

INFORMATION PURSUANT TO THE THIRTY SECOND SESSION OF THE STANDING COMMITTEE ON THE LAW OF PATENTS – SCP

(i) Certain aspects of National/Regional Patent Law

**(1) Prior art**

It is suggested to amend the point 1 as follows:

1. Everything made accessible to the public by a written publication to the public anywhere in the world, by oral disclosure, use or in any other way, before the filing date (priority date).

**Correction done** :1. Everything made accessible to the public by a written publication to the public anywhere in the world, **or in Sri Lanka** by oral disclosure, use or in any other way, before the filing date (priority date).

**(2) Novelty**

It is suggested to amend the definition of novelty as follows:

The invention is not anticipated by prior art. The prior art consists of everything made accessible to the public by a written publication to the public anywhere in the world, by oral disclosure, use or in any other way, before the filing date (priority date), and the contents of subsequently granted Sri Lankan patent applications with an earlier filing date (priority date).

**Correction done:** The invention is not anticipated by prior art. The prior art consists of everything made accessible to the public by a written publication to the public anywhere in the world, **or in Sri Lanka** by oral disclosure, use or in any other way, before the filing date (priority date), and the contents of subsequently granted Sri Lankan patent applications with an earlier filing date (priority date).

**(3) Inventive Step (Obviousness)**

It is suggested to amend the definition of Inventive Step as follows:

The invention would not have been obvious to a person having ordinary skill in the art having regard to the prior art. The prior art consists of everything made accessible to the public by a written publication to the public anywhere in the world, by oral disclosure, use or in any other way, before the filing date (priority date), and the contents of subsequently granted Sri Lankan patent applications with an earlier filing date (priority date)."

**Correction done:** The invention would not have been obvious to a person having ordinary skill in the art having regard to the prior art. The prior art consists of everything made accessible to the public by a written publication to the public anywhere in the world, **or in Sri Lanka** by oral disclosure, use or in any other way, before the filing date (priority date), and the contents of subsequently granted Sri Lankan patent applications with an earlier filing date (priority date)).

**(4) Exclusions from patentable subject matter:**

The following points also should be added.

5. An invention which is useful in the utilization of special nuclear material or atomic energy in an atomic weapon.

6. Any invention, the prevention within Sri Lanka of the commercial exploitation of which is necessary to protect the public order, morality including the protection of human, animal or plant life or health or the avoidance of serious prejudice to the environment.

#### (6) Exceptions and Limitations of the Rights

The following point also should to be added.

(viii) Compulsory licensing and/or government use

#### **(ii)Opposition systems and other administrative revocation and invalidation mechanisms**

According to the Intellectual Property Act No. 36 of Sri Lanka, an opposition may be requested before the grant of a patent (pre-grant opposition) or after the grant of a patent (post-grant opposition). In a pre-grant opposition, an opposition may be directed by the court, within a three months period after the publication of the application for a patent in the government gazette and which is done after the substantive examination phase.

#### Extract of IP Act Chapter xviii

99. (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 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 subsection (1) of section 62, or is excluded from protection under subsection (3) of section 62, or subsection (1) of section 79, or is not patentable due to the failure to satisfy the requirements of sections 63, 64, 65 and 66 ; or

(b) that the description or the claims, fails to satisfy the requirements of subsections (3) and (4) of section 71 ; or

(c) that any drawings required for the understanding of the claimed invention have not been furnished ; or

(d) that the right to the patent belongs to a person other than 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 paragraph (d) of subsection (1), the applicant shall give notice of the application to the person to whom the right to the patent is alleged to belong.

**(iii) International worksharing and collaborative activities for search & examination of patent applications (<http://www.wipo.int/patents/en/topics/worksharing>)**

When examining PCT applications and non-residential patent applications received through the Paris Convention, NIPO SL refers to Global dossier information and accepts the search results of IP5 offices. Therefore, applicants are encouraged to submit amended claims approved by any office of the IP5 offices and thereby patent granting process is expedited.