

THE LAW OF PATENTS IN NIGERIA: A REVIEW

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A. Introduction

Nigeria has in recent years made considerable progress in commercial and industrial fields. Consequently a class of rights which are more popularly known as "industrial property" are becoming of increasing importance in the economic activities of the country. These are patents, industrial designs, trade marks, trade names and copyrights. They are characterised as property because they are rights in personality of an incorporeal nature and are worth money. Recently the Nigerian Legislature has revised and modified what laws there were on these subjects with a view to equipping them to serve the current needs of the country.¹ In this article it is proposed to review the law on patents which are probably the most important of these species of property.

B. Patent right

A patent is a temporary but exclusive right granted under a system of law to the inventor of a new manufacture to make, use and sell articles according to his invention. The general policy of the law is to stimulate competition among clever and skilful persons, in the hope that goods will be produced and made available to the public in the best and cheapest way. The financial rewards which flow to the inventor from the temporary monopoly is intended to induce ingenious minds to undertake researches and make the results of their investigations available to the public. At the end of the monopoly the public is then free to act as if none existed before.

C. History

Patents law in Nigeria has an interesting history. It

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¹See Trade Marks Act, No. 29 of 1965; Patents and Designs Decree, No. 60 of 1970; Copyright Decree, No. 61 of 1970.

made its first appearance in 1900 by the enactment of the Patents Ordinance² and Patents Proclamation³ for the Colony and Southern Nigeria respectively. It was introduced in Northern Nigeria in 1902 by the Patents Proclamation⁴ of that year. Each of these enactments contained full-scale provisions for the grant and control of patents in the country and were comparable to the English enactment on the subject at the time. They set up well staffed Patent Offices under the control of a Registrar and his deputy. The Registrar exercised the functions which in Britain were carried out by the Comptroller-General of the Patents Office. Applications for patents for inventions were made to the Patents Office and appeals from decisions of the Registrar lay to the Attorney-General who had power to secure the assistance of experts in considering such appeals. A successful applicant was granted a patent by the High Commissioner in the name of the Crown.⁵

After the amalgamation of Northern and Southern Nigeria all these enactments were repealed and replaced by the Patents Ordinance, 1916,⁶ which applied throughout the country. The title of the statute was in 1925⁷ altered to "Registration of United Kingdom Patents Ordinance"⁸ and, except for minor modifications, it remained the law on the subject till 1970. According to the Ordinance application for a patent could no longer be made in Nigeria. It provided instead that a paten-

²No. 17 of 1900. All Ordinances and Proclamations are now Acts but for purposes of clarity of exposition it is intended to retain these words in the text. See, Designation of Ordinances Act, No. 57 of 1961.

³No. 27 of 1900.

⁴No. 12 of 1902.

⁵In the Colony and the North the Governor granted a patent in the name of the Crown.

⁶Cap. 141 of 1923 Edition of Laws of Nigeria (No. 30 of 1916).

⁷No. 6 of 1925.

⁸See Cap. 182 of 1958 Edition of Laws of Nigeria.

tee in the United Kingdom or a person claiming through him, could within three years of the grant of the patent apply to the Registrar of Patents in Nigeria to have his patent registered in the country.⁹ Every such application must be accompanied by a certified copy of the specifications (including drawings) of the patent and a certificate of the Comptroller-General giving full particulars of the issue of the patent on such specifications.¹⁰ On the receipt of the relevant documents the Registrar issued a certificate to the applicant and this conferred on him privileges and rights as though the patent had been issued in the United Kingdom with an extension to Nigeria.¹¹ Such rights and privileges continued in force as long as the patent remained in force in the United Kingdom,¹² and if the term of the patent was extended in that country such extension could be registered here.¹³ Similarly, assignments or transmissions of the rights and privileges acquired by registration here could be registered.¹⁴ The High Court was given the power, upon the application of any person who alleged that his interests had been prejudicially affected by the issue of a certificate of registration, to declare that exclusive rights and privileges conferred by such certificate had not been acquired on any of the grounds upon which the United Kingdom patent might be revoked under the law for the time being in force in that country.¹⁵

It is rather curious that about two decades after the introduction of patents law in Nigeria the law was altered to the effect that a patent could no longer be obtained in the

⁹s. 3.

