lecture is given, on the entrance doors of the building in which it is given or in a place in the room in which it is given.

(3) When a series of lectures is intended to be given by the same lecturer on the same subject, one notice only need be given in respect of the whole series.

PART IV.—ARTISTIC COPYRIGHT.

28 The copyright in an artistic work means the exclusive right of the owner of the copyright to reproduce or authorize another person to reproduce the artistic work, or any material part of it, in any manner, form, or size, in any material, or by any process, or for any purpose.

Meaning of copyright.

29 Copyright shall subsist in every artistic work, whether the author is a British subject or not, which is made in Ceylon after the commencement of this Ordinance.

Copyright in artistic works.

30 The copyright in an artistic work shall begin with the making of the work, and shall subsist for the term of forty-two years or for the author's life and seven years, whichever shall last the longer.

Commencement and term of artistic copyright.

31 The author of an artistic work shall be the first owner of the copyright in the work.

Ownership of copyright in artistic work.

32 When an artistic work, being a portrait, is made to order for valuable consideration, the person to whose order it is made shall be entitled to the copyright therein as if he were the author thereof.

Copyright in portraits.

33 (1) When a photograph is made to order for valuable consideration, the person to whose order it is made shall be entitled to the copyright therein as if he were the author thereof.

Copyright in photographs.

(2) Subject to sub-section (1) of this section, when a photograph is made by an employé on behalf of his employer the employer shall be deemed to be the author of the photograph.

34 (1) Subject to section 28 of this Ordinance, the engraver or other person who makes the plate or other instrument by which copies of an artistic work are multiplied shall be deemed to be the author of the copies produced by means of the plate or instrument.

Engravings and prints.

(2) When the plate or other instrument mentioned in this section is made by an employé on behalf of his employer, the employer shall be deemed to be the author of the copies produced by means of the plate or instrument.

Copyright in case of sale of painting, statue, or bust.

35 (1) When the owner of the copyright in any artistic work being a painting, or a statue, bust, or other like work, disposes of such work for valuable consideration, but does not assign the copyright therein, the owner of the copyright (except as in this section mentioned) may, in the absence of any agreement in writing to the contrary, make a replica of such work.

Right of author to make replicas of statues, &c., in public places.

(2) When a statue, bust, or other like work, whether made to order or not, is placed or is intended to be placed in a street or other like public place, the author may, in the absence of any agreement to the contrary, make replicas thereof.

Artistic copyright to be assignable.

36 The copyright in an artistic work shall be capable of assignment and of transmission by operation of law.

Copyright and ownership in artistic works.

37 The copyright in an artistic work and the ownership of the artistic work shall be deemed to be distinct properties for the purposes of ownership, assignment, license, transmission, and all other purposes.

Assignment of copyright.

38 The owner of the copyright in an artistic work may assign his right wholly or partially and either generally or limited to any particular place or period and may grant any interest therein by license; but an assignment or grant shall not be valid unless it is in writing signed by the owner of the copyright.

PART V.—INFRINGEMENT OF COPYRIGHT.

Infringement of rights under Ordinance.

39 If any person infringes any right conferred by this Ordinance in respect of the copyright in a book, the lecturing right in a lecture, or the copyright in an artistic work, the owner of the right infringed may maintain an action for damages or penalties or profits and for an injunction, or for any of these remedies.

Damages in case of lecturing right.

40 In assessing the damages in respect of the infringement of the lecturing right in a lecture, regard shall be had to the amount of profit made by the infringer by reason of the infringement, and to the amount of actual damage incurred by the owner of the lecturing right.

Notice of objection to title.

41 The plaintiff in an action for the infringement of a right conferred by this Ordinance shall be presumed to be the owner of the right which he claims, unless the defendant in his pleadings in defence pleads that the defendant disputes the title of the plaintiff, and states the grounds on which the plea is founded, and the name of the person, if any, whom the defendant alleges to be the owner of the right.

42 No action for any infringement of copyright or lecturing right under this Ordinance shall be maintainable unless it is commenced within two years next after the infringement is committed.

Limitation of actions.

43 All pirated books and all pirated artistic works shall be deemed to be the property of the owner of the copyright in the book or work, and may, together with the plates, blocks, stone, matrix, negative, or thing, if any, from which they are printed or made, be recovered by him by action or other lawful method.

Property in pirated books or artistic work.

44 If any person—

- (a) Sells, or lets for hire, or exposes, offers, or keeps for sale or hire, any pirated book or any pirated artistic work; or
- (b) Distributes, or exhibits in public, any pirated book or any pirated artistic work; or
- (c) Imports into Ceylon any pirated book or any pirated artistic work;

Penalties for dealing with pirated books.

he shall be guilty of an offence against this Ordinance, and shall be liable to a penalty not exceeding fifty rupees for each copy of such pirated book or pirated artistic work dealt with in contravention of this section, and also to forfeit to the owner of the copyright every such copy so dealt with, and also to forfeit the plates, blocks, stone, matrix, negative, or thing, if any, from which the pirated book or pirated artistic work was printed or made.

Provided that the whole penalties inflicted on any one offender in respect of the same transaction shall not exceed five hundred rupees.

Provided also that no person shall be convicted of an offence under this section if he proves to the satisfaction of the court at the hearing that he did not know, and could not, with reasonable care, have ascertained that the book was a pirated book or the work was a pirated artistic work.

45 (1) A Police Magistrate may, upon the application of the owner of the copyright in any book or in any artistic work, or of the agent of such owner appointed in writing—

Search warrant and seizure of pirated copies.

- (a) If satisfied by evidence that there is reasonable ground for believing that pirated books or pirated artistic works are being sold or offered for sale, issue a warrant, in accordance with the form prescribed, authorizing any police officer to seize the pirated books or pirated artistic works and to bring them before the court.
- (b) If satisfied by evidence that there is reasonable ground for believing that pirated books or pirated artistic works are to be found in any house, shop, or other place, issue a warrant, in accordance with the form prescribed, authorizing any police officer to search

between sunrise and sunset the place where the pirated books or pirated artistic works are supposed to be, and to seize and bring them or any books or artistic works reasonably suspected to be pirated books or pirated artistic works before the court.

(2) The court may, on proof that any books or artistic work brought before it in pursuance of this section are pirated books or pirated artistic works, order them to be destroyed or to be delivered up, subject to such conditions, if any, as the court thinks fit, to the owner of the copyright in the book or artistic work.

Power of owner of copyright to require delivery to him of pirated books and works.

46 (1) The owner of the copyright in any book or artistic work, or the agent of such owner appointed in writing, may by notice, in accordance with the prescribed form, require any person to deliver up to him any pirated production of the book or work, and every person to whom such notice has been given, and who has any pirated reproduction of the book or work in his possession or power, shall deliver up the pirated reproduction of the book or work in accordance with the notice, and in default of doing so shall be liable to a fine of one hundred rupees.

(2) A person shall not give any notice in accordance with this section without just cause, and any person so giving notice shall be liable to a fine of two hundred rupees.

(3) In any prosecution under sub-section (2) of this section the defendant shall be deemed to have given the notice without just cause, unless he proves to the satisfaction of the court at the hearing that at the time of giving the notice he was the owner of the copyright in the book or artistic work or was the agent of such owner appointed in writing, and had reasonable ground to believe that the person to whom the notice was given had pirated reproductions of the book or work in his possession or power.

Penalty for false representations in notices.

47 Any person who in any notice given in pursuance of this Ordinance makes a representation which is false in fact, and which he knows to be false or does not believe to be true, that he is—

(a) The owner of the copyright in any book or artistic work ; or

(b) The agent of any such owner ;

shall be guilty of an offence against this Ordinance, and shall be liable to imprisonment, which may extend to three months, or to a fine not exceeding one hundred rupees.

Request to police to seize pirated books and works.

48 (1) The owner of the copyright in any book or artistic work or the agent of such owner appointed in writing may, in accordance with the prescribed form, request that any pirated reproductions of the book or work be seized by the police, and may lodge the request at any police station.

(2) Any police officer in the town or district in which the police station is situated may, at any time in the daytime

within seven days after the request was so lodged, seize all pirated reproductions of the book or work mentioned in the notice, and all reproductions of the book or work which he has reasonable ground to believe are pirated reproductions, found by him in the possession of any person other than the owner of the copyright in the book or work.

(3) Every police officer who seizes any books or works in pursuance of this section shall forthwith bring all such books or works before a Police Court.

(4) A Police Court may, on the application of any person interested, make such order for the disposal of the books or works as it thinks just.

(5) Any person who shall lodge any request at any police station in accordance with this section without just cause shall be guilty of an offence, and liable to a fine of two hundred rupees.

(6) In any prosecution under sub-section (5) of this section the defendant shall be deemed to have lodged the request without just cause, unless he proves to the satisfaction of the court at the hearing that at the time of lodging the request he was the owner of the copyright in the book or artistic work, or was the agent of such owner appointed in writing, and had reasonable ground to believe that pirated reproductions of the book or work were being unlawfully sold, or let for hire, or exposed, or offered, or kept for sale or hire, or distributed, or exhibited in public, in the town or district in which the police station is situated.

49 Where proceedings for any penalty under this Ordinance are instituted by the owner of the copyright in any book or in any artistic work or by the owner of the artistic work, the penalty shall be paid to him by way of compensation for the injury he has sustained.

Application of penalties.

50 Whoever aids, abets, counsels, or procures, or by act or omission is in any way, directly or indirectly, knowingly concerned in the commission of any offence against this Ordinance, shall be deemed to have committed that offence, and shall be punishable accordingly.

Aiders and abettors.

51 Proceedings may be instituted in any Police Court for the recovery of any penalty under this Ordinance, but no such proceedings shall be instituted after the expiration of six months from the date of the offence in respect of which the penalty is imposed.

Limitation of actions.

52 An appeal shall lie to the Supreme Court from any conviction or order (including any dismissal of any information, complaint, or application) of a Police Court, exercising jurisdiction with respect to any offence or matter under this Ordinance, to the court and in the manner and time provided by chapter XXX. of 'The Criminal Procedure Code, 1898.'

Appeal.

Importation of
pirated works.

53 (1) The following goods are prohibited to be imported :

(a) All pirated books in which copyright is subsisting in Ceylon ; and

(b) All pirated artistic works in which copyright is subsisting in Ceylon.

(2) All pirated books and pirated artistic works imported into Ceylon contrary to this section shall be forfeited and may be seized by any officer of customs.

(3) Subject to this Ordinance, the provisions of the Ordinance No. 17 of 1869 shall apply to the seizure and forfeiture of pirated books and artistic works under this section to the same extent as if they were prohibited imports under that Ordinance.

(4) The provisions of this section shall not apply to any book or artistic work unless the owner of the copyright therein or his agent has given written notice to the Colonial Secretary of the existence of the copyright and of his term.

PART VI.—REGISTRATION OF COPYRIGHTS.

Copyright
registers.

54 The following registers of copyrights shall be kept by the Registrar at the copyright office :—

The Register of Literary Copyrights.

The Register of Fine Arts Copyrights.

Method of
registration.

55 The owner of any copyright or lecturing right under this Ordinance may obtain registration of his right in the manner prescribed.

Registration of
assignments and
transmissions.

56 When any person becomes entitled to any copyright or lecturing right under this Ordinance by virtue of any assignment or transmission, or to any interest therein by license, he may obtain registration of the assignment, transmission, or license in the manner prescribed.

How
registration
effected.

57 The registration of any copyright or lecturing right under this Ordinance, or of any assignment or transmission thereof or of any interest therein by license, shall be effected by entering in the proper register the prescribed particulars relating to the right, assignment, transmission, or license.

Trusts not
registered.

58 (1) No notice of any trust, expressed, implied, or constructive, shall be entered in any register of copyrights under this Ordinance or be receivable by the Registrar.

(2) Subject to this section, equities in respect of any copyright or lecturing right under this Ordinance may be enforced in the same manner as equities in respect of other property.

Register to be
evidence.

59 Every register of copyrights under this Ordinance shall be *prima facie* evidence of the particulars entered therein, and documents purporting to be copies of any entry therein or extracts therefrom certified by the Registrar and sealed

with the seal of the copyrights office shall be admissible in evidence in all courts without further proof or production of the originals.

60 Certified copies of entries in any register under this Ordinance or of extracts therefrom shall, on payment of the prescribed fee, be given to any person applying for them.

Certified copies

61 Each register under this Ordinance shall be open to public inspection at all convenient times on payment of the prescribed fee.

Inspection of register.

62 The Registrar may, in prescribed cases and subject to the prescribed conditions, amend or alter any register under this Ordinance by—

Correction of register.

(a) Correcting any error in any name, address, or particular; and

(b) Entering any prescribed memorandum or particular relating to copyright or other right under this Ordinance.

63 (1) Subject to this Ordinance, the District Court of Colombo may, on the application of the Registrar or of any person aggrieved, order the rectification of any register under this Ordinance by—

Rectification of register by the court.

(a) The making of any entry wrongly omitted to be made in the register; or

(b) The expunging of any entry wrongly made in or remaining on the register; or

(c) The correction of any error or defect in the register.

(2) An appeal shall lie to the Supreme Court from any order for the rectification of any register made by the District Court under this section.

64 (1) The owner of any copyright under this Ordinance, or of any interest therein by the license shall not be entitled to bring any action or suit or institute any proceedings for any infringement of the copyright, unless such right or interest has been registered in pursuance of this Ordinance.

Owner cannot sue before registration.

(2) When such right or interest has been registered the owner thereof may, subject to this Ordinance, bring actions or suits or institute proceedings for infringements of the copyright, whether those infringements happened before or after the registration.

(3) This section shall not affect the right of the owner of the lecturing right in a lecture to bring actions or suits or institute proceedings for infringements of his lecturing right.

65 (1) Every person applying for the registration of the copyright in any book to which the provisions of Ordinance No. 1 of 1885 are applicable shall produce to the Registrar the receipt given by the appointed officer under section 3 of the said Ordinance for the copies of the book delivered in accordance with the requirements of the said Ordinance.

Delivery of books to Registrar.

APPENDIX (R)

THE COPYRIGHT ORDINANCE, NO.20 OF 1912

No. 20 of 1912.

An Ordinance to amend the Law relating to Copyright.

Preamble.

WHEREAS the Act of the Imperial Parliament, as set out in the schedule to this Ordinance, known as the Copyright Act, 1911, is in force in Ceylon, and whereas the effect thereof is to supersede in Ceylon "The Copyright Ordinance, 1908": And whereas the provisions of the said Act with regard to summary remedies do not apply to Ceylon, and it is necessary to supplement the said Act in its application to Ceylon by providing for summary remedies: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

1 This Ordinance may be cited as "The Copyright Ordinance, No. 20 of 1912."

Short title.

2 "The Copyright Ordinance, 1908," is hereby repealed.

Repeal.

3 (1) If any person knowingly—

- (a) Makes for sale or hire any infringing copy of a work in which copyright subsists; or
- (b) Sells or lets for hire, or by way of trade exposes or offers for sale or hire, any infringing copy of any such work; or
- (c) Distributes infringing copies of any such work either for the purposes of trade or to such an extent as to affect prejudicially the owner of the copyright; or
- (d) By way of trade exhibits in public any infringing copy of any such work; or
- (e) Imports for sale or hire into Ceylon any infringing copy of any such work—

Penalties for dealing with infringing copies, &c.

he shall be guilty of an offence under this Ordinance, and be liable on summary conviction before a Police Magistrate to a fine not exceeding thirty rupees for every copy dealt with in contravention of this section, but not exceeding seven hundred and fifty rupees in respect of the same transaction; or, in the case of a second or subsequent offence, either to such fine or to simple or rigorous imprisonment for a term not exceeding two months.

(2) If any person knowingly makes or has in his possession any plate for the purpose of making infringing copies of any work in which copyright subsists, or knowingly and for his private profit causes any such work to be performed in public without the consent of the owner of the copyright, he shall be guilty of an offence under this Ordinance, and be liable on summary conviction to a fine not exceeding seven hundred and fifty rupees; or, in the case of a second or subsequent offence, either to such fine or to simple or rigorous imprisonment for a term not exceeding two months.

(3) The court before which any such proceedings are taken may, whether the alleged offender is convicted or not, order that all copies of the work, or all plates in the possession of the alleged offender, which appear to it to be infringing copies or plates for the purpose of making infringing copies, be destroyed or delivered up to the owner of the copyright, or otherwise dealt with as the court may think fit.

(4) A Police Magistrate shall have jurisdiction to impose the full amount of the penalties to which the offender may be liable, notwithstanding any limitation of his ordinary powers or jurisdiction.

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SCHEDULE.

Copyright Act, 1911.

Chapter 46.

An Act to amend and consolidate the Law relating to Copyright.

BE it enacted by the King's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.

IMPERIAL COPYRIGHT.

Rights.

Copyright.

1. (1) Subject to the provisions of this Act, copyright shall subsist throughout the parts of His Majesty's dominions to which this Act extends for the term hereinafter mentioned in every original, literary, dramatic, musical, and artistic work, if—

(a) In the case of a published work, the work was first published within such parts of His Majesty's dominions as aforesaid ; and

(b) In the case of an unpublished work, the author was at the date of the making of the work a British subject or resident within such parts of His Majesty's dominions as aforesaid ;

but in no other works, except so far as the protection conferred by this Act is extended by Orders in Council thereunder relating to self-governing dominions to which this Act does not extend and to foreign countries.

(2) For the purposes of this Act " copyright " means the sole right to produce or reproduce the work or any substantial part thereof in any material form whatsoever, to perform, or in the case of a lecture to deliver, the work or any substantial part thereof in public ; if the work is unpublished, to publish the work or any substantial part thereof ; and shall include the sole right—

(a) To produce, reproduce, perform, or publish any translation of the work ;

(b) In the case of a dramatic work, to convert it into a novel or other non-dramatic work ;

(c) In the case of a novel or other non-dramatic work, or of an artistic work, to convert it into a dramatic work by way of performance in public or otherwise ;

(d) In the case of a literary, dramatic, or musical work, to make any record, perforated roll, cinematograph film or other contrivance by means of which the work may be mechanically performed or delivered ;

and to authorize any such acts as aforesaid.

(3) For the purposes of this Act publication, in relation to any work, means the issue of copies of the work to the public, and does not include the performance in public of a dramatic or musical work, the delivery in public of a lecture, the exhibition in public of an artistic work, or the construction of an architectural work of art, but for the purposes of this provision the issue of photographs and engravings of works of sculpture and architectural works of art shall not be deemed to be publication of such works.

APPENDIX (S)

COPYRIGHT ORDINANCE, NO.21 OF 1915

No. 21 of 1915.

*to be referred to
with No 11 of 11
(see note on
of latter 1
46a*

An Ordinance to amend "The Copyright Ordinance,
No. 20 of 1912."

ROBERT CHALMERS.

Preamble.

WHEREAS by section 27 of the Act of the Imperial Parliament known as "The Copyright Act, 1911," set out in the schedule to "The Copyright Ordinance, No. 20 of 1912," it is provided that the Legislature of any British Possession to which the Act extends may modify or add to any of the provisions of that Act in its application to the Possession on any question relating to procedure and remedies:

And whereas it is expedient to modify the provisions of section 14 of that Act: Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

Short title.

1 This Ordinance may be cited as "The Copyright (Amendment) Ordinance, No. 21 of 1915."

Substitution of New Section 14.

2 "The Copyright Act, 1911," in its application to Ceylon shall be read as though the following section were substituted for section 14 thereof:

Importation of copies.

14 (1) Copies made out of Ceylon of any work in which copyright subsists which if made in Ceylon would infringe copyright, and as to which the owner of the copyright gives notice in writing by himself or his agent to the Principal Collector of Customs that he is desirous that such copies should not be imported into Ceylon, shall not be so imported, and shall, subject to the provisions of this section, be deemed to be included in the table of prohibitions and restrictions contained in section 36 of the Ordinance for the General Regulation of Customs in the Island of Ceylon, No. 17 of 1869, and that section shall apply accordingly.

(2) Before detaining any such copies, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Principal Collector of Customs may require the regulations under this section, whether as to information, conditions, or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the copies are such as are prohibited by this section to be imported.

*Regulations
9.12.1915.*

(3) The Principal Collector of Customs may make regulations, either general or special, respecting the detention and forfeiture of copies the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

(4) The regulations may apply to copies of all works the importation of copies of which is prohibited by this section, or different regulations may be made respecting different classes of such works.

(5) The regulations may provide for the informant reimbursing the Principal Collector of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention, and may provide for notices under "The Copyright Ordinance, 1908," being treated as notices given under this section, and also that notices given to the Commissioners of Customs and Excise of the United Kingdom and communicated by them to the Principal Collector of Customs shall be deemed to have been given by the owner to the Principal Collector of Customs.

Passed in Council the Thirtieth day of September, One thousand Nine hundred and Fifteen.

A. G. CLAYTON,
Clerk to the Council.

Assented to by His Excellency the Governor the Eighth day of October, One thousand Nine hundred and Fifteen.

R. E. STUBBS,
Colonial Secretary.

APPENDIX (T)

THE COPYRIGHT (AMENDMENT) ORDINANCE, NO.11 OF 1918

Ordinance enacted by the Governor of Ceylon, with the advice
and consent of the Legislative Council thereof.

No. 11 of 1918.

An Ordinance to amend "The Copyright (Amendment)
Ordinance, No. 21 of 1915."

R. E. STUBBS.

Preamble.

WHEREAS it is expedient to amend "The Copyright
(Amendment) Ordinance, No. 21 of 1915": Be it
therefore enacted by the Governor of Ceylon, by and with the
advice and consent of the Legislative Council thereof, as
follows :

Short title.

1 This Ordinance may be cited as "The Copyright
(Amendment) Ordinance, No. 11 of 1918."

Addition of new
sub-section.

2 The following sub-section shall be added to the section
which by the said Ordinance was substituted for section 14 of
the Imperial Copyright Act, 1911, and shall be numbered (6) :

(6) All regulations made under this section shall be
subject to the approval of the Governor in Executive Council.

Passed in Council the Tenth day of July, One thousand
Nine hundred and Eighteen.

C. H. COLLINS,
Clerk to the Council.

Assented to by His Excellency the Officer Administering the
Government the Twenty-third day of July, One thousand
Nine hundred and Eighteen.

A. S. PAGDEN,
Acting Colonial Secretary.

APPENDIX (U)

THE COPYRIGHT (AMENDMENT) ORDINANCE, NO. 6 OF 1919

Ordinance No. 6 of 1919.

An Ordinance to repeal "The Copyright (Amendment) Ordinance, No. 21 of 1915," and "The Copyright (Amendment) Ordinance, No. 11 of 1918," and to make provision for the Application of Section 14 of "The Copyright Act, 1911," of the Imperial Parliament, to this Colony.

[Date of Governor's assent : March 7, 1919.]

[Date of commencement : to be fixed by Proclamation.]

W. H. MANNING.

WHEREAS it is expedient to make provision for the application of section 14 of "The Copyright Act, 1911," to this Colony, and to repeal "The Copyright (Amendment) Ordinance, No. 21 of 1915," and "The Copyright (Amendment) Ordinance, No. 11 of 1918": Be it therefore enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows:

1 This Ordinance may be cited as "The Copyright (Amendment) Ordinance, No. 6 of 1919," and shall come into operation on such date as the Governor shall, by Proclamation in the *Government Gazette*, appoint.

2 "The Copyright (Amendment) Ordinance, No. 21 of 1915," and "The Copyright (Amendment) Ordinance, No. 11 of 1918," are hereby repealed.

3 For the purpose of the application of section 14 of "The Copyright Act, 1911," of the Imperial Parliament to the importation into this Colony of works made out of this Colony—

(1) The Principal Collector of Customs shall perform the duties and may exercise the powers thereby imposed on or given to the Commissioners of Customs and Excise of the United Kingdom.

(2) Regulations made by the Principal Collector of Customs under that section shall require the approval of the Governor in Executive Council.

(3) Regulations made under that section may provide that notices given to the Commissioners of Customs and Excise of the United Kingdom, if communicated by them to the Principal Collector of Customs, shall be deemed to have been given by the owner of the copyright to the Principal Collector of Customs.

(4) That section shall have effect as if it formed part of the Ordinance for the General Regulation of Customs in the Island of Ceylon, No. 17 of 1869.

Passed in Council the Twenty-sixth day of February, One thousand Nine hundred and Nineteen.

C. H. COLLINS,
Clerk to the Council.

Assented to by His Excellency the Governor the Seventh day of March, One thousand Nine hundred and Nineteen.

R. E. STUBBS,
Colonial Secretary.

Preamble.

