

## AN OVERVIEW OF THE LAW OF PATENTS IN NIGERIA

### Introduction

The grant of a patent for an invention is the grant to the patentee for a limited period of a monopoly right in respect of that invention i.e the right to exclude others from using that invention.

Patents are granted in Nigeria under the Patents and Designs Act of 1970. Cap 344 of Laws of the Federation of Nigeria 1990.

The purpose of patenting is essentially economic. The state, in order to encourage technological development assures an inventor of a monopoly right to exploit the invention for a limited period of time. It is envisaged that the inventor, during the period of such monopoly would have derived maximum financial benefit from the exploitation of the invention. The state thus ensures that inventions which could improve the quality of life of the citizenry are exploited to the good of the greatest number of people.

### A brief history of patenting in England

The concept of patenting originated in Europe as early as the 14<sup>th</sup> century. In England, from where Nigeria inherited its patent law, patenting started as grant of trading monopolies in exercise of the prerogative of the English Crown. James I was reported to be partial to rewarding his political friends with trading monopolies granted by letters patent. Between 1331 and 1452 various letters of protection were issued to foreign weaver and other craftsmen.

The first judicial pronouncement on the legality of patents for inventions was made in the Clothworkers of Ipswich Case where it was stated:

“But if a man has brought in a new invention and a new trade within the kingdom in peril of his life and consumption of his estate or stock, etc., or if a man hath made a new discovery of anything, in such cases the King of his grace and favour in recompense of his costs and travail may grant by charter unto him that he shall only use such a trade or trafique for a certain time, because at first people of the kingdom are ignorant, and have not the knowledge and skill to use it. But when the patent is expired the King cannot make a new grant thereof”

The origin of the modern system of patenting however is to be found in Statute of Monopolies enacted in 1624 by the English parliament in reaction to the scandalous abuse of the monopolies system perpetrated by the crown. The statute declared as void all monopolies, dispensations and from the general revocation. The section provided thus:

“Provided also (and be it declared and enacted) that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be

made, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures which others at the time of making such letters patent and grant shall not use, so as also they be not contrary to the law or mischievous to the state, by raising prices of commodities at home or hurt of trade, or generally inconvenient”

The development of modern patent law did not however start until 1753 when patent litigation was brought under the jurisdiction of the Court of Chancery and Queen’s Bench. Thereafter, cases on the construction of the Statute of Monopolies began to be reported, and the law of patents developed therefrom.

### A brief history of the Nigerian patent law

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 Southern protectorate Nigeria. Subsequently similar provisions were made to apply to the Northern protectorate Nigeria by virtue of the Patents Proclamation Ordinance No.12 of 1902.

These laws provided for the establishment of fully fledged patents administration system for Nigeria.

However, the situation was dramatically reversed after the amalgamation of the southern and Northern protectorates in 1914. The Patents ordinance and Patents proclamation ordinance was repealed and replaced with the Patents ordinance of 1916 later renamed and re-enacted as the Registration of United Kingdom Patents Ordinance of 1925 (Cap 182 Laws of the Federation of Nigeria and Lagos 1958).

The provision of the 1925 Ordinance was simply to extend the validity of patents granted in United Kingdom to Nigeria if an application to register same is made to the registrar of patents in Nigeria within three years of the grant of the patent in United Kingdom. Thus the independent patenting system provided for under the 1900 ordinances was terminated, and Nigeria became an extension of the territory of application of a United Kingdom patent.

Perhaps this legislative development is really not anomalous within the period of its occurrence. Perhaps the 1900 ordinances were indeed too ambitious, considering the standard of western civilization and level of western technological know how available within the indigenous population at the time. Again, since at that time, personnel for a patent office will have to be provided by the colonialists in any case, it must have been rationalised that to save cost, it was better to have persons interested in being granted patent protection in Nigeria to first obtain a grant in the UK where there was adequate personnel to evaluate such applications. Thereafter, registration of grant could be done in Nigeria to extend the validity of the UK patent to Nigeria.

