

Challenges to Effective Legal Protection of Industrial Designs in Nigeria

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Abstract

Industrial designs are primarily those elements incorporated into mass produced products that aim to enhance their attractiveness by their appearance. The primary objective of the law governing industrial design is to protect a design that is new or essentially better in some ways than what was created before. Despite the importance of the law governing industrial design and the protection of infringement of industrial design in Nigeria, it is however very sad that the rate of infringement of industrial design is on the increase. This is due to the fact of some challenges to effective legal protection of industrial designs in Nigeria. In this paper we will be looking at the meaning of industrial design, when an industrial design will be deemed registrable, non registrable designs, categories of persons who may apply to register an industrial designs, duration and renewal of industrial designs, extent of the right/protection conferred upon the proprietor of an industrial design, challenges to effective protection of industrial design and the recommendations on how to tackle these challenges.

Introduction

A design is aspects of or features applied to an article; it is not the article itself¹. In normal usage the word design can be taken to mean a plan or scheme, which may be written or drawn, showing how something is to be constructed, or how the elements of an item or article are arranged. In the legal terms, a design is defined by reference to the provisions applicable to either the registered design or the design right, as appropriate.

Industrial design is any combination of lines or colours or both and any three dimensional form, whether which is intended by the creator to be used as a model or pattern to be multiplied by industrial process and not intended solely to obtain a technical result².

Industrial designs are primarily those elements incorporated into mass produced products that aim to enhance their attractiveness by their appearance³.

The primary objective of the law governing industrial design is to protect a design that is new or essentially better in some ways than what was created before. This protection is of immense importance to artists, lace designers and designers of other type of products. When goods are similar, designs becomes an important distinguishing factor.

In this paper, we will be dealing with when an industrial design will be deemed registrable, non registrable designs, categories of persons who may apply to register an industrial design, duration and renewal of industrial designs, extent of the right/protection conferred upon the proprietor of an industrial design, challenges to the effective protection conferred upon the proprietor of an industrial design and the recommendations on how to tackle these challenges.

When will an industrial design be deemed registrable?

The Act sets out conditions under which an industrial design will be deemed registrable. Section 13(1) Patent and Designs Act¹ provides that subject to this section, an industrial design is registrable if:

¹ Clark's Design [1896] 13 R.P.C. 351, Per Lindley L.J

² Section 12 **Patents and Designs Act** Cap. P2 Law of the Federation of Nigeria 2004

³ F.O. Babafemi: **Intellectual Property in Nigeria**; Justinian Book Limited: Ibadan ; 2007; p.412

- (a) it is new, and
- (b) it is not contrary to public order or morality.

The design to be registrable must be new and this means that it has not previously been registered or published in Nigeria prior to the date of application for registration.

On the definition of what is new and original Duckley L.J. in the English case of **Dower Limited v Numberger** said:²

The word “original” contemplates that the person has originated something that by exercise of intellectual activity he has started an idea which has not occurred to anyone before that a particular pattern or shape or ornament, may be rendered applicable to the particular articles to which he suggests that it shall be applied. If that state of things be satisfied, then the design will be original although the actual pattern or shape or whatever it is which is being considered is old in the sense that it has existed with reference to another article before. The word “new or original” involves the idea of novelty either in the pattern, shape or in the way in which an old pattern, shape or ornament is to be applied to some special subject matter.

In the case of **F. O. Ajibowo Co. Ltd v Western Textiles Mills Limited**³ which came up before Court the issue of “publication” was fully considered and applied. In this case, the plaintiffs/respondents, a limited liability company, were textile manufacturers. The defendants/respondents, also a limited liability company dealt in textile piece goods and were the customers of the respondents.

After they had been incorporated on 15th November 1972 the appellants acquired all the rights, benefit and title in respect of a textile check design, known as K13/14 Registration No. 0003441. The design had been previously registered in the name of Francis Ajibowo & Co. who was issued with a certificate of registration dated 30th December 1971 by the Registrar of Patents and Designs.

Earlier, on 13th August 1971, Francis Ajibowo & Company (the appellants predecessor in title of the design) ordered 10,000 yards of designs from the respondents. The respondents accepted the order by the appellants, but, according to the respondents took delivery of only 7,774 yards of the said order, refusing to clear the balance of 2,226 yards despite repeated requests from the respondents to do so. Because of this, a second order by the Francis Ajibowo & Co. for another 10,000 yards of the same new design, booked by letter dated 23rd October 1971 was not executed. As has been pointed out earlier Francis Ajibowo & Co. registered the design just over two months later on 30th December 1971. They transferred the registered design to the appellants after their incorporation on 15th November, 1972.

