



**PATENTS AND DESIGNS ACT**  
**CAP P2 LFN 2004**  
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## CHAPTER P2

### PATENTS AND DESIGNS ACT

An Act to make comprehensive provisions for the registration and proprietorship of Patents and Designs in Nigeria and other matter ancillary thereto

1<sup>st</sup> December 1971

#### Patents

##### 1.

(1) Subject to this section, an invention is patentable-

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

(2) For the purposes of subsection (1) of this section-

- (a) an invention is new if it does not form part of the state of the art,
- (b) an invention results from inventive activity if it does not obviously follow from the state of the art, either as to the method, the application, the combination of methods, or the product which it concerns, or as to the industrial result it produces; and
- (c) an invention is capable of industrial application if it can be manufactured or used in any kind of industry, including agriculture.

(3) In subsection (2) of this section, "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 successor in title has exhibited it in an official or officially recognised international exhibition.

(4) Patents cannot be validly obtained in respect of-

(a) plant or animal varieties, or essentially biological processes for the production of plants or animals (other than microbiological processes and their products); or

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

(5) Principles and discoveries of a scientific nature are not inventions for the purposes of this Act.

## 2.

(1) Subject to this section, the right to a patent in respect of an invention is vested in the statutory inventor, that is to say, the person who, whether or not he is the true inventor, is the first to file, or validly to claim a foreign priority for, a patent application in respect of the invention.

(2) The true inventor is entitled to be named as such in the patent, whether or not he is also the statutory inventor, and, the entitlement in question shall not be modifiable by contract.

(3) If the essential elements of a patent application have been obtained by the purported applicant from the invention of another person (or from that other person's successor in title) without the consent of that other person (or his said successor) both to the obtaining of those essential elements and to the filing of the application, all rights in the application and in any patent granted in pursuance of it shall be deemed to be transferred to that other person or his said successor, as the case may be.

(4) Where 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, as the case may be, in the person who commissioned the work:

Provided that, where the inventor is an employee, then-

(a) if-

(i) his contract of employment does not require him to exercise any inventive activity but he has in making the invention used data or means that his employment has put at his disposal, or

(ii) the invention is of exceptional importance, he is entitled to fair remuneration taking into account his salary and the importance of the invention; and

(b) the entitlement in question is not modifiable by contract and may be enforced by civil proceedings.

(5) A person is not an inventor for the purposes of this section if he has merely assisted in doing work connected with the development of an invention without contributing any inventive activity.

### 3.

(1) 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 may be 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, legalisation or certification of the signature of the power of attorney shall be unnecessary).

(2) The description referred to in subsection (1)(a)(ii) of this section shall disclose the relevant invention in a manner sufficiently clear and complete for the invention to be put into effect by a person skilled in the art or field of knowledge to which the invention relates; and the claim or claims referred to in subsection (1)(a)(iii) of this section shall define the protection sought and shall not go beyond the limits of the said description.

(3) A patent application shall relate to only one invention, but may include in connection with that invention

(a) claims-

(i) For any number of products,

(ii) For any number of manufacturing processes for those products,

And

(iii) For any number of applications of those products; and

(b) claims-

(i) for any number of processes, and

(ii) for the means of working those processes, for the resulting product or products and for the application of those products.

(4) Where the applicant for a patent seeks to avail himself of a foreign priority in respect of an earlier application made in a country outside Nigeria-

(a) he shall append to his application under subsection (1) of this section a written declaration showing-

(i) The date and number of the earlier application,

(ii) The country in which the earlier application was made, and

(iii) The name of the person who made the earlier application; and

(b) not more than three months after the making of the application under subsection (1) of this section, he shall furnish the Registrar with a copy of the earlier application certified correct by the Industrial Property Office (or its equivalent) in the country where the earlier application was made.

**4.**

(1) The Registrar shall examine every patent application as to its conformity with section 3(1), (3) and (4) of this Act, and-

(a) if section 3(1) of this Act has not been complied with, the Registrar shall reject the application;

(b) if section 3(3) of this Act has not been complied with, the Registrar shall-

(i) invite the applicant to restrict the application so that it relates to only one invention, and

(ii) notify the applicant that he may within, three months file in respect of the other inventions dealt with in the original application subsidiary applications which shall benefit from the date of filing of the original application and, if relevant, from the date of any foreign priority claimed under section 3(4) of this Act, and, if the applicant does not comply with the invitation mentioned in sub-paragraph (i) of this subsection, shall reject the application, and

(c) if section 3(4) of this Act has not been complied with, the Registrar shall disregard any claim for foreign priority.

(2) Where the examination mentioned in subsection (1) of this subsection shows that patent application satisfies the requirements of section 3(1) and(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 this Act;

(b) whether the description and claims satisfy the requirements of section 3(2) of this Act; and

(c) whether a prior application, or an 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.

(3) Where the said examination shows that section 3(4) of this Act has been complied with as respects a claim for a foreign priority, the foreign priority claimed shall be mentioned in the patent.

(4) Patents are granted at the risk of the patentee and without guarantee of their validity.

