

INTELLECTUAL PROPERTY LAW ASSOCIATION OF NIGERIA (IPLAN)

RETREAT TO REVIEW BILL NO. 41 VOL. 13 DATED THE 16TH OF JUNE, 2016, FOR AN ACT TO PROVIDE FOR THE ESTABLISHMENT OF THE INDUSTRIAL PROPERTY COMMISSION OF NIGERIA, REPEAL OF TRADEMARKS ACT CAP 436, LFN 1990 AND PATENTS AND DESIGNS ACT, CAP 344, LFN 1990 AND MAKE COMPREHENSIVE PROVISIONS FOR THE TRADEMARKS, REGISTRATION AND PROTECTION OF TRADEMARKS, PATENTS AND DESIGNS, PLANT VARIETIES, ANIMAL BREEDERS AND FARMERS RIGHTS AND FOR OTHER RELATED MATTERS.

PRESENT

Ms. Lara Kayode;	}Chairman
Mr. Femi Olubanwo	}President IPLAN
Mr. Obafemi Agaba	}Vice President IPLAN
Mr. Otu-Ekong Ukoyen	}General Secretary IPLAN
Professor Oyelowo Oyewo	}University of Lagos
Professor Joke Oyewunmi	}University of Lagos
Professor Bankole Sodipo	} G.O Sodipo & Co
Mr. Afam Nwokedi	} Still Waters Law Firm
Mr. Shafiu Adamu Yauri	}Trademark Registry
Ms. Florence Atuluku	} Qais Conrad Laureate
Ms. Chitua Uzoh	} Aluko & Oyebode

COMMENCEMENT

1. The Chairman welcomed all the participants to the Retreat. Thereafter, the each participant introduced himself/herself. ★
2. The President stated that the intention was for participants to isolate themselves from their work schedules and conduct a substantive review of the Bill. The purpose of the review is to ensure that it establishes a modern framework for the protection of industrial property rights, promotes business and facilitates the growth of the economy. The President enjoined participants to review the Bill over the next 2 (Two) days and recommend provisions that are critical to achieving the desired result.

REVIEW OF THE BILL

Part A

Establishment of the Industrial Property Commission

1. Constitution of the Governing Council
 - (a) Section 3 provides for the membership of the Governing Council of the Commission. Section 3(1)(c) provides for the requirement of 2 (two) legal practitioners in private practice with considerable experience in intellectual

property law who shall be members of the Governing Council of the Commission.

- (b) The language of Section 3(1)(c) be revised to ensure that it includes at least 1 (One) legal practitioner from the academia with experience in intellectual property law. The basis for this recommendation is that members of the academia constitute a valuable resource and the Bill should expressly provide for their inclusion in the Governing Council.

2. The Registrar-General of the Commission

- (a) The Registrar-General should represent the face of the Commission and be primarily responsible for its management and administration.
- (b) Section 9(4) should be amended to clarify the nature of the relationship between the Registrar-General and the various Registrars. The following draft was proposed:

“there shall be appointed Registrars of Trademarks, Patents and Designs and Animal Breeders, who shall, subject to the control of the Comptroller-General, have all the powers conferred by this Act on the Comptroller-General and such Deputy Registrars of Trademarks, Patents and Designs and Animal Breeders who shall whenever the applicable Registrar is for any reason, unable to fulfil his obligations, act in his stead”.

- (c) The Registrars should possess the skill and expertise that are necessary to take decisions on the relevant aspects of applications that are processed within their Registries. Furthermore, the decisions of the Registrars should be deemed to be those of the Registrar-General.

3. Immunity

Section 16 confers immunity on members of the staff of the Commission which (i) deters accountability (ii) promotes impunity and (iii) is contrary to best practices. It was therefore recommended that this provision be deleted from the Bill.

4. Industrial Property Appeal Board:

- (a) The function of the Appeals Board as contained in Section 22(1) is limited to determining appeals by aggrieved persons against refusals by a “competent authority” to grant a compulsory license, which is too narrow.
- (b) Sections 21 and 22(1) should be revised to incorporate all decisions of the Registrar-General. The basis for this recommendation is that (i) the quality of the administrative processes and decisions of the various Registries within the Commission will be enhanced if they are subject to appeals to Board that can reverse the decisions of the Registries (ii) members of the public are likely to patronise the a quasi-judicial tribunal such as an Appeals Board thereby decongesting the Courts (iii) the decisions of the Appeals Board will strengthen

the existing jurisprudence on industrial property administration in Nigeria. The following draft was proposed:

There shall be established an Industrial Property Appeal Board. An appeal shall lie from any decision of the Registrar- General or Competent Authority under the Act to the Appeal Board. For this purpose, decision includes any act of the Registrar-General or competent authority in the exercise of discretion vested in him or the authority under this Act.

