ANALYSIS OF THE LEGAL REGIME FOR THE PROTECTION OF PATENT AND INDUSTRIAL DESIGNS IN NIGERIA

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MAY, 2021

DECLARATION

I hereby declare that this dissertation has been written by me and that it is my research. It has never been presented in any previous research for the award of Master of Laws Degree (LLM). All quotations and references are indicated with specific acknowledgements.

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CERTIFICATION

This Dissertation entitled,**ANALYSIS OF THE LEGAL REGIME FOR THE PROTECTION OF PATENT AND INDUSTRIAL DESIGNS IN NIGERIA** meets the regulations governing the award of Master of Laws (LL,M) of Ahmadu Bello University, Zaria and is approved for its contribution to legal knowledge and literary presentation.

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DEDICATION

This work is dedicated to my late Paternal and Maternal grandparents. May Allah continue to grant them eternal rest. Ameen!

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First and foremost, I acknowledge Allah, The most Gracious and the most Merciful, the ultimate Pilot of my life. Without whom I wouldn't have gotten to this stage of life. I remain grateful for seeing me through all the hurdles in the course of my study, research and life in totality.

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ABSTRACT

This dissertation analysed the legal regime for the protection of patent and Industrial Designs in Nigeria with the view to identifying the challenges hindering the effective protection of the subject matter. The global community has benefited from various forms of intellectual property which have not only ensured economic growth and development but have also led to improved standard of living, employment creation and high generation of revenue for the government. Patents and industrial designs are forms of intellectual property which have been exploited by countries of the world to achieve economic and social boost and to solve problems in various sector of national life such as defence, education, and health. As a result of the importance of patent and industrial design, countries have long been setting up appropriate systems and Legal framework to achieve this. Nigeria as a developing country is not left out in this global efforts. Thus, this dissertation through doctrinal and empirical approach of research carried out an in-depth analysis of patent and industrial design in Nigeria with special focus on the legal and institutional frameworks for the protection of patents and industrial designs in Nigeria. The origin of patent and industrial design rights in Nigeria was traced, the applicable laws analysed, and remedies, defences, administration, jurisdiction and the challenges identified, findings which include that law regulating patent and industrial designs in Nigeria are inadequate. Consequent upon the foregoing, the research found that there is only one Patents and Industrial Designs registry in the whole of Nigeria which is situated in Abuja. Also, there is low level of public awareness on the generality of patent and industrial designs in Nigeria. Amongst others, this dissertation recommends that there is an exigent need to review the existing legal framework on the subject matter increasing the level of awareness and establishing more patent and industrial designs institutions in Nigeria.

TABLE OF CASES

Abgoronfov Grain Haulage and Transport Limited (1997-2003) 4 I.P.L.R. 139.	-	-	-	47
Adeleke v Lawal (2014) 3 NWLR (Pt. 1393), p. 4 S. C	-	-	-	78,86
Ajibowo& Co. Limited v Western Textile Mills Limited, (1976) 7 S.C 97.	-	-	-	13,57
Akuma Ind. Ltd v Ayman Ent. Ltd. (1999) 13 NWLR (Pt. 633) 68.	-	-	-	74,81
Anton Piller KG v Manufacturing Processes Limited (1976) Ch. 55	-	-	-	79
Apple Inc. v Samsung Electronics Co. (2012) US 580	-	-	-	77
Arewa Textiles PLC and Others vFinetex Limited (2003) 7 N.W.L.R 322	-	-	-	37,70
Auchinclossv Agriculture & Veterinary Supplies Limited (1997) RPC 649.	-	-	-	73
Ayman Ent.Ltd vAkuma Industry Ltd (2003)13 NWLR (pt.836)p.99	-	-	-	74
Beddings Holdings v INEC and others (2014) 3 CLRN 147	-	-	-	69
BejingCotec New Technology Corporation & Another vGreenlife Pharmaceuticals Company Limited and 5 others (2003) F.H.C.L 718	-	-	-	78
Black Horse Plastics Industries Limited v. Ceplas Industries Nigeria Limited. (1998) F.H.C.L. 348.	-	-	-	87
Buchamanv Alba Diagnostics Limited (2001) R.P.C.851	-	-	-	73
Chanrai& co. (Nigeria) Limited v. Khawan. (1965) All NLRAt 189	-	-	-	85
Chukwumereije and Sons (W/A) Limited vPatkum Industries Limited & Sons (1989) FHCLR 423.	-	-	-	52, 56
Chukwumereje and Sons (W/A) Limited v. Metropolitan Industries Ltd & Sons	-	-	-	84
Controlled Plastics v Black Horse Plastics Industries, Limited (1990-1991) F.H.C.L.R 180.	-	-	-	55,83,85
Farmer Build Ltd V Carrier Bulk Materials Handling ltd (1999) RPC 461	-	-	-	89
Femento Industrial S.AvMentmore Manufacturing Company Ltd. (1956) 4 R.P.C. 87 C.A	-	-	-	31
Ferodo Limited vUnibros Stores (1980) F.S.R 489.	-	-	-	79,88
Fette's Patent (1961) R.F.C 390.	-	-	-	41
FrearsonvLoe (1878)9 Ch. D 48.	-	-	-	73

General Tire & Rubber CO v Firestone Rubber Co. Ltd (1976)93 RPC 197	-	-	-	74
IyeruOkin Plastic Industries Limited v Metropolitan Industries Nigeria Limited (1986) F.H.C.L.R 336.	-	-	-	56, 66
James OitomenAgbonrofov Grain Haulage and Transport limited (1998) F.H.C.1.236.	-	-	33, 70, 78, 82	
Metropolitan Industries (Nigeria) Limited v Industrial Application (Nigeria) Limited [1973] I N.M.L.R.274	-	-	-	57
Ocular Sciences Limited v Aspect Vision Care Limited (1997) R.P.C 289	-	-	-	51
Oluwanishola Development Company v Guinness Insurance Company Limited (1980-(1986) Vol. 2 Nigerian Shipping Cases 275.	-	-	-	80
Peter E. Ventures (Nigeria) Limited vGazasonner Industries Limited & another (1998) 6 N.W.L.R. 619 C.A.	-	-	-	87
Pfizer Inc. v Polyking Pharmaceuticals Ltd. (1988) Vol 1 FHLR 1	- 78	-	34, 35, 72, 74, 77,	
Pfizer Limited vTyonex Nigeria Limited and Ebamic Pharmacy Limited,	-	-	-	69
Pittevil& Co. vBrakelsberg Melting Process Limited, 49 RFC 23 at 32	-	-	-	75
Proctor v Bennis, (1929) R.P.C. 241 at 248.	-	-	-	32,76
Reynolds v Herbert Smith & Company Limited (1913) 20 R.P.C 123.	-	-	-	25
Rokana Industries Limited v Maun (1993) FHCLR 243.	-	-	-	80,88
Sauder vWiel, (1893) 10 R.P.C.29	-	-	-	55
Sarg Aims Aluminum Products Limited v Stanley Akagha& Another [1994] F.H.C.S.188	-	-	-	83
SolignumvAdetola (1992) FHCLR 157 at 163	-	-	-	80
Sony Kabushiki Kaisahav. Shahani and Co. Limited (1986) F.H.C.L.R 1.	-	-	-	88
Spivap Nigeria Limited v Bola Alaba& Others (1991) F.H.C.L.R 181.	-	-	-	52,57, 66
Sumal Foods and Confectionary Limited v Wholesome Foods Processing Co. Limited (1990)3 1.P.L.R. 52.	-	-	-	86,87
Uwemedimov Mobil Producing Nigeria Limited (2011) 4 NWLR (Pt.1236) 80.	-	-	-	71
Van der Lady v Bamford (1963) R.P.C 61	-	-	-	31
Windsurfing International vTabur Marine (GB) Ltd (1985) R.P.C. 61.	-	-	-	26,75

LIST OF STATUTES

NIGERIAN STATUTES

Constitution of the Federal Republic of Nigeria (1999 as amended Cap C23 Laws of the Federation of Nigeria 2004).	-	-	-	81,90
Kaduna State Limitation Law, Cap.89, 1990	-	-	-	89
Limitation Act, Cap 522, Laws of the Federal Capital Territory, 2006	-	-	-	89
National Office for Technology Acquisition and Promotion Act, Cap. N 68, Laws of the Federation of Nigeria, 2004.	-	-	-	5,97,98
Patents and Designs Act, Cap. P2, Laws of the Federation of Nigeria, 2004.	-	-		5, 17, 18, 22
University of Ibadan Intellectual Property Policy of 2012	-	-	-	36

FOREIGN STATUTES

Industrial Property Act 2001, Kenya	-	-	-	51
Canada Industrial Designs Act 1985	-	-	-	52

CONVENTIONS

Berne Convention for the Protection of Literary and Article Work, 1886.	-	-	-	2
Patent and Designs (Convention Countries) Order of 1971	-	-	-	44

ABBREVIATIONS

CFRN	-	Constitution of the Federal Republic of Nigeria
Ch.D	-	Chancery Decisions
CJ	-	Chief Justice
CLRN	-	Commercial Law Report of Nigeria
CO	-	Company
D	-	Defence
DW1	-	Defence Witness One
FCT	-	Federal capital Territory
FHCLR	-	Federal High Court Law Reports
IBID	-	Ibidem
INC	-	Incorporation
IPLR	-	Intellectual Property Law Report
LFN	-	Laws of the Federation of Nigeria
LTD	-	Limited
NMLR	-	Nigerian Monthly Law Report
NOTAP	-	National Office for Technology Acquisition and Promotion
NWLR	-	Nigerian Weekly Law Reports
OP CIT	-	Opera Citato
P	-	Page

PDA	-	Patent and Designs Act
PIDC	-	Patent Information and Documentation Centre
PLC	-	Public Limited Company
PW1	-	Prosecution Witness One
RPC	-	Report of Patent Cases
SC	-	Supreme Court
SC	-	Supreme Court
UNESCO	-	United Nations Educational, Scientific and Cultural Organization
US	-	United State
VOL	-	Volume
V	-	Versus
WIPO	-	World Intellectual Property Organization

TABLE OF CONTENTS

Title Page - - - - - - - - - i

Declaration - - - - - - - - - ii

Certification - - - - - - - - - iii

Dedication - - - - - - - - - iv

Acknowledgement - - - - - - - - - v

Abstract - - - - - - - - - vii

Table of Cases - - - - - - - - - viii

Table of Statutes - - - - - - - - - x

Abbreviation - - - - - - - - - xi

Table of Contents - - - - - - - - - xiii

CHAPTER ONE: GENERAL INTRODUCTION

1.1 Background to the Study - - - - - - 1

1.2 Statement of Research Problem - - - - - 3

1.3 Aim and Objectives of the Study - - - - - 3

1.4 Justification of the Study - - - - - - 4

1.5 Scope of the Research - - - - - - - 4

1.6 Research Methodology - - - - - - 5

1.7 Literature Review - - - - - - - 5

1.8 Organizational Layout - - - - - - 19

CHAPTER TWO: LEGAL FRAMEWORK FOR THE PROTECTION OF PATENTS IN NIGERIA

2.1 Introduction - - - - - - - - *21*

2.2 Definition of Patent - - - - - - - 22

2.3 Historical Development of Patent Law in Nigeria - - - 23

2.4 Patentable and Non-Patentable Inventions - - - - 25

2.4.1 Patentable Inventions - - - - - - - 25

2.4.2 Non-patentable inventions - - - - - - 34

2.5 Categories of Person who may apply to register a Patent - - 34

2.5.1 Statutory inventor - - - - - - - 34

2.5.2 Persons who employ or commission others to work for them - 35

2.5.3 Persons to whom the invention has been assigned - - - 37

2.5.4 Persons to whom a license has been granted - - - - 38

2.6 Patent Application - - - - - - - 43

2.6.1 Foreign priority applications rule - - - - - 44

2.7 Examination and Grant of Patent - - - - - 45

2.8 Rights Conferred by Patent and Limitation - - - - 46

2.9 Duration, Lapse and Renewal of Patent - - - - 48

2.10 Nullity of a Patent - - - - - - - 48

2.11 Surrender of Patent - - - - - - - 49

CHAPTER THREE: LEGAL FRAMEWORK FOR THE PROTECTION OF INDUSTRIAL DESIGNS IN NIGERIA

3.1 Introduction - - - - - - - - 50

3.2 Definition of Industrial Designs - - - - - 51

3.3 Historical Development of Designs' Law in Nigeria - - - 53

3.4 Registrable and Non-Registrable Designs - - - - 54

3.4.1 Registrable designs - - - - - - - 54

3.4.2 Non-Registrable designs - - - - - - 58

3.5 Categories of Person's Who May Apply to Register an IndustrialDesign- 58

3.5.1 Statutory creator - - - - - - - 58

3.5.2 Person who employ or commission others to create a design - 59

3.5.3 Person to whom a design has been assigned - - - - 60

3.5.4 Person to whom a license has been granted - - - - 60

3.6 Industrial Design Application - - - - - - - 61

3.7 Duration and Renewal - - - - - - - - 64

3.8 Renunciation and Nullity of Industrial Design - - - 64

3.9 Rights Conferred by Registration of an Industrial Design - - 66

CHAPTER FOUR: INFRINGEMENT OF PATENTS AND INDUSTRIAL DESIGNS

4.1 Introduction - - - - - - - - 68

4.2 Patent Infringement - - - - - - - - 68

4.3 Defences to a Patent Infringement - - - - - 73

4.4 Remedies Available to a Patentee - - - - - 76

4.4.1 Damages - - - - - - - - 76

4.4.2 Injunction - - - - - - - - 77

4.4.3 Account for profits - - - - - - - 78

4.4.4 Orders for inspection and seizure (*Anton Piller Order*) - - 79

4.4.5 Delivery up - - - - - - - - 82

4.5 Industrial Designs' Infringement - - - - - 82

4.6 Remedies Available upon Infringement of an Industrial Design - 84

4.6.1 Damages - - - - - - - - 84

4.6.2 Injunction - - - - - - - - 86

4.6.3 Delivery Up - - - - - - - - 87

4.6.4 Order for Inspection and Seizure (*Anton Piller Order*) - - 88

4.7 Defences to Infringement of an Industrial Design Dispute - - 88

4.8 Jurisdiction over Patent and Industrial Design Disputes - - 90

4.9 Administration of Patent and Industrial Design in Nigeria - - 91

4.9.1 The Minister - - - - - - - - 91

4.9.2 The Registrar - - - - - - - - 92

4.10 Challenges Hindering the Effective Protection of Patents and Industrial Designs' Rights in Nigeria - - - - - 94

4.10.1 Lack of expert examiners - - - - - - 94

4.10.2 Lack of Effective Enforcement of our Intellectual Property Rights - 95

4.10.3 Obsolete legal regime - - - - - - - 95

4.10.4 Lack of efficient automated registry and electronic patent and industrial designs system - - - - - - 97

4.10.5 Low level of awareness of patent and industrial design - - 98

4.10.6 Inefficiency at the patent and designs Registry - - - 99

4.11 Statistics of Patent and Industrial Designs in Nigeria - - - 99

CHAPTER FIVE: SUMMARY AND CONCLUSION

5.1 Summary - - - - - - - - 102

5.2 Findings - - - - - - - - 102

5.3 Recommendations - - - - - - - 104

5.4 Conclusion - - - - - - - - 105

Bibliography - - - - - - - - 106

CHAPTER ONE

GENERAL INTRODUCTION

1.1 Background to the Study

Across the world, it is undisputable that what drives economy and social development is innovation in every country. There are intelligent people with great creativity and innovation, it is necessary that the capacities of such people are encouraged and utilized for national economic development.[1] According protection to people's innovation is one way of achieving such encouragement.

The field of intellectual property law is essentially related to the protection from theft of virtually all the intangible rights protecting commercially valuable products of the human intellect. Such legal protection accorded to various species of intellectual property namely; copyright, trademark and patent right do not only encourage the owners of such rights to engage their creative intellect, it also serves as incentive to others that have creative minds to put their creative intellect into use.[2] Without legal protection, it is doubtful if any reasonable person would dissipate energy into creating intellectual property for public consumption. Intellectual property is the product of the mind and has been described as man's only genuine property and as such, merits protection. The legislature of the State of Massachusetts in the United States of America once remarked in 1782 that there is no property as valuable as that which is produced by the labour of the mind.[3]

Intellectual property law is an area of law which deters others from copying or taking unfair advantage of the work or reputation of another and provides remedies when this arises. Under intellectual property law, owners are granted certain exclusive rights to a variety of intangible assets such as a literary and artistic work; discoveries and inventions, words, phrases, symbols and designs. Intellectual property law reward creators of intellectual property by preventing others from copying, performing or using the work in any form without permission.[4] The main purpose of protection as earlier mentioned, is to provide incentives for people to produce scientific and creative works that benefit the society at large.

It is pertinent to note that some forms of intellectual property such as copyright confers automatic protection in the creator of an eligible work upon fixation of the work in any definite medium of expression and without need for registration or compliance with any other

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[1] Agaba, I.A. (2013). *"Copyright Law: The Right of the Owner versus the Freedom of the User to Copy",* Ahmadu Bello University Journal of Commercial Law. Zaria, Nigeria, pp. 178-190.

[2] Ameh, I. (2012). "*An Appraisal of the Role of Nigerian Copyright Commission on the Enforcement of Copyright Laws in Nigeria*". Ahmadu Bello University Journal of Commercial Law, pp. 140-161.

[3] Ameh, I. (2014) *Analysis of the Legal and Institutional Framework for the Protection of Intellectual Property Right in Nigeria*. (Ph.D Thesis, Ahmadu Bello University Zaria, Nigeria). Retrieved from Kubanni.abu.edu.ng/jspui/handle/123456789/6304 accessed on 20 August,2021 at 10:27am.

[4] Adekola, I. & Eze, (2015) "Intellectual property rights in Nigeria: *A Critical Examination of the Activities of the Nigerian Copyright Commission", Journal of Law, Policy and Globalization* Vol. 35, p. 56 online article available at www.itse.org, accessed on the 9th August, 2018 at 2:35pm.

formality.[5] Whereas other forms such as patent, industrial designs require formal registration as a prerequisite to enjoy legal protection.[6]

1.2 Statement of Research Problem

Patent and Industrial Design are very important industrial properties with enormous economic and social benefits. The potentials of these Industrial Properties to boost national economy cannot be over emphasized. In his era of quest to diversify Nigeria's economy, government should be looking into providing more protection for Intellectual Property. This will improve revenue to the country and income to the owners of the patent or industrial design. Therefore, this research work will address the following questions;

a. How has the law protected patent and industrial design in Nigeria?

b. What are the rights conferred on patent and industrial design owners in Nigeria?

c. What are the challenges hindering the effective enforcement of patent and industrial design rights?

1.3 Aim and Objectives of the Study

The research aims at analyzing the legal regime for protection of patent and industrial designs in Nigeria with the view to achieving the following objectives.

a. To analyze the provisions of the law relating to the protection of patents and industrial designs in Nigeria.

b. To identify and examine the rights of patent and industrial design owners in Nigeria.

c. To examine the challenges hindering the effective enforcement of patent and industrial designs in Nigeria and proffer likely solutions and recommendations.

