

LEGAL INSIGHT TO THE GRANT AND REVOCATION OF PATENT IN NIGERIA*

Abstract

This work focused on the legal rules guiding the administration of patents in Nigeria. It made a critical analysis of the complexities surrounding the grant of patents in Nigeria. In this wise, the various issues associated with determining what amounts to a patentable invention were examined in this work. Also, the procedure for registration of patents in Nigeria as well as the grounds and procedure for challenging the registration of a patent were fully considered. This work found that the statutory framework for the administration of patents in Nigeria is robust though involves a lot of technicalities which may pose clogs in the smooth running of the system. This work recommended periodic updates of the Patents and Designs Act and the adoption of internationally recognized best practices towards enhancing the state of patent administration in Nigeria.

Keywords: Patents, Revocation, Law, Nigeria

1. Introduction

A substantial political economy literature, dating back to the eighteenth century, exists on the determinants of property rights. One of such property rights is the right to obtain a patent on a discovery or an invention. Around the world we all enjoy and make use of things, varying from medical discoveries and inventions to electronic devices and their compatible applications. As a natural response, people are driven to develop means and systems to encourage the creation, protection, and codification of such things they treasure. The need for such protection birthed the intellectual property law on patents.¹ As the world becomes more interconnected through rapid dissemination of concepts and ideas, the intellectual property law on patents serves as the primary medium of protecting these concepts and ideas from piracy or misappropriation.² In modern and pre-modern societies, the rate of innovation is subject to economic forces. Innovations do not appear like manna from heaven. Innovations are the result of sustained efforts by individuals, either alone or as part of a laboratory or firm, to create new products and better ways to produce existing products. When innovators are allowed to retain rights to the output of innovative effort, they will have the incentive to devote their creative resources to developing innovations. If property rights to potential innovation do not reside with an innovator, the incentive to devote resources to innovation is reduced, and society can expect fewer new products and processes. Such property rights are typically embodied in laws regarding patents.³ 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.⁴

2. Meaning, Nature and Scope of Patent

The word *patent* originates from the Latin *patere*, which means 'to lay open' (i.e., to make available for public inspection). It is a shortened version of the term *letters patent*, which was an open document or instrument issued by a monarch or government granting exclusive rights to a person, predating the modern patent system. Similar grants included land patents, which were land grants by early state governments in the United States of America (USA), and printing patents, a precursor of modern copyright.⁵ In modern usage, the term 'patent' usually refers to the right granted to anyone who invents something new, useful and non-obvious. A patent is

*By **M.V.C. OZIOKO, PhD**, Reader and Formerly Head, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, P.M.B. 5025, Awka, Anambra State, Nigeria. Email: mvcozioko@gmail.com; mv.ozioke@unizik.edu.ng. Phone Number: +2348039464374;

***Chukwubuike J.S. AZORO, LLB, LLM, BL, PhD Candidate**, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, Awka, Nigeria and Associate at IUC Global Chambers, Awka, Nigeria; Phone Number: +234(0)8061116935; Email: cjsazoro@yahoo.com; cjsazoro@nigerianbar.ng; and

***Chinedu A. ONAH, LLM**, Lecturer, Department of Commercial and Property Law, Faculty of Law, Nnamdi Azikiwe University, P.M.B. 5025, Awka, Anambra State, Nigeria. Email: ac.onah@unizik.edu.ng; chineduonah@nigerianbar.ng. Phone Number: +2348064794333;

¹T & A Legal, 'Registration of Patent in Nigeria', <<https://www.mondaq.com/nigeria/patent/703362/registrati-on-of-patent-in-nigeria>> Last accessed on 3/2/2022.

² *Ibid.*

³ *Ibid.*

⁴An Overview of the Law of Patents in Nigeria', <http://www.nigerianlawguru.com/articles/intellectual%20property%20law/AN%20OVERVIEW%20OF%20THE%20LAW%20OF%20PATENTS%20IN%20NIGERIA.pdf> Last accessed on 3/2/2022.