- (c) In order to enhance the quality of the decisions of the Appeals Board and enable it discharge its functions efficiently and effectively the Appeals Board should (i) comprise of legal practitioners and professionals with significant experience in intellectual property laws and not merely members of the Nigerian Civil Service and (ii) be independent of any form of control, influence and interference by the Registrars and or the Registrar-General of Commission.
- (d) With regard to the appointment and constitution of the Appeals Board as contained in Section 22(2) (i) the appointments should be done by the Governing Council of the Commission (ii) if for any reason a Governing Council is not constituted, by the Minister and (iii) there should be a total of five panels within the Appeals Board consisting of three members each. The following draft was proposed:

“The Appeals Board shall consist of a Chairperson and not less than 3 (three) and not more than 15 (fifteen) other members appointed by the Governing Council of the Commission and if for any reason a Governing Council has not been constituted, the by the Minister, on a full time basis”.

- (e) Subject to any constitutional issues that may arise, appeals from the decision of the Appeals Board should lie to the Court of Appeal.

Part B

Trademarks

1. Definitions

- (a) The definition of “*a mark*” in the definition section of the Bill (Section 188) is narrow and should be expanded, in accordance with international standards. The following draft was proposed:

“A mark is a sign which includes the following or any combination of the following, namely any letter, word, name, signature, numeral, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent which is capable of being represented graphically or in any manner which enables the registry and the public to determine the clear and precise subject matter of protection afforded to the proprietor”.

- (b) The definition of “*a trademark*” is also narrow and should be expanded in accordance with international standards. The following draft was proposed:

“A trademark means a mark used, or proposed to be used, in the course of trade in relation to goods or services capable of distinguishing the goods or services of one undertaking from those of other undertakings. References in this Act to a Trademark include, unless the context otherwise requires, references to a collective mark or certification mark”.

- (c) The definition of “*Certification Mark*” should be amended and the following draft was proposed:

“A certification means a mark registered or deemed to have been registered under Section 71”.

2. Registration of a Sign or Combination of Signs:

- (a) All references to “*signs*” in Section 30(1) and all other sections of the Bill should be replaced with “*mark*”.
- (b) The definition of a “*well-known mark*” in Section 30(4)(e) should include a reference to Section 32(3).
- (c) A new provision should be included as Section 30(4)(f) to indicate that pseudo names, nicknames, individual or group names, aliases, likeness, except with the consent of the owner(s), its/their heirs or successors shall not be registrable as a trademark in Nigeria.
- (d) In view of the proposed definitions of “*mark*” and “*a Trademark*”, the entire provision in 30(5) should be deleted.
- (e) Section 71 refers to a schedule which was not attached to or incorporated in the Bill. This will need to be rectified.

3. Rights Given by Registration:

- (a) Section 39 which provides for distinctiveness required for registration should be relocated to the first part of Section 31 for good order.
- (b) Section 31(4) which provides for conditions or limitations which shall not cause the use of a trademark to be unjustifiably encumbered by special requirements, such as use of another trademark, use in a special form or manner detrimental to its capacity to distinguish the goods or services from one undertaking etc., should be deleted.

4. Identical Marks:

- (a) Section 40 (1) provides for non-registration of identical marks. For the purpose of clarity, it was recommended that the provision be deleted and replaced by Section 13(1) of the current Trademark Act Cap 436, LFN 1990 which is clearer.
- (b) Section 40(3) should include a third course of action i.e. the Registrar shall either publish both applications for opposition or refuse to register any of them, until the rights of the proprietors have been determined by a Court or have been settled by agreement.

5. Well Known Marks/Section 32:

- (a) “*Well-known marks*” should be defined in Section 32(1).
- (b) Section 32(2) should address the requirements for registration of well-known marks.
- (c) Section 32(1) should be relocated to Section 32(3).
- (d) Section 32(2) should be relocated to Section 32(4).

6. Section 33: The reference to “*Appeal Board*” should be deleted and replaced with “Court”.

7. Section 34:

- (a) Section 34(2) should be amended to authorise the applicant “and or his solicitor”.
- (b) Section 34(2) (c) should be amended to include inspection and or seizure of any and all documents.
- (c) Section 35(2) should be amended as follows: “...shall designate the mark as a collective mark and shall be accompanied by a copy of regulations governing...”

