

# **PROTECTION OF NEW PLANT VARIETIES (BREEDER'S RIGHTS)**

**SRI LANKA 2001**

Definitions:

1. For the purposes of this Act -

"Authority of a Convention Country" means the Authority entrusted with the implementation of the law on the protection of new varieties of plants for that country.

"breeder" means the person who has bred, or discovered and developed, a variety;

"holder" means the holder of a breeder's right;

"Office" means the National Intellectual Property Office of Sri Lanka (NIPOS):

"protected variety," means any variety that is the subject of a breeder's right,

"variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a Breeder's Right are fully met, can be -

- (a) defined by the expression of the characteristics resulting from a given genotype or combination of genotypes;
- (b) distinguished from any other plant grouping by the expression of at least one of the said characteristics; and
- (c) considered as a unit with regard to its suitability for being propagated unchanged.

## **PLANT BREEDER'S RIGHT**

Criteria for Protection.

2. Subject to this section and any other formal requirements of this Act, a right to be known as a plant breeder's right shall be granted in respect of plant varieties of those genera or species specified in the regulations where the variety is-

- (a) new;
- (b) distinct;
- (c) homogenous/uniform;
- (d) stable; and

given a variety denomination, which is acceptable for registration in accordance with section 22.

Novelty.

3. (1) Subject to subsections (2) and (3), a variety shall be considered new if the propagating or harvested material of the variety has not been sold or otherwise disposed of to others with the authorization of the plant breeder or his successor in title-
- (a) in Sri Lanka for longer than one year before the date on which protection is applied for under this Act; and
  - (b) outside Sri Lanka, for longer than six years in the case of trees or vines or longer than four years in the case of other plants, before the effective filing date in Sri Lanka.
- (2) It shall not be considered detrimental to the novelty of a variety if the propagating or harvested material of that variety has been sold or otherwise disposed of to others in [Sri Lanka] with the authorization of its breeder or his successor in title for up to four years prior to the inclusion of the genus or species to which the variety belongs in the list of genera and species specified in the Regulations, and for a maximum of six months after such inclusion where the application filed within six month period.

#### Distinctness.

4. (1) The variety is distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application or, where relevant, at the priority date.
- (2) The filing, in any country, of an application for a breeder's right or for entry in a catalogue of varieties admitted to trade shall be deemed to render the variety being the subject of the application a matter of common knowledge from the date of the application, provided that the application leads to the grant of the breeder's right or the entry in the catalogue, as the case may be.
- (3) Common knowledge may also be established by reference to various factors such as exploitation of the variety already in progress, entry of the variety in the register of varieties kept by a recognized professional association, or inclusion of the variety in a reference collection.

#### Homogeneity.

5. The variety shall be considered homogeneous if its plants show the same expression of the same characteristics, subject to the variation, which may be expected in view of the particular features of its sexual reproduction, or vegetative propagation.

#### Stability.

6. The variety is stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.
7. (1) The Minister may by Regulation, subject to subsection(2), publish a list of those genera and species to which this part applies and may also amend such list by adding new genera or species to it, modifying the names of the genera or species already published or by deleting such names, with effect from any prospective date specified in the Regulations.

(2) In compiling the list of genera or species, the Minister may exclude all varieties of that genus or species which are not characterized by a particular manner of reproduction or multiplication or by a certain end-use.

(3) Where a genus or species is deleted from the list of genera and species to which this Act applies with effect from a given date, the deletion shall not affect the rights of applicants who have filed applications for the protection of varieties of that genus or species before that date.

## **ENTITLEMENT TO PROTECTION**

Right to apply for protection.

8. (1) The breeder of the variety or his successor in title is entitled to apply for protection under this Act.

(2) Where two or more persons have bred, or discovered and developed, a variety jointly, entitlement to protection shall vest in them jointly and subject to any agreement to the contrary between the joint breeders, their shares in the property of the breeder's right shall be equal.

(3) Where a variety has been bred, or discovered and developed, by several persons independently of each other, the entitlement to apply for the grant of the breeder's right belongs to the person who has first applied for protection or filed an application with an earlier priority date at the Office.

(4) Where a variety has been bred, or discovered and developed, in the execution of a commission or an employment contract, the entitlement to apply for the protection shall belong in the absence of contractual provisions to the contrary, to the person who commissioned the work or to the employer.

Presumption of Ownership.

9. The applicant shall, in the absence of proof to the contrary, be presumed to be entitled to protection, but where the application is made by a successor in title, it shall be accompanied by sufficient proof of succession.

Applications by those not entitled.

10. (1) Where an application is filed by a person who is not entitled to protection, the person entitled may bring an action before the Court for the assignment of the application to him or if the plant breeder's right is already granted, for the assignment of the plant breeder's right.