¹⁰s. 4.

¹¹ss. 5 and 6.

¹²s. 7.

¹³s. 8.

¹⁴s. 11.

¹⁵s. 9.

country. Any inventor in the country who desired his invention to be protected by a patent could do so only by applying for and obtaining a United Kingdom patent and registering it in Nigeria. A possible explanation for this apparently retrograde step may lie in the fact that until quite recently there were hardly any industries or research institutions in Nigeria and as a result inventions scarcely took place. The consequence was probably that no patent applications were lodged in spite of the facilities provided by the law. But at the same time it was really necessary to protect in the colonial territory rights and privileges acquired under a patent granted in the metropolitan country. The law was therefore modified to reflect the realities.

The only reported case on the Registration of United Kingdom Patents Ordinance or its predecessors, so far as the writer is aware, is Poulenc and anor. v Lodeka Pharmacy, Ltd.¹⁶ In that case the parties were importers of poisonous and dangerous drugs as well as other pharmaceutical preparations. The plaintiffs took out a patent in the United Kingdom in 1951 "in respect of improvements in or the new phenthiazine derivatives", and registered it in 1957 under the Ordinance. They sold the chemical product under the name "Largactil" and it was said to have acquired very wide and good reputation throughout the country. In 1964 the defendant supplied a large quantity of this drug bearing its label to the Federal Ministry of Health and received an order to supply an additional quantity to the same Ministry. Moreover, the defendant displayed the same drug at its stand in an exhibition of Pharmaceutical Industry at the Federal Palace Hotel, Lagos. The plaintiffs commenced this action to restrain the infringement of their rights and in the meantime applied for an interim injunction to restrain further breaches pending the determination of the action.

The defendant contended that while it would amount to an infringement of the plaintiffs' patent rights to distribute the drug to the general public, it could not be so to supply it to the Federal Ministry of Health for use by the public. For this contention the defendant relied on s.46(1) of the Current United Kingdom Patents Legislation - Patent Act, 1949, which provides thus:

¹⁶1965 L.L.R. 9.

"Notwithstanding anything in this Act, any Government department, and any person authorised in writing by a Government department, may make, use and exercise any patented invention for the services of the Crown."

Ikpeazu, J. held that the United Kingdom Patents Act, 1949, did not apply in Nigeria in its totality. The effect of s.6 of the Registration of United Kingdom Patents Ordinance was that the registration conferred on a person who registered the patent privileges and rights such as were conferred on the patentee in the United Kingdom. But this, said his Lordship, did not mean that the whole Act applied. S.46(1) is an express power which the Act specifically confers on a government department, which may operate in diminution of the patentee's rights. For this limitation to operate in this country the local legislature must expressly make that provision in favour of the government department giving it express power to authorise a non-holder of a patent to supply patent substances. But this had not been done and the conclusion must be that the legislature did not intend the power to exist.

To negative the effect of the decision in the Poulenc case the Federal Military Government in 1968 promulgated the Patent Rights (Limitation) Decree.¹⁷ It empowered a Commissioner to authorise any person, including a government department, to purchase, make, use, exercise or vend any patented articles for the services of a government agency in the Federation if he was satisfied that it was in the public interest to do so. Such authority could be given with respect to any article before or after a patent had been obtained with respect thereto. The Government was exempted from infringement of a patent granted with respect to the articles concerned or the liability to pay compensation or royalty to a patentee or any person deriving title from him. The Permanent Secretary in the Ministry concerned might merely give the patentee such information as he

¹⁷No. 8 of 1968.

pleased concerning the extent of the use.¹⁸ Arrangements between the patentee and any person other than a Ministry with respect to the article was of no effect so far as it restricted its use or provided for the making of payments.¹⁹ Special provision was made for the use of this power during an emergency, including a civil war, for the efficient prosecution of such war, supply and maintenance of essential services and protection of the economy.²⁰ Finally, it was stated that the United Kingdom Patents Act, 1949 applied in Nigeria subject only to the modifications introduced by the Decree.²¹

