

No. 30 of 1964

TRADE MARKS

AN ACT TO AMEND AND CONSOLIDATE THE LAW RELATING TO TRADE MARKS

[12th November, 1964.]

[Not in operation on 31st December, 1966.*]

Short title and date of operation.

1. This Act may be cited as the Trade Marks Act, No. 30 of 1964, and shall come into operation on such date * as the Minister may appoint by Order published in the Gazette.

PART I

REGISTRATION OF TRADE MARKS

THE REGISTER

The register of trade marks.

2. (1) There shall continue to be kept at the Registrar's office for the purposes of this Act the record called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may from time to time be prescribed.

(2) The register shall continue to be divided into two parts called respectively Part A and Part B.

(3) The register shall be kept under the control and management of the Registrar.

Register to be open to the public for inspection.

3. The register shall at all convenient times be open to the inspection of the public, subject to such rules as may be made in that behalf.

EFFECT OF REGISTRATION AND ACTION OF INFRINGEMENT

No action for infringement of unregistered trade marks.

4. No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of

* Not in operation on 31st December, 1966.

action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

5. (1) Subject to the provisions of this section, and of section 8 and section 9, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the preceding provisions of this section, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being used as a trade mark ; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in at any place in relation to goods to be exported to any market, or in any other circumstances to which, having regard to any such limitations, the registration does not extend.

Right given by registration in Part A, and infringement thereof.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark ; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Right given
by registra-
tion in Part B,
and infringe-
ment thereof.

6. (1) Except as provided by subsection (2) of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions of the last preceding section shall have effect in like manner in relation to a trade

mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of the next succeeding section, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

7. (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorizes it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

Infringement
by breach of
certain
restrictions.

(2) The acts to which this section applies are—

(a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing ;

(b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof ;

- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated ;
- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods ; and
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section, references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark in respect of those goods, and the expression "upon" includes in relation to any goods a reference to physical relation thereto.

**Savings for
vested rights.**

8. Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his ; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his, whichever is the earlier, or to object (on such use being proved) to that person being put on

the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section 13.

9. No registration of a trade mark shall interfere with—

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (1) of section 5, or in paragraph (b) of subsection (1) of section 42.

Saving for-
use, of name,
address, or
description
of goods.

REGISTRABILITY AND VALIDITY OF REGISTRATION

10. (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it shall contain or consist of at least one of the following essential particulars:—

- (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 foregoing paragraphs (a), (b), (c), and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

Distinctive-
ness requisite
for registra-
tion in Part
A.

(2) For the purposes of this section "distinctive" means adapted, in relation to the goods in respect of

which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid, the Registrar or the court may have regard to the extent to which—

(a) the trade mark is inherently adapted to distinguish as aforesaid ; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

Capability of distinguishing requisite for registration in Part B.

11. (1) [In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid, the Registrar or the court may have regard to the extent to which—

(a) the trade mark is inherently capable of distinguishing as aforesaid ; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

12. 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 cause confusion 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.

Prohibition of registration of deceptive matter, &c.

13. (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

Prohibition of registration of identical and resembling trade marks.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar make it proper so to do, the court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the Registrar, as the case may be, may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, 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 a manner approved by him or by the court on an appeal to the court.

14. (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 32) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

Registration in Part A to be conclusive as to validity after seven years.

(a) that registration was obtained by fraud, or

(b) the trade mark offends against the provisions of section 12.

(2) Nothing in subsection (1) of section 6 shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the preceding provisions of this section relating to a trade mark registered in Part A of the register.

Registration
subject to
disclaimer.

15. If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark ; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character,

the Registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the Registrar or the court holds him not to be entitled ; or
- (ii) that the proprietor shall make such other disclaimer as the Registrar or the court may consider necessary for the purpose of defining his rights under the registration :

Provided that no disclaimer on the register shall affect any rights 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.

Words used
as name or
description
of an article
or substance.

16. (1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance :

Provided, that if it is proved either—

- (a) that there is a well known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein; not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent in force on, or granted after, the first day of January, 1907, that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance,

then, the provisions of the next succeeding subsection shall have effect.

(2) Where the facts mentioned in paragraph (a) or (b) of the proviso to the preceding subsection are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 32 to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the

register shall affect any rights 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; and

(c) for the purposes of any other legal proceedings relating to the trade mark,—

(i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or

(ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to the foregoing subsection (1) first became well known and established, or at the expiration of the period of two years mentioned in paragraph (b) of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force immediately prior to the appointed day shall, notwithstanding anything in section 14, be deemed for the purposes of section 32 to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that the preceding provisions of this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished

from the element or compound as made by others, and in association with a suitable name or description open to the public use.