Short title and commencement.

Repeal.

Principal Collector of Customs to perform duties imposed on or given to Commissioners of Customs and Excise of United Kingdom.

APPENDIX (V)

THE TELEGRAM COPYRIGHT ORDINANCE, NO.19 OF 1898

Telegram Copyright Ordinance

No. 19 of 1898

AN ORDINANCE TO SECURE, IN CERTAIN CASES, THE RIGHT OF PROPERTY IN TELEGRAPHIC PRESS MESSAGES.

(14th December, 1898.)

1. This ordinance may be cited as the Telegram Copyright Ordinance.
2. When any person, in the manner hereinafter mentioned, publishes in any newspaper or other printed paper published and circulated in Ceylon any message by telegraph from any place outside Ceylon, lawfully received by such person, no other person shall, without the consent in writing of such first mentioned person, or his agent thereto lawfully authorized, print or publish, or cause to be printed or published such telegram, or the substance thereof, or any extract therefrom, after a period of forty-eight hours from the time of first publication:

Provided that such period shall not extend beyond sixty hours from the time of receipt of message such Sundays and public and bank holidays excepted, and the publication of the whole or any part of such telegram, or of the substance thereof, or (excepting the publication of any similar message in like manner sent) of the intelligence therein contained, or any comment upon, or any reference to, such intelligence, shall be deemed to be publication of the same.

3. If any person wilfully print and publish, or cause to be printed and published any matter contrary to the provisions of this Ordinance, he shall be liable to a fine not exceeding one hundred rupees; and every person who is convicted a second time of any offence against this Ordinance shall be liable to a fine not exceeding three hundred rupees.
4. Telegraphic messages published under the protection of this Ordinance shall be printed under the heading 'Telegram Copyright

Ordinance", and shall state the day and hour of their receipt, and such statement shall be prima facie evidence of the time of the receipt of such messages.

5. (1) During the period of forty eight hours herein before mentioned, no intelligence protected by this Ordinance shall be transmitted by telegraph to any person outside Ceylon by or on behalf of any person other than the person who, under the provisions of this Ordinance, is entitled to the exclusive use of such intelligence.

(2) Any person acting in contravention of this section shall be guilty of an offence, and liable on conviction to a fine not exceeding one hundred rupees for a first offence, and to a fine not exceeding three hundred rupees for any subsequent offence.

6. In any prosecution under this Ordinance the production of any document which purports to be a telegraphic message from some place outside Ceylon, and which contains the intelligence published in the newspapers as aforesaid, and which has been delivered to some person entitled to receive the same by the proper officer of the Telecommunications Department, shall be prima facie evidence that the message published as herein before described in such newspaper is a message within the meaning of this Ordinance; and proof that any person is owner, or is, or is acting, or appears to be acting, as editor or manager of any newspaper in which there has been any publication contrary to the provisions of this Ordinance shall be prima facie evidence that such person has wilfully caused such unlawful publication.

7. Nothing in this Ordinance shall extend to any document published by the Government Printer, or to the report of any proceedings in the Senate or in the House of Representatives.

8. In this Ordinance unless the context otherwise requires the expression "telegraph" includes telephone and wireless telegraph or telephone, and "telegraphic" has a corresponding meaning.

APPENDIX (W)

THE TELEGRAM COPYRIGHT ORDINANCE, NO.1 OF 1926

Ordinance No. 1 of 1926

An Ordinance to amend the Telegram Copyright Ordinance, 1898.

[Date of Governor's assent : February 16, 1926.]
[Date of commencement : February 16, 1926.]

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INSTITUTE OF ADVANCED
LEGAL STUDIES
26 OCT 1976
25 RUSSELL SQUARE
LONDON W.C.1

HUGH CLIFFORD.

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BE it enacted by the Governor of Ceylon, by and with the advice and consent of the Legislative Council thereof, as follows :

1 This Ordinance may be cited as the Telegram Copyright Ordinance, No. 1 of 1926.

Short title.

2 The word "electric" shall be deleted from section 1 and sub-section (1) of section 4 of the principal Ordinance.

Deletion of "electric."

3 Section 3 of the principal Ordinance, which now reads as follows, viz. :

Amendment of section 3 of the principal Ordinance.

Telegraphic messages published under the protection of this Ordinance shall be printed under the heading "By Submarine Telegraph," and shall state the day and hour of their receipt, and such statement shall be *prima facie* evidence of the time of the receipt of such messages.

is hereby amended so as to read as follows, viz. :

Telegraphic messages published under the protection of this Ordinance shall be printed under the heading "Telegram Copyright Ordinance, 1898," and shall state the day and hour of their receipt, and such statement shall be *prima facie* evidence of the time of the receipt of such messages.

4 The following section shall be inserted in the principal Ordinance between sections 6 and 7 thereof, viz. :

Insertion of new section in principal Ordinance.

6A. In this Ordinance, unless the context otherwise requires, the expression "telegraph" includes telephone and wireless telegraph or telephone, and "telegraphic" has a corresponding meaning.

Definition of "telegraph."

Passed in Council the Fourth day of February, One thousand Nine hundred and Twenty-six.

J. A. MAYBIN,
Clerk to the Council.

Assented to by His Excellency the Governor the Sixteenth day of February, One thousand Nine hundred and Twenty-six.

A G. M. FLETCHER,
Colonial Secretary.

APPENDIX (X)

**EXTRACTS OF THE CODE OF
INTELLECTUAL PROPERTY ACT, NO.52 OF 1979**

CHAPTER 186

CODE OF INTELLECTUAL PROPERTY

AN ACT TO REVISE, CONSOLIDATE, AMEND AND EMBODY IN THE FORM OF A CODE THE LAW RELATING TO COPYRIGHT, INDUSTRIAL DESIGNS, PATENTS, MARKS, TRADE NAMES AND UNFAIR COMPETITION AND PROVIDE FOR THE BETTER REGISTRATION, CONTROL AND ADMINISTRATION THEREOF AND FOR MATTERS CONNECTED THEREWITH OR INCIDENTAL THERETO.

Act
Nos. 52 of 1979,
30 of 1980.

[2nd January, 1980.]

Short title. 1. This Act (hereinafter referred to as the "Code") may be cited as the Code of Intellectual Property Act.

PART I

ADMINISTRATION

CHAPTER I

Appointment of Registrar and his duties. 2. (1) There may be appointed a person to be or to act as Registrar of Patents and Trade Marks of Sri Lanka (hereinafter referred to as the "Registrar")

(2) In default of such appointment the Registrar of Companies or any person for the time being acting as such shall discharge the duties of the Registrar under this Code.

(3) The Registrar shall, subject to the directions of the Minister, be vested with the general control and superintendence of the registration of industrial designs, patents and marks under the provisions of this Code and of all persons appointed for or engaged in the carrying out of the provisions of this Code.

Deputy Registrars and Assistant Registrars. 3. (1) There may from time to time be appointed a fit and proper person, or each of two or more such persons, to be or to act as a Deputy Registrar of Patents and Trade Marks and such other Assistant Registrars as the Minister may consider necessary.

(2) Any person so appointed may exercise, perform or discharge any power, duty or function expressly conferred or imposed upon the Deputy Registrar or Assistant Registrar, as the case may be, and may, subject to the directions of the Minister and under the authority and control of the Registrar, exercise, perform

(3) In default of any such appointment the Deputy Registrar of Companies or an Assistant Registrar of Companies, as the case may be, shall discharge the duties of the Deputy Registrar of Patents and Trade Marks or an Assistant Registrar of Patents and Trade Marks.

4. (1) The Minister may by notification in the Gazette establish an office called the Registry of Patents and Trade Marks (hereinafter referred to as the "Registry") which shall be the only office in Sri Lanka for the registration of industrial designs, patents and marks.

(2) All registers required to be kept and maintained under the provisions of this Code shall be kept and maintained under the supervision of the Registrar at the Registry and such registers shall be the only legally recognized registers for the registration of industrial designs, patents and marks in Sri Lanka.

5. Every Registrar, Deputy Registrar and Assistant Registrar for the time being shall, as long as they hold office, be deemed to be public servants within the meaning of the Penal Code.

PART II

COPYRIGHT

CHAPTER II

6. For the purposes of this Part—

"broadcasting" means the transmitting, for reception by the general public,

by wireless or by means of wire, of sounds or of images and sounds;

(c) dramatic and dramatico-musical works;

"folklore" means all literary and artistic works created in Sri Lanka by various communities, passed on from generation to generation and constituting one of the basic elements of the traditional cultural heritage;

(d) musical works, whether or not they are in written form and whether or not they include accompanying words;

(e) choreographic works and pantomimes;

"performance" means a public performance or delivery of a work by any means whatsoever;

(f) cinematographic, radiophonic and audio-visual works;

"published works" means works published in any manner whatsoever with the consent of their authors provided that the number of copies so published are sufficient to satisfy the reasonable requirements of the public, having regard to the nature of the work;

(g) works of drawing, painting, architecture, sculpture, engraving, lithography and tapestry;

(h) photographic works, including works expressed by processes analogous to photography;

(i) works of applied art, whether handicraft or produced on an industrial scale;

"reproduction" means the making of one or more copies of a literary, artistic or scientific work, in any material form including any sound or visual recording;

(j) illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture or science.

"works first published" means works first published in Sri Lanka, or works first published abroad but also published in Sri Lanka within thirty days from the earlier publication;

(3) Works shall be protected irrespective of their quality and the purpose for which they were created.

"work of joint authorship" means a work created by two or more authors in collaboration, in which the individual contributions are indistinguishable from each other.

8. (1) The following shall also be protected as original works—

(a) translations, adaptations, arrangements and other transformations of literary, artistic or scientific works;

(b) collections of literary, artistic or scientific works, such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations; and

7. (1) Authors of original literary, artistic and scientific works shall be entitled to protection of their works under this Part.

Works protected,

(2) Literary, artistic and scientific works shall include in particular—

(a) books, pamphlets and other writings;

(c) works derived from Sri Lanka folklore.

(b) lectures, addresses, sermons and other works of the same nature;

(2) The protection of any work referred to in subsection (1) shall be without prejudice

to any protection of a pre-existing work utilized for the making of such work.

Works not protected.
9. Notwithstanding the provisions of sections 7 and 8, protection shall not extend to—

(a) laws and decisions of courts and administrative bodies, as well as to official translations thereof; and

(b) news of the day published, broadcast or publicly communicated by any other means.

Economic rights.
10. Subject to the provisions of sections 12 to 16 the author of a protected work shall have the exclusive right to do or authorize any other person to do the following acts in relation to the whole work or a part thereof—

(a) reproduce the work;

(b) make a translation, adaptation, arrangement, or other transformation of the work;

(c) communicate the work to the public by performance, broadcasting, television or any other means.

Moral rights.
11. (1) The author of a protected work shall have the right—

(a) to claim authorship of his work, in particular that his authorship be indicated; In connexion with any of the acts referred to in section 10, except when the work is included incidentally or accidentally when reporting current events by means of broadcasting or television,

(b) to object to, and to seek relief in connexion with, any distortion, mutilation or other modification of, and any other derogatory action in relation to, his work, where such action would be or is prejudicial to his honour or reputation.

(2) The rights referred to in subsection (1) shall subsist for the life of the author and fifty years thereafter. After his death, the said rights shall be exercisable by his heirs.

(3) The rights referred to in subsection (1) shall be exercisable even where the author or his heirs do not have the rights referred to in section 10.

(4) The rights referred to in subsection (1) shall not be transferable.

12. (1) In the case of works of Sri Lanka folklore, the rights referred to in sections 10 and 11(1) shall be exercised by the Minister in charge of the subject of Culture.

(2) Works of Sri Lanka folklore shall be protected by all means available under this Part, without limitation in time.

(3) Copies of works of Sri Lanka folklore made abroad and copies of translations, adaptations, arrangements, or other transformations of works of Sri Lanka folklore made abroad, without the authorization of the Minister in charge of the subject of Culture, shall be neither imported nor distributed.

Fair use.

13. Notwithstanding the provisions of section 10, the following uses of a protected work, either in the original languages or in translation, shall be permissible without the author's consent—

(a) in the case of any work that has been lawfully published—

(i) the reproduction, translation, adaptation, arrangement or other transformation of such work exclusively for the user's own personal and private use;

(ii) the inclusion, subject to mention of the source and the name of the author, of quotations from such work in another work, provided that such quotations are compatible with fair practice and their extent does not exceed that justified by the purpose, including quotations from newspaper articles and periodicals in the form of press summaries;

(iii) the utilization of the work by way of illustration in publications, broadcasts or sound or visual recordings for teaching to the extent justified by the purpose, or the communication for teaching purposes of the work broadcast or televised for use in schools, education, universities and professional training;

Provided that such use is compatible with fair practice and that the source and the name of the author are mentioned in the publication, broadcast, television broadcast or recording;

(b) in the case of any article published in newspapers or periodicals on current economic, political or religious topics, and in the case of any broadcast or televised work of the same character, the reproduction of such article or such work in the press, or the communication of it to the public, unless the said article when first published, or the said broadcast or televised work when broadcast or televised, was accompanied by an express condition prohibiting such use, and that the source of the work when used in the said manner is clearly indicated;

(c) for the purposes of reporting on a current event by means of photography, cinematography or communication to the public, the reproduction or making available to the public, to the extent justified by the informative purpose of any work that can be seen or heard in the course of the said current event;

(d) the reproduction of works of art and of architecture in a film or television broadcast, and the communication to the public of the works so reproduced, if the said works are permanently located in a place where they can be viewed by

the public or are included in the film or television broadcast only by way of background or as incidental to the essential matters represented;

(e) the reproduction, by sound recording, photographic or similar process, by public libraries, non-commercial documentation centres, scientific institutions and educational establishments, of literary, artistic or scientific works which have already been lawfully made available to the public;

Provided that such reproduction and the number of copies made are limited to the needs of their activities, do not conflict with the normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author;

14. the reproduction in the press of—

(i) any political speech delivered in public or any speech delivered during legal proceedings, or

(ii) any lecture, address, sermon or other work of the same nature delivered in public, provided that the use is exclusively for the purposes of current information,

the author retaining the right to publish a collection of such works.

Ephemeral recordings

14. Notwithstanding the provisions of section 10, any broadcasting or television organization may make, for the purpose of its own broadcasts or television broadcasts and by means of its own facilities, an ephemeral recording, in one or several copies, of any work which it is authorized to broadcast or televise. All copies of such recording shall be destroyed within six months of the making thereof or within any longer period agreed to by the author;

Provided, however, that where such recording has an exceptional documentary character, one copy of it may be preserved

in official archives, without prejudice to the application of the provisions of section 11.

15. Where any work has not been published in Sinhala or Tamil within ten years from its having been published for the first time in its original language, it shall be lawful to translate the said work into Sinhala or Tamil, as the case may be, and to publish such translation, even without the authorization of, and without any payment to, the owner of the copyright of the work, without prejudice to the application of the provisions of section 11.

16. (1) Where the owner of the copyright in a musical work has already authorized a person to make a sound recording of the performance of the work, any other person may, if he cannot agree with the owner to make a sound recording of a performance of the same work, make a new sound recording of a performance of the said work without the authorization of the owner, provided that such other person pays to the owner an equitable remuneration which amount shall be fixed by the Secretary to the Ministry charged with the subject of Culture. The foregoing provisions shall apply also to any words accompanying the music.

(2) Where any public broadcasting or television organization operating in and from Sri Lanka cannot agree with the owner of the copyright in any work which it wishes to transmit by broadcasting or television on the conditions on which the work may be broadcast or televised, it shall be entitled to proceed to such broadcasting or television even without the authorization of the owner, provided that it pays to the owner an equitable remuneration which amount shall be fixed by the Secretary to the Ministry charged with the subject of Culture.

(3) The provisions of subsections (1) and (2) shall be without prejudice to the application of the provisions of section 11.

(4) The mode and manner of the assessment and payment of remuneration under subsections (1) and (2) shall be as prescribed.

17. (1) The rights protected under this Part shall be owned in the first instance by

the author or authors who created the work. The authors of a work of joint authorship shall be co-owners of the said rights.

(2) In the absence of proof to the contrary, the author of a work is the person under whose name the work is disclosed—

(3) In the case of a work created by an author for any person or body of persons corporate or unincorporate in the course of his employment under a contract of service, or of a work commissioned from the author by such person or body of persons, the rights mentioned in section 10 shall, in the absence of contractual provisions to the contrary, be deemed to be transferred to the employer or to the person commissioning the work.

18. (1) The rights referred to in section 10 shall be transferable in whole or in part.

(2) Any transfer, other than by operation of law, of a right referred to in section 10 shall be in writing signed by the transferor.

(3) A transfer, in whole or in part of any right referred to in section 10, shall not include or be deemed to include the transfer of any other rights referred to therein/

(4) When a contract provides for the total transfer of one of the rights referred to in section 10, the scope of such contract shall be limited to the exercise of such rights as are provided for in the contract.

(5) The transfer of ownership of the only copy or of one or several copies of a work shall not imply or be deemed to imply the transfer of the copyright in the work.

19. (1) Unless expressly provided otherwise in this Part, the rights referred to in section 10 shall be protected during the life of the author and for fifty years after his death.

(2) In the case of a work of joint authorship the rights referred to in section 10 shall be protected during the life of the last surviving author and for fifty years after his death.

(3) In the case of a work published anonymously or under a pseudonym, the

rights referred to in section 10 shall be protected until the expiration of fifty years from the date on which such work was first lawfully published :

Provided that where, before the expiration of the said period, the author or the author's identity is revealed or is no longer in doubt, the provisions of subsection (1) or subsection (2) shall apply as the case may be.

(4) In the case of a cinematographic, radiophonic or audiovisual work, the rights referred to in section 10 shall be protected until the expiration of fifty years from the making of the work or, if the work is made available to the public during such period with the consent of the author, fifty-years from the date of its communication to the public.

(5) In the case of a photographic work or a work of applied art, the rights referred to in section 10 shall be protected until the expiration of twenty-five years from the making of the work.

(6) Every period under the preceding provisions of this section shall run to the end of the calendar year in which it would otherwise expire.

20. (1) The lawful maker of any sound recording shall, for a period of fifty years from the first publication of the sound recording, have the exclusive right to reproduce or authorize the reproduction of the sound recording.

(2) The provisions of sections 14, 18, 19 (6), and 21 shall apply to sound recordings.

21. (1) Any person who infringes any of the rights protected under this Part may be prohibited by injunction from continuing such infringement and may also be liable in damages.

(2) The provisions of Chapter XXXII relating to infringements shall apply, *mutatis mutandis*, to the rights protected under this Part.

22. This Part shall apply to—

(a) works of authors who are nationals of, or have their habitual residence in, Sri Lanka, and

(b) works first published in Sri Lanka, irrespective of the nationality or residence of their authors ; and

(c) all works which, by virtue of treaties entered into by Sri Lanka, are to be protected, as well as to works of Sri Lanka folklore.

23. No copyright, or right in the nature of copyright, shall subsist otherwise than by virtue of this Part or of any other enactment made in that behalf.

24. The provisions of this Part shall not affect any rights herebefore acquired under the common law or any other law.

PART III

INDUSTRIAL DESIGNS

CHAPTER 'III

SCOPE OF THIS PART AND DEFINITIONS

25. The protection of industrial designs provided under this Part shall be in addition to and not in derogation of any other protection provided under any other written law, in particular under Part II of this Code.

26. The protection provided under this Part shall—

(1) apply only to new industrial designs ;

(2) not apply to an industrial design which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious, or racial susceptibilities of any community.

27. For the purposes of this Part any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, that gives a special appearance to a product of industry or handicraft and is capable of serving as a

Limitation of right of translation.

Limitation of right of sound recording and broadcasting.

Ownership of copyright.

Definition of industrial design

Infringements and sanctions.

Sound recording.

Fields of application.

Transfer of copyright.

Duration of economic rights

(5) Where a licence contract in respect of a patent is recorded in the register, the Registrar shall not, in the absence of provision to the contrary in such licence contract, accept or record the said surrender except upon receipt of a signed declaration by which every licensee or sub-licensee on record consents to the said surrender, unless the requirement of his consent is expressly waived in the licence contract.

95. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the owner of the patent and every assignee, licensee or sub-licensee on record shall be made party, declare the patent null and void on any one or more of the following grounds:—

(a) that what is claimed as an invention in the patent is not an invention within the meaning of section 59 (1), or is excluded from protection under section 59 (3) or section 76 (1) or is not patentable because it does not comply with the requirements of sections 60 to 63; or

(b) that the description or the claims do not comply with the requirements of section 68 (3) and (4); or

(c) that any drawings which are necessary for the understanding of the claimed invention have not been furnished; or

(d) that the right to the patent does not belong to the person to whom the patent was granted:

Provided that the patent has not been assigned to the person to whom the right to the patent belongs.

(2) (a) Where the provisions of subsection (1) apply only to some of the claims or some parts of a claim, such claims or parts of a claim may be declared null and void by the court.

(b) The nullity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

(3) (a) An assignee, licensee or sub-licensee, as the case may be, who has been made party to the application under subsection (1) shall be entitled to join in the proceedings in the absence of any provision to the contrary in any contract or agreement with the owner of the patent.

(b) Where the application to Court is on the ground referred to in subsection (1) (d), the applicant shall give notice of the application to the person to whom the right to the patent is alleged to belong.

96. (1) Upon a final decision of the Court declaring total or partial nullity of a patent, the patent shall be deemed to have been null and void totally or partially, as the case may be, from the date of the grant of the patent.

Date and effect of nullity.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Registrar who shall record the said declaration in the register and cause it to be published in the Gazette.

PART V

MARKS, TRADE NAMES AND UNFAIR COMPETITION

CHAPTER XIX

DEFINITIONS

97. For the purposes of this Part, unjiss Definitions. the context otherwise requires—

"appellation of origin" means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors;

"collective mark" means any visible sign designated as such and serving to distinguish the origin or any other common characteristic of goods or services of different enterprises which use the mark under the control of the registered owner;

"enterprise" means any business, industry or other activity carried on by an individual, partnership, company, or co-operative society wherever registered or incorporated and whether registered or not under any law for the time being in force relating to companies, co-operative societies or businesses engaged in or proposing to engage in any business and includes any business undertaking of the Government or any State corporation whether carrying on business in Sri Lanka or otherwise;

"false trade description" means a trade description which is false or misleading in a material respect as regards the goods or services to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false or misleading in a material respect, and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Part;

"goods" means anything which is the subject of trade, manufacture or merchandise and includes services;

"indication of source" means any expression or sign used to indicate that a product or service originates in a given country or group of countries, region, or locality;

"mark" means a trade mark or service mark;

"name" includes any abbreviation of a name;

"person", "manufacturer, dealer, or trader", and "owner" include any body of persons corporate or unincorporate;

"service mark" means any visible sign serving to distinguish the services of one enterprise from those of other enterprises;

"trade description" means any description, statement or other indication, direct or indirect—

(a) as to the number, quantity, measure, gauge, or weight of any goods; or

(b) as to the place or country in which any goods were made or produced; or

(c) as to the mode of manufacturing or producing any goods; or

(d) as to the material of which any goods are composed; or

(e) as to any goods being the subject of an existing copyright, industrial design or patent; or

(f) as to the quality, kind or nature of the services; or

(g) as to the standard of quality of any goods, according to a classification commonly used or recognized in the trade; or

(h) as to the fitness for purpose, strength, performance or behaviour of any goods,

and the use of any figure, word or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Part;

"trade mark" means any visible sign serving to distinguish the

goods of one enterprise from those of other enterprises ; and

* trade name " means the name or designation identifying the enterprise of a natural or legal person.

CHAPTER XX

ADMISSIBILITY OF MARKS

98. (1) The exclusive right to a mark conferred by this Part shall be acquired, subject to the following provisions, by registration.

(2) Registration of a mark may be granted only to the person who has first fulfilled the conditions for valid application or who is the first validly to claim the earliest priority for his application.