(2) The action shall be statute barred after five years from publication of the grant of the plant breeder's right, save that an action brought against a defendant who has acted in bad faith shall not be subject to any limitation period.

Persons entitled to make application.

11. (1) An application for the grant of a plant breeder's right may be filed by the owner of the variety who is a -

(a) national or resident of Sri Lanka;

(b) national or resident of a convention country;

- (c) national or resident of any State which, is not a convention country but grants reciprocity of treatment to Sri Lanka.
- (2) Any person having neither residence nor registered office in Sri Lanka may be party to an action instituted pursuant to this Act and asserts rights deriving therefrom only if he has an agent resident or with an office in Sri Lanka.
- (3) The Agent shall be given the power in writing to act on his principal's behalf before the office and any other authority and in legal proceedings relating to the protection of new varieties of plant.
- (4) For the purpose of instituting legal proceedings by or against any person represented in the manner defined in subsection (2), the place which the Office identifies as the address of the representative, or where there are several representatives, the address of the main representative, or representative first designated, is deemed to be the place where the right in the variety is located.
- (5) The Agent means an agent referred to in Part VIC of the Code of Intellectual Property Act No. 52 of 1979 (as amended).

### **ASSIGNMENT AND TRANSFER OF THE APPLICATION OR OF THE PLANT BREEDERS' RIGHT**

- 12. (1) An application for the grant of plant breeder's right and the plant breeder's right may be assigned or may otherwise be transferred.
- (2) The assignment or transfer shall be in writing and shall be signed by the parties.
- (3) An assignment or transfer shall be registered in the Register on written request by any or all the parties to the assignment or transfer and on payment of the prescribed fee.
- (4) No assignment or transfer shall have effect against a third party until after such registration.
- 13. (1) Where there are two or more applicants for the grant of a plant breeder's right or where there are two or more holders of such a right in any protected variety, in the absence of any agreement to the contrary, each applicant or holder may separately transfer his shares, or exploit the variety as the case may be, or subject to this Act, exclude others from exploiting it.
- (2) In the case of the grant of an exclusive license however, the holders of the plant breeder's license may only jointly grant an exclusive license to a third party to exploit the variety.

### **SCOPE AND DURATION OF THE BREEDER'S RIGHT**

Scope of the breeder's right.

- 14. (1) (a) Subject to subsections 4 and 5, the following acts in respect of the propagating material of a protected variety shall require the authorization of the holder of the breeder's right granted in respect of the variety-

- (i) production or reproduction (multiplication);
- (ii) conditioning for the purpose of propagation;
- (iii) offering for sale;
- (iv) selling or other marketing;
- (v) Exporting;
- (vi) Importing; and
- (vii) Stocking for any of the purposes referred to in paragraphs (i) to (vi).

(b) The holder may make his authorization subject to conditions and limitations.

(2) Subject to subsections 4 and 5, the acts referred to in paragraphs (i) to (vii) of subsection (1)(a) in respect of harvested material, including entire plants and parts of plants, obtained through the unauthorized use of the propagating material of the protected variety shall require the authorization of the holder, unless the holder has had reasonable opportunity, before the harvested material is obtained, to exercise his right in relation to the unauthorized use of the propagating material.

(3) (a) The provisions of subsections (1) and (2) shall also apply in relation to varieties –

- (i) which are essentially derived from the protected variety, where the protected variety is not itself and essentially derived variety;
- (ii) which are not clearly distinguishable in accordance with section 4 from the protected variety; and
- (iii) whose production requires the repeated use of the protected variety,

(b) For the purposes of subparagraph (a)(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety"),

- (i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotypes of the initial variety;
- (ii) it is clearly distinguishable from the initial variety and
- (iii) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

(c) Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somoclonal variant, the selection of a variant individual from plants of the initial variety backcrossing, or transformation by genetic engineering.

Exceptions to breeder's right.

4. (I) The breeder's right shall not extend to -

- (a) acts done privately and for non-commercial purposes;
  - (b) acts done for experimental purposes; and
  - (c) acts done for the purpose of breeding other varieties, and, except where the provisions of section 14(3) apply, acts referred to in section 14(1) and (2) in respect of such other varieties.
- (II) The Minister may by regulations, within reasonable limits and subject to the safeguarding of the legitimate interests of the holders of breeder's right, restrict the breeder's right in relation to the varieties of any specified plant genera or species in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, the protected variety or a variety covered by section 14(3)(a)(i) or (ii).