⁵ M Frumkin, "The Origin of Patents", Journal of the Patent Office Society, March 1945, Vol. XXVII, No. 3, p. 143 *et seq.*

often referred to as a form of intellectual property right, an expression which is also used to refer to trademarks and copyrights, and which has proponents and detractors.⁶ The Oxford Advanced Learner's Dictionary of Current English defines the word 'patent' as, 'An official right to be the only person to make, use or sell a product or an invention.'⁷ Similarly the Black's Law Dictionary defines it as:

(1) The governmental grant of a right, privilege, or authority. (2) The official document so granting. (3) The right to exclude others from making, using, marketing, selling, offering for sale, or importing an invention for a specified period... granted by the... government to the inventor if the device or process is novel, useful and non-obvious.⁸

Bently and Sherman defines a patent as '...a limited monopoly that is granted in return for the disclosure of technical information.'⁹ This definition is vague to the extent that it does not prescribe what kind of technical information will be required before a patent can be granted. According to Nwabachili, 'A patent is the grant by the government to an inventor or his assignee, for a short time, of a right of monopoly to preclude any other person from exploiting his invention without his consent.'¹⁰ It is a type of intellectual property that gives its owner the legal right to exclude others from making, using, or selling an invention for a limited period of time in exchange for publishing an enabling disclosure of the invention.¹¹ In the case of *Bloomer v. McQuewan*,¹² it was held that, '[T]he franchise which the patent grants consists altogether in the right to exclude everyone from making, using, or vending the patented article, without the permission of the patentee. This is all he obtains by the patent.' To Kintner and Lahr,

In its simplest terms a patent is an agreement between an inventor and the public represented by the... government; in return for a full public disclosure of the invention the inventor is granted the right for a fixed period of time to exclude others from making, using, or selling the defined invention... It is a limited monopoly, designed not primarily to reward the inventor (this may or may not follow) but to encourage a public disclosure of inventions so that after the monopoly expires, the public is free to take unrestricted advantage of the invention.¹³

From the foregoing, it is clear that a patent is the grant to a person who made an invention limited time to prevent any other person from exploiting such an invention without the consent of the person.

3. Grant of Patent in Nigeria

The principal law governing the application for patent in Nigeria is the Patents and Designs Act.¹⁴ The law provides for requirements for patenting an invention in Nigeria. By virtue of section 1(1) of the Act, 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. Under the Act, an invention is new if it does not form part of the state of the art.¹⁵ The expression 'the art' is statutorily defined to mean the art or field of knowledge to which an invention relates, while the expression 'the state of the art' is statutorily defined to mean 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

⁶ S Wall, S Minocha and B Rees, *International Business* (Harlow: Prentice Hall Financial Times, 2009) p. 43.

⁷ S Wehmeier et al (ed), *Oxford Advanced Learner's Dictionary of Current English* (Oxford: Oxford University Press, 2006) p. 1067.

⁸ BA Garner (ed), *Black's Law Dictionary* (11th edn, St. Paul: Thomson Reuters, 2019) p. 1353.

⁹ L Bently and B Sherman, *Intellectual Property* (New York: Oxford University Press, 2014) 1 et seq.

¹⁰ C Nwabachili, *Intellectual Property Law and Practice in Nigeria* (Lagos: Malthouse Press Ltd, 2017) p. 139.

¹¹ According to the Court of Appeal of the United States in *Herman v. Youngstown Car Mfg. Co.*, 191 F. 579, 584 – 85, 112 CCA 185 (6th Cir. 1911), "A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder."

¹² 55 US 539, 549 (1852).

¹³ W Kintner and JL Lahr, *An Intellectual Property Law Primer* (2nd edn, New York: Clark Boardman Co., 1982) pp. 7 – 11.

¹⁴ Patents and Designs Act, Cap. P2 *Laws of the Federation of Nigeria* 2004.

¹⁵ *Ibid.*, s. 1(2)(a).

invention, the inventor or his successor in title has exhibited it in an official or officially recognized international exhibition.¹⁶

According to Prof. Nwabachili, novelty (i.e. newness of the invention), is really a question of whether the invention has been ‘anticipated’ for example, by a previous patent, or by publication or use. The anticipating patent or publication could have occurred anywhere in the world since section 3 of the Act refers to public availability in Nigeria or elsewhere.¹⁷ In *Windsurfing Int’l Inc v. Tabular Marine (Great Britain) Ltd*, the Court of Appeal held that a 12-year-old boy who built a sailboard and used it in public for a few weeks had effectively anticipated a later patent for a sailboard, and the later patent was declared invalid for want of novelty. 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*¹⁸ as follows: ‘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 above 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 which invalidates novelty and renders a product unpatentable.¹⁹ It must also be noted 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, 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, if a book, written in French is kept in the British museum, in a room not accessible to the public and only its title appeared in the catalogue of the museum, the book may be held to have been made available to the public.

