

E-ALERT: RECENT DEVELOPMENTS IN INTELLECTUAL PROPERTY LAW IN SRI LANKA



SRI LANKA AMENDS IP LAW TO INTRODUCE REGISTRATION SYSTEM FOR GEOGRAPHICAL INDICATIONS

March 2022

Despite being well-known globally for its “Ceylon Tea” and “Ceylon Cinnamon”, Sri Lanka was yet to offer complete protection for Geographical Indications under its Intellectual Property regime.

Geographical Indication (GI), as recognized under the Intellectual Property Act No. 36 of 2003 (IP Act) is “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”. While protection for GIs were not completely excluded under the IP Act, it was received through intervention of courts (“Sui generis” protection), under unfair competition, certification marks, collective marks and certain provisions pertaining to trademark registration.

The initial step to enable registration of GI came through an amendment of the IP Act in 2018 (No. 7 of 2018) empowering the Minister to prescribe any Geographical Indication in respect of any goods or products for the purpose of the IP Act. However, the amendment was not followed by regulations for setting up procedure for registration and administration of the GIs in Sri Lanka.

Through the continued efforts of all industry stake holders to enhance the protection afforded to GIs through a registration system, the required amendments to the law have now come through thereby assuring stronger protection for GIs in Sri Lanka. A bill to amend the IP Act which fulfills the requirement of a GI registration system was recently passed in Parliament and the Intellectual Property (Amendment) Act, No. 8 of 2022 has come into effect from 16th March 2022.

Please feel free to contact us should you require further information on the Impact of the amendment, admissibility criteria, the registration procedure, duration etc.

SRI LANKA AMENDS IP ACT AFTER ACCESSION TO MARRAKESH TREATY TO FACILITATE ACCESS TO PUBLISHED WORKS FOR PERSONS WHO ARE BLIND, VISUALLY IMPAIRED OR OTHERWISE PRINT DISABLED

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Stevie Wonder, American singer, songwriter, musician and record producer once said, “Just because a man lacks the use of his eyes doesn’t mean he lacks vision.” This statement, and his successful carrier in the music industry, is an excellent example to prove that physical disability is not and should not be a barrier to human creativity. And the law has an important role to play to enable specific criteria making available to every human irrespective of physical abilities, modes of access to knowledge and information.

Although millions of books are annually published worldwide not even 10% of these works are made available to blind, visually impaired or otherwise print disabled persons. The purpose of the Marrakesh Treaty is to facilitate access to published works for persons who are blind, visually impaired, or otherwise print disabled (the Marrakesh Treaty). The Marrakesh Treaty is the first copyright Treaty to include clear human rights perspective.

In October 2016, Sri Lanka became the 24th Country to accede to the Marrakesh Treaty and the respective provisions were introduced to the Intellectual Property Act No, 36 of 2003 (IP Act) of Sri Lanka by way of an amendment in 2021: Intellectual Property (Amendment) Act, No. 8 of 2021.

In order to understand the scope and application of the Marrakesh Treaty the definitions provided are fundamental. These definitions were incorporated into the IP Act which would provide clarity on,

- I. who will be able to enjoy the limitations and exceptions outlined in the Treaty (the “beneficiaries”),
- II. what can be made accessible (the “works”) and
- III. into which formats such works can be adapted (“accessible formats”).

Accordingly, Section 05 of the IP Act was amended to insert the following definitions.

“accessible format” means a copy of a work in an alternative form or manner which gives a beneficiary person access to such work, including to permit such person to have access as feasibly and comfortably as a person without any disability which a beneficiary person has. The accessible format copy shall be used exclusively by beneficiary persons and shall respect the integrity of the original work, taking into consideration of the changes needed to make the work accessible in the alternative format and of the accessibility needs of the beneficiary person;”.

“beneficiary person” means any person who

- (a) is blind;
- (b) has a visual impairment or a perceptual or reading disability which cannot be improved to give visual function substantially equivalent to a person who has no such impairment or disability and is unable to read printed works to substantially the same degree as a person without any such impairment or disability; or
- (c) is otherwise unable, through physical disability to hold or manipulate a book or to focus or move eyes to the extent that is acceptable for reading.

The two main obligations of the contracting parties when implementing the Marrakesh Treaty at the national level are as follows.

1. To provide for a limitation or an exception to copyright in order to allow “beneficiaries” and “authorized entities” to undertake any changes needed to make a copy of a work in an accessible format for persons with print disability.
2. To allow the exchange across borders of those accessible copies produced according to the limitations and exceptions provided in the Marrakesh Treaty, or in accordance with the operation of law.

Section 12 which includes the provisions pertaining to Fair Use of Copyrights was amended and the following section has been inserted immediately after, thus attempts have been made to comply with the above obligations.

12A (1) (a) Notwithstanding anything contained in this Part, any authorized entity may adapt, reproduce and issue of copies of any work in an accessible format for the benefit of a beneficiary person in order to facilitate such beneficiary person to access such work including the sharing with any other beneficiary person of such work where the reproduction is made exclusively for the own use of the beneficiary person, his educational purpose or research and where the original format of such work prevents the enjoyment thereof by such person. Such adaptation, reproduction, and issue of copies of any work by the authorized entity shall not be an infringement of copyright.

(b) The provisions of paragraph (a) shall apply for any work only where such work is not commercially available in such accessible format under reasonable terms. In such event, the Minister shall deposit a notification with the Director-General of the World Intellectual Property Organization declaring the limitations or exceptions, as the case may be, to such work.

12A (2) An authorized entity shall—

- (a) be such persons or organizations as shall be prescribed by the Minister in consultation with the Director-General of Intellectual Property.
- (b) make available to any beneficiary person copies of any work in accessible format on non-profit basis recovering only the cost of the production of such work in an accessible format.

- (c) ensure that copies of any work in accessible format are used only by a beneficiary person and take reasonable steps to prevent its entry into ordinary channels of business.
- (d) limit the supply of copies of any work in accessible format only to adapt, reproduce and issue of copies of such work to the beneficiary persons or any other persons acting on behalf of the beneficiary person.
- (e) discourage the reproduction, distribution and making available of unauthorized copies of any work in accessible format; and
- (f) maintain due care in, and records of its handling of copies of any work in accessible format while respecting the privacy of a beneficiary person.

Accordingly, by acceding the Treaty and amending the IP Act to introduce the above provisions, Sri Lanka has enhanced and secured the interests of blind, visually impaired and otherwise print disabled persons and increased their access to books, magazines and other printed materials. When the above amendment bill was at the committee stage, the ministerial consultative committee on trade informed that an audio recording of any book can be issued for those who are unable to use print media due to physical disability. It was pointed out to the committee that a software is used for this purpose and that such audio recordings can be used for the convenience of the persons with special needs, without paying royalty. As the law is now settled and has specific provisions that will facilitate and encourage any interested parties to initiate any such projects or measures for the benefit of blind, visually impaired or otherwise print disabled persons without violating the rights of the copyright holders.

FOR FURTHER INFORMATION, PLEASE CONTACT:



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