The state of this branch of the law as described above was hardly satisfactory. Nigeria was becoming increasingly industrialised and many of the new industries were owned by Nigerians either exclusively or in partnership with foreign interests. In an industrialised economy inventions are the life-blood of progress and if inventions are to be encouraged the law should provide a convenient machinery to enable the inventor to obtain a patent which rewards him for his labours. It was therefore not good enough that an inventor in Nigeria had to obtain a patent in the United Kingdom under the law of that country and register it in Nigeria before he could obtain in Nigeria such rewards as were prescribed by English law. This was bound to be intensely inconvenient and liable to frustrate efforts. Nor was the English law on the matter necessarily adequate for the needs of Nigeria in view of the different levels of industrialisation in the two countries and the peculiar position of Britain as one of the world's leading industrial and commercial centres. Above all, the arrangement detracted from the status of Nigeria as a sovereign and independent state which should order its international and domestic affairs. In the light of all these, it was scarcely surprising that in 1970 the Federal Military Government promulgated a Nigerian law on the subject entitled

¹⁸ s. 1.

¹⁹ s. 2.

²⁰ s. 3.

²¹ s. 5.

Patents and Designs Decree.²²

Patents and Designs Decree

1. Introduction

The Decree which came into force on 1st December, 1971 deals with patents and industrial designs.²³ It repealed the Registration of United Kingdom Patents Ordinance (Act), the United Kingdom Designs (Protection) Act, the Patent Rights (Limitation) Decree and, in so far as they are in force in Nigeria, the United Kingdom Patents Act, 1949 and amendments thereof,²⁴ and sets out a truly Nigerian law on the subject.

A registry for patents under the control of a Registrar is established in Lagos in the Commercial Law Division of the Federal Ministry of Trade.²⁵ The Registrar is endowed with very wide powers in connection with applications for and grants of patents and in the administration of the law generally. Appeals from his decisions lie to the court.²⁶

2. Patentable Inventions

According to s.1 an invention is patentable if it

- (a) is new, results from inventive activity and is capable of industrial application, or
- (b) constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.

²²No. 60 of 1970.

²³See s.33 and L.N. 53 of 1971. The Decree is supplemented with Rules made by the Commissioner in pursuance of s.30 of the Decree. See Patents Rules, L.N. 96 of 1971.

²⁴s. 31.

²⁵s. 28.

²⁶s. 28(5).

An invention is new if it breaks a new ground in the field of knowledge to which it relates. It results from inventive activity if it does not obviously follow from what is already known to the public anywhere in the particular field and is capable of industrial application if it can be manufactured or used in any kind of industry, including agriculture.²⁷

A patent cannot be obtained in respect of plant or animal varieties or essentially biological processes for the production of plants or animals or for inventions the production or exploitation of which would be contrary to public order or morality.²⁸ Moreover, mere principles or discoveries of purely scientific nature are not inventions for the purpose of the Decree.

3. Who may apply for a patent?

(a) An applicant for a patent does not have to be the true inventor of the invention to which the application relates. Any person, whether or not he is the true inventor, is entitled to apply for a patent with respect to an invention, and the person first to apply or claim a foreign priority²⁹ in respect thereof is known as statutory inventor.³⁰ But whether or not he is the statutory inventor, the true inventor is entitled to be named as such in the patent, and this entitlement cannot be modified by contract. Where a person, without the consent of the inventor, applies for, and obtains a patent with respect to the invention, the rights arising therefrom are deemed transferred to the inventor. If an invention is made in the course of employment or in the execution of a contract for the performance of specified work, the right to a patent in the invention is vested in the employer or in the

²⁷S. 1(2), (3).

²⁸S. 1(4).

²⁹See below.