(3) Provided that they are not inadmissible under sections 99 and 100, marks may consist, in particular, of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedges, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

99. (1) A mark shall not be registered—

(a) which consists of shapes or forms imposed by the inherent nature of the goods or services or by their industrial function ;

(b) which consists exclusively of a sign or indication which may serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production, or of supply, of the goods or services concerned ;

(c) which consists exclusively of a sign or indication which has become, in the current language or in the bona fide and established practices of the trade of Sri Lanka, a customary designation of the goods or services concerned ;

(d) which, for other reasons, is incapable of distinguishing the goods or services of one enterprise from those of other enterprises ;

(e) which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Registrar or the Court, is likely to offend the religious or racial susceptibilities of any community ;

(f) which is likely to mislead trade circles or the public as to the nature, the source, the manufacturing process, the characteristics, or the suitability for their purpose, of the goods or services concerned ;

(g) which does not represent in a special or particular manner the name of an individual or enterprise ;

(h) which is, according to its ordinary signification, a geographical name or surname ;

(i) which reproduces or imitates armorial bearings, flags or other emblems, initials, names or abbreviated names of any State or any inter-governmental international organization or any organization created by international convention, unless authorized by the competent authority of that State or international organization ;

(j) which reproduces or imitates official signs or hallmarks of a State, unless authorized by the competent authority of that State ;

(k) which resembles in such a way as to be likely to mislead the public, a mark or a collective mark the registration of which has expired and has not been renewed or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding the filing of the mark in question ;

(l) which consists of any other words or definitions as may be prescribed.

(2) The Registrar shall in applying the provisions of paragraphs (b), (c), (d), (f), (g) and (h), of subsection (1), have regard to all the factual circumstances and, in particular, the length of time the mark has been in use in Sri Lanka or in other countries and the fact that the mark is held to be distinctive in other countries or in trade circles.

Marks inadmissible by reason of third-party rights.

100. (1) A mark shall not be registered—

(a) which resembles, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a third party, or subsequently filed by a person validly claiming priority in respect of the same goods or services or of other goods or services in connexion with which use of such mark may be likely to mislead the public ;

(b) which resembles, in such a way as to be likely to mislead the public, an unregistered mark used earlier in Sri Lanka by a third party in connexion with identical or similar goods or services, if the applicant is aware, or could not have been unaware, of such use ;

(c) which resembles, in such a way as to be likely to mislead the public, a trade name already used in Sri Lanka by a third party, if the applicant is aware, or could not have been unaware, of such use ;

(d) which constitutes a reproduction in whole or in part, an imitation, translation or transcription, likely to mislead the public, of a mark or trade name which is well known in Sri Lanka and belongs to a third party ;

(e) which infringes other third party rights or is contrary to the provisions of Chapter XXIX relating to the prevention of unfair competition ;

(f) which is filed by the agent or representative of a third party who is

the owner of such mark in another country, without the authorization of such owner, unless the agent or representative justifies his action.

(2) The Registrar shall, in applying the provisions of paragraphs (a) to (e) of subsection (1), have regard to the fact that the third parties referred to therein have consented to the registration of such mark.

101. There shall not be entered in the register notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

CHAPTER XXI

REQUIREMENTS OF APPLICATION AND PROCEDURE FOR REGISTRATION

102. (1) An application for registration of a mark shall be made to the Registrar in the prescribed form and shall contain—

(a) a request for the registration of the mark ;

(b) the name, address and description of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka ;

(c) four copies of a representation of the mark ;

(d) a clear and complete list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification, as may be prescribed.

(2) Where the application is filed through an agent, it shall be accompanied by a power of attorney granted to such agent by the applicant ;

Provided that legalization or certification of the applicant's signature shall not be necessary.

103. An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in a

Convention country shall, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in which he or his predecessor in title filed such application and shall, within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.

104. (1) An applicant for registration of a mark who has exhibited goods bearing the mark or rendered services under the mark at an official or officially recognized international exhibition and who applies for registration of the mark within six months from the date on which the goods bearing the mark or services under the mark were first exhibited or rendered at such exhibition shall, on request, be deemed to have applied for registration of that mark on the date on which the goods bearing the mark or the services rendered under the mark were first exhibited or rendered at such exhibition.

(2) Evidence of the exhibition of the goods bearing the mark or the services rendered under the mark shall be by a certificate issued by the competent authority of the exhibition stating the date on which the mark was first used at such exhibition in connexion with such goods or services.

(3) The provisions of subsections (1) and (2) shall not extend any other period of priority claimed by the applicant.

105. An application for registration of a mark shall not be entertained unless the prescribed fee has been paid to the Registrar.

106. (1) The Registrar shall examine whether the application for registration complies with sections 102 and 105 and, where applicable, sections 103 and 104.

(2) Where the application does not comply with sections 102 and 105, the Registrar shall refuse registration of the mark :

Provided that the Registrar shall first notify the applicant of any defect in the application and shall afford him an opportunity to remedy such defect within three months from the date of receipt of such notification.

(3) Where the application does not comply with section 103 or 104, the Registrar shall not, in connexion with the registration of the mark, make any reference to the priority claimed.

(4) Where the application complies with sections 103 and 104, the Registrar shall in connexion with the registration of the mark record the priority claimed or the date of the certified use of the mark at an international exhibition.

(5) Where the Registrar refuses to register a mark, he shall, if required by the applicant, state in writing the grounds of his decision.

107. (1) Where the application complies with sections 102 and 105, the Registrar shall examine the mark in relation to the provisions of sections 99 and 100.

(2) Where the mark is inadmissible under section 99 or 100 the Registrar shall notify the applicant accordingly stating in writing the grounds on which registration of the mark is refused.

(3) Where the applicant is dissatisfied with all or any of the grounds stated by the Registrar in the notification referred to in subsection (2) he may, within a period of one month from the date of such notification, make his submissions in writing to the Registrar against such refusal.

(4) On receipt of any such submissions the Registrar may grant the applicant a hearing and inform him of the date and time of such hearing.

(5) The Registrar may, after such inquiry as he thinks fit, refuse to accept the application for registration of the mark, or may accept it absolutely or subject to conditions, amendments or modifications, or to such limitations, if any, as to the mode or place of user or otherwise as he may think fit to impose.

(6) In case of any refusal or conditional acceptance of an application for registration of a mark, the Registrar shall, if required by the applicant, state in writing the grounds of his decision.

(7) Where the Registrar is of the opinion that the mark is admissible under section 99 or 100 he may request the applicant to pay within a period of two months the prescribed fee for publication of the application.

(8) Where the fee for publication of the application is not paid within the prescribed period registration of the mark may be refused.

(9) If the fee for publication is paid within the prescribed period the Registrar shall proceed to publish the application setting out the date of application, the representation of the mark, the goods or services in respect of which registration of the mark is requested with an indication of the corresponding class or classes, the name and address of the applicant and, if the applicant is resident outside Sri Lanka, a postal address for service in Sri Lanka, the priority claimed, if any, or the date of certified use of the mark at an international exhibition.

(10) Where any person considers that the mark is inadmissible on one or more of the grounds referred to in section 99 or 100 he may, within a period of three months from the date of publication of the application, give to the Registrar in the prescribed form, and together with the prescribed fee, notice of opposition to such registration stating his grounds of opposition.

(11) Where notice of opposition has not been received by the Registrar within the period specified in subsection (10) the Registrar shall register the mark.

(12) Where, within the period specified in subsection (10) notice of opposition in the prescribed form is received by the Registrar, together with the prescribed fee, he shall serve a copy of such grounds of opposition on the applicant and shall request him to

present his observations on those grounds in writing within a period of three months.

(13) On receipt of the observations of the applicant the Registrar shall after hearing the parties, if he considers such hearing necessary, decide, as expeditiously as possible, whether or not the mark may be registered. If he decides that the mark is registrable he shall accordingly register such mark.

(14) The Registrar may allow a reasonable extension of the prescribed period within which any act has to be done or any fee has to be paid under this section.

108. Where, by reason of default on the part of the applicant, registration of a mark is not completed within twelve months from the date of receipt by the Registrar of the application, the Registrar may, after giving notice of non-completion to the applicant in writing in the prescribed form, treat the application as abandoned, unless it is completed within the time specified in that behalf in such notice.

109. (1) The Registrar shall keep and maintain a register called the Register of Marks wherein shall be recorded, in the order of their registration, all registered marks and such other matters relating to marks as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.

(2) The registration of a mark shall include a representation of the mark and shall specify its number, the name and address of the registered owner and, if the registered owner's address is outside Sri Lanka, a postal address for service in Sri Lanka; the dates of application and registration; if priority is validly claimed, an indication of that fact and the number, date and country of the application on the basis of which the priority is claimed; if a valid certificate has been filed relating to the use of a mark at an international exhibition, the contents of such certificate; the list of goods and services in respect of which registration of the mark has been granted with an indication of the corresponding class or classes.

(3) Upon the registration of a mark the Registrar shall issue to the registered owner thereof a certificate of registration and shall, at the request of the registered owner, send such certificate to him by registered post at his last recorded postal address in Sri Lanka or, if he is resident outside Sri Lanka, at his last recorded postal address for service in Sri Lanka.

Publication of registered marks
 of 110. The Registrar shall cause to be published in the Gazette, in the prescribed form, all registered marks in the order of their registration, including in respect of each mark so published reference to such particulars as may be prescribed.

Examination of register and certified copies
 111. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

Associated marks,
 112. Where application is made for the registration of a mark identical with or so closely resembling a mark of the applicant already on the register for the same goods or description of goods as to be likely to mislead or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that such marks shall be entered on the register as associated marks.

Assignment and user of associated marks
 113. Associated marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate marks :

Provided that where under the provisions of this Part user of a registered mark is required to be proved for any purpose, the Registrar may, if and so far as is considered right, accept user of an associated registered mark, or of the mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

CHAPTER XXII

DURATION OF REGISTRATION

Duration of registration. to
 114. (1) Subject and without prejudice to other provisions of this Part, registration of a mark shall expire ten years after the date of registration.

(2) A mark when registered shall be registered as of the date of receipt by the Registrar of the application for registration, and such date shall be deemed for the purposes of this Part to be the date of registration.

Renewal.
 115. (1) Registration of a mark may be renewed for consecutive periods of ten years each on payment of the prescribed fee.

(2) Renewal of registration of a mark shall not be subject to any further examination of the mark by the Registrar or to opposition by any person.

(3) The renewal fee shall be paid within the twelve months preceding the date of expiration of the period of registration :

Provided, however, that a period of grace of six months shall be allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed.

(4) The Registrar shall record in the register and cause to be published in the Gazette in the prescribed form all renewals of registration stating any elimination from the lists of goods or services.

(5) Where the renewal fee has not been paid within such period or such extended period specified in subsection (3), the Registrar shall remove the mark from the register.

Alteration of registered mark
 116. The registered owner of any mark may apply in the prescribed manner to the Registrar for leave to add to or alter such mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of user as he may think fit. If leave be granted, the mark as altered shall be published in the prescribed manner.

CHAPTER XXIII

RIGHTS OF REGISTERED OWNER OF MARK

Rights of registered owner
 117. (1) Subject and without prejudice to other provisions of this Part, the registered owner of a mark shall have the

following exclusive rights in relation to the mark :—

- (a) to use the mark ;
 - (b) to assign or transmit the registration of the mark ;
 - (c) to conclude licence contracts.
- (2) Without the consent of the registered owner of the mark third parties are precluded from the following acts :—

(a) any use of the mark, or of a sign resembling it, in such a way as to be likely to mislead the public for goods or services in respect of which the mark is registered, or for other goods or services in connexion with which the use of the mark or sign is likely to mislead the public ; and

(b) any other use of the mark, or of a sign or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interests of the registered owner of the mark.

Limitation of registered owner's rights.
 118. The registration of the mark shall not confer on its registered owner the right to preclude third parties—

- (a) from using bona fide their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production or of supply of their goods and services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services ;
- (b) from using the mark in relation to goods lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka under that mark, provided that such goods have not undergone any change.

(1) For the purposes of this Part licence contract means any contract by which the registered owner of a mark (" the licensor ") grants to another person or enterprise (" the licensee ") a licence to use the mark for all or part of the goods or services in respect of which the mark is registered.

CHAPTER XXIV

ASSIGNMENT AND TRANSMISSION OF APPLICATIONS AND REGISTRATIONS

Assignment and transmission of applications and registrations.
 119. (1) An application for registration or the registration of a mark may be assigned or transmitted independently of the transfer of all or part of the enterprise using the mark, in respect of all or part of the goods or services for which the application was filed or the mark registered.

(2) Such assignment or transmission shall be invalid if the purpose or effect thereof is to mislead the public, in particular in respect of the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark is applied.

(3) Any person becoming entitled by assignment or transmission to an application for registration or the registration of a mark may apply to the Registrar in the prescribed manner to have such assignment or transmission recorded in the register.

(4) No such assignment or transmission shall be recorded in the register unless—

(a) the prescribed fee has been paid to the Registrar ;

(b) in the case of an assignment, it is in writing signed by or on behalf of the contracting parties.

(5) No such assignment or transmission shall have effect against third parties, unless so recorded in the register.

CHAPTER XXV

LICENCE CONTRACTS

(1) For the purposes of this Part licence contract means any contract by which the registered owner of a mark (" the licensor ") grants to another person or enterprise (" the licensee ") a licence to use the mark for all or part of the goods or services in respect of which the mark is registered.

(2) Use of the mark by the licensee shall be deemed to be use of the mark by the registered owner.

Form and record of licence contract.

121. (1) A licence contract shall be in writing signed by or on behalf of the contracting parties.

(2) Upon a request in writing signed by or on behalf of the contracting parties, the Registrar shall, on payment of the prescribed fee, record in the register such particulars relating to the contract as the parties thereto might wish to have recorded :

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to the said contract.

Rights of licensee.

122. (1) In the absence of any provision to the contrary in the licence contract, the licensee shall—

(a) be entitled to use the mark within the whole geographical area of Sri Lanka, during the whole period of registration of the mark, including renewals, in respect of all the goods or services for which the mark is registered ;

(b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.

(2) The provisions of this Chapter shall apply, *mutatis mutandis*, to assignments and sub-licences.

Rights of licensor.

123. (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same mark or himself use the mark.

(2) Where the licence contract provides that the licence is exclusive, and unless it is expressly provided otherwise in such contract, the licensor shall not grant further licences to third parties in respect of the same mark or himself use the mark.

124. (1) A licence contract shall be null and void in the absence of stipulations ensuring effective control by the licensor of the quality of the goods or services in respect of which the mark may be used.

(2) Any clause or condition in a licence contract shall be null and void in so far as it imposes upon the licensee restrictions not derived from the rights conferred by this Part on the registered owner of the mark, or unnecessary for the safeguarding of such rights :

Provided that—

(a) restrictions concerning the scope, extent, duration of use of the mark or the geographical area in or the quality or quantity of the goods or services in connexion with which the mark may be used ;

(b) restrictions justified by the stipulations referred to in subsection (1) ; and

(c) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the mark.

shall not be deemed to constitute such restrictions.

125. The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, annul and cancel the said contract if—

(a) the licensor has lost effective control over the quality of the goods or services in respect of which the mark is used ;

(b) the licensee has used the mark in such a way as to mislead or confuse the public.

126. (1) Where the Registrar has reasonable cause to believe that any licence contract or any amendment or renewal thereof—

(a) which involves the payment of royalties abroad ; or

(b) which by reason of other circumstances relating to such licence contract ;

is detrimental to the economic development of Sri Lanka he shall in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter to the Governor of the Central Bank.

(2) Where the Governor of the Central Bank on receipt of any communication under subsection (1) informs the Registrar in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka the Registrar shall cancel and invalidate the record of such contract in the register.

Effect of nullity of registration on licence contract.

127. Where, before the expiration of the licence contract, the registration is declared null and void the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payments already made ;

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.

Expiry, termination or invalidation of licence contract.

129. The Registrar shall—

(a) if he is satisfied that a recorded licence contract has expired or been terminated, record that fact in the register upon a request in writing to that effect signed by or on behalf of the parties thereto ;

(b) record in the register the expiry, termination, annulment or invalidation of a licence contract under any provision of this Part.

RENUNCIATION AND NULLITY OF REGISTRATION

129. (1) The registered owner of a mark may renounce the registration, either wholly or in respect of part of the goods or services for which the mark is registered, by a declaration in writing signed by him or on his behalf and submitted to the Registrar.

Renunciation of registration.

(2) The Registrar shall, on receipt of the said declaration, record it in the register and cause such record to be published in the Gazette.

(3) The renunciation shall take effect from the date that the Registrar receives the said declaration.

(4) Where a licence contract in respect of a mark is recorded in the register the Registrar shall not, in the absence of provision to the contrary in such licence contract, accept or record the said renunciation except upon receipt of a signed declaration by which any assignee, licensee or sub-licensee on record consents to the renunciation, unless his consent is expressly waived in the licence contract.

130. (1) The Court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, declare the registration of the mark null and void if its registration is precluded under the provisions of sections 99 and 100 :

Nullity of registration.

Provided, however, that grounds of nullity which do not exist at the date of the application to Court shall not be taken into account.

(2) Where the grounds for nullity of registration of the mark exist in respect of only part of the goods or services for which the mark is registered, nullity of the registration shall be declared for that part only of such goods or services.

(3) An application for a declaration of nullity based on any of the grounds specified in section 100 (1) shall be made within five years from the date of registration of the mark.

131. (1) Upon a final decision of the Court declaring total or partial nullity of registration of a mark, the registration shall be deemed to have been lull and void totally or partially, as the case may be, from the date of such registration.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Registrar who shall record the said declaration in the register and cause it to be published in the Gazette.

CHAPTER XXVII

REMOVAL OF MARK

132. (1) The court may on the application of any person showing a legitimate interest, or of any competent authority including the Registrar, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, remove any registered mark from the register :—

(a) if the registered owner has, without valid grounds, failed to use the mark within Sri Lanka or cause it to be used within Sri Lanka by virtue of a licence, during five consecutive years immediately preceding the date of the application to Court ;

(b) if the registered owner has caused, provoked or tolerated the transformation of the mark into a generic name for one or more of the goods or services in respect of which the mark is registered so that in trade circles and in the eyes of the public its significance as a mark has been lost.

(2) In any application under subsection (1) (a) the Court may take into account the fact that non-use of the mark was due to circumstances beyond the control of the registered owner. The Court shall not take

into account the lack of funds of the registered owner as a ground for non-use of the mark.

(3) The use of a mark—

(a) in a form differing, in elements which do not alter the distinctive character of the mark, from the form in which it was registered, shall not be a ground for removal of the mark ;

(b) in connexion with one or more of the goods or services belonging to any given class in respect of which the mark is registered, shall suffice to prevent the removal of the mark in respect of all the other goods or services of the same class.

133. Upon a final decision of the Court removing any registered mark from the register—

(1) the Court may, taking into account the date of the events and other circumstances which occasion the removal of the mark, determine the date on which the registration of the mark shall be deemed to have ceased to have any legal effect;

(2) the Registrar of the Court shall communicate the decision of the Court to the Registrar who shall, if the Court decides that the mark be removed, enter in the register a record of such removal and cause the decision of the Court to be published in the Gazette.

CHAPTER XXVIII

COLLECTIVE MARKS

134. Sections 102, 116, 118, 119, and 129 to 133 of this Part shall apply to collective marks.

135. (1) An application for registration of a collective mark shall not be filed unless in the said application the mark is designated as a collective mark and unless the application is accompanied by a copy of such conditions as may be prescribed governing the use of the mark duly certified by the applicant.

(2) The conditions prescribed under subsection (1) shall define the common characteristics or quality of the goods or services which the collective mark shall designate and the conditions in which and the person by whom it may be used. They shall also provide for the exercise of effective control of the use of the mark and shall specify proper sanctions for the use of the mark contrary to the said conditions.

136. (1) Registration of a collective mark shall be in such pan of the register as the Registrar may decide and a copy of the conditions governing the use of the mark shall be appended to the registration.

(2) The publication of an application for a collective mark in accordance with section 107 (9) shall include a summary of the conditions to be appended to the registration.

(3) When so registered under subsection (1) a collective mark shall be deemed in all respects to be a registered mark.

137. (1) The registered owner of a collective mark shall notify the Registrar in the prescribed manner of any changes effected in the conditions governing the use of the mark.

(2) Any notification of such change shall be recorded in the register on payment of the prescribed fee. Any change in the conditions shall be effectual only if they have been so recorded.

(3) The Registrar shall cause to be published in the Gazette a summary of the changes so recorded in the register.

138. The provisions of sections 117 to 133 shall apply, *mutatis mutandis*, to collective marks and other matters.

CHAPTER XXIX

TRADE NAMES AND UNFAIR COMPETITION

139. A name or designation shall not be admissible as a trade name if, by reason of its nature or the uses to which it may be put, it is contrary to morality or public order or is likely to offend the religious or racial susceptibilities of any community or is likely to mislead trade circles or the public as to the nature of the enterprise identified by that name.

140. (1) Notwithstanding the provisions of any written law providing for the registration of a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party.

(2) Any subsequent use of a trade name by a third party, whether as a trade name or as a trade mark, service mark or collective name, trade mark, service mark or collective mark likely to mislead the public shall be deemed unlawful.

(3) Section 118 of this Part shall apply to trade names.

141. (1) A trade name may be assigned or transmitted together with the assignment or transmission of the enterprise or part of the enterprise identified by that name.

(2) The provisions of section 119 shall apply, *mutatis mutandis*, to trade names.

142. (1) Any act of competition contrary to honest practices in industrial or

commercial matters shall constitute an act of unfair competition.

(2) Acts of unfair competition shall include the following :—

(a) all ads of such a nature as to create confusion by any means whatsoever with the establishment, the goods, services or the industrial or commercial activities of a competitor ;

(b) a false allegation in the course of trade of such a nature as to discredit the establishment, the goods, services or the industrial or commercial activities of a competitor ;

(c) any indication of source or appellation of origin the use of which in the course of trade is liable to mislead the public as to the nature, manufacturing process, characteristics, suitability for their purpose or the quantity of goods ;

(d) making direct or indirect use of a false or deceptive indication of the source of goods or services or of the identity of their producer, manufacturer or supplier ;

(e) making direct or indirect use of a false or deceptive appellation of origin or imitating an appellation of origin even if the true origin of the product is indicated, or using the appellation in translated form or accompanied by terms such as " kind ", " type ", " mark ", " imitation " or the like.

(3) Any person or association of producers, manufacturers or traders aggrieved by any of the acts referred to in subsection (2) may institute proceedings in Court to prohibit the continuance of such acts, and the provisions of Chapter XXXII relating to infringements shall apply, *mutatis mutandis*, to such proceedings.

PART VI

OFFENCES AND PENALTIES

CHAPTER XXX

143. Any person who makes or causes entries in any to be made a false entry in any of the register.

registers kept under this Code, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false shall be guilty of an offence and shall be liable on conviction after trial to imprisonment for a term not exceeding seven years.

144. (1) Any person who wilfully infringes any of the rights protected under Part II of this Code shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

(2) The Magistrate may, whether the alleged offender is convicted or not, order that all copies of the work and all implements used for the infringement, or all plates in the possession of the alleged offender, which appear to him to be infringing copies or plates for the purpose of making infringing copies, shall be destroyed or delivered up to the owner of the copyright, or otherwise dealt with as the Magistrate may think fit.

145. Any person who wilfully infringes the rights of any registered owner, assignor or licensee of an industrial design shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

146. (1) Any person who, for industrial or commercial purposes, makes a representation—

(a) with respect to an industrial design not being a registered industrial design to the effect that it is a registered industrial design ;

(b) to the effect that a registered industrial design is registered in respect of any products in respect of which it is not registered ; or

(c) to the effect that the registration of an industrial design gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that an industrial design is registered if he uses in connexion with the industrial design the word " registered ", or any word or words expressing or implying that registration has been obtained for the industrial design.

Infringement of patents.

147. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or term of imprisonment or both may be doubled.

False representations regarding patents.

148. (1) Any person who, for industrial or commercial purposes, makes a representation—

(a) with respect to a patent not being a registered patent to the effect that it is a registered patent ;

(b) to the effect that a registered patent is registered in respect of any product or process in respect of which it is not registered ; or

(c) to the effect that the registration of a patent gives an exclusive right to

the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that a patent is registered if he uses in connexion with the patent the word " registered ", or any word or words expressing or implying that registration has been obtained for the patent.

149. Any person who being or having been employed in or at the Registry, communicates any information relating to patents or matters connected therewith obtained by him during the course of his employment in or at the Registry to any person not entitled or authorized to receive such information, or discloses such information to the public or makes any other unlawful use of such information shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding twelve months or to both such fine and such imprisonment.

150. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a mark shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding twelve months or to both such fine and such imprisonment.

Infringement of marks.

151. (1) Any person who, for industrial or commercial purposes, makes a representation—

(a) with respect to a mark not being a registered mark to the effect that it is a registered mark ;

(b) to the effect that a registered patent is registered in respect of any product or process in respect of which it is not registered ; or

(c) to the effect that the registration of a patent gives an exclusive right to

(i) are not a mark, or part of a mark; and

(ii) are identical with, or a colourable imitation of, the name or initials of a person carrying on business in connexion with goods of the same description, and not having authorized the use of such name or initials; and

(iii) are either those of a fictitious person or of some person not bona fide carrying on business in connexion with such goods.