#### Exhaustion of breeder's right.

- (5) (I) A breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of section 14(3), which has been sold or otherwise marketed by the breeder or with his consent in Sri Lanka, or any material derived from the said material unless such acts –
- (a) involve further propagation of the variety in question; or
  - (b) involve an export of material of the variety which enables the propagation of the variety, into a country, which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes
- (II) For the purposes of subsection (1), "material" means, in relation to a variety –
- (a) propagating material of any kind; and
  - (b) harvested material, including entire plants and parts of plants.

#### Maintenance of propagating material.

15. (1) The holder of a breeder's right shall, throughout the period for which the right is exercisable, be under an obligation to provide the Director with propagating material capable of producing plants which correspond to the characteristics defined for the variety when the right was granted.
- (2) The holder of a breeder's right shall also provide the Director with all such information and assistance as the Director may request for the purpose of ensuring that the holder of the breeder's right is fulfilling his obligations under subsection (I), including facilities for the inspection by or on behalf of the Director of the measures taken for, the maintenance of the variety.

#### Period of protection.

16. (1) subject to subsection(2), the breeder's right in respect of vines, forest trees, fruit trees and ornamental trees including in each case, their rootstocks, shall expire twenty five years after the grant thereof.
- (2) Protection for all other genera or species shall expire twenty years after the grant thereof.

(3) Where in the cases referred to in section 4(2), a variety has already been offered for sale or marketed in Sri Lanka for a period of more than one year before the date of the filing of the application, the duration of the protection shall be reduced by the number of full years minus one year that have elapsed since the beginning of the offering for sale or the marketing, with the authorization of the breeder or his successor in title, before the filing of the application.

Renewal fees.

17. The holder shall, every year during the period of protection, pay the Director the annual renewal fee prescribed, which fee shall fall due at the beginning of the calendar year to which it relates, and shall be payable by the 31<sup>st</sup> of January of each such calendar year.

### **TERMINATION, ANNULMENT AND FORFEITURE**

18. (1) The plant breeder's right shall terminate before the term expires where the holder of that right renounces it by written declaration addressed to the Director. The date of termination shall be that specified, in the declaration or, if none is specified, the date on which the declaration is received by the office. The Director shall record the termination in the Register.

(2) The Court shall declare a plant breeder's right null and void at the request of any person, where it is established that -

(a) the variety is not new or distinct within the meaning of, and on applicable dates referred to in sections 3 and 4; or

(b) the holder of the right is not the owner of the variety.

(3) The Director shall declare the plant breeder's right forfeit where the holder of the right -

(a) is no longer in a position to provide the Office on request with the propagating material capable of producing plants that correspond to the characteristics defined for the variety when the right was granted.

(b) does not pay the renewal fee that is due, having been reminded to do so by the Office, and after three months have elapsed since the date of the reminder.

(c) does not fulfil the obligation under Section 15(2).

(4) An appeal shall lie to the Court against any decision of the Director under this subsection.

(5) A license agreement made under this Act becomes ineffective if the plant breeder's right under which it was granted is declared null and void or forfeit, save however that no payment of any royalty which was due before the date of annulment or forfeiture can be demanded by the licensee in view of that annulment or forfeiture.

## **APPLICATION & PROCESSING**

### **Application.**

19. (1) An applicant for the protection of a variety shall file an application with the Office in the prescribed form and the application fee shall be paid at the same time.
- (2) The application form shall be accompanied by the technical questionnaire in the prescribed form, for the relevant genus or species, which shall be completed by the applicant to the best of his knowledge.
- (3) At the request of the Director, the applicant shall submit the amount of propagating material determined by him, on the date and at the place fixed by the Director.
- (4) Every application received by the Office and completed in accordance with this section, shall be published, including the date of filing, the name and address of the applicant and the original breeder, the variety denomination proposed under section 22 and the main characteristics of the variety as indicated in the application.
- (5) The application shall contain the following
  - (i) the name and address of the applicant and, where relevant, his agent;
  - (ii) the name and address of the breeder, if he is not the applicant;
  - (iii) the identification of the botanical taxon (Latin and common name);
  - (iv) the denomination proposed for the variety, or a provisional designation (breeder's reference);
  - (v) where the priority of an earlier application is claimed, the convention country with which the application was filed and the filing date;
  - (vi) a technical description of the variety;
  - (vii) proof of payment of the application fee.
  - (viii) a declaration that to the best of his knowledge the variety is new.
  - (xi) any other matter, as may be prescribed by regulations

### **Priority.**

20. (1) The applicant may avail himself of the priority of an earlier application (hereinafter) referred to as the "right of Priority" that has been duly filed for the same variety, by himself or by his predecessor in title, with the Authority of a convention country.
- (2) The right of priority shall be expressly claimed in the application filed with the Office and may only be claimed within a period of twelve months from the date of filing of the earliest application, but the day of filing shall not be included in the said period.
21. (1) In order to avail himself of the right of priority, the applicant shall submit to the Office, within three months from filing the application in Sri Lanka, a copy of the documents that constitute the earlier application, certified to be a true copy by the Authority with which that the application was filed in English translation.