³⁰An agent applies on Form 2: Rule 6.

person who commissioned the work. In certain exceptional cases, however, the inventor who is an employee is entitled to fair remuneration.³¹

Every patent application must be made to the Registrar and contain the applicant's full name and address, and if the latter is outside Nigeria, an address for service in Nigeria. It must also include a description of the relevant invention with any appropriate plans and drawings, a claim or claims, all in duplicate, a signed power of attorney or authorisation if the application is made by an agent, the prescribed fee and, where appropriate, a declaration signed by the true inventor requesting that he be mentioned in the patent and giving his name and address. The specification or description must expose the invention in sufficiently clear and complete manner that it can be put into effect by a person skilled in the art or field of knowledge to which the invention relates.³² The claim or claims on the other hand must state clearly and distinctly the monopoly for which protection is sought.

(b) Convention application and foreign priority

A patent may be applied for by a person who has earlier applied for patent protection for the same invention in a convention country. A convention country is one which, in pursuance of a treaty or other international agreement to which Nigeria is a party, the Commissioner has by order declared to be a convention country for the purposes of the Decree.³³ Such an applicant shall in addition to the requirements mentioned above include the following information in his application: the date and number of the earlier application, the country in which it was made and the name of the person who made it. He must within three months of making the application furnish the Registrar with a copy of the earlier application certified correct by the Industrial Property Office in

³¹S. 2.

³²S. 3 and Rules 11 and 12.

³³S. 27(1). The Commissioner has in fact declared 76 countries to be convention countries for the purposes of the section. See L.N. 95 of 1971.

the country where it was made.³⁴ Where a patent application is made in Nigeria within twelve months of an earlier corresponding application for protection of an invention in a convention country, such application in Nigeria is treated as having been made on the date when the earlier application was made. This date is referred to in the Decree as "foreign priority."³⁵

4. Examination of application and grant of patent

The Registrar examines every application as to its conformity with the provisions of the Decree. Depending on which of the requirements have been complied with and which have not, he may grant the patent, reject the application, grant the patent but disregard any claim for foreign priority or invite the applicant to amend his application, and if the invitation is not responded to, reject the application.³⁶

A patent is granted by the issue to the patentee of a document in the specified form³⁷ containing the following: the number of the patent in the order of grant, the name and address of the patentee, and, if that address is outside Nigeria, an address for service in Nigeria, the dates of the patent application and the grant, the title of the invention and the period of its validity with reservations as to the rights of third parties and, where appropriate, the name and address of the true inventor. A copy each of the specification and the relevant plans and drawings, if any, are annexed. If foreign priority is claimed the document also contains an indication of that fact and the number and date of the application on which the claim is based, and the name of the country where it was made.

The Registrar maintains a Register of Patents in which he enters the information contained in a patent as well as other

³⁴s. 3(4).

³⁵s. 27(2) and (4).

³⁶s. 4.

³⁷Form 4.

matters required by the Decree to be registered. Soon after a patent is granted the Registrar causes to be published a notification of the grant containing the details thereof.³⁸

5. Term, surrender and nullification of patent

A patent expires after a term of twenty years from the date of the filing of the relevant application. But before the expiration of the term a patent is liable to lapse if the prescribed annual fees are not paid. It shall however continue in force if the fees and any prescribed surcharge are paid within a six months period of grace.³⁹ Again a patentee may by a written declaration addressed to the Registrar surrender his patent. Such surrender which may relate to all or any of the claims made by the patent is not effective until it has been registered. If a contractual licence or licence of right has been registered with respect to it, registration is possible only if it is accompanied by the written consent of the licensee.⁴⁰

On the application of any person who has a material interest in making the application or a public officer in exercise of his functions, the court, after hearing the parties, may declare the whole of a patent or any particular claim or claims made by it null and void if

- (a) the subject of the patent is not patentable;
- (b) the description of the invention or the claims does not conform to the Decree;
- (c) a patent has previously been granted in Nigeria with respect to the same invention.⁴¹

If a declaration is made as prayed then the patent in question

³⁸S. 5.

³⁹S. 7.

⁴⁰S. 8.

