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## ASSESSING THE CONDITIONS FOR PATENTABILITY IN NIGERIA

By

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### Abstract

*When it comes to the issue of patentability of an invention, it is not just what the inventor imagines, it is a question of what the law says about that type of invention. In other words an invention must pass the litmus test laid down by law both in terms of the substantive and procedural requirements. Every country has its own peculiarity in terms of the conditions to be satisfied and in some cases it is just a change in semantics. However the core or common substantive conditions relate to newness and the exercise of inventive faculty. This paper examines the conditions to be met for patentability in Nigeria under the patents and Designs Act in comparison with some other Countries. The paper points out some loopholes in the process and ends with some recommendations for efficiency.*

### 1 Introduction

“In order for a design to be ‘patentable,’ there must be both originality and exercise of inventive faculty”<sup>1</sup> Patent Law is part of the umbrella of laws described as Intellectual Property Law.<sup>2</sup> *Intellectual Property* (IP) refers to any product of the human mind or intellect, such as an idea, invention, expression, unique name, business method, industrial process or chemical formula which has some value in the market place, and that ultimately can be reduced to a tangible form. Such tangibles could take the form of a computer, a chemical, a software base invention, a gadget, a process, *etcetera*. IP Law determines when and how a person can capitalize on a creation.<sup>3</sup> A *patent* on the other hand has been described as “a grant from a government that confers upon an inventor the right to exclude them from making, using, selling, importing, or offering an invention for sale for a fixed period of time.”<sup>4</sup> It has been seen as a form of personal property that can

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<sup>1</sup> See *Connecticut PaperProducts v. New York Paper Co.*CCA.Md,127 F.2d 423,429.

<sup>2</sup> Sometimes it is categorized as Industrial Property, in which case subjects like Patents, Designs and Trademark are deemed to form part of Industrial Property while Copyright is left as Intellectual Property.

<sup>3</sup> Pressman, D., *Patent it yourself, Your Step-by Step Guide to Filing at the U.S Patent office*, 14th ed. (USA: Delta Printing Solutions, Inc, 2009) p.17.

<sup>4</sup> *Ibid.*, p.9

be sold outright for a lump sum, or its owner can give anyone permission to use the invention covered in return for royalty payments.<sup>5</sup> Patents also constitute a great avenue for the transfer of technology.<sup>6</sup>

This paper analyses the conditions of patentability under the laws in Nigeria. Thus, emphasis is laid on patentability from the Nigerian perspective, without prejudice to examining the law and practice in some other jurisdictions. It uses both the interpretative and comparative approaches to unveil the nuances of patentability. The paper raises fundamental concerns about the practice of the patent law in Nigeria and makes suggestions for prompt action.

## 2 Origin of Patents

The Statute of Monopolies, 1623 may be described as the origin of restricting the exercise of royal power in granting monopolies. The term derived from the fact that the forms of grant are *litterae patentes* or open letters, being addressed to all whom they may come.<sup>7</sup> It is apparent from the above that patent originated from Great Britain, it is tied to the Legal System of Great Britain and traceable to some of its laws to a large extent.<sup>8</sup> The issue of grant of patents was not much developed in Nigeria until about 1970. The origin of Patent Law in Nigeria was aptly captured by Orojo<sup>9</sup> in the following words;

Before 1970, there was no provision for the grant of Patents in Nigeria. The Registration of United Kingdom Patents Act provided for the registration in Nigeria of Patents granted in the United Kingdom so as to confer rights on the person registered in respect thereof. Such registration conferred on the applicant privileges and rights subject to all conditions established by the law of Nigeria as though the Patent had been issued in the United Kingdom with an extension to Nigeria. Thus, in order to protect in Nigeria and invention made in Nigeria, it was necessary to have a patent in the United Kingdom and thereafter register it in Nigeria. In 1968, provisions were made by the Patent Right (Limitation) Decree 1968 for the use of

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<sup>5</sup> Pressman. op. cit p.9

<sup>6</sup> See J. M. Nasir, "Transfer of Technology in Nigeria's Development", available at [dspace.unijos.edu.ng/bitstream/10485/342/1/31-71.pdf](http://dspace.unijos.edu.ng/bitstream/10485/342/1/31-71.pdf) accessed March 9, 2013.