17. A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Registrar or the court in deciding on the distinctive character of the 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.

Effect of limitation as to colour, and of absence thereof.

PROCEDURE FOR, AND DURATION OF, REGISTRATION

18. (1) A person who claims to be the proprietor of a trade mark used or proposed to be used by him and who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

Application for registration.

(2) Subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think proper.

(3) The Registrar may refuse to accept any application for the registration of a trade mark upon which any of the following appear:—

- (a) the expressions "Patent", "Patented", "Registered", "Registered Design", "Copyright", "To counterfeit this is a forgery", or words to like effect;
- (b) representations of Her Majesty, or any member of the Royal Family, or any colourable imitations thereof;
- (c) representations of the Royal or Imperial Arms, crests, armorial bearings or insignia, or devices so nearly resembling them as to be likely to lead to mistake, or of the British Royal or Imperial Crowns, or of the Royal, Imperial or National flags, or the words "Royal" or "Imperial" or any other words, letters, or

devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorization ;

- (d) the expression "Anzac" ;
- (e) the expressions "Red Cross" or "Geneva Cross", and representations of the Geneva and other crosses in red, or of the Swiss Federal cross in white on a red ground or silver on a red ground, or such representations in a similar colour or colours ; and
- (f) any other expression or representation which may be prescribed.

(4) Where there appears in a trade mark the registration of which is applied for a representation of a cross in any colour, not being one of those mentioned in the last preceding subsection, the Registrar may require the applicant as a condition of acceptance to undertake not to use the cross device in red, or in white on a red ground or silver on a red ground, or in any similar colour or colours.

(5) Where a representation of the armorial bearings, insignia, orders of chivalry, decorations or flags of any state, city, town, place, society, body corporate, institution or person appears on a trade mark, the Registrar, before proceeding to register the mark, shall, if he so requires be furnished with a consent to the registration and use of such emblems from such official or other person as appears to the Registrar to be entitled to give such consent, and in default of such consent, he may refuse to register the mark.

(6) Where the name or representation of any person appears on a trade mark, the Registrar shall, if he so requires before proceeding to register the mark, be furnished with consent from that person or, in the case of a person recently dead, from his legal representatives, and in default of such consent, the Registrar may refuse to register the mark.

(7) Where the name or description of any goods appears on a trade mark, the Registrar may refuse to register such mark in respect of any goods other than the goods so named or described.

(8) Where the name or description of any goods appears on a trade mark, and such name or description in use varies, the Registrar may permit the registration of the mark for those and other goods, and in that case the applicant shall state in his application that the name or description will be varied when the mark is used upon goods covered by the specification other than the named or described goods.

(9) In the case of an application for registration of a trade mark (other than a certification trade mark) 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 and deal with the application accordingly.

(10) In the case of a 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 thereat, and the decision shall be subject to appeal to the court.

(11) An appeal under this section shall be made in the prescribed manner, and upon appeal, the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(12) Appeals under this section shall be heard on the materials stated as aforesaid by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated as aforesaid 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.

(13) 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 the court, as the case may be, may think fit.

Opposition to registration.

19. (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted :

Provided that the Registrar may cause an application to be advertised before acceptance if it is made under paragraph (e) of subsection (1) of section 10, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof 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.

(5) If the applicant sends such a counter-statement as aforesaid, 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 limitations, if any, registration is to be permitted.

(6) The decision of the Registrar shall be subject to appeal to the court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal, the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.

(9) On an appeal 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 so stated as aforesaid by the opponent 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.

(10) On an 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 thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(11) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Ceylon, the Registrar or the court may require him to give security for costs of the proceedings relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

Registration. 20. (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—

(a) the application has not been opposed and the time for notice of opposition has expired;

or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error or unless the court otherwise directs, register the trade mark in Part A or Part B, as the case may be, and the trade mark when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the preceding provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall not apply in the case of a trade mark registered under section 46 in accordance with any international arrangements.

(2) A trade mark shall be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Registrar, and the Registrar's decision thereon shall be final and conclusive.

(3) On the registration of a trade mark, the Registrar shall issue to the applicant, in the prescribed form, a certificate of the registration thereof under the hand of the Registrar.

(4) In case of the death of any applicant for the registration of a trade mark after the date of his application, and before the trade mark applied for has been entered in the register, the Registrar, after the expiration of the prescribed period of advertisement and the determination of any opposition to the application may, on being satisfied of the applicant's death, enter in the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the trade mark, on such ownership being proved to the satisfaction of the Registrar.

(5) Where registration of a trade mark is not completed within twelve months from the date 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 the notice.