8. Section 36: The protection of unregistered tradenames is not in the interest of the Commission and or the general public. Consequently, the section should be deleted.

9. Section 41: The section refers to Section 64 instead of section 61. The erroneous reference should be addressed.

10. Section 44:

- (a) The Ghanaian Trademark Act, Ugandan Trademark Act and the Singaporean Act contain appropriate definitions of “*Geographical Indicators*” that should be adopted for the purpose of this Section. The said definition must also include agricultural products, natural products and products of handicraft.

- (b) A new sub section should be included under Section 44 that will provide for the registrability of Geographical Indications.
 - (c) A sub section should be included under Section 44 that will provide for a Register for Geographical Indications.
 - (d) A provision should be included to the effect that the Registrar-General shall make regulations for the registration of Geographical Indicators.
11. Section 46:
- (a) Section 46(3) should be deleted.
 - (b) The right of appeal under Section 46 should be amended to include the option of either the Appeals Board or the Court.
12. Section 47: Section 47 includes an erroneous reference to Section 38. The correct reference should be Section 40.
13. Section 48:
- (a) Section 48(1) contains typographical errors that need to be addressed.
 - (b) The proposed expansion of the opposition period from 2 months to 3 months will unduly delay the opposition process given the peculiarities in Nigeria. The current period of 2 months is adequate and should be retained.
 - (c) Section 48(1) contains an erroneous reference to Section 45 instead of Section 47, which needs to be addressed.
 - (d) Section 48(3) should be amended and the following draft was proposed:

“the Opponent shall personally serve a copy of the Notice of Opposition on the Applicant within 2 months from the date of publication of the Trademark Journal and shall within 14 days of such service, deposit a sworn affidavit of service at the Trademark Registry. It was also recommended that in the event of failure to comply with Section 48(3), the opposition will be deemed abandoned”.
 - (e) The basis for the recommendation is that (i) under the current system, the Commercial Law Department of the Ministry of Trade is responsible for serving opposition processes, which is at a cost (ii) the Commercial Law Department is notorious for delays in effecting service and (iii) if the responsibility is transferred by Statute to the parties with clear timelines and penalties for non-compliance (as proposed) delays should be eliminated and costs will be saved by the Commercial Law Department.
 - (f) Section 48(4) should be amended and the following draft was proposed:

“The Applicant shall serve his counterstatement on the Opponent within two months of receipt of the Notice of Opposition and shall within 14 days of such service, deposit a sworn affidavit of service at the Registry. It was also recommended that the new period of two months for filing and serving counter statements is practical but should not be subject to extension in order to avoid unduly prolonging the opposition process”.

14. Section 49:

- (a) Section 49(1) contains an erroneous reference to Section 45(4) instead of Section 48(4).
- (b) Section 49(4) contains an erroneous reference to Section 46 instead of section 48.
- (c) The right of appeal under Section 49(2) should be revised to include an option of the Appeals Board or the Court. It was also recommended that the reference to "Registrar" should be revised to indicate "the parties".

15. Section 51: The validity period of trademark registrations should be revised from 7 years to 10 years in compliance with TRIPS. Terms for renewal of registration should be revised from 14 years to 10 years.

16. Section 52:

- (a) Section 52(2) contains an erroneous reference to Section 62(2) instead of Section 64(2).
- (b) Section 52(3) contains an erroneous reference to Section 54 instead of Section 56.
- (c) Section 53(2) contains an erroneous reference to Section 54 instead of Section 56.

17. Section 58(2): Section 58(2) contains an erroneous reference to Section 64 instead of Section 66.

18. Section 59:

- (a) Section 59(1) contains an erroneous reference to Section 82 instead of Section 84. It was recommended that the reference to Court should be revised to indicate the “Appeals Board”.
- (b) The current period of 5 years for non use is in line with international standards and should be retained as opposed to the proposed period of 3 years.
- (c) The reference to “Tribunal” in Section 59(3) should be deleted.

- (d) Section 59(3) (a) contains an erroneous reference to Section 39 instead of Section 40.
- (e) The reference to “*any proprietor*” in Section 59(3) should be revised to “*the proprietor*”.

19. Section 60:

- (a) Section 60(1) contains an erroneous reference to Section 59 instead of Section 56.
- (b) Section 60(3) contains an erroneous reference to Section 54 instead of Section 56.
- (c) Section 60(4) contains an erroneous reference to Section 82 instead of Section 84.