1.4 Justification of the Study

Giving the importance of patents and industrial designs as forms of intellectual properties and their potentials in economic growth and development, the research work comes

[5] Article 5(2) of the Berne Convention for the protection of Literary and Article work, 1886.
[6] Oyewunmi, A. (2018), *Nigerian Law of Intellectual Property,* University of Lagos Press and Bookshop Ltd, p. 32.

in handy in this period when Nigeria is going through severe economic challenges and requires diversification so as to reduce reliance on petroleum products.

This research will be of immense benefit to the government and owners as this will increase the revenue base of Nigeria and also provide income to owners of patent or industrial design which will in turn encourage more people to be innovative since they can reap the benefit of their hard work.

Essentially, this research will be of benefit to the legislatures and policy makers as this will point them to important areas to include in their proposed bill, economic growth and development plans. In addition, researchers (Lecturers, students, legal practitioner) and general Public that may be interested in this area of intellectual property will also benefit from the research work by using the work as a reference material and as a tool for enriching their awareness on the patent and industrial design.

1.5 Scope of the Research

The scope of this work is limited to two perspectives: From the territorial scope and from the patent and industrial design scope. From the territorial scope it will largely be within the territory of Nigeria. However, for purposes of analysis and point buttressing, the work may look into some other jurisdictions with the same legal system with Nigeria in relation to the patent and industrial design of the research.

While from the patent and industrial design scope, this work will be limited to the Patents and Designs Act[7] which forms the Legal framework on patents and industrial design in Nigeria as well as the NOTAP Act[8].

1.6 Research Methodology

In this work the doctrinal method and empirical approach were mainly adopted. The doctrinal method which consists of primary and secondary sources were explored. Primary sources are documents; whose source of authority is most authoritative. These include: laws made by any legislative (whether at federal, state or local government level). While secondary sources are not sources of law include: textbooks, journals, articles, seminar/workshop papers, conferences, reports, commentaries, law reviews and annotations.

In addition, with the present era of information technology and advancement, this work will explore the internet in addressing the patent and industrial design. Empirical research was carried out through facts, data and questionnaire collected from Stakeholders at the Patents and Designs registry.[9]

[7] Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[8] Cap. N68, *Laws of the Federation of Nigeria*, 2004.
[9] *Patents and Designs Registry*, Commercial Law Department, Federal Ministry of Industry, Trade and Investment, Abuja, Nigeria.

1.7 Literature Review

The field of intellectual property and its jurisprudence has been the subject of various academic materials written by authors, writers and commentators while examining the patent and industrial design of this work, it would be impossible to conduct a meaningful research in this area of law without reference to these materials.

Agaba[10] expressed the view that intellectual property has been under serious threat over the years, particularly in Nigeria. This problem according to him was responsible for the various laws that has been promulgated and the various amendments as well as the various international conventions and resolution. The writer in his work carried out a review of the copyright Act, tracing the origin, as well as examining the various provisions of the Act. The writer however did not extend his examination to other forms of intellectual property such as patent and designs. The present research intends to improve on the writer's work in that aspect.

Ameh,[11] while appraising the role of the Nigerian Copyright Commission in the enforcement of the copyright law in Nigeria, posits that protection accorded intellectual property serves as incentives to people with creative minds to put their creative intellect into use. The work examined the Nigerian Copyright Commission as well as some international bodies established for the protection of copyright. Again, this work is limited in its scope as it majorly focuses on copyright but the present work will improve on it by examining patent and industrial design as other areas of intellectual property.

Adekola T. & Eze S.[12] in their work *Intellectual Property Rights in Nigeria* asserted that the principal types of intellectual property are patents, copyrights and trademarks. Patent laws according to them, protects inventions that demonstrates technological progress. Copyright law protects a variety of literary and artistic works while trademark law protects words, slogans and symbols that serve to identify brands of goods and services. The writers' work is however limited to copyright and did not examine other types of intellectual property, a gap that will be filled in this work.

Ayodele & Damola,[13] in their work defined intellectual property as creations of the mind: inventions literary and artistic works and symbols, names images and designs use in commerce. They further stressed that intellectual property rights are property rights in something intangible that protect innovation and reward innovative activities. They went further by asserting that intellectual property refers to property rights in creation of the mind such as inventions, industrial designs, symbols, names, images among others. It allows people to own their creativity and innovations in the same way that they can own physical property and this indeed is the most valued asset owned by a person. The writers are of the view that there are two categories of intellectual property (a). Industrial property which includes inventions

[10] Agaba, op. cit. p. 178
[11] Ameh, I. Op. cit. p. 140
[12] Adekola, T. & Eze S. Op. cit. p. 56
[13] Ayodele & Damola (2016), *Patentability of Inventions under the Nigeria's Patent and Designs Act; An Examination.* An online article available at: https://www.ajol.info/index.php/naujilj/article/view/156739 accessed on 12th July,2019 at 3.42AM.

(patents) trademarks, industrial designs, and so on and (b) copyright which include literary and artistic work such as novels, poems and plays and artistic work including performing and recording right granted to anyone who invents any new and useful process or fundamentally impresses an existing process. However, their work does not cover issues on administration and jurisdiction on these patent and industrial designs.

Oyewunmi,[14] the author in chapter nine to sixteen extensively dealt with the patent and industrial design in Nigeria. She defined patent as legal rights that confer on inventors of new and useful products and process the right to exclude others from the commercial exploitation of the invention. The author also adopted the definition of World Intellectual Property Organization (WIPO) resources which defines a patents as a document issued upon application by a government office (or regional office acting for several countries) which describes an invention and creates a legal situation in which the patented invention can normally only be exploited (manufactured, used, sold. imported) with the authorization of the owner of the patent.[15] She further analyzed the requirement for patentability, the procedure for registration, the subsistence of patent rights, infringements of patents, remedies available to a Patent owner whose right has been infringed.

With regards to industrial design, the learned author adopts the definition provided by section 32 of the Patent and Design Act which provides that a design means an industrial design[16]. In addition, she describes industrial design as a form of intangible property which the law protects by grant of an exclusive right of exploitation for a limited duration to the statutory creator of the design thereby rewarding the inputs of creative effort, time and other resources that go into creation of designs.[17]

Furthermore, the author adopted the definition of industrial designs provided in the Patent and Design Act as any combination of lines or colors or both and a three dimensional form, whether or not associated with colours as long as it is intended by the creator to be used as a model or a pattern to be multiplied by industrial process and not solely intended to obtain a technical result.[18] This definition received judicial backing in the case of *F.O. Ajibowo and Co Ltd v Western Textiles Mills Ltd*.[19] In this case the plaintiff, a limited liability company, are textile manufacturers at Ilupeju Industrial Estate in the Ilupeju district of Lagos. The defendants are also a limited liability company. They deal in textile piece goods and have been the customers of the plaintiffs since 1970.After their incorporation on 15th November, 1972, the defendants acquired all "the rights, benefit and title" in respect of a textile check design known as K13/14 (Registration No. 000344). The design had been previously registered in the name of Francis Ajibowo & Co. who was issued with a certificate of registration by the Registrar of Patents and Designs. The certificate (Exhibit. 1) is dated 30th December, 1971. Earlier, on 13th August, 1971,

[14] Oyewunmi, A.O (2018), *Nigerian Law of Intellectual Property*. University of Lagos Press and Bookshop Ltd.
[15] WIPO, *Intellectual Property Handbook* (2nd ed. Geneva: WIPO, Publication No. 489 (e) 2004).
[16] *Patents and Designs Act* Cap p2 *LFN*, 2004.
[17] Oyewunmi, A.O (2018), *Nigerian Law of Intellectual Property.* University of Lagos Press and Bookshop Ltd, p. 205
[18] Section 12, *Ibid*.
[19] (1976) 7 SC 97

Francis Ajibowo and Company (the defendants' predecessor- in-title of the design), by letter ordered some 10,000 yards of the design from the plaintiffs. The letter (Exhibit 2) reads- "Dear Sir, Booking 10,000 yards on a new design. We write to book 10,000 yards on our new design. We would like the goods in the four colour ways, each to the quantity of 2,500 yards as attached with this booking order. The colour 4 is a different design but we would want its colour to be our colour 4 on our new design. We would like the goods supplied to our company and our company only. Please early production and supply will be appreciated. Thanks in advance. Yours faithfully, FRANCIS AJIBOWO & COMPANY FOR Francis Ajibowo Managing Director." The plaintiffs accepted the order and completed it between October and December, 1971. According to the plaintiffs, Francis Ajibowo & Co. took delivery of only 7,774 yards of the said order. They refused to clear the balance of 2,226 yards in spite of repeated requests from the plaintiffs to do so. Because of this, a second order by Francis Ajibowo & Co. for another 10,000 yards of the same new design, booked by letter dated 23rd October, 1971, (Exhibit 4) was not executed. As we had pointed out earlier, Francis Ajibowo & Co. registered the design just over two months later on 30th December, 1971. They transferred the registered design to the defendants after their incorporation on 15th November, 1972.On 23rd August, 1972, that is, about ten months after they had rejected the second order of Francis Ajibowo Company, the plaintiffs applied to the Registrar of Patents and Design for the registration of the same design which had already been registered by Francis Ajibowo & Company. The design was again registered for the plaintiffs, no doubt, in error. Latter, when it was discovered that the design had been registered earlier for another party, the plaintiffs' registration was cancelled by the Registrar by letter dated 8th September, 1972 (Exhibit 10) which reads:- "The General Manager, Western Textile Mills Ltd., Plot A1, Block IX, Ilupeju Industrial Estate, P.O. Box 2800, Lagos. Registration of Designs Cancellation of Certificate of Registration Re: Certificate No. 000331. I regret to inform you that Designs Registration Certificate No. 000331 issued to Western Textile Mills Limited in respect of "Textile Piece Goods only (Checks)" with effect from 25th day of August, 1972, and which was delivered to your Manager on Tuesday, 5th September, 1972, is hereby cancelled. 2. The certificate was issued to your company in error, because a certificate has been issued to FRANCIS AJIBOWO & COMPANY OF 143 NNAMDI AZIKIWE STREET, LAGOS in respect of the same identical design with effect from 30th December, 1971: the issue to you of the certificate is therefore contrary to Section 14 of the Patents and Designs Decree No. 60 of 1970. (Sgd.) J.A. Adeosun. Registrar of Patents & Designs. On 24th March, 1973, the plaintiffs, no doubt annoyed by this decision, instituted proceedings against the defendants in the High Court of Lagos State in which they claimed as follows: "The plaintiffs' claim against the defendants is for a declaration that the Design Registration No. 000344 of 30th December, 1971 in the name of Francis Ajibowo & Company, the defendants' predecessor-in-title, is null and void pursuant to Section 22 of the Patents and Designs Decree, 1970." Paragraphs 9 and 10 of their Statement of Claim read- "9. The plaintiff avers that Design Registration No. 000344 (K13/14) is void and of no effect in law because it did not comply with the provisions of the Patents and Designs Decree, 1970. 10. The plaintiff has a material interest in taking this action in that (a) it has to mitigate the financial loss caused by the defendant's refusal to take delivery of the 2,226 yards referred to in paragraph (8) supra by selling same, and (b) the defendant is threatening litigation against the plaintiff for an alleged infringement of its design. In their Statement of Defence, the defendants after explaining how they came to acquire the registered design from Francis Ajibowo & Co., averred

that the plaintiffs have no material interest in the registered design other than that of having the same design registered in their favour. The defendants thereupon counter-claimed as follows:- "COUNTERCLAIM 1. The defendants counterclaim that they are the validly registered owners of Design No. K/13/14 registered at the Registry of Patents and Designs, Federal Ministry of Trade in Lagos as Certificate No. 000344 of 30th December, 1971. 2. The defendants will at the trial show that the plaintiffs knowingly and willfully infringed the said Design when they wove several yards of material to the said defendants' Design Certificate No. 000344 and sold same to several persons. 3. The defendants further claim for: (i) an injunction to restrain the plaintiffs by their directors, officers, employees, servants or agents or otherwise howsoever from infringing the said defendants' registered Design Certificate No. 000344; (ii) an order for the delivery up or destruction on oath of all articles or chemical components or catalogue of Designs in the plaintiffs' possession, custody or power which infringe the said registered Design; (iii) an inquiry as to damages or at the defendants' option an account of the profit and payment of all sums found due upon taking such inquiry or account; or in the alternative, special and general damages of N150,000 (One Hundred and Fifty Thousand Naira); and (iv) such further or other reliefs as this Honorable Court may deem fit." At the hearing, Ebenezer Festus Olabode, the sales director of the plaintiffs (1st P1/W) testified that Francis Ajibowo & Co., was their customer and that after the defendants were incorporated they also became their customers. He then continued: - "I know the design which is the cause of the present action. We manufactured the design for Mr. Ajibowo. He first brought the design. The design is a popular design. He first brought it before other customers. He brought a cutting of the design in August, 1970." He further testified about the order given to them by Francis Ajibowo and about how, after the order had been completed, he failed to clear the outstanding quantity which they had to sell. He said they did nothing to infringe the defendants' design. Under cross-examination, the witness testified further as follows: - "Apart from the quantity of the design not cleared by Ajibowo from the first order and which quantity was sold to other customers after due warning to Ajibowo, the plaintiffs, to my knowledge, did not manufacture for nor manufacture on their own and sell to other customers, textile of the design in dispute in this case. We take care in our company not to print one design for two customers. We do not search the register of designs to find out who the registered proprietor is before executing an order to a design." Throughout his testimony, the 1st P1/W did not say whether the remaining textile materials which Ajibowo failed to pay for and collect and which they had to sell to other customers were sold before or after the registration of the new design on 30th December, 1971. The significance of this omission will emerge later. In support of his contention that the registration of the design is void and of no effect because the design is not new, the plaintiffs called two witnesses, Wusamotu Moranti Dosumu (3rd P1/W) and Muraino Adeyemi Adenusi (4th P1/W). The testimony of Wusamotu Dosunmu, another textile dealer, on this point reads: - "I know the plaintiffs as manufacturers of textiles. I know about four companies manufacturng the design in Exhibit1. These are Nigerian Teijin, Taylor Bard & Co. Ltd., M. Debs & Co. Ltd., and Bhojsons & Sons. Except for Bhojsons & Sons, these firms are manufacturers. They do not market. I also buy this design from any of them for sales. My shop is at 619 LEDB Shop at Fred MacEwen Street, Lagos. I have no stock of this material at the moment. I also buy the design from the plaintiffs. I have sold more than two thousand yards of the material in Exhibit 1. I know Mr. Ajibowo sitting in court. We are both customers of the plaintiffs. I bought some quantity of the design from the

plaintiffs towards the end of 1971 and again in 1972. I do not agree with Mr. Ajibowo that nobody else could sell the design." When cross-examined about check designs, presumably because the design in dispute is a check design, she replied that the "check designs can be of various types." The other witness, Muraino Adeyemi Adenusi (4th P1/W) who was once a clerk with P.Z. & Co. Ltd., testified about the disputed design as follows:- "When I was in P.Z. we sold the design in Exhibit 1. The design in Exhibit 1 is known as Kentucky, Check or Prince of Wales material. The design No. 1 sold by P.Z came from Manchester, England. While in textile business on my own I have sold 1,000 to 2,000 yards of the design in Exhibit1. We have the design in different colours. I obtain my supply of the design from Setty Textiles Limited, London. The design is a common one and in my opinion, nobody can claim the proprietorship of it." The defendants called no evidence and rested.

In addition, the author analyzed the historical development of industrial designs, procedure for registration, infringement sanctions and remedies for infringement of industrial designs. However, the author did not discuss the challenges hindering the effective enforcement and protection of patents and industrial designs in Nigeria. Also, there was no discussion on the court having jurisdiction over patents and industrial designs matters in Nigeria. These unaddressed issues are part of what this work seeks to address.

Another author, Babafemi[20] opines that patent is granted under the law to protect an invention that is new or essentially better in some way than what was made before or for a better way of making it. To this author protection is of importance to technicians, technologist. Medical scientist, space scientist, lecturers, researchers, academicians, physicians. Biologist, agriculturist, pharmacist, computer engineers, marine engineers electrical. Electronics and mechanical engineers among others. With regards to industrial designs he explains that they are primarily those elements incorporated into mass produced products that aim to enhance their attractiveness by their appearance and that their protection is of immense importance to the artists, lace designers and others. Furthermore, the author extensively discussed the historical development of patents and industrial designs in Nigeria, categories of persons who may apply to register, the procedure, duration, renewal, infringement, remedies administration and jurisdiction of patents and industrial designs in Nigeria.

Although the learned author discussed extensively on the generality of the patent and industrial design of this work, he did not give or adopt any definition of patent and industrial designs in Nigeria. This area is also what this work shall address.

Another Nigerian authors, Uloko and Greg in their book[21] gave a sketchy discussion on patents and industrial designs in Nigeria. THey merely discussed the definition, the historical development and duration of patents and industrial designs in Nigeria. However, the author did not give a detailed discussion on other essentials on the patent and industrial design. For instance, categories of persons entitled to grant of the right, procedure for registration and renewal, infringement, defences, remedies, jurisdiction and administration for the protection of

[20]Babafemi, F.O (2017) *Intellectual Property, The Law and Practice of Copyright Trademarks, Patents and Industrial Designs in Nigeria*, First Edition, Section C.
[21]Uloko and Greg (2010) *Modern Approach to Intellectual Property Laws in Nigeria*, Princeton Publishing Co Lagos, 1st Edition.

patents and industrial designs in Nigeria. This work will address these areas not discussed by the authors.

Attorney Richard Stim,[22] defines patent as a grant that allows for an owner to maintain monopoly over the work for a limited period of time. To him, there are two essential requirements to determine if an invention is patent or not, that is:

a. Whether the invention is new

b. Whether the invention is non obvious.

He further discussed the procedure for applying for a patent, enforcement of patent laws, duration and renewal of patent. However, this writer did not discuss anything in respect of industrial designs.

Chudi in his book[23] examined the generality of patent and industrial design. However, this work has not addressed sufficiently analyzed the challenges impeding the protection of patent and industrial design in Nigeria. Therefore, the work shall analyze these challenges in details.

Paul Mareet in his book[24] titled the adopted the definition of design given in the registered designs Act of 1949, where it was defined to mean shape, feature, configuration, patent or ornament applied to an article by any industrial process. He further gave extensive discussion on patents and industrial designs. Nonetheless, his work has not covered areas such as challenges hindering the effective protection of the patent and industrial design among others. Therefore, this work intends to improve in that area.

Shyllon [25] gave a detailed analysis of patents and industrial design in Nigeria but did not discuss jurisdiction and administration over disputes arising from patents and industrial design. Therefore, this work will improve on this area.