Disclosure to the public could also be by prior use. However, 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. v. Norton & Co. Ltd*,²⁰ it 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 to produce the substance. 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 *PCG Research Ltd v. Ardon International*²¹ as follows:

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 judgment of the Court of Appeal in the *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd* (1972) RPC 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

¹⁶ *Ibid*, s. 1(3).

¹⁷C Nwabachili, *op. cit*, p. 147. He further opined that the ‘state of the art’ includes matters in other patent applications published on or after the priority date of the invention being tested against the state of the art, provided the priority dates of those applications are earlier.

¹⁸ (1989) RPC 147 at 204.

¹⁹ *Pall Corp. v. Commercial Hydraulics (Bedford) Ltd* (1900) FS 329; *Vax-Appliances Ltd v. Hoover Plc* (1991) FSR 307.

²⁰ (1994) RPC 1.

²¹ (1993) FSR 197 at 218.

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*,²² Lord Westbury LC 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.

From the foregoing, it is clear 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.

Under the Act, an invention is said to have resulted 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.²³ In *Technograph Printed Circuits Ltd v. Mills & Rockley (Electronics) Ltd*,²⁴ 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 Svenska Elektriska A/B v. The Burntisland Shipbuilding Co. Ltd*²⁵ where it was held as follows:

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 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.

Thus, an invention will not qualify for a valid patent if, given the state of the art at the date the application was filed and regardless of the fact that the inventor undertook independent research and arrived at his invention without relying on available literature, the said invention is such as could have been arrived at by a person

²² (1860)31 LJ. Ch 457 at 463.

²³ Patents and Designs Act, s. 1(2)(b).

²⁴ (1972) RPC 346.

²⁵(1951)68 RPC 63 at 69. See further the dictum of Lopes, LJ in *Savage v. Harris & Sons* (1896)13 RPC 364 at 370 where the lawlord held as follows: "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."

skilled in the art, having access to all available information on the subject as at 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.

For the purposes of the Act, an invention is capable of industrial application if it can be manufactured or used in any kind of industry, including agriculture.²⁶ Since the definition of industry has been extended in the provision to include agriculture, it is arguably the intention of the legislature to allow patenting in respect of product or processes used in almost all kinds of commercial enterprise. There is no available 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. Perhaps, the requirement for industrial applicability may be referring to utility of the invention. In other words, an invention will not be patentable if it has no practical application. Prof. Nwabachili appears to support this view when he opined that the requirement of industrial applicability demonstrates the practical nature of patent law, which requires that the invention should be made industrially or relate to an industrial process. An application for a patent that depends on the use of yet undiscovered materials in its manufacture would be refused since an invention has to be something that can be worked industrially.²⁷ As already noted, an invention is patentable if it constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.²⁸ Under this requirement, it does not matter that a process similar to the invention had already been invented. As long as this new process constitutes an improvement on the old process and it satisfies all the requirements of novelty then it will be deemed patentable.²⁹

Patents cannot be validly obtained in respect of plant or animal varieties, or essentially biological processes for the production of plants or animals other than microbiological processes and their products.³⁰ Patents cannot also be validly obtained in respect of inventions the publication or exploitation of which would be contrary to public order or morality.³¹ However, principles and discoveries of a scientific nature are not inventions for the purposes of the Act.³² It must however be noted that the right to a patent is not vested in the true inventor but is rather vested in the statutory inventor.³³ Accordingly, section 2(1) of the Act provides that 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. 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.³⁴ 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.³⁵

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. However, where the inventor is an employee and 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 the invention is of exceptional importance, he is entitled

²⁶ Patents and Designs Act, s. 1(2)(c).

²⁷C Nwabachili, *op. cit.*, p. 148. However, by virtue of s. 1(4) of the Patents and Designs Act, 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). Indeed, by s. 1(5), principles and discoveries of a scientific nature are not inventions for the purposes of the Act.

²⁸ *Ibid.*, s. 1(1).

²⁹ See *James O. Agbovofo v. Gram Haulage & Transport Ltd* (1998) FHCLR 236.

³⁰ Patents and Designs Act, s. 1(4)(a).

³¹*Ibid.*, s. 1(4)(b). Apart from these exceptions, all products and processes, which meet the qualification for patentability under s. 1(1) of the Act are patentable. Note however that the exploitation of an invention is not contrary to public order or morality merely because its exploitation is prohibited by law.

