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REGISTERING A TRADEMARK IN SRI LANKA

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Colombo, Sri Lanka

Like in many parts of the world where there is an active protection for Intellectual Property Rights ((IPR), the law and procedure in place in Sri Lanka with regard to IP laws is very straightforward. The first reference to IP Law in Sri Lanka dates way back to the year 1860.

Presently, the statute governing IPR in Sri Lanka is the Intellectual Property Act No 36 of 2003 and the governmental authority vested with the power to overlook the registration and management of IP matters is the National Intellectual Property Office (NIPO).

A rectangular graphic with an orange background. It features a faint image of a chessboard with a king piece in the center. Overlaid on this is the text 'How to Register a Trademark in Sri Lanka' in a white, bold, sans-serif font.

How to Register a Trademark in Sri Lanka

It can be considered that the most actively operating unit in the NIPO is the Trademark Division, which on average receives at least 20 to 30 applications per day. For a tiny island nation like Sri Lanka, it can be considered that the most actively operating unit in the NIPO is the Trademark Division, which on average receives at least 20 to 30 applications per day. For a tiny island nation like Sri Lanka, this is a considerable amount. Let's look into the Trademark application process in Sri Lanka to gain better understanding on how the system works.

Prior to the submission of an application for the registration of a trademark or logo to the NIPO, it is

advisable to conduct a trademark search to ensure that no identical or similar marks have been registered or applied for registration, to avoid the risk of refusal of the trademark application and infringing the rights of a third party. A computerized word search can be conducted within the NICE classification in which the trademark is intended to be registered under. The search for logos, however, is somewhat cumbersome as it must be done by manually looking through each and every image available in the database, appearing under the said class.

Sri Lanka does not allow multiple class registrations, therefore an application each should be filed if an applicant intends to obtain protection under several classes.

Once it is ascertained that no such similar or identical mark is available in the database, the following documents should be prepared:

1. A duly filled application form, including the applicant's name and address, the NICE class and the specific goods or services which are intended to be protected, information on any priority claim, details of Agent if any etc.
2. In the event a Trademark Agent is appointed to handle the application process, then a duly filled Letter of Authority appointing the said Agent
3. Clear depiction of the mark which is to be filed. This can be either included within the specified field in the application form or submitted as an annexure to the application.
4. In the event of an image of a person being used in the logo/get up of a product, an agreement entered into between the applicant and the said person, which allows for their image to be used
5. If a word or phrase appears on the logo in any language other than the official or link languages in Sri Lanka, then a translation of such word or phrase should be obtained through a sworn translator.

The above list of documents should be submitted to the NIPO along with a set of copies. An acknowledgement will be printed on the set of copies, more specifically on the copy of the application and a reference number assigned to the application will be provided. This number shall be the trademark number which can be used by the applicant to follow up on the application. Applications for trademark registration can be made by both local and foreign persons and business entities.



The application process is somewhat time consuming and may take well over 5 to 6 years for the trademark to be registered.

Once the application is handed over and a number is assigned, the application proceeds to the Formalities Examination stage where NIPO does an assessment to ascertain if the basic requirements of the application has been met, such as inclusion of applicant details, annexure of an LOA, provision of translation if necessary, etc. The time period to conduct this assessment may vary.

The next step will be the Substantive Examination process where the application is assessed, and a determination is made on whether the trademark intended to be registered complies with the provisions of the National Intellectual Property Act. The outcome of this may either be the mark being accepted, either subject to conditions or not, or the application being refused. In the event the application is refused, the applicant has the right to request for a hearing or to file written submissions explaining grounds to allow registration.

The types of conditions imposed by the NIPO on the acceptance of marks may either be a condition stating that no exclusive rights will be granted over a specific word or words appearing in the trademark, association with similar marks of the same applicant or the condition to inform a third party who may have similar marks which have already been registered at the NIPO etc.

Once the acceptance letter has been received, if the applicant is in agreement with the conditions or in a situation where no conditions have been imposed, then the applicant can proceed to pay the publication fee, for the mark to be published in the Government Gazette.

If there is any dispute with regard to the conditions imposed, submissions in writing can be made to the NIPO

asserting the position of the applicant and why such condition(s) should be removed. However, the discretion entirely lies with the NIPO to accept such submissions or not.

The publication of the mark on the Government Gazette provides the opportunity for a third party whose rights are being infringed should the registration of the said mark be allowed, to oppose the registration. Such opposition should be made within 3 months of the date of the mark being published in the Government Gazette. If further time is required by a third party to draft the Opposition document, prior to the lapse of the 3 months an extension of time can be requested from the NIPO.