On 13th August, 1972, that is ten months after they had rejected the second order of Francis Ajibowo & Company, the plaintiff applied to the Registrar of Patents and Designs for the registration of the same design which had already been registered by Francis Ajibowo and Company. The design was again registered for the plaintiffs. Later however when it was discovered that the design had been registered for another company, the plaintiff's registration was cancelled by the Registrar.

On 24th March 1973 the respondents, no doubt, angered by this decision instituted proceedings against the defendants/appellants in the Lagos High Court seeking inter alia, a declaration that the design registration No. 000344 effected in the name of Francis Ajibowo & Co. is null and void.

The Lagos High Court found in favour of the respondents and held that:

- (a) That registration of Design No. 000344 effected on 30th December 1974 in the name of Francis Ajibowo & Company Limited is hereby declared null and void. The Registrar of Patents and Designs shall forthwith cancel the registration and expunge it from the registrar.
- (b) The design was published before it was registered and was therefore not new. It violated the provisions of section 13(1)(a) and is not registrable under section 22(1)(b) of the Patents and Designs Decree.

The learned trial judge said:⁴

¹ Cap. P2 Laws of the Federation, 2004

² [1910] Ch. D.25 at p. 29

³ [1976] 7 S.C. 97

⁴ Ibid at p.106-107

I am satisfied that the material ordered by Mr. Ajibowo was made to the design in Exhibit 1 which is the subject matter of this action. There is no direct evidence that Ajibowo sold the quantity of the material he took delivery of to the public but I am satisfied that since he is a trader, he ordered the material for sale and he must have sold the quantity to the public..... Considering the evidence before me I have found that the Defendant's predecessor in title, Mr. Ajibowo placed order for a quantity of material to be made to the design in August 1971, and part of which order he received and sold to the public. By his default the plaintiffs were forced to sell the balance of that quantity to their customers who as traders would sell them to the public. It was after this that Mr. Ajibowo applied and registered the design in December of that year. I therefore hold that there has been publication of the design before its registration and it is not therefore new.

Unanimously upholding the appeal of the defendants/appellants the Supreme Court stated that the plaintiffs/respondents relied on three types of prior publication viz:

- (i) Publication of the design to them by the defendants/appellants
- (ii) Publication to the 3rd and 4th plaintiffs' witnesses.
- (iii) Publication by presumed sale by the defendants/appellants after they had purchased the textile materials from the plaintiffs/respondents.

The Supreme Court of Justices were however of the view that there was no proof or publication in the instance case in any of the above and went on to hold:

- (a) The law is that the publication of an industrial design is confidential if the person to whom the disclosure is made is under an obligation as to secrecy or has himself an interest in the design.
- (b) The onus is on the plaintiffs/respondents to prove prior publication and this they have failed to do.

Fatai – Williams J.S.C. said, *inter alia*¹

In the first place, before a sale could amount to publication under the Decree, there must be evidence that the sale by the Defendants/appellants, assuming that they did at all, was before registration. There is clearly no such evidence. Secondly, it does not follow that because they have bought the textiles manufactured from the design they must have sold it since it is equally possible, there being no evidence of any sale to any particular individual, that none of what the plaintiffs/respondents sold to them in August, 1971 was resold before registration of the design on 30th December, 1971. The finding that they must have sold the textiles containing the design before registration and that they had thereby published the design, is clearly a non sequitur...

The appeal was accordingly allowed.

In **Controlled Plastic Limited v Black Horse Plastic Industries Limited**² the plaintiff who was a manufacturer of plastic materials registered one of his products, large colander as a design under the Patents and Designs Act of 1970 and obtained a Certificate of Registration. The plaintiff alleged that sometime in 1989 the defendant infringed his design and brought this action claiming damages and injunction. At the hearing however, the defendant argued that the design of the plaintiff was not registrable because it was not original or new.

Giving judgment for the plaintiff, Ezekwe, J. said:

.... I am also of the view that the plaintiff's design is original or new. There is no other design that was placed before me in order to compare whether the design of the plaintiff was new and/or original.... What is before me is Exhibit A, A1 and I am satisfied that the large colander of the plaintiff which is duly registered is new or original....