21. (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section :

Duration and
renewal of
registration.

Provided that, in relation to a registration as of a date before the appointed day, this subsection shall have effect as if there were substituted for the said period of seven years, a period of fourteen years.

(2) 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 the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as "the expiration of the last registration".

(3) 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 of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application

for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register :

Provided that the preceding provisions of this subsection shall not have effect where the Registrar or the court is satisfied either—

- (a) that there has been no bona fide trade use of the trade mark that has been removed during the two years immediately preceding its removal ;
or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

Registration of parts of trade marks and of trade marks as a series.

22. (1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole mark and that part of the mark as separate trade marks.

Each such separate trade mark must satisfy all the conditions of an independent trade mark. Upon registration, each such separate trade mark shall, subject to the provisions of subsection (3) of section 24 and subsection (2) of section 30, have all the incidents of an independent trade mark.

(2) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statements of the goods in relation to 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 those trade marks, they may be registered as a series in one registration.

ASSIGNMENT AND TRANSMISSION

23. (1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

Powers of, and restrictions on, assignment and transmission.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) The provisions of subsection (1) and subsection (2) of this section shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in the preceding provisions of this section, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or

have subsisted, whether under the common law or by virtue of registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion :

Provided that, where a trade mark is, or has been, assigned or transmitted in such case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within Ceylon (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside Ceylon.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the statement, the proposed assignment of the first-mentioned trade mark would or would not be invalid under the last preceding subsection, and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation be conclusive as to the validity or invalidity under the last preceding subsection of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 26 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1) to (3) of this section, a trade mark shall not, on or after the appointed day, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by virtue of registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in Ceylon, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in Ceylon:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the appointed day, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4) of this section, so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 26 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Where an assignment, in respect of any goods, of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the appointed day, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on

which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

(8) Any decision of the Registrar under this section shall be subject to appeal to the court.

Certain trade marks to be associated so as to be assignable and transmissible as a whole only.

24. (1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks. Any decision of the Registrar under this subsection shall be subject to appeal to the court.

(3) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section 22, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of subsection (2) of section 22, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to

any of the goods in respect of which it is registered, and may amend the register accordingly. Any decision of the Registrar under this subsection shall be subject to appeal to the court.

25. Subject to the provisions of this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

Power of registered proprietor to assign and give receipts.

26. (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

Registration of assignments and transmissions.

(2) Any decision of the Registrar under this section shall be subject to appeal to the court.

(3) Except for the purposes of an appeal under this section or of an application under section 32, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

USE AND NON-USE

27. (1) Subject to the provisions of section 37, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered, on application by any person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 61 to the Registrar, on the ground either—

Removal from register and imposition of limitations on ground of non-use.

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in

relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application ; or

- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being :

Provided that (except where the applicant has been permitted under subsection (2) of section 13 to register an identical or nearly resembling trade mark in respect of the goods in question or where the court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark) the Registrar or the court may refuse an application made under paragraph (a) or paragraph (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1) of this section on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

Registered
users.

28. (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the "permitted use" thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 27 and for any other purpose for which such use is material under this Act or the common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant. A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the Registrar in the prescribed manner and shall furnish him with a declaration verified by affidavit made by the proprietor, or by some person authorized to act on his behalf and approved by the Registrar—

(a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered

user or that there shall be any other restriction as to persons for whose registration as registered users application may be made ;

- (b) stating the goods in respect of which registration is proposed ;
- (c) stating any conditions or restriction proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter ; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof ;

and with such further documents information or evidence as may be required under the rules made in that behalf or by the Registrar.

(5) When the requirements of the preceding subsection have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied and subject as aforesaid.

(6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the preceding provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.

(8) Without prejudice to the provisions of section 32, the registration of a person as a registered user—

- (a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect,

on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates ;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark ; or

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say,—

(i) that the registered user has used the trade mark otherwise than by way of permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion ;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration ;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by rules for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under the preceding subsection to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules made in that behalf an opportunity of being heard.

(10) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(11) Any decision of the Registrar under this section shall be subject to appeal to the court

(12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

Proposed use
of trade mark
by corpora-
tion to be
constituted,
&c.

29. (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

(a) if the Registrar or the court is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to use thereof in relation to those goods by the corporation; or

(b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Registrar or the court is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Registrar or the court is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The provisions of section 27 shall have effect, in relation to a trade mark registered under the power conferred by the preceding subsection, as if for the reference, in paragraph (a) of subsection (1) of that section, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) The Registrar or the court may, as a condition of the exercise of the power conferred by subsection (1) of this section in favour of an applicant who relies

on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings relative to any opposition or appeal, as the case may be, and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods, under the powers conferred by subsection (1) of this section, in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless, within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

30. (1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the Registrar or the court may, if and so far as it appears to be right in the circumstances of the case, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

Use of one of associated or substantially identical trade marks equivalent to use of another.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 22.