⁴¹S. 9.

is deemed to have been null and void since the date of the grant but the patentee is not bound to pay royalties paid by any licensee unless the court so orders. The fact of the declaration is then transmitted to the Registrar who registers and notifies the same.⁴²

6. Rights conferred by patent

A patent confers upon the patentee the right to prevent any other person from doing any of the following acts:

- (a) if the patent has been granted 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, and
- (b) if the patent has been granted in 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 of the acts mentioned in (a) above.

But the above provision is diluted by another which stipulates that rights under a patent extend only to acts done for industrial or commercial purposes, and do not extend to acts done in respect of a product covered by a patent after the product has been lawfully sold in Nigeria. If, however, the patent makes provision for a special application for the product then the special application continues to be reserved to the patentee. Moreover if at the date of a patent application in relation to a product or process or of a foreign priority validly claimed in respect of the application, a person other than the applicant, was conducting an undertaking in Nigeria and for that purpose was manufacturing the product or applying the process or had made serious preparations to do so, then notwithstanding the grant of a patent, the person shall have the right to continue the manufacture or application or to continue and complete the preparations. Thereafter he is entitled to carry on the manufacture or application, and in respect of the resulting products do the acts reserved to a patentee.⁴³

⁴²s. 9(4).

⁴³s. 6.

7. Assignments and Licences

(a) Assignments

A person's right in a patent application or a patent may be assigned to another person or transferred by succession. Such assignment must be in writing signed by the parties. An assignment or a transfer has no effect against third parties unless it has been registered and the prescribed fees paid. Joint owners of a patent may, unless they provide otherwise, separately transfer their share or exploit the patented invention, but can only grant a licence with respect to the patent jointly.⁴⁴

Apart from an out and out assignment or transfer by succession other persons than the patentee may be allowed to exercise the rights exclusively reserved for a patentee:

(b) Licences of right

On the application of a patentee the Registrar will register the words "licences of right" in respect of the applicant's patent, unless under a previous licence the patentee is precluded from granting a further licence. When such an entry is made anybody has a right to obtain a licence from the patentee to exploit the patent on such terms as they mutually agree. Failing agreement, the terms will be fixed by the court at the instance of the proposed licensee. Then the amount of the annual fees payable in respect of the patent is reduced by half. However, the patentee has a right at any time to apply to the Registrar for the entry to be cancelled. But if licences have already been granted in pursuance of the entry, cancellation is possible only with the consent of the licensees.⁴⁵

(c) Contractual licences

A patentee may by a written agreement grant a licence to any person to exploit the relevant invention. Unless it is

⁴⁴S. 24.

⁴⁵S. 10.

otherwise provided in the agreement, the patentee remains entitled to exploit the patent or to grant further licences to other persons. But the licensee cannot assign the licence nor is he entitled to grant further licences. If the contract permits the licensee to grant further licences such grant shall be governed by the same conditions as regulate the grant to himself.⁴⁶

Both licences of right and contractual licences must be registered and are not effective against third parties until registered and the prescribed fees paid.⁴⁷ The registration of a contractual licence is cancelled at the request of the licensor if the Registrar is satisfied that the licence has been terminated.⁴⁸ Any agreement for the grant of either of the licences is void to the extent that it imposes on the licensee in the industrial or commercial field restrictions which do not derive from the rights conferred by the relevant patent or are unnecessary to safeguard those rights.⁴⁹ In the absence of any provision to the contrary in the contract, both kinds of licensee are entitled to do anywhere in Nigeria in relation to the relevant patent any of the acts which the Decree reserves to a patentee.⁵⁰

(d) Compulsory licences

Four years after the filing of a patent application or three years after the actual grant of a patent, a person may apply to the court for the grant of a compulsory licence on one or more of the following grounds:⁵¹

- (a) that the patented invention, being capable of being worked in Nigeria has not been so worked;

⁴⁶ s. 23(1)(a), (4) and (5) and Rule 44.

⁴⁷ ss. 10(5), 23(2)(a).

⁴⁸ s. 23(2)(b).

⁴⁹ ss. 10(5), 23(3).

⁵⁰ ss. 10(5), 23(1)(b).

⁵¹ See Schedule I Part I, Rules 36-43.