## 5.

(1) A patent shall be granted by the issue to the patentee of a document containing-

- (a) the number of the patent in the order of grant;
- (b) the name and address of the patentee and, if that address is outside Nigeria, an address for service in Nigeria;
- (c) the dates of the patent application and the grant;
- (d) if foreign priority is claimed-
  - (i) an indication of the fact, and
  - (ii) the number and date of the application on which the claim is based and the name of the country where it was made
- (e) the description of the invention (with any relevant plans and drawings) and the claims; and
- (f) where appropriate, the name and address of the true inventor.

(2) The Registrar shall maintain a Register of Patents which shall consist of duplicates of the documents issued under subsection (1) of this section, together with such further matter as is required by this Act to be registered.

(3) As soon as may be after a patent has been granted subsection (1) of this section, the Registrar shall to be published-

- (a) a notification of the grant containing the details mentioned in paragraphs (a) to (f) of that subsection (except the description and the plans and drawings, if any); or
- (b) if a summary form of notification is prescribed, a notification in that form.

6.

(1) A patent confers upon the patentee the right to preclude any other person 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

(b) 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.

(2) The scope of the protection conferred by a patent shall be determined by the terms of the claims; and the description (and the plans and drawings, if any) included in the patent shall be used to interpret the claims.

(3) The rights under a patent-

(a) shall extend only to acts done for industrial or 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,

(4) Where, at the date of the filing of a patent application in respect of a product or process or at the date of a foreign priority validly claimed in respect of the application, a person other than the applicant-

(a) was conducting an undertaking in Nigeria; and

(b) in good faith and for the purposes of the undertaking, was manufacturing the product or applying the process or had made serious preparations with a view to doing so, then, notwithstanding the grant of a patent, there shall exist a right (exercisable by the person for the time being conducting the undertaking, and not otherwise) to continue the manufacture or application, or to continue and complete the preparations and thereafter undertake the manufacture or application,

as the case may be, and in respect of any resulting products to do any other act mentioned in subsection (1) of this section.

**7.**

(1) Subject to this Act, a patent shall expire at the end of the twentieth year from the date of the filing of the relevant patent application.

(2) A patent shall lapse if the prescribed annual fees are not duly paid in respect of it:

Provided that-

(a) a period of grace of six months shall be allowed for the payment of the fees; and

(b) if the fees and any prescribed surcharge are paid within that period, the patent shall continue as if the fees had been duly paid.

(3) The expiration or lapse of a patent shall be registered and notified.

**8.**

(1) Subject to subsection (2) of this section, a patent, may be surrendered by the patentee by written declaration addressed to the Registrar.

(2) The surrender of a patent-

(a) may relate to all or any of the claims made by the patent;

(b) subject to paragraph (d) of this subsection, shall be registered and notified;

(c) shall not be effective until it has been registered; and

(d) if it relates to a patent as to which a contractual licence or licence of right is registered, shall be registered only if it is accompanied by the written consent of the licensee.

**9.**

(1) Subject to this section, on the application of any person (including a public officer acting in the exercise of his functions) the court shall declare a patent null and void-

- (a) if the subject of the patent is not patentable under section 1 of this Act; or
- (b) if the description of the invention or the claim does not conform with section 3(2) of this Act; or
- (c) if for the same invention a patent has been granted in Nigeria as the result of a prior application or an application benefiting from an earlier foreign priority.

(2) Subsection (1) of this section may apply to the whole of a patent or to any particular claim or claims made by it.

(3) For the purpose of disposing of an application under subsection (1) of this section, the court on the motion of the applicant or of its own motion may require the patentee of the relevant patent to produce in evidence any of the following-

- (a) a list of any publications or earlier patents referred to in connection with a patent application made in respect of the same invention by the patentee to the appropriate authority in any country outside Nigeria;
- (b) any proceedings relating to the patent application in question or any patent granted in pursuance of it; and
- (c) any publications or patents mentioned in any report sent to the patentee by a governmental or intergovernmental research or investigation institute.

(4) Where a declaration is made under subsection, (1) of this section-

- (a) the patent in question shall be deemed to have been null and void since the date of its grant, so however that it shall not be necessary to repay royalties paid by any licensee unless the court so orders, and
- (b) the proper officer of the court shall inform the Registrar, who shall register and notify the declaration.

(5) The court-

- (a) shall not make a declaration under subsection (1) of this section without first giving the patentee an opportunity to be heard;
- (b) in applying subsection (1) of this section, shall have regard only to the state of affairs existing when the proceedings were instituted; and

(c) shall dismiss an application under subsection (1) of this section if the applicant (not being a public officer) fails to satisfy the court that he has a material interest in making the application.

**10.**

(1) Subject to this section, if a patentee (not being precluded by the terms of any previously registered licence from granting a further licence) applies in writing to the Registrar for the words "licences of right" to be registered in respect of his patent, the Registrar shall enter the words accordingly in the Register and notify the entry.