³² *Ibid.*, s. 1(5).

³³ C Nwabachili, *op. cit.*, p. 150.

³⁴ Patents and Designs Act, s. 2(2).

³⁵ *Ibid.*, s. 2(3).

to fair remuneration taking into account his salary and the importance of the invention.³⁶ The entitlement in question is not modifiable by contract and may be enforced by civil proceedings.³⁷ It appears that in such a case, the right to the patent is vested in the employer. However, if the employee's contract of employment does not require him to exercise any inventive activity and he makes an invention without utilizing data or means placed at his disposal by his employment, the right to the patent will be vested in the employee.³⁸ A person is not an inventor if he has merely assisted in doing work connected with the development of an invention without contributing any inventive activity.³⁹

It must however be noted that a person's right to the patent of an invention may be assigned, transferred by succession, or held in joint ownership.⁴⁰ An assignment of a patent however, must be in writing and signed by all the parties to the assignment.⁴¹ Such assignment will have no effect against third parties unless registered and the prescribed fee for the assignment paid.⁴² 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. In the absence of any provision to the contrary in the contract, the licensee shall be entitled to do anywhere in Nigeria in relation to the patent or design any act which but for the licence would amount to an infringement of the rights of the patentee or design owner.⁴³ Whenever any such licence is granted, the licence shall be registered, and shall be of no effect against third parties until registration is effected and the prescribed fee paid.⁴⁴ The registration shall be cancelled at the request of the licensor if the Registrar is satisfied that the licence has been terminated.⁴⁵ Any clause in a contract for a licence which 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 is unnecessary for the safeguarding of those rights is null and void. However, limitations concerning the scope, extent, territory or duration of the exploitation of the patent or design or the quality of the products in connection with which the patent or design may be exploited; 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 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 valid and enforceable.⁴⁶ In the absence of any provision to the contrary in a contract for a licence, the grant of the licence shall not prevent the licensor from granting further licences to other persons, or from himself exploiting the relevant patent or design. Unless the contract for a licence provides otherwise, the licence shall not be assignable by the licensee, and the licensee shall not be entitled to grant further licences to other persons.⁴⁷

4. Rights Conferred by the Grant of Patent

By virtue of section 6(1) of the Act, a patent confers upon the patentee the right to preclude any other person from doing any of the following acts, to wit - (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 in respect of a product obtained directly by means of the process, the act of making, importing, selling or using the product, or stocking it for the purpose of sale or use. 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 such claims.⁴⁸ The rights under a patent shall extend only to acts done for industrial or commercial purposes. The said rights however, 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

³⁶ See *British Reinforced Concrete v. Lind* (1917) 34 RPC 101; *Adamson v. Kemsworthy* (1992) RPC 57.

³⁷ Patents and Designs Act, s. 2(4).

³⁸ C Nwabachili, *op. cit.*, p. 151.

³⁹ Patents and Designs Act, s. 2(5).

⁴⁰ *Ibid.*, s. 24(1).

⁴¹ *Ibid.*, s. 24(2).

⁴² *Ibid.*, s. 24(3). See *Arewa Textile Plc & Ors v. Finetex Ltd* (2003)7 NWLR 322; *Printing and Numerical v. Samsent* (1895)19 EQ 462; *Jones v. Leers* (1856)1 H & N 189. Note that by s. 24(4), joint owners of a patent may separately transfer their shares therein, exploit the patented invention and exercise the rights conferred on patentees by law.

⁴³ Patents and Designs Act, s. 23(1).

⁴⁴ *Ibid.*, s. 23(2)(a).

⁴⁵ *Ibid.*, s. 23(2)(b).

⁴⁶ *Ibid.*, s. 23(3).

⁴⁷ *Ibid.*, s. 23(4). Where a contract for a licence provides for a licensee to grant further licences, the provisions of s. 23 shall apply in relation to any such further licence. See *ibid.*, s. 23(5).

⁴⁸ *Ibid.*, s. 6(2).

reserved to the patentee.⁴⁹ 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 was conducting an undertaking in Nigeria and 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 preparation, and thereafter undertake the manufacture or application, as the case may be, and in respect of any resulting products to exercise any of the rights allowed to a patentee by law.⁵⁰

5. Registration of Patent in Nigeria

The formal requirements for a patent application are set out in section 3 of the Act which provides that every patent application 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. The application 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, legalization or certification of the signature of the power of attorney shall be unnecessary. The procedure for filing of an application for a Nigerian patent is prescribed in the Patent Rules of 1971, which is also contained in the Second schedule to the Act. Specifically rule 8 provides that an application shall be made on Form 1 as provided in the Rules, 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.⁵¹ 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.