- (b) that the existing degree of working of the invention in Nigeria does not meet, on reasonable terms, the demand for the product;
- (c) that the working of the invention in Nigeria is being hindered or prevented by the importation of the patented article, and
- (d) that by reason of the refusal of the patentee to grant licences on reasonable terms, the establishment or development of industrial or commercial activities in Nigeria is unfairly and substantially prejudiced.

If an invention protected by a patent cannot be worked without infringing rights derived from a patent granted on an earlier application or benefitting from an earlier foreign priority, a compulsory licence may be granted to the patentee of the later patent. But such a grant must be made only to the extent necessary for the working of his invention and if it serves industrial purposes different from those served by the invention which is the subject of the earlier patent, or constitutes substantial technical progress in relation to the earlier invention. If the two inventions serve the same industrial purposes then a compulsory licence of the later patent may be granted to the patentee of the earlier patent if he so requests. A compulsory licence shall not be granted if the patentee satisfies the court that his actions in relation to the patented invention are justified in the circumstance. But this requirement is not satisfied by evidence that the patented article is freely available elsewhere for importation into the country.

At the hearing of the application by the court, a representative of the Commissioner for Trade is entitled to be heard. The application will not be approved unless the applicant satisfies the court that he has asked the patentee for a contractual licence but has been unable to obtain such a licence on reasonable terms or within a reasonable time. He must also offer guarantees satisfactory to the court to work the relevant invention sufficiently to remedy the deficiencies which gave rise to his application. If the court decides to grant a licence the parties are required to reach agreement on the terms and if they cannot agree the court fixes them and

this is deemed to constitute a valid contract between them.

A compulsory licence, which must not be exclusive, entitles the grantee to do all the acts, except importation, which the patentee has the right to do. It may contain additional obligations and restrictions as regards both the licensee and patentee, but does not entitle the licensee to grant further licences.

On the application of the patentee the court may cancel a compulsory licence if the licensee fails to comply with the terms of the licence or if the conditions which justified its grant have ceased to exist. The terms of the licence may instead be varied by the court on the application of the patentee or licensee if new facts justify the variation. The grant, variation or cancellation of a compulsory licence is communicated to the Registrar who registers same and is not valid against third parties until it has been registered.

The Commissioner may by order in the Federal Gazette declare that for certain patented products or processes which are of vital importance for the defence or economy of Nigeria or for public health, compulsory licences may be granted at any time before the expiration of three or four years, as the case may be.

8. Action for infringement of the rights of patentee

The rights of a patentee are infringed if another person, without his consent, does or causes the doing of any act which the Decree reserves to the patentee. If the latter has been granted a patent in respect of a process for the manufacture of a new product and that product is manufactured by another person, then the product, in the absence of proof to the contrary, is presumed to have been manufactured by that process. An infringement is actionable at the suit of the patentee who may be awarded relief in the form of damages, injunction or account. A grantee of a licence from a patentee may by registered letter require the licensor to institute proceedings for any infringement indicated in the letter. If the licensor unreasonably refuses or neglects to institute the proceedings, the licensee may do so in his own name, without prejudice to

the right of the licensor to intervene.⁵²

9. Use of patents for service of Government Agencies⁵³

A patent has the same effect against the Government as against an individual.⁵⁴ This, however, is subject to very wide rights of user by Federal and State Government Ministries and Departments as well as voluntary hospitals, local authorities, statutory corporations and any company owned or controlled by the Government.⁵⁵ Thus, if a Federal or State Commissioner is satisfied that it is in the public interest to do so, he may authorise any person to purchase, make, exercise or vend any patented article or invention for the service of any of these institutions. The authority may be given either before or after the relevant patent has been granted and either before or after the acts authorised are done. It may also be given to any person whether or not he is authorised directly or indirectly by the patentee to make, use, exercise or vend the relevant article or invention. During a period of emergency very wide powers are conferred on a Commissioner to employ his powers under these provisions to deal with the situation.⁵⁶ Such authorisation exempts the Government, any authorised person, any supplier of the Government and any agent of the supplier, from liability for the infringement of any patent relating to the article or invention. He is also exempted from liability to make any payment to the patentee by way of royalty or otherwise. Where the use of an article is authorised, then, unless the Commissioner decides otherwise in the public interest, the Ministry concerned must furnish the patentee with such information as to the extent of the act

⁵² S. 25.