<sup>7</sup> Hailsham, V., *Halsbury's Laws of England* (Great Britain: William Clower & Sons Limited, 1937) vol. xxiv p.529

<sup>8</sup> *Ibid.*

<sup>9</sup> Orojo, J.O., *Nigerian Commercial Law and Practice* (London: Sweet & Maxwell, 1983) p.1106

certain inventions for the service of the state and for rights of third parties in respect of the use of such inventions. The law on patents is, however, now contained in the Patents and Designs Act, 1970.

The Patents and Designs Act, 1970 referred to above was eventually encapsulated in the Laws of the Federation of Nigeria, 1990<sup>10</sup> and it became the cornerstone, legislation on patents in Nigeria. In the year 2004, the Laws of the Federation of Nigeria were updated and placed in new volumes. The current law regulating Patents in Nigeria can be cited as the Patents and Designs Act, CAP. P2, Laws of the Federation of Nigeria, 2004.<sup>11</sup>

### **3 Patentable Invention in General**

A patentable invention or patentability<sup>12</sup> appears to be the Kernel that separates protected inventions from unprotected ones. For an invention to be described as patentable, certain criteria must be used as a measuring line. Thus, it has been stated that, “The test of ‘Patentability’ of a novel design is an affirmative answer to the question: Does it impact to the eyes of ordinary persons, not to those of artists or experts, a pleasing impression?”<sup>13</sup> In the case of *White v Lanbardy Dresses*,<sup>14</sup> it was said that “A dress may be new, original and attractive and yet not be ‘patentable’ unless the faculty of invention is likewise present.” Thus, patentability goes beyond doing something new, to address the aspect of the uniqueness of the thing that is done. There must be something distinct. In *Cuttler Mail Chute Co. v Capital Mail Chute. Corp.*,<sup>15</sup> it was held that “a combination is patentable though the result is old, if the result has been produced in a better way; as in a more facile, more economical and more efficient manner.”

Sometimes it appears that the degree of novelty or invention has to be high whereas in some cases it may not be. For instance, it has also been held that for “patentability”, it is not enough to show that a design is novel, ornamental and pleasing in appearance, but it must be the product of “invention”, which means

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<sup>10</sup>In force 31<sup>st</sup> Day of January 1990, See Revised Edition (Laws of the Federation of Nigeria) Decree 1990.

<sup>11</sup> As Updated May, 2007 under the Authority of Revised Edition (Laws of the Federation of Nigeria) Act, 2004.

<sup>12</sup> They are sometimes used interchangeably, see for Example Orojo, *op.cit.*, at p.1106 where he uses patentable invention to address the same issues addressed in *Boyle v. Rousso*, CC. A. Minn. 16F.2d.666,668. Available in *Words and Phrases* (Permanent Edition) (USA: St. Paul Minn. West Publishing Co., 1957) p.127 as patentability.

<sup>13</sup> See *Boyle v. Rousso*, (*supra*)

<sup>14</sup> D.C NY. 40 F. Supp 216, 217

<sup>15</sup> DC. NY. 31 F. Supp. 254, 263

that conception of the design must require some exceptional talents beyond the range of ordinary designer familiar with the prior art.<sup>16</sup>

In the United States, five conditions for patentability have been identified to include patentable subject matter, utility requirement, novelty requirement, non-obviousness, and adequate description.<sup>17</sup> In Europe, the general requirements for patentability have been summarised as invention, novelty, the presence of inventive step, and the potential for industrial application.<sup>18</sup> In India, the Patents Act of 1970 provides that Patent may be granted for an 'Invention.' An invention is defined in section 2(1)(j) of the Patents Act of India as, "a new product or process involving an inventive step and capable of industrial application." Thus the criteria required are three; new, inventive step, and capable of industrial application.<sup>19</sup> From the foregoing, two core criteria stand out for an invention to be patentable, and they are, "novelty" and "unobviousness,"<sup>20</sup> even though other factors play a vital role in this regard.<sup>21</sup>

#### 4 Patentability in Nigeria

Patentability in Nigeria can be seen from the perspective of substantive requirements and procedural requirements.<sup>22</sup> Substantive requirements for patentability in Nigeria are governed by section 1(1) of Patents and Designs Act (PDA).<sup>23</sup> It provides as follows:

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.