Ayodele and Damola[26] examined patentibility of inventions under the Patent and Design Act. In their paper they discussed the nature of invention, the reason(s) for protecting invention and the requirements for the patentability of invention under the Patents and Designs Act. In addition, they examined the criteria for patenting inventions, that is, such invention must be novel; it must result from inventive activity and must not be obvious to a person knowledgeable in the art or field of study. In respect of plant or animal varieties, or essentially biological processes for the production of plants or animals (other than microbiological processes and their products) patent is denied. The paper analyses this position and concludes that there is the

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[22]Attorney, R.S. (2017) *Patent, Copyright of Trademarks: An Intellectual Property Desk Reference.* Fifteenth Edition. P 14.
[23] Chudi, C. N. (2016) *Intellectual Property and Law in Nigeria*, Malthouse Press Limited, Lagos, First Edition, pp 39-70
[24] Mareet: Intellectual Property Law, Fifth Edition
[25] Shyllon, F. (2003) *Intellectual Property Law in Nigeria*, C.H. Beck. First Edition.
[26] Ayodele, O.A. and Danmola, F.O. (2017) "*Patentability of Inventions under the Nigeria's Patents and Designs Act: An Examination"*. Retrieved from https://www.ajol.info/index.php/naujilj/article/download/156739/146346 on 7 February, 2021 at 3:45am.

need to ensure that invention and innovation is not stultified by refusing to patent an invention just because it is biological. The Nigerian Patent Registry refuses patent applications for Software or Computer-implemented inventions this paper argues that this provision of law should be changed in line with the rapid development in the field of computer technology. The paper concludes by making recommendations to improve the current legal situation in Nigeria.

Adamu[27] briefly traces the historical development of the Patent system in Nigeria and describes the current system under the Patents and Designs Act of 1970. A database of Nigerian Patents is under construction, but currently Patent searches can be conducted by the Registry's Patent section upon request. The author concludes that the present law needs updating in line with the World Trade Organization/ Trade-Related Aspects of Intellectual Property Rights (WTO/TRIPS) Agreement and with current realities, that the infrastructure and capacity for enforcement need improvement, and that public awareness of the potential importance of Patents and other Intellectual property rights needs to be raised.

According to Chudi and Chioma[28], Industrial designs are primarily those elements incorporated into mass produced products that aim to enhance their attractiveness by their appearance. The primary objective of the law governing industrial design is to protect a design that is new or essentially better in some ways than what was created before. Despite the importance of the law governing industrial design and the protection of infringement of industrial design in Nigeria, it is however very sad that the rate of infringement of industrial design is on the increase. This is due to the fact of some challenges to effective legal protection of industrial designs in Nigeria. In their paper they discussed the meaning of industrial design, when an industrial design will be deemed registrable, non-registrable designs, categories of persons who may apply to register an industrial designs, duration and renewal of industrial designs, extent of the right/protection conferred upon the proprietor of an industrial design, challenges to effective protection of industrial design and the recommendations on how to tackle these challenges. However, patent was not addressed at all, so this work examine similar issues relating to patent

Conclusively, this work will address how the law has protected patent and industrial design in Nigeria as well as the challenges hindering the effective enforcement of patent and industrial design rights in and likely recommendations.

1.8 Organizational Layout

This work comprises of five chapters. Chapter one which is titled the General Introduction deals with the general introduction, background of the study, statement of

[27] Adamu, A. Y. The Patent System in Nigeria World Patent Information, Volume 34, Issue 3, September 2012, pp 213-215. Retrieved from https://www.researchgate.net/publication/257036636_The_Patent_system_in_Nigeria on 7th February, 2021 at 4:03am.

[28] Chudi, C.N. and Chioma, O.N. (2015)" *Challenges to Effective Legal Protection of Industrial Designs in Nigeria"* Journal of Law, Policy and Globalization. Vol.33, 2015 Retrieved from https://www.iiste.org/Journals/index.php/JLPG/article/download/19580/19996 on 7th Februaury, 2021 at 3.48am.

research problem, aim and objectives, justification, scope of research, methodology, literature review and organizational layout of the work.

Chapter two titled the Legal frame work for the protection of patents in Nigeria analyses the definition of patent, the historical development of patent law in Nigeria, patentable and non-patentable inventions, categories of persons who may apply to register a patent, patent application, duration, renewal and lapse of patent, extent of right conferred upon registration of a patent, limitation to the exclusive right conferred upon registration and other allied matters.

Chapter three titled Legal frame work for the protection of industrial designs in Nigeria analyses the definition of industrial design, the historical development of industrial design in Nigeria, registrable and non-registrable designs, procedure for registration of industrial designs, categories of persons who may apply to register, duration and renewal of industrial designs, rights conferred upon registration, limitation to industrial design, exploitation of designs, renunciation and nullity of registration and other ancillary matters.

Chapter four which is titled Infringement of Patents and Industrial designs in Nigeria and Challenges hindering the effective protection of patents and industrial designs Rights in Nigeria discusses matters relating to infringement, administration and jurisdiction of patents and industrial designs, Challenges impeding the effective protection of the patent and industrial design.

Finally, chapter five which is titled the summary and conclusion contains the summary, findings and recommendations.

CHAPTER TWO

LEGAL FRAMEWORK FOR THE PROTECTION OF PATENTS IN NIGERIA

2.1 Introduction

Basically, the law of patent relates to the protection of new inventions. According to the World Intellectual Property Organization (WIPO), a patent is an exclusive right granted for an invention, which is a product or a process that provides, in general a new way of doing something, or offers a new technical solution to a problem.[1]

The legislation governing Patent regime in Nigeria is the Patents and Designs Act.[2] It is the substantive law governing patents in Nigeria. The Act comprises of thirty-three sections, divided into several parts. The first part section 1-11 deals with patent, the second part, Section 12-22 deals with Designs, and the third part, Section 23-33 deals with issues relating to both patents and designs. The Act is supported by the Patent Rules which regulates the procedure for patent application in Nigeria. By the provisons of Section 26 of the Patent and Design Act, the jurisdiction to hear and dispose of legal proceedings in respect of patent is vested on the Federal High Court.[3]

A patent is regarded as a catalyst for technological and socio-economic development.[4] This is because it encourages indigenous inventive activity and also, helps to facilitate the transfer of technology from the technologically advanced countries to the less developed ones.[5]

In addition, Protection of Patent rights encourages and stimulates the development of trade and commerce. It creates wealth for individuals, corporate body concerned and the nation through payment of royalties, Patent and industrial designs application/registration fees and generation of foreign exchange from technology transfers.[6] Chapter two intends to analyse the definition of patent, the historical development of patent law in Nigeria, patentable and non-patentable inventions, categories of persons who may apply to register a patent, patent application, duration, renewal and lapse of patent, extent of right conferred upon registration of a patent, limitation to the exclusive right conferred upon registration and other allied matters.

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[1] https://www.wipo.int/patents/en/

[2] Cap. P2. Laws of the Federation of Nigeria, 2004.

[3] Ibid.

[4] Ameh, I. (2014). *Analysis of the Legal Regime and Institutional Frameworks for the Protection of Intellectual Property Rights in Nigeria*. P. 185. (Doctoral Dissertation, Ahmadu Bello University, Zaria). Retrieved from https://google.com.ng/url?sa=web&rct=j&url=https://kubani.abu.edu.ng/jspui/bitstream/123456789/6304/1/ANALYSIS%2520OF%2520THE%2520%INSTITUTIONAL%2520FRAMEWORKS%2520FOR%2520THE%2520PROTECTION%2520OF%2520INTELECTUAL%2520PROPERTY%2520RIGHTS%2520IN%2520NIGERIA.pdf&ved=2ahUEwizuc_5rdPeAhXFaFAKHXc_DjEQFjAAegQIAxAB&usg=AOvVaw0Ont0KY66ne_3M3jul accessed on 24 0ctober, 2018 at 1.23am.

[5] Oyewunmi, A.O. (2018), *Nigerian Law of Intellectual Property*, University of Lagos Press and Bookshop Ltd, pp. 142-143.

[6] Waziri, K.M. *The Legal Regime of Patents and Deigns Law and its effect on national Development*. p14. (Faculty of law, University of Abuja). Retrieved from http://ssrn.com/abstract=1875725 accessed on 2 November, 2018 at 10.40am.

2.2 *Definition of Patent*

The Patents and Designs Act[7], which is the governing legislation on the patent and industrial design does not proffer a definition of Patents. Section 32 of the Patents and Designs Act merely defines a patent application as an application for the grant of a patent.

However, Patent may be defined as legal rights that confer on inventors of a new and useful products and processes right to exclude others from the commercial exploitation of the invention[8]

It may also be defined as a form of intellectual property that gives its owner the legal right to exclude others from making, using, selling and importing an invention for a limited period of years, in exchange for publishing an enabling public disclosure of the invention.[9]

According to the World Intellectual Property Organization (WIPO), a patent is an exclusive right granted for an invention, which is a product or a process that provides, in general a new way of doing something, or offers a new technical solution to a problem.[10]

2.3 *Historical Development of Patent Law in Nigeria*

The first patent legislation enacted in Nigeria was the Patents Ordinance No. 17 of 1900 and the Patents Proclamation Ordinance No. 27 of 1900. These statutes applied to the Colony of Lagos and Sothern Protectorate Nigeria. Subsequently similar provisions were made to apply to the Northern Protectorate by virtue of the Patents Proclamation Ordinance No. 12 1902. These laws provided for the establishment of fully fledged patents administration system in Nigeria.

However, the situation was dramatically reversed after the amalgamation of the Southern and Northern Protectorate in 1914, The Patents Ordinance and Patents Proclamation Ordinance was repealed and replaced with the Patents Ordinance, No.30 of 1916. The Ordinance was amended and it became the Registration of United Kingdom Patents Ordinance of 1925[11].

A major shortcoming of the 1925 Ordinance was that unlike the 1900 and 1902 Ordinances, the 1925 Ordinance only allowed patents registration in Nigeria conditional, such registration must have been granted in the United Kingdom. The implication was that an inventor in Nigeria who was desirous of securing a patent for an invention had to first apply to the U.K. Patent Office for the grant before having it registered in Nigeria.[12]

Eventually, after independence in 1960, this shortcoming was corrected by repealing the 1925 Ordinance and the promulgation of the Patents and Designs Decree No.60 of 1970 (now

[7] Cap.P2, *Laws of the Federation of Nigeria*, 2004.
[8] Oyewunmi, A.O. (2018), *Nigerian Law of Intellectual Property*, University of Lagos Press and Bookshop Ltd, p. 141.
[9] https://en.wikipedia.org/wiki/Patent accessed on 2 November, 2018 at 10.50am.
[10] https://www.wipo.int/patents/en/ accessed on 2 November, 2018 at 10.58am.
[11] Cap 182 *Laws of the Federation of Nigeria*, 1958.
[12] *Ibid*.

known as the Patents and Designs Act contained in Cap P.2 Laws of the Federation of Nigeria, 2004). The Patent and Designs Act is the existing legislation governing the patent and industrial design, it is supported by rules made pursuant to the Act, The Act extensively lays down the substantive and procedural rules governing requirements for patentability, procedure for grants, ownership and exploitation, duration, infringement, remedies and a wide variety of other issues.[13]

2.4 Patentable and Non-Patentable Inventions

Under the Patents and Designs Act[14] there is no definition of an invention. However, an invention is defined as the discovery of creation of a new material (either a new manufactured product or a new composition of matter), a new process, a new use of an existing material or any improvement of any of these.[15] It should be noted that an invention is distinct from discovery, this distinction was stated by Buckley J. in the English Case of *Reynolds vs Herbert Smith & Co. Ltd.*[16] Where he remarked that;

> Discovery adds to the amount of human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new process, or a new combination for producing an old product or an old result.

2.4.1 Patentable Inventions

For an invention to be patentable it must fulfill the criteria set out in Section 1 of the Act[17]which are;

a. If it is new, results from inventive activity and is capable of industrial application:

   or

b. If it constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.

Three conditions are primarily set up by the provisions of the Act above which includes that;

a. The invention must be new.

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[13] Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[14] *Ibid*.
[15] Edward C.W. (1994) "Early Evolution of U.S Patent Law". In: *Journal of Patent and Trademark Office Society.* (Pt.14), p. 16
[16] (1913) 20 R.P.C 123.
[17] Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

b. The invention must involve an inventive step.

c. The invention must be capable of industrial application.

a. The invention must be new

This is the first criteria for an invention to qualify for patentability. An invention is new if it does not form part of the state of the art.[18]

> "the art" means the art or field of knowledge to which an invention relates and "the state of art" means everything concerning the art or filed of knowledge which has been made available to the public anywhere and at any time whatever (by means of a written or oral description, by use or in any other way) before the date of filing the patent application…[19]

In essence, the invention must not have been known or disclosed to the public prior to the application of the patent. The requirement of newness was judicially illustrated in the case of *Windsurfing International vs Tabur Marine (GB) Ltd,*[20] In this case the patent in suit ("Schweitzer Patent") claimed a wind-propelled vehicle having an unstayed spar connected through a universal joint and a sail attached along one edge to the spar and held taut between a pair of arcuate booms mounted on the spar at one end and joined together at the other (i.e. a Bermuda rig with a wishbone spar). The unstayed sail was used to steer the vehicle and could be jettisoned in case of trouble. The plaintiff (Windsurfing International Inc.) was enjoying patent rights over the patent and industrial design of the dispute since the priority date of 27th March, 1968. On finding that the Defendant (Tabur Marine (Great Britain) Inc.) was manufacturing and selling infringing copies of the patented product, the Plaintiff filed a suit for injunction before the Patents Court. The Defendant counter claimed for the revocation of the patent, challenging the validity of it on the ground that what was claimed lacked novelty over a prior user by a person named Peter Chilvers and was obvious in view of the prior user or of a printed publication in theform of an article. The printed publication was an article entitled "*Sailboarding-Exciting New Water Sport*" published in *Popular Science Monthly* which described the same basic concept as that of the patent but the sailboard had been fitted with a square-rigged sail.

The cited prior user had taken place some ten years before the date of the patent when Peter Chilvers (then a 12-year-old boy) had built a sailboard and used it on an inlet near an island on summer weekends during two consecutive seasons. The user was open and visible to anyone in the vicinity of the caravan site where the family stayed. Chilver's sailboard differed from what was claimed only in that the sail was held between a pair of booms which were straight when the vehicle was at rest. However, the evidence was that in use the booms were sufficiently flexible to assume an arcuate shape. The Patents Court held that the claims of the

[18] Section 1(2), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[19] Section 1(3), *Ibid*.
[20] (1985) R.P.C. 61.

plaintiff were invalid as anticipated by the prior user and obvious in view of the published article. The plaintiff then sought to amend their claims, but the judge concluded that there was no scope for such an amendment and refused to allow it. The plaintiffs appealed to the Court of Appeal against the findings of anticipation and obviousness and the refusal to allow amendment. The defendants lodged a respondents' notice on the question of obviousness over the prior user.

On the question of obviousness, the Defendant argued that it must be assumed from the mere fact of publication that a skilled man would have been familiar with and interested in what was known. The Plaintiff stated that it was necessary to show that a person interested in the field of the invention would have been likely to have come upon what was known and to have appreciated its significance and utility. A man skilled in the art would have dismissed the published article as describing a not very practical toy which it would not have been obvious to develop. They argued that the Chilvers' isolated user could not be relied upon for obviousness, as opposed to anticipation and that it was not an anticipation because the booms were not arcuate at rest. The Court opined that the question of obviousness was not to be answered by looking at the benefit of hindsight at what was now known and what had been known at the priority date and asking whether the former flowed naturally and obviously from the latter, but by hypothesizing what would have been obvious at the priority date to a person skilled in the art who had access to what was known in the art at that date. The philosophy behind obviousness must take into account the same concept as anticipation, namely that it would be wrong to prevent a man from doing something which was merely an obvious extension of what he had been doing or what was known in the art before the priority date.

The Court rejected the contention of the plaintiff and observed that the question to be answered was whether what had been claimed was obvious, not whether it would have appeared commercially worthwhile to exploit. The Court laid down four steps to determine obviousness. They are as follows:

(i) Identifying the inventive concept embodied in the patent;

(ii) Imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date;

(iii) Identifying the differences if any between the matter cited and the alleged invention; and

(iv) Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps which would have been obvious to the skilled man or whether they required any degree of invention.

The Court also observed that the instances of prior art and prior user relied on by the defendants were very much similar to that of the patented product. The differences cited by the plaintiff were not enough to deny the fact that any man skilled in the art could have made the necessary modifications to make exactly similar copies of the product. Hence, the Court stated that the test for non-obviousness was not satisfied in the instant case.

The Court held that the anticipation by the prior user was established in the instant case and the patented product did not satisfy the test for non-obviousness. Therefore, the appeal was dismissed along with the request for making amendments to the patent application.

However, there are exceptions to the newness criteria. The first exception provides that, an invention will still be regarded as new even if it has been displayed or exhibited in an official or officially recognized international exhibition. However, such exhibition must have taken place within six months of the date of filling the patent application.[21]

Secondly, the publication will not be deemed to have made available to the public where the disclosure is a confidential one, made by an inventor or someone deriving title through him in confidence to third parties. Furthermore, there are conditions which will render the invention not new, these include;

i. Publication by Oral disclosure

For an invention to be eligible for a grant of patent, it must not have been orally communicated to other persons by the inventor before applying for the patent. That such disclosure was made intentionally or unintentionally is of no relevance under the Patent Law.[22] In essence, for an invention to be eligible, it must not have been disclosed orally and I agree to this position because if it has been disclosed, the person to which the information regarding the invention has been made to can go ahead and fraudulently apply to patent such an invention.

ii. Publication by document

Where an invention has been documented or published (it could be a book, journal, newspaper or other means), such invention will be presumed anticipated and cannot be patented. Mere exhibition in a bookshop or display on a library shelf constitutes publication. It is therefore not necessary that the document has been sold or not. This was judicially enunciated in the case of *Van der Lady vs Bamford*[23], the Patentee claimed a hay raking machine in which rake-wheels were turned not by an engine but by contact with the ground, the patent application was denied because such invention has been anticipated by a photograph in a journal showing a hay rake with this feature, In fact, the photograph in the journal was clear enough to reveal the proposed invention to an informed person.

iii. Prior use

Where an invention has been used in the public, such an invention cannot be granted patent. This was buttressed in the English case of *Femento Industrial S.A vs Mentmore Manufacturing Company Ltd.*[24], in this case, the inventor had prior to his application for grant of patent for his ball–point pen invention had given out the invention to three different persons as gifts. The court held that such a gift amounted to prior use by members of the public. However,

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[21] Section 3, Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[22] Babafemi, F.O. (2007), *Intellectual Property: The Law and Practice of Copyrights, Trademarks, Patents and Industrial Designs in Nigeria.* Justian Books Ltd, p.350.
[23] (1963) R.P.C 61
[24] (1956) 4 R.P.C. 87 C.A

where the prior use of the invention is secret, educational or for experimental purpose it will not defeat newness. This is because the Act recognizes these as exception to this rule of prior use. This position of the Law is valid as granting patent to an invention which has been earlier used or known to the public will defeat the concept of originality/innovation which patent is all about

b. The invention must involve inventive Activity

Inventive activity is defined in section 1(2) (b) of the Act as "an invention results from inventive activity if it does not obviously follow from the state of the art , either as to the method, the application, the combination of methods, or the product which it concerns or as to the industrial result it produces".

