PROTECTION OF PATENTS AND INDUSTRIAL DESIGNS IN NIGERIA: AN OVERVIEW

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ABSTRACT

Patents are grants protecting new inventions and Industrial Designs are those elements attributed to industrial or commercial products to enhance their appearance and attractiveness. As instruments of economic development, the law affords protection to persons whose efforts and energy are exerted in this direction. The primary concern of applicable laws is to protect inventions and designs that are new or constitute a fundamental improvement of existing inventions and designs. The Nigerian legislation governing patents and designs is the Patent and Design Act, Cap. P20, LFN, 2004. Despite the protection against infringement enshrined in the Act, there are obvious challenges to the system which hinders an effective accomplishment of the aim of the law. This paper proffers an insight into the Nigerian legal regime of patents and designs, identifies existing setbacks and advances possible solutions.

Keywords: Patents, industrial designs.

INTRODUCTION

There is no doubt that the catalyst behind world development is industrial activities cutting across various spheres of life which include advertising, graphics, fashion, furniture, engineering, medicine and so on. It will therefore be of immense advantage to a nation which has implanted, a strong patents and industrial designs regime. Notwithstanding, the efforts Nigeria has put in so far in this respect, some setbacks still exist in the areas of examination of patents and designs applications, omission of Utility Models amongst others. In this paper, we shall be discussing the substantive and formal requirements of patents and designs, the protection and rights ascribed to an inventor and creator as well as challenges to an efficient legal regime of subject intellectual products.

CONCEPTUAL CLARIFICATIONS

1) Intellectual Property

Intellectual property simply refers to intangible products of the intellect (Marret, 1996. They are defined as the creations of the mind which are subject of ownership by its conceivers. It is broadly divided into 'Industrial property' (constituting of Trademarks, Patents, Designs, Utility Models, and Geographic indication of source), and 'Copyright' (constituting of literary works, artistic works, musical works, broadcasts and cinematographs), (WIPO). These products of the intellect are regarded as property because their owners can exclude others from using them and as well alienate them at will, (IPIC, 2015).

2) Patent

A Patent refers to a legal right, (Patent, n.d.), granted to an individual who applies for the registration of an invention, (Hodkinson, 1987), who could either be the true inventor or statutory inventor (that is a person whether or not the true inventor, who is the first to file a patent application in respect to an invention or who validly claims a foreign priority for a patent application in respect to an invention). It applies to technological products and processes including agricultural technology and conferrers on the holder the right to exclusively use, make, import, sell and stock the invented product or apply the invented processes in production, (Patents and Designs Act, 2004 : Section 6). Notably, these rights extends only to acts done for industrial and commercial purposes and is exercisable for a period of 20 years subject to no renewal, (Patents and Designs Act, 2004 : Section 7).

While a patent is granted in respect to a technological innovation which is a product or a process (but not scientific principles and discoveries), an industrial design is directed towards an industrial product's physical appearance.

3) Industrial Design

In ordinary parlance, a design will refer to the overall form and function of an invention while legally, it will refer only to the form or pattern of the invention; the ornamental, aesthetic elements of a product distinct from its technical or functional aspects, (Uloko G., 2010). A design or industrial design, is seen as any combination of lines, colours or both and any three-

dimensional form, whether or not associated with colours, used as a model or pattern for an industrial product and multiplied in an industrial process, (Patents and Designs Act, 2004: Section 12).

They are those artistic concepts incorporated into industrial products to enhance their appearances and attractiveness to consumers and not necessarily to obtain a technical result, (Babafemi, 2007).

PROTECTION OF PATENTS AND DESIGNS IN NIGERIA

For a better understanding the two concepts shall be elucidated separately.

1) Patents

Protection of patents in Nigeria is achieved by registering a patent application with the Patents Registry of the Intellectual Property office under the Ministry of Trade and Investment which entitles the patent holder to exercise ensuing rights within Nigeria. It is also possible to obtain patent in other countries with an application deposited in Nigeria. Depending on whether it's a regional or international application, the application will either be deposited in a regional office working for two or more countries within a given region jointly, such as the African Regional Property Organisation or the European Patent Office or the country's patent office accompanied by an international application. This is made possible by some regional and international treaties to which Nigeria is a signatory.