(2) The effect of the right of priority shall be that, with respect to the conditions of protection attached to the variety, the application shall be deemed to have been filed at the date of the filing of the earlier application.

(3) The applicant shall be entitled to declare that he will submit the material mentioned in section 19(3) or any additional documents required by the Office at a later date, but no later than four years after the end of the priority period, unless the earlier application mentioned in Subsection(1), has been withdrawn in the country in which it was filed or has been rejected there.

(4) If any of the provisions of this section are not complied with, the application shall be dealt with as if no priority had been claimed.

## **VARIETY DENOMINATION**

22. (1) The applicant for plant breeder's right must, within three months after the filing of the application, propose in accordance with subsection(4), a variety denomination, which should be made on the form issued by the Office for that purpose.

(2) A variety denomination may consist of one word, combination of words subject to a maximum of three, combination of words and figures, of words and letters or of letters and figures, but shall not consist wholly of figures save however that in a word/figure combination, the figures shall have a meaning in relation to the words

(3) No person shall use as a variety denomination a designation which

(a) does not enable the variety to be identified;

(b) is liable to mislead a person of average attentiveness or to cause confusion concerning the origin, derivation, characteristics, value or identity of the variety, or the identity of the breeder;

(c) is identical to or can be confused with a variety denomination which in the country or in another Convention country designates an existing variety of the same or of a related botanical species, save however that the denomination shall be admissible, if the other variety is not registered and has not been grown for some considerable time;

(d) is identical to or can be confused with a designation in which a third party enjoys a prior right which would prohibit the use of the designation as a variety denomination;

(e) is contrary to public policy or morality;

(f) refers solely to attributes which are also common in other varieties of the species concerned;

(g) consists of a botanical or common name of a genus or species, or includes such a name, where this is likely to mislead or cause confusion;

(h) suggests that the variety is derived from or related to another variety when this is not the case;

(i) includes words such as "variety", "cultivar", "form", "hybrid", "cross" or translation of such words;

(j) is for reasons other than those mentioned in this subsection, not suitable as a generic designation of the variety.

(4) Where a variety is already protected by a convention country or where an application for the protection of the same variety is filed in such country only the variety denomination which has been proposed or registered in that other country, may be proposed and registered and the Director shall not register any other designation as a denomination for the variety, save however, that where the variety denomination used in the other country is inappropriate for linguistic reasons, or for any of the reasons mentioned in the preceding paragraph, the applicant may be requested to propose another variety denomination.

23. The Director shall publish the variety denominations which have been proposed to him or registered or cancelled by him.

24. (1) Any person who offers for sale or markets propagating material of a variety protected in Sri Lanka shall, even after the expiration of the protection, use the registered variety denomination only in so far as prior rights do not prevent such use.

(2) When a protected variety is offered for sale or marketed, a trademark, trade name or other similar indication may be associated with the registered variety denomination provided that the denomination is easily recognizable.

(3) The holder of plant breeder's right may not invoke any trademark, trade name or other right in his possession against a variety denomination legitimately used in the offering for sale or marketing of the variety by another person, even after the expiration of the protection.

25. Prior rights of third parties in a designation are not affected by this Act.

26. (1) The Director shall cancel any registered variety denomination at the request of

—

(a) any person or on his own initiative, if the denomination should not have been registered or if subsequently, facts become known which would have justified the rejection of the denomination;

(b) the holder of the plant breeder's right or of a third person, if a final court decision is delivered according to which the variety denomination must be cancelled or if it is established that a third-party right exists in the denomination and the holder of the plant breeder's right agrees to the cancellation;

(c) a person who is obliged to use the variety denomination under section 23(1), if he is prohibited by a final court decision from using that denomination, provided that the holder of the plant breeder's right had participated or had been given the possibility to participate in the court proceedings.

(2) In the case of the cancellation of the variety denomination, the Director shall request the holder of a plant breeder's right to submit, within an appropriate period fixed by him, a proposal for a new variety denomination, which shall be registered if it is considered admissible but where the proposal is not acceptable, another request for submission shall be made.

(3) The Office shall establish, at the request of the holder or a third person, a provisional variety denomination where the holder or the third person demonstrates a legitimate interest.

(4) Where, after the period for submitting a proposal for a new variety denomination has expired, the holder of the plant breeder's right has not submitted the requested proposal, the Office may establish on its own initiative, a provisional variety or permanent variety denomination.