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<sup>16</sup> *Gold Seal Importers v. Morris White, Fashions*, C.C.A. NY, 124 F.2d 141, 142

<sup>17</sup> Quinn, G "Patentability Requirements" available at [www.ipwatchdog.com/patent/patentability-requirements/](http://www.ipwatchdog.com/patent/patentability-requirements/)

<sup>18</sup> Gold, R. and Joly, Y., "The Patent System and Research Freedom: A Comparative Study" available at [http://projectsquared.lboro.ac.uk/the\\_system\\_of\\_p/PID424htm](http://projectsquared.lboro.ac.uk/the_system_of_p/PID424htm) accessed March 7, 2013.

<sup>19</sup> R. Matthew, "Patentability Requirements in India" available at <http://www.lslaw.in/News-and-Publications/Publications/IPR/Patentability-requirements-in-India> Accessed March 7, 2013.

<sup>20</sup> Pressman, *op.cit* p.10

<sup>21</sup> For instance, it has been said that in addition to being novel and unobvious, utility inventions must also be in a statutory class and be useful. See Pressman, *op.cit.*, at p.13

<sup>22</sup> Jegede, E., "Obtaining and Maintaining Trademark, Patent and Design Rights in Nigeria" in Sodipo, B. and Fagbemi, B., *Nigeria's Foreign Investment Laws and Intellectual Property Rights* (London: University of London, 1994) p 109.

<sup>23</sup> CAP P2, Laws of the Federation of Nigeria, 2004.

From the above it is apparent that the core conditions are that the invention must be new, it must be the result of an inventive activity, it must be capable of industrial application and section 1(1)(b) of the PDA provides that improvements upon a patented invention are also crucial at this stage to state that the invention must not be of a kind that is excluded by the PDA. Thus, sections 4(a) and (b) and 5 of PDA exclude plants and animal varieties and biological processes for their production; invention that would be contrary to public order or morality and principles and discoveries of a scientific nature are not regarded as inventions for the purpose of the Act.

It is pertinent to have a broader discussion of each of the above conditions covered by section 1 of PDA.

*i New or Improved Invention*

The PDA itself provides to the effect that an invention is new if it does not form part of the State of the art.<sup>24</sup> Section 1(3) states that 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 or knowledge which has been made available to the public anywhere and at anytime (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 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 exhausted it in an officially recognized international exhibition.

What is manifest from the above definition is the fact that the invention must be such that has not been made available to the public before, except in the form of an officially recognized international exhibition within six months to the application. Although the PDA does not define the word *invention*, the *Blacks Law Dictionary* defines invention as, “any art, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof . . . which is or

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<sup>24</sup> Section 1(2)(a) PDA

may be patentable under patent laws.”<sup>25</sup> The Act makes provision for improvements of an old invention provided it meets the criteria of novelty, inventive step and capability of industrial application.<sup>26</sup> Thus, it has been held that, “Patentable improvement may rest in putting together desirable elements of prior art and making them perform in a new, useful and obvious way, but all improvement that results from combination of old elements is not necessarily inventive.”<sup>27</sup>

## ii *Inventive Activity*

The Act does not define what an inventive activity is, rather it states that an invention results from an inventive activity if it does not obviously follow from the state of the art, either as to the method, the application, the combination of methods, or the products which it concerns, or as to the industrial result it produces. In other words, the invention must go beyond what can be commonly produced. It has been said that “unobviousness is best shown by new and unexpected, surprising, or far superior results when compared with previous inventions and knowledge (“prior art”) in the particular area of the invention”<sup>28</sup> in the sense that it can be manufactured or used in any kind of industry, including agriculture.<sup>29</sup> Some scholars use the term *nonobviousness* to explain this requirement. Thus, *nonobviousness* has been described as the “ultimate condition of patentability” because it requires that an invention represents a significant technological or scientific breakthrough compared to what is already known or doable.<sup>30</sup> The emphasis of the law is that an invention is not just for the selfish aggrandizement of the inventor, but it must have some kind of economic development to the society. As it was held in the case of *Williams Iron Works Co. v. Hughes Tool Co.*,<sup>31</sup> “a new combination of old elements whereby a new and useful result is obtained, or whereby an old result is obtained in a more facile, economical and efficient way is patentable ...”