Upon registration of a patent application, such patent holder is conferred with the exclusive rights to make, import, sell, stock commercially the patented invention, apply the patented process, (Patents and Designs Act, 2004 : Section 6) and grant licenses to persons to exploit the patented invention, (Patents and Designs Act, 2004: Section 23). Licensing or contractual licensing is a way of effecting transfer of technology which most developing countries like Nigeria rely on to boost their technological development and advancement. Recognizing same as one of the rights enjoyed and exercisable by a patent holder, the Act also protects the licensee against unnecessary and unreasonable contractual restrictions, (Patents and Designs Act, 2004: Section 23(2)). However, while the licensee, unless permitted by the contract, is precluded from disposing the license by way of assignment or license, the patentee is not precluded from exploiting the patent or granting other licenses in respect to the same patent, (Patents and Designs Act, 2004: Section 23(4)).

However, it is not all alleged inventions that are patentable. There are conditions for patentability of an invention as contained in the Patents Act. Such invention must be new, (whether or not it is an improvement on an already patented invention), must result from an inventive activity, otherwise known as the 'principle of obviousness' and must be capable of industrial application, (Patents and Designs Act, 2004: Section 1). A new invention is one which has not been previously known or 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 time of filing of the patent application, as relates the field of knowledge to which the invention relates, (Patents and Designs Act, 2004: Section 1(2) (a) & (3)). An invention is a result of an inventive activity if it does not 'obviously' follow the trend as obtainable in the relevant field of knowledge in terms of its method, application, results and products, (Patents and Designs Act, 2004: Section 1(2) (b)). Thus, where an invention does not follow the obvious or known scientific or technological steps as pertain that field of knowledge, it will be regarded as having emanated from an inventive activity and consequently, patentable. Thirdly, an invention is deemed capable of an industrial application if same can be manufactured or used in any kind of industry including agriculture but with the exception of biological processes for the production of plants and animals, (Patents and Designs Act, 2004 : Section 1(2)(c) & (4)(a)).

The above also constitutes the substantive requirements of a patent application which ordinarily should be met alongside some formal requirements before it can be accepted for registration by the Registrar of patents. The formal requirements are stipulated in Section 3 of the Patents Act and include indication of applicant's full name, addresses, addresses for service within Nigeria (where a foreign address is proffered), the description of the inventions, various claims to which the invention can be attributed and legal fees.

Public interest is also put into consideration as it relates to the exploitation of a registered patent hence, the recognition and

inclusion of compulsory licensing in the Act as an avenue for limiting the monopoly enjoyed by a patent holder solely in the interest of the public, (Musa, 2011).

Infringements of the rights of the patentee will occur when there is an unauthorised application of the patented invention in any way the patentee can lawfully apply same and the such aggrieved patentee becomes entitled to seek remedies in court, (Patents and Designs Act, 2004: Section 25).

2) Industrial Designs

Similarly, industrial designs gain protection by registration which is made by a statutory creator, true creator, an employer in respect to designs created by his employee, or one who commissions a work through which the design emanated, (Patents and Designs Act, 2004:). The rights conferred on the designer holder by virtue of the registration are the exclusive rights to reproduce the designs in production; import, sell and utilise commercially the product with the industrial design as well as grant licenses to person for the exploitation of the registered industrial design.

The registration is considered by the Registrar of designs upon an application for registration of designs which should also conform to the formal and substantive requirements. The formal requirements are contained in Section 15 of the Patents and Designs Act and includes applicant's name, address, address for service within Nigeria where applicable, a specimen of the design, indication of the product or class of product to which

the design applies.

On the other hand the substantive requirement entails that the design must be novel or new, must not be in contradiction with public order and morality. A design is not novel if any of the following applies:

1. If the design is made available publicly anywhere or at any time by whatever manner prior to the date of application of the registration, (Patents and Designs Act, 2004:Section 13)
2. If the design constitutes a minor difference to an existing design or
3. If the design merely applies to a different from that which it applies to.

The duty to ascertain conformity of the design application to this requirements lies with the Registrar.

CHALLENGES TO THE PATENTS AND DESIGNS REGIME IN NIGERIA

The areas that shall be discussed are examination of patents and designs, exception to the rights of a patentee as enshrined in Section 6(4), undue emphasis on the statutory inventor and creator, and lack of recognition of Utility Models. Other challenges will include improper data computation which can lead to multiple registrations of similar designs, societal problems including illiteracy, corruption, poverty, ignorance and greed, inadequate infrastructure, inefficiency of the relevant governmental agencies and poor data keeping, (Chudi & Chioma, 2015).