Supposing that no such opposition is received, the applicant can proceed to register the trademark by making the registration fee payment to the NIPO along with copies of the corresponding Gazette Notification in Sinhala, Tamil and English.

Pursuant to the above, a Registration Certificate will be issued within several months. A trademark once registered is valid for a period of ten years from the date of application and should be renewed prior to the lapse of such time period. However, a grace period of 6 months post the expiration date is allowed for renewals. In the event the mark is registered 10 years after the date of application, then the trademark should be renewed within one year from the date of issuance of the Registration Certificate.

Trademark protection laws and procedure in Sri Lanka have ensured that not only corporate giants but small scaled businesses too are afforded the same amount of IPR protection that they are entitled to.



REVISITING DIVISIONAL PATENT APPLICATIONS: THE PLURALITY OF INVENTIONS DEBATE IN INDIA



Adv. Divyendu Verma

In India, divisional applications can be filed under certain conditions, and these conditions are primarily governed by Section 16 of the Indian Patents Act, 1970. Section 16 provides:

16: Power of Controller to make orders respecting division of application:

- (1) *A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.*
- (2). *The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.*
- (3). *The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete*

specifications includes a claim for any matter claimed in the other.

Here are the key points related to filing divisional patent applications in India:

- **Unity of Invention:** The main condition for filing a divisional application in India is that the parent application should relate to more than one invention. If the claims in the original application relate to multiple inventions, the applicant may be required to restrict the application to a single invention. In such cases, the applicant can file one or more divisional applications to cover the remaining inventions disclosed in the original application.
- **Timely Filing:** Divisional applications should be filed during the pendency of the original (parent) application. Once the original application has been granted or refused, divisional applications cannot be filed.
- **Disclosure of the Invention:** The subject matter of the divisional application should have been disclosed in the original (parent) application. The divisional application cannot introduce new subject matter.
- **No Double Patenting:** The divisional application should not result in double patenting with the original application. In other words, the same invention cannot be claimed in both the parent and divisional applications.
- **Request for Examination:** A divisional application must follow the examination process, which includes filing a separate request for examination within 6 months from the date of filing of Divisional Application.
- **Rights and Priority:** The divisional application is considered an independent application with its own set of rights and priority based on the filing date of the original application.
- **Term of Protection:** The term of protection of a divisional patent is 20 years from the filing date of the original application or 20 years from the priority date, whichever is earlier.

Filing divisional applications is a strategic approach to protect different inventions disclosed in a single original application, ensuring that each invention is examined and protected separately. It allows applicants to maximize the value of their intellectual property.

The above information was in practice until 2022 when a single bench judge of the Delhi High Court in **Boehringer Ingelheim International GMBH v. The Controller of Patents, 2022 SCC Online Del 3777**, held that a divisional application would not be maintainable if it does not contain a plurality of inventions within the claims of the parent application. The single judge also emphasized that allowing divisional applications when multiple inventions are not claimed in the original application would contradict the fundamental principle of patent law, which is “**what is not claimed is disclaimed**”.

However, another single bench judge of the Delhi High Court disagreed with the above judgement in the matter of – **Syngenta Limited v. The Controller of Patents and Designs, C.A.(COMM.IPD-PAT) 471/2022**, referred the matter to the division bench (two judge bench) with two questions:

- *Is the condition of plurality of inventions in the parent application, applicable even where the divisional application is filed by the applicant suo moto, and not based on any objection raised by the Controller?*
- *Assuming that the requirement of plurality is \ necessary for a divisional application to be maintainable, does the plurality have to be reflected in the claims in the parent application or is it sufficient if the plurality is reflected in complete specification?*

At the time of the referral, the single bench judge of the Delhi High Court in the **Syngenta case** made an observation and noted that the **Boehringer case** essentially reinterprets Section 16 of the Patents Act, 1970 by removing the phrase “disclosed in the provisional or complete specification already filed” and replacing it with “claims,” which cannot be legally justified. The Single bench judge also pointed out that the question of whether a plurality of inventions is encompassed in the original claim must be raised by the applicant **suo moto**.