(2) A trade description which denotes or implies that there are contained in any goods to which it is applied more metres or standard metres than there are contained therein, is a false trade description.

156. A person shall be deemed to forge Forging marks. a mark who either—

(a) without the assent of the owner of the mark makes that mark, or a mark so nearly resembling that mark as to be likely to mislead; or

(b) falsifies any genuine mark, whether by alteration, addition, effacement or otherwise,

and any mark so made or falsified is in this Part referred to as a forged mark :

Provided that in any prosecution for forging a mark the burden of proving the assent of the owner shall lie on the accused.

157. (1) A person shall be deemed to Applying marks and description. apply a mark or trade description to goods who—

(a) applies it to the goods themselves; or

(b) applies it to any covering, label, reel or other thing in or with which the goods are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture; or

term of imprisonment or both may be doubled.

(5) The Magistrate may, whether the alleged offender is convicted or not, order that every chattel, article, instrument or thing by means of or in relation to which the offence has or might have been committed shall be destroyed or declared forfeit to the State or otherwise dealt with as he may think fit.

153. Where an offence under this Code has been committed by a body corporate, every person who at the time of the commission of the offence was a director, general manager, secretary or other similar officer of that body or was obliged to act in any such capacity, shall be deemed to be guilty of such offence, unless he proves that the offence was committed without his consent or connivance and that he exercised all due diligence to prevent the commission of the offence having regard to the nature of his functions in that capacity and to all the circumstances.

Offences by bodies corporate.

154. For the purposes of this Part, the definitions contained in section 97 shall apply, unless the context otherwise requires.

155. (1) The provisions of this Part respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods—

(a) of any such figures, words, marks or arrangement or combination thereof, whether including a registered mark or not, as are likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are;

(b) of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purposes of this Part the expression "false name or initials" means, as applied to any goods, any name or initials of a person which—

(b) to the effect that a registered mark is registered in respect of any goods or services in respect of which it is not registered; or

(c) to the effect that the registration of a mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that a mark is registered if he uses in connexion with the mark the word "registered", or any word or words expressing or implying that registration has been obtained for the mark.

Other offences as to marks and trade descriptions.

152. (1) Any person who —

(a) forges any mark; or

(b) falsely applies to goods any mark or marks so nearly resembling a registered mark as to be likely to mislead, or

(c) makes any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a mark; or

(d) applies any false trade description to goods; or

(e) disposes of, or has in his possession, any die, block, machine, or other instrument for the purpose of forging a mark; or

(f) cause to be done any of the things referred to above in this subsection,

shall, subject to the provisions of this Part, and unless he proves that he acted without intent to defraud, be guilty of an offence.

(2) Any person who sells or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged mark or false trade description is applied, or to which any mark so nearly resembling a registered mark as to be likely to mislead, is falsely applied, as the case may be, shall, unless he proves—

(a) that having taken all reasonable precautions against committing an offence he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, or trade description; and

(b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

(c) that otherwise he had acted innocently,

be guilty of an offence.

(3) Any person who imports any piece-goods ordinarily sold by length or by the piece, manufactured beyond the limits of Sri Lanka, or who sells or exposes for, or has in his possession for, sale, or any purpose of trade, any piece-goods ordinarily sold as aforesaid, whether manufactured within or beyond the limits of Sri Lanka, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres, or in standard metres and a fraction of such a metre, according to the real length of the piece, shall be guilty of an offence :

Provided that nothing in this subsection contained shall apply to any piece-goods manufactured within the limits of Sri Lanka by hand labour only.

(4) Any person found guilty of an offence under this section after trial before a Magistrate shall be liable on conviction to a fine not exceeding twenty thousand rupees or to imprisonment for a term not exceeding two years or to both such fine and such imprisonment, and in the case of a second or subsequent conviction the above fine or

(c) places, encloses, or annexes any goods which are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a mark or trade description has been applied ; or

(d) uses a mark, or trade description in any manner likely to lead to the belief that the goods in connexion with which it is used are designated or described by that mark, or trade description.

(2) The expression " covering " includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper ; and the expression " label " includes any band or ticket.

(3) A mark, or trade description shall be deemed to be applied whether it is woven, impressed, stamped, branded, or otherwise worked into or annexed, or affixed to the goods, or any covering, label, reel, or other thing.

(4) A person shall be deemed to falsely apply to goods a mark who, without the assent of the owner of a mark, applies such mark or any mark so nearly resembling it as to be likely to mislead, but in any prosecution for falsely applying a mark to goods the burden of proving the assent of the owner shall lie on the accused.

Exemption of certain persons employed in ordinary course of business.

158. Where a person is charged with making any die, block, machine, or other instrument for the purpose of forging or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the" case which is, the subject of the

charge he was so employed by some person resident in Sri Lanka, and was not interested in the goods by way of profit or commission dependent on the sale of such goods ; and

(b) that he took reasonable precautions against committing the offence charged ; and

(c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or trade description ; and

(d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the mark or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor unless he has given due notice to him that he will rely on the above defence.

159. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall, prima facie, be deemed to be a description of that country within the meaning of this Part, and the provisions of this Part with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for, sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression " watch " means all that portion of a watch which is not the watch case.

Exemption of certain persons employed in ordinary course of business.

158. Where a person is charged with making any die, block, machine, or other instrument for the purpose of forging or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the" case which is, the subject of the

(c) places, encloses, or annexes any goods which are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a mark or trade description has been applied ; or

(d) uses a mark, or trade description in any manner likely to lead to the belief that the goods in connexion with which it is used are designated or described by that mark, or trade description.

(2) The expression " covering " includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper ; and the expression " label " includes any band or ticket.

(3) A mark, or trade description shall be deemed to be applied whether it is woven, impressed, stamped, branded, or otherwise worked into or annexed, or affixed to the goods, or any covering, label, reel, or other thing.

(4) A person shall be deemed to falsely apply to goods a mark who, without the assent of the owner of a mark, applies such mark or any mark so nearly resembling it as to be likely to mislead, but in any prosecution for falsely applying a mark to goods the burden of proving the assent of the owner shall lie on the accused.

Exemption of certain persons employed in ordinary course of business.

158. Where a person is charged with making any die, block, machine, or other instrument for the purpose of forging or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the" case which is, the subject of the

charge he was so employed by some person resident in Sri Lanka, and was not interested in the goods by way of profit or commission dependent on the sale of such goods ; and

(b) that he took reasonable precautions against committing the offence charged ; and

(c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or trade description ; and

(d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the mark or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor unless he has given due notice to him that he will rely on the above defence.

159. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall, prima facie, be deemed to be a description of that country within the meaning of this Part, and the provisions of this Part with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for, sale, or any purpose of trade or manufacture, goods with a false trade description, shall apply accordingly, and for the purposes of this section the expression " watch " means all that portion of a watch which is not the watch case.

Exemption of certain persons employed in ordinary course of business.

158. Where a person is charged with making any die, block, machine, or other instrument for the purpose of forging or being used for forging, a mark, or with falsely applying to goods any mark or any mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, marks, or as the case may be, to apply marks or descriptions to goods and that in the" case which is, the subject of the

161. In any prosecution for an offence under this Part—

(a) an accused, and his wife or her husband, as the case may be, may, if the accused thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness ;

(b) in the case of imported goods evidence of the port of shipment shall be prima facie evidence of the place or country in which the goods were made or produced.

Punishment of accessories. 162. Any person who, being within Sri Lanka, abets the commission, outside Sri Lanka, of any act which, if committed within Sri Lanka, would under this Part be an offence, shall be deemed guilty of that offence, and be liable to be indicted, proceeded against, tried and convicted in any district or place in Sri Lanka in which he may be as if the offence had been there committed.

Search warrant. 163. (1) Where, upon information of an offence under this part, a Magistrate has issued either a summons requiring the person charged by such information to appear to answer to the same, or a warrant for the arrest of such person, and either the said Magistrate on or after issuing the summons or warrant, or any other Magistrate, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to, which such offence has been committed are in any house or premises of the person charged by such information, or otherwise in his possession or under his control, in any place, such Magistrate may issue a warrant under his hand, by virtue of which it shall be lawful for any police officer, or other person named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search therefor and seize and take away such goods or things ; and any goods or things seized under any such warrant shall be brought before a Magistrate's Court for the purpose of its being determined whether the same are or are not liable to forfeiture under this Part.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Part, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a Magistrate's Court may cause notice to be advertised stating that, unless cause is shown to the contrary at the time, and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows sufficient cause to the contrary, may order such goods or things or any of them to be forfeited, and every such order shall be subject to appeal.

(3) Any goods or things forfeited under this section, or under any other provisions of this Part, may be destroyed or otherwise disposed of in such manner as the Court by which the same are forfeited may direct, and such Court may, out of any proceeds which may be realized by the disposition of such goods (all marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

164. In any prosecution under this Part the Court may order costs to be paid to the accused by the prosecutor or to the prosecutor by the accused, having regard to the information given by, and the conduct of, the accused and prosecutor respectively, and the sum so awarded as costs shall be recoverable as if it were a fine.

165. No prosecution for an offence under this Part shall be commenced after the expiration of three years next after the commission of the offence or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.

166. (1) All goods which, if sold, would be liable to forfeiture under this Part, and also all goods made or produced beyond the limits of Sri Lanka, and having applied thereto any name or mark being, or purporting to be, or being a colourable imitation of, the name or mark of any manufacturer, dealer, or trader in Sri Lanka, unless accompanied in

Lanka, unless such name or mark is accompanied by a definite indication, indicated in letters as large and conspicuous as any letter in the name or mark, of the place and country in which the goods were made or produced, and also all piece-goods such as are ordinarily sold by the length or by the piece, which have not conspicuously stamped in English numerals on each piece the length thereof in standard metres or in standard metres and a fraction of such a metre according to the real length of the piece, are hereby prohibited to be imported into Sri Lanka, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were referred to in section 43 of the Customs Ordinance, and included in Schedule B to that Ordinance.

(2) Before detaining any such goods, or taking any further proceedings with a view to the forfeiture thereof under the law relating to the customs, the Principal Collector of Customs, or other officer specially appointed in that behalf by the Minister in charge of the subject of Finance may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy himself in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

(3) The Principal Collector of Customs may from time to time, with the sanction of the Minister in charge of the subject of Finance, make, revoke, and vary regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of giving such evidence.

(4) Where there is on any goods a name which is identical with, or a colourable imitation of, the name of a place in Sri Lanka, that name unless accompanied in equally large and conspicuous letters by the

name of the country in which such place is situate, shall be treated, for the purposes of this section, as if it were the name of a place in Sri Lanka.

(5) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

(6) The regulations may provide for the informant reimbursing the Principal Collector of Customs all expenses and damages incurred in respect of any detention made on his information and of any proceedings consequent on such detention.

(7) All regulations under this section shall be published in the Gazette.

(8) This section shall have effect as if it formed part of the Customs Ordinance.

167. 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 some 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.

168. Where, on the 2nd day of January, 1980, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Part with respect to false trade descriptions shall not apply to such trade description when so applied :

Provided that where such trade description includes the name of a place or country, and is likely to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this

description includes the name of a place or country, and is likely to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this

Implied warranty on sale of marked goods.

Provisions as to false description not to apply in certain cases.

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, with that name, 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. 169. (1) 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 render liable to 'any prosecution or punishment any servant of a master resident in Sri Lanka who bona fide acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

Cognizable and bailable offences- 170. All offences under this Part are hereby declared to be "cognizable" and "bailable", within the meaning of those terms as defined in the Code of Criminal Procedure Act.

PART VII

MISCELLANEOUS

CHAPTER XXXI

REGULATIONS

Regulations. 171. (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 Code and in particular in respect of any matter required under this Code to be prescribed.

(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 practice 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 ;

(e) all matters which under Parts III, IV and V of this Code have been placed under the direction or control of the Registrar.

(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 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 XXXII

APPLICATIONS TO, AND PROCEEDINGS

BEFORE, THE

REGISTRAR AND COURT

172. (1) The Registrar may, on application in the prescribed manner by or on behalf of the registered owner of an industrial design, patent or mark, correct any error or enter any change—

Correction and rectification of register.

(a) in the name, address or description of the registered owner of any industrial design, patent or mark ; or

(b) concerning any other particulars relating to the registration of an industrial design, patent or mark as may be permitted by regulation.

(2) Subject and without prejudice to other provisions of this Code—

(a) the Court may on the application in the prescribed manner 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 in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion 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, the Registrar may himself apply to the Court under the provisions of this section.

(3) In any proceedings under this Code in which the relief sought includes correction, alteration or rectification of any register, the Registrar 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 Registrar 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 Registrar, as he 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 Registrar relating to the entry in question or the correction, alteration or rectification sought to be made.

173. (1) Where the Registrar is satisfied that any volume of any register kept under this Code 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 Registrar 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 Registrar, 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 regulations providing—

(a) for evidence to be admitted and used by the Registrar in ascertaining the particulars originally contained in the lost or mutilated or damaged folio ;

(b) for the giving of notice by the Registrar 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 reconstructed folio ; and

(d) for the inquiry into any such objections by the Registrar.

(6) Where any folio has been reconstructed by the Registrar in accordance with the preceding

provisions of this section, the Registrar 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 Registrar 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 Code and for that purpose may recall any such certificate and amend the same or issue a fresh certificate in its place.

Certificate of Registrar to be evidence.

174. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorized by this Code 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.

Certified copies to be evidence.

175. Printed, mechanically produced, typed or written copies or extracts, purporting to be certified by the Registrar, or from any document, register, or other book filed or kept under this Code in the Registry shall be admitted in evidence in all Courts in Sri Lanka, and in all proceedings, without further proof or production of the originals.

Mode of giving evidence.

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

(2) In case any part of the evidence is taken *viva voce*, the Registrar 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.

177. Where any discretionary or other power is given to the Registrar by this Code or regulations made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered owner of an industrial design, patent or mark without (if duly required so to do within the prescribed time) giving such applicant or registered owner an opportunity of being heard.

178. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Code, apply to the Attorney-General or Solicitor-General for directions in the matter.

179. Where the registered owner of an industrial design, patent or mark proves that any person is threatening to infringe or has infringed the said industrial design, patent or mark, as the case may be, or is performing acts which make it likely that infringement will occur, the Court may grant an injunction restraining any such person from committing or continuing such infringement or performing such acts and may award damages and such other relief as to the Court appears just and appropriate ;

Provided that the defendant may in the same proceedings request the Court to declare the registration of the said industrial design, patent or mark, as the case may be, or any part of it, null and void, in which event the provisions of sections 57, 58, 95, 96, 130 and 131 shall apply as appropriate.

180. In the absence of any provision to the contrary in a licence contract relating to an industrial design, patent or mark, the licensee may—

- (a) in respect of the threatened infringement, infringement or acts referred to in section 179 request the registered owner of the industrial design, patent or mark to apply for an injunction :

Provided that the licensee shall indicate the threatened infringement, infringement or acts being performed, and specify the relief desired ; and

(b) if the registered owner of the said industrial design, patent or mark refuses or fails to apply for an injunction within three months from 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, even before the expiry of the period of three months, grant an injunction if he proves that immediate action is necessary to avoid substantial damage.

Declaration of non-infringement

181. (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, 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.

(2) The registered owner of the industrial design, patent or mark, 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) Proceedings for a declaration of non-infringement may be instituted concurrently with proceedings to declare the registration of an industrial design, patent or mark 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 and the Civil Procedure Code shall apply to

every application for an injunction made to the Court under this Code.

182. (1) Any person aggrieved by any Appeals decision or order made by the Registrar under any provision of this Code may appeal therefrom to the Court.

(2) In any such appeal the Court shall have and exercise the same discretionary powers as under this Code are conferred upon the Registrar.

(3) Every Judgement or order of the District Court under this Code shall be subject to an appeal to the Court of Appeal and such appeal shall be subject to the same rules which govern interlocutory appeals from District Courts.

183. (1) In all proceedings before the Registrar under this Code, the Registrar 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.

(2) In all proceedings before a Court under this Code, the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

184. The minimum stamp duties chargeable in the District Court in civil proceedings and in the Court of Appeal under the provisions of the enactment for the time being in force relating to stamps shall, so far as the same may be applicable and except as herein otherwise provided, be charged in all proceedings under this Code in the District Court and in the Court of Appeal:

Provided that in no case shall the Registrar be required to use any stamp or be charged with any stamp duty.

185. (1) For the purposes of this Code Fund there shall be established a Fund which shall be maintained in such manner as the Secretary to the Ministry charged with the subject of Trade and the Registrar may direct.

(2) There shall be paid into the Fund two thirds of each and every fee or charge prescribed, levied or recoverable under this Code by the Registrar.

(3) The balance one-third of each and every such fee or charge prescribed, levied or recoverable under this Code by the Registrar shall be paid into the Consolidated Fund.

(4) There shall be paid out of the Fund referred to in subsection (1) all sums of money required to defray any expenditure incurred by the Registrar in the exercise, discharge and performance of his powers, functions and duties under this Code and all such sums of money as are required to be paid out of such Fund by or under this Code or any regulation made thereunder.

(5) The Secretary to the Ministry charged with the subject of Trade shall as soon as possible after the end of each calendar year prepare a report on the administration of the Fund and shall cause to be maintained a full and appropriate account of the Fund in respect of each calendar year.

(6) The Auditor-General shall audit the accounts of the Fund.

(7) The financial year of the Fund shall be the calendar year.

186 In this Code unless the context otherwise requires—

"appointed date" means the 2nd day of January, 1980;

"Central Bank of Ceylon" means the Central Bank of Ceylon established under the Monetary Law Act;

"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 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 the registration thereof;

"Court" means the District Court of Colombo;

"prescribed" means prescribed by this Code or any regulation thereunder.

CHAPTER XXXIII

REPEALS AND SAVINGS

187. (1) The Copyright Ordinance is hereby repealed.

(2) The Copyright Act, 1911, of the Parliament of the United Kingdom or any provision therein contained shall have no application to any right or title acquired in any copyright after the appointed date.

(3) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder, and under section 14 of the Copyright Act, 1911, of the Parliament of the United Kingdom, as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part II of this Code shall be deemed to be a regulation made under this Code, and may be amended, or rescinded by regulations made under this Code.

188. (1) The Designs Ordinance is hereby repealed.

(2) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder as is in force on the appointed date in so far as such, rule or regulation is not inconsistent with the provisions of Part III of this Code shall be deemed to be a regulation made under this Code, and may be amended or rescinded by regulations made under this Code.

(3) The validity of the original entry of a design on the register of designs existing under the repealed Ordinance immediately before the appointed date or on any register of designs which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in

accordance with the law in force at the date of such entry, and every such design shall retain its original date, but for all purposes it shall be deemed to have been registered under Part III of this Code.

189. (1) The Patents Ordinance is hereby repealed.

(2) Notwithstanding the repeal of the aforesaid Ordinance every rule or regulation made thereunder as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part IV of this Code shall be deemed to be a regulation made under this Code, and may be amended or rescinded by regulations made under this Code.

(3) The validity of the original entry of a patent on the register of patents existing under the repealed Ordinance immediately before the appointed date or on any register of patents which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in accordance with the law in force at the date of such entry, and every such patent shall retain its original date, but for all purposes it shall be deemed to have been registered under Part IV of this Code.

(4) The Registrar may in his discretion, notwithstanding anything in any other provision of this Act, issue a certificate under section 76 of this Act in respect of applications made under section 46 of the repealed Ordinance.

190. (1) The Trade Marks Ordinance and the Merchandise Marks Ordinance are hereby repealed.

(2) Notwithstanding the repeal of the aforesaid Ordinances—

(a) every rule or regulation made thereunder as is in force on the appointed date in so far as such rule or regulation is not inconsistent with the provisions of Part V of this Code shall be deemed to be a regulation made under this Code and may be amended or rescinded by regulations made under this Code ;

(b) any trade mark registered in Part B of the Register of Trade Marks by virtue of the provisions of Part III of the repealed Trade Marks Ordinance shall be deemed to be valid and effectual and shall continue to be so registered until such time not exceeding a period of five years from the appointed date, as the owner of such trade mark shall satisfy the Registrar that he is entitled to registration of such trade mark under the provisions of this Code ;

(c) the validity of the original entry of a trade mark on the Register of Trade Marks existing under the repealed Trade Marks Ordinance immediately before the appointed date or on any register of trade marks which was kept under any previous Ordinance and was incorporated with and declared to form part of the first-mentioned register, shall be determined in accordance with the law in force at the date of such entry, and every such trade mark shall retain its original date, but for all purposes it shall be deemed to have been registered under Part V of this Code ;

(d) no trade mark which was on the register at the commencement of the repealed Trade Marks Ordinance and which under that Ordinance was then a registrable trade 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 ;

(e) no trade mark which was on the register immediately before the appointed date 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 ;

Patents :
Repeal of
Patents
Ordinance and
savings.

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1980]

Marks :
Repeal of
Trade Marks
and
Merchandise
Marks
Ordinances
and savings.

Copyright:
Repeal of
Copyright
Ordinance and
savings.

Industrial
Designs:
Repeal of
Designs
Ordinance and
savings

- nothing in Part V shall—
- (i) invalidate the original registration of a trade mark which was validly on the register immediately before the appointed date ; or
 - (ii) subject any person to any liability in respect to any act or thing done before the appointed date to which he would not have been subject under the law in force at the time such act or thing was done—

Additional repeals.

191. The Patents, Designs and Trade Marks (Neuchâtel Agreement) Act, the Patents, Designs, Copyright and Trade Marks (Emergency) Ordinance and the Trade Marks Act, No. 30 of 1964, are hereby repealed.

Additional savings.

192. Notwithstanding the repeal of the Acts and Ordinances referred to in sections 187 to 191—

- (1) every application for registration of an industrial design, patent or mark made to the Registrar before the appointed date shall be deemed to be an application made to the Registrar under Part III, IV or V respectively of this Code, and the Registrar shall deal with such

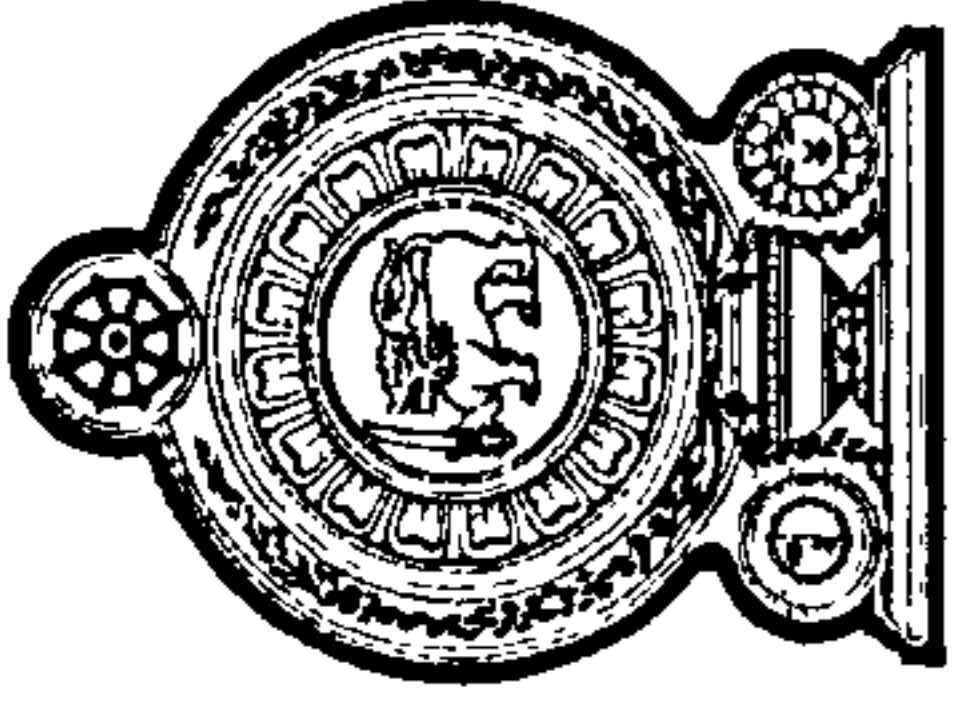
applications under the provisions of this Code applicable to applications made after the appointed date ;

- (2) every action, proceeding or other matter relating to copyright, industrial designs, patents and marks already instituted and pending under the provisions of the repealed Acts and Ordinances in any Court, original or appellate, on the appointed date shall be continued and proceeded with to final judgment, completion and execution under the provisions of the repealed Acts and Ordinances ;

- (3) nothing in Parts III, IV and V of this Code 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 Acts and Ordinances repealed by this 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 appointed date, continue in force and shall, so far as it could have been made, issued, given or done under this Code have effect as if made, issued, given or done under the corresponding provisions of this Code.