## iii *Must not be Statutorily Forbidden or Excluded*

This element is very crucial because an invention may be new, distinctive, capable of industrial application yet unpatentable because it falls into the category that is

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<sup>25</sup> D.Garner (ed), *Blacks Law Dictionary*, 7th ed. (USA: West Group, 1999) p.830; see also section 1(2)(b) of PDA

<sup>26</sup> S.1(1)(b),PDA

<sup>27</sup> In re Meyer,123 F.2d 1021,1023,

<sup>28</sup> Pressman, op.cit pp10-11.

<sup>29</sup> Section 1(2)(c) PDA

<sup>30</sup> Fromer, J., “The Layers of obviousness in Patent Law,” May 1,2007, *available at* [jolt.law.harvard.edu/articles/pdf/v22/22HarvJLTech075.pdf+J.Fromer](http://jolt.law.harvard.edu/articles/pdf/v22/22HarvJLTech075.pdf+J.Fromer) accessed March 7, 2013.

<sup>31</sup> CCA OKC 109 F 2d, 500, 506

forbidden by the PDA, or is not recognised as an invention under PDA. Thus, for an invention to be patentable, it is important to double check with the provisions of the Act, whether it is within the statutory class or not. Thus, plant or animal varieties or essentially biological processes for the production of plants or animals, other than microbiological processes and their products, are not patentable.<sup>32</sup> This suggests that microbiological processes for securing plant and animal varieties may be patentable. Thus, a patent cannot be acquired by cross breeding animals or grafting plants because these are all biological processes. However, where micro-biological processes such as taking one plant fluid to combine with another to produce enhanced plant growth (which can be seen as a plant variety) would pass the test of the PDA.

Inventions that are contrary to public order or morality are not also patentable.<sup>33</sup> The Act does not itemize such inventions that can be classified as being contrary to public order or morality. To make it more confusing, the PDA provides further that “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.”<sup>34</sup> Unfortunately, this writer has not yet come across a Nigerian decision that interprets this provision of the PDA. The provision then appears to leave the decision in the hands of the patent officer to use his conception of public order or morality to decide the patentability of the invention. Addressing this issue in relation to the Patent Office (PTO) USA, Pressman said;

In the past, the PTO has again on its own initiative included morality in its requirements. But in recent years, with increased sexual liberality, the requirement is now virtually non-existent. Thus, the PTO now regularly issues patents on sexual aids, gags and stimulants.<sup>35</sup>

The issue of public order and morality has also generated a lot of concerns even in the European countries especially as it relates to what moral standards are to be used. Thus, it has been observed that;

The analysis shows that the moral exclusion scopes differ between these fields and that there is a more narrow moral protection for plant inventions. The broadest protection is found concerning human related inventions. The analysis also shows that the

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<sup>32</sup> Section 1(4)(a) PDA

<sup>33</sup> Section 1(4)(b) PDA

<sup>34</sup> *Ibid.*

<sup>35</sup> . Pressman *op.cit.* at p.99.



human moral exclusion scope is quite uncertain since there are different interpretations regarding this field. The specified moral exclusions under Article 6(2) of the Biotech Directive create uncertainty regarding the moral exclusion. The fact that the biotechnology field is a fast developing area, with large potential for creating medical benefits for human beings, makes it inappropriate to include too specified moral exclusions in the European biotechnology patent law.<sup>36</sup>

Finally, the PDA does not regard principles and discoveries of a scientific nature as inventions for the purposes of the Act.<sup>37</sup> Here, the PDA is silent again on what could be classified as principles and discoveries of a scientific nature. This loophole in the law is likely to lead to some confusion because the fields of discoveries in science are very wide and it is practically difficult to draw a line between a mere scientific discovery and the class of inventions protected by the Act. Sometimes it requires the verdict of a judge based on expert opinion to decipher what can truly be regarded as an invention. In *N.B. PLC v P.B LTD*,<sup>38</sup> the court examined the role of judges and experts on patents when it stated thus;

An obvious imitation of a design in a patent rights infringement is not just what appears obvious at a glance to the uneducated or unskilled eye, but what is obvious to the judge or to the jury with the assistance of expert persons conversant with the particular trade.