20. Section 61:

- (a) Section 61(2) (b) line 4 contains a typographical error. It was recommended that the reference to “use” should be revised to indicate “user”. It was also recommended that registered users under this section should be renewable subject to the terms of the agreement between parties.
- (b) Section 61(3) contains an erroneous reference to Section 56 instead of Section 59.

21. Section 62:

- (a) Section 62(2) line 7 contains a typographical error. (Registrar instead of Registrar).
- (b) Section 62(8) should be subject to payment of prescribed fee.
- (c) Section 62 to 68 should indicate Appeals Board as the forum and cross referencing should be addressed.

22. Section 63: The reference to “Tribunal” in Section 63(1) should be revised to indicate “Registrar” from tribunal's

23. Sections 93 to 99:

- (a) Section 93 should include a provision that the applicant may apply to the Attorney-General for a fiat to prosecute the matter. The section also contains a typographical errors that need to be addressed.
- (b) The penalties contained in Section 97 were insufficient in view of the current realities. It was therefore recommended that imprisonment for a term of 1 to 3 years and or an increase in the fine of up to 10 million naira be considered.

24. Section 72(1): Section 65 of Kenyan Trademark Act be adopted for this provision.
25. Section 73: Section 73 should provide for reclassification.
26. Section 101:
 - (a) The Registrar should publish Trademark Journals on a monthly basis. The basis of this recommendation is to address the constant backlog of applications that are awaiting publication at the Commercial Law Department and generate revenue for the Commission through processes that follow publication of trademark applications.
 - (b) Section 101 should also contain an option of publishing Journals via electronic means. This will significantly reduce the cost of publishing journals on paper. Electronic publication of journals will also align with current global practices.
27. Finally, unique architectural trademarks should be protected under the Bill.

Part C

Patents and Designs

1. Section 105(1) (c) should be revised to indicate what exactly is to be registered.
2. Section 105(5) should be revised to incorporate Sections 41 (amounts of compensation payable) and 42 (enforceability of contracts relating to employees inventions) of the United Kingdom Patent Act of 1977.
3. In order to facilitate ease of filing and administration, it was recommended that Section 107 should be revised to provide for the establishment of State offices with a Head Office domiciled in Abuja.
4. Section 107(4) should be revised to change the reference of “Patent Registrar” to “Registrar-General”. This recommendation is also applicable to to Section 109(a).
5. Headings and side notes should be revised to accurately reflect the content of the applicable sections of the Bill.
6. Section 105:
 - (a) Section 105(c) should be clear as to the element(s) of computer programme that is/are not patentable.
 - (b) Section 105(5) (b) – It was recommended that reference to section 1(4)(a) of our current Patent Act.
7. Section 107(4): the official seal should be owned by the Registrar-General.

8. Section 109:
 - (a) Under Section 109(a), patent applications should be made to the Registrar-General.
 - (b) Section 109(4) (c) should refer to international conventions that are applicable to Nigeria.
 - (c) The inclusion of patents granted on the basis of foreign applications in Section 109 (5) (b)(ii) is not practical and should be deleted.
9. Section 110(2): The word “may” should be revised to “shall”.
10. Section 110(3): The section contains an erroneous reference to Section 105(4) instead of Section 109(4).
11. Sections 122 to 133: The heading (Layout Designs) is required for Sections 122 to 133.
12. Section 136: The heading (Utility Models) is required for Section 136.
13. Section 142: Remuneration for the purpose of fair compensation should be tied to the value of the invention as opposed to the salary of the employee.
14. Traditional Knowledge: Provisions on disclosure and remuneration as contained in the South African Act and Indian Act should be included in the Bill.
15. Section 141: This section is superfluous and should be amended.
16. Finally, it was recommended that all the exceptions contained in the WTO should be imported.

Part D

Plant Varieties and Animal Breeders

1. Exceptions: It was noted that the Bill does not contain exceptions to the legal rights established under Section 186. This can be redressed by incorporating the provisions contained in Section 23(6) of the South African Act (public interest exceptions) and the relevant provisions contained in the Indian Act.
2. Section 175: It was noted that the requirements for registration do not include a provision for newness, which is contrary to international and best practices. The provisions contained in the DOHA Law and UPOV may be incorporated in this section of the Bill.

Otu Ukoyen
General Secretary
Intellectual Property Law Association of Nigeria