(2) Where an entry is made under subsection (1) of this section in respect of a patent-

(a) any person shall have the right to obtain a licence to exploit the patent on such terms as, failing agreement between that person and the patentee, shall be fixed by the court on the application of that person; and

(b) the amount of the actual fees payable in respect of the patent shall be reduced by half, the reduction first taking effect in relation to the annual fees first payable after the date of the entry

(3) A patentee may at any time apply to the Registrar for an entry under subsection (1) of this section to be cancelled; and, if no licences have been granted under this section or all the grantees agree, the Registrar shall thereupon cancel the entry and notify the cancellation, but only after payment of all annual or other fees which would have been payable if the entry had never been made.

(4) The grantee of a licence under this section shall not be entitled to assign the licence or grant further licences under it.

(5) Subsections (1)(b), (2)(a), (3) and (6) of section 23 of this Act shall apply in relation to licences granted under this section as they apply to licences and contracts under section 23 of this Act.

**11.**

The provisions of the First Schedule to this Act shall have effect in relation to compulsory licences and the use of patents for the service of government agencies.

**Designs**

**12.**

Any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, is an industrial design, if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result.

**13.**

(1) Subject to this section, an industrial design is registrable if-

(a) it is new; and

(b) it is not contrary to public order or morality,

(2) Where application is made for the registration of an industrial design, the design shall be presumed to be new at the time of the application except in so far as the following provisions of this section provide otherwise-

(3) An industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the Registrar that the creator of the design could not have known that it had been made so available.

(4) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that within the period of six months preceding the filing of the application for registration the creator has exhibited it in an official or officially recognised exhibition.

(5) An industrial design is not new merely because it differs in minor or inessential ways from an earlier design or concerns a type of product other than the type with which an earlier design is concerned.

#### **14.**

(1) Subject to this section, the right to registration of Right to an industrial design shall be vested in the statutory creator, registration. that is to say, the person who, whether or not he is the true creator, is the first to file, or validly to claim a foreign priority for, an application for registration of the design.

(2) The true creator shall be entitled to be named as such in the Register, and the entitlement in question shall not be modifiable by contract.

(3) If the essential elements of an application for the registration of an industrial design have been obtained by the purported applicant from the creation of another person without the consent of that other person both to the obtaining of those essential elements and to the filing of the application, all rights in the application and in any consequent registration shall be deemed to be transferred to that other person.

(4) Where an industrial design is created in the course of employment or in the execution of a contract for the performance of specified work, the ownership of the design shall be vested in the employer or, as the case may be, in the person who commissioned the work: Provided that, where the creator is an employee, then, if his contract of employment does not require him to exercise any creative activity but he has in creating the design used data or means that his employment has put at his disposal-

(a) he shall be entitled to fair remuneration taking into account his salary and the importance of the design which he has created; and

(b) the entitlement in question is not modifiable by contract and may be enforced by civil proceedings.

#### **15.**

(1) An, application for the registration of an industrial design shall be made to the Registrar and

(a) shall contain-

(i) a request for registration of the design,

(ii) the applicant's full name and address and, if that address is outside Nigeria, an address for service in Nigeria,

- (iii) a specimen of the design or a photographic or graphic representation of the design with any printing block or other means of reproduction from which the representation was derived,
- (iv) an indication of the kind of product (or, where a classification has been prescribed, the class of product) for which the design will be used, and
- (v) such other matter as may be prescribed, and

(b) shall be accompanied by

- (i) the prescribed fee,
- (ii) where appropriate, a declaration signed by the true creator requesting that he be named as such in the Register 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, legalisation or certification of the signature of the power of attorney shall be unnecessary).

(2) A single application may relate to any number of industrial designs not exceeding fifty, if the products to which the designs relate are of the same kind or, where a classification has been prescribed, of the same class

(3) Where an applicant for the registration of an industrial design seeks to avail himself of a foreign priority in respect of an earlier application made in a country outside Nigeria-

(a) he shall append to his application under subsection (1) of this section a written declaration showing-

- (i) the date and number of the earlier application,
- (ii) the country in which the earlier application was made, and
- (iii) the name of the person who made the earlier application; and

(b) not more than three months after the making of the application under subsection (1) of this section, he shall furnish the Registrar with a copy of the earlier application certified correct by the Industrial Property Office (or its equivalent) in the country where the earlier application was made.

## **16.**

(1) The Registrar shall examine every application for registration of an industrial design as to its conformity with sections 13(1)(b) and 15 of this Act, and-

(a) if the application fails in any respect to conform with section 13(1)(b) or 15(1) or (2) of this Act, the Registrar shall reject the application; and

(b) if the application fails in any respect to conform with section 15(3) of this Act, the Registrar shall disregard any claim for foreign priority.

(2) Where the examination mentioned in subsection (1) of this section shows that an application for the registration of an industrial design satisfies the requirements of sections 13(1)(b) and 15 of this Act, the design shall be registered in accordance with the application without further examination and, in particular, without examination of the question whether the registration might be contrary to section 13(1)(a) of this Act; and, where the said examination shows that section 15(3) of this Act has been complied with as respects a claim for foreign priority, the foreign priority claimed shall be recorded in the Register.