APPENDIX (Y)

**EXTRACTS OF THE INTELLECTUAL
PROPERTY ACT, NO.36 OF 2003**



PARLIAMENT OF THE DEMOCRATIC
SOCIALIST REPUBLIC OF
SRI LANKA

INTELLECTUAL PROPERTY
ACT, No. 36 OF 2003

437

[Certified on 12th November, 2003]

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L.D.—O. 54/2002.

AN ACT TO PROVIDE FOR THE LAW RELATING TO INTELLECTUAL PROPERTY AND FOR AN EFFICIENT PROCEDURE FOR THE REGISTRATION, CONTROL AND ADMINISTRATION THERE OF ; TO AMEND THE CUSTOMS ORDINANCE (CHAPTER 235) AND THE HIGH COURT OF THE PROVINCES (SPECIAL) PROVISIONS ACT, No. 10 OF 1996 ; AND TO PROVIDE FOR MATTERS CONNECTED THEREWITH OR INCIDENTAL THERETO

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 Act, No. 36 of 2003. Short title.

PART I

ADMINISTRATION

2. (1) There shall be a person to be or to act as the Director-General of Intellectual Property of Sri Lanka (hereinafter referred to as the “Director-General”). Appointment and powers of the Director-General.

(2) The Director-General shall—

(a) be vested with the power of implementation of the provisions of this Act, the control and superintendence of the registration and administration of Industrial Designs, Patents, Marks and of any other matter as provided by the Act, and the supervision and control of all persons appointed for, or engaged in, the implementation of the provisions of this Act ; and

(b) take all necessary steps to promote and encourage national awareness of the subject of Intellectual Property including copyright and related rights by organisation of exhibitions, contests, seminars and publications and by promoting and encouraging the establishment and proper functioning of organisations or societies to protect and administer copyright and related rights under Part II of the Act.

(3) The Director-General shall comply with the general policy of the government with respect to subject of intellectual property and with any general or special directions issued by the Minister in relation to such policy.

Director and
Deputy Directors.

3. (1) There may from time to time be appointed a fit and proper person or persons, to be or to act as Director of Intellectual Property and such other Deputy Directors for the proper implementation and administration of the provisions of this Act.

(2) Any person so appointed may exercise, perform and discharge any power, duty or function expressly conferred or imposed upon the Director or the Deputy directors, as the case may be, and may, subject to the directions of the Minister and under the authority and control of the Director-General, exercise, perform and discharge any power, duty or function conferred or imposed upon the Director-General by or under this Act.

(3) There shall be appointed such other officers and servants as may be necessary for the administration of the Act.

Office and
maintenance of
registers.

4. (1) There shall be an office called the National Intellectual Property Office of Sri Lanka (hereinafter referred to as the "Office"). Such office shall be the sole office in Sri Lanka for the registration and administration of Industrial designs, patents, marks and any other matter as provided by the Act.

(2) All registers required to be kept and maintained under the provisions of this Act shall be kept and maintained under the supervision of the Director-General at the Office and such registers shall be the only legally recognized registers in Sri Lanka for the registration of industrial designs, patents, marks and any other matter as provided by the Act.

PART II

CHAPTER I

COPYRIGHT

5. For the purposes of this Part—

Interpretation.

“audiovisual work” means a work that consists of a series of related images which impart the impression of motion, with or without accompanying sounds, susceptible of being made visible, and where accompanied by sounds susceptible of being made audible ;

“author” means the physical person who has created the work ;

“broadcasting” means the communication of a work, a performance or a sound recording to the public by wireless transmission, including transmission by satellite ;

“collective work” means a work created by two or more physical persons at the initiative and under the direction of a physical person or legal entity, with the understanding that it will be disclosed by the latter person or entity under his or its own name and that the identity of the contributing physical persons will not be indicated ;

“communication to the public” means the transmission to the public by wire or without wire of the images or sounds, or both, of a work, a performance or a sound recording including the making available to the public of a work, performance or sound recording in such a way that members of the public may access them from a place and at a time individually chosen by them ;

“computer” means an electronic or similar device having information processing capabilities ;

“computer program” is a set of instructions expressed in words, codes, schemes or in any other form, which is capable, when incorporated in a medium that the computer can read, of causing a computer to perform or achieve a particular task or result ;

“economic rights” means the rights referred to in section 9 ;

“expression of folklore” means a group oriented and tradition based creation of groups or individuals reflecting the expectation of the community as an adequate expression of its cultural and social identity, its standards and values as transmitted orally, by imitation or by other means, including :

- (a) folktales, folk poetry, and folk riddles ;
- (b) folk songs and instrumental folk music ;
- (c) folk dances and folk plays ;
- (d) productions of folk arts in particular, drawings, paintings, carvings, sculptures, pottery, terracotta, mosaic, woodwork, metalware, jewellery, handicrafts, costumes, and indigenous textiles ;

“infringement” means an act that violated any right protected under this Part ;

“moral rights” means rights referred to in section 10 ;

“performers” means singers, musicians, and other persons who sing, deliver, declaim, play in, or otherwise perform, literary or artistic works or expressions of folklore ;

“photographic work” means the recording of light or other radiation on any medium on which an image is produced or from which an image may be produced, irrespective of the technique (chemical, electronic or other) by which such recording is made, a still picture extracted from an audiovisual work shall not be considered a “photographic work” but a part of the audiovisual work concerned ;

“producer” of an audiovisual work or a sound recording means the physical person or legal entity that undertakes the initiative and responsibility for the making of the audiovisual work or sound recording ;

“public display” means the showing of the original or a copy of a work—

- (a) directly ;
- (b) by means of a film, slide, television image or otherwise on screen ;
- (c) by means of any other device or process ; or
- (d) in the case of an audiovisual work, the showing of individual images nonsequentially at a place or places where persons outside the normal circle of a family and its closest social acquaintances are or can be present, irrespective of whether they are or can be present at the same place and time or at different places or times, and where the work can be displayed without communication to the public within the meaning of the definition of the expression “Communication to the Public” ;

“public lending” means the transfer of the possession of the original or a copy of a work or a sound recording for a limited period of time for non-profit making purposes, by an institution, the services of which are available to the public, such as a public library or archives ;

“public performance” means—

- (a) in the case of a work other than an audiovisual work, the recitation, playing, dancing, acting or otherwise performing the work in public either directly or by means of any device or process ;
- (b) in the case of an audiovisual work, the showing of images in sequence or the making of accompanying sound audible in public ; and
- (c) in the case of a sound recording, making the recording sounds audible at a place or at places where persons outside the normal circle of the family and its closest acquaintances are or can be present, irrespective of whether they are or can be present at the same place and time, or at different places or times, and where the performance can be perceived without the need for communication to the public within the meaning of the definition of the expression “communication to the public” ;

“published” means a work or a sound recording—

- (a) copies of which have been made available to the public in a reasonable quantity for sale, rental, public lending or for transfer of the ownership or the possession of the copies ;
or
- (b) which has been made available to the public by means of an electronic system :

Provided that, in the case of a work, the making available to the public took place with the consent of the owner of the copyright, and in the case of a sound recording, with the consent of, the producer of the sound recording or his successor in title ;

“rental” means the transfer of the possession of the original or a copy of a work or sound recording for a limited period of time for profit making purposes ;

“reproduction” means the making of one or more copies of a work or sound recording in any material form, including any permanent or temporary storage of a work or sound recording in electronic form ;

“sound recording” means any exclusively aural fixation of the sounds of a performance or of other sounds, regardless of the method by which the sounds are fixed or the medium in which the sounds are embodied ; it does not include a fixation of sounds and images, such as the sounds incorporated in an audiovisual work ;

“work” means any literary, artistic or scientific work referred to in section 6 ;

“work of applied art” means an artistic creation with utilitarian functions or incorporated in a useful article, whether made by hand or produced on an industrial scale ;

“work of joint authorship” means a work to the creation of which two or more authors have contributed, provided the work does not qualify as “a collective work”.

Works protected.

6. (1) The following works shall be protected as literary, artistic or scientific work (hereinafter referred to as “works”) which are original intellectual creations in the literary, artistic and scientific domain, including and in particular—

- (a) books, pamphlets, articles, computer programs and other writings ;
- (b) speeches, lectures, addresses, sermons and other oral works ;

- (c) dramatic, dramatic-musical works, pantomimes, choreographic works and other works created for stage productions ;
- (d) stage production of works specified in paragraph (c) and expressions of folklore that are apt for such productions ;
- (e) musical works, with or without accompanying words ;
- (f) audiovisual works ;
- (g) works of architecture ;
- (h) works of drawing, painting, sculpture, engraving, litho-graphy, tapestry and other works of fine art ;
- (j) photographic works ;
- (k) works of applied art ;
- (l) illustrations, maps, plans, sketches and three dimensional works relative to geography, topography, architecture or science.

(2) The works specified in subsection (1) of this section shall be protected by the sole fact of their creation and irrespective of their mode or form of expression, as well as of their content, quality and purpose.

Derivative works. 7. (1) The following shall also be protected as works :—

- (a) translations, adaptations, arrangements and other transformations or modifications of works ; and
- (b) collections of works and collections of mere data (data bases), whether in machine readable or other form, provided that such collections are original by reason of the selection, co-ordination or arrangement of their contents.

(2) The protection of any work referred to in subsection (1) shall be without prejudice to any protection of a pre-existing work incorporated in, or utilized for, the making of such a work.

8. Notwithstanding the provisions of sections 6 and 7, no protection shall be extended under this Part —

Works not protected.

- (a) to any idea, procedure, system, method of operation, concept, principle, discovery or mere data, even if expressed, described, explained, illustrated or embodied in a work ;
- (b) to any official text of a legislative, administrative or legal nature, as well as any official translation thereof ;
- (c) to news of the day published, broadcast, or publicly communicated by any other means.

9. (1) Subject to the provisions of sections 11 to 13 the owner of copyright of a work shall have the exclusive right to carry out or to authorize the following acts in relation to the work —

Economic rights.

- (a) reproduction of the work ;
- (b) translation of the work ;
- (c) adaptation, arrangement or other transformation of the work ;
- (d) the public distribution of the original and each copy of the work by sale, rental, export or otherwise ;
- (e) rental of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer program, a data base or a musical work in the form of notation, irrespective of the ownership of the original or copy concerned ;

- (f) importation of copies of the work, (even where the imported copies were made with the authorization of the owner of the copyright) ;
- (g) public display of the original or a copy of the work ;
- (h) public performance of the work ;
- (j) broadcasting of the work ; and
- (k) other communication to the public of the work.

(2) The provisions of subsection (1) of this section shall apply to both the entire work and a substantial part thereof.

(3) The rights of rental in terms of paragraph (e) of subsection (1) shall not apply to rental of computer programs where the program itself is not the essential object of the rental.

(4) Notwithstanding the provisions of paragraph (d) of subsection (1), the owner of a work or a copy of a work lawfully made or any person authorized in that behalf by such owner, is entitled without the authority of the owner of the copyright, to sell or otherwise dispose of that copy.

Moral Rights.

10. (1) The author of a work shall independently of his economic rights and even where he is no longer the owner of those economic rights, have the following rights :—

- (a) to have his name indicated prominently on the copies and in connection with any public use of his work, as far as practicable ;
- (b) the right to use a pseudonym and not have his name indicated on the copies and in connection with any public use of his work ;
- (c) to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, his work which would be prejudicial to his honour or reputation.

(2) No right mentioned in subsection (1) shall be transmissible during the life time of the author, however on the death of the author, the right to exercise any of those rights shall be transmissible by testamentary disposition or by operation of law.

(3) The author may waive any of the moral rights mentioned in subsection (1), provided that such a waiver is in writing and clearly specifies the right or rights waived and the circumstances to which the waiver applies :

Provided that where any waiver of the rights under paragraph (c) of subsection (1) specifies the nature and extent of the modification or other action in respect of which the right is waived, subsequent to the death of the author, the physical person or legal entity upon whom or which the moral rights have devolved shall have the right to waive the said rights.

11. (1) Notwithstanding the provisions of subsection (1) of section 9, the fair use of a work, including such use by reproduction in copies or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship or research, shall not be an infringement of copyright.

Fair use.

(2) The following factors shall be considered in determining whether the use made of a work in any particular case is fair use :—

- (a) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes ;
- (b) the nature of the copyrighted work ;
- (c) the amount and substantiality of the portion used in relation to the copyrighted work as a whole ; and
- (d) the effect of the use upon the potential market for, or value of, the copyrighted work.

(3) The acts of fair use shall include the circumstances specified in section 12.

Act of fair use.

12. (1) Notwithstanding anything contained in paragraph (a) of subsection (1) of section 9 and subject to the provisions of subsection (2) of this section, the private reproduction of a published work in a single copy shall be permitted without the authorization of the owner of the copyright, where the reproduction is made by a physical person from a lawful copy of such work exclusively for his own personal purposes.

(2) The permission under subsection (1) of this section shall not be extended to the reproduction—

- (a) of a work of architecture in the form of a building or other constructions ;
- (b) in the form of reprography of the whole or a substantial part of a book or of a musical work in the form of notations ;
- (c) of the whole or a substantial part of a data base ;
- (d) of a computer program, except as provided in subsection (7) ; and
- (e) of any work, in case the reproduction would conflict with a normal exploitation of the work or would otherwise unreasonably prejudice the legitimate interests of the owner of the copyright.

(3) Notwithstanding the provisions of paragraph (a) of subsection (1) of section 9, the reproduction, in the form of a quotation, of a short part of a published work shall be permitted without authorization of the owner of copyright :

Provided that the reproduction is compatible with fair practice and does not exceed the extent justified by the purpose of such reproduction. The quotation shall be accompanied by an indication of the source and the name of the author, if his name appears in the work from which the quotation is taken.

(4) Notwithstanding the provisions of paragraph (a) of subsection (1) of section 9, the following acts shall be permitted without the authorization of the owner of the copyright :—

(a) the reproduction of a short part of a published work for teaching purposes by way of illustration, in writing or sound or visual recordings, provided that the reproduction is compatible with fair practice and does not exceed the extent justified by the purpose of such reproduction;

(b) the reprographic reproduction for face to face teaching in any educational institution the activities of which do not serve direct or indirect commercial gain, of published articles, other short works or short extracts of works, to the extent justified by the purpose, provided that the act of reproduction is an isolated one occurring, if repeated, on separate and unrelated occasions :

Provided however the source of the work reproduced and the name of the author shall be indicated as far as practicable on all copies made under this subsection.

(5) Notwithstanding the provisions of paragraph (a) of subsection (1) of section 9, any library or archives, whose activities do not serve any direct or indirect commercial gain may, without the authorization of the owner of copyright, make a single copy of the work by reprographic reproduction—

(a) where the work reproduced is a published article, other short work or short extract of a work, and where the purpose of the reproduction is to satisfy the request of a physical person :

Provided that—

- (i) the library or archives is satisfied that the copy will be used solely for the purposes of study, scholarship or private research,

(ii) the act of reproduction is an isolated occurrence, occurring if repeated, on separate and unrelated occasions ;

(b) where the copy is made in order to preserve and, if necessary replace a copy, or to replace a copy which has been lost, destroyed or rendered unusable in the permanent collection of another similar library or archives :

Provided that it is not possible to obtain such a copy under reasonable conditions ; and

Provided further, that the act of reprographic reproduction is an isolated occurrence occurring if repeated, on separate and unrelated occasions.

(6) Notwithstanding the provisions of paragraphs (a), (h) and (j) of subsection (1) of section 9, and subject to the condition that the source and the name of the author is indicated as far as practicable, the following acts shall be permitted in respect of a work without the authorization of the owner of copyright—

(a) the reproduction in a newspaper or periodical, manner of broadcasting or other manner of communication to the public, of an article published in a newspaper or periodical on current economic, political or religious topics or a broadcast or communication relating to the same, and such permission shall not apply where the right to authorize reproduction, broadcasting or other communication to the public is expressly reserved on the copies, by the owner of copyright, or in connection with broadcasting or other communication to the public of the work ;

(b) for the purpose of reporting current events, the reproduction and the broadcasting or other communication to the public of short excerpts of a

work seen or heard in the course of such events, to the extent that it is justified by the purpose of such reproduction;

(c) the reproduction in a newspaper or periodical, broadcasting or other manner of communication to the public, of a political speech, a lecture, address, sermon or other work of a similar nature delivered in public, or a speech delivered during legal proceedings, to the extent that it is justified by reason of the fact of providing current information.

(7) (a) Notwithstanding anything contained in paragraphs(a) and (c) of subsection (1) of section 9, reproduction in a single copy or the adaptation of a computer program by the lawful owner of a copy of that computer program, shall be permitted without the authorization of the owner of copyright provided that the copy or adaptation is necessary—

(i) for use of the computer program with a computer for the purpose and extent for which the computer program has been obtained ;

(ii) for archival purposes and for replacement of the lawfully owned copy of the computer program in the event that the said copy of the computer program is lost, destroyed or rendered unusable.

(b) No copy or adaptation of a computer program shall be used for any purpose other than those specified in paragraph (a), and any such copy or adaptation shall be destroyed in the event that continued possession of the copy of the computer program ceases to be lawful.

(8) Notwithstanding the provisions of paragraph (f) of subsection (1) of section 9, the importation of a copy of a work by a physical person for his own personal purposes shall be permitted without the authorization of the owner of copyright.

(9) Notwithstanding anything contained in paragraph (g) of subsection (1) of section 9, the public display of originals or copies of works shall be permitted without the authorization of the owner of copyright :

Provided that the display is made other than by means of a film, slide, television image or otherwise on screen or by means of any other device or process :

Provided further, the work has been published or the original or the copy displayed has been sold, given away or otherwise transferred to another person by the author or his successor in title.

(10) Notwithstanding anything contained in this Part, the following shall not be an infringement of copyright :—

(a) the performance or display of a work for educational or teaching purposes by government or non profit educational institutions, in classrooms or similar places set aside for education :

Provided that, in the case of an audiovisual work, the performance or the display of individual images, is given by means of a lawfully made copy, or the person responsible for the performance did not know or had no reason to believe that the copy was not lawfully made.

(b) the communication of a transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus, of a kind commonly used in private homes, unless —

- (i) a direct charge is made to see or hear the transmission ; or
- (ii) the transmission thus received is further transmitted to the public.

13. (1) Subject to the provisions of subsections (2), (3), (4) and (5), the economic and moral rights shall be protected during the life time of the author and for a further period of seventy years from the date of his death.

Duration of
copyright.

(2) In the case of a work of joint authorship, the economic and moral rights shall be protected during the life of the last surviving author and for a further period of seventy years from the date of the death of the last surviving author.

(3) In the case of a collective work, other than a work of applied art, and in the case of an audiovisual work, the economic and moral rights shall be protected for seventy years from the date on which the work was first published, or failing publication within seventy years from the making of the work.

(4) In the case of a work published anonymously or under a pseudonym, the economic and moral rights shall be protected for seventy years from the date on which the work was first published :

Provided that, where the author's identity is revealed or is no longer in doubt before the expiration of the said period, the provisions of subsection (1) or subsection (2) shall apply, as the case may require.

(5) In the case of work of applied art, the economic and moral rights shall be protected for twenty-five years from the date of the making of the work.

(6) Every period provided for under the preceding subsections shall run to the end of the calendar year in which it would otherwise expire.

14. (1) Subject to the provisions of subsections (2), (3), (4) and (5), of this section, the author who created the work shall be the original owner of economic rights.

Original
ownership of
economic rights.

(2) In respect of a work of joint authorship, the co-authors shall be the original owners of the economic rights. If, however, a work of joint authorship consists of parts that can be used separately and the author of each part can be identified, the author of each part shall be the original owner of the economic rights in respect of the part that he has created.

(3) In respect of a collective work, the physical person or legal entity at the initiative, and under the direction, of whom or which the work has been created shall be the original owner of the economic rights.

(4) In respect of a work created by an author employed by a physical person or legal entity in the course of his employment, the original owner of the economic rights shall, unless provided otherwise by way of a contract, be the employer. If the work is created pursuant to a commission, the original owner of economic rights shall be, unless otherwise provided in a contract, the person who commissioned the work.

(5) In respect of an audiovisual work, the original owner of the economic rights shall be the producer, unless otherwise provided in a contract. The co-authors of the audiovisual work and the authors of the pre-existing works, included in, or adapted for, the making of the audiovisual work shall, however, maintain their economic rights in their contributions or pre-existing works, respectively, to the extent that those contributions or pre-existing works can be the subject of acts covered by their economic rights separately from the audiovisual work.

Presumption of authorship and of representation of the author.

15. (1) The physical person whose name is indicated as the author on a work in the usual manner shall, in the absence of proof to the contrary, be presumed to be the author of the work. The provisions of this section shall be applicable even if the name is a pseudonym, where the pseudonym leaves no doubt as to the identity of the author.

(2) The physical person or legal entity whose name appears on an audio-visual work shall, in the absence of proof to the contrary, be presumed to be the producer of the said work.

16. (1) The owner of a copyright may -

(a) grant licence to a physical person or legal entity to carry out all or any of the acts relating to the economic rights referred to in section 9 ;

(b) assign or transfer in whole or any part of the economic rights referred to in section 9.

(2) Any assignment or transfer of an economic right, and any licence to do such an act subject to authorization by the owner of the copyright, shall be in writing signed by the assignor and the assignee, transferor and the transferee or by the licensor and the licensee, as the case may be.

(3) An assignment or transfer in whole or in part of any economic right, or a licence to do an act subject to authorization by the owner of copyright, shall not include or be deemed to include the assignment or transfer or licence in respect of any other rights not expressly referred to therein.

CHAPTER II

RELATED RIGHTS

[PROTECTION OF RIGHTS OF PERFORMERS, PRODUCERS OF SOUND RECORDING AND BROADCASTING ORGANIZATION]

17. (1) Subject to the provisions of section 21, a performer shall have exclusive right to carry out or to authorize any of the following acts :—

Rights requiring authorization of performers.

(a) the broadcasting or other communication to the public of his performance or a substantial part thereof, except where the broadcasting, or the other communication—

(i) is made from a fixation of the performance, other than a fixation made in terms of section 21 ; or

(ii) is a re-broadcasting, made or authorized by the organisation initially broadcasting the performance or substantial part thereof ;

(b) the fixation of his unfixd performance or substantial part thereof ;

(c) the reproduction of a fixation of his performance or substantial part thereof.

(2) Once the performer has authorized the incorporation of his performance in a audiovisual fixation, the provisions of subsection (1) shall have no further application.

(3) Nothing in this section shall be construed to deprive performers of the right to enter into contracts in respect of their performances on terms and conditions more favourable to them.

(4) The rights under this section shall be protected from the moment the performance takes place until the end of the fiftieth calendar year following the year in which the performance takes place.

18. (1) Subject to the provisions of section 21, a producer of a sound recording shall have the exclusive right to carry out or to authorize any of the following acts :—

(a) the direct or indirect reproduction of the sound recording or substantial part thereof ;

(b) the importation of copies of the sound recording or a substantial part thereof even where such imported copies were made with the authorisation of the producer ;

(c) the adaptation or other transformation of the sound recording or a substantial part thereof ;

(d) the rental of a copy of the sound recording or a substantial part thereof, irrespective of the ownership of the copy rented ;

(e) the sale or offering for sale to the public of the original or copies of the sound recording or substantial part thereof.

(2) The rights under subsection (1) of this section shall be protected from the date of publication of the sound recording until the end of the fiftieth calendar year following the year of publication, or if the sound recording has not been published, from the date of fixation of the sound recording until the end of fiftieth calendar year following the year of fixation.

19. (1) where a sound recording published for commercial purposes, or a reproduction of such sound recording, is used directly for broadcasting or other form of communication to the public, or is publicly performed, a single equitable remuneration for the performer or performers and the producer of the sound recording shall be paid by the user.

(2) Unless otherwise agreed between the performer or the producer, half of the sum received by the producer under subsection (1) shall be paid by the producer to any performer.

(3) The right to an equitable remuneration under this section shall subsist from the date of publication of the sound recording until the end of the fiftieth calendar year following the year of publication, or if the sound recording has not been published, from the date of fixation of the sound recording until the end of the fiftieth calendar year following the year of fixation.