In other words, there must be significant contribution to the state of the art, the inventor is required to have duly exercised his inventive faculty in a manner considered sufficiently ingenuous and not obvious to justify the grant of the patent.[25]

This Point was well buttressed in the case of *Proctor vs Bennis*,[26] the defendant argued that the plaintiffs stocking machine with the peculiar feature of a door or flap was a mere obvious variation readily apparent to a workman and did not involve any inventive step. The court however, disagreed with this position of the defendant and held that the inventive activity was not obvious because the defendant had tried to include this feature in his machine and it was unsuccessful.

c. The invention must be capable of industrial application

It is not every invention which is new or results from inventive activity that can be patented. An invention will not be patentable if it is not industrially applicable. Section 1(2) (c) of the Act[27] defines the concept of industrial applicability as "an invention which is capable of industrial application if it can be manufactured or used in any kind of industry including agriculture".

In the Nigerian case of *James Oitomen Agbonrofo vs Grain Haulage and Transport Ltd,*[28] the plaintiff sued the defendant for infringing his patent grant. In this case, the plaintiff had invented a harmless electric water boiler which unlike the imported ring boiler, would prevent fire disasters because it will not work if it is not filled with water. The plaintiff also mentioned two identification characters of the Oitmen harmless boiler. One is the perforation of the filter. The second is the material used, a stainless-steel product which he claims no one has ever used before in a heating device. The court granted that the defendant had infringed on the Plaintiffs patent and held that the invention was new and industrially applicable. Therefore, for a patent to be valid it must be capable of industrial application.

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[25] Oyewunmi, A.O. (2018), *Nigerian Law of Intellectual Property,* University of Lagos Press and Bookshop Ltd., p. 153.
[26] (1929) R.P.C. 241 at 248.
[27] *Ibid*.
[28] (1977-2003) Vol. 4, IPLR 139.29 ch 164.

d. The invention must constitute an improvement on an existing Patent.

Patents may validly be obtained in respect of improvements to existing inventions. The improvements must not be a mere cosmetic adjustment or a minor alteration but must render a product or process better or more efficient than it was before. An example of an improvement patent is the case of *James Oitomen Agbonrofo vs Grain Haulage and Transport Ltd,*[29] The plaintiff invented the "Oitmen Harmless Boiler" which was an improvement on existing ring boilers. The special feature of the plaintiff's invention was that the boiler did not shock like the existing ring boiler and the boiler will not work without water thereby preventing fire disaster. The invention constituted an improvement and was subsequently granted patent.

2.5.2 Non-patentable inventions

The fact that an invention satisfies the criteria's provided by the Act does not conclusively entitle it to a grant of patent. The Act excludes some certain inventions from been Patentable. For instance;

a) Plant or Animal varieties and, or essentially Biological process for the production of plants or animals (other than microbiological processes and their products);[30]or

b) Inventions the publication or exploitation of which would be contrary to public order or morality (it must be understood for the purposes of this paragraph that the exploitation of an invention is not contrary to public order or morality merely because its exploitation is prohibited by law).[31]

c) Principles and discoveries of scientific nature.[32]

2.6 Categories of Person who may apply to register a Patent

2.5.5 **Statutory inventor**

By the provisions of the Patents and Designs Act the right to a patent in respect of an invention is vested in the statutory inventor, that is to say. The person who, whether or not he is the true inventor, is the first to file, or validly to claim foreign priority of the invention"[33] In this context, the true inventor means the original creator of the invention.

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[29] (1977-2003) Vol. 4, IPLR 139.29 ch 164.
[30] Section 1(4) (a), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[31] Section 1(4) (b) *Ibid*.
[32] Section 1(5), *Ibid*.
[33] Section 2(1), *Ibid*. 1. *Pfizer Inc. v Polyking Pharmaceuticals Ltd.* (1988) Vol 1 FHLR 1

In essence, the first to file encourages prompts filing of a patent application on an inventor and supports the equitable principle "delay defeats equity". In most cases the statutory inventor is always he first to file .However, where he delays to file and another person files, the true inventor is entitled to be named in the patent, this is immaterial whether or not he is the statutory inventor and this position cannot be modified by contract.[34] This is to prevent a situation where the first to file approach gives room for hijacking of the invention of others and also to accord recognition to the person endowed with ingenuity and skill to enrich society through the exercise of their inventive faculty.[35]

Furthermore, where two or more persons are involved in the making of an invention, they may apply jointly for a patent right in respect of the invention. However, a person who merely assisted in doing work connected with the development of an invention without contributing any inventive activity is not an inventor.[36]

2.5.6 **Persons who employ or commission others to work for them**

The Act provides that where an invention is made in the course of employment or in the execution of a contract for the performance of a specified work, the right to patent the invention vest on the employer or the person who commissioned the work[37] This position of law applies where in the course of employment , the employee uses the employers time and materials(includes data, equipment or other facilities placed at the employees disposal by reason of his employment)[38] Therefore, if an invention is made in the spare time of the employee or on vacation and with his own resources such an invention will not be held to be made in the course of employment.

However, in fairness to both the employer and the employees the Act further provides that, where the inventor is an employee, if his contract of employment does not require him to exercise any inventive activity but he has, in making the invention used data and materials that his employment has put at his disposal, or if the invention is of exceptional importance, then he is entitled to a fair remuneration, taking into account his present salary and the importance of the invention.[39]

In Nigeria, some universities and research institutes have taken cognizance of the relevance of the position of law above by allocating a certain percentage of profit to the employee/inventor from the commercialization of his invention. In essence, except otherwise, the ownership of inventions shall vest in the university where the invention was sustainably funded by the university (60%), where the creator or inventor used the equipment, tools, resources, time, assistance, infrastructure, utilities or apparatus owned by the university or

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[34] Section 2(2), *Ibid*.
[35] Oyewunmi, A.O. (2018), *Nigerian Law of Intellectual Property,* University of Lagos Press and Bookshop Ltd, p. 164.
[36] Section 2(5), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[37] Section 2(4), *Ibid*. 1. *Pfizer Inc. v Polyking Pharmaceuticals Ltd.* (1988) Vol. 1 FHLR 1
[38] *Patchet v sterling* (1955) AC 534.
[39] Section 2(4) (a) (i) and (ii), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

where the research conducted was with the sponsorship gained, negotiated facilitated or procured by any staff of the University during the cause of his/her official responsibility.[40]

2.5.7 **Persons to whom the invention has been assigned**

As provided under the Act the Patentee has the right to assign, transfer by succession or hold in joint ownership his Patent.[41] Such transfer or assignment may be the whole of the patent or some part of it. For instance, the Patentee can assign his rights conferred on him to different Assignors, such rights include, right to import, right to manufacture.[42]

However, it is pertinent to note that, where the contract is silent on whether the whole of the right is to be by assignment or not, the court will impute the assignees intention to mean the total rights in the patent. The Act further requires that, the assignment shall be in writing and shall be signed by the parties[43] Also, an assignment or transfer by succession shall be registered and the required fees paid so as to constitute notice to third parties[44] This was judicially elucidated in the Nigerian case of *Arewa Textiles PLC and Others vs Finetex Limited,*[45] in this case the respondent instituted an action at the Federal High court , Kaduna, claiming an infringement by the appellants, of its registered patent No. RP 12024 in respect of a process "method and apparatus" of producing textiles materials. It further claimed declaratory reliefs, a perpetual injunction and general damages against the appellants. The process was invented by one Kong Sang Wong. The said process was later assigned to Boaty Company Ltd, who further assigned right to apply for a patent in Nigeria to the respondent. The respondent contended that the 1st appellant used its process illegally. The trial court granted in the claims of the respondent. Dissatisfied with the judgment of the trial court, the respondent appealed, on appeal, the court upheld the appeal of the appellant, because there was no evidence that the respondent ever registered the process in Nigeria. On the effect of an unregistered assignment or transfer of patent, Salami J.C.A who delivered the leading judgment, held *inter alia*

> The right to apply for patent in respect of an invention by an assignees thereof under his own name is not a mere moral adjuration. It is a duty under Section 24(1) of the Patents and Designs Act, Cap .344 Laws of the Federation of Nigeria 1990, to register assignment, transfer or interest held in joint ownership of a patent. This is because by virtue of Section 24(1) and (3) of the patents and Designs Act an assignment and transfer thereof shall have no effect against third parties unless it has been

[40] For instance, Clause 3.5 of Ahmadu Bello University, Zaria, Nigeria Research Policy 2010. Clause 5.5.2 of the University of Ibadan Intellectual Property Policy of 2012. Retrieved from http://www.ui.edu.ng/sites/default/files/INTTELLECTUAL%20PROPERTY%20POLICY%20AS%APPROVED%BYTHE%20COPD.pdf, accessed 31 October, 2018 at 10.26pm.
[41] Section 24(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[42] Section 6, *Ibid*.
[43] Section 24(2), *Ibid*.
[44] Section 24(3), *Ibid*.
[45] (2003) 7 N.W.L.R 322

> registered and the prescribed fees paid. In this instance, there is no evidence of such registration and payment of requisite fees before the court and in the absence of such vital evidence, the respondent cause of action is inchoate because the assignment would have no effect.

From the foregoing, it has been established by the court that registration and payment of the prescribed patent fee is essential to validate a patent assignment. Without the aforementioned the assignment will be considered inchoate.

2.5.8 **Persons to whom a license has been granted**

A license is a permission, usually revocable to commit some act that would otherwise be unlawful.[46]

There are three forms of licenses recognized under the Act. These are licensee of right, contractual license and compulsory licensee.

a. License of Right

This form of license is obtained by the Patentee by applying in writing to the Registrar[47] for the words "License of Right" to be registered in respect of his Patent, the Registrar will enter the words accordingly in the Registrar and notify the entry.[48] Once this is done, the Licensor is obliged to grant a license to anybody who approaches him for license, provided they agree on the terms of the license,

However, where they fail to reach an agreement, the terms shall be fixed by the court.[49]Where the entry is made the amount of the annual fees payable in respect of the patent will be reduced by half [50].However, where the Licensor applies to have the entry

[46] Bryan, A.G. (2019) *Black's Law Dictionary*. Thomson Reuters, 11th Edition at p.89.
[47] "Registrar" means the Registrar of Patent and Industrial Designs at the Commercial law Department of Federal Ministry of Industry, Trade and Investment.
[48] Section 10(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[49] Section 10(2) (a), *Ibid*.
[50] Section 10(2) (b), *Ibid*.

cancelled, he is bound to pay up all annual or other fees which would have been payable if the entry had not been made.[51] The purpose of the provision is to discourage the licensor from cancelling the license. In addition, a licensee cannot assign or grant further license from the license he has obtained.[52]

b. **Contractual License**

As provided under the Act[53], a Patentee may by a written contract signed by both parties grant a license to any person to exploit the relevant invention. Subject to the terms of the license, a licensee shall be entitled to carry out any acts in regards to the patent, anywhere in Nigeria.[54] It is pertinent to note that, for the license to have effect against third parties, the license shall be registered and the prescribed fees paid.[55] Furthermore, a licensor can still exploit the patent or grant further licenses to other person except he is expressly prohibited by the contract.[56] On the other hand except if expressly provided in the contract, the licensee is prohibited from assigning or further granting licenses of the patent.[57]

[51] Section 10(3), *Ibid*.
[52] Section 10(4), *Ibid*.
[53] Section 23(1) (a), *Ibid*.
[54] Section 23(1) (b), *Ibid*.
[55] Section 23(2) (a), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[56] Section 23(4) (a) (i) and (ii), *Ibid*.
[57] Section 23(4) (b) and (c), *Ibid*.

The terms of the contract shall be agreed upon by the parties. However, where the terms impose unreasonably restrictions in the industrial or commercial field, such clause in the terms of contract shall be declared null and void by the court.[58]

However, there are three exceptions created under section 23(3) of the Patent and Designs Act where the restriction will not amount to unreasonable restrictions, the exceptions are, Firstly, limitations concerning the scope, extent, territory or duration of the exploitation of the patent or the quality of the products in connection with which the patent may be exploited. Secondly, obligations imposed on the licensee to abstain from all acts capable of prejudicing the validity of the patent. Lastly, limitations justified by the interest of the licensor in the technically efficient exploitation of the subject of the patent.

c. Compulsory License

The Patent Act[59] provides that, a person may apply to the court for a grant of a compulsory license at any time after the expiration of four years after the filling of a patent application or three years after the grant of a patent on the following grounds

i. That the Patented invention, being capable of being worked in Nigeria has not been so worked.

ii. That the existing degree of working of the patented invention in Nigeria does not meet on reasonable terms the demand for the product.

iii. That the working of the patented invention in Nigeria is being hindered or prevented by the importation of the patented article.

[58] Section 23 (3), *Ibid*. and Section 6, National Office for Technological and Promotion Act, Cap.N62, *Laws of the Federation*, 2004.
[59] Paragraph 1, Part 1 of the First Schedule to the Act

iv. That by reason of the refusal of the Patentee to grant license on reasonable terms, the establishment or development of industrial activities in Nigeria is unfairly and substantially prejudiced.

In addition to the grounds listed above, compulsory license can be granted where a patented invention in Nigeria cannot be worked without infringing rights derived from an earlier patent. For a successful grant of a compulsory license, the applicant must satisfy the court that he has been unable to obtain such a license on reasonable terms[60] and within a reasonable time and also, he guarantees the court to work the relevant invention sufficiently to remedy the deficiencies that gave rise to the application.[61]

After listening to both parties, the court shall decide whether or not to grant the application. Where it grants the application, and the parties cannot agree on terms, the court shall fix the terms having regards to the extent to which the relevant invention is to be worked and this shall constitute a valid contract between the parties.[62] The licensee shall have the right to do any act mentioned in section 6 of the Patents and Designs Act except importation.[63]However, it does not permit the licensee to grant further licenses and the grant may contain additional restrictions and obligations on both parties.[64]That is why a compulsory license is deemed non –exclusive.[65]

On the application of the Patentee, the court may cancel a compulsory license if the licensee fails to comply with the terms of the licensee or the condition which justified the grant of the license have ceased to exist[66] It is pertinent to note that, the grant, cancellation or variation of a patent shall have no effect against third parties until it has been registered.[67] In my own view, the justification behind the compulsory license may be in order to check the excessive misuse of the exclusive right bestowed on a Patentee.

2.6 Patent Application

The application for the grant of patent signed by the applicant or his agent.[68] Which shall be on Form 1.[69] The application shall be made to the Registrar and shall contain;

a) The applicants full name and address and, if that address is outside Nigeria, an address for service in Nigeria.

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[60] *Fette's Patent* (1961) R.F.C 390.
[61] Paragraph 5(a) and (b), Part 1, First Schedule to the Patents and Designs Act.
[62] Paragraph 8, *Ibid*.
[63] Paragraph 6(a), *Ibid*.
[64] Paragraphs 6(b) and (d), *Ibid*.
[65] Paragraph 6(c), *Ibid*.
[66] Paragraph 9, *Ibid*.
[67] Paragraph 11, *Ibid*.
[68] Rule 7, Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[69] Rule8 (1), *Ibid*.

b) A description of the relevant information with the appropriate plans and drawings.

c) A claim or claims.

d) The prescribed fees.

e) Where necessary, a declaration signed by the true inventor requesting that he be mentioned.

f) Where the application is made by an agent, a signed power of attorney.

g) Such other matters as may be prescribed.[70]

It should be noted that, the description should be drawn up very carefully, sufficiently clear and complete for the invention to be put into effect by a person skilled in the art of field of knowledge of the invention.[71] Also, the claim should be professionally drawn so that the right granted adequately covers the patent and industrial design intended to be protected.[72]This was judicially buttressed in the English case of *Mineral Separation case*[73], Thorson J remarked that;

> By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give necessary warning and must not fence in any property that is not his own. The terms of a claim must be free from avoidable obscurity and must not be flexible. They must be clear and precise so that the public will be able to know where it must not trespass but where it may go safely, if a claim does not satisfy this requirement then it cannot stand…

[70] Section 3 (1) (a) and (b), *Ibid*.
[71] Section 3(2) (1) (a) (ii), *Ibid*.
[72] Section 3(2) (1) (a) (iii), *Ibid*.
[73] (1947) Exc. R.306.

Section 3(3)[74] further provides that a patent application shall relate only to one invention, but may include in connection with the invention, the claims for any number of products and/or manufacturing process for those products and also any number of applications of those products. It also permits claims for any number of processes and means of working those processes, for the resulting product or products and for the application of those products.[75]

2.6.1 Foreign priority applications rule

Where an earlier application for a patent grant has been made in another country (specifically a convention country)[76] and another application is made in Nigeria in respect of the same invention, the later application (Nigeria) will be deemed to have been made on the date of the earlier application (the other country).[77] This is very beneficial for the purposes of determining which application is earlier between two persons. For a better understanding, by way of illustration, where X filed for a patent application in January 2018 in Ghana and later filed for patent for the same invention in June 2018, X will enjoy foreign priority over Y who filed for his patent in February 2018, because X application will be deemed to have been filled in January 2018. However, the earlier application must have been made within twelve months of the latter application in Nigeria.[78] Where an applicant for a patent intend to avail himself of a foreign priority respect of an earlier application made in a country outside Nigeria, the Nigerian application shall be accompanied by the date, number, country of application and name of the earlier applicant.

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[74] Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[75] Section 3(3) (b), *Ibid*.
[76] Section 27(1) and Patent and Designs (Convention Countries) Order of 1971, for a list of Nigerian Convention Countries.
[77] Section 27(2), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[78] *Ibid*.

2.7 Examination and Grant of Patent

The Registrars powers are limited and are purely administrative, this is because the Registrar merely examines the application to ascertain formal compliance not substantive examination. Once the application satisfies the statutory requirements as to forms and fees and relates to one invention. He is not required to enquire as to its novelty, inventiveness and industrial application or whether the application sufficiently discloses the invention.[79]Where the patent application has not been complied with, the Registrar shall reject the application and invite the applicant to regularize the defect in the application if necessary[80] It is obvious that the Act foresees the danger of the limited power given to the Registrar that is why the Act provides that patents are granted at the risk of the Patentee and without guarantee of their validity.[81] Where the patent application satisfies the requirements, the patent shall be granted, this is done by issuance of a Patent certificate (Form 4)h containing, the number of the patent in the order of the grant, the name and address of the Patentee and if the address is outside Nigeria, an address for service within Nigeria, the dates of the patent application and grant, , the description of the grant(with any relevant drawings and plans), the claims, where necessary, the name and address of the true inventor, if foreign priority is claimed, an indication of the fact ,the number, date and country of the application . [82] After the grant of the document to the Patentee, the Registrar publishes a notification of the grant [83]

[79] Section 4(2), *Ibid*.
[80] Section 4(1) (a) and (b), *Ibid*.
[81] Section 4(4), *Ibid*.
[82] Section 5(1) (a-f), *Ibid*.
[83] Section 5(3), *Ibid*.