Nigeria practices what is referred to as the 'deposit system' of patenting rather than the 'examination system' as obtainable in more industrialized countries, ("An Overview of the Law of Patent", n. d., para. 15). Even though the Act provides that the features of an invention and design which are novelty, inventive activity and industrial application are conditions of patentability and eligibility of designs, the Act does not empower the Registrars of Patents and designs to ensure their existence before effecting a registration. Thus, the Registrar is not empowered to ascertain the conformity of a patent and design application to the substantive requirements for registration but only the formal requirements. The Act in Section 4(2) provides thus:

> *when the examination mentioned in Subsection (1) of this section show that a patent application satisfies the requirements of subsection (1) and (3) of this section 3 of this Act, the patent shall be granted as applied for without further examination and, in particular, without examination of the questions-*
>
> *(a) Whether the subject of the application is patentable under section 1 of the act;*
> *(b) Whether the description and claims satisfy the requirements of subsection (2) of section 3 of this Act and*
> *(c) Whether a prior application benefiting from a foreign priority, has been made in Nigeria in respect of the same invention and whether a patent has been granted as a result*

of such an application.

In addition is Section 4(4) thus:

> *Patents are granted at the risk of the patentee and without guarantee of their validity*

With this practice, the whole essence of patenting and registration is somewhat ridiculed as real invention and inventive activity cannot be ascertained and deciphered for sure before a registration is made. Secondly, this current system indicates little or no mechanism for the avoidance and discouragement of multiple registrations giving the possibility of more than one registration of non-distinct inventions, especially as the Registrars are also exempted from ensuring that the description of the invention on the application is not adumbrated which consequently offers an abridged information on the usage and application of the invention. Further, Nigerian inventions will be negatively impacted as they may not be highly regarded internationally.

The effect of this deposit system is captured in section 4(4) above. The implication being that registration of a patent and design doesn't confer validity on the invention and design and upon the court (as empowered under Section 9) discovering non conformity with the substantive requirements, such patent or design shall be nullified.

The Act in Section 6(4) contains an exception to the rights of a patentee which appears very contradictory. By the section, a

prior manufacturer of a patented invention or user of a patented process is not precluded from further use of the patented invention or process after the registration of the patent by the patent holder, if done in good faith. It would therefore mean that what was registered was not novel at the time of registration.

The right to seek a patent and design registration is primarily vested in statutory inventor who can either be the true inventor or not. Apparently, the Act underscores the non-inventor rather than the inventor and invariably, disregards the possible incidents of fraud and unfair dealings. Further, when the rights of employers to acquire inventions made by their employees are extended to inventions made outside employee's job description, it depicts unfairness. And the question as to whether the employer's materials were used by the employee in the process is not enough justification to deprive the employee compulsorily, his right to seek and obtain patent, (Patents and Designs Act, 2004: Proviso (a) (i) to Section 2(4)).

Although Nigeria may be lacking in inventions, it is rich in local fabrications otherwise known as utility models or petty patents in various jurisdictions which is not recognized under the current regime as a subject of protection. Utility models are those technological products and processes that are less inventive as patents. They are usually minor improvements on existing patented inventions, (Onyeka, 2014). Their utility is evident in the areas of mechanics and micro-technology (Bainbridge, 1999: 439). Compared to patents, they undergo less stringent technological process (What is a Utility Model, 2013).

A utility Model system is alternative to the traditional patents system in terms of the less duration it attracts, the usual lack of examination of the product and less expensive registration process, (Onyeka, 2014). Its suitability for Nigeria lies in the fact that Nigeria is still developing as it will boost the development of the country. Secondly, as there is little or no examination conducted, it will be well suiting to Nigeria. However, there is no hindrance for effecting more suitable conditions. Also it will help protect against indiscriminate copying and abuse of such cumulative innovations.

CONCLUSION

We have attempted a succinct elucidation of the legal cover afforded to innovations and their designs in Nigeria. Also some challenges plaguing the current legal protection regime have also been highlighted and analyzed.

While agreeing to the view that a very tight patent and design protection system can affect the level of innovation needed to spur up a developing country like Nigeria (Onyeka, 2014), we are also of the view that an improvement in the light of the areas under recommendation will afford a better protection system and be of immense boost to the level of innovation in the country.

RECOMMENDATION

Patents and designs rights are the only shield against theft enjoyed by an inventor or creator over his product and therefore demands adequate protection. We hereby recommend a review

or amendment of the Patents and Designs Act to reflect the following:

1. An examination system that will consider both substantive and formal requirements for registration
2. The recognition and protection of Utility Models
3. Expunging the exception to the rights of a patent holder under Section 6(4)
4. Allowing an inventor employee right to seek and obtain patent on his invention and
5. Removing the emphasis placed on the statutory inventor or creator and place same on the true inventor or creator.

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