## **17.**

(1) An industrial design shall be registered by the issue to the applicant of a registration certificate containing-

(a) the number of the design in order of registration;

(b) the name and address of the registered owner and, if that address is outside Nigeria, an address for service in Nigeria;

(c) the date of the application and of the issue of the registration certificate;

(d) if foreign priority is claimed-

(i) an indication of the fact, and

(ii) the number and date of the application on which the claim is based and the name of the country where the application was made;

(e) a reproduction or representation of the design and an indication of the kind (or, where a classification has been prescribed, the class) of products for which it will be used; and

(f) where appropriate, the name and address of the true creator.

(2) The Registrar shall maintain a Register of Industrial Designs which shall consist of duplicates of the registration certificates issued under subsection (1) of this section, together with such further matter as is required by this Act to be registered.

(3) As soon as may be after a design has been registered under subsection (1) of this section, the Registrar shall cause to be published-

(a) a notification of the registration containing the details mentioned in paragraphs (a) to (f) of that subsection; or

(b) if a summary form of notification is prescribed, a notification in that form.

**18.**

(1) An applicant for the registration of an industrial design may ask for the design to be kept secret for a specified period not exceeding twelve months from the date of the application; and, where he does so, then, notwithstanding any other provision of this Act-

(a) the specimen and other matters mentioned in section 15(1)(a)(iii) and (iv) of this Act shall be enclosed in a sealed package, which shall be opened by the Registrar-

(i) when the specified period has elapsed, or

(ii) if, before the specified period has elapsed, the applicant asks for the application to be converted into an open application, or

(iii) if the package is still sealed, at the expiration of twelve months after the date of the application,

(b) a provisional registration certificate shall be issued and a provisional notification published under section 17 of this Act, each of which shall exclude the reproduction and other matters mentioned in section 17(1)(e) of this Act;

(c) the said provisional registration certificate and provisional notification shall not confer any right to protection under section 25 of this Act; and

(d) when the sealed package has been opened pursuant to paragraph (a) of this subsection, the Registrar shall proceed in accordance with sections 16 and 17 of this Act in so far as he has not already done so

and, if authorised by those sections, shall issue a revised registration certificate and publish a revised notification which shall have the same effect as any other certificate issued or notification published under section 17 of this Act.

(2) Notwithstanding subsection (1) of this section, a sealed package may be opened by the Registrar at any time on the direction of a court and shall be revealed when the court no longer requires it: Provided that, if the time at which the package may be opened under subsection (1)(a) of this section arrives before the court has ceased to require it, the package shall be deemed to have been duly opened at that time and shall not be released.

## **19.**

(1) Registration of an industrial design confers upon the registered owner the right to preclude any other person from doing any of the following acts-

- (a) reproducing the design in the manufacture of a product;
- (b) importing, selling or utilising for commercial purposes a product reproducing the design; and
- (c) holding such a product for the purpose of selling it or of utilising it for commercial purposes.

(2) The reproduction of a registered industrial design is not lawful for the purposes of subsection (1) of this section merely because it differs in minor or inessential ways from the design or because it concerns a type of product other than the type with which the design is concerned.

(2) The rights conferred by this section-

- (a) shall extend only to acts done for commercial or industrial purposes; and
- (b) shall not extend to acts done in respect of a product incorporating a registered industrial design after the product has been lawfully sold in Nigeria.

## **20.**

(1) Subject to this Act, registration of an industrial design-

(a) shall be effective in the first instance for five years from the date of the application for registration; and

(b) on payment of the prescribed fee may be renewed for two further consecutive periods of five years.

(2) The fee mentioned in subsection (1)(b) of this section shall be paid within the twelve months immediately preceding the renewal period to which it relates:

Provided that-

(a) a period of grace of six months after the beginning of the renewal period shall be allowed for the payment of the fee; and

(b) if the fee and any prescribed surcharge are paid within that period, this subsection shall be deemed to have been complied with.

(3) The fact that the registration of an industrial design has ceased to be effective or has been renewed shall be registered and notified.

## **21.**

(1) Subject to subsection (2) of this section, the registered owner of an industrial design may renounce the registration by a written declaration addressed to the Registrar.

(2) A renunciation under subsection (1) of this section-

(a) may be limited-

(i) to any particular kind or kinds of product, or

(ii) if a classification of products has been prescribed, to any particular class or classes of product, or

(iii) if the application for registration comprised several designs, to any one or more of those designs;

(b) subject to paragraph (d) of this subsection, shall be registered and notified;

(c) shall not be effective until it has been registered; and

(d) if it relates to a design as to which a contractual licence is registered, shall be registered only if -

- (i) it is accompanied by the licensee's written consent to registration, or
- (ii) the licensee has in the licence contract agreed that this paragraph shall not apply.

## 22.

(1) Subject to this section, on the application of any person (including a public officer acting in the exercise of his functions) the court shall declare the registration of an industrial design to be null and void-

- (a) if the design, because of its failure to conform with section 13(1)(b) of this Act, ought not to have been registered; or
- (b) if the design fails to comply with section 13(1)(a) or 14 of this Act.