20. (1) Subject to the provisions of section 21, a broadcasting organisation shall have the exclusive right to carry out or to authorize any of followings acts :—

(a) the re-broadcasting of its broadcast or a substantial part thereof ;

(b) the communication to the public of its broadcast or a substantial part thereof ;

Equitable remuneration for use of sound recordings.

Rights of broadcasting organisation.

- (c) the fixation of its broadcast or a substantial part thereof ;
 - (d) the reproduction of a fixation of its broadcast or a substantial part thereof.
- (2) The rights under this section shall be protected from the moment when the broadcasting takes place until the end of the fiftieth calendar year following the year in which broadcast takes place.

Limitations on protection.

21. Sections 17, 18, 19 and 20 shall not apply where the acts referred to in those sections are related to—

- (a) the use by a physical person exclusively for his own personal purposes ;
- (b) using short excerpts for reporting current events to the extent justified by the purpose of providing current information ;
- (c) use solely for the purpose of face to face teaching activities or for scientific research ;
- (d) cases where, under copyright, a work can be used without the authorization of the owner of copyright.

Enforcement of rights and disputes resolution.

22. (1) Any person who infringes or is about to infringe any of the rights protected under this Part may be prohibited from doing so by way of an injunction and be liable to damages. The owner of such rights is entitled to seek such other remedy as the court may deem fit.

(2) (a) The Court shall have power and jurisdiction—

- (i) to grant such injunctions to prohibit the commission of any act of, infringement or the continued commission of such acts of infringement of any right protected under this Part ;

(ii) to order the impounding of copies of works or sound recordings suspected of being made sold, rented or imported without the authorization of the owner of any right protected under this Part where the making, selling, renting or importation of copies is subject to such authorization, as well as the impounding of the packaging of, the implements that could be used for the making of, and the documents, accounts or business papers, referring to, such copies.

(b) The Court shall in addition have the jurisdiction to order the payment by the infringer, of damages for the loss suffered as a consequence of the act of infringement, as well as the payment of expenses caused by the infringement, including legal costs. The amount of damages shall be fixed taking into account *inter alia*, the importance of the material and moral prejudice suffered by the owner of the right, as well as the importance of the infringer's profits attributable to the infringement. Where the infringer did not know or had no reasonable cause to know that he or it was engaged in infringing activity, the court may limit damages to the profits of the infringer attributable to the infringement or to pre established damages.

(c) The Court shall have the authority to order the destruction or other reasonable manner of disposing of copies made in infringement of any right protected under this Part if available and their packaging outside the channels of commerce in such a manner as would avoid harm to the owner of the rights, unless he requests otherwise. The provisions of this section shall not be applicable to copies and their packaging which were acquired by a third party in good faith.

(d) Where there is a danger that implements may be used to commit or continue to commit acts of infringement, the Court shall, whenever and to the extent that it is reasonable, order their destruction or other reasonable manner of disposing of the same outside the channels of commerce in such a manner as to minimize the risks of further infringements, including surrender to the owner of the rights.

(e) Where there is a danger that acts of infringement may be continued, the court shall make such orders as may be necessary prevent such acts being committed.

(f) The provisions of Chapter XXXV of this Act relating to infringement and remedies shall apply, *mutatis mutandis*, to rights protected under this Part.

(g) Any person who infringes or attempts to infringe any of the rights protected under this Part shall be guilty of an offence and on conviction be liable to any penalty as provided for in Chapters XXXVIII and XLI of the Act.

(3) (a) The Director-General may on an application being made in the prescribed form and manner by a person aggrieved by any of his rights under this Part being infringed or in any other manner affected, and after such inquiry as he thinks fit determine any question that may be necessary or expedient to determine in connection with such application and such decision shall be binding on the parties subject to the provisions of paragraph (b) of this subsection.

(b) Any person aggrieved by the decision of the Director-General may make an appeal to the Court and unless the Court issues an interim order staying the operation of the decision of the Director-General, such decision shall continue to be in force until the matter is decided by the Court.

23. (1) The following acts shall be considered unlawful and in the application of section 22 shall be assimilated to infringements of the rights of the owner of copyright :—

- (i) the manufacture or importation for sale or rental of any device or means specifically designed or adapted to circumvent any device or means intended to prevent or restrict reproduction of a work or to impair the quality of copies made (the latter device or means hereinafter referred to as “copy protection or copy management device or means”);

(ii) the manufacture or importation for sale or rental of any device or means that is susceptible to enable or assist the reception of an encrypted program, which is broadcast or otherwise communicated to the public, including reception by satellite, by those who are not entitled to receive the program.

(2) In the application of section 22, any illicit device and means mentioned in subsection (1) of this section shall be assimilated to infringing copies of works.

(3) The owner of copyright in a work shall also be entitled to the damages for infringement provided for in section 22 where—

(a) authorized copies of the work have been made and offered for sale or rental in an electronic form combined with a copy protection or copy management device or means, and a device or means specifically designed or adapted to circumvent the said device or means, made or imported for sale or rental;

(b) the work is authorised for inclusion in an encrypted program, broadcast or otherwise communicated to the public, including by satellite, and a device or means enabling or assisting the reception of the program by those who are not entitled to receive the program made or imported, for sale or rental.

24. (1) Subject to the provision of subsection (4) of this section expressions of folklore shall be protected against—

- (a) reproduction ;
- (b) communication to the public by performance, broadcasting, distribution by cable or other means ;
- (c) adaptation, translation and other transformation, when such expressions are made either for commercial purposes or outside their traditional or customary context.

Protection of expressions of folklore and damages.

Measures, remedies and sanctions against abuses in respect of technical means.

(2) The rights conferred by subsection (1) of this section shall not apply where the acts referred to therein are related to –

- (a) the use by a physical person exclusively for his own personal purposes ;
- (b) using short excerpts for reporting current events to the extent justified by the purpose of providing current information ;
- (c) the use solely for the purpose of face to face teaching or for scientific research ;
- (d) instances referred to in sections 11 and 12, where a work can be used without the authorization of the owner of copyright.

(3) In all printed publications, and in connection with any communication to the public of any identifiable expression of folklore, its source shall be indicated in an appropriate manner and in conformity with fair practice by mentioning the community or place from where the expression utilized has been derived.

(4) The right to authorize acts referred to in subsection (1) of this section shall subject to the payment of a prescribed fee, vest in a Competent authority to be determined by the Minister.

(5) The money collected under subsection (4) shall be used for purposes of cultural development.

(6) Any person who, without the permission of the Competent Authority referred to in subsection (4), uses an expression of folklore in a manner not permitted by this section shall be in contravention of the provisions of this section and shall be liable to damages, and be subject to an injunctions and any other remedy as the Court may deem fit to award in the circumstances.

25. (1) (a) No person or body of persons corporate or unincorporate shall, after the coming into operation of this Act, commence or carry on the business of issuing or granting licences in respect of any right protected under this Part except under or in accordance with, the provisions of paragraph (c) of this subsection :

Provided that the owner of such right shall, in his individual capacity, continue to have the right to grant licences in respect of his own rights. Where such owner is a member of a society registered under this section the grant of such licences shall be consistent with his obligations as a member of such society.

(b) Any body of persons corporate or unincorporate which fulfils such conditions as may be prescribed, apply to the Director-General for permission to engage in the business specified in paragraph (a) and register the society.

(c) The Director-General may having regard to the interests of the owners of the rights protected under this Part, the interests and convenience of the public and in particular of the groups of persons who are most likely to seek licences in respect of relevant rights and the ability and professional competence of the applicant to grant permission to commence or carry on business specified in paragraph (a) of subsection (1) and register such person or body of persons as a collective society subject to such conditions as may be prescribed :

Provided that the Director-General shall not ordinarily register more than one such society to do business in respect of the same class of rights.

(d) The Director-General may, if he is satisfied that the society is being managed in a manner detrimental to the interests of the owners of rights concerned, cancel or suspend the registration of the society and the permission to commence or carry on business as specified in paragraph (a) of this subsection, after such inquiry as may be necessary.

Registration of society, administration of rights by societies, control over the rights and submission of report.

(e) The Director-General may by order cancel or suspend the registration of such society and the permission to carry on business pending inquiry for such period not exceeding one year as may be specified in such order under paragraph (d) of this subsection.

(f) Where the Director-General suspends the registration of a society, he shall thereupon appoint an administrator to carry out the functions of the society.

(2) (a) Subject to such conditions as may be prescribed—

(i) a society may accept from an owner of the rights exclusive authorization to administer any right under this Part by the issue of licences or collection of licence fees or both ; and

(ii) an owner of the rights shall have the right to withdraw such authorization without prejudice to the rights of the society under any contract between such owner and society.

(b) It shall be competent for a society to enter into any agreement with any foreign society or organization administering rights corresponding to the rights protected under this Part, and to entrust to such foreign society or organization the administration in any foreign country of rights administered by the said society in Sri Lanka, or for administering in Sri Lanka the rights administered in a foreign country by such foreign society or organization :

Provided that no such society or organization shall permit any discrimination in regard to the terms of a licence or the distribution of fees collected in connection with the rights protected under this Part and in such foreign country.

(c) Subject to such conditions as may be prescribed, a society may —

(i) issue licences in respect of any rights protected under this Part ;

(ii) collect fees in pursuance of such licences ;

(iii) distribute such fees among owners of rights after making deductions for its own expenses ;

(iv) perform any other functions consistent with the provisions of subsection (4).

(3) (a) Every society shall be subject to the collective control of the owners of rights under this Part whose rights are administered in such a manner as may be prescribed in order to —

(i) obtain the approval of such owners of rights for its procedures of collection and distribution of fees ;

(ii) obtain their approval for the utilization of any amounts collected as fees for any purpose other than distribution to the owner of rights ; and

(iii) provide to such owners regular, full and detailed information concerning all its activities, in relation to the administration of their rights.

(b) All fees distributed among the owners of rights shall, as far as may be, be distributed in proportion to the actual use of their works.

(4) (a) Every Society shall submit to the Director-General such returns as may be prescribed.

(b) The Director-General may call for any report or records of any society for the purpose of satisfying himself that the fees collected by the society in respect of the rights administered by it are being utilized or distributed in accordance with the provisions of this Part.

26. (1) The provisions of this Part in respect of the protection of literary, artistic or scientific works shall apply to —

Scope of application.

(a) works of authors who are nationals of, or have their habitual residence in, Sri Lanka ; and

(b) works first published in Sri Lanka, works first published in another country and hereupon published in Sri Lanka, within thirty days from such publication, irrespective of the nationality or residence of the author.

(2) The provisions of this Part shall also apply to works that are protected in Sri Lanka by virtue of, and in accordance with, any international convention or any international agreement to which Sri Lanka is a party.

Protection of performers.

27. (1) The provisions of this Part in respect of protection of performers shall apply to—

- (a) performers who are nationals of Sri Lanka ;
- (b) performers who are not nationals of Sri Lanka but whose performances :—

- (i) take place on the territory of Sri Lanka ; or
- (ii) are incorporated in sound recordings that are protected under this Part ; or
- (iii) have not been fixed in a sound recording but are included in broadcasts qualifying for protection under this Part.

(2) The provisions of this Part on the protection of sound recordings, shall apply to —

- (a) sound recordings the producers of which, are nationals of Sri Lanka ;
- (b) sound recordings first fixed in Sri Lanka ; and
- (c) sound recordings first published in Sri Lanka.

(3) The provisions of this Part on the protection of broadcasts shall apply to—

- (a) broadcasts of broadcasting organisations where the registered office of such organisations are situated in Sri Lanka ; and

(b) broadcasts transmitted from transmitters situated in Sri Lanka.

(4) The provisions of this Part shall in addition apply to performers, producers of sound recordings and broadcasting organisations protected by virtue of, and in accordance with, any international convention or any international agreement to which Sri Lanka is a party.

PART III

CHAPTER III

INDUSTRIAL DESIGNS

SCOPE OF THIS PART AND DEFINITIONS

28. The protection of industrial designs provided under this Part shall be in addition to and not in derogation of any other protection provided under any other written law, in particular under Part II of this Act.

Conditions for protection.

29. The protection provided under this Part shall—

Scope of this Part.

- (a) apply only to new industrial designs ;
- (b) not apply to an industrial design which consists of any scandalous design or is contrary to morality or public order or public interest or which, in the opinion of the Director-General or of any Court to which such matter has been referred to is likely to offend the religious or racial susceptibilities of any community.

30. For the purposes of this Part any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, that gives a special appearance to a product of industry or handicraft and is capable of serving as a pattern for a product of industry or handicraft shall be deemed to be an industrial design :

Definition of industrial design.

PART V
CHAPTER XIX

MARKS AND TRADE NAMES

101. For the purposes of this Part, unless the context otherwise requires—

“certification mark” means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics ;

“collective mark” means any visible sign designated as such and serving to distinguish the origin or any other common characteristic of goods or services of different enterprises which use the mark under the control of the registered owner ;

“enterprise” means any business, industry or other activity carried on by an individual, partnership, company, or co-operative society wherever registered or incorporated and whether registered or not under any law for the time being in force relating to companies, co-operative societies or businesses engaged in or proposing to engage in any business and includes any business undertaking of the Government or any State Corporation whether carrying on business in Sri Lanka or otherwise ;

“false trade description” means a trade description which is false or misleading in a material respect as regards the goods or services to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement or otherwise, where that alteration makes the description false or misleading in a material respect,

and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Part ;

“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 anything which is the subject of trade, manufacture or merchandise and includes services ;

“indication of source” means any expression or sign used to indicate that a product or service originates in a given country or group of countries, region, or locality ;

“mark” means a trade mark or service mark ;

“name” includes any abbreviation of a name ;

“person” means manufacturer, dealer, trader or owner and includes any body of persons, corporate or unincorporate ;

“service mark” means any visible sign serving to distinguish the services of one enterprise from those of an other enterprise ;

“trade description” means any description, statement or other indication, direct or indirect—

(a) as to the number, quantity, measure, gauge, or weight of any goods ; or

(b) as to the place or country in which any goods were made or produced ; or

- (c) as to the mode of manufacturing or producing any goods ; or
- (d) as to the material of which any goods are composed ; or
- (e) as to any goods being the subject of an existing copyright, related rights, industrial design or patent or any other matter protected under this Act ; or
- (f) as to the quality, kind or nature of the services ; or
- (g) as to the standard of quality of any goods, according to a classification commonly used or recognized in the trade ; or
- (h) as to the fitness for purpose, strength, performance or behaviour of any goods, and the use of any figure, word or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters shall be deemed to be a trade description within the meaning of this Part ;

“trade mark” means any visible sign serving to distinguish the goods of one enterprise from those of another enterprise ; and

“trade name” means the name or designation identifying the enterprise of a natural or legal person.

CHAPTER XX

ADMISSIBILITY OF MARKS

Admissibility of marks.

102. (1) The exclusive right to a mark conferred by this Part shall be acquired, subject to the succeeding provisions, by registration.
- (2) Registration of a mark may be granted to the person who—

- (a) is the first to fulfill the conditions of a valid application ; or
- (b) is the first to validly claim the earliest priority for his application :

Provided however such mark shall not be inadmissible under sections 103 and 104.

- (3) A mark may consist in particular, of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, selvedges, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

Marks inadmissible on objective grounds.

103. (1) A mark shall not be registered—
- (a) which consists of shapes or forms imposed by the inherent nature of the goods or services or by their industrial function ;
- (b) which consists exclusively of a sign or indication which may serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production, or of supply, of the goods or services concerned ;

- (c) which consists exclusively of a sign or indication which has become, in the current language or in the *bona fide* and established practices of trade in Sri Lanka, a customary designation of the goods or services concerned ;
- (d) which, is incapable of distinguishing the goods or services of one enterprise from those of another enterprise ;
- (e) which consists of any scandalous design or is contrary to morality or public order or which, in the opinion of the Director-General or of any court to which the matter may be referred to, as the case may be, is likely to offend the religious or racial susceptibilities of any community ;
- (f) which is likely to mislead trade circles or the public as to the nature, the source, geographical indication the manufacturing process, the characteristics, or the suitability for their purposes, of the goods or services concerned ;
- (g) which does not represent in a special or particular manner the name of an individual or enterprise ;
- (h) which is, according to its ordinary signification, a geographical name or surname ;
- (i) which reproduces or imitates armorial bearings, flags or other emblems, initials, names or abbreviated names of any State or any inter-governmental international organization or any organization created by international convention, unless authorized by the Competent Authority of that State or international organization ;
- (j) which reproduces or imitates official signs or hall-marks of a State, unless authorized by the Competent Authority of that State ;

- (k) which resembles in such a way as to be likely to mislead the public, a mark or a collective mark or a certification mark the registration of which has expired and has not been renewed during a period of two years preceding the filing of the application for the registration of the mark in question or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding the filing of the application for the mark in question ;
- (l) the registration of which has been sought in respect of goods or services the trading of which is prohibited in Sri Lanka ;
- (m) which consists of any other word or definition as may be prescribed.
- (2) The Director-General shall in applying the provisions of paragraphs (b), (c), (d), (f), (g) and (h), of subsection (1), have regard to all the factual circumstances and, in particular, the length of time the mark has been in use in Sri Lanka or in other countries and the fact that the mark is held to be distinctive in other countries or in trade circles.

Marks
inadmissible by
reason of third-
party rights.

104. (1) The Director-General shall not register a mark —

- (a) which resembles, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a third party, or subsequently filed by a person validly claiming priority, in respect of identical or similar goods or services in connection with which the use of such mark may be likely to mislead the public ;
- (b) which resembles, in such a way as to be likely to mislead the public, an unregistered mark used earlier in Sri Lanka by a third party in connection with identical or similar goods or services, if the applicant is aware, or could not have been unaware, of such use ;

- (c) which resembles, in such a way as to be likely to mislead the public, a trade name already used in Sri Lanka by a third party, if the applicant is aware, or could not have been unaware, of such use ;
- (d) if it is identical with, or misleadingly similar to, or constitutes or translation or transliteration or transcription of a mark or trade name which is well known in Sri Lanka for identical or similar goods or services of a third party, or such mark or trade name is well known and registered in Sri Lanka for goods or services which are not identical or similar to these in respect of which registration is applied for, provided in the latter case the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well known mark and that the interests of the owner of the well known mark are likely to be damaged by such use ;
- (e) which infringes other third party rights or is contrary to the provisions of Chapter XXXII relating to the prevention of unfair competition ;
- (f) which is filed by the agent or a representative of a third party who is the owner of such mark in another country, without the authorization of such owner, unless the agent or representative justifies his action.

(2) The following criteria shall be taken into account in determining whether a mark is well known :—

- (i) particular facts and circumstances relating to each mark ;
- (ii) any fact or circumstance from which it may be inferred that the mark is well known ;
- (iii) the degree of knowledge or recognition of the mark of the relevant sector of the public ;
- (iv) the duration, extent and geographical area of use of the mark ;

- (v) the duration, extent and geographical area of promotion of the mark, including advertising or publicity and the presentation at any fair or exhibition of the goods or services to which the mark applies ;
- (vi) the duration and geographical area of the registration or the application for registration, of the mark, to the extent that they reflect use or recognition of the mark ;
- (vii) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark has been recognized as being well known, by the Competent Authority ;
- (viii) the value associated with the mark ;
- (ix) the criteria specified in this subsection to determine whether a mark is well known or not shall not be exclusive nor exhaustive ;
- (x) for the purpose of this subsection —
 - (a) “Competent Authority” means an administrative, judicial or quasi-judicial authority which is competent, to determine whether a mark is well known mark or to enforce the protection given to a well known mark ;
 - (b) “relevant sector of public” includes :—
 - (i) actual or potential consumers of the types of goods or services to which the mark applies ;
 - (ii) persons involved in channels of distribution of the types of goods or services to which the mark applies ;
 - (iii) any person or a body of persons dealing with the type of goods or services to which the mark applies.

(3) The Director-General shall, in applying the provisions of paragraphs (a) to (e) of subsection (1), have regard to the fact that the third parties referred to therein have consented to the registration of such mark.

105. There shall not be entered in the register a notice of any Trust expressed, implied, or constructive, nor shall any such notice be receivable by the Director-General.

Trust not to be entered in register.

CHAPTER XXI

REQUIREMENTS OF APPLICATION AND PROCEDURE FOR REGISTRATION

106. (1) An application for registration of a mark shall be made to the Director-General in the prescribed form and shall contain —

Requirements of application.

- (a) a request for the registration of the mark ;
- (b) the name, address of the applicant and, if he is resident outside Sri Lanka, a postal address for service in Sri Lanka ;
- (c) five copies of a representation of the mark ;
- (d) a clear and complete list of the particular goods or services in respect of which registration of the mark is requested, with an indication of the corresponding class or classes in the international classification, as may be prescribed.

(2) Where the application is filed through an agent, it shall be accompanied by a power of attorney granted to such agent by the applicant.

107. An applicant for registration of a mark who wishes to avail himself of the priority of an earlier application filed in a Convention country shall, within six months of the date of such earlier application, append to his application a written declaration indicating the date and number of the earlier application, the name of the applicant and the country in

Right of priority.

which he or his predecessor in title filed such application and shall, within a period of three months from the date of the later application filed in Sri Lanka, furnish a copy of the earlier application certified as correct by the appropriate authority of the country where such earlier application was filed.

Temporary protection of mark exhibited at international exhibition.

108. (1) An applicant for registration of a mark who has exhibited goods bearing the mark or rendered services under the mark at an official or officially recognized international exhibition and who applies for registration of the mark within six months from the date on which the goods bearing the mark or services under the mark were first exhibited or services respectively at such exhibition, shall on request, be deemed to have applied for registration of that mark on the date on which the goods bearing the mark or the services rendered under the mark were first exhibited or rendered at such exhibition.

(2) Evidence of the exhibition of the goods bearing the mark or the services rendered under the mark shall be by a certificate issued by the appropriate Authority of the exhibition stating the date on which the mark was first used at such exhibition in connection with such goods or services.

(3) The provisions of subsections (1) and (2) shall not extend to any other period of priority claimed by the applicant.

Application fee.

109. An application for registration of a mark shall not be entertained unless the prescribed fee has been paid to the Director-General.

Examination of application as to form.

110. (1) The Director-General shall examine whether the applicant for registration of the mark satisfies the requirements specified in sections 106 and 109 and where applicable the provisions of sections 107 and 108.

(2) Where the applicant fails to comply with the provision of sections 106 and 109, the Director-General shall refuse to register the mark :

Provided however the Director-General shall first notify the applicant of any defect in the application and shall afford him an opportunity to rectify such defect within three months from the date of receipt of such notification.

(3) The date on which the applicant rectifies such defect shall be deemed to be the date of receipt of the application for registration.

(4) Where the applicant fails to comply with the provisions of section 107 or 108, the Director-General shall not, in connection with the registration of the mark, make any reference to the priority claimed.

(5) Where the applicant complies with the provisions of sections 107 and 108, the Director-General shall in connection with the registration of the mark record the priority claimed or the date of the certified use of the mark at an international exhibition.

(6) Where the Director-General refuses to register a mark, he shall, if so requested by the applicant, state in writing the grounds of his decision.

111. (1) Where the applicant complies with the provisions of sections 106 and 109, the Director-General shall examine the mark in relation to the provisions of sections 103 and 104.

Registration of
mark after further
examination and
publication of
mark.

(2) Where the mark is inadmissible under section 103 or 104 the Director-General shall notify the applicant accordingly stating in writing the grounds on which registration of the mark is refused.

(3) Where the applicant is dissatisfied with all or any of the grounds stated by the Director-General in the notification referred to in subsection (2) he may, within a period of one month from the date of such notification, make his submissions against such refusal to the Director-General, in writing.

(4) On receipt of any submissions the Director-General may inform the applicant that he has been granted a hearing and the date, time and place of such hearing.

(5) The Director-General may, after such inquiry as he thinks fit, refuse to accept the application for registration of the mark, or may accept it absolutely or subject to conditions, amendments or modifications, or to such limitations, if any, as to the mode or place of user or otherwise as he may think fit to impose.

(6) In case of any refusal or conditional acceptance of an application for registration of a mark, the Director-General shall, if required by the applicant within a period of three months from such refusal or conditional acceptance, state in writing the grounds of his decision.

(7) Where the Director-General is of the opinion that the mark is admissible under section 103 or 104 he may request the applicant to pay the prescribed fee within a prescribed period for publication of the application.

(8) The Director-General shall refuse registration of the mark where the fee for publication of the application is not paid within the prescribed period.