⁵³ Schedule 1, Part II which provides for this is practically a reproduction of the Patents Rights (Limitation) Decree, considered above.

⁵⁴ S. 29.

⁵⁵ Each of these institutions is described as a government agency. See Para. 23.

⁵⁶ Para. 20-22.

done with respect to the article as the patentee may from time to time require.

As has been pointed out above, authorisation may be given by a Commissioner to a licensee or assignee from a patentee to act with respect to a patented article or invention for the services of a government agency. Consequently, it is provided that the terms of any agreement made before or after the commencement of the Decree between the patentee and a licensee or assignee or any other person (other than the Government or a Ministry) are of no effect in so far as they restrict or regulate the use of a patented article or invention. They are also inoperative to the extent that they provide for payments in respect of such use.

Miscellaneous

The Federal Commissioner of Industries is authorised to establish a scheme designed to encourage incentive activity. Such a scheme may include a provision for the payment of grants to persons who have discovered or perfected or appear to have reasonable prospects of discovering or perfecting important inventions which cannot be further developed due to financial reasons.⁵⁷ If the Commissioner of Trade so directs, the Registrar shall publish a journal to be known as Patents and Designs Journal. In it shall be published all matters required by the Decree to be published or notified and such other matters as the Registrar deems fit. Until the direction is given any matter required by the Decree to be published or notified shall be published in the Federal Gazette.⁵⁸

If a patent registered in Nigeria under the former patent law was subsisting at the commencement of the Decree, it is treated as if it had been registered under the Decree. It shall then expire when the rights and privileges conferred by it would have expired had the Decree not been promulgated. But action for infringement lies under the Decree only if the alleged infringement occurred after the commencement of the Decree. In any other case such action may be instituted and

⁵⁷ s. 30(2).

⁵⁸ s. 28(6).

disposed of as if the Decree had not been made.⁵⁹ Any authorisation given under the Patent Rights (Limitation) Decree and effective at the commencement of the Decree is deemed to have been given under Part II of Schedule I thereof and continues in force accordingly.⁶⁰

Jurisdiction to hear legal proceedings

Jurisdiction to hear and dispose of legal proceedings under the Decree is vested in the High Court of Lagos State.⁶¹ The provisions of the Trade Marks Act 1965⁶² applicable to legal proceedings under that Act apply with the necessary modifications to legal proceedings under the Decree.⁶³ In such proceedings the court may sit with and be advised by two assessors having expert knowledge of matters of a technological or economic nature.⁶⁴

There are perhaps two possible explanations for confining jurisdiction under the Decree to the High Court of Lagos State. One is that the Decree is of a specialised and technical nature and as a result it was decided to reserve its administration to a particular court in the hope that it will in time acquire special skill in this area of the law. Another is that the arrangement was designed to suit the convenience of the Registrar. He may in certain circumstances apply to the court for an order.⁶⁵ He may appear and be heard in certain patent proceedings and shall do so in any patent proceedings if he is so directed by the court.⁶⁶ As the

⁵⁹Schedule 2, para. 2.

⁶⁰Schedule 2, para. 5.

⁶¹s. 26(1).

⁶²No. 29 of 1965.

⁶³Ibid.

⁶⁴s. 26(2).

⁶⁵See Trade Marks Act, ss. 38(3); 39(2), 5 & 6.

⁶⁶See Trade Marks Act s. 53.

Registrar has his office in Lagos it might have been thought that he would be better able to do all these if the proceedings take place only in Lagos.

Whatever is the correct reason for this arrangement, it is bound to be very inconvenient and expensive, in the context of Nigeria, for persons who will have recourse to the court in patent matters. There are now industrial and research establishments not only in Lagos but also in different parts of the large and extensive country. Yet a person from any corner of the country can have a patent matter settled by the court only in Lagos - by the High Court - and possibly, the Supreme Court. It would therefore seem that a better arrangement would have been to confer jurisdiction under the Decree on all the High Courts in the country or to establish special federal courts and assign to them jurisdiction under the Decree.