The Division Bench (2 Judge Bench) of the Delhi High Court in the case of **Syngenta Limited v. The Controller of Patents and Designs, C.A. (COMM.IPD-PAT) 471/2022** (Judgement dated 13 October 2023), held that:

1. The Division Bench first emphasized that the evaluation of filing a divisional application, whether initiated by the Applicant voluntarily or in response to

an objection by the Controller, should follow the same criteria. This stance contradicted the perspective expressed by the Single Judge in the Syngenta case, which suggested treating these two categories differently, thus rejecting the observation of the Single Judge in the **Syngenta case**.

2. The Division Bench, secondly, pointed out that there seems to be no valid reason to confine the filing of a divisional application solely to scenarios where the plurality of inventions is explicitly mentioned in the claims. Such an interpretation contradicts the clear language of Section 16 of the Act, which references inventions “**disclosed in the provisional or complete specification**.” The Bench reasoned that, in the case of a provisional filing, claims may not yet exist, and thus, adhering to the **Boehringer** rationale would imply that no divisional application could be submitted when a provisional specification is involved. The Bench also clarified that the principle of “**what is not claimed is disclaimed**” primarily applies to claim drafting and is less relevant to infringement analysis.

The Bench accordingly overruled the **Boehringer decision** and established that the maintenance of a divisional application is permissible in either of the two circumstances: (i) voluntary divisional filing by the applicant or (ii) filing of divisional application in response to an objection raised by the Controller regarding plurality of inventions. This allowance, however, is contingent on the condition that the existence of multiple inventions can be substantiated based on the disclosures contained within either the provisional or the complete specification.



AUDIRI VOX ATTENDED APAA ANNUAL MEETING 2023 IN SINGAPORE

Audiri Vox, a prominent player in the field of Intellectual Property Rights in the Middle East and Africa, made a profound presence at the 20th General Assembly and 74th & 75th Council Meetings of the Asian Patent Attorneys Association (APAA) held in Singapore, from November 03 to 07, 2023. More than 1,400 registered distinguished professionals and experts from over 65 countries intellectual property community has marked their presence, offering a unique platform for knowledge exchange and collaboration.



At the 20th General Assembly on 7 November 2023, Mr. Hari Subramaniam from India has appointed as the 14th President of APAA.



Audiri Vox had most enlightening meetings with expertise in IP field during the 2023 APAA Meeting in Singapore. The event was successful with informative academic sessions, workshops, and roundtables.




Audiri Vox's presence at the APAA annual meeting marked a successful networking opportunity and celebration of their substantial contribution to the field. As the firm continues to make strides in the intellectual property realm, the election as a committee member is a crowning achievement of the firm, solidifying its position as a key player in the industry.




IP UPDATES

UNITED ARAB EMIRATES: Updation of Official Fees for patents, industrial designs, and utility models.

 On November 15, 2023, the Cabinet of Ministers issued Resolution No. 112 of 2023 for introducing amendments in the official fees associated with Federal Law No. 11 of 2021 concerning the Regulation and Protection of Industrial Property Rights. According to Article 4 of the decision, these changes will come into effect two months of post-publication, i.e., from January 15, 2024. The main highlights of the resolution are as follows:

1. **Free of Charge Services:** The new fee schedule reinstated the free of charge services which are previously abolished, including publications, annuities, recordal of assignments, amendments, restoration, change in authorization of agents, etc.
2. **Fee Reduction for SMEs and Academic entities:** There is a fee reduction for various services for the small and medium sized enterprises (SMEs) and academic entities.
3. **Introduction of New Fees for Services:** The new fees for services are defined which includes change in entity, addition of claims, filing of a request for the restoration of lapsed applications, filing a request for expedited examination, filing a request for re-examination of minor office actions, post grant examination,
4. **Claim Limitation:** The official fee for filing the application will be based on the number of claims. The law limits the number of claims at 50 per patent. Ministerial Decision takes this into account by establishing a tiered fee structure with three different examination fees based on the number of claims.

Saudi Arabia: Adoption of NICE Classification

 NICE Classification From November 05, 2023, the Saudi Authority for Intellectual Property (SAIP) has adopted the 12th edition of International Classification of Goods and Services for the purpose of registering marks under the Nice Agreement. With this adaptation, the users can file the trademark applications through an online filing system. The users are no longer to select the class headings. Now, they can select the specific items from a list or select an option of all items within in the class.

GAZA: Suspension of Services by Trademark Office



The Trademark Office has suspended all the services due to the ongoing war in Gaza strip. The legal deadlines which are falling within the war period have been suspended until further notice. On November 09, 2023, a second decree by law was issued for the west bank, where the suspension of legal deadlines is extended for thirty days. Accordingly, the legal deadlines are scheduled to resume from December 07, 2023, unless further decrees are enacted.