In **Sunday Uzokwe v Densy Industries (Nig) Ltd & Anor**³ the issue was whether the design was new at the time it was registered, in compliance with the requirements of Section 13(1)(a) of the Patents and Designs Act. The case of the appellant at the trial was that he is the registered owner of the Design 4464 in respect of Kitchen plastic. He claimed that at the time of the registration of the design in March 1991 it was a new design which he

¹ Ibid at p.116

² [1990] F.H.C.L.R. 180; **Dover Limited v Numberger** [1990] 2 Ch.25

³ [2002]M.J.S.C.37: **Kodilinye v Odu** 2 W.A.C.A.331;**Jules v Ajani** [1980]3- 7 S.C. 96 AT 108; **Metropolitan Industries(Nigeria) Limited v Industrial Application (Nigeria) Limited** [1973] I N.M.L.R.274

created. He stated the production of plastic containers after the registration of the design. However, he discovered shortly after the registration that his right had been infringed by the respondents. The 1st respondent however countered that the design was not new and that the appellant was in fact not the creator of the design.

The respondent further said that it was a common design which was available in the market and which has been produced before the registration of the appellant's design. The 2nd respondent also denied newness of the design.

The learned judge found in favour of the appellant and awarded ₦10,000.00 damages against the respondents. The appeal of the respondents to the Court of Appeal was successful. The appellant being dissatisfied with the judgment of the Court of Appeal appealed to the Supreme Court, affirming the judgment of the Court of Appeal, Ogwuegbu J.S.C. who read the leading judgment of the Supreme Court said:

I am satisfied that the learned trial judge was in error in coming to his conclusion that the two products are similar and produced from one design by mere cursory perusal of the external appearance of Exhibit 2 and Exhibit 5. Similarity of design has nothing to do with its novelty or distinctiveness. A claim for an infringement of rights in design cannot be sustained merely because the infringing product is similar to that of the plaintiff. More is required from the plaintiff bearing in mind the provisions of Section 1 of the Act. The earlier observation of the learned trial judge that owing to the absence of the design for Exhibit "S" is sound but he derailed when he proceeded to compare the finished products as against the designs from which they were produced.

Also the design to be registrable, it must not be contrary to public order or morality. Public order or morality must be deemed to cover such matters as good government, the administration of justice, public services, national economic policy and the proper interest of the state and society.

Accordingly, an industrial design must not run contrary to the attainment of the above objective.

Non Registrable Designs

The Act does not state specifically which designs should be excluded for registration. The following should however be excluded:

- (a) works of sculpture other than casts or models used or intended to be used as models or patterns to be multiplied by an industrial process
- (b) wall plaques and medals
- (c) printed matter primarily of a literary or artistic character, including book jackets, calendars, certificates, coupons, dressmaking patterns, greeting cards, leaflets, maps, plans, post cards, stamps, trade advertisement, trade forms and cards transfers and the like

Categories of Persons who may Apply to Register an Industrial Design

(1) Statutory Creator: Section 14(1) Patents and Designs Act¹ provides that the right to registration of an industrial design shall be vested in the statutory creator that is to say, the person who, whether or not he is the true creator, is the first to file, or validly to claim a foreign priority for an application for registration of the design.

(2) Persons who employ or commission others to create a Design: Section 14(4) Patents and Designs Act² provides that where an industrial design is created in the course of employment or in the execution of a contract for the performance of specified work, the ownership of the design shall be vested in the employer or, as the case may be, in the person who commissioned the work.

(3) Persons to whom the design has been assigned: Section 24(1) Patents and Designs Act³ provides that a person's rights in a patent application in an application for the registration of a design, in a patent or in a registered design may be assigned, transferred by succession or held in joint ownership.

¹ Cap.P2 Laws of the Federation 2004

² *Ibid*

³ *Ibid*

(4) Persons to whom a contractual licence has been granted: Section 23(1) Patents and Designs Act¹ provides that:

- (a) a patentee or design owner may by a written contract signed by the parties grant a licence to any person to exploit the relevant invention or design; and
- (b) in the absence of any provision to the contrary in the contract, the licensee shall be entitled to do anywhere in Nigeria in relation to the patent and design any of the acts mentioned in Sections 6 or 19 of this Act² as the case may be³.