2.8 Rights conferred by Patent and limitation

A grant of patent confers upon the Patentee the right to exclude others from doing the following acts;

a. Where the patent is in respect of a product, the act of making, importing, selling, or using the product or stocking it for the purpose of sale or use.

b. Where the grant is respect of a process, the act of applying the process or doing, in respect of a product obtained directly by means of the process, any other acts mentioned in paragraph (a) above.[84]

However, The Act[85] provides limitations to these rights conferred above, it provides that, where at the date of the filing of a patent application or at the date of a foreign priority validly claimed in respect of the application, a person other than the applicant can continue to exercise all rights conferred by section 6 of the Act as long as it was in good faith and he was earlier conducting an undertaken in Nigeria.

Another limitation is that, the rights under a patent extend only to acts done for industrial or commercial purpose.[86] In other words, private, experimental, educational or research use is exempted.[87]

In addition, the scope of protection conferred on a patent shall be determined by the terms of the claims and description.[88] This principle was illustrated in the case of *Abgoronfo vs Grain Haulage and Transport Limited,*[89] In this case the court held that the defendant was liable to the plaintiff for the infringement of his patent because the key components of his invention were covered by the claims of the plaintiff.

[84] Section 6(1) (a) and (b), *Ibid*.
[85] *Ibid*.
[86] Section 6(3) (a), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[87] Jones v Pearce, (1832)1 W.P.C.122.
[88] Section 6(2), Patents and Designs Act, Cap. P2*, Laws of the Federation of Nigeria*, 2004.
[89] 1997_2003) 4 I.P.L.R. 139.

2.9 *Duration, Lapse and Renewal of Patent*

Every Patent in Nigeria shall expire at the end of the twentieth year from the date of the filing of the relevant patent application.[90] Once expired the Patent falls into the public domain for free exploitation of the invention.

The Act further provides for only one ground for the lapse of a patent, i.e non-payment of the prescribed fees within the time frame stipulated and with a grace of extra six months where there is default in paying the renewal fees, after the expiration or lapse, a patent shall be registered and notified.[91]

2.10 *Nullity of a Patent*

In view of Section 4(4) of the Patent and Designs Act which grants patents at the risk of the Patentee and without guarantee of their validity, The Act has empowered the courts to declare a patent null and void if the subject of the patent is not patentable, or if the description or claims does not conform with the Act or if the same invention has been granted in Nigeria as a result of foreign priority.[92] Nullity of a patent can apply to the whole patent or to a particular claim or claims.[93] The principle of natural justice, *Audi Alteram Patem* (a Latin maxim meaning hear the other side) must be complied with before the courts makes a declaration on the validity or otherwise of the patent[94]

Furthermore, the court in determining the question of invalidity shall have regard only to the state of affairs existing when the proceedings were instituted.[95]Also, where the court nullifies the patent, it shall be deemed to have been nullified since the date of its grant. However, except otherwise ordered by the court, he shall not be required to pay royalties paid by a licensee prior to the declaration of nullity.[96] After the declaration, the proper officer of the court is required to inform the Registrar of Patents of such a declaration and the Registrar shall duly register and notify the declaration.[97]

2.11 *Surrender of Patent*

A Patentee can voluntarily surrender his patent by a written declaration addressed to the Registrar,[98] in this instance, the invention goes into public domain and can be freely exploited by interested persons. The surrender of a patent may relate to all or any of the claims made by the Patentee.[99] Where the Patentee surrenders his patent, it shall be registered and

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[90] Section 7(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[91] Section 7(2-3), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[92] Section 9(1) (a-c), *Ibid*.
[93] Section 9(2), *Ibid*.
[94] Section 9(5), *Ibid*.
[95] Section 9(5) (b), *Ibid*.
[96] Section 4(a), *Ibid*.
[97] Section 4(b), *Ibid*.
[98] Section 8(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[99] Section 8(2) (a), *Ibid*.

notified.[100] However, it is important to note that, a surrender shall not be effective until it is registered, [101]and if it relates to a patent in respect of which a contractual license has been granted, it shall only be registered only if it is accompanied by the written consent of the licensee.[102]

[100] Section 8(2) (b), *Ibid*.
[101] Section 8(2) (c), *Ibid*.
[102] Section 8(2) (d), *Ibid*.

CHAPTER THREE

LEGAL FRAMEWORK FOR THE PROTECTION OF INDUSTRIAL DESIGNS IN NIGERIA

4.1 Introduction

Industrial designs law exists to protect that appearance of articles rather than the articles themselves. It is concerned with how things look. It is important that design law is a part and parcel of industrial property law which takes its principles from intellectual property law. The underlying ideas behind the law of design is that it involves the two distinct elements of an 'article' and a 'product'.[1]

An industrial design adds value to a product and make it more appealing and attractive to customers. Registration of industrial designs encourages fair competition and honest trade practices which in turn promotes the production of a diverse range of aesthetically attractive products.[2] Generally, design may be functional articles such as an opener, a pen, a refrigerator, or even a car stereo.[3] It is an aspect of features applied to an article or product. This chapter examines the definition of industrial design, the historical development of industrial design in Nigeria, registrable and non-registrable designs, procedure for registration of industrial designs, categories of persons who may apply to register, duration and renewal of industrial designs, rights conferred upon registration, limitation to industrial design, exploitation of designs, renunciation and nullity of registration and other ancillary matters

3.2 Definition of Industrial Designs

An industrial design right is an intellectual property right that protects the visual design of objects that are not purely utilitarian. An industrial design consists of the creation of a shape, configuration, or composition of pattern or colour or combination of pattern and colour in three dimensional forms, containing aesthetic.[4]

An industrial design can be a two or three-dimensional pattern used to produce a product, industrial commodity or handicraft. The initial demand for a system of registration came from the textile industry, but now all manner of designs are registrable. Some of the most common kinds of design for which registration is applied include packaging and containers, recording communications and information retrieval equipment and furnishing.[5]

In Kenya according to Industrial Property Act 2001, an industrial design is defined as "any composition of lines or colour or any three dimensional form whether or not associated with lines or colour provided that such composition or form gives a special appearance to a

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[1] Bainbridge D. I. (2007) *Intellectual Property*, Person Education Limited. p.47.
[2] Looking Good: *An Introduction to Industrial Designs for Small and Medium Sized Enterprises in Nigeria*, WIPO Publication No.498 accessed at http://www.wipo.int/ebookshop on 4th February, 2019 at 2.15pm.
[3] Norman H. (2005) *Intellectual Property*, University of London Press, p. 50.
[4] *Ocular Sciences Ltd v Aspect Vision Care Ltd* (1997) RPC 289.
[5] Norman, H. (2014) *Intellectual Property Law Directions*, 2nd Edition, Oxford University Press, p. 14.

product of industry or handicraft and can serve as pattern for a product of industry or handcraft".[6]

In Indian, the Indian's Design Act 2000 was enacted to consolidate and amend the law relating to protection of designs and to comply with articles 25 and 26 of TRIPS Agreement. The Act define 'Design' to mean only the features of shapes, configuration pattern, ornament or composition of lines or colours applied to any articles whether in two or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separated or combined which in the finished articles appeal to and judged solely by eye, but does not include any mode or principles of construction.[7]

In Canada, the law is quite different from other common wealth nations. Canada's Industrial Designs Act 1985 defines 'Designs' to mean "features of shape configuration, pattern or ornament and any combination of those features that in a finished articles appeal to and are judged solely by the eye".[8]

In Nigeria, section 12 of the Nigeria's Patents and Designs Act defines Industrial designs to mean any combination of lines or colours or both and any three- dimensional form, whether or not associated with colours, is an industrial design if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain technical result. It is pertinent to note that designs in this context includes flower vase, cup or shoe sole, ranges and dimensions.[9]

Generally, designs concern the ornamental or aesthetic aspects of products and are a type of intellectual property.[10]

3.3 Historical Development of Designs' Law in Nigeria

The law of designs has a reasonably long history dating back to the latter part of the 18th century. In 1778 the first Designs Act protecting designs was passed in the United Kingdom. The act gave two months to designs applied for linens, cotton, calicoes, and muslins. The origin of design law sprang from this.[11]

Several other Acts were passed over the next few years and eventually these were repealed and replaced by Patents Designs and Trademarks Act 1883. A previous distinction between ornamental and useful designs was removed and the duration of protection was set at five Years. Later the Patents and Designs Act 1907 increased the maximum of protection to 15 years.

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[6] Section 14 Industrial Property Act 2001, Kenya.
[7] See generally section 2 of the Indian Design Act 2000.
[8] Article 1 Copyrights, Patents and Designs Act. CCL 93.
[9] *Chukwumereije & Sons (W/A) Limited v Patkum Industries Limited & Sons (1989) FHCLR 423; Spivap v Bola Alaba (1991) FHCLR 181; Serg Aims Aluminum Products Limited v Stanley Akagba & Ors (1994) F.H.C.S 188.*
[10] WIPO at http://wipo.int/designs/en/index.html, accessed on 2nd January, 2019 at 6.45pm.
[11] Cornish W. & Liewelyn D. (2007) *Trademarks and allied Rights*, Sweet & Maxwell, London. P 102

With the development of artistic copyright came problems of duplication of rights and the Copyright Act 1911, followed by Copyright Act 1956 which attempted to remove the overlap between a registrable design and artistic copyright. This was modified by the Designs Copyright Act 1968 which permitted dual protection to a design both as registered designs and under artistic copyright.[12]

If a design is aesthetic it was subject to some other requirements registrable under the Registered Designs Act 1949 and could be protected for 15 years. This has now been extended to 25 years. If the design was functional, it was not registrable but could attract artistic copyright through it drawings. This may last for the remainder of life of the author plus 50 years.[13]

The law on designs was radically altered by the Copyrights, Designs and Patents Act 1988 both in terms of changes to the registered designs and the new unregistered designs right. The law prior to the coming into force of this Act remained relevant for designs which were created or recorded before 1st August 1989 in the U.K. In Nigeria, the Patents and Designed Act was introduced in 1968.[14] Subsequently it was passed in 1970 to repeal the United Kingdom (Protection) Act. Therefore, the current legislation which provides for the original registration and other matters of industrial design in Nigeria is the Patents and Designs Act, Cap. P2, Laws of the Federation of Nigeria, 2004.

3.4 Registrable and Non-Registrable Designs

3.4.1 Registrable designs

The requirement for the registration of designs in Nigeria are incorporated in section 13(1) of the Patents and Designs Act. The section provides. "Subject to this section an industrial design is registrable if – (a) it is new; and (b) it is not contrary to public order or morality"

a. Newness

Accordingly, newness or originality as it is commonly called is a *sine qua* non of registrability. On the definition of what is new and original, Duckley in the English case of *Dover Ltd. vs Numberger*[15] said:

> The word "Original" contemplates that the person has originated something that by exercise of intellectual activity he has started an idea which has not occurred to anyone before that a particular pattern or shape or ornament may be rendered applicable to the particular

[12] *Ibid*. p. 103.
[13] *Ibid*. p. 105.
[14] Patents and Designs Act cap 68 LFN 1968
[15] (1910) Ch. D 25 at 29.

> article to which he suggests that it shall be applied. If that state of things be satisfied, then the design will be original although the actual pattern or shape or whatever it is which is being considered is old in the sense that it has existed with reference to another article before. The word 'new' or 'original' involves the idea of novelty either in the pattern, shape or ornament is to be applied to some special patent and industrial design.

Also, in the Nigerian case of *Controlled Plastics vs Black Horse Plastics Industries, Limited*[16], the court described the word "new or original" as involving the idea of novelty either in the pattern, shape or ornament itself or in the way in which an old pattern is to be applied to some special patent and industrial design. The requirement of newness has been illustrated in a plethora of cases. For instance, in the case of *Sauder vs Wiel,*[17] the design in issue consisted of representation of West Minister Abbey which was applied to the handle of a spoon. The design was held to be new, being the indigenous application of known design or drawing to an article of manufacture.

However, a design will not be considered new or novel where the design proposed to be registered does not differ from an earlier design merely in minor or inessential ways.[18]

In addition, after establishing the newness or originality of the design, the design must also fulfilled further conditions of the Act before it can be registered, For instance, section 13(3) [19] provides that "an industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description use or in any other way unless it is shown to the satisfaction of the Registrar that the creator of the design could not have known that it has been made so available". This has been judicially illustrated in the case of *Chukwumereije and Sons (W/A) Limited vs Patkum Indsutries Limited & Sons,*[20] the design in dispute (shoe soles) was held not to be new as it had been sold to customers prior to the application for registration. Also, in *Iyeru Okin Plastic Industries Limited vs Metropolitan Industries Nigeria Limited*,[21] the plaintiff secured registration of its design (school sandal model No.3099) after their sandals had been manufactured and sold in the market. The court held that the registration was invalid on the ground of lack of newness.

However, there are exceptions to the general rule of newness and certain acts that would not constitute prior application. First, it would not amount to prior publication where the creator of the design is unaware that the design had been published or made available to the public. But he must show this to the satisfaction of the Registrar.[22]The Second exception is where the publication of the design is being exhibited in an officially recognized exhibition within the period of six months.

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[16] (1990-1991) F.H.C.L.R 180.
[17] (1893) 10 R.P.C.29.
[18] Section 13(5) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[19] Patents and designs Act
[20] (1989) FHCLR 423.
[21] (1986) F.H.C.L.R 336.
[22] Section 13(3) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

Furthermore, confidential disclosure by the creator to a person under obligation of secrecy where the other party has interest in the design is also excluded. *In Ajibowo & Co. Limited vs Western Textile Mills Limited,*[23] the Supreme Court held that there was no publication where disclosure was made in confidence. Also, in *Spivap Nigeria Limited vs Bola Alaba & Ors*,[24] it was held that an employee was under an implied obligation not to disclose information about designs passed to him during the course of employment. The rationale is that it will cause a lot of hardship on employers if knowledge of designs during the course of employment amount s to publication.[25]

b. **Public Order or Morality**

An industrial design must not be contrary to public order or morality. However, the Act does not define what is meant by public order or morality in relation to industrial design. The test for determining whether a design is contrary to public order or morality is an objective test which is based on a reasonable decent person and not an overly permissive or extremely conservative member of the society. The determination of what is immoral is not an easy task as time changes and what is considered immoral in one era can be considered moral in another era.

3.4.2 Non-Registrable designs

The following designs are not registrable under the Act.

a. works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by an industrial process

b. wall plaques and medals

c. printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dressmaking patterns, greeting cards, leaflets, maps, plans, post cards, stamps, trade, advertisement, trade forms and cards transfers and the like.

3.5 Categories of person's who may apply to register an Industrial design

The right to the registration of an industrial design is not vested in the true creator of the design. Such right is vested in the statutory creator that is, the person who whether or not

[23] (1976) 7 S.C 97. *Metropolitan Industries (Nigeria) Limited v Industrial Application (Nigeria) Limited [1973]* I N.M.L.R.274
[24] (1991) F.H.C.L.R 181.
[25] Oyewunmi, A.O. (2018), *Nigerian Law of Intellectual Property*, University of Lagos Press and Bookshop Ltd, p. 212.

he is the true creator is the first to file an application for the registration of the design. Person to whom the design has been assigned and person who employ or commission others to create a design also have the legal right to register their titles.[26]

3.5.1 Statutory creator

Section 14(1) of the Patents and Designs Act provides:

> The right to registration of an industrial design shall be vested in the statutory creator, that is to say, the person who whether or not he is the true creator, is the first to file or validly to claim a foreign priority for an application for registration of the design.

The Act however goes on to provide that the true creator is entitled to be named as such in the register and that this entitlement cannot be modified by contact.[27]

Thus, the first to file a claim obtains a right to register the design. In order to ensure no room for any fraudulent claim, the Act further provides that if the essential elements of an application for the registration of an industrial design have been obtained by the purported applicant from the creation of another person without the consent of the other person both to the obtaining of those essential elements and to the fillings of the application, all rights in the application and in any consequent registration shall be transferred to that other person.[28]

3.5.2 Person who employ or commission others to create a design

Where the design has been created by someone in the course of his employment or in the execution of a contact for the performance of specified work who should lay claim to the design? Section 14(4) of the Act provide "where an industrial design is created in the course of employment or in the execution of a contract for the performance of specified work the ownership of the design shall be vested in the person who commissioned the work".

Indeed, where the design has been commissioned or has been created in the course of a person's employment that is as part of the job of that person his employer has the right to register the design.[29]

3.5.3 Person to whom a design has been assigned

A person's right in an application for the registration of a design and a person's right in a design may be assigned. Apart from assignment such right may also be transferred by succession

[26] Section 14(1) (2) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[27] Section 14(2), *Ibid*.
[28] Section 14(3) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[29] Baba Femi op. cit.

or held in joint ownership. An assignment shall be in writing, signed by the partners and must be registered with prescribed fees paid.[30]

3.5.4 Person to whom a license has been granted

Section 23[31] provide that a design owner may by a written contact grant a license to any person to exploit the design and in the absence of any provision to the contrary in the contract the licensee shall be entitled to do anywhere in Nigeria in relation to the design any of the act mentioned in section 19 of the Act which but for the license would be an infringement of the rights of the person who gave the license.

It appears from the provisions that "writing" is not obligatory in respect of a contractual license. It follows thus, that an effective license may arise by a parole agreement if acted upon. The Act[32] however requires that a license when granted must be registered and will be of no effect against third parties until registration is affected.

Furthermore, unless the intention is expressed or implied in the license, a licensee is not free to assign or sub license. A design owner, unless otherwise prohibited by the contract from the license may grant further license to other persons.

A contractual license may be general or limited. A general contractual license is one that grants to the licensee the power to use the design in any manner and to any extent throughout the whole territory for which the design was granted. Thus, the word 'use' and 'exercise' the design in the grant of contractual license without words of limitation will create a general license.

On the other hand, a limited contractual license is one that is limited in its scope either to a particular district or territory or for a portion only of the term for which the design was granted to the quality or quantity of the product to which the design may be exploited.[33]

3.6 Industrial Design Application

By virtue of section 15(1) of the patents and Designs Act, an application for the registration of an industrial designs shall contain; a request for registration of the design, the applicant's full name and address and, if that address is outside Nigeria and address for service in Nigeria, a specimen of the design or a photographic or graphic representation of the design with any printing block or other means of reproduction from which the representation was derived, an indication of the kind of product (or, where a classification has been prescribed or the class of product) for which the design will be used and such other matter as may be prescribed and shall be accompanied by the prescribed fee. Where appropriate a declaration signed by the true creator requesting that he be named as such in the register and given his name and address and if the application is made by an agent, a signed power of attorney (so

[30] Section 24 (1) (2) (3) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[31] Ibid.
[32] Ibid
[33] Section 23(3) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004

however that notwithstanding any rule of law legalization or certification of the signature of the power of attorney shall be unnecessary) [34]

A single application may relate to any number of industrial designs not exceeding fifty if the products to which the designs relate are of the same kind or where a classification has been prescribed of the same class.[35]

Where an applicant for the registration of an industrial design seeks to avail himself of a foreign priority in respect of an earlier application made in a country outside Nigeria – he shall append to his application a written declaration showing the date and number of the earlier application, the country in which the earlier application was made and the name of the person who made the earlier application and not more than three months after making of the application he shall furnish the Registrar with a copy of the earlier application certified correct by the Industrial property Office (or its equivalent) in the country where the earlier application was made.[36]

The Registrar shall examine every application for registration of an industrial design as to its conformity with the requirements of the Act, the design shall be registered in accordance with the application without further examination with and in particular without examination of the question whether the registration might be contrary to section 13(1)(a) of the Act and where the said examination shows that section 15(3) of the Act has been complied with as respects a claim for foreign priority, the foreign priority claims shall be recorded in the Register.[37]

An industrial design shall be registered by the issue to the applicant of a registration certificate containing – the number of the design in order of registration, the name and address of the registered owner and if that address is outside Nigeria, an address for service in Nigeria, the date of the application and of the issue of the registration certificate if a foreign priority is claimed – an indication of the fact and the number and the date of the application to which the claim is based and the name of the country where the application was made, a [38]reproduction or representation of the design and an indication of the kind (or where a classification has been prescribed the class) of products for which it will be used and where appropriate the name and address of the true creator.