31. The application in Ceylon of a trade mark to goods to be exported from Ceylon, and any other act done in Ceylon in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded within Ceylon, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or under the common law.

Use of trade mark for export.

RECTIFICATION AND CORRECTION OF THE REGISTER

General power to rectify entries in register.

32. (1) 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, may apply in the prescribed manner to the court or, at the option of the applicant and subject to the provisions of section 61, to the Registrar, and the court or the Registrar, as the case may be, may make such order for making, expunging or varying the entry as may seem just.

(2) The court or the Registrar 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.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the court under the provisions of this section.

(4) Any order of the court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B thereof.

Power to expunge or vary registration for breach of condition.

33. On application by any person aggrieved to the court, or at the option of the applicant and subject to the provisions of section 61, to the Registrar or on application by the Registrar to the court, the court or the Registrar, as the case may be, may make such order as may seem just for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

34. (1) The Registrar may, on request made in the prescribed manner by the registered proprietor—

Correction
of register.

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark ;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark ;
- (c) cancel the entry of a trade mark on the register ;
- (d) strike out any goods or classes of goods from those in respect of 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 the trade mark.

(2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

35. (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for permission to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse permission or may grant such permission on such terms and subject to such limitations as he may think fit.

Alteration
of registered
trade mark.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Registrar under this section shall be subject to appeal to the court.

(4) Where permission as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised in the form to which it has been altered, in an advertisement under subsection (2) of this section.

Adaptation
of entries in
register to
amended or
substituted
classification
of goods.

36. (1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The Registrar shall not, in the exercise of any power conferred on him for the purpose referred to in subsection (1), make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods :

Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose referred to in subsection (1) shall be notified to the registered proprietor of the trade mark affected and shall be subject to appeal by the registered proprietor to the court. Every such proposal shall be advertised with any modifications and may be opposed before the Registrar by any person aggrieved

on the ground that the proposed amendment contravenes the provisions of the preceding subsection, and the decision of the Registrar on any such opposition shall be subject to appeal to the court.

PART II

DEFENSIVE REGISTRATION AND CERTIFICATION MARKS

DEFENSIVE REGISTRATION

37. (1) Where a trade mark which consists of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 27, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 27.

Defensive registration of well known trade marks.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the court or, at the option of the applicant and subject to the provisions of section 61, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

CERTIFICATION TRADE MARKS

Marks registrable as certification trade marks.

38. (1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person :

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish as aforesaid, the Registrar or the court may have regard to the extent to which—

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

39. (1) An application for the registration of a certification trade mark under this section shall be made to the Registrar in writing in the prescribed manner by the person who claims to be the proprietor thereof.

Application
for registra-
tion of
certification
trade mark.

(2) The provisions of subsection (2) and of subsections (9) to (12) of section 18 shall have effect in relation to an application for registration under this section as they have effect in relation to an application under subsection (1) of section 18.

(3) In dealing, under the provisions referred to in subsection (2), with an application under this section, the Registrar shall have regard to the like considerations, so far as relevant, as if the application were an application under section 18 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a certification trade mark under section 38 shall, on or before such date as may be fixed by the Registrar, being a date before a decision is made on the application, transmit to the Registrar draft regulations for regulating the use of the trade mark.

(5) The Registrar shall consider each application having regard to the following matters, that is to say :—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered ;
- (b) whether the draft regulations are satisfactory ; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage,

and may either—

- (i) refuse to accept the application ; or
- (ii) accept the application, and approve the draft regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he may consider proper having regard to any of the matters aforesaid,

but, except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide the matter without giving to the applicant an opportunity of being heard :

Provided that the Registrar may, at the request of the applicant, consider the application with regard to any of the matters aforesaid, so however that the Registrar shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft regulations.

Proceedings
on applica-
tion.

40. (1) When an application has been accepted, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (11) of section 19 shall have effect

in relation to the registration of the mark as if the application had been an application made under section 18 :

Provided that, in deciding under the said provisions, the Registrar shall have regard only to the considerations referred to in subsection (3) of section 39, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Registrar under subsection (2) of this section of any opposition relating to any of the matters referred to in subsection (5) of section 39.