INDIA:



New Balance Athletics Inc. (plaintiff) vs New Balance Immigration Private Limited (defendant)

Case Number: CS(COMM) 444/2022 & I.A. 11940/2023

Decided On: 02 November 2023



The present suit has been filed by the plaintiff for permanent injunction and damages against the defendant. The Plaintiff also seeks a declaration of its marks as well-known marks. The Hon'ble Delhi High Court in order dated 15th September 2022 had proceeded with the ex-parte decision after there was no appearance on behalf of the defendant. The Hon'ble Court had granted an ad-interim injunction restraining the defendant from using the "NEW BALANCE" and "NB" name and mark in respect of its immigration services. In respect of prayer regarding well-known declaration, the Hon'ble Court had directed evidence to be filed by the plaintiff. The plaintiff has placed sufficient documentary evidence on record in support of prayer for declaration as a well-known mark. After going through the evidence filed by the plaintiff, the Hon'ble Court noted that the mark "NEW BALANCE" is a unique combination of two distinctive words which have no connection, allusion or description of the products of the services offered by the plaintiff. The logo is also quite distinctive and has been repeatedly enforced by the Court orders against misuse.



**Pernod Ricard India Private Limited (plaintiff) vs
A B Sugars Limited & Anr. (defendants)**

**Case Number: CS(COMM) 371/2019
Decided On: 31 October 2023**



The present suit was filed by the plaintiff against the defendant for seeking injunction against infringement and passing off of its registered mark “ROYAL STAG” and “ROYAL STAG BARREL SELECT”. The plaintiff asserted that it has gained remarkable goodwill in the Indian liquor market. The Stag device has become the source identifiers of the plaintiff, and it is perpetually associated in the mind of consuming in public. On the other hand, the defendant has argued that “Stag” is publicly juris in the liquor industry therefore plaintiff cannot claim monopoly over the word “Stag”. The defendant has also cited some of the whiskey brands around the world like Dalmore and Glenfiddich which deliberately use the word “Stag” and Stag devices on their labels. The Hon'ble Delhi High Court observed that the mark “INDIAN STAG” is deceptively similar to the mark “ROYAL STAG”. The use of the word “STAG”, being an essential feature in the impugned mark, represents the “INDIAN STAG” mark phonetically and structurally similar to the mark “ROYAL STAG”. The Hon'ble Court further observed that the disclaimer in respect of “ROYAL” part of plaintiff's mark, while granting registration to plaintiff's “ROYAL STAG” mark cannot, therefore, make any difference. The common part in the rival marks is “STAG”, which has not been disclaimed by the plaintiff. Therefore, there is no restriction on the plaintiff claiming exclusivity in respect of the STAG part of its mark. The Hon'ble Delhi High Court has confirmed the ad interim order, which restrained defendants from using, manufacturing, bottling, selling, exporting, and offering for sale the products of liquor, whisky or any related alcoholic beverages under the trademark 'Indian Stag' and/or its 'Stag' device or any other trade mark/device that may be deceptively similar to the plaintiff's trade mark 'Royal Stag' and/or 'Stag' device.

which is deceptively similar to the plaintiffs registered trademark “NILKAMAL”. Plaintiffs submitted that defendants have clearly acted malafide, as is apparent from the deceptive similarity between the “NILKRANTI” logo that they have adopted and the pre-existing “NILKAMAL” logo of the plaintiffs. Plaintiffs further asserted that it could be considered phonetically similar to the defendant has used prefix “NIL”. The Hon'ble Delhi High Court has observed that the device marks, when compared, are deceptively and confusingly similar and being written in similar blue letters and the covering of font. Subsequently, the defendants were restrained from using the device mark or any similar mark but were allowed to continue using the word mark NILKRANTI, and thus no case of infringement is made out. Hence, the Hon'ble court disposed of the present application, by restraining defendants from using the impugned device mark and by rejecting the prayer for injunction in respect of the word mark “NILKRANTI”.



**Nilkamal Crates And Contaners & Anr. (plaintiffs)
vs Ms. Reena Rajpal & Anr. (defendants)**

**Case Number: CS(COMM) 707/2023
Decided On: 06 November 2023**



The present application was filed by the plaintiffs to restrain defendants from using “NILKRANTI” as a wordmark as well as a device mark





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