27. The filing date of the application is fixed by the Office as the day on which the application form, the technical questionnaire, duly completed, and the fee are received.

## **EXAMINATION OF APPLICATION**

Formal examination of application.

28. (1) The Director shall examine the application to determine whether it and its supporting documents fulfil the requirements for applications under this Act and whether the required amount of propagating material has been submitted on the due date and at the proper place.

(2) Where any of the requirements referred to in subsection (1) have not been complied with, the Director shall reject the application for the grant of a breeder's right, unless the Director grants to the applicant a further period to complete the application or to submit the propagating material, but no such further period may be granted which will expire later than three months after the application date or the date fixed for submission of the material as the case may be.

Examination of novelty, distinctness etc.

29. (1) The Director shall examine the variety to determine whether it fulfills the requirements of novelty and where those requirements are not fulfilled, the Director shall reject the application.

(2) Where the requirements of novelty are duly fulfilled the Director shall invite the applicant, on a date fixed by him before the beginning of each year or testing period, to pay the prescribed testing fee for that year or testing period and failure to do so, by the applicant, shall cause the application to be rejected.

(3) The Director shall, after receiving the testing fee for the first year or for the first testing period, examine whether the variety fulfills the requirements of distinctness, homogeneity and stability.

(4) The Director for the purposes of the examination may enter into, subject to the regulations made by the Minister, arrangements with relevant institutions or persons both in or outside Sri Lanka to carry out scientific tests to determine the distinctness, uniformity or stability of the variety or may use the results of such tests that have already been carried out.

(5) The Director may treat the results obtained from, and expert opinions given by such institutions or persons, as results obtained from and opinions given by, the Director himself.

(6) Subject to section 21(3), the Director may, where necessary for an examination, request the applicant to submit additional material or documents within the period specified in the request and where the applicant fails to do so, without giving valid reasons for such failure, he shall reject the application.

(7) Where the examination shows that the application satisfies the requirements of novelty, distinctness, homogeneity and stability and that the proposed denomination of the variety can be registered, the Director shall grant a breeder's right.

(8) Where the examination shows that the variety is neither distinct, homogenous nor stable, the Director shall reject the application. The Director shall afford the applicant an opportunity to be heard before the application is rejected.

(9) Where the examination shows that the proposed denomination of the variety cannot be registered, the Director shall request the applicant to submit another denomination within a period fixed by him, failing which he shall reject the application.

(10) Where the Director makes a decision to grant breeders' right, he shall publish that decision; and he shall also reflect, in the publication, that an application for such a right has been made.

(11) (1) Where a breeder's right is granted, the holder of the right shall be entitled to equitable compensation for anything done during the application period which, if done after the grant of the right, would constitute an infringement of it.

(2) In this section "application period", in relation to the grant of breeder's right, means the period -

(a) beginning with the day on which details of the application for the grant of the right were published pursuant to section 19(4)- and

(b) ending with the grant of the right.

#### Examination of novelty, distinctness, etc. (Alternative Proposal)

29 (1) Where the requirements referred to in Section 28(1) are duly fulfilled, the Director shall submit the application to a competent institution under the Ministry of Agriculture or any other institution as prescribed by the Minister under regulation (which is referred to hereinafter as examination authority) to examine the variety to determine whether it fulfills the requirements of novelty. Where those requirements are not fulfilled the examination authority shall inform the Director accordingly and the Director shall reject the application.

(2) Where the requirements of novelty are duly fulfilled the examination authority shall invite the applicant, on a date fixed by him before the beginning of each year or testing period, to pay the prescribed testing fee for that year or testing period. Upon the failure of the applicant to do so the examination authority shall inform the Director accordingly and the Director shall reject the application.

(3) The examination authority shall, after receiving the testing fee for the first year or for the first testing period, examine whether the variety fulfills the requirements of distinctness, homogeneity and stability.

(4) Subject to section 21(3), the examination authority may, where necessary for an examination request the applicant to submit additional material or document within

a period specified in the request and where the applicant fails to do so without valid reasons the examination authority shall recommend the Director to reject the application and the Director shall accordingly reject the application.

(5) Where the examination shows that the application satisfies the requirements of novelty, distinctness, homogeneity and stability and that the proposed denomination of the variety can be registered, the examination authority shall recommend the grant of breeder's right to the Director who shall accordingly grant the breeder's right.

(6) Where the examination shows that the variety is neither distinct, homogenous not stable, the Director shall reject the application. The Director shall afford the applicant an opportunity to be heard before the application is rejected.

(7) Where the examination shows that the proposed denomination of variety cannot be registered, examination authority shall request the applicant to submit another denomination within a period fixed by him, failing which he shall recommend the rejection of the application to the Director who shall accordingly reject the application.