(2) Where-

- (a) a declaration under subsection (1) of this section relates to an application comprising several designs; and
- (b) the grounds for making the declaration affect only some of those designs, the declaration shall apply only to the designs so affected.

(3) Where a declaration is made under subsection (1) of this section-

- (a) the registration in question shall be deemed, to the extent specified in the declaration, to have been null and void *ab initio*, so however that it shall not be necessary to repay royalties paid by any licensee unless the court so orders; and
- (b) the proper officer of the court shall inform the Registrar, who shall register and notify the declaration.

(4) The court-

- (a) shall not make a declaration under subsection (1) of this section without first giving the design owner an opportunity to be heard;

(b) in applying subsection (1)(a) of this section, shall have regard only to the state of affairs existing when the proceedings were instituted; and

(c) shall dismiss an application under subsection (1) of this section if the applicant (not being a public officer) fails to satisfy the court that he has a material interest in making the application.

## General

### 23.

(1) Subject to this section-

(a) a patentee or design owner may by a written contract signed by the parties grant a licence to any person to exploit the relevant invention or design; and

(b) in the absence of any provision to the contrary in the contract, the licensee shall be entitled to do at, anywhere in Nigeria in relation to the patent or design, any of the acts mentioned in section 6 or 9 of this Act, as the case may be.

(2) Where a licensee is granted under subsection (1) of this section

(a) the licence shall be registered, and shall be of no effect against third parties until registration is effected and the prescribed fee paid; and

(b) the registration shall be cancelled at the request of the licensor if the Registrar is satisfied that the licence, has been terminated.

(3) Any clause in a contract for a license under subsection (1) of this section is null and void in so far as 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 design or are necessary for the safeguarding of those rights

Provided that-

(a) limitations concerning the scope, extent, territory or duration of the exploitation of the patent or design or the quality or quantity of the products in connection with which the patent or design may be exploited;

(b) obligations imposed on the licensee to abstain from all acts capable of prejudicing the validity of the patent or the validity of the registration of the design; and

(c) in the case of a patent, limitations justified by the interest of the licensor in the technically efficient exploitation of the subject of the patent, are not restrictions of the kind mentioned in this subsection.

(4) In the absence of any provision to the contrary in a contract for a licence under subsection (1) of this section-

(a) the grant of the licence shall not prevent the licensor from-

(i) granting further licences to other persons, or

(ii) himself exploiting the relevant patent or design;

(b) the licensee shall not be assignable by the licensee; and

(c) the licensee shall not be entitled to grant further licences.

(5) Where a contract under subsection (1) of this section provides for a licensee to grant further licences, this section shall apply in relation to any such further license as it applies in relation to license granted under the said subsection (1).

(6) The Minister, if he is satisfied that it is in the interest of Nigeria and its economic development to do so, may by order in the Federal Gazette provide that contracts under subsection (1) of this section (or any specified class thereof) shall, in so far as they involve the payment of royalties outside Nigeria, be invalid without the approval of such authority as may be specified in the order.

## **24.**

(1) Subject to this section, a person's rights in a patent application, in an application for the registration of a design, in a patent or in a registered design may be assigned, transferred by succession or held in joint ownership.

(2) An assignment under subsection (1) of this section shall be in writing and signed by the parties.

(3) An assignment or transfer by succession under subsection (1) of this section shall have no effect against third parties unless it has been registered and the prescribed fee paid.

(4) In the absence of any provision to the contrary among themselves, joint owners of a patent or registered design may separately transfer their shares,

exploit the patented invention, utilise the registered design or exercise the rights conferred by section 6 or 9 of this Act, as the case may be; but a licensee under this Act may not be granted by joint owners otherwise than jointly.

(5) Any reference (however expressed) in this Act to an applicant for a patent, an applicant for the registration of a design, a patentee or a design owner includes, unless the context otherwise requires, a reference to any predecessors or successors in title and, where appropriate, to joint applicants, joint patentees or joint owners, as the case may be.

## 25.

(1) The rights of a patentee or design owner are infringed if another person, without the licensee of the patentee or design owner, does or causes the doing of any act which that other person is precluded from doing under section 6 or 9 of this Act, as the case may be.

(2) An infringement of the rights of a patentee or design owner shall be actionable at the suit of the patentee or design owner in question; and in any action for such an infringement all such relief by way of damages, injunction, accounts or otherwise shall be available to the plaintiff as is available in any corresponding proceedings in respect of the infringement of other proprietary rights.

(3) If-

- (a) a patent has been granted in respect of a process for the manufacture of a new product; and
- (b) the same product is manufactured by a person other than the patentee,

The product shall in the absence of proof to the contrary be presumed to have been manufactured by that process.

(4) The grantee of a licence under this Act from a patentee or design owner may by registered letter require the licensor to institute proceedings under subsection (1) of this section in respect of any infringement indicated by the grantee in the letter; and, if the licensor unreasonably refuses or neglects to institute the proceedings, the licensee may institute them in his own name, without prejudice to the right of the licensor to intervene in the proceedings.

## **26.**

(1) Jurisdiction to hear and dispose of legal proceedings under this Act is hereby vested in the Federal High Court and , subject to this Act, and provisions of the Trade Marks Act applicable to legal proceedings under that Act shall apply with the necessary modifications to legal proceedings under this Act.