In the Nigerian case of *Mobil Producing Nig Ltd. v C.J.A Uwemedimo & Comandclem Nig. Ltd*,<sup>39</sup> where the Court of Appeal held that the patent in the invention called Anti-Corrosive special paint for QIT was vested in Comandclem Nig Ltd., who became the registered patentee from 5/8/99 and that in the absence of a contract transferring the patent to Mobil Producing Nig. Unltd. the right to the patent will still remain in Commandclem Ltd; and any infringement by the respondent or any other person is actionable by the appellant from 5/8/99. Going by the above, would an “Anti-Corrosive special paint” not be classified as “a scientific discovery?”

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<sup>36</sup> Burhöi, A., “Moral Exclusions in European Biotechnology Patent law,” available at <http://biblioteket.ehl.lu.se/olle/papers/0002294.pdf> accessed March 7, 2013.

<sup>37</sup> Section 1(5) PDA

<sup>38</sup> (2010) 14 NWLR pt 1214, p.529, H.5

<sup>39</sup> Suit No. CA/C/6/2003, see generally [commandclemonline.com/legal.htm](http://commandclemonline.com/legal.htm) accessed March 9, 2013.

*iv Must Meet the Procedural Requirements for Registration*

Apart from the substantive requirements on patentability, an application for registration of patent may be turned down if it does not meet the procedural requirements laid down in Section 3 of PDA. The section opens as follows: "Every patent application- (a) Shall be made to the Registrar and Shall Contain...."<sup>40</sup> This section of the law is mandatory because of the use of the word *shall*.<sup>41</sup> The contents of an application are basically the applicant's full name,<sup>42</sup> description of the invention,<sup>43</sup> claim(s),<sup>44</sup> other matters as may be prescribed,<sup>45</sup> and the application has to be accompanied by a fee,<sup>46</sup> declaration signed by the true inventor or a power of Attorney if the inventor is acting through an agent.<sup>47</sup> The PDA contains rules which go further to specify other requirements such as the paper size to be used for the application, the forms for the application among others.<sup>48</sup>

## 5 Conclusion

The big hurdle which an inventor must cross to protect his invention is to fulfill the requirements laid down in law for patentability. Every country has its own laid down conditions for patentability. The focus of this paper was on Nigeria. The paper has traced the origin of patent law from a global perspective and narrowed it to the development of patent law in Nigeria. The paper has also gone further to bring out the issue of patentability from a general perspective to peculiar requirements. It is manifest that the cardinal and widely accepted conditions for patentability is its originality or novelty on the one hand and inventive activity or non-obviousness on the other hand. The other requirements vary according to the statutory requirement of the country in question. This work has brought out the nuances of the conditions for patentability under Nigerian law. Regrettably, there are not many Nigerian cases in this regard. It is thus recommended that there should be some more awareness created about this field of the law including further training of Registrars of Patents to appreciate their role under the PDA. More so, inventors should be encouraged to test decisions of Registrars who turn

<sup>40</sup> S.3(1) PDA.

<sup>41</sup> The use of the word "shall" presupposes a mandatory requirement and it is construed as a condition precedent. See <http://hawaiiappellatelaw.wordpress.com/2009/09/11/statutory-interpretation-is-%E2%80%9Cshall%E2%80%9D-mandatory-or-discretionary/> accessed November 23, 2011.

<sup>42</sup> S.3(1)(a)(i).

<sup>43</sup> 3(1)(a)(ii).

<sup>44</sup> 3(1)(a)(iii).

<sup>45</sup> 3(1)(a)(iv).

<sup>46</sup> 3(1)(b)(i).

<sup>47</sup> 3(1)(b)(ii-iii).

<sup>48</sup> See Orojo *op.cit.* p1109-1111 for fuller discussions on this.

down their applications for registration in Court. This is one sure way of developing case law in this regard.