(8) Where the Director makes a decision to grant breeders' right, he shall publish that decision; and he shall also reflect, in the publication, that an application for such a right has been made.

(9) (1) Where a breeder's right is granted, the holder of the right shall be entitled to equitable compensation for anything done during the application period which, if done after the grant of the right, would constitute an infringement of it.

(2) In this section "application period", in relation to the grant of a breeder's right, means the period -

(a) beginning with the day on which details of the application for the grant of the right were published pursuant to section 19(4)- and

(b) ending with the grant of the right.

## **OPPOSITION**

30. (1) Within three months after the date of publication any person may file a notice of opposition in the prescribed form with the Director against the grant of the breeder's right on payment of the prescribed fee.

(2) The opposition shall be based on the following grounds, namely that;

(a) the applicant is not the owner of the variety.

(b) the variety is not new or distinct at the pertinent dates in accordance with sections 3, 4 and 21(2);

(c) it is neither homogeneous/uniform nor stable;

(d) the variety denomination that the office intends to register is inadmissible.

(3) The notice of opposition shall contain sufficient material to substantiate the grounds of opposition.

(4) Where, within the period specified in Section 30(1) the notice of Opposition in the prescribed form is received by the Director together with the prescribed fee and the material to substantiate the grounds of opposition, he shall serve a copy of the notice and other materials supplied by the opponent on the applicant and shall request him to present his observations on those grounds in writing within a period of 3 months together with the prescribed fee.

(5) On receipt of the observations of the applicant the Director shall after hearing the parties, if he considers such hearing necessary, decide, as expeditious as possible whether or not the grant of plant breeder's right can be confirmed. Where the opposition is justified, the Director shall, subject to subsection 6, revoke the decision to grant the breeder's right and reject the application.

(6) Where the opposition based on the claim that the variety denomination is inadmissible is justified, the Director shall revoke the decision that a plant breeder's right is to be granted and reopen the granting procedure by requesting the applicant to submit another denomination failing which the application shall be rejected.

(7) The Director may authorize a competent person to hear and determine the opposition. Such authorized person shall have and exercise the same power as under this Act are conferred upon the Director. The decision of such person shall be treated as a decision of the Director.

(8) Such authorized person shall entitle to an honorarium as prescribed for each decision he makes under this subsection. Such fee shall not be more than the opposition fee referred to in subsection (1).

(9) The grant of plant breeder's right shall be published.

(10) Where no opposition is filed within the period specified in subsection (1) or if all opposition duly filed have been rejected, the Director shall grant the breeder's right and register the variety denomination.

### **OPPOSITION (ALTERNATIVE PROPOSAL)**

30. (1) Within three months after the date of publication any person may file an opposition with the Director against the grant of the right on payment of the prescribed fee.

(2) The opposition shall be based on the following grounds, namely that;

- (a) the applicant is not the owner of the variety.
- (b) the variety is not new or distinct at the pertinent at the dates in accordance with sections 3, 4 and 21(2);
- (c) it is neither homogeneous/uniform nor stable.;
- (d) the variety denomination that the office intends to register is inadmissible.

(3) The notice of opposition shall contain sufficient material to substantiate the grounds of opposition.

(4) Where, within the period specified in Section 30 (1) the notice of opposition in the prescribed form is received by the Director together with the prescribed fee and

the material to substantiate the grounds of opposition, he shall serve a copy of the notice and other materials supplied by the opponent on the applicant and shall request him to present his observations on those grounds in writing within a period of 3 months together with the prescribed fee.

(5) On receipt of the observations of the applicant the Director shall after hearing the parties, if he considers such hearing necessary, decide, as expeditious as possible whether or not the grant of plant breeder's right can be confirmed. Where the opposition is justified the Director shall subject to subsection 6, revoke the decision to grant the breeder's right and reject the application.

(6) Where the opposition based on the claim that the variety denomination is inadmissible is justified, the Director shall revoke the decision that a plant breeder's right is to be granted and reopen the granting procedure by requesting the applicant to submit another denomination, failing which the application shall be rejected.

(7) The Director may request the examination authority to nominate a competent person and the examination authority shall upon such request nominate a suitable person to hear and determine the opposition. Such nominated person authorized by the Director shall have and exercise the same power as conferred upon the Director in respect of examination and opposition. The decision of such person shall be treated as the decision of the Director.

(8) Such authorized person is entitled to an honorarium as prescribed for each decision he makes under this subsection. (not more than the opposition fee)

(9) Where no opposition is filed within a period mentioned in subsection (1) or if all oppositions filed within that period have been rejected, the Director shall grant the plant breeder's right and register the variety denomination.

(10) The grant of a plant breeder's right shall be published.