(9) (a) If the fee for publication is paid within the prescribed period the Director-General shall proceed to publish the application setting out the date of application, the representation of the mark, the goods or services in respect of which registration of the mark is requested with an indication of the corresponding class or classes, the name and address of the applicant and, if the applicant is resident outside Sri Lanka, a postal address for service in Sri Lanka, the priority claimed, if any, or the date of certified use of the mark at an international exhibition.

(b) Notwithstanding the provisions of subsections (7), (8) and paragraph (a) of this subsection relating to the prescribed fee and the publication, the Director-General may, at his discretion, require the applicant by notice in writing to publish an application as referred to in paragraph (a) of this subsection. Where the applicant fails or neglects to publish such application within a period of three months from the date of such notice the application may be refused.

(10) Where any person considers that the mark is inadmissible on one or more of the grounds specified in section 103 or 104 he may, within a period of three months from the date of publication of the application, give to the Director-General in the prescribed form, and together with the prescribed fee, notice of opposition to such registration stating his grounds of opposition accompanied by evidence to substantiate such grounds.

(11) Where notice of opposition has not been received by the Director-General within the period specified in subsection (10) of this section, the Director-General shall register the mark.

(12) Where, within the period specified in subsection (10) of this section notice of grounds of opposition in the prescribed form is received by the Director-General, together with the prescribed fee, he shall serve a copy of such grounds of opposition on the applicant and shall request him to present his observations on those grounds in writing accompanied by evidence to support his application within a period of three months.

(13) On receipt of the observations of the applicant the Director-General shall after hearing the parties, if he considers such hearing necessary, decide, as expeditiously as possible, whether such mark should be registered or not. If the Director-General decides that the mark can be registered, then if —

(a) no appeal is preferred against his decision, upon the expiry of the period within which an appeal may be preferred against his decision ;

(b) an appeal is preferred against his decision, upon the determination of such appeal,

the Director-General shall accordingly register such mark.

(14) The Director-General may allow a reasonable extension of the prescribed period within which any act has to be done or any fee has to be paid under this section.

112. Where, by reason of default on the part of the applicant, the registration of a mark is not completed within twelve months from the date of receipt by the Director-General of the application, the Director-General shall, after giving notice of non-completion to the applicant in writing in the prescribed form, treat the application as abandoned, unless it is completed within the time specified in that behalf in such notice.

Non completion of registration.

113. (1) The Director-General shall keep and maintain a register called the "Register of Marks" wherein shall be recorded in the order of their registration, all registered marks and such other matters relating to marks as are authorized or directed by this Part to be so recorded or may from time to time be prescribed.

Register of marks and issue of certificate.

(2) The registration of a mark shall include a representation of the mark and shall specify its number, the name and address of the registered owner and, if the registered owner's address is outside Sri Lanka, a postal address for service in Sri Lanka, the dates of application and registration ; if priority is validly claimed, an indication of that fact and the number, date and country of the application on the basis of which the priority is claimed, if a valid certificate has been filed relating to the use of a mark at an international exhibition, the contents of such certificate, the list of goods and services in respect of which registration of the mark has been granted with an indication of the corresponding class or classes.

(3) Upon the registration of a mark the Director-General shall issue to the registered owner thereof a certificate of registration and shall, at the request of the registered owner, send such certificate to him by registered post to his last recorded postal address in Sri Lanka, or if he is resident outside Sri Lanka to his last recorded postal address in Sri Lanka.

114. The Director-General shall cause to be published in the Gazette, in the prescribed form, all registered marks in the order of their registration, including in respect of each mark so published reference to such particulars as may be prescribed.

Publication of registered marks.

115. Any person may examine the register and may obtain certified extracts therefrom on payment of the prescribed fee.

Examination of register and certified copies.

116. Where application is made for the registration of a mark identical with or so closely resembling a mark of the applicant already on the register for the same goods or services, the same description of goods or services as to be likely to mislead or cause confusion if used by a person other than the applicant, the Director-General may require as a condition of registration that such marks shall be entered on the register as associated marks.

Associated marks.

117. Associated marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate marks :

Assignment and user of associated marks.

Provided that where under the provisions of this Part user of a registered mark is required to be proved for any purpose, the Director-General may, in so far as is considered necessary accept the user of an associated registered mark, or of the mark, with additions or alterations not substantially affecting its identity, as an equivalent for such user.

CHAPTER XXII

DURATION OF REGISTRATION OF A MARK

118. (1) Subject and without prejudice to the other provisions of this Part, registration of a mark shall expire ten years after the date of registration of such mark.

Duration of registration.

(2) A mark when registered shall be registered with reference to the date of receipt of the application for registration by the Director-General, and such date shall be deemed for the purposes of this Part to be the date of registration.

Renewal.

119. (1) Registration of a mark may be renewed for consecutive periods of ten years each on payment of the prescribed fee.

(2) Renewal of registration of a mark shall not be subject to any further examination of the mark by the Director-General or to opposition by any person.

(3) The renewal fee shall be paid within the twelve months preceding the date of expiration of the period of registration :

Provided, however, that a period of grace of six months shall be allowed for the payment of the fee after the date of such expiration, upon payment of such surcharge as may be prescribed.

(4) The Director-General shall record in the register and cause to be published in the Gazette in the prescribed form all renewals of registration specifying any removal from the lists of goods or services.

(5) Where the renewal fee has not been paid within such period or such extended period specified in subsection (3), the Director-General shall remove the mark from the register.

Alteration of registered mark.

120. The registered owner of any mark may apply in the prescribed manner and with prescribed fee to the Director-General for leave to add to or alter such mark in any manner not substantially affecting the identity of the same, and the Director-General may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of use as he may think fit. If leave be granted, the mark as altered shall be published in the prescribed manner.

CHAPTER XXIII

RIGHTS OF THE REGISTERED OWNER OF A MARK

121. (1) Subject and without prejudice to the other provisions of this Part, the registered owner of a mark shall have the following exclusive rights in relation to the mark :—

- (a) to use the mark ;
- (b) to assign or transmit the registration of the mark ;
- (c) to conclude licence contracts.

(2) Without the consent of the registered owner of the mark third parties are precluded from the following acts :—

- (a) any use of the mark, or a sign resembling it in such a way as to be likely to mislead the public, for goods or services in respect of which the mark is registered or for similar goods or services in connection with which the use of the mark or sign is likely to mislead the public ; and
- (b) any other use of the mark, or of a sign or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interests of the registered owner of the mark.

(3) The application (whether by way of printing, painting or otherwise) or the affixing in Sri Lanka by a third party, of a mark or any sign resembling such mark in such a way as to be likely to mislead the public, on or in connection with, goods in respect of which such mark has been registered (whether such goods are intended for sale in Sri Lanka, or for export from Sri Lanka) shall be deemed to be an act prohibited under Subsection (2).

(4) The court shall presume the likelihood of misleading the public in instances where a person uses a mark identical to the registered mark for identical goods or services in respect of which the mark is registered.

Limitation of registered owners' rights.

122. The registration of the mark shall not confer on its registered owner the right to preclude third parties —

- (a) from using their *bona fide* names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin or time of production or of supply of their goods and services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services ;
- (b) from using the mark in relation to goods lawfully manufactured, imported, offered for sale, sold, used or stocked in Sri Lanka under that mark, provided that such goods have not undergone any change.

CHAPTER XXIV

ASSIGNMENT AND TRANSMISSION OF APPLICATIONS AND REGISTRATIONS OF MARKS

Assignment and transmission of applications and registrations.

123. (1) An application for registration or the registration of a mark may be assigned or transmitted independently of the transfer of all or part of the enterprise using the mark, in respect of all or part of the goods or services for which the application was filed or the mark registered and such assignment or transmission shall be in writing signed by or on behalf of the contracting parties.

(2) Such assignment or transmission shall be invalid if the purpose or effect thereof is to mislead the public, in particular in respect of the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark is applied.

(3) Any person becoming entitled by assignment or transmission to an application for registration or the registration of a mark may apply to the Director-General in the prescribed manner to have such assignment or transmission recorded in the register.

(4) No such assignment or transmission shall be recorded in the register unless the prescribed fee has been paid to the Director-General.

(5) No such assignment or transmission shall have effect against third parties unless so recorded in the register.

CHAPTER XXV

LICENCE CONTRACTS

124. (1) For the purposes of this Part licence contract means any contract by which the registered owner of a mark (hereinafter referred to as "the licensor") grants to another person or enterprise (hereinafter referred to as "the licensee") a licence to use the mark for all or part of the goods or services in respect of which the mark is registered.

(2) Use of the mark by the licensee shall be deemed to be use of the mark by the registered owner.

462

125. (1) A licence contract shall be in writing signed by or on behalf of the contracting parties.

(2) Upon a request in writing signed by or on behalf of the contracting parties, the Director-General shall, on payment of the prescribed fee, record in the register such particulars relating to the contract as the parties thereto might wish to have recorded :

Provided that the parties shall not be required to disclose or have recorded any other particulars relating to such contract.

126. In the absence of any provision to the contrary in the licence contract, the licensee shall -

(a) be entitled to use the mark within the territory of Sri Lanka, during the entire period of registration of the mark, including renewals, in respect of all the goods or services for which the mark is registered ;

(b) not be entitled to assign or transmit his rights under the licence contract or grant sub-licences to third parties.

127. (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant further licences to third parties in respect of the same mark or himself use the mark.

(2) Where the licence contract provides the licence to be exclusive, the licensor shall not grant further licences to third parties in respect of the same mark or himself use the mark unless the contract otherwise provides.

Nullity of licence contract and certain clauses.

128. (1) A licence contract shall be null and void in the absence of stipulations ensuring effective control by the licensor of the quality of the goods or services in respect of which the mark may be used.

(2) Any clause or condition in a licence contract shall be null and void in so far as it imposes upon the licensee restrictions not derived from the rights conferred by this Part on the registered owner of the mark, or which are unnecessary for the safeguarding of such rights :

Provided that -

(a) restrictions concerning the scope, extent, duration of use of the mark or the geographical area in or the quality or quantity of the goods or services in connection with which the mark may be used ;

(b) restrictions justified by the stipulations referred to in subsection (1) ; and

(c) obligations imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the mark,

shall not be deemed to constitute a restrictions as mentioned above.

Interpretation.

Form and record of licence contract.

Rights of licensee.

129. The Court may on the application of any person showing a legitimate interest, or of any Authority including the Director-General, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, annul and cancel the said contract if—

- (a) the licensor has lost effective control over the quality of the goods or services in respect of which the mark is used;
- (b) the licensee has used the mark in such a way as to mislead or confuse the public.

130. (1) Where the Director-General has reasonable cause to believe that any licence contract or any amendment or renewal thereof—

- (a) which involves the payment of royalties abroad ; or
- (b) which by reason of other circumstances relating to such licence contract,

is detrimental to the economic development of Sri Lanka he shall in writing communicate such fact to the Governor of the Central Bank and transmit all papers in his custody relevant to a decision on such matter, to the Governor of the Central Bank.

(2) Where the Governor of the Central Bank on receipt of any communication under subsection (1) informs the Director-General in writing that the said licence contract or any amendment or renewal thereof is detrimental to the economic development of Sri Lanka the Director-General shall cancel and invalidate the record of such contract in the register.

(3) The provisions of this section shall, *mutatis mutandis*, apply to assignments and transmissions.

(4) The provisions of this Chapter shall, *mutatis mutandis*, apply to sub-licences.

Effect of nullity of registration on licence contract.

131. Where, before the expiration of the licence contract, the registration is declared null and void, the licensee shall no longer be required to make any payment to the licensor under the licence contract, and shall be entitled to repayment of the payments already made :

Provided that the licensor shall not be required to make any repayment, or shall be required to make repayment only in part, to the extent that he can prove that any such repayment would be inequitable under all the circumstances, in particular if the licensee has effectively profited from the licence.

Expiry, termination or invalidation of licence contract.

132. The Director-General shall —
- (a) if he is satisfied that a licence contract recorded under subsection (2) of section 125 has expired or been terminated, record that fact in the register upon a request made in writing to that effect signed by or on behalf of the parties thereto ;
 - (b) record in the register the expiry, termination, annulment or invalidation of a licence contract under any provision of this Part.

CHAPTER XXVI

RENUNCIATION AND NULLITY OF REGISTRATION OF A MARK

Renunciation of registration.

133. (1) The registered owner of a mark may renounce the registration, either wholly or in respect of part of the goods or services for which the mark is registered, by a declaration in writing signed by him or on his behalf and forwarded to the Director-General.

(2) The Director-General shall, on receipt of the said declaration, record it in the register and cause such record to be published in the Gazette.

(3) The renunciation shall take effect from the date that the Director-General receives the said declaration.

(4) Where a licence contract in respect of a mark is recorded in the register the Director-General shall not, in the absence of provision to the contrary in such licence contract, accept or record the said renunciation except upon receipt of a signed declaration by which any assignee, licensee or sub-licensee on record consents to the renunciation, unless his consent is expressly waived in the licence contract.

134. (1) The Court may on the application of any person showing a legitimate interest, or of any competent Authority including the Director-General, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, declare the registration of the mark null and void if its registration is precluded under the provisions of sections 103 and 104 :

Provided, however, that grounds of nullity which do not exist on the date of the application to Court, shall not be taken into account.

(2) Where the grounds for nullity of registration of the mark exist in respect of only part of the goods or services for which the mark is registered, nullity of the registration shall be declared for that part only for such goods or services.

(3) An application for a declaration of nullity based on any of the grounds specified in subsection (1) of section 104 shall be made within five years from the date of issue of the certificate of registration under subsection (3) of section 113.

135. (1) Upon a final decision of the Court declaring total or partial nullity of registration of a mark, the registration shall be deemed to have been null and void totally or partially, as the case may be, from the date of such registration.

(2) When a declaration of nullity becomes final the Registrar of the Court shall notify the Director-General of such fact and he shall record the said declaration in the register and cause it to be published in the Gazette.

CHAPTER XXVII

REMOVAL OF MARK

Removal of mark.

136. (1) The Court may on the application of any person showing a legitimate interest, or of any Competent Authority including the Director-General, to which the registered owner of the mark and every assignee, licensee or sub-licensee on record shall be made party, remove any registered mark from the register—

(a) if the registered owner has, without valid grounds, failed to use the mark within Sri Lanka or cause it to be used within Sri Lanka by virtue of a licence, during five consecutive years immediately preceding the date of the application to Court ;

(b) if the registered owner has caused, provoked or tolerated the transformation of the mark into a generic name for one or more of the goods or services in respect of which the mark is registered so that in trade circles and in the eyes of the public its significance as a mark has been lost.

(2) In any application under paragraph (a) of subsection (1) the Court may take into account the fact that non-use of the mark was due to circumstances beyond the control of the registered owner. The Court shall not take into account the lack of funds of the registered owner as a ground for non-use of the mark.

(3) The use of a mark—

(a) in a form differing, in elements which do not alter the distinctive character of the mark, from the form in which it was registered, shall not be a ground for removal of the mark ;

(b) in connection with one or more of the goods or services belonging to any given class in respect of which the mark is registered, shall suffice to prevent the removal of the mark in respect of all the other goods or services of the same class.

137. Upon a final decision of the Court in respect of removing any registered mark from the register—

- (1) the Court may, taking into account the date of the events and other circumstances which occasioned the removal of the mark, determine the date on which the registration of the mark shall be deemed to have ceased to have any legal effect ;
- (2) the Registrar of the Court shall communicate the decision of the Court to the Director-General who shall, if the Court decides that the mark be removed, enter in the register a record of such removal and cause the decision of Court to be published in the Gazette.

CHAPTER XXVIII

COLLECTIVE MARKS

138. (1) Subject to the provisions of this Chapter the provisions relating to marks shall apply to collective marks.

(2) In relation to a collective mark, the reference in section 101 (signs of which a trade mark or service mark may consist) to distinguish goods or services of one enterprise from those of other enterprises shall be construed as a reference to distinguish goods or services of the enterprise which uses the collective mark from those of other enterprises.

(3) Notwithstanding the provisions of section 103 a collective mark may be registered which consists of a sign or indication which may serve, in trade, to indicate the geographical origin of the goods or services :

Provided, however, the owner of such a mark shall not be entitled to prohibit the use of such sign or indication in accordance with honest practices in industrial or commercial matters and in particular, by a person who is entitled to use a geographical name.

Application for registration of collective marks.

139. (1) An application for registration of a collective mark shall not be entertained unless in such application the mark is designated as a collective mark and the application is accompanied by a copy of conditions governing the use of the mark duly certified by the applicant.

(2) The conditions governing the use of the mark under subsection (1) shall define the common characteristics or quality of the goods or services which the collective mark shall designate, the conditions in which, and the person by whom it may be used, the exercise of effective control of the use of the mark and proper sanctions against the use of the mark contrary to such conditions. They shall contain further prescribed requirements under this section.

(3) A collective mark shall not be registered unless the conditions governing the use of the mark—

- (a) comply with the provisions of subsection (2) and any requirement imposed by any regulation made thereunder ;
- (b) are not contrary to public policy or accepted principles of morality.

(4) (a) An authorised user shall, subject to any agreement to the contrary between him and registered owner of the collective mark, be entitled to require the owner to take infringement proceedings in respect of any matter which affects his interests.

(b) If the owner—

- (i) refuses to do so ; or
- (ii) fails to do so within two months after being called upon to do so,

the authorised user may bring the proceedings in his own name as if he was the owner. The registered owner shall be made party to the action.

(c) In infringement proceedings brought by the owner of a registered collective mark, any loss suffered or likely to be suffered by any authorised user shall be taken into consideration by Court.

(5) The registration of the collective mark may be removed on the following grounds in addition to the grounds specified in section 136 :—

- (i) that the manner in which the mark has been used by the owner has caused it to become liable to mislead the public to understand or think that the mark has state patronage ;
- (ii) that the owner has failed to observe, or to secure the observance of, the conditions governing use of the mark ; or
- (iii) that an amendment of the conditions has been made so that the conditions—
 - (a) no longer comply with subsection (2) and any other condition imposed by regulation made under this Act ; or
 - (b) are contrary to public policy or to the accepted principles of morality.

(6) The registration of a collective mark shall be declared null and void in addition to the grounds of nullity specified in section 134 if it was registered in violation of the provisions of subsections (1), (2) and (3) of section 139.

140. (1) Registration of a collective mark shall be in such Part of the register as the Director-General may decide and a copy of the conditions governing the use of the mark shall be appended to the registration.

(2) The publication of an application for a collective mark in accordance with subsection (9) of section 111 shall include a summary of the conditions to be appended to the registration.

(3) When a collective mark, is registered under subsection (1) it shall be deemed in all respects to be a registered mark.

(4) The conditions governing the use of a registered collective mark shall be open for public inspection in the same way as the register.

Changes in condition governing the use of collective marks.

141. (1) The registered owner of a collective mark shall notify the Director-General in the prescribed manner of any change or amendments effected in the conditions governing the use of the collective mark.

(2) Any notification of such change or amendment shall be recorded in the register on payment of the prescribed fee. Any such change or amendment in the condition shall be effectual only if they have been recorded.

(3) The Director-General shall cause a summary of such changes and amendments made in the conditions and recorded under subsection (2) to be published in the Gazette.

CHAPTER XXIX

CERTIFICATION MARKS

Certification marks.

142. (1) Subject to the provisions of this Chapter, provisions relating to marks shall apply to certification marks.

(2) In relation to a certification mark the reference in section 101 (signs of which a trade mark or service mark may consist) to distinguish goods or services of one enterprise from those of another enterprise shall be construed as a reference to distinguish goods or services which are certified from those which are not certified.

(3) Notwithstanding the provisions of section 103, a certification mark which consists of a sign or indication which may serve in trade to designate the geographical origin of the goods and services may be registered :

Provided, however, the owner of such mark is not entitled to prohibit the use of such sign or indication in accordance with honest practices in industrial or commercial matters and in particular by a person who is entitled to use a geographical name.

(4) An application for registration of a certification mark shall not be filed unless in the application the mark is designated as a certification mark and is accompanied by a copy of the conditions governing the use of the mark duly certified by the applicant.

(5) The conditions shall indicate the name of the person authorised to use the mark, the characteristics to be certified by the mark, how the owner is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes. They may in addition contain further prescribed requirements under this section.

(6) A certification mark shall not be registered—

- (a) if the owner of the certification mark carries on a business involving the supply of goods or services of the kind certified; and
- (b) unless the conditions governing the use of the mark,—
 - (i) comply with the provisions of subsection (5) and any other requirement imposed by regulations made under that subsection; and
 - (ii) are not contrary to public policy or accepted principles of morality.

(7) In infringement proceedings brought by the owner of the registered certification mark any loss suffered, or likely to be suffered, by any authorised user shall be taken into account; and the Court may give such directions as it thinks fit as to the extent to which the owner is to hold the proceeds of any pecuniary remedy on behalf of such users.

(8) Apart from the grounds of removal of a mark provided for in section 136, the registration of a certification mark may be removed on the ground—

- (a) that the owner has commenced such a business as is mentioned in paragraph (a) of subsection (6);
- (b) that the manner in which the mark has been used by the owner has caused it to become liable to mislead the public as to the character of significance of the mark;
- (c) that the owner has failed to observe, or to secure observance of, the conditions governing the use of the mark;
- (d) that the owner is no longer competent to certify the goods or services for which the mark is registered;
- (e) that an amendment of the conditions have been made so that the conditions—
 - (i) no longer comply with the provisions of subsection (5) and any other condition imposed by regulations;
 - (ii) are contrary to public policy and order or to the accepted principles of morality.

(9) Apart from the grounds of nullity provided in section 134 the registration of a certification mark may be declared null and void if it was registered contrary to the provisions of subsections (3), (4) and (5).

(10) (a) Registration of a certification mark shall be in such part of the register as the Director-General may decide, and a copy of the conditions, governing the use of the mark, shall be appended to such registration.

(b) The publication of an application of a certification mark shall be in accordance with subsection (9) of section 111, which shall include a summary of the conditions to be appended to the registration.

(c) A certification mark registered under subsection (4) shall be deemed for all purposes to be a registered mark.

(d) The conditions governing the use of a certification mark shall be open for public inspection in the same manner as the register.

(11) (a) The registered owner of a certification mark shall notify the Director-General in prescribed manner of any changes or amendments effected to the conditions governing the use of the mark.

(b) Any notification of such changes and amendments shall be recorded in the register on the payment of prescribed fee. Any change or amendment of conditions shall come into force only if they have been so recorded.

(c) The Director-General shall cause to be published in the Gazette a summary of the changes or amendments so recorded in the register.

PART VI

CHAPTER XXX

TRADE NAMES

143. A name or designation shall not be admissible as a trade name if, by reason of its nature or the uses to which it may be put, it is contrary to morality or public order or is likely to offend the religious or racial susceptibilities of any community or is likely to mislead trade circles or the public as to the nature of the enterprise identified by that name.

Prohibited trade names.

Protection of trade name.

144. (1) Notwithstanding the provisions of any written law providing for the registration of a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party.

(2) Any subsequent use of a trade name by a third party, whether as a trade name or as a trade mark, service mark, collective mark or certification mark or any such use of similar trade name, trade mark, service mark or collective mark or certification mark likely to mislead the public shall be deemed to be unlawful.

(3) Section 122 of this Act shall apply to trade names.

Assignment and transmission of trade names.

145. (1) A trade name may be assigned or transmitted together with the assignment or transmission of the enterprise or part of the enterprise identified by that name.

(2) The provisions of section 123 shall apply, *mutatis mutandis*, to trade names.

PART VII

CHAPTER XXXI

LAYOUT DESIGNS OF INTEGRATED CIRCUITS

Right to protection.

146. (1) The right to protection of a layout design shall belong to the creator of layout design. Where several persons have jointly created a layout design such persons shall be co-owners of the right to protection.

(2) The right to protection of a layout design made or created in the performance of a contract of employment or in the execution of a work shall, unless the terms of such contract of employment or contract for the execution of such work otherwise provides, belong to the employer or the person who commissioned the work, as the case may be.

Interpretation.

159. In this Part unless the context otherwise requires—

“integrated circuit” means a product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of material and which is intended to perform an electronic function ;

“layout design” is synonymous with “topography” and means the three dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture ;

“right holder” means the natural person who, or the legal entity which, is to be regarded as the beneficiary of the protection referred to in section 146.

PART VIII

CHAPTER XXXII

UNFAIR COMPETITION AND UNDISCLOSED INFORMATION

Unfair competition and undisclosed information.

160. (1) (a) Any act or practice carried out or engaged in, in the course of industrial or commercial activities, that is contrary to honest practices shall constitute an act of unfair competition.