Curiously however, the Registration of United Kingdom Patents Ordinance was not repealed until 1970, ten years after independence. If one could understand why the colonialist enacted the United Kingdom Patents Registration Ordinance in 1925, one finds it difficult to understand how the government of independent Nigeria allowed the law to subsist in our statute books for ten years after independence.

Eventually however, in 1970, the Patents and Designs Decree No. 60 ( now Patents and Designs Act) was enacted. The Act which created a Nigerian patent system and administration is still in force till today, and was published as chapter 344 of the Laws of Federatio of Nigeria 1990.

### Nigerian patent

Under the Act, a patent may be granted either for a product or for a process. An example of a process is the process known as electroplating or indeed any chemical reaction which may give rise to a product. Which ever the case may be, the life of the patent lasts for 20 years provided the annual renewal fees are paid for the duration of its potential life. Where the patentee defaults in the payment of the annual renewal fee, the patent

lapses, after a 6 months period of grace, if still not renewed and cannot be revived again.

#### Exclusion from patentability:

The act provides that certain matters are not patentable. These are set out in section 1(4) and (5) of the Act. These include plants or animal varieties, or essentially biological processes for the production of plants or animals. Inventions the publication of which will be contrary to public order and morality are also excluded, so also are principles of a scientific nature.

Apart from these exceptions, all products and processes, which meet the qualification for patentability under section 1(1) of the Act are patentable.

#### Grant without guarantee of validity

It must be understood before we delve into the requirements for patentability that the grant of the Nigerian patent is made without a guarantee of validity. Section 4(4) of the Patents and Designs Act 1970 provides:

“Patents are granted at the risk of the patentee and without guarantee of their validity”

A Nigerian patent is granted without the registrar looking into the questions whether the application meets the requirement for patentability. The Registrar only examines the application to ensure that all the documents which are required to be filed have been filed. Once he is satisfied that the formal requirements have been met, he proceeds to issue the certificate of patent (see section 4 of the Act).

Consequently, the fact that one has been issued with a patent certificate in Nigeria does not mean that the patent is valid. The validity is open to challenge in court, and if challenged, the primary onus of proving validity rests on the patentee (see section 9 of the Act).

Thus the Nigeria patent system is called the deposit system of patenting as opposed to the examination system adopted in the industrialised countries, where rigorous examination as to compliance with the requirements for patentability is undertaken.

As earlier mentioned the patentability of the Nigerian patent can be looked into anytime by the court upon the suit of any person interested. Section 9 of the Act provides that on the application of any person, including a public officer acting in the exercise of his functions, the court shall look into the questions whether an invention in respect of which a patent has been granted is patentable, the question whether the description of the invention conforms with the requirement for clarity and completeness set out under section 3(2), and the question whether at the time the application for the patent was filed, there already existed a prior application or a grant of a patent in respect of the same invention.

Where the court finds that a patent does not pass the test of validity under the provisions of section 1 or 3(2) of the Act, the patent will be declared null and void.

The rationale for the adoption of the deposit system of patenting is that in a developing country such as ours, there will be a shortage of persons of adequate expertise in all fields of technology and science who will be able to assess the novelty of any invention being sought to be patented. The deposit system, shifts the burden

of establishing patentability from the registrar to whoever wishes to oppose the patent. This system, apart from saving the government revenue it might otherwise pay out to experts who will assess the application, it is also speedy. One does not waste any time waiting for the application to complete the laborious process of assessment.

### Patentable inventions

Section 1 of the Patents and Designs Act 1970, prescribes the conditions for patentability. It provides:

- 1 (1) Subject to this section an invention is patentable
- (a) if it is new, results from an 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 by this provision for patentability:

1. The invention is new
2. The invention involves an inventive step
3. The invention must be capable of industrial applicability

The secondary provision which is made under section 1(1)(b) is that an invention will still be patentable if it is an improvement on an already patented invention.