### **PROCEDURE IN CASES OF REQUESTS FOR ANNULMENT AND FORFEITURE**

31. (1) A request for annulment of a plant breeder's right may be filed in Court by any person.

(2) A request shall be filed in a written reasoned statement by way of a petition and it may be filed even after the plant breeder's right has expired to which right holder and licensees shall be made party.

(3) The request may not be filed during the period within which an appeal may still be made against the grant of the plant breeder's right or while proceedings on such appeal are still pending before the Court.

(4) The Court shall declare the request inadmissible if it is not accompanied by a reasoned statement, or if it was filed during the period within which an appeal could still be made against the grant of the plant breeder's right, or while proceedings on such an appeal are still pending before the Court.

(5) If the request is admissible, the Court shall hear the holder of the plant breeder's right and may obtain any other evidence and shall conduct the hearing on its own initiative; and it shall continue the hearing if the request for the annulment is withdrawn.

- (6) If the Court finds that the request is not justified, it shall be rejected.
  - (7) Where the Court finds that the request is justified, it shall declare the plant breeder's right null and void. The court shall inform the Director of its decision who shall record the nullity of the registration in the Register.
- 32.
- (1) Proceedings for forfeiture of plant breeder's right shall be initiated by the Director on his own initiative if the condition under section 18 (3) (a) is fulfilled or may be initiated by the Director or a third party if any of the conditions under section 18 (3) (b) and (c) are fulfilled.
  - (2) A request shall not be necessary for the commencement of such proceedings but where any such request is filed, the Director shall treat it as a suggestion to initiate official proceedings.
  - (3) Before declaring a plant breeder's right forfeit, the Director shall hear the holder of that right.
  - (4) Where after having heard the holder of the plant breeder's right, the Director finds that there is no reason to declare the right forfeit, he shall declare the proceedings terminated and inform the holder of the right accordingly.
  - (5) Where the Director declares plant breeder's right forfeit, he shall also inform the holder, giving reasons therefore and shall the date of forfeiture.
  - (6) An appeal shall lie to the Court against any decision by which a plant breeder's right is declared forfeit and such appeal may be filed only by the holder of the plant breeder's right.
  - (7) The forfeiture shall be recorded in the register.
- 33.
- (1) The infringements of the right of the holder of plant breeder's right shall be actionable in the Court at the suit of the holder of that right and in any action for such an infringement all such relief by way of damages, injunction, accounts or otherwise shall be available in any corresponding proceedings in respect of infringements of other propriety rights.
  - (2) The Court shall have the authority -
    - (a) to grant injunctions to prohibit the committing, or continuation of committing, of an infringement of plant breeder's right, pursuant to section 14.
    - (b) to order the forfeiture, seizure and destruction of propagating material which has been produced in contravention of plant breeder's right.
    - (c) To fix the amount of damages taking into account the pecuniary and non-pecuniary loss suffered by the holder of the plant breeder's right.
  - (3) Where the person alleged to have infringed a right did not know or could not be reasonably expected to know that he was engaged in activity, that infringed a right the Court may limit damages to the profits attributable to the infringement.
  - (4) The court shall not, in respect of the same infringement, both award the holder of the plant breeder's right damages and order that he be given an account of profits.
34. The provisions of Chapter XXXII of the Code of Intellectual Property Act No. 52 of 1979 (as amended) shall apply mutatis mutandis to all proceedings before the Director and the Court under this Act.



35. (1) Any person who willfully offers for sale or markets propagating material of a variety protected in Sri Lanka without using the registered variety denomination, commits an offence and on conviction by a magistrate shall be liable to a fine of ... rupees.
- (2) Any person who wilfully makes use of the registered variety denomination of a variety protected in Sri Lanka, or a denomination likely to cause confusion therewith, or another variety of the same botanical or a related species commits an offence and on conviction by a magistrate shall be liable to .....
- (3) The provisions of part VI of the Code of Intellectual Property Act No 52 of 1979 (as amended) shall apply mutatis mutandis to the offences under this section.