(2) When notice of opposition is given relating to any of the matters referred to in subsection (5) of section 39, the Registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

41. (1) In respect of every certification trade mark registered under section 38 there shall be deposited by the proprietor at the office of the Registrar a copy of the regulations approved by the Registrar for regulating the use of that trade mark, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorize the use of the trade mark, and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorize the use of the trade mark in accordance with the regulations). Regulations so deposited shall be open to inspection in like manner as the register.

Deposit of regulations relating to each registered certification trade marks.

(2) The regulations deposited in respect of a certification trade mark, may, on the application of the registered proprietor, be altered by the Registrar.

(3) The Registrar may cause an application for his consent under subsection (2) to be advertised in any case where it appears to him that it is expedient so to

do, and, where the Registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

Consequences
of regis-
tration of
certification
trade marks.

42. (1) Subject to the provisions of subsections (2) to (4) of this section, and to the provisions of sections 8 and 9, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and without prejudice to the generality of the preceding provisions that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations framed in that behalf and using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being use as a trade mark ; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorization under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(2) The right to the use of a certification trade mark given by registration under section 38 shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation

to goods to be sold or otherwise traded in at any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a certification trade mark given by registration under section 38 shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

(a) in relation to goods certified by the proprietor of the trade mark, if as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorization under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark ; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor :

Provided that paragraph (a) of this subsection shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(4) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in the exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(5) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Registrar.

Power of court to direct amendment of the register or variation of regulations.

43. (1) The court may, on the application in the prescribed manner of any person aggrieved, or on the application of the Registrar, make such order as it may think fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground—

- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods ;
- (b) that the proprietor has failed to observe a provision of the deposited regulations required to be observed on his part ;
- (c) that it is no longer to the public advantage that the trade mark should be registered ; or
- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied,

and neither the court nor the Registrar shall have any jurisdiction to make an order under section 32 on any of those grounds.

(2) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under the foregoing subsection.

Special provisions as to the award of costs.

44. Notwithstanding anything in section 51, the Registrar shall not award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorize the use of the trade mark.

Exclusion of certain provisions of this Act.

45. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say—

- section 5 ;
- section 7 ;
- section 10 ;

subsections (1), (2), (8) to (12) of section 18, and section 19 (except as expressly applied by sections 39 and 40) ;
subsections (4) to (8) of section 23 ;
sections 27 to 29 (both inclusive) ;
section 37 ;
section 73 ; and

any provisions the operation of which is limited by the terms thereof to registration in Part B only of the register.

PART III

INTERNATIONAL ARRANGEMENTS

46. (1) Any person who has applied for protection for any trade mark in a Convention country shall, on application by himself or his heirs, executors, administrators or assigns, and subject to the provisions of this Act as to the admissibility of a trade mark to registration, be entitled to procure the registration of that trade mark under this Act in priority to other applicants ; and such registration shall have the same date as the application in the Convention country if the application for such registration in Ceylon has been made within six months after the date on which application was made in the Convention country.

Registration of trade marks for which protection has been sought in a Convention country.

(2) Nothing in this subsection shall be deemed or construed to entitle the proprietor of a trade mark to recover damages for any infringement of a trade mark which has occurred before the date of the actual registration of that trade mark in Ceylon.

(3) The use in Ceylon of any trade mark referred to in subsection (1) of this section during the period of six months specified in that subsection shall not invalidate the registration of that trade mark in Ceylon.

(4) The application for the registration of a trade mark under this section shall be made and dealt with in the same manner as if it were an application under section 18 for the registration of a trade mark under this Act.

(5) Where a person has applied for protection for any trade mark by an application which—

- (a) in accordance with the terms of a treaty subsisting between any two or more Convention countries, is equivalent to an application duly made in any one of those Convention countries, or
- (b) in accordance with the law for the time being in force of any Convention country, is equivalent to an application duly made in that Convention country,

he shall be deemed for the purposes of this section to have applied for protection for that trade mark in that Convention country.

PART IV

GENERAL

RULES AND FEES

Power to
make rules.

47. (1) The Minister may make all such rules as may be necessary to carry out the provisions and give effect to the principles of this Act.

(2) Without prejudice to the generality of the provisions of subsection (1), the powers thereby conferred shall be deemed to include the powers to make rules for all or any of the following purposes :—

- (a) for regulating the practice and procedure under this Act, including the service of documents ;
- (b) for classifying goods for the purposes of registration of trade marks ;
- (c) for making or requiring duplicates of trade marks and other documents ;
- (d) for securing and regulating the publication, sale and distribution in such manner as the Minister thinks fit, of copies of trade marks and other documents ;
- (e) for prescribing the forms, the procedure, the conditions or restrictions and other matters required or authorized to be prescribed by this Act ; and

(f) for regulating the conduct of business at the office of the Registrar in relation to trade marks and all other matters by this Act placed under the direction or control of the Registrar.