The Registrar shall maintain a register of industrial design which shall consist of duplicates of the registration certificates issued under the Act together with such further matter as is required by the Act to be registered. As soon as may be after a design has been registered, the Registrar shall cause to be published, a notification of the registration containing the details mentioned above or if a summary form of notification is prescribed a notification in that form.[39]

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[34] See generally section 15 Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004

[35] Section 15(2) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[36] Section 15(3), *Ibid*.
[37] Section (1) (2), *Ibid*.
[38] Section 17(1) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[39] Section 17(2), *Ibid*.

3.7 Duration and Renewal

Matters relating to duration and renewal of industrial designs registration are contained in section 20 of the Patents and Designs Act. The Act states that registration of an industrial design shall be effective in the first instance for five years from the date of the application for registration and on payment of the prescribed fee may be renewed for two further consecutive periods of five years.[40]

The fee so mentioned shall be paid within twelve months immediately preceding the renewal period of grace of six months after the beginning of the renewal period shall allowed for the payment of the fee and if the fee and any prescribed surcharge are paid within that period, the provision shall be deemed to have been complied with.[41]

Finally, the fact that the registration of an industrial design has ceased to be effective or has been renewed shall be registered and notified.[42]

3.8 Renunciation and Nullity of Industrial Design

The registered owner of an industrial design may renounce the registration by a written declaration addressed to the Registrar. A renunciation may be limited to any particular kind or kinds of product or if a classification of products has been prescribed to any particular class or classes of product or if the application for registration comprised several designs to any one or more of those designs. Renunciation shall not be effective until it has been registered. If it relates to a design as to which a contractual license is registered it shall be registered only if it is accompanied by the licensee's written consent to registration or the licensee has in the license contract agreed that his consent need not to be obtained.[43]

On the application of any person including a public officer acting in the exercise of his functions, the court shall declare the registration of an industrial design to be null and void if the design because of its failure to conform with the novelty and public order or morality conformity ought not to have been registered or where the design fails to comply with section 13(1) and 14 of the Act.[44] Where a declaration of nullity relates to an application comprising several designs and the grounds for making the declaration affect only some of those designs the declaration shall apply only to the designs so affected.[45]

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[40] Section 20(1), *Ibid*.
[41] Section 20(2), *Ibid*.
[42] Section 20(3), *Ibid*.
[43] Section 21, *Ibid*.
[44] Section 22(1), *Ibid*.
[45] Section 22(2), *Ibid*.

Where a declaration for nullity is made the registration in question shall be deemed to have been null and void *ab initio* so however that it shall not be necessary to repay royalties paid by any licensee unless the court so orders and the proper officer of the court shall inform the Registrar who shall register and notify the declaration.[46]

The court however shall not make a declaration of nullity of a registered design without first giving the design owner an opportunity to be heard, that is the principle of natural justice, *Audi Alteram Patem* (a Latin maxim meaning hear the other side) must be complied with before the Court makes a declaration of the validity or otherwise of the patent. The court in deciding shall have regard only to the state of affairs existing when the proceedings were constituted and shall dismiss an application for declaration of nullity of industrial design if the applicant not being a public officer fails to satisfy the court that he has a material interest in making the application.[47] Nullity of an industrial application design succeeded in the case of *Iyeru Okin Plastic Industries Limited vs Metropolitan Industries Nigeria Limited.*[48] It is pertinent to note that the burden of proving the invalidity of a registered design is on the party alleging it.[49]

3.9 Rights Conferred by Registration of an Industrial Design

The owner of rights subsisting in a registered design has the exclusive right to reproduce the design for commercial purpose by making articles to the design or by making a design document recording the design for the purpose of enabling such article to be made. Commercial purposes, however refers to things done with a view to the article in question being sold or hired in the course of business.

Section 19 of the Patents and Designs Act states that registration of an industrial design confers upon the registered owner the right to preclude any other person from doing any the following acts.

(a) Reproducing the design in the manufacture of a product;

(b) importing selling or utilizing for commercial purposes a product reproducing the design; and

(c) Holding such a product for the purposes of selling it or of utilizing it for commercial purposes.[50]

The reproduction of a registered industrial design is not lawful namely because it differs in minor or inessential ways from the design or because it concerns a type other than the type with which the design is concerned.[51]

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[46] Section 22(3), *Ibid*.
[47] Section 22(4) (a-c), *Ibid*.
[48] (1986) F.H.C.L.R 336.
[49] *Spivap Nigeria Limited v Bola Alaba & Ors* (1991) F.H.C.L.R 181.
[50] Section 19(1) Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

The rights conferred shall extend only to acts done for commercial or industrial purposes and shall not extends to acts done in respect of a product incorporating a registered industrial design after the product has been lawfully sold in Nigeria.[52]

[51] Section 19(2), *Ibid*.
[52] Section 19(3) (a) (b), *Ibid*.

CHAPTER FOUR

INFRINGEMENT OF PATENTS AND INDUSTRIAL DESIGNS

4.1 Introduction

Patent and Industrial designs are very important forms of intellectual property. As a result, the Act[1] has accorded them protection. In event of infringement the Patent and Design Act makes provision for remedies. Protection of these form of intellectual property is a way of encouraging people who have creative ability to put their effort into productive use and come up with innovations which can be used for national growth and development. Nigeria is a large country with a lot of potentials, as such there are so many existing and expected innovations. Therefore, these innovations and results must be given adequate and efficient legal protection so that inventors and the country at large will benefit from such creativity/innovations. Consequently, this chapter will discuss matters relating to infringement, administration and jurisdiction of patents and industrial designs, Challenges hindering the effective protection of the patent and industrial design.

4.2 Patent Infringement

Patent infringement is the commission of a prohibited act with respect to a patented invention without permission from the patent holder[2] Under the Act,[3] the Patentee has the exclusive right to his patented invention. He can preclude all others from commercially exploiting his right conferred on him by Section 6 of the Patents and Designs Act.[4] Therefore, where a person commercially exploits[5] the rights of the Patentee without license or relevant permission, such a person will be liable for infringement.[6]

In *Pfizer Limited vs Tyonex Nigeria Limited and Ebamic Pharmacy Limited,* Pfizer sued two pharmaceutical companies in Nigeria, Tyonex Nigeria Limited and Ebamic Pharmacy Limited for importing a drug from Turkey and selling it under the name "Amolovas". According to the plaintiff the active ingredient found in the "Amolovas" was invented by Pfizer under the brand name" Norvasc" and patented in Nigeria under patent No.9970. In delivery judgment the court held that the two companies had infringed on Pfizer's patent because it was successfully proved that "Amolovas" contained Pfizer's patented product. Subsequently, the court granted injunction and awarded damages in favor of Pfizer Limited.

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[1] Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[2] Revters, T. (2018) *Patent Infringement and Litigation.* https://small business.findlaw.com/ intellectual-property/patent-infingement-and-litigation.html, accessed on 12/09/2018 at 7.45am
[3] Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[4] Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[5] Includes all activities used to benefit commercially from one's property. For instance, producing, selling it, offering it for sale, or licensing its appropriation or use.
https://www.law.cornell.edu/wex/commercial_exploitation
[6] Section 6(3) and 25(1), *Ibid*.

In another recent and remarkable case of *Beddings Holdings v INEC and others*,[7] the plaintiff, Beddings Holdings was a limited liability company registered in Nigeria and specializing in the general fabrication and manufacture of products such as Transparent Ballot boxes and collapsible polling Booths. The plaintiff contended that it had acquired patent right over the process and application of Direct Data Capture Machines for the compilation and collection of various biometric information. While delivering judgment Honorable Justice A. Bello of the Federal High Court affirmed that, the Patent and Industrial Design Rights (RP 12994 and RPD 5946 respectively) held by Bedding Holdings Limited (the plaintiff) for the invention "Transparent Ballot Box" were infringed by INEC when it licensed the importation of the Transparent Ballot Boxes to two private Nigerian companies without seeking the requisite consent or license of the plaintiff.

In *James Oitomen Agboronfo vs Grain Haulage and Transport Limited,* [8]the court stated that for a plaintiff to succeed in an action for infringement of patent, four things must be proved. These are:

i. That what he invented was patentable and had been registered as such under section 1 of the Patent and Designs Act.

ii. That the defendant did an act which constituted an infringement of the patented invention.

iii. That the act of infringement was done without consent or license of the defendant.

iv. That the act of infringement has been covered by a valid claim of the plaintiff's patent.

In the case of *Arewa Textiles Plc. and others vs Finetex Limited,*[9] the respondent instituted an action at the Federal High court, Kaduna, claiming an infringement by the appellants, of its registered patent No. RP 12024 in respect of a process "method and apparatus" of producing textiles materials. It further claimed declaratory reliefs, a perpetual injunction and general damages against the appellants. The process was invented by one Kong Sang Wong. The said process was later assigned to Boaty Company Ltd, who further assigned right to apply for a patent in Nigeria to the respondent. The respondent contended that the 1st appellant used its process illegally. The trial court granted the claims of the respondent and awarded damages against the appellant for patent infringement.

Dissatisfied with the judgment of the trial court, the respondent appealed, on appeal, the court upheld the appeal of the appellant, because there was no evidence that the respondent ever registered the process in Nigeria.

[7] (2014) 3 CLRN 147
[8] (1977-2003) Vol. 4, IPLR 139.29 ch 164.
[9] (2003) 7 N.W.L.R 322.

Also, the action for infringement was judicially illustrated in the case of *Uwemedimo vs Mobil Producing Nigeria Limited*,[10] in this case, the appellants sued the respondent at the Federal High court claiming an injunction to restrain the respondent whether acting by its directors, officers, servants or agents from infringing letters Patent No. RP 13522 of 5th August, 1999 and an inquiry as to damages or, at the appellants option or an action for profits made by the respondent in its infringement of the letters patent in the business of production of crude oil , condensate, liquefied natural gas produced daily from 5th August, 1999 for the term of years and use of $2.00 (two dollars) or the equivalent in Naira as royalty per barrel daily by the respondent from 5th August,1999 to 4th August, 2001.The appellants claimed that there was an oral agreement between the parties that the respondent would pay two dollars for the petroleum product of the respondent for the appellants invention that stopped the corrosion of the respondent's pipelines. The appellants asserted that the agreement for the payment was reached at a meeting attended by the appellants and the respondent's staff in 1980.The fits contract was on 2nd May, 1980.

The respondent denied that it had entered into an oral agreement with the appellants as it was not its practice to do so even for contracts involving small amounts. In a letter written on 2nd July, 1980, the respondent acknowledged that a verbal discussion was held on 30th June, 1980on Mobil Blue Enamel Oil. Subsequently, the appellants sent their quotations leading to the issuance of Local Purchasing orders (LPO) contained in Exhibit 7 and 7B. The LPO for Mobil Blue Oil Based Enamel Paint was issued on 1st July, 1980 and the LPO for the appellants to purchase the paints and the appellants wrote letters dated 31st December, 1984 and 8th May, 1987 to protest the respondents' actions.

The appellants applied for the patent and the patents certificate rp.13522 was issued to the 1st appellant on the 5th August, 1999. Upon conclusion, the trial court held that the appellant /applicant did not have a valid patent vested on him as at the date of the alleged infringement by the defendant.

In another case of *Pfizer Inc. vs Polyking Pharmaceuticals Limited and Another*,[11] the plaintiff was the manufacturer and marketer of certain pharmaceuticals in Nigeria, which included its Piroxicam drug, "Feldene", in respect of which patent was granted. The patent was applied for in 1973 but was granted in 1987. The 1st defendant (Polyking Pharmaceuticals Limited) and 2nd defendant (Polyking International Limited) imported and sold the drug "Piroxicam" under the trade mark of "Rossiden Capsule". The plaintiff sued the defendants for infringing his patent of the Piroxicam product. The defendants argued that the ingredients in their own Rossiden was different from the plaintiffs Feldene drugs. They further argued that, the plaintiff patent was not valid since the renewal fees were not paid since October, 1974. On the issue of infringement, the learned judge, Olomojobi said:

> On the basis of the evidence adduced by the 1st plaintiff expert who is an expert in the field of science pertaining to the chemicals in the drugs in issue and in the absence of evidence to the contrary. I have no alternative but to hold that the compound in the defendant's drug, Rossiden is the

[10] (2011) 4 NWLR (Pt.1236) 80.
[11] (1998) F.H.C.L. 1.

> same Piroxicam as the one in the plaintiffs No.PR 9708 and I so hold. As such the defendants have infringed the plaintiffs patent PR.0708. It is important to note that, in patent infringement, the burden of proof lies on the claimant and the claim or claims is what the court will refer to ascertain whether an infringement has occurred.[12]

From the foregoing, it is evident that to establish a case of patent infringement, the onus lies on the claimant.[13]

4.3 Defences to a Patent Infringement

Where a person exploits a patent without the required authorization, such a person will be regarded an infringer, however, an infringer has a wide range of excuse to escape liability. These includes:

a. Non-Infringement: The defendant can assert that the infringing act was done for purposes permitted under the Law. For instance, the alleged infringer can prove that the infringement was carried out for research, educational purpose or non-commercial purposes and not for industrial or commercial purpose.[14]

b. Prior Invention: Another defence an alleged infringer can raise is that the act was done in good faith and before the prior date of the invention.[15] For an infringement of patent to be actionable, the infringement must have taken place after the application of registration for registration has been made and not before.[16]

c. Assignment: where the alleged infringer can prove that the Patent was assigned to him by the Patentee, then this will serve as a defence.[17] An assignment is a transfer

[12] See also *Buchaman v Alba Diagnostics Limited* (2001) R.P.C.851
[13] Section 137, Evidence Act Cap. E14, Laws of the Federation of Nigeria, 2004.
[14] Section 6(3) (a), *Auchincloss v Agriculture & Veterinary Supplies Limited (1997) RPC 649.Frearson v Loe (1878)9 Ch. D 48.*
[15] Section 6(4), Patents and Designs Act, Cap. P2, Laws of the Federation of Nigeria, 2004.
[16] *Pfizer Inc. v Polyking Pharmaceuticals Ltd.* (1988), Vol. 1 FHLR 1, *General Tire & Rubber CO v Firestone Rubber Co. Ltd* (1976) 93 RPC 197. *Ayman Ent Ltd v Akuma Industry Ltd* (2003)13 NWLR (pt. 836), p. 99
[17] Section 24, *Ibid*.

or setting over of a property or of some right or interest there in from one person to another.[18] Property in this context includes all forms of intellectual property. As provided under the Patent and Design Act the Patentee has the right to assign, transfer by succession or hold in joint ownership his Patent.[19] Such transfer or assignment may be the whole of the patent or some part of it. In addition, the Patentee can assign his rights conferred on him to different Assignors, such rights include, right to import, right to manufacture.[20]

d. License: A license is an official document that gives you permission to own, do, or use something.[21] Licences are in two forms. It could be contractual or compulsory, in either case the defendant can validly defend himself against a patent infringement if he can successfully prove to the court, he had a valid license to use the patent and industrial design.[22]

e. Authority of the Minister to produce a patented product in public interest.[23]

f. True Inventor: By the provisions of the Patent and Design Act, the alleged infringer can raise this as a defence successfully that he is the true inventor.[24] In this context, the true inventor is the original creator of an invention.

g. Invalidity of Patent: This could be that the invention is not patentable as stipulated under the Patent and Design Act or if the claims does not conform with the provisions of the Patent and Design Act or the patent has already been granted in

[18] Bryan, A.G. (2019) *Black's Law Dictionary*. Thomson Reuters, 11th Edition p136.
[19] Section 24(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[20] Section 6, *Ibid*.
[21] https://dictionary.cambridge.org/dictionary/english/license?a=british accessed on 17th November, 2019 at 10.40am
[22] Section 10, 11 and 23, *Ibid*.
[23] Paragraphs 16 of the First Schedule to the Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004
[24] Section 2, Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

Nigeria for the same invention or it enjoys foreign priority.[25] There can be no infringement of an invalid patent since it can be held that the alleged Patentee had no rights *ab initio*.[26]

h. The doctrine of estoppel and Acquiescence: Estoppel is a bar that prevents someone from asserting a claim or right that contradicts what one has said or done before.[27] While acquiescence means a tacit, passive or implied acceptance to an act.[28] Where the Patentee had at some point represented to him either expressly or impliedly, including through leaving him (the infringer) to continue with his infringing activity for an unreasonable period of time, he did not object to the defendants conduct. This point was well illustrated in *Proctor vs Bennis,*[29]in this case, Bowen L.J held that to successfully apply for the defense of estoppel, it must be established that the plaintiff made an express or implied representation either that he would not enforce his right or that he had no rights against the defendant. On acquiescence, the defendant must prove that the plaintiff stood by and knowingly allowed the defendant to proceed with infringement.

4.4 Remedies Available to a Patentee

Generally, Section 25(2)[30] provides remedies available to a Patentee where his patent has been infringed upon. These remedies include;

4.4.6 Damages

Damages refers to the sum of money the law imposes for a breach of some duty or violation of some right. It could be compensatory damages (intended to compensate the injured

[25] Section 9(1) (a-c) and 2, *Ibid*.
[26] *Pittevil & Co v Brakelsberg Melting Process Limited*.49 RFC 23 at 32; *Windsurfing International v Tabur Marine (GB) Ltd.*
[27]Bryan, A.G. (2019) *Black's Law Dictionary*. Thomson Reuters, 11th Edition.
[28] *Ibid*.
[29] (1887) 37 Ch.D. 740.
[30] Patents and Designs Act, Cap. P2, Laws of the Federation of Nigeria, 2004.

party) or punitive damages (intended to punish the infringer).[31] Generally we have various type of damages such as general damages, special damages, exemplary damages, punitive damages, interlocutory damages, nominal damages.