(2) The court hearing proceedings under this Act may sit with and be advised by two assessors having expert knowledge of matters of a technological or economic nature.

(3) The Chief Judge of the Federal High Court may make rules of court for the regulation of legal proceedings under this Act if he thinks it necessary to do so.

## **27.**

(1) The Minister may, with a view to the fulfilment of a treaty, convention or other international arrangement or agreement to which Nigeria is a party, declare by order in the Federal Gazette that any country specified in the order is a convention country for purposes of this section.

(2) So long as there is in force an order under subsection (1) of this section declaring a country to be a convention country, a patent application or a design application in Nigeria, if an earlier corresponding application for the protection of an invention or the legislation of a design has been made in that convention country, shall be treated as having been made on the date when that earlier application was made:

Provided that this subsection shall not apply where the earlier application was made-

- (a) in the case of an invention, more than twelve months; or
- (b) in the case of a design, more than six months, before the application in Nigeria.

(3) Where a person has applied for the protection of an invention or the registration of a design by an application which-

- (a) in accordance with a treaty, convention or other international arrangement or agreement subsisting between any two or more convention countries is equivalent to an application duly made in any one of those convention countries; or

(b) in accordance with the law of any convention country is equivalent to an application duly made in that convention country, he shall be deemed for the purposes of this Act to have applied in each of those convention countries or in that convention country, as the case may be.

(4) Where a patent application or a design application is to be treated by virtue of subsection (2) of this section as having been made on the date of an earlier application in a convention country, that earlier date is referred to in this Act as a foreign priority, and in this Act the expression "foreign priority" shall be construed accordingly-

## **28.**

(1) There shall be a Registrar of Patents and Designs, who shall be appointed by the Federal Civil Service Commission.

(2) The Registrar may correct any clerical error in an entry in the Register, but before doing so shall give the person to whom the entry relates an opportunity to make representations.

(3) Any person-

(a) may consult the Register free of charge during the prescribed hours; and

(b) on payment of the prescribed fee, may obtain a copy of any entry in the Register.

(4) A copy of an entry in the Register sealed with the Registrar's seal shall be admissible as evidence of what is stated therein; and any document purporting to be such a copy shall be presumed, until the contrary is proved, to be what it purports to be.

(5) Any person aggrieved by a decision of the Registrar in the exercise of his functions under this Act may appeal to the court.

(6) If the Minister so directs, the Registrar shall from time to time publish a journal to be known as the Patents and Designs Journal in which shall be published all such matters as are required by this Act to be published or notified and such other matters relating to patents and designs as the Registrar thinks fit:

Provided that, if there is no such direction in force, any matter required by this Act to be published or notified shall be published by the Registrar in the Federal Gazette.

(7) Subject to this Act and any such rules made under section 30(b) of this Act, the Registrar shall maintain and make entries in the Register in whatever manner appears to him to be most suitable and convenient.

**29.** Subject to Part II of the First Schedule to this Act, a patent or registered design shall have the same effect against the State as against an individual.

**30.**

(1) The Minister may make rules-

(a) prescribing anything requiring to be prescribed for the purposes of this Act, (including summary forms of notification of the grant of a patent and the registration of a design, and classifications of products to which designs relate);

(b) regulating the manner in which the Registrar shall maintain and make entries in the Register; and

(c) containing such administrative or procedural provisions as appear to him to be necessary or expedient in order to facilitate the operation of this Act.

(2) The Minister for Industries with the approval of the National Council of Ministers may make rules establishing schemes to encourage inventive activity; and, without prejudice to the generality of the foregoing, any such scheme may include 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 for financial reasons.

**31.**

(1) The Registration of United Kingdom Patents Act, the United Kingdom Designs (Protection) Act, the Patent Rights (Limitation) Act 1968 and (in so far as they are in force in Nigeria) the Patents Act 1949 of the United Kingdom and amendments thereof are hereby repealed.

(2) The transitional and saving provisions in the Second Schedule shall have effect notwithstanding subsection (1) of this section or any other provision of this Act.

### **32.**

(1) In this Act, unless the context otherwise requires- "court" means the Federal High Court;

"Design" means an industrial design;

"Design Application" means an application for the registration of an industrial design;

"Design Owner" means the registered owner of an industrial design;

"Foreign Priority" has the meaning assigned by section 27 of this act;

"Import" means import into Nigeria;

"The Minister", except in part ii of the first schedule to this act, means minister for trade and tourism;

"Patent Application" means an application for the grant of a patent;

"Patentee" means a person to whom a patent has been granted;

"Register" means the register of patents, the register of industrial designs, or both, as the case may require;

"Registrar" means the Registrar of Patents and Designs.

(2) In this Act, unless the context otherwise requires, a reference to a numbered section or schedule is a reference to the section or schedule so numbered in this Act.