(3) No rule made by the Minister shall have effect until it is approved by the Senate and the House of Representatives and notification of such approval is published in the Gazette.

48. There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Minister by rules made in that behalf.

Fees.

POWERS AND DUTIES OF REGISTRAR

49. (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar prima facie to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

Preliminary advice by Registrar as to distinctiveness.

(2) Any such person who is desirous of obtaining such advice shall make application to the Registrar therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to a refund of any fee paid upon the filing of the application.

50. Where any discretionary or other power is given to the Registrar by this Act or the 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

Hearing before exercise of Registrar's discretion.

duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

Power of Registrar to award costs.

51. In all proceedings before the Registrar under this Act, 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.

Power to make copies of damaged volumes of the register, to prepare and insert reconstructed folios and to rectify clerical errors or omissions.

52. (1) Whenever the Registrar is satisfied that any volume of the register 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.

(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) Whenever the Registrar, after due investigation, is satisfied that any folio of any volume of the 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 and inserted 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.

(5) No folio shall be reconstructed as provided in subsection (4) except in accordance with rules providing—

- (a) for the 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 ; and
- (c) for the lodging of objections by any person affected by any of the particulars contained in the reconstructed folio and 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 effect as the folio which such reconstructed folio replaces.

(7) The Registrar may, after such enquiry as he may deem necessary, correct any clerical error or omission which may be discovered in any entry in the register or in any certificate 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.

53. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Attorney-General for directions in the matter.

Registrar
may take
directions
from the
Attorney-
General.

LEGAL PROCEEDINGS AND APPEALS

Registration to be prima facie evidence of validity.

54. In all legal proceedings relating to a registered trade mark (including applications under section 32) the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Certificate of validity.

55. 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 the trade mark, the court may certify to that effect, and if it so certifies, then, in any subsequent legal proceeding in which the validity of the registration comes into question, the proprietor of the 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 the subsequent proceedings the court certifies that he ought not to have them.

Cost of Registrar in proceedings before court, and payment of costs by Registrar.

56. In all proceedings before the court under this Act, the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not, in any proceedings in which he has appeared, be ordered to pay the costs of any other of the parties.

Trade usage, &c., to be considered.

57. In any action or proceedings relating to a trade mark or trade name, the Registrar or 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.

Registrar's appearance in proceedings involving rectification.

58. (1) 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.

(2) 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 or of the grounds of any decision given by him in

relation to the matter in issue or of the practice of his office in like cases or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

59. The court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 32), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Court's power to review Registrar's decision.

60. In any appeal from a decision of the Registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

Discretion of court in appeals.

61. Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the Registrar—

Procedure in cases of option to apply to court or Registrar.

(a) if an action concerning the trade mark in question is pending, the application shall be made to the court ;

(b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question between them, subject to appeal to the court.

62. Every order made by the court in any matter or proceedings under this Act shall be subject to an appeal to the Supreme Court, and every such appeal shall be preferred and prosecuted in accordance with the provisions of the Civil Procedure Code applicable to interlocutory appeals from District Courts.

Appeal from orders of the court.

Cap. 101.

STAMP DUTIES ON PROCEEDINGS

63. (1) Every application made to the court under section 27, section 32, section 33, or section 43 shall be subject to a stamp duty of two rupees.

Stamp duties on proceedings in the court.

(2) The minimum stamp duties chargeable in civil proceedings in District Courts under the law for the time being in force relating to such stamp duties shall, save as otherwise expressly provided in this Act, be charged in all proceedings in the court under this Act :

Provided, however, that the Registrar shall in no case be required to use any stamp or be charged with any stamp duty.

Stamp duties on appeals to the Supreme Court.

64. The minimum stamp duties chargeable in the Supreme Court under the law for the time being in force relating to stamp duties shall, save as otherwise expressly provided by this Act, be charged in all appeals preferred to the Supreme Court under this Act :

Provided, however, that the Registrar shall in no case be required to use any stamp or be charged with any stamp duty.

EVIDENCE

Mode of giving evidence.

65. (1) In any proceeding under this Act before the Registrar, the evidence shall be given by affidavit in the absence of directions to the contrary, but, in any case in which the Registrar thinks it right so to do, he may take evidence viva voce in lieu of or in addition to evidence by affidavit. Any such affidavit may in the case of appeal be used before the court.

Cap. 393.

(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 such commission.

Evidence of entries in register.

66. (1) A printed or written copy of any entry in the register, purporting to be certified by the Registrar, shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(2) Any person requiring any such certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

67. A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorized by this Act or the 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.