We shall now examine each condition for patentability to understand the precise meaning of the provisions of the Act. In this process, reference will be made mainly to judicial pronouncements of the English court on provisions of the English Patents Act which coincide with the provisions of the Nigerian Law. There has been very few patent litigation in Nigeria, therefore there is a paucity of judicial pronouncements on the interpretation of our legislative provisions.

### The invention must be new or an improvement on a patented invention

The requirement of novelty is the primary focus of the law of patents. In other words, for an invention to qualify to be validly patented, the discovery must be completely unknown anywhere in the world at the time the application for the patent is filed. Thus if anybody else had made the discovery before the applicant, or even if the applicant himself had disclosed the discovery prior to the filing of the patent application, a valid patent cannot be granted to him. In defining novelty, the Act adopts a two step approach. The Act first provides in section 1(2)(a) that an invention is new, if it does not form part of the state of the art. Then it goes further to define "the art" and "state of the art" in section 1(3) as follows:

"the art" means the art or field of knowledge to which an invention relates and "the state of the art" means everything concerning that art or field 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 the filing of the patent application relating to the invention or the foreign priority date validly claimed in respect thereof, so however that an invention shall not be deemed to have been made available to the public merely by reason of the fact that, within the period of six months preceding the filing of a patent application in respect of the invention, the inventor or his predecessor in title has exhibited it in an official or officially recognised exhibition.”

Thus the parameters for determining novelty would seem to be fairly objective. So long as the invention has not been made available to the public. This has been judicially interpreted in *Gentech Inc's Patent (1989)* R.P.C. 147 at 204 as meaning:

“thus to form part of the state of the art, the information given (by the user) must have been made available to at least one member of the public who was free in law and in equity to use it”

The implication of the judicial interpretation is that if the information regarding the invention is disclosed confidentially to a person or a group of persons, under circumstances which makes it obvious that they are not expected to disclose to any other person or to make use of the information, then the invention has not been made available to the public as to form part of the state of the art. It has further been judicially held that to form part of the state of the art, the disclosure of the invention must be “an enabling disclosure”. In other words, the information provided must be sufficiently detailed as to enable a person skilled in that field of knowledge make use of it.

The courts have tended to be very willing to declare that an invention has been made available to the public once the possibility has been established that relevant information about the invention has been made available to at least one person. Thus, it had been held that if an invention is disclosed in a book which has not been sold but only displayed for sale in a bookshop, sufficient disclosure had been made to make the invention part of the state of the art. So also, where a book, written in French was in the British museum, in a room not accessible to the public and only its title appeared in the catalogue of the museum, it was held that it had been made available to the public.

Disclosure to the public could also be by prior use. It has been held though, that where the invention is used such that an analysis of the product will not disclose the nature of the invention, disclosure to the public would not be said to have been made. An obvious example is where a new process is employed in the manufacture of an established product, an analysis of the product will not reveal any information about the process. Therefore the process still remains patentable though it had been used prior to the date of the application for a patent.

In *Merrell Dow Pharmaceuticals Inc. Vs. Norton & Co. Ltd. (1994)* RPC 1.its was held that the prior use of a product was to be considered in the same way as a prior published document. In both cases prior use will not invalidate the patent where information available will not enable a person skilled in that field of knowledge produce the substance.

Prior applications or grants:

Included in the body of sources that must be considered on the question of novelty are prior applications or prior grants of patents. The position of the courts is that where a patented invention coincides with an earlier application filed or patent granted, the subsequent patent will be rendered invalid. The test for determining when such a situation arises was set out at length in the dictum of Aldous J. in *P.C.G. Research Ltd. v. Ardon International* (1993) FSR 197 at 218

“Novelty has been a requirement of patent law for hundreds of years and there are a number of well known authorities which help to illustrate what must be established. They are still good law. It is sufficient for me to refer to the judgement of the Court of Appeal in the *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd* (1972) R.P.C 457 at 485. In that case, the Court of Appeal stated:

“The earlier publication and the patentee’s claim must each be construed as they would be at the respective relevant dates by a reader skilled in the art to which they relate having regard to the state of knowledge in such art at the relevant date. The construction of these documents is a function of the court, being a matter of law, but since documents of this nature are almost certain to contain technical material, the court must by evidence, be put in a position of a person of the kind to whom the document is addressed, that is to say, a person skilled in the relevant art at the relevant date. .... If the prior inventor’s publication contains a clear description of , or clear instructions to do or make, something that would infringe the patentee’s claim if carried out after the grant of the patentee’s patent, the patentee’s claim would have been shown to lack the novelty, that is to say, it will have been anticipated ..... If of the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee’s claim, but would be at least as likely to be carried out in a way which would not do so, the patentee’s will not have been anticipated, although it may fail on the ground of obviousness. To anticipate the patentee’s claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented”

In *Hills v. Evans* (1860) 31 LJ. Ch. 457 at 463 Lord Westbury L.C. in the same vein as the foregoing dictum stated:

“The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments ..... the information .. given by the prior publication must, for the purpose of practical utility, be equal to that given by the subsequent patent”

The conclusion under this head is that the earlier patent or application must be such that it exactly coincides with the subsequent application or grant. It is not enough to state that the subsequent grant or application logically follows from the previous application or grant. Such an argument justifies nullification on the ground of

obviousness, and not on the ground of anticipation.

### Improvement on Prior Invention

The subject of disclosure by prior use is closely related to the secondary provision for novelty contained in our law. Thus it can be stated that if an invention is related to an existing patented invention but could not have been anticipated based on information available regarding that existing patent, it would qualify as a patentable improvement on the existing patented invention.

Thus the invention of the jet propulsion engine was based on the initial invention of the internal combustion engine but could not have been anticipated by an ordinary person having possession of the knowledge of internal combustion engine. It required a spark of inventive genius to take that leap from one level of the same technology to the other. This then brings us to the next condition of patentability which is the requirement that the invention must evolve from an inventive activity.

### Inventive Activity

Inventive activity is defined in Section 1(2)(b) of the Act as follows:

“an invention results from an 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 *Technograph Printed Circuits Ltd. –v- Mills & Rockley (Electronics) Ltd.* (1972) R.P.C. 346. It was held that in considering whether an invention is obvious it is necessary to examine the question whether the new product or process could have been suggested to persons skilled in the art and undertaking a study of other relevant documents which a diligent researcher would know about. It has however been argued that all published documents have to be assumed to be available for study of persons to whom the patent specifications has been addressed.

This point was further made by the English Court of Appeal in *Allmanna Suenska Elektriska A/B vs. The Burntisland Shipbuilding Co. Ltd.* –(1951) 68 RPC 63 at 69.

“The matter of obviousness is to be judged by reference to the “state of the art” in the light of all that was previously known by persons versed in that art derived from experience of what was practically employed, as well as from the contents of previous writings, specifications, textbook and other documents ... When the relevant facts (as regards the state of the art) are known, the question: Was the alleged invention obvious? Must in the end of all be as it were a kind of jury question. The relevant question to be asked and answered is in form and substance the question formulated by Sir Stafford Cripps ..... ‘The real question is: Was it for all practical purposes obvious to any skilled chemist in the state of chemical knowledge existing at the date of the patent, which consists of the chemical literature available ... and his general chemical knowledge, that he could manufacture that he could manufacture valuable therapeutic

agents by making the higher alkyl resorcinols ....’

“It remains to say that the question must be answered objectively, for it is immaterial that .. the invention claimed was in truth an invention of [the inventor] in the sense of being the result of independent work and research on his part – without knowledge on his part of many of the matters which must, on any view, be taken into account by the court”

See further dictum of Lopes L.J. in *Savage v. Harris & Sons*. 13 RPC 364 at 370.

“The material question to be considered in a case like this is, whether the alleged discovery lies so much out of the track of what was known before as not naturally to suggest itself to a person thinking on the subject; it must not be the obvious or natural suggestion of what was previously known”.

Thus an invention will not qualify for a valid patent if, given the state of the art at the date the application therefor was filed, regardless of the fact that the inventor undertook independent research and arrived at his invention without relying on available literature, is such as could have been arrived at by a person skilled in the art, having access to all available information on the subject as the date of the filing of the application.