### **LICENSES AND LEGAL PROCEEDINGS BY LICENSEE**

36. (1) The applicant for or the holder of plant breeder's right may grant to any person an exclusive or a non-exclusive license relating to all or any of the rights provided for under this Act
- (2) The license contract shall be in writing and shall require the signatures of the parties thereto,
- (3) A license contract shall be registered at the Office on request and on payment of the prescribed fee, but the license shall have no effect against a third party until after its registration.
- (4) The grant of an exclusive license shall be published.
37. In the absence of any provision to the contrary in the license contract, the grant of a license shall not prevent the licensor from granting further licenses to third parties or from exploiting the variety himself.
38. In the absence of provisions to the contrary in the license contract, rights granted therein shall not be assignable to a third party by the licensee, who shall not be entitled to grant a sub-license.
39. A clause in a license contract or relating to such a contract shall be null and void, in so far as it imposes upon the licensee, restrictions that do not derive from the rights conferred by the plant breeder's right or are unnecessary for the safeguarding of the right.
40. (1) Any holder of plant breeder's right or any applicant for the grant of plant breeder's right may declare that any person prepared to pay a royalty is entitled to use his variety, as from the date on which he has informed the holder or applicant accordingly.
- (2) The declaration shall be addressed to the Office and a remark to that effect shall be entered in the Register.
- (3) The royalty payable by the licensee of right shall be stated in the declaration to which subsection (1) refers, and shall also be entered in the Register.
- (4) After the entry in the Register, the holder of the plant breeder's right shall pay only half of the prescribed renewal fees.

- (5) Where all beneficiaries agree, the Office may cancel the entry under subsection (2), at the request of the holder of the plant breeder's right.
- (6) An appeal shall lie to the Court against any refusal to cancel the entry under subsection (2).
41. (1) At any time after the expiration of three years from the date of grant of plant breeder's right under this Act, any person interested may apply to the Court for the grant of a compulsory license, in respect of any plant breeder's right on the ground that it is necessary to safeguard the public interest in Sri Lanka.
- (2) Subject to subsections (4), (5) and (6), where the Court is satisfied that the ground referred to in subsection (1) is established, the Court may make an order for the grant of the license in accordance with the application on such terms as it thinks fit.
- (3) A license granted under this section, shall confer on the owner the non-exclusive right to perform all or any of the activities referred to in section 14.
- (4) Any person to whom a license is granted under this section shall pay such remuneration to the licensor as may be agreed, or as may be determined by a method agreed upon between that person and the licensor, or in the default of agreement, as is determined by the Court on the application of either party.
- (5) The Court may require the holder of the plant breeder's right to hold available for the owner of the compulsory license, the amount of propagating material necessary for making reasonable use of the compulsory license, against payment of adequate remuneration to the holder of the right and under conditions which are economically acceptable to him.
- (6) A license shall not be granted under this section unless-
- (a) the applicant for the license is financially able and otherwise in a position to exploit the plant breeder's right in a competent and business like manner, and must be prepared to do so;
  - (b) the holder of the plant breeder's right has refused to permit the applicant for the license to produce or market propagating material of the protected variety in a manner sufficient for the needs of the general public as referred to in subsection (1) above or is not prepared to give such permission under reasonable terms;
  - (c) no conditions exist under which the holder of the plant breeder's right cannot be expected to permit the use of his variety in the manner requested;
  - (d) the applicant for the compulsory license has paid the prescribed fee for the grant of such license.
- (7) The duration of the license shall be fixed by the Court and shall not, except under extraordinary circumstances, be granted for less than two or for more than four years but the period may be extended if the Court is satisfied, on the basis of a new application, that the conditions for granting a compulsory license continue to exist after the expiration of the first period.
- (8) Before granting a compulsory license, the Court may hear the national non-governmental organizations in the field of plant breeding and the seed trade.

- (9) Where the Court is satisfied that the grounds on which any license granted under this section have ceased to exist or that its owner has failed to comply with the conditions under which it was granted, it may, on the application of any interested party, terminate such license.
42. (1) Any licensee under a contractual or compulsory license or a licensee of right may, by registered letter, require the licensor to institute legal action necessary to obtain civil remedies or criminal penalties, in respect of any infringement of the plant breeder's indicated by the licensee.
- (2) Where the licensor refuses or neglects to institute the said legal action within three months after the request has been made, the licensee may institute such action in his own name, without prejudice to the right of the licensor to intervene in such action.
43. (1) The Director shall keep and maintain a register, to be known as the Register of Plant Breeder's Rights in which the following shall be entered:
- (a) any grant of a plant breeder's right;
  - (b) the number of the grant;
  - (c) the name and address of the grantee and if the grantee is resident outside Sri Lanka the address for service;
  - (d) date of application and grant;
  - (e) any change in the holder of that right;
  - (f) any annulment or forfeiture of the right;
  - (g) any submission, registration, change or cancellation of the variety denomination;
  - (h) any license of right or compulsory license granted, with an indication of the conditions of such licenses; and
  - (i) any other matter as may be prescribed;
  - (j) the conclusion of any license contract at the request of one of the parties to such contract.
- (2) A person who has paid the prescribed fee, is entitled during normal office hours, to examine the Register kept in accordance with section 43(1), and to obtain copies of or extracts from the information contained therein.

This Act shall prevail over and repeal all other laws governing breeder's rights in Sri Lanka.