Evidence of things done by the Registrar.

OFFENCES

68. If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the 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 liable on conviction to imprisonment of either description for a term not exceeding seven years, or to a fine not exceeding one thousand rupees or to both such imprisonment and such fine.

Falsification of entries in register.

69. (1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark ; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered ; or
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered ; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

Falsely representing a trade mark as registered.

shall be guilty of an offence and liable on summary conviction to a fine not exceeding one hundred rupees.

(2) For the purposes of this section, the use in Ceylon in relation to a trade mark of the word "registered", or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of any foreign country, being a country under the law of which the registration referred to is in fact in force ;
- (b) where that word (being a word other than the word "registered") is of itself such as to indicate that the reference is to such registration as aforesaid ; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a foreign country and in relation to goods to be exported to that country.

Unauthorized
assumption of
Royal Arms,
&c.

70. (1) If any person, without the authority of Her Majesty, uses, in connection with any trade, business, calling or profession, the Royal Arms (or arms so closely resembling the Royal Arms as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorized so to use the Royal Arms, or if any person, without the authority of Her 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, Her Majesty or such member of the Royal Family, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding one hundred rupees.

(2) If any person, without the authority of the Governor-General, uses in connection with any trade, business, calling or profession, the arms of the Government of Ceylon (or arms so closely resembling those

arms as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorized to use those arms, or if any person, without the authority of the Governor-General, 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, the Government of Ceylon, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding one hundred rupees.

(3) Nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem or title to continue to use such trade mark.

71. (1) If any person, without the consent of the appropriate authority, uses in connection with any trade, business, calling or profession the name or any abbreviation of the name or the title, seal, emblem or device of any international organization to which this subsection applies, he shall be guilty of an offence, and shall be liable on summary conviction to a fine not exceeding one hundred rupees.

Unauthorized use of name, title, seal, &c., of international organizations.

(2) Subsection (1) shall apply to every international organization specified in that behalf by Order made by the Minister and published in the Gazette.

(3) The Minister shall in every such Order specify the officer or person who shall be the authority competent to give the consent referred to in subsection (1).

72. (1) If any person, without the consent of the appropriate authority, uses in connection with any trade, business, calling or profession the mark, seal, emblem or device (or any mark, seal, emblem or device so closely resembling such mark, seal, emblem or device as to be calculated to deceive) of any organization, institution or corporation, in which the Government of Ceylon has an interest and to which this subsection applies, he shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding one hundred rupees.

Unauthorized use of mark, seal, emblem or device of certain organizations.

(2) Subsection (1) shall apply to every mark, seal, emblem or device specified in that behalf by Order made by the Minister and published in the Gazette.

(3) The Minister shall in every such Order specify the officer or person who shall be the authority competent to give the consent referred to in subsection (1).

(4) Nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such mark, seal, emblem or device to continue to use such trade mark.

Use of religious pictures, names and titles.

73. (1) Any person who—

- (a) uses a religious picture as a trade mark, or
- (b) in connection with any trade, business, calling or profession and without the consent of the Minister, uses a religious picture otherwise than as a trade mark or uses a religious name or title whether as a trade mark or otherwise,

shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding one hundred rupees :

Provided, however, that it shall not be an offence under the preceding provisions of this subsection if a religious picture or a religious name or title—

- (a) is used, whether as a trade mark or otherwise, in connection with a trade or business in articles venerated by the followers of the religion with which such picture, name or title is associated, or
- (b) is made, printed or inscribed for sale or supply as an article of veneration, or
- (c) is set out in a publication which expounds matters relating to such religion or which is issued by or on behalf of an institution or organization controlled by persons who are followers of such religion, or
- (d) is made, printed or inscribed for any other purpose which the Minister may specify as an excepted purpose by Order published in the

Gazette and in at least one Sinhala newspaper, one Tamil newspaper and one English newspaper circulating in Ceylon.

(2) In this section—

“calling” and “profession” do not include a religious order;

“religious picture” means a representation of—

(a) the founder of a religion, or

(b) a deity or saint venerated by the followers of a religion, or

(c) an emblem or device associated with a religion; and

“religious name or title” means such name or title as is associated with a religion.

74. If any person contravenes the provisions of sections 70 to 73 he may, in lieu of or in addition to the punishment provided therein, at the suit of any person who is authorized to use any such name, mark, emblem, title, seal or device referred to therein, or of the Registrar, be restrained by injunction from continuing so to use the same.

Power to issue injunctions.

MISCELLANEOUS

75. The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

Change of form of trade connection not to be deemed to cause deception.

76. Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

Jointly owned trade marks.

(a) on behalf of both or all of them, or

(b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person. Subject as aforesaid, nothing in this Act shall be deemed to authorize the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Trusts.

77. There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

Recognition of agents.

78. Where by this Act any act is required to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may under and in accordance with the rules made in that behalf be done by or to an agent of that person who is resident in Ceylon and duly authorized in the prescribed manner.

REPEAL AND SAVINGS**Repeal and savings.
Cap. 150.**

79. (1) The Trade Marks Ordinance is hereby repealed.

(2) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, or thing done, under the Ordinance repealed by this Act; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force on the day immediately preceding the appointed day, 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 provision of this Act.

80. (1) Subject to the provisions of this section and of section 14, the validity of the original entry of a trade mark on the register of trade marks existing under the repealed Ordinance immediately before the appointed day 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 other purposes it shall be deemed to have been registered under this Act.

Validity of registration under previous law.

(2) No trade mark which was on the register at the commencement of the repealed 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.

(3) No trade mark which was on the register immediately before the appointed day and which under this Act is 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.

(4) Nothing in this Act shall be deemed—

- (a) to invalidate the original registration of a trade mark which was validly on the register immediately before the appointed day; or
- (b) to subject any person to any liability in respect of any act or thing done before the appointed day to which he would not have been subject under the law in force at the time such act or thing was done.

81. (1) The validity of an assignment or transmission of a trade mark effected or claimed to have been effected before the appointed day, in any such case as is mentioned in subsection (6) of section 23, shall be determined as if the provisions contained in subsections (1) to (5) of that section had not been enacted :

Assignments and transmissions prior to appointed day.

Provided that, on application made in the prescribed manner within two years next succeeding the appointed day, by a person who claims that an assignment or transmission of a registered trade mark to him or to a predecessor in title of his has been so effected, the Registrar shall have the like jurisdiction as under the proviso to subsection (6) of section 23, and an assignment or transmission approved by him shall not be deemed to have been invalid on the ground of the subsistence of such rights as are mentioned in the said subsection (6) or on the ground that the assignment or transmission was effected otherwise than in connection with the goodwill of a business or was effected in respect of some (but not all) of the goods in respect of which the trade mark was registered, if application for the registration under section 26 of the title of the person becoming entitled is made within six months from the date on which the approval is given, or was made before that date.

Any decision of the Registrar under this subsection shall be subject to appeal to the court.

(2) The provisions contained in section 23, and in the last preceding subsection, shall have effect without prejudice to any determination of a court of competent jurisdiction that was made before the appointed day, or to the determination of any appeal from a determination so made, or to any title acquired for valuable consideration before the appointed day.

Association of trade marks assignable or transmissible only as a whole.

82. Where immediately before the appointed day a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

83. Where a person is registered as a registered user of a trade mark on an application made within one year next succeeding the appointed day, subsection (2) of section 28 shall have effect in relation to any previous use (whether before or after the appointed day) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

Previous use of a trade mark by person becoming registered user after appointed day.

84. Section 31 shall be deemed to have had effect in relation to an act done before the appointed day as it has effect in relation to an act done after that day, without prejudice, however, to any determination of a court of competent jurisdiction which was made before the appointed day, or to the determination of any appeal from a determination so made.

Use of trade mark for export trade before appointed day.

INTERPRETATION

85. (1) In this Act, unless the context otherwise requires,—

Interpretation.

“appointed day” means the date appointed by the Minister by Order under section 1;

“assignment” means assignment by act of the parties concerned;

“Convention country” means any country that has acceded to or that may hereafter accede to and is a member of the International 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 Ceylon creating reciprocal rights and obligations in regard to trade marks and registration of trade marks between such country and Ceylon;

“the court” means the District Court of Colombo.

“limitations” means any limitations of the exclusive right to the use of a trade mark given by

the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place within Ceylon, or as to use in relation to goods to be exported to any market outside Ceylon ;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof ;

“permitted use” has the meaning assigned to it by subsection (1) of section 28 ;

“register” means the register of trade marks kept under this Act ;

“registered trade mark” means a trade mark that is actually on the register ;

“registered user” means a person who is for the time being registered as such under section 28 ;

“Registrar” means the Registrar of Companies and includes the Deputy Registrar and each Assistant Registrar of Companies, who has been authorized in writing by the Registrar of Companies to discharge the duties of the Registrar under this Act ;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and in relation to a certification trade mark, a mark registered or deemed to have been registered under section 38 ;

“transmission” means transmission by operation of law, devolution on the legal representative or heir of a deceased person, and any other mode of transfer not being an assignment.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.