Duration and Renewal

The registration of an industrial design shall be effective in the first instance for five years from the date of the application for registration; and on payment of the prescribed fee, for two further consecutive periods of five years.

Extent of the Right/ Protection Conferred Upon the Proprietor of an Industrial Designs

The registration of an industrial design confers upon the proprietor the right to preclude any other person from doing any of the following acts:

- (a) reproducing the design in the manufacture of a product.
- (b) Importing, selling or utilizing for commercial purposes a product reproducing the design and
- (c) Holding such a product for the purpose of selling it or of utilizing it for commercial purpose⁴.

In **Sumal Foods and Confectionary Limited v Wholesome Processing Co. Ltd**⁵ the plaintiffs who were manufacturers of the chewing gum marketed under the trademark “TWIST” alleged that the defendants also later began to produce a chewing gum, using similar label as that of plaintiff and called it “TOOTSIE”, thus infringing their registered design. The plaintiffs also alleged that when they called the attention of the defendants to the infringement, they changed their label but when they could not make a good sale under the new label, they reverted to the offensive label, hence this action. The defendants however, totally denied the said infringement of the plaintiffs’ design.

Upon reviewing the evidence before the court, the court upheld the plaintiffs’ claim of infringement against the defendants.

Ezekwe, J. said inter alia⁶.

The question of whether the alleged infringed design is or not an infringement of the registered design is a question of fact and like the question of novelty can only be decided by the eye, the function or object which the article may fulfill being immaterial. The question is this, has the alleged infringement substantially the same appearance as the registered design? In order to ascertain what the registered design is so that it may be compared with the alleged infringement, it is necessary to examine the picture or pictures of the article attached to the certificate of registration, and an actual manufactured article embodying the design may also be looked at. It is necessary to see what the essential features of the design are and if the essential features have not been taken there will be no infringement.

In **Sarg Aims Aluminum Products Limited v Stanley Akagha & Anor**⁷ the plaintiffs claimed that the defendants had breached their exclusive right to the production, manufacture and marketing of the products carried under the certificate of registration of design issued to them. In upholding the plaintiffs’ claims that the defendants had copied the designs from their own almanacs into the defendants almanacs Egbo – Egbo, J. said inter alia:

¹ *Ibid*

² **Patents and Design Act** Cap. P2 Laws of the Federation 2004

³ Section 20 (1) **Patent and Designs Act** Cap. P2 Laws of Federation 2004

⁴ Section 19 (1) *Ibid*

⁵ [1990] F.H.C.L.R. 143

⁶ *Ibid* at p. 161

⁷ [1994] F.H.C.S.188

It is my duty from the above findings to delve into the second issue for determination which is whether such statutory rights of the plaintiff have been infringed by the defendant. A convenient starting point is the issue of Almanacs, Exhibits D – D1, which are pleaded in paragraphs 10, 11, 12 and 16 of statement of claim and paragraphs 9 and 12 of the statement of defence respectively. Here issues were joined as defendant said its Almanacs was not copied from the Almanacs of the plaintiff. Since both Almanacs were tendered in evidence it is for me first and foremost to look at Exhibits D – D1 to decide whether they are similar. PW1 in his evidence in chief had meticulously indicated some examples in Exhibit D1 which were similar to his products in Exhibit D. To quote him, he said prime steel casement window in Exhibit D was the same as casement window in Exhibit D. That there were 14 items of the dimensions in each case. Also Bonsue Revolving Door in Exhibit D was the same as Tropical Hinge Door in Exhibit D. There were 6 items of the same dimensions in each case.

In fact after my visual examination of both Exhibits D – D1, I discovered that the evidence of PW1 was very truthful. The items were of the same dimensions and number as above stated by PW1, the only difference was in name. If this is placed side by side with the fact that plaintiff started production in the products in 1990 when he obtained Exhibits B – B1, that 1st defendant worked under the plaintiff from 1989 to 1991 when he left to found 2nd defendant in 1992, it will be inferred rightly that it was the defendant who copied from the plaintiff. I do hold here that it is true that the defendant copied what was in plaintiff's Almanacs in Exhibit D into its own Almanacs Exhibit D1.