Whether an invention is obvious or not is however a question of fact in respect of which the court, and I daresay, patent lawyers require expert advice before rendering a verdict.

The final condition of Patentability to consider is capability of industrial application.

### Industrial applicability

It is not every invention which is new or results from an inventive activity that can be patented. Patent laws are especially design to promote industrial development. They are to provide incentive for creativity for persons involved in industrial endeavours. Therefore, an invention will not be patentable, if it is not industrially applicable.

Section 1.(2)(c) defines the concept of industrial applicability as follows

“an invention is capable of industrial application if it can be manufactured or used in any kind of industry including agriculture”.

However, as the definition of industry has been extended in the provision to include agriculture, it has been suggested that the intention of the legislature is to allow patenting in respect of product or processes used in almost all kinds of commercial enterprise. There is no judicial pronouncement on this issue, to which one can readily refer, therefore one would say that the point is moot as to those areas of endeavour outside the traditional industrial activities in which patents can be granted. It has also been suggested that the requirement for industrial applicability may be referring to utility of the invention. In other words, an invention will not be patentable, it is argued, if it has no practical application

A last point under this head is to draw attention to the fact that methods of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human body or animal body have been specifically excluded from the definition of industrial applicability under the English 1977 Patents Act. Though there is no such specific exclusion in our law, one can surmise that such matters should not in any case fall under the definition of matters which are capable of industrial application.

## PROCEDURE FOR APPLICATION

The formal requirements for a patent application are set out in section 3 of the Act which provides that every patent application

- (a) shall be made to the Registrar and shall contain -
  - (i) the applicant's full name and address and if that address is outside Nigeria, an address for service in Nigeria,
  - (ii) a description of the relevant invention with any appropriate plans and drawings,
  - (iii) a claim or claims, and
  - (iv) such other matter as maybe prescribed; and
- (b) shall be accompanied by –
  - (i) the prescribed fee,
  - (ii) where appropriate, a declaration signed by the true inventor requesting that he be mentioned as such in the patent and giving his name and address, and
  - (iii) if the application is made by an agent, a signed power of attorney (so however that, notwithstanding any rule of law, legislation or certification of the signature of the power of attorney shall be unnecessary)

The Act further provides under section 4 that the registrar shall examine the application, and if he is satisfied that all the documents which are required to be submitted with the application have been submitted, shall grant the patent without enquiring into the questions

- (a) whether the subject of the application is patentable under section 1.
- (b) Whether the description of the invention and claims made comply with the requirement that they must be sufficiently clear and complete as to enable a person skilled in the art or field of knowledge to which the invention relate be able to put it into effect.
- (c) Whether there is a prior application or a prior grant of a patent for the same invention has been made in Nigeria

The procedure for filing of an application for a Nigerian patent is prescribed in the Patent Rules of 1971, which is also contained in Cap. 344 of the Laws of The Federation of Nigeria 1990.

Specifically rule 8 provides that an application shall be made on Form 1 (please note that there are forms 1(a) and 1(b))and shall relate to only one invention, though it may include claims for any number of products, any number of manufacturing processes for those products and any number of application of those products.

The most important document to be filed is the patent specification. The specification is the document in which the invention will be described in detail. Section 3(2) of the Act requires that such description should be sufficiently detailed and complete that someone skilled in the field of knowledge to which the invention relates will be able to apply the information and produce thereby the object of the invention.