Although the Patent and Designs Act does not enumerate the types of damages, however, courts have a wide discretion to award certain categories of damages based upon the fact of the case.[32]In Nigeria a Federal High court ordered N1.2billion as damages against a Multinational Pharmaceutical firm, Glaxosmithkline Consumer Nigeria Plc. (GSK) and its parent company, Smithkline Beecham Plc. based in the UK for infringing the patent of Continental Pharmaceutical Limited (CPL).[33]

In the case of *Pfizer Inc. vs Polyking Pharmaceuticals Limited and Another*,[34] the plaintiff had successfully proved that the defendants had infringed on their patent , the court awarded damages to the plaintiff to the tune of twenty-three million nine hundred and two thousand three hundred and twenty eight naira seventy-four kobo(N23,902,328.74).

Also, in the case of *Alcatel vs Microsoft corporation*,[35] a United States jury had found that Microsoft had violated patents held by Alcatel-Lucent Technology relating to the Music Player (MP3) format and awarded the plaintiff one billion fifty-two thousand dollars ($1.52billion). This damages has been considered as one of the largest damages ever awarded for patent infringement.[36]

4.4.7 Injunction

Another remedy available to the Patentee is an order of injunction. Injunction is a court order prohibiting someone from doing some specified acts or commanding someone to undo some wrong or injury. In other words, it is an equitable order restraining the person to whom it is directed from doing the thing specified in the order or requiring in exceptional situations the performance of a specified act.[37] The purpose of a patent injunction is to prevent the patent owner from experiencing continued irreparable harm caused by the infringer.[38]

The award of injunction was also granted in the case of *James Oitomen Agbonrofo vs Grain Haulage and Transport Ltd,*[39] in another case of *Pfizer Inc. vs Polyking Pharmaceuticals*

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[31] https://www.law.cornell.edu/wex/damages accessed on 23rd October, 2018 at 1.13am.
[32] Brian, F. (2018). *What types of damages or compensation will court award for patent infringement*? Retrieved from https://www.nolo.legal-encyclopedia/what-types-of-damages-or-compensation-will-court-award-for-patent-infringement.html. Accessed on 5 November, 2019 at 6.45pm.
[33] https://allafrica.com/stories/201106281132.html accessed on 20 October, 2018 at 8.20am.
[34] (1998) F.H.C.L.
[35] (2007) US 456, also *Apple Inc. v Samsung Electronics Co.* (2012)
[36] Grey, B. (2017), *9block Buster Initial Patent Damages in the US.* Retrieved from https://www.gregb.com/top-9-patent-damages/ accessed on 24th October, 2019 at 5:40pm.
[37] *Adeleke v. Lawal* (2014) 3 NWLR (Pt. 1393), p. 4 S. C
[38] https://ocpatentlawyer.com/overview-of-patent-based-injuction/ accessed 13th November, 2019.
[39] Supra; *Beijing Cotec New Technology Corporation & another v Greenlife Pharmaceuticals Company limited and 5 others* (2003) F.H.C.L 718.

Limited and another,[40] an order of *exparte* injunction was granted restraining the defendant further infringing on the plaintiffs' patent.

4.4.8 Account for profits

This relief is also available as a remedy when an infringement as occurred, it is an action taken against a defendant to recover the profits made by infringing on a Patentee or industrial designer's right. Basically, it aims at preventing unjust enrichment.

This remedy was approved in the case of James *Oitomen Agbonrofo vs Grain Haulage and Transport Ltd,*[41] where the court held that an award for damages will not succeed because of failure to prove the damages which he claimed. However, since an infringement was already established, the court ordered account for profits made by the defendant from the patent in order to prevent unjust enrichment.

4.4.9 Orders for inspection and seizure (*Anton Piller Order*)

Anton Piller Order is a court order that provides the right to search premises and seize evidence without prior warning. Generally, this order is intended to prevent the destruction of relevant evidence.

The first *Anton Pillar* order in Nigeria was made by Anyaegbunam C.J. in *Ferodo Limited vs Unibros Stores*[42] following the persuasive authority of the decision of the English Court of Appeal in *Anton Piller KG vs Manufacturing Processes Ltd.*[43] (the case from which the order took its name). The fact of the case was that the appellant, Ferodo Limited manufactured and sold a brand of brake linings and brake pads packaged in card boards under the name 'Ferodo" while applying for registration of the trademark, the appellants did not specify that the registration was sought for the accompanying design or garnishing (a red rectangle, at the upper end of which was a smaller black rectangle inside of which the name "Ferodo" was printed in white. The respondent, subsequently

[40] (1998) F.H.C.L. 1.
[41] Supra
[42] (1980) F.S.R 489.
[43] (1976) Ch. 55.

introduced into the market its own brand of brake pads and linings which it marketed under the trademark "Union or Union SUPA" Ferodo contended that the trade dress "Union" was similar to the trade dress of "Ferodo" and sued for passing off and infringement of its registered trademark. Consequently, the court while delivering the Lead judgement for the Supreme Court held that the Ferodo Limited had registered the trademark which could not by any manner be confused with "Union or Union SUPA" and therefore held that there was no infringement and the order was denied.

The next reported decision of a Nigerian Court on the *Anton Piller* order was the decision of Belgore J in *Oluwanishola Development Co. vs Guines Insurance Co. Ltd*[44]. In refusing to grant an *Anton Piller* order as prayed in that decision, Belgore J did not disapprove of the order, he however disapproved of the variation to the order as prescribed in the *Anton Piller* case sought to be introduced in the Nigerian context. He ruled that it did not accord with the order prescribed in the *Anton Piller* case to order that the party serving the order should include a senior official of the court as well as policemen. He expressed the view that to involve officers of the court in the execution of the order would be to involve the court in the contest between the parties. He also ruled that to authorize policemen to accompany the team would be to give the order the colouration of a search warrant which it was not.

Subsequent to that decision, Belgore J granted several *Anton Piller* orders. He also softened his view regarding the presence of the police in the raiding team. He recognized that in the Nigerian environment, a group of persons seeking to serve an *Anton Piller* order in a market run a very high risk of being attacked by a mob. He therefore would allow a

[44] (1980) - (1986) Vol. 2 Nigerian Shipping Cases 275.

specified number of policemen to accompany the team serving the order but only for the purpose of keeping the peace.

After the above-mentioned decisions in the 1980s there were at least two decisions[45] of the Federal High Court in early 1990s in which the court refused to grant *Anton Piller* orders on the ground that to do so would be to breach the right to fair hearing enshrined in the Constitution[46].

Recently the question whether the grant of an *Anton Piller* order would breach the constitutional right of fair hearing appears to have been settled by the Court of Appeal in *Akuma Ind. Ltd vs Ayman Ent. Ltd.*[47] The issue was raised in that appeal. In the decision of the court on that issue, Pats-Acholonu JCA stated: "Indeed Anton Pillar order although seemingly appearing as a monstrosity has become accepted within the vortex of our legal doctrines and jurisprudence."

It is therefore to be regarded as settled that *Anton Piller* order is a remedy available. *Anton Piller* Order is an order made in the exercise of the inherent jurisdiction of the court to do justice as occasion demands. The ex-parte nature of the order takes it out of reach of the normal rules of court authorizing inspection and discovery. Those rules require notice of an application in that regard to be given to the respondent.

The *Anton Piller* order is an order *in personam.* It is addressed to the respondent ordering him to permit the persons serving the order enter his premises and do therein, all the things which the order authorises them to do.

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[45] : *Solignum v Adetola* (1992) FHCLR 157 at 163; *Rokana Industries Ltd v Maun* (1993) FHCLR 243.

[46] Section 36, *Constitution of the Federal Republic of Nigeria* (1999 as amended).

[47] (1999) 13 NWLR (Pt. 633) 68.

Lord Denning in his judgment in the *Anton Piller* case[48] emphasized the fact that the order is not a search warrant which would empower entry into the respondent's premises without his consent. He stated that the court had no authority to issue a search warrant in support of a civil action. Hence the respondent under an *Anton Piller* order has to give consent to the applicant to enter his premises otherwise the applicant cannot.

Though the respondent can refuse to permit the applicant to enter his premises, in view of the fact that the court has ordered him to give such permission, he runs the risk of a committal for contempt of court if he refuses.

In consideration of the drastic nature of the order, and given the fact that the respondent will not be heard before the order is made, Lord Denning in the *Anton Piller case* emphasized that the order should only be made "When it is necessary in the interest of justice …" But only in an extreme case where there is grave danger of property being smuggled away or of vital evidence being destroyed"[49]

However, in patent and industrial, design cases, Courts are reluctant to grant this order because it has not been statutory provided under the Act.

4.4.10 Delivery up

This relief is granted by the court.[50] For instance in the case of *James Oitomen Agbonrofo vs Grain Haulage and Transport Ltd,*[51] The court ordered the defendant to deliver up for destruction all infringing articles in his possession, custody or control.

4.5 Industrial Designs' Infringements

Section 25(1) of the Patents and Designs Act provides that the rights of a design owner are infringed if another person without the license of the design owner, does or causes the doing of any act which that other person is precluded from doing under section 6 or 9 of the Act.

[48] (1976) Ch. 55.
[49] (1976) Ch. 55.
[50] Section 25 (2), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[51] (1977-2003) Vol. 4, IPLR 139.29 ch 164.

Section 6 of the Act mentioned Act of making, importing, selling or using or stocking for the purpose of sale. In *Controlled Plastics Ltd vs Black Horse Plastics Industry Ltd*.[52] the infringement action was in respect of a colander, which had earlier been registered by the plaintiff. The defendant started marketing a similar colander, the only difference being that while the plaintiff's product was perforated at the bottom, the defendant's product was not. Also, the plaintiff's colander had thicker lines than those of the defendant's. The court held that the differences were insignificant and therefore the defendant was liable for infringement.

In *Sarg Aims Aluminum Products Limited vs Stanley Akagha & Anor*[53] the plaintiffs claimed that the defendants had breached their exclusive right to the production, manufacture and marketing of the products carried under the certificate of registration of design issued to them. In upholding the plaintiffs' claims that the defendants had copied the designs from their own almanacs into the defendant's almanacs. Egbo, J. said *inter alia*

> It is my duty from the above findings to delve into the second issue for determination which is whether such statutory rights of the plaintiff have been infringed by the defendant. A convenient starting point is the issue of Almanacs, Exhibits D – D1, which are pleaded in paragraphs 10, 11, 12 and 16 of statement of claim and paragraphs 9 and 12 of the statement of defence respectively. Here issues were joined as defendant said its Almanacs was not copied from the Almanacs of the plaintiff. Since both Almanacs were tendered in evidence it is for me first and foremost to look at Exhibits D – D1 to decide whether they are similar. PW1 in his evidence in chief had meticulously indicated some examples in Exhibit D1 which were similar to his products in Exhibit D. To quote him, he said: "Prime steel casement window in Exhibit D was the same as casement window in Exhibit D. That there were 14 items of the dimensions in each case. Also Bonsue Revolving Door in Exhibit D was the same as Tropical Hinge Door in Exhibit D. There were 6 items of the same dimensions in each case. In fact after my visual examination of both Exhibits D – D1, I discovered that the evidence of PW1 was very truthful. The items were of the same dimensions and number as above stated by PW1, the only difference was in name. If this is placed side by side with the fact that plaintiff started production in the products in 1990 when he obtained Exhibits B – B1, that 1st defendant worked under the plaintiff from 1989 to 1991 when he left to found 2nd defendant in 1992, it will be inferred rightly that it was the defendant who copied from the plaintiff. I do hold here that it is true that the defendant copied what was in plaintiff's Almanacs in Exhibit D into its own Almanacs Exhibit D1"

[52] (1990-1991) F.H.C.L.R 180.
[53] [1994] F.H.C.S.188

To determine whether or not the plaintiff's right has been infringed, reference is made to the peculiar features of the designs as contained in the statement of novelty filled during the plaintiff's application for design. In *Chukwumereje and Sons (W/A) Limited vs Metropolitan Industries Limited & Sons,*[54] the fact that the statement of novelty did not cover the specific design feature alleged to have been infringed was held to be fatal to the case of the plaintiff. Also, in the case of *Metropolitan Industries Nigeria Limited vs Industrial Applications Nigeria Limited*,[55] the court held that where no statement if novelty is filled such failure affects the validity of the design.

4.6 Remedies Available upon infringement of an Industrial Design

4.6.1 Damages

Damages refers to the sum of money the law imposes for a breach of some duty or violation of some right. It could be compensatory damages (intended to compensate the injured party) or punitive damages (intended to punish the infringer).[56] Generally we have various type of damages such as general damages, special damages, exemplary damages, punitive damages, interlocutory damages, nominal damages. Although the Patent and Designs Act does not enumerate the types of damages, however, courts have a wide discretion to award certain categories of damages based upon the fact of the case.[57]

This remedy was judicially demonstrated in the case of *Chanrai & co. (Nigeria) Limited vs Khawan.*[58] In this case, the plaintiff sued in the High Court for the infringement of his registered design of a certain cloth, claiming an injunction and damages. The Judge granted the injunction and awarded 3,832.10 as special damages and 3000 as general damages. On appeal, the defendants admitted liability and did not complain of the injunction but complained on the amount of damages. The defendant's appeal was upheld and the amount of damages was reviewed. The Supreme Court laid down a very important principle that must be followed to determine the amount of damages to be awarded which is that damages must be awarded upon consideration of all the facts and evidence of the case. This principled was followed by the court in the case of *Controlled Plastics vs Black Horse Industries Limited.*[59]

*A*gain, in the case of *Sumal Foods and Confectionary Limited vs Wholesome Foods Processing Co. Limited*,[60] the court upheld the plaintiff's claim that the defendant had infringed their registered design in the label they used for their chewing gum and warded the plaintiff general damages. Ezekwa J. said, inter alia:

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[54] Supra.
[55] Supra.
[56] https://www.law.cornell.edu/wex/damages accessed on 23rd October, 2018 at 1.13am.
[57] Brian, F. (2018). *What types of damages or compensation will court award for patent infringement*? Retrieved from https://www.nolo.legal-encyclopedia/what-types-of-damages-or-compensation-will-court-award-for-patent-infringement.html. Accessed on 5 November, 2019 at 6.45pm.
[58] (1965) All NLR. At 189
[59] (1990) F.H.C.L. 180
[60] (1990)3 1.P.L.R. 52.

> "From the evidence before me, I am satisfied that as a result of the infringement of the plaintiff's design and the passing of the plaintiff's goods by the defendant as its own, the plaintiff suffered a loss of at least 25% decrease in trade from the time i.e. early 1998 when the defendant started the production of Toottsie Chewing Gum to the time the action was filled and to the present time. There is also evidence before me which I accept that the plaintiff sells its Chewing gum at #78.00-#80.00 per carton. I hold that the plaintiff is entitled to damages for the injury it suffered as a result of the act of the defendant in infringing its designs…" Accordingly the plaintiff was awarded the sum of two hundred thousand naira as general damages.

4.6.2 Injunction

Injunction is a court order prohibiting someone from doing some specified acts or commanding someone to undo some wrong or injury. In other words, it is an equitable order restraining the person to whom it is directed from doing the thing specified in the order or requiring in exceptional situations the performance of a specified act.[61] The purpose of a patent injunction is to prevent the patent owner from experiencing continued irreparable harm caused by the infringer.[62]

We have various types of injunction granted depending on the fact of each case. Injunctions may be granted before or during trial, to maintain status quo, pending final determination of the substantive suit. In *Peter E. Ventures (Nigeria) Limited vs Gazasonner Industries Limited & Another*,[63] the application for interlocutory injunction failed at the lower court and on appeal too on the grounds that the balance of convenience did not weigh in their favor.

In contrast the court awarded an order of interlocutory injunction in *Black Horse Plastics Industries Limited vs Ceplas Industries Nigeria Limited*,[64] in the case the plaintiff/applicant was the registered proprietor of a design in respect of which it instituted action against the defendant for infringement. The applicant filled for interlocutory injunction to restrain the defendant from further infringing on the said design n pending the determination of the substantive suit. The court agreed with the plaintiffs contention and prayer that it has a legal right to protect and the balance of convenience was sin their favour, Thus, the court granted their prayer for an interlocutory injunction against the defendant.

4.6.3 Delivery-Up

[61] *Adeleke v. Lawal* (2014) 3 NWLR (Pt. 1393), p. 4 S. C
[62] https://ocpatentlawyer.com/overview-of-patent-based-injuction/ accessed 13th November, 2019 at 4:30pm.
[63] (1998) 6 N.W.L.R. 619 C.A
[64] (1998) F.H.C.L. 348.

In the case of *Black Horse Plastics Industries Limited vs Ceplas Industries Nigeria Limited,*[65] the court ordered the defendants to deliver up for destruction within 7 days the packets of chewing gum and the large plastic colanders in their possession under their control.

4.6.4 Order for Inspection and Seizure (*Anton Piller Order*)

Anton Piller Order is a court order that provides the right to search premises and seize evidence without prior warning. Generally, this order is intended to prevent the destruction of relevant evidence.[66]

In *Rokana Industries Plc vs A.S Maun and Others,*[67] the application for this order was denied on the basis that this order is unconstitutional as it violates the provision of the constitutional right to fair hearing in Nigeria.[68]

4.7 Defences to Infringement of an Industrial Design Disputes

A person who has allegedly infringed a design may plead one or more defence. Such defence include;

a. That right is not valid because the features copied fall within the exceptions

b. That the claimant's design did not originate from the designer or is a common place and therefore not original in that sense.

c. That the duration of the design has expired: As provided by the Patent and Design Act registration of an industrial design shall be effective in the first instance for five years from the date of the application for registration and on payment of the prescribed fee may be renewed for two further consecutive periods of five years.[69]

d. Designs. Where the act which constituted the infringement was carried within the exceptions recognized by the Patent and Design Act. These include acts done for either educational, experimental, educational, private or non-commercial purpose.

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[65] Supra at, Also, *Sumal Foods and Confectionary Limited v Wholesome Foods Processing Co. Limited* (1990)3 1.P.L.R. 52.
[66] A very detailed explanation of the remedy has been given in this work.
[67] (1996) F.H.C.L 243. Also, *Sony Kabushiki Kaisaha v Shahani and Co. Limited (1986) F.H.C.L.R 1. Ferodo Limited v Unibros Stores*
[68] *Ibid* at p. 67
[69] Section 20, *Ibid*.

e. That claimant lack *locus standi*: *Locus standi* is a Latin word which means place of standing. It connotes the right to bring an action or to be heard in court.

f. That the alleged infringement occurred before the right existed; in other to successfully prove this defense, the infringer must prove o the court that the infringement occurred before the owner of the industrial design registered his design.

g. Acquiescence is always a potential defense where the circumstances are such that the claimant have made it clear by his conduct that he has assented to the infringement and will not commence proceeding in respect of it. As regards the limitation period, the general tort's rule of six years from the day which the cause of action arises also applies.[70] Where the infringement continues or is repeated, fresh cause of action will arise. In *Farmer Build Ltd V Carrier Bulk Materials Handling ltd.*[71] the claimant knew that his rights were being infringed but decided to wait to see how successful the defendant infringing machines were. This was held not sufficient to count as a defense of acquiescence even when the claimant and the defendant continue to have a trading relationship during which the period the infringement was taking place to the knowledge of the claimant. The court held that the fairly modest delay by the claimant in bringing the action was not sufficient for acquiescence.