(b) The provisions of this section shall apply independently of, and in addition to, other provisions of the Act protecting inventions, industrial designs, marks, trade names, literary, scientific and artistic works and other intellectual property.

(2) (a) Any act or practice carried out or engaged in, in the course of industrial or commercial activities, that causes, or is likely to cause, confusion with respect to another’s enterprise or its activities, in particular, the products or services offered by such enterprise, shall constitute an act of unfair competition.

(b) Confusion may, in particular, be caused with respect to —

- (i) a mark, whether registered or not ;
- (ii) a trade name ;
- (iii) a business identifier other than a mark or trade name ;
- (iv) the appearance of a product ;
- (v) the presentation of products or services ;
- (vi) celebrity or a well known fictional character.

(3) (a) Any act or practice carried out or engaged in, in the course of industrial or commercial activities, that damages, or is likely to damage, the goodwill or reputation of another’s enterprise shall constitute an act of unfair competition, whether or not such act or practice actually causes confusion.

(b) Damaging another’s goodwill or reputation may, in particular, result from the dilution of the goodwill or reputation attached to—

- (i) a mark, whether registered or not ;
- (ii) a trade name ;
- (iii) a business identifier other than a mark or a trade name ;

- (iv) the appearance of product ;
- (v) the presentation of products or services;
- (vi) celebrity or a well-known fictional character.

(c) For the purposes of these provisions, “dilution of goodwill or reputation” means the lessening of the distinctive character or advertising value of a mark, trade name or other business identifier, the appearance of a product or the presentations of products or services or of a celebrity or well known fictional character.

(4) (a) Any act or practice carried out or engaged in, in the course of any industrial or commercial activity, that misleads, or is likely to mislead, the public with respect to an enterprise or its activities, in particular, the products or services offered by such enterprise, shall constitute an act of unfair competition.

(b) Misleading may arise out of advertising or promotion and may, in particular occur with respect to —

- (i) the manufacturing process of a product ;
- (ii) the suitability of a product or service for a particular purpose ;
- (iii) the quality or quantity or other characteristics of products or services ;
- (iv) the geographical indication of products or services ;
- (v) the conditions on which products or services are offered or provided ;
- (vi) the price of products or services or the manner in which it is calculated.

(5) (a) any false or unjustifiable allegation, in the course of industrial or commercial activities, that discredits, or is likely to discredit, an enterprise of another person or the activities of such enterprise, in particular, the products or services offered by such enterprise, shall constitute an act of unfair competition.

(b) Discrediting may arise out of advertising or promotion and may, in particular, occur with respect to—

- (i) the manufacturing process of a product ;
- (ii) the suitability of a product or service for a particular purpose ;
- (iii) the quality or quantity or other characteristics of products or services ;
- (iv) the conditions on which products or services are offered or provided ;
- (v) the price of products or services or the manner in which it is calculated.

(6) (a) Any act or practice, in the course of industrial or commercial activities, that results in the disclosure, acquisition or use by others, of undisclosed information without the consent of the person lawfully in control of that information (in this section referred to as “the rightful holder”) and in a manner contrary to honest commercial practices shall constitute an act of unfair competition.

(b) Disclosure, acquisition or use of undisclosed information by others without the consent of the rightful holder may, in particular, result from—

- (i) industrial or commercial espionage ;
- (ii) breach of contract ;
- (iii) breach of confidence ;
- (iv) inducement to commit any of the acts referred to in sub-paragraphs (i) to (iii) ;

(v) acquisition of undisclosed information by a third party who knew or was grossly negligent in failing to know, that an act referred to in sub-paragraphs (i) to (iv) was involved in the acquisition.

(c) For the purposes of this Act, information shall be considered "undisclosed information" if—

(i) it is not, as a body or in the precise configuration and assembly of its components, generally known among, or readily accessible to, persons within the circles that normally deal with the kind of information in question ;

(ii) it has actual or potential commercial value because it is secret ; and

(iii) it has been subject to reasonable steps under the circumstances by the rightful holder to keep it secret.

(d) Any act or practice, in the course of industrial or commercial activities, shall be considered an act of unfair competition if it consists of results in—

(i) an unfair commercial use of secret test or other data, the origination of which involves considerable effort and which have been submitted to appropriate authority for the purposes of obtaining approval of the marketing of pharmaceutical or agricultural or chemical products which utilize new chemical entities ; or

(ii) the disclosure of such data, except where necessary to protect the public, or unless steps have been taken to ensure that the data is protected against unfair commercial use.

(e) The undisclosed information for the purpose of this Act shall include—

(i) technical information related to the manufacture of goods or the provision of services ; or

(ii) business information which includes the internal information which an enterprise has developed so as to be used within the enterprise.

In this section the word "enterprise" has the same meaning as in section 101 of the Act.

(7) Any person or enterprise or association of producers, manufacturers or traders aggrieved by any act or practice referred to in this Part, may institute proceedings in Court to prohibit the continuance of such act or practice and obtain damages for losses suffered as a result of such act or practice. The provisions of Chapter XXXV of this Act relating to infringement shall apply, *mutatis mutandis*, to such proceeding.

(8) (a) Any person, who willfully and without lawful authority, discloses any undisclosed information shall be guilty of an offence under this Act and shall on conviction after trial before a Magistrate be liable to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and imprisonment.

(b) The provisions of Chapter XXXVIII of the Act shall apply, *mutatis mutandis*, to the offence specified under this subsection.

(9) The rights conferred by the provisions of subsection (6) shall be in addition to, and not in derogation of, any common law rights.

PART IX

CHAPTER XXXIII

GEOGRAPHICAL INDICATIONS

161. (1) Any interested party shall be entitled to prevent—

Protection of geographical indications.

(i) the use of any means in the designation or presentation of goods that indicates or suggests that the goods including an agricultural product, food, wine or spirit in question originates in a

geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of goods ; or

(ii) any use of a geographical indication which constitutes an act of unfair competition within the meaning of section 160 ;

(iii) the use of a geographical indication identifying goods including an agricultural product, food, wine or spirit not originating in the place indicated by the geographical indication in question or identifying goods not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expression such as kind, type, style or imitation or the like.

(2) The protection accorded to geographical indications under sections 103, 160 and 161 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

(3) In the case of homonymous geographical indications for goods including an agricultural product, food, wine or spirit, protection shall be accorded to each indication, subject to the provisions of subsection (2) of this section. The Minister, in case of permitted concurrent use of such indications, shall determine by prescribed practical conditions under which the homonymous indications in question will be differentiated from each other, taking into consideration the need to ensure equitable treatment of the producers concerned and the protection of consumers from false or deceptive indications.

(4) The Court shall have power and jurisdiction to grant an injunction and any other relief deemed appropriate to prevent any such use as is referred to in this section. The provisions of Chapter XXXV of the Act shall, *mutatis mutandis*, apply to such proceedings.

(5) For the purposes of this section "geographical indications" shall have the same meaning as in section 101.

PART X

CHAPTER XXXIV

CONSTITUTION AND POWERS OF ADVISORY COMMISSION

162. (1) The Minister may constitute an Advisory Commission (hereinafter referred to as the "Commission") for the purpose of advising him on any matter referred to him in relation to the law relating to Copyright, Industrial Designs, Marks, Patents and Unfair Competition and any other area or subject of Intellectual Property.

Appointments &c.
of Advisory
Commission.

(2) The Commission constituted under subsection (1) shall consist of—

(a) not less than five and not more than ten members appointed by the Minister from among persons who have shown capacity in law or commerce or related fields, (hereinafter referred to as an "appointed member"); and

(b) the Director-General who shall be an *ex-officio* member and who shall function as the Secretary to the Commission ;

(3) (a) Subject to the provisions of subsection (4), the term of office of an appointed member of the Commission shall be three years :

Provided that a member appointed in place of a member who resigns or is removed or otherwise vacates office, shall hold office for the unexpired portion of the part of term of office of the member whom he succeeds ;

(b) An appointed member of the Commission who vacates office by effluxion of time shall be eligible for re -appointment.

PART XI
CHAPTER XXXV

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

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 discretion 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.

(4) A corporate body or a firm may act as an agent if the majority of the Directors of such corporate body or if the majority of the partners of the firm, as the case may be, are registered agents.

(5) The registration of an agent under this Act shall be valid for a period of three years and shall be renewable, subject to the payment of a prescribed fee, for a consecutive period of three years provided, however, that a period of grace of six months shall be allowed for renewal upon payment of such surcharge as may be prescribed.

(6) Notwithstanding anything in the provisions of subsection (2), any duly appointed agent, irrespective of not being registered under this Chapter, may represent his clients, for a period of two years from the date on which the provisions of this Chapter comes into operation.

(7) The power of attorney referred to in this Act means a power of attorney duly executed or a letter of authorisation duly signed by the principal.

CHAPTER XXXVII

FUND

176. (1) For the purposes of this Act there shall be established a Fund which shall be maintained in such manner as the Secretary to the Ministry of the Minister in charge of the subject of Trade in consultation with the Director-General may direct.

(2) There shall be paid into the Fund two-thirds of every fee or charge, levied or recoverable under this Act or any regulation made thereunder.

(3) There shall be paid out of the Fund referred to in subsection (1) all sums of money required to defray any expenditure incurred by the Director-General in the exercise, discharge and performance of his powers, functions and

duties under this Act and all such sums of money as are required to be paid out of such Fund by or under this Act or any regulation made thereunder.

(4) The balance one-third of the money paid into the Fund under subsection (2), of each and every such fee or charge levied or recoverable under this Act or any regulation made thereunder shall be credited to the Consolidated Fund.

(5) The Secretary to the Ministry of the Minister in charge of the subject of Trade shall as soon as possible after the end of each calendar year prepare a report on the administration of the Fund and shall cause to be maintained a full and appropriate account of the Fund in respect of each calendar year.

(6) The Auditor-General shall audit the accounts of the Fund in terms of Article 154 of the Constitution.

(7) The financial year of the Fund shall be the calendar year.

CHAPTER XXXVIII

OFFENCES AND PENALTIES

177. Any person who makes or causes to be made a false entry in any of the registers kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false shall be guilty of an offence and shall on conviction after trial before a Magistrate be liable to a fine not exceeding rupees five hundred thousand or to imprisonment for a term not exceeding seven years.

Fund.

Falsification of entries in any register.

Infringement of Copyright.

178. (1) Any person who wilfully infringes any of the rights protected under Part II of this Act shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not exceeding rupees five hundred

thousand or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction such fine or term of imprisonment or both such fine and imprisonment may be doubled.

(2) Any person knowing or having reason to believe that copies have been made in infringement of the rights protected under Part II of the Act, sells, displays for sale, or has in his possession for sale or rental or for any other purpose of trade any such copies, shall be guilty of an offence and shall be liable on conviction by a Magistrate for a fine not exceeding rupees five hundred thousand or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction, to double the amount of a such fine or term of imprisonment or both.

(3) Any person knowingly or having reasons to believe that he is in possession or has access to a computer program infringing the rights of another person, and wilfully makes use of such program for commercial gain, shall be guilty of an offence and shall be liable on conviction by a Magistrate for a fine not exceeding rupees five hundred thousand or to imprisonment for a period of six months or to both such fine and imprisonment.

(4) The Magistrate may, whether the alleged offender is convicted or not, order that all copies of the work and all implements used for the infringement, or all plates in the possession of the alleged offender, which appear to him to be infringing copies, or plates or implements used for the purpose of making infringing copies, shall be destroyed or delivered up to the owner of the right, or otherwise dealt with in such manner as the Magistrate may think fit.

Infringement of
Industrial
Designs.

179. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of an Industrial Design shall be guilty of an offence and shall be liable on conviction after trial before a Magistrate to a fine not

exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case of a second or subsequent conviction to double the amount of such fine or term of imprisonment or both.

180. (1) Any person who, for industrial or commercial purposes, makes a representation —

False
representations
regarding
industrial Designs.

(a) with respect to an Industrial Design not being a registered Industrial Design to the effect that it is a registered Industrial Design ;

(b) to the effect that a registered Industrial Design is registered in respect of any product, regarding which registration has not been carried out ;

(c) to the effect that the registration of an Industrial Design gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall on conviction after trial before a Magistrate be liable to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent that an Industrial Design is registered if he uses in connection with the Industrial Design the word “registered”, or any word or words expressing or implying that registration has been obtained for the Industrial Design.

Infringement of
Patents.

181. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a patent shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment, and in the case

of a second or subsequent conviction to double the amount of such fine or term of imprisonment or both.

182. (1) Any person who, for industrial or commercial purposes, makes a representation –

- (a) with respect to a patent not being a registered patent to the effect that it is a registered Patent ;
- (b) to the effect that a registered Patent is registered in respect of any product or process regarding which registration has not been carried out ; or
- (c) to the effect that the registration of a Patent gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence, and shall be liable on conviction after trial before a Magistrate to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment.

(2) A person shall be deemed to represent a Patent as registered if he uses in connection with the Patent the word “registered”, or any word or words expressing or implying that registration has been obtained for the Patent.

183. Any person who being or having been employed in or at the office, communicates any information relating to Patents or matters connected therewith obtained by him during the course of his employment in or at the office to any person not entitled or authorized to receive such information, or discloses such information to the public or makes any other unlawful use of such information shall be guilty of an offence, and shall on conviction after trial before a Magistrate be liable to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding twelve months or to both such fine and such imprisonment.

Unlawful disclosure of information relating to Patents.

184. Any person who wilfully infringes the rights of any registered owner, assignee or licensee of a Mark, shall be guilty of an offence and shall on conviction after trial before a Magistrate be liable to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and such imprisonment and in the case of a second or subsequent conviction to double the amount of such fine or term of imprisonment or both such fine and imprisonment.

185. (1) Any person who, for industrial or commercial purposes, makes a representation—

- (a) with respect to a Mark not being a registered Mark to the effect that it is a registered Mark ;
- (b) to the effect that a registered mark is registered in respect of any goods or services regarding which registration has not been carried out ; or
- (c) to the effect that the registration of a mark gives an exclusive right to the use thereof in any circumstances, in which having regard to limitations recorded in the register, the registration does not give that right,

shall be guilty of an offence and shall on conviction after trial before a Magistrate be liable to a fine not exceeding five hundred thousand rupees or to imprisonment for a term not exceeding six months or to both such fine and imprisonment.

(2) A person shall be deemed to represent a Mark as registered if he uses in connection with the Mark the word “registered”, or any word or sign expressing or implying that registration has been obtained for the mark.

186. (1) Any person who—

- (a) forges any Mark ; or
- (b) falsely applies to goods any Mark or Marks so nearly resembling a registered Mark as to be likely to mislead ; or

Other offences as to marks and trade descriptions.

Infringement of Marks.

False representations regarding marks.

- (c) makes any die, seal block, machine, or other instrument for the purpose of forging, or to be used for forging, a Mark ; or
- (d) applies any false trade description to goods ; or
- (e) disposes of, or has in his possession, any die, seal block, machine, or other instrument for the purpose of forging a Mark ; or
- (f) causes any of the things referred to in this subsection to be done,

shall, subject to the provisions of this Part, and unless he proves that he acted without intent to defraud, be guilty of an offence.

(2) Any person who sells or exposes for sale, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged Mark or false trade description is applied, or to which any Mark so nearly resembling a registered Mark so as to be likely to mislead, is falsely applied, as the case may be, shall, unless he proves—

(a) that having taken all reasonable precautions against committing an offence he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the Mark, or trade description ; and

(b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things ; or

(c) that otherwise he had acted innocently, be guilty of an offence.

(3) Any person who imports any piece-goods ordinarily sold by length or by the piece, manufactured outside Sri Lanka, or who sells or exposes for, or has in his possession for sale or any purpose of trade, any piece-goods ordinarily

sold by length or by piece, whether manufactured within or outside the territory of Sri Lanka, which do not have conspicuously stamped in English numerals on each piece, the length thereof in standard metres, or in standard metres and a fraction of such a metre, according to the real length of the piece, shall be guilty of an offence :

Provided that nothing contained in this subsection shall apply to any piece-goods manufactured within the limits of Sri Lanka by hand labour only.

(4) Any person found guilty of an offence under this section shall on conviction after trial before a Magistrate be liable to a fine not exceeding rupees five hundred thousand or to imprisonment for a term not exceeding two years or to both such fine and such imprisonment, and in the case of a second or subsequent conviction such fine or term of imprisonment or both such fine and imprisonment may be doubled.

(5) The Magistrate may, whether the alleged offender is convicted or not, order that every chattel, article, instrument or thing by means of or in relation to which the offence has or might have been committed shall be destroyed or declared forfeit to the State or otherwise dealt with as he may think fit.

187. Where an offence under this Act has been committed by a body corporate, every person who at the time of the commission of the offence was a Director-General, Manager, Secretary or other similar officer of that body shall be deemed to be guilty of such offence, unless he proves that the offence was committed without his consent or connivance and that he exercised all due diligence to prevent the commission of the offence.

Offences by
bodies corporate.

188. For the purposes of this Part, the definitions contained in section 101 shall apply, unless the context otherwise requires.

Interpretation.

False name or initials.

189. (1) The provisions of this Part respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods—

(a) of any such figures, words, marks or arrangement or combination thereof, whether including a registered Mark or not, as are likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are ;

(b) of any false name or initials of a person and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description.

(2) For the purposes of this Part the expression “false name or initials” means, as applied to any goods, any name or initials of a person which—

(i) are not a Mark, or part of a Mark ; and

(ii) are identical with, or are a colourable imitation of, the name or initials of a person carrying on business in connection with goods of the same description, and not having been authorized the use of such name or initials ; and

(iii) are either those of a fictitious person or of some person not, *bona fide*, carrying on business in connection with such goods.

(3) A trade description which denotes or implies that in any goods to which it is applied which contains more metres or standard metres than contained therein, is a false trade description.

190. A person shall be deemed to forge a Mark who either—

Forging marks.

(a) without the assent of the owner of the Mark make that Mark, or a Mark so nearly resembling that mark as to be likely to mislead ; or

(b) falsifies any genuine Mark, whether by alteration, addition, effacement or otherwise,

and any Mark so made or falsified is in this Part referred to as a forged Mark :

Provided that in any prosecution for forging a Mark the burden of proving the assent of the owner shall lie on the accused.

191. Any person who—

False declaration to be an offence.

(a) Makes a false declaration to the Director-General ;

(b) Makes a false declaration in respect of geographical indication inclusive of Ceylon Tea and Ceylon Cinnamon,

shall be guilty of an offence and shall be liable on conviction by a Magistrate to a fine not exceeding five hundred thousand rupees.

192. (1) Any person shall be deemed to apply a Mark or trade description to goods who—

Applying Marks and descriptions.

(a) applies it to the goods itself ; or

(b) applies it to any covering, label, reel or other thing in or with which the goods are sold or exposed, or had in possession for any purpose of sale, trade, or manufacture ; or

(c) places, encloses, or annexes any goods which are sold or exposed, or had in possession for the purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a mark or trade description has been applied ; or

(d) uses a Mark, or trade description in any manner likely to lead to the belief that the goods in connection with which it is used are designated or described by that Mark, or trade description.

(2) The expression “covering” includes any stopper, cask, bottle, vessel, box, cover capsule, case, frame, or wrapper ; and the expression “label” includes any band or ticket.

(3) A Mark or trade description shall be deemed to be applied whether it is woven, impressed, stamped, branded, or otherwise worked into or annexed, or affixed to the goods, or any covering, label, reel, or other thing.

(4) A person shall be deemed to falsely apply to goods a mark who, without the assent of the owner of a Mark, applies such Mark or any Mark so nearly resembling it as to be likely to mislead, but in any prosecution for falsely applying a Mark to goods the burden of proving the assent of the owner shall lie on the accused.

193. Where a person is charged with of making any die, stamp block, machine, or other instrument for the purpose of forging or being used for forging, a Mark, or with falsely applying to goods any Mark or any Mark so nearly resembling a mark as to be likely to mislead, or with applying to goods any false trade description or causing any of the things in this section mentioned to be done, and such person proves—

(a) that in the ordinary course of his business he is employed, on behalf of other persons, to make dies, stamps blocks, machines, or other instruments for making, or to be used in making, Marks, or as the case may be, to apply Marks or descriptions to goods and that in the case which is the subject of the charge he was so employed by some person resident in Sri Lanka, and was not interested in the goods by way of profit or commission dependent on the sale of such goods ; and

483
Exemption certain persons employed in ordinary course of business.

(b) that he took reasonable precautions against committing the offence charged with ; and

(c) that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the Mark or trade description ; and

(d) that he gave to the prosecutor all the information in his power with respect to the person on whose behalf the Mark or description was applied,

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor unless he gives due notice to the prosecutor regarding his intention to rely on defence specified in this section.

194. In any indictment, charge, proceeding, or document in which any mark or forged mark is required to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that Mark or forged Mark to be a Mark or forged Mark.

Mark how described in pleading.

195. In any prosecution for and offence under this Part—

Rules as to evidence.

(a) an accused, and his or her spouse as the case may be, may, if the accused thinks fit, be called as a witness, and if called, shall be sworn and examined and may be cross-examined and re-examined in like manner as any other witness ;

(b) in the case of imported goods evidence of the port of shipment shall be, *prima facie*, evidence of the place or country in which the goods were made or produced.

196. Any person who, being within Sri Lanka, abets the commission out side Sri Lanka of any act which, if committed within Sri Lanka, would under this Part be an offence, shall be deemed to be guilty of that offence, and be liable to be indicted, proceeded against, tried and convicted in any district or place in Sri Lanka in which he may be as if the offence had been committed therein.

Punishment of accessories.

For the purpose of this section “abet” shall have the same meaning as in section 101 of the Penal Code.

Search warrant.

197. (1) (a) Upon receipt of information of an offence being committed under this Part, a Magistrate may issue either a summons requiring the person alleged to have committed such offence to appear in court and show cause or where such person fails to appear issue a warrant for the arrest of such person ;

(b) The Magistrate may upon being satisfied by information on oath that there are reasonable grounds to believe that any goods or things by means of, or in relation to, which such alleged offence has been committed are in any house or premises of the person charged on the basis of such information, or in his possession or under his control, in any place, such Magistrate may issue a warrant under his hand ;

(c) It shall be lawful for any police officer, or other person named or referred to in the warrant, to enter such house, premises, or place at any reasonable time of the day, and to search therefore and seize such goods or things ; and any goods or things seized under any such warrant shall be brought before the Magistrate’s Court for the purpose of determining whether such goods are liable to forfeiture under this Part.

(2) (a) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Part, is unknown or cannot be found, any information or complaint may be led for the purpose only of enforcing such forfeiture, and a Magistrate may cause notice to be published requiring reasons to be shown to the contrary at the time and place named in the notice, as to why such goods or things should not be forfeited.

(b) If the owner or any person on his behalf, or other person interested in the goods or things, fails to show sufficient cause to the contrary at the time and place named in the notice, Magistrate may order such goods or things or any of them to be forfeited. Every such order shall be subject to an appeal.

(3) Any goods or things forfeited under this section, or under any other provisions of this Part, may be destroyed or otherwise disposed of, in such manner as the Magistrate who ordered the forfeiture may direct, and the Magistrate out of any proceeds which may be realized by the disposition of such goods (all marks and trade descriptions being first obliterated), may make an award to an innocent party for any loss he may have sustained in dealing with such goods.

198. In any prosecution under this Part the Court may order costs to be paid to the accused by the prosecutor or to the prosecutor by the accused, having regard to the information given by, and the conduct of, the accused and prosecutor respectively, and the sum so awarded as costs shall be recoverable as if it were a fine.

Costs of defence
and of
prosecution.

199. Where, at the commencement of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Part with respect to false trade descriptions shall not apply to such trade description when so applied :

Provisions as to
false description
not to apply in
certain cases.

Provided that where such trade description includes the name of a place or country, which is likely to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually

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.

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.

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.

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, which ever 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.

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.

(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 ;

Implied warranty
on sale of marked
goods.

Regulations.

(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

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 therefore 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 :—

“(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 :—

“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

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

Insertion of new sections in the Customs Ordinance.

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 suspension.

(4) If the Director-General of customs fails to receive any notice regarding the institution of proceedings in respect of the 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 Designs, Patents, Marks and unfair competition pending on the day immediately preceding 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 preceding 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.

Savings of
Designs.

210. The validity of the original entry of a Patent on the register of Patents existing on the day immediately preceding 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 preceding the date of commencement of this Act or any register of Marks which was kept under any previous law and was incorporated 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 preceding 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

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 there of ;

“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.