III

Patents and Designs Decree and the U.K. Patents Act, 1949 compared

Before 1970 the United Kingdom Patents Act, 1949 and amendments thereof⁶⁷ applied in Nigeria. But the Decree is not in any way a reproduction of the Act with necessary modifications and adaptations. The Act's equivalent of the Registrar under the Decree is the Comptroller-General. The Act contains 107 long sections and 3 schedules while the Decree consists of 33 sections and 2 schedules shared almost equally between patents and industrial designs. Here and there in the two enactments are a few similar provisions which are basic to the nature of a patent, but the Act contains numerous provisions which are not found in the Decree. For example, unlike the Decree the Act makes provisions for the following: Grant of patents of addition instead of completely new ones in respect of improvements and modifications of main inventions;⁶⁸ avoidance of applications for patents if all the requirements imposed upon the applicant by the Act are not completed within two years and six months from the date of

⁶⁷E.g., Patents Act, 1957; Defence Contracts Act, 1958.

⁶⁸s. 26.

filing of the complete specification;⁶⁹ opposition by any person on the prescribed grounds of the grant of a patent;⁷⁰ secrecy of inventions relevant for defence purposes;⁷¹ safeguard against anticipation by previous publication;⁷² and remedy for groundless threats of infringement.⁷³

Unlike the Act the Decree does not provide for an examiner whose report assists⁷⁴ the Comptroller-General in reaching a decision. It is however expected that in practice the Registrar has to be guided by such an expert. Under the Act a patentee is, in certain circumstances, compensated if the patented invention is used for the services of the government.⁷⁵ The Decree on the other hand does not provide for compensation in any event.⁷⁶ According to the Decree the term of a patent is 20 years,⁷⁷ but under the Act it is 16 years.⁷⁸ The latter period can be extended by the court for up to 5 years, and 10 years in exceptional cases, if the patentee complains that he has not been adequately remunerated.⁷⁹ It can also be extended by the court or comptroller for up to 10 years if the patentee or licensee shows that he has suffered

⁶⁹S. 12 as amended by Patents Act, 1957, s.1; Patent Rules, 1958 r.38 and s.1 1964 No. 228.

⁷⁰S. 14.

⁷¹S. 18.

⁷²SS. 50-52.

⁷³S. 65.

⁷⁴S. 6 and C's Application 7 R.P.C. 250.

⁷⁵SS. 46(3) and 48(1).

⁷⁶Schedule 1 Part 2 para. 17.

⁷⁷S. 7.

⁷⁸S. 22.

⁷⁹S. 23.

loss or damage as a result of war.⁸⁰

On the whole, the Act is a more detailed and sophisticated document. This is obviously explained by the high level of industrialisation in the United Kingdom and the commanding status of that country in the international community. The Decree on the other hand is short and simple. The simplicity will surely facilitate the procurement of patents and ultimately encourage inventive efforts.

IV

CONCLUSION

Although the Decree is short and appears simple, yet it is an extremely technical document. The interpretation of its provisions will certainly tax the resourcefulness and ingenuity of the Nigerian judges, particularly as there are no local precedents to guide them. The dearth of local judicial decisions on the former patents law of the country is due to the nature of the law itself and the previous level of industrialisation in the country. But today the position is different. Nigeria has achieved a large measure of industrialisation and consequently, there are now bound to be inventions here and there. An inventor in Nigeria or other person can now apply for and obtain a patent in the country in accordance with the Decree which has to be interpreted and applied by the courts. In this exercise they will certainly derive assistance from English decisions on similar provisions of the United Kingdom Patents Act. Commonwealth decisions interpreting statutes in pari materia may also be helpful. But the Decree is first and foremost a Nigerian legislation enacted against the background of the country's economic conditions, and it is hoped that the courts will not lose sight of this fact. The situation is being watched with keen interest and the years ahead will show how they will grapple with the problem.

⁸⁰SS. 24 and 25.