4.8 Jurisdiction over Patent and Industrial design disputes

In Nigeria, just as it is in the United States, Patent is a Federal matter and one of the items listed in the Exclusive Legislative List of the 1999 constitution.[72] By exclusive legislative list this means that only the federal government can legislate on matters contained therein. The

[70] Limitation Act, Cap 522, Laws of the Federal Capital Territory, 2006 All other states have their respective limitation laws, For instance, Kaduna State Limitation Law, Cap.89, 1990
[71] (1999) RPC 461
[72] Schedule 2, Part I, Constitution of the Federal Republic of Nigeria 1999 (as amended)

jurisdiction over patent disputes in Nigeria is vested in the Federal High court,[73] this is in line with Section 251[74] which provides that:

> … (f) Any Federal enactment relating to copyright, patent, designs, trademarks and passing-off, industrial designs and merchandise marks, business names, commercial and industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards…

In addition, section 26(1) of the Patents and Designs Act is also in line with the above provision as it provides that jurisdiction to hear and dispose of legal proceedings under the Act is vested with the Federal High Court. The judge may sit with and. be advised by two assessors having expert knowledge of matters of technological or economic nature.[75]The chief Judge of the Federal High Court may make rules of court for the regulation of legal proceedings under this Act if he thinks it necessary to do so.[76]

Jurisdiction to hear and dispose of legal proceedings relating to industrial designs is vested in the Federal High Court.[77] The court hearing such proceedings may sit with and be advised by two assessors having expert knowledge of matters of a technological or economic nature.[78] In addition, the Chief Judge of the Federal High Court may make rules of court for the regulation of legal proceedings relating to intellectual property as he thinks it necessary to do so.[79]

4.9 Administration of Patent and Industrial Design in Nigeria

The Minister and the Registrar are the two important officers for administering Patents and Industrial designs in Nigeria. By virtue of the provisions of the Patents and Designs Act, the administration of industrial designs in Nigeria is a duly vested on two important officers which are; a) the Minister of Industry, Trade and Investment. b) The Registrar of Patent and Design Registry.

4.9.1 The Minister

He is the Minister for Industry, Trade and Investment and is duly appointed by the President of Nigeria. The Minister is charged with the responsibility of patent and industrial design in Nigeria. Firstly, the Minister may make rules prescribing anything requiring to be prescribed for the purpose of the Act, rules to regulate the manner in which the Registrar shall maintain and make entries in the Register and he can make rules containing such administrative

[73] Section 32 of the Patents and Designs Act, and Section 251(f) *Ibid*.
[74] *Ibid*.
[75] Section 26(2), Ibid.
[76] Section 26(3), *Ibid*.
[77] Section 26(1), Ibid.
[78] Section 26(2), *Ibid*.
[79] Section 26(3), *Ibid*.

or procedural provisions as he deems necessary or expedient in order to facilitate the operation of the Act. In addition, he can, with the approval of the President Make rules establishing schemes to encourage inventive activity.[80]

Secondly the Minister is empowered to grant contractual licenses where he is satisfied that the grant is in the interest of Nigeria and its economic development.[81] This also includes directing the grant of compulsory license for certain patented products and processes declared by the order to be of vital importance for the defense or economy of Nigeria or for public health.[82]

Lastly, He may also direct the Registrar to publish from time to time a journal to be known as the Patents and Designs Journal as required by the Act to be published or notified.[83] Usually the Journal is published regularly.

4.9.2 The Registrar

He acts under the control and direction of the Minister. He is appointed by the Federal Civil Service Commission.[84] He is in the Commercial Law Department, Federal Ministry of Industry, Trade and investment. [85] His duties include: receiving and processing of applications for the registration of patents.[86]Examining such applications for conformity with rules 8 and 11 of the Patent Rules.[87]Granting Patent where the patent conforms to the statutory requirement.[88]Maintenance of the Register of Patents and making entries therein.[89]Correcting clerical errors in an entry in the Register after giving opportunity to them by the patent applicant to make a representation.[90]Publishing of patent and Designs Journal as directed by the Minister.[91]Registering the cancellation and surrender of patent.[92] He issues certificate, where such a certificate is required for the purpose of obtaining a patent abroad or for the purpose of obtaining a patent abroad, or for any legal proceedings, or other special purpose as to any entry, matter or thing which the Registrar is authorized to do.[93]Processing the application for the grant of compulsory license.[94]

Although the Registrar has enormous powers, any person aggrieved by a decision of the Registrar in the exercise of his powers and duties can appeal to the Federal High court for

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[80] Section 30(1&2), *Ibid*.
[81] Section 23(6), *Ibid*.
[82] Paragraph 13, Part 1, First Schedule to the Patents and Designs Act.
[83] Section 28(6), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[84] Section 28(1), *Ibid*.
[85]Official website of Trademark, Patent and Industrial designs in Nigeria, www.iponigeria.com/#/About accessed on 17 October, 2018 at 8:20pm.
[86] Section 3(1), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[87] Section 4(1), *Ibid*.
[88] Section 25(2), *Ibid*.
[89] Section 5(2), *Ibid*.
[90] Section 28(2), *Ibid*.
[91] Section 28(6), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[92] Section 8, *Ibid*.
[93] Rule 29, Patent Rules, Cap. 2. *Laws of the Federation of Nigeria*, 2004.
[94] Rule 36, *Ibid*.

redress.[95] It is believed that this provision of the law seeks to confer on the Registrar of Patents a high status. His status is more like that of an umpire who administers the rules fairly.

4.10 Challenges Hindering the Effective Protection of Patents and Industrial Designs' Rights in Nigeria

The primary function of intellectual property rights under the law is to protect from exploitation the rights of a person's work and effort. Despite the various efforts made at strengthening Intellectual Property rights and protection in Nigeria challenges remain. Common infringements take the form of unauthorized/unlicensed use and unfair competition. These activities violate the proprietary rights of owners from reaping the benefits of their inventions and efforts hence, hampers the growth and development of intellectualism, innovation and the entire creativity industry. Some of the challenges facing patents and industrial designs law in Nigeria are identified and discussed below which include the following;

4.10.1 Lack of expert examiners

One of the biggest challenges with enforcement of patent law in Nigeria is the fact that most patent examiners lack adequate knowledge and experience on Patent and are largely unskilled in the field of science, technology, and engineering and software applications. The Registrar of patent examines application as to their conformity with rules 8 and 11 of the Patent Rules but it is lugubrious that the Registrar who examines every patent application does not have prior knowledge of the state of art, in essence the purpose of examination is defeated, the effect of this lack of expertise is that patent examiners only perform a cursory look or search of the registry records in order to locate prior art and as such there is no substantive examination of the specification and drawings that are submitted for filing .This is dangerous because the average person finds it difficult to read and understand patent specification and there might be possibility of patent being registered when there is prior patent covered by the new registration. More worrisome is that not only is there lack of patent examiners, there are very few training modules or patent examination guidelines that have been developed to educate patent examiners in Nigeria.[96]

4.10.2 Lack of Effective Enforcement of Intellectual Property Rights

Generally, there is little or no effort achieved in enforcing intellectual property rights in Nigeria. Patent should be taken seriously because no country can achieve technological growth without efficient legal regime for enforcement of Patent rights. It is not about existence of

[95] Section 28(5), Patents and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.
[96] Waziri, K.M. *The Legal Regime of Patents and Designs Law and its effect on national Development.* (Faculty of Law, University of Abuja). P.14. Retrieved from http://ssrn.com/abstract=1875725 accessed 2 November, 2018 at 10.40am.

articulate laws creating these rights, it is about adequacy of enforcing them. When this is taken serious, challenges of patent enforcement would whittle down by its own. This problem is certainly not limited to Nigeria and other developing countries. In the U.S counterfeit cost business an estimated $200 billion a year[97]and Nigeria is no exception. It can even lead to loss of lives in the case of production of sub- standard drugs and equipment that are not fit for human consumption.[98]

4.10.3 Obsolete legal regime

Most of Nigeria's intellectual property laws are old and not in tune with the trends in the 21st century global market place. Since the enactment of the Act in 1971, there have been no significant amendment to it. One area of deficiency in the Act is that it has not provided for the remedy of *Anton pillar* order which has over the time proved to be a good remedy in instances of infringement. Also, there is no provision for criminal sanctions under the Act. All remedies available are civil in nature[99] which to this writer is insufficient to serve as deterrence to intending infringers.

Therefore, some of such archaic, vague and ambiguous provisions need to be amended or expunged so as to ensure that our Patent and Designs law is in tune with emerging global developments and on the same pedestal with what is obtainable in advanced countries. For instance, the Act only provides that patent granted without guarantee as to its validity,[100] in essence, the Registrar will only ensure compliance of the patent application as to formality not as to its compliance with the provisions of patentability. Therefore, granting patent or industrial designs at the risk of the Patentee.

This lack of amendment has certainly been a challenge in view of the fast pace in which technology is advancing in Nigeria and worldwide. Stakeholders have repeatedly pointed out the fact that in other advanced jurisdictions such as Britain from where most of Nigeria Intellectual Property Laws took their roots, reform have been carried out severally to enhance effective protection of Patent rights, elimination onerous statutory provisions and ensuring conformity with new innovations. Even countries like China have made several significant amendments to their patent laws. For example, in 2009, the Chinese government[101] made its third revision on the Chinese patent laws and in 2010 new regulation was issued.

4.10.4 Lack of efficient automated registry and electronic patent and industrial designs system

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[97] Mitche, l. O. (2011) *Fake Medicine Common in Many Sub-Saharan African Countries Gallup World*.http://www.gallup.com/poll/149942/fake–medicine–common–sub-Saharan–africa-countriesaspx accessed on 18th June, 2019 at 5:58am.

[98] *Ibid*.

[99] Section 25(1), *Ibid*.

[100] Section 4 (4) Patent and Designs Act, Cap. P2, *Laws of the Federation of Nigeria*, 2004.

[101] Akpotaire, U. A. (2012) Patent Strategies for Companies doing Business in Nigeria. http://ssrn.com/abstract. 1801883 accessed on 12th June, 2019 at 3:31am.

Unlike National Office for Technology Acquisition and Promotion (NOTAP), which can account for the number of patent applications submitted to it and the number granted, Patents and Design Registry in Nigeria is not efficiently automated. Asides registration of patent and designs that has been recently made available online[102] other matters are dealt with manually[103]. Presently the Patent registry is situated only in Abuja, so every inventor or lawyer will have to travel to Abuja to register his/her patent or industrial designs.

In addition, there is absence of regular power supply at the registries making it difficult to carry out efficient activities at the registry. Also, the online platform does not contain a comprehensive record of existing Patents and designs in Nigeria, so searches cannot be done online. These reasons have impeded the smooth development of these areas of intellectual properties.

This short coming often leads to double registration and makes it extremely difficult to compile/ report relevant data with regards to the number of patent application filed annually and trends in patent applications.[104] In addition, this shortcoming can cause delay in the registration and errors of patent and industrial designs in Nigeria. In 2011, World Intellectual Property Organization (WIPO) indicators compiled data relating intellectual property activities in several countries, including a number of African countries, data relating to Nigeria was incomplete. One possible reason for the failure is the difficulty that arises due to the lack of a complete computerized registry system that would make it easy to run reports on the number of patent application filed and registered at the Registry on a year-to-year basis.

4.10.5 Low level of awareness of patent and industrial design

Although there has been significant increase in the level of awareness of Patent in Nigeria, the Pace is slow compared to the rapid global changes and technological development taking place in respect of Patent. This challenge led to the creation of the Patent Information and Documentation Center (PIDC) which was established at the National Office for Technology Acquisition and Promotion (NOTAP) with the assistance of World Intellectual Property Organization (WIPO). However even with creation of PIDC there is still a low level of awareness of patents among the generality of the populace.[105] Most inventors/Nigerians have little or no knowledge about the statutory protection of their creative inventions and designs or even ways to go about protecting their work. This gap in awareness is also responsible for the series of infringement of these forms of intellectual property rights experienced in Nigeria.[106]

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[102] www.iponigeria.com accessed on 24th June, 2019 at 1.30am.
[103] Akpotaire, U.A Op.Cit
[104] WIPO's World Intellectual Property Indicators 2012 provides a wide range of indicators covering various areas of intellectual property: patents, utility models, trademarks, industrial designs, microorganisms and plant varieties protection. It draws on data from national and regional Intellectual Property office, WIPO, the World Bank and UNESCO.
[105] Owoseni, T.O. (2011) *Recent Development and Challenges in the Protection of Intellectual Property Rights.* World Intellectual Property Document, May 2011. p.3
[106] *Ibid*.

4.10.6 Inefficiency at the patent and designs Registry

This is another obstacle hindering the effective protection of these rights. Nigerian civil service is generally characterized by poor work ethics, poor mindset and poor work attitude.[107]

From findings some staff at the patent and designs registry come late, sleep, gossip or engage in unproductive activities during work hours in the offices when there is heap of work to attend to. The slogan "government work no be my papa work" is the order of the day. And this attitude to work is bad as it in turn slows the development and efficiency of the patent and industrial design.

4.11 Statistics of Patent and Industrial Designs in Nigeria

Table 4.11.1: Patent

Year	Total Applications filled	Applications granted	Applications not granted
2015	1403	1340	63
2016	927	837	90
2017	846	752	94
2018	692	629	66
2019	777	723	54

Source: Patent and Industrial Designs Registry, Abuja, Nigeria.

Table 4.11.2: Industrial designs

Year	Total Applications filled	Applications granted	Applications not granted
2015	1,000	876	124
2016	895	760	135
2017	1,456	1,258	198
2018	1,057	961	96
2019	1,109	1,035	74

Source: Patent and Industrial Designs Registry, Abuja, Nigeria.

[107] Victor, A.Y. (2018) *Challenges of civil service*. https://www.google.com/amp/s/www.vanguardngr.com/2018/09/challenges-of-civil-service-bakoyo/amp/ accessed on 3rd January, 2020 at 3:20pm.

4.12 Statistics of Patent and Industrial Designs in China

Table 4.12.1: Patents

Year	Total Applications filled	Applications grated	Applications not granted
2015	2,344,136	520,038	1,824,098
2016	1,343,747	425,88	1,301,159
2017	1,441,965	445,741	996,224
2018	1,608,431	463,493	1,144,938

Table 4.12.2: Industrial Designs

Year	Total Application's filled	Applications grated	Application's not granted
2015	748,126	651,799	96,327
2016	812,479	598,147	214,332
2017	844,466	680,611	163,855
2018	976,943	792,563	184380

Source: WIPO Official website[108]

From the tables above, one may be safe to say that, the low number of patents and industrial designs applications filled annually is as a result of this plethora of challenges discussed in 4.11 above. As compared to countries with an effective legal regime on these patent and industrial designs, Nigeria statistics is very low.[109]

[108] https://www.wipo.int/ipstats/en/statistics/country_profile/profile.jsp?code=CN

[109] World Intellectual Property Indicators 2019: https://www.wipo.int/edocs/pubdocs/en/wipo_pub_941_2019.pdf accessed on 13th January 2020.

CHAPTER FIVE

SUMMARY AND CONCLUSION

5.1 Summary

The research work has analyzed the legal regime for the protection of patents and industrial design in Nigeria. A foundation for the research was laid and preliminary issues were discussed and a review of existing literatures carried out.

Patent as a form of intellectual property was examined with the origin and development of patent protection traced. In addition, the present regime for the protection of patent in Nigeria was copiously analyzed bringing out eligibility for protection and the extent of rights conferred by the Patent and Design Act as well as the limitation to the exclusive patent's rights. Subsequently, Industrial Design was discussed and a detailed analysis of this was undertaken in this work. The research work also addressed challenges hindering the effective enforcement of these rights as well as the infringement of patent and industrial design in Nigeria. Finally, the research made some of the findings and consequently, some recommendations were made.

5.2 Findings

The research made the following findings:

i. The law regulating patent and industrial design in Nigeria are inadequate and require amendment, this accounts for some of the challenges which have been sufficiently discussed in Chapter four of this work. For instance, where there is an infringement of patent or industrial design right, only a true inventor/creator can institute an action for infringement. In essence, the state does not involve itself with the prosecution of patent and industrial design matters and this should not be the case since the state also generates revenue from patent and industrial design.

Also, another area requiring amendment in the Patent and Design Act is Section 4 which only empowers the Registrar to carry out formal examination of a patent application and not substantive examination. The implication of this section is that once the application satisfies the statutory requirements as to forms and fees and relates to one invention. He is not required to enquire as to its novelty, inventiveness

and industrial application or whether the application sufficiently discloses the inventions required under Section 1 of the Patent and Design Act.

ii. In addition, there are no adequate institutions apart from the Patent and Industrial Design Registry which is only located in Abuja. There are no other institutions like the Nigerian Copyright Commission to oversee the proper regulation of patent and industrial design in Nigeria. Therefore, for anyone who desires to file an application, such a person must travel to Abuja or pay an accredited agent/Lawyer who must also travel to Abuja since the method of application and search is still largely carried out manually.

iii. Another finding of this research is that there is low level of public awareness on the generality of patent and industrial designs in Nigeria. This lack or low level of awareness has made it very difficult for the efficient enforcement of patent and industrial design's Law in Nigeria because most people don't even know their rights or how to enforce their patent or industrial designs rights.

5.3 Recommendations

In line with the above findings, the following recommendations are made:

i. There is an imperative need to review the existing Patent and Design Act which regulates patent and industrial design matters so it can meet up with emerging international standards. This may be achieved by settling up a committee which should be made up of stake holders on the patent and industrial design. This committee should to come up with a bill reflecting the proposed amendments and should be forwarded to the Nigerian Legislative arm for consideration.

ii. It is also important to setup adequate institutions For instance, additional offices can be created in each state or each geo-political zone in Nigeria and In addition, a Statutory body (Agency/Commission) should be created similar to the Nigeria Copyright Commission which will be responsible for the protection and promotion of patent and industrial design in Nigeria.

iii. The jurisdiction over patent and industrial design matters should be increased to cover High court and not only the Federal High Court as provided under the Patent and Design Act.

iv. Proper sensitization/awareness of the public on the patent and industrial design as this would help curb infringements and strengthen the legal regime for patents and industrial designs in Nigeria. This can be achieved by sensitization campaigns, public education by the Minister, Registrar and the proposed Commission through the mass media and distribution of educational pamphlets on the patent and industrial design, organizing more intellectual property seminars, and workshops, Provision of scholarship opportunities to researchers or students in these fields which will serve as an encouragement. Proper awareness of the patent and industrial designs right will assist the public become aware of their rights, and enable them apply for the ideal protection.

5.4 Conclusion

Nigeria's Intellectual Property System (IPS) is young and still evolving in terms of contents and effective protection. While there are some challenges the current intellectual property presents opportunities operating within the country especially as Nigerian consumers are ravenously seeking innovations.

Patents and Industrial Designs has contributed to economic growth and development of the economy of developed countries. Therefore, it becomes necessary for efforts to continuously

be channeled towards the development of patent and industrial design in Nigeria in order to reap full benefits of these intellectual properties.

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