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 of the Act; (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 whether a prior grant of a patent for the same invention has been made in Nigeria. Where the Registrar is satisfied that the application is not supported with the necessary documents or details as specified in section 3(1) of the Act, the Registrar shall reject the application.⁵² Where the Registrar is satisfied that the application relates to more than one invention, he may invite the applicant to restrict the application to only one invention and notify the applicant that he may within three months file subsidiary applications for the other inventions which shall benefit from the date of filing of the initial application and also benefit from any claim for a foreign priority made under the Act, provided that where the applicant fails to comply with such invitation, his application shall be rejected.⁵³ Further, where the Registrar is satisfied that an applicant seeking to avail himself of a foreign priority in respect of an earlier application made in a country outside Nigeria has failed to append to his application 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; or has failed within a period of not more than three months after the making of the application to 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 as required under section 3(4) of the Act, the Registrar shall disregard such claim for foreign priority.⁵⁴

Upon the Registrar granting a patent under the Act, he shall issue to the patentee 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

⁴⁹ *Ibid*, s. 6(3).

⁵⁰ *Ibid*, s. 6(4).

⁵¹ *Ibid*, s. 3(3).

⁵² *Ibid*, s. 4(1)(a).

⁵³ *Ibid*, s. 4(1)(b).

⁵⁴ *Ibid*, s. 4(1)(c). Where the Registrar is satisfied that this requirement has been satisfied, the foreign priority claimed shall be mentioned in the patent. See *ibid*, s. 4(3).

priority is claimed, an indication of the fact, and the number and date of the application on which the claim is based, and the name of the country where it was made; (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.⁵⁵ The Act requires the Registrar to maintain a Register of Patents which shall consist of duplicates of the documents issued upon grant of a patent, together with such further particulars as is required by the Act to be registered concerning the patent.⁵⁶ As soon as a patent has been granted under the Act, the Registrar shall publish a notification of the grant containing the following details - (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, an indication of the fact, and the number and date of the application on which the claim is based, and the name of the country where it was made; (e) the claims; and (f) where appropriate, the name and address of the true inventor.⁵⁷ By virtue of section 7(1) of the Act, a patent shall expire at the end of the twentieth year from the date of the filing of the relevant patent application. A patent shall lapse if the prescribed annual fees are not duly paid in respect of it. However, a period of grace of six months shall be allowed for the payment of the fees. If the fees and any prescribed surcharge are paid within that period, the patent shall continue as if the fees had been duly paid.⁵⁸

6. Opposition and Revocation of Patent Registration in Nigeria

Section 4(4) of the Act provides that patents are granted at the risk of the patentee and without guarantee of their validity. 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. Thus the Nigeria patent system is called the deposit system of patenting as opposed to the examination system adopted in the industrialized countries, where rigorous examination as to compliance with the requirements for patentability is undertaken. 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. Pursuant to section 9(1) of the Act, the Court, upon the application of any person (including a public officer acting in the exercise of his functions) shall declare a patent null and void - (a) if the subject of the patent is not patentable under the Act; or (b) if the description of the invention or the claim supplied by the patentee at the time of registration is eventually found as not having conformed with the requirements of the 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. Going by the above provision, it seems only a Court can nullify a patent once granted by the Registrar, and any attempt by any other person including the Registrar to nullify a patent is *ultra vires* and liable to be declared ineffective. It also appears that aside the statutory grounds of unpatentability of the subject matter of a patent,⁵⁹ existence of a prior patent or an application benefiting from an earlier foreign priority, and failure of the description or claims supplied during registration to conform with the requirements of the Act, a patent cannot be nullified by the Court on any other ground.

An application to Court for nullification of a registration may apply to the whole of a patent or to any particular claim or claims made by it.⁶⁰ For the purpose of disposing of an application for nullification of a patent, 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) 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

⁵⁵ *Ibid.*, s. 5(1).

⁵⁶ *Ibid.*, s. 5(2).

⁵⁷ *Ibid.*, s. 5(3).