### **33. This Act may be cited as the Patents and Designs Act.**

## **First Schedule**

### **Compulsory Licences and use of patents for service of government agencies**

#### **Part I**

##### **Compulsory Licences**

**1.** Subject to this Part, at any time after the expiration of a period of four years after the filing of a patent application or three years after the grant of a patent, whichever period last expires, a person may apply to the Court for the grant of a compulsory licence on one or more of the following grounds-

- (a) that the patented invention, being capable of being worked in Nigeria, has not been so worked;
- (b) that the existing degree of working, of the patented invention in Nigeria does not meet on reasonable terms the demand for the product;
- (c) that the working of the patented 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.

**2.** If an invention protected by a patent in Nigeria cannot be worked without infringing rights derived from a patent granted on an earlier application or benefiting from an earlier foreign priority, a compulsory licence may be granted to the patentee of the later patent to the extent necessary for the working of his invention if the invention-

- (a) Serves industrial purposes different from those served by the it, invention which is the subject of the earlier patent; or
- (b) constitutes substantial technical progress in relation to that last mentioned invention.

**3.** If the two inventions mentioned in paragraph 2 of this Schedule serve the same industrial purposes, a compulsory licence may be granted under that paragraph only on condition that a compulsory licence shall also be granted in

respect of the later patent to the patentee of the earlier patent, if he so requests.

**4.** A compulsory licence shall not be granted in respect of a patent if the patentee satisfies the court that his actions in relation to the patented invention are justifiable in the circumstances, but he shall not be held to have so satisfied the court if he merely shows that the patented article is freely available for importation.

**5.** A compulsory licence shall not be granted unless the applicant-

(a) satisfies the court that he has asked the patentee for a contractual licence but has been unable to obtain such a license on reasonable terms and within a reasonable time; and

(b) offers guarantees satisfactory to the court to work the relevant invention sufficiently to remedy the deficiencies (or to satisfy the requirements) which gave rise to his application.

**6.** A compulsory license-

(a) entitles the licensee to do any act mentioned in section 6 of this Act except importation;

(b) does not entitle the licensee to grant further licences;

(c) Shall be non-exclusive, and

(d) may contain additional obligations and restrictions as regards both the licensee and the patentee.

**7.** A compulsory licence may be transferred only with the industrial undertaking in which the relevant invention is used, and no such transfer shall be valid until the consent of the court has been obtained.

**8.** On hearing an application for a compulsory licence, the court shall first decide whether a compulsory licence may be granted and shall then, if it decides in favour of the grant and the parties cannot agree on the terms, proceed to fix the terms (including adequate royalties having regard extent to which the relevant invention is to be worked which shall be deemed to constitute a valid contract between the parties.

**9.** On the application of the patentee, the court may cancel a compulsory licence if-

(a) the licensee fails to comply with the terms of the licence; or

(b) the conditions which justified the grant of the licence have ceased to exist, so however that in the latter case a reasonable time shall be given to the licensee to cease working the relevant invention if an immediate cessation would cause him to suffer substantial damage.

**10.** On the application of the patentee or licensee, the court may vary the terms of a compulsory licence if new facts justify the variation, and in particular (without prejudice to the generality of the foregoing) if the patentee has granted contractual licences on more favourable terms.

**11.** Where the court grants, cancels or varies the terms of a compulsory licence-

(a) the proper officer of the court shall inform the Registrar, who shall register the grant, cancellation or variation without fee; and

(b) the grant, cancellation or variation shall have no effect as against third parties until it has been registered.

**12.** A representative of the Minister shall have the right to appear and be heard at the hearing of an application for a compulsory licence.

**13.** The Minister by order in the Federal Gazette may provide that, for certain patented products and processes (or for certain categories thereof) declared by the order to be of vital importance for the defence or the economy of Nigeria or for public health, compulsory licences may be granted before the expiration of the period mentioned in paragraph 1 above and may permit importation.

**14.** For the purposes of this Part, references to the working of a patented invention are to be construed as references to-

(a) the manufacture of a patented article; or

(b) the application of a patented process; or

(c) the use in manufacture of a patented machine, by an effective and serious establishment existing in Nigeria on a scale which is adequate and reasonable in the circumstances.

## Part II

### Use of Patents for service of government agencies

**15.** Notwithstanding anything in this Act, where a Minister 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 a government agency in the Federal Republic.

**16.** The authority of a Minister under paragraph 15 of this Schedule may be given-

- (a) before or after the relevant patent has been granted;
- (b) before or after the doing of the acts in respect of which the authority is given; and
- (c) 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.

**17.** Paragraphs 15 and 16 of this Schedule shall have effect so as to exempt-

- (a) the Government;
- (b) any person authorised under those paragraphs;
- (c) any supplier of the Government or of any such person; and
- (d) any agent of any such supplier, from liability for the infringement of any patent relating to the relevant article or invention and from liability to make any payment to the patentee by way of royalty or otherwise.

**18.** Where any act is done in respect of an article on the authority of a Minister under paragraph 15 of this Schedule, then, unless it appears to the Minister that it would be contrary to the public interest to do so, the Ministry concerned with the act shall furnish the patentee with such information, as to the extent of the act as the patentee may from time to time require.