When an invention is made, there may be several products which can be made from the same invention. There may also be several applications which can be made of the product. The story of the discovery of Viagra is a well known illustration of this. The substance which Pfizer discovered, was originally intended as a drug to treat the medical condition known as arrhythmia, in layman's language, irregular heart beat. However it turned out to be a wonder drug for erectile dysfunction. The discovery was made in the course of testing for efficacy in the treatment of the other condition. Therefore, the specification filed with the patent application for the

drug, the generic name of which is Sildeneafil could conceivably include a first claim that it is a pharmaceutical product to treat erectile dysfunction, and a second claim that it is a drug to treat arrhythmia. Of primary importance in the determination of the question whether an invention is new, or results from an inventive step is the date on which the state of the art will be considered. Normally, the applicable date of state of the art is the date on which the application is filed, because if the patent is granted, its twenty years tenure commences on the date of the application (see section 7(1) of the Act). Thus the filing date is the date from which the application takes priority. By virtue of Nigeria being a signatory to some international conventions related to patent protection, the Nigerian patents Act allows an applicant for a patent, who had earlier filed the same application in another country which is also a signatory to the convention (referred to in the Act as “a convention country”) is long as he files the corresponding application in Nigeria within one year of having filed the first application in the convention country, he is entitled to claim the date on which he filed the convention country application as his priority date for the Nigerian application. Therefore, when the question of novelty as concerns the Nigerian application is being considered, the court will enquire into the state of the art for the period preceding the date on which the convention country application was filed, and not the later date on which the Nigerian application was filed.

An applicant who wants to claim a convention country priority date, will make his application on Form 1(b). He shall file a declaration showing the date, number and country of the convention country application. The declaration should also contain the name of the person who made the earlier application. Finally the applicant must file not later than three months after filing of the application, a certified true copy of the application filed in the convention country.

After the filing of the application, the registrar will examine the application, and if all formal requirements have been met, will issue the applicant with a patent certificate. There is further provision under the Nigerian Act that after a patent is granted, the registrar shall publish a notification of the patent granted. Presumably, the publication envisaged by this provision, is publication in the Federal Government Gazette or a Patent Journal. It should be noted that it is not known that any such publication had ever been made since the Patent Act came into force in 1970. This, however being a post-grant exercise is not of much importance, and does not affect the validity of the patent granted.

#### Rights conferred by patent:

Section 6 (1) of the Patents and Designs Act 1970, provides that the grant of a patent confers on the patentee the right to preclude all other persons from doing any of the following acts:

- “(a) where 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
- (c) where 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 paragraph (a) of this subsection”

The preclusive right is however limited by the further provisions of subsection 3 of section 6 aforesaid as follows:

- (3) The rights under a patent –
  - (a) shall extend only to acts done for industrial and commercial purposes; and
  - (b) shall not extend to acts done in respect of a product covered by the patent after the product has been lawfully sold in Nigeria, except in so far as the patent makes provision for a special application of the product, in which case the special application shall continue to be reserved to the patentee notwithstanding this paragraph

The exception to the right of a patentee under section 6(4) however appear puzzling. The subsection provides that the right of the patentee shall not preclude the continued production by a person who at the date of the filing of the application for the patent or as at the date of the foreign priority, was conducting an undertaking in Nigeria and was thereby in good faith producing the patented product or using the patented process. It would seem that if such a situation exists, then the patent granted could not have been new at the date of filing. Therefore, the patent would be invalid.

Apart from the forementioned puzzle, the rights conferred on a patentee are fairly easy to understand. Once a patent is granted, nobody may deal with the product or use the process for a commercial or industrial purpose without the consent of the patentee.

Therefore, whilst importation for private use of a patented product is allowed, importation of or otherwise, dealing in the same product for a commercial purpose would be in infringement of patent.

### Infringement of patent

Infringement of patent is provided for in section 25 of the Patents and Designs Act 1970. Under the section, it is provided that it will be an infringement of patent if any person does or causes the doing of any act which is precluded under the provisions of section 6, referred to above. The section further raises a presumption in respect of process patent to the effect that if a process by which a new product is to be made is patented, it shall be presumed that a defendant who makes the product and is sued for the infringement of the process has manufactured the product by means of the patented process. The onus of disproving the presumption lies on the defendant.

The patentee, whose patent has been infringed shall be entitled to the remedies of damages, injunction and accounts.

The Federal High Court has the exclusive jurisdiction for entertaining action brought under the Patents and Designs Act. Therefore, patents infringement actions have to be filed in the Federal High Court.