⁵⁸ *Ibid.*, s. 7(2). The expiration or lapse of a patent shall be registered and notified – *Ibid.*, s. 7(3). However, note that a patent may be surrendered by the patentee by written declaration addressed to the registrar – *ibid.*, s. 8(1). The surrender of a patent - (a) may relate to all or any of the claims made by the patent; (b) 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 – *Ibid.*, s. 8(2).

⁵⁹ The rules on patentability have been considered in this work under the head ‘Grant of Patents in Nigeria’. Where patent was granted for an invention which does not meet the requirements of patentability as already discussed, such grant is liable to be nullified upon application to the Court.

⁶⁰ Patents and Designs Act, s. 9(2).

sent to the patentee by a governmental or intergovernmental research or investigation institute.⁶¹ Where a declaration is made by the Court nullifying a patent, 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. The proper officer of the Court shall inform the registrar of such nullification, and the Register shall register same and notify the patentee of such registration.⁶² The Court shall not make a declaration nullifying a patent without first giving the patentee an opportunity to be heard.⁶³ In the determination of an application for nullification of a patent, the Court shall have regard only to the state of affairs existing when the proceedings were instituted;⁶⁴ and shall dismiss the application if the applicant fails to satisfy the Court that he has a material interest in making the application, unless the applicant is a public officer.⁶⁵ It is submitted that the term ‘public officer’ should be interpreted to mean the Registrar or any officer under the Registrar’s authority, hence will be preposterous to extend same as referring to all public officers in Nigeria. Section 26(1) of the Act vests the Federal High Court with the jurisdiction to hear and dispose of legal proceedings in connection with patents.⁶⁶ It must however be noted that by virtue of section 251(1) of the 1999 Constitution of the Federal Republic of Nigeria (as amended), the Federal High Court enjoys exclusive jurisdiction over all matters related to patents in Nigeria.⁶⁷ During such proceedings however, the Court may sit with and be advised by two assessors having expert knowledge of matters of a technological or economic nature. This provision is laudable as it will afford the Court the benefit of expert opinion on the ‘state of the art’ as regards the subject matter of the patent being considered in the proceedings.

7. Conclusion

This work has so far examined the legal principles applicable to the grant, registration, opposition and revocation of patents in Nigeria with a view to determining the efficiency of the Nigerian patent system. It was found that novelty, inventiveness and capacity for industrial application are important factors to be considered before a patent can be granted. The legal principles applicable in Nigeria on the grant and registration of patents are quite robust, though its efficiency is greatly affected by the fact of the deposit system of patenting practiced in Nigeria, as opposed to the examination system adopted in the industrialized countries. This deposit system allows a patentee to enjoy the monopoly of a patent that may eventually be voided by the Courts. In view of the above, it is recommended that Nigeria adopts the examination system as is obtainable in advanced societies. This will remove the said problem of a patentee enjoying wrong monopoly for a patent, and will also remove the problem of *locus standi* that allows only public officers and persons whose interests are specifically affected to challenge a grant of patent, as the examination mechanism would enable any third party to so challenge a patent application.⁶⁸ It is believed that if this recommendation is followed through, the Nigerian patent system will not only become more effective and efficient, but it will begin to also achieve an objective of a patent system, which is to promote indigenous inventiveness and enhance local echnological development.

⁶¹ *Ibid*, s. 9(3).

⁶² *Ibid*, s. 9(4).

⁶³ *Ibid*, s. 9(5)(a). This rule is consistent with the constitutional right to fair hearing granted the patentee under s. 36 of the 1999 Constitution of the Federal Republic of Nigeria (as amended). See *Obot v. CBN* (1993)8 NWLR (pt. 310) 140; *UCHBM v. Morakinyo* (2014)16 NWLR (pt. 1434) 589; *Ridge v. Balwin* (1963)2 ER 66.

⁶⁴ *Ibid*, s. 9(5)(b).

⁶⁵ *Ibid*, s. 9(5)(c).

⁶⁶This section also provides that the provisions of the Trade Marks Act on legal proceedings are *mutatis mutandis* applicable to legal proceedings on patents.

⁶⁷ See *Omnia Nigeria Limited v Dyktrade Limited* (2007) LCN/3695(SC).

⁶⁸DO Oriakhogba and AI Fenemigho, ‘Making the Nigerian Patent System more Efficient through Pre-Grant Opposition Mechanism: Lessons from India and Botswana’, (2016)4 *South African Intellectual Property Law Journal*, 64 – 92.