**19.** The revisions of any licence, assignment or agreement made before or after the commencement of this Act between a patentee and any person, other than the Government, or a Ministry shall be of no effect in so far as those provisions restrict or regulate the use of a patented article or invention or provide for the making of payment in respect of any such use, or are calculated by reference thereto.

**20.** During any period of emergency the powers exercisable in relation to a patented article or invention on the authority of a Minister under paragraph 15 of this Schedule shall include power to purchase make, use, exercise and vend the article or invention for any purpose which appears to the Minister necessary or expedient-

- (a) for the efficient prosecution of any war in which the Federal Republic may be engaged; or
- (b) for the maintenance of supplies and services essential to the life of the community; or
- (c) for securing a sufficiency of supplies and services essential to the well-being of the community; or
- (d) for promoting the productivity of industry, commerce and agriculture; or
- (e) for fostering and directing exports and reducing imports (or any class or classes of imports) from all or any countries and fear redressing the balance of trade; or
- (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community.

**21.** Where a patented article is purchased, made, used, exercised or vended by or on behalf of a government agency, the benefit of this Part shall extend to the agency and to persons acting in any capacity on its behalf.

**22.** This Part shall apply to a patented article forfeited under any law relating to customs and excise; and, on any such forfeiture, the Government may use or sell the article as if it had been imported for the use of a government agency in Nigeria.

**23.** In this Part, unless the context otherwise requires- "articles" includes-

- (a) any drugs or pharmaceutical preparations, substances or materials; and
- (b) any plant, machinery or apparatus, whether fixed to the land or not after importation, patented under the law of a country other than Nigeria;

"export" means export from Nigeria;

"Federal Republic" means the Federal Republic of Nigeria, and includes any State of the Federation;

"Government" means the Federal Government, and includes the Governor of any State of the Federation;

"Government agency" means any Federal or State Ministry or Department of Government, and includes-

(a) a voluntary agency hospital, that is to say, an hospital in Nigeria (not being a hospital operated by the government) which is wholly or partly maintained by the Federation or a State by way of grant in aid or otherwise;

(b) a local authority, that is to say, any administration, council or other authority exercising limited governmental powers in a defined area within a State;

(c) a statutory corporation, that is to say, a body corporate directly established by law to which in the performance of its functions the Government or a Minister is empowered by law to give directions; and

(d) Any company which is owned or controlled by the Government;

"Ministry" means a Federal or State Ministry or Department of Government;

"Minister" means a Minister of the Federation and a State Commissioner;

"Period of emergency" means any period of emergency however declared or notified by or on behalf of the Government or any successor Government;

"Person" includes the Government or a Ministry;

"War" includes civil war.

## **Second Schedule**

### **Transitional and saving provisions**

- 1.** The person who, immediately before the commencement of this Act, was Registrar of Patents under the former patents law shall on the commencement of this Act become Registrar of Patents and Designs for the purposes of this Act.
- 2.** Where a patent has been registered in Nigeria under the former patent law and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act, then-
  - (a) subject to the following sub-paragraphs, the patent shall be treated in Nigeria as if it had been granted under this Act;
  - (b) The patent shall expire as regards Nigeria when those privileges and rights would have expired if this Act had not been made;
  - (c) The certificate of registration shall be admissible as prima facie evidence of the date and fact of registration; and
  - (d) An action for infringement shall lie under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in any other case may be instituted and disposed of as if this Act had not been made.
- 3.** So far as is necessary for the purposes of paragraph 2 of this Schedule, the register of patents under the former patent law shall be maintained as nearly as may be, and shall be regarded and dealt with, as if it were part of the Register under this Act.
- 4.** Where immediately before the commencement of this Act any person enjoyed any privileges or rights in respect of a design by virtue of the United Kingdom Designs (Protection) Act-
  - (a) that person shall continue to enjoy those privileges and rights for twelve months after the commencement of this Act or, if he applies within those twelve months for registration of the design under this Act, until the application is disposed of;

(b) at the end of the said twelve months or on the disposal of the said application, as the case may be, those privileges and rights shall cease to exist; and

(c) So long as that person continues to enjoy those privileges and rights, no other person shall have any right to registration of the design under this Act.

5. Any authorisation given under the Patent Rights (Limitation) Act 1968 shall, if it was still effective immediately before the commencement of this Act, be deemed to have been given under Part II of Schedule 1 and shall continue in force accordingly.

6. The Patents (Fees) Regulations 1961 shall, as far as may be-

(a) apply in relation to patents under this Act as they applied in relation to patents under the former patent law; and

(b) Apply in relation to designs under this Act as they apply in relation to patents under this Act, and may be amended or revoked by rules made under section 30 of this Act

7. Within twelve months after the commencement of this Act the Minister may by order in the Federal Gazette make any further transitional saving provisions (not inconsistent with this Schedule) which appear to him to be necessary or desirable.

8. In this Schedule, "the former patents law" means the Registration of United Kingdom Patents Act.

### **Subsidiary Legislation**

1. Patents and Designs (Convention Countries) Order
2. Patents Rules
3. Designs Rules
4. Patents and Designs (Additional Transitional and Saving Provisions) Order