Challenges to the effective protection conferred upon the proprietor of an industrial design

(1) **Statutory Problems:** The patent and Designs Act¹ have not undergone any amendment since its inception. This is not an encouraging thing. The Act is not exhaustive in its provisions. There are some lacuna in its provisions. As a result, some of the problems associated with industrial designs were not addressed. One of the obvious features of the Act is the lack of precision in many sections of the Act. For example Section 12² which defined Industrial Design was not clearly defined. The definition of the term “industrial design” is so long and winding, with punctuation that its meaning is lost in verbiage.

Another issue is Section 13(a)³ dealing with registrable design, the provision is not clear on when a design is new and not contrary to public order or morality. Another issue is Section 14(1)⁴ which provides that the right to registration of an industrial design shall be vested in the statutory creator that is to say, the person who, whether or not he is the true creator, is the first to file, or validly to claim a foreign priority for an application for registration of the design.

From the foregoing provisions, it is quite clear that the first to file a claim obtains a right to register one would thought that this section creates a room for fraud.

Another area of the section that deserve mention is the issue of remedies for infringement of industrial designs. It is clear from the analysis of the remedies for infringement of industrial designs, that the Act⁵ does not represent a serious attempt at providing remedies for those whose rights are infringed. This is a serious lacuna, more so, when the Act does not expressly authorize reliance on the English or common law for support. It is therefore arguable whether it is right for the Nigerian Courts to rely on the remedies available under the common law as a matter of course without even seeking to rely on any indigenous statutory provision to that effect.

From the foregoing issues examined above and others, we can rightly say that some provisions of the Act are ambiguous and that there are some lacuna in the Act which in no small way are challenges to effective protection of industrial design in Nigeria.

(2) Enforcement Problems

This is also one of the challenges to effective industrial designs protection in Nigeria. The pace of judicial proceeding is slow. The enforcement of industrial designs as well as other branches of intellectual property is the

¹ Cap.P2 Law of the Federation 2004

² **Patents and Designs Act** *Ibid*

³ *Ibid*

⁴ *Ibid*

⁵ *Ibid*

exclusive preserve of the Federal High Court. The Federal High Courts is not in all 36 states of the federation. This always poses a problem to lawyers and the litigants who are constrained to travel to another state to institute their actions.

The Nigerian judiciary is bedeviled with manpower and infrastructural constraints such as insufficient number of judicial officers, poor record management facilities, absence of research assistants for presiding officers of court and the non availability or insufficient court halls to mention but a few. Also the recurrent remuneration related crisis in the judiciary nationwide has impacted on the pace of judicial proceedings before the courts in Nigeria.

On the other hand, there is no effective alternative dispute resolution mechanisms. Even though, there are three centers or institutions for alternative dispute resolution in Nigeria, that is, two in Lagos and another in Abuja. It still have not really help the situation, as the entire process is cumbersome.

(3) Societal Problems

Societal problems have also posed a challenge to effective protection of industrial design in Nigeria. There are many problems in the society which have influence the society negatively. There are:

- (a) **High Rate of Illiteracy:** In Nigeria where a lot of people are becoming literate, we still have large number of illiterates, this in turn is a challenge to effective protection of industrial design. The illiterate design owners whose designs have gained reputation may not even know when their design are infringed. Even, when they find out that their designs are infringed, may resign themselves to fate and do nothing.

On the other hand, an illiterate customer may not be able to differentiate the registered design from the infringing one.

As a result, the infringer will continue to perpetrate their fraud without the intervention of the law enforcement agencies and regulatory bodies.

- (b) **Corruption:** corruption in the form of bribery influences outcomes of the legal and statutory process. Bribes can alter outcomes of the legal and regulatory process. Corruption has been largely responsible for the close to nil ratio of final judgments in criminal cases that is, almost none has been competently concluded.
- (c) **Lack of Awareness:** Awareness have not much been canvassed in respect of this area of law and as such people are ignorant about this area of law. As such infringers take advantage of this public ignorance against the public.
- (d) **Greed and Poverty:** The rate of poverty in the country has also hindered the protection of industrial designs in Nigeria. People tend to use all kinds of means to make money including imitating other peoples design.

Greed among Nigerians is on the increase. An average Nigerian wants to be a Billionaire over night. As a result, people indulge in duplicating other peoples work.

(4) **Inefficient system of registering industrial designs:** Industrial designs as a form of property is protected by registration. The main purpose of registration is to afford industrial design owners consistent and predictable protection.

The registrar of Patents and Designs is the officer in charge of registering designs and there is a register in which industrial designs are registered. The system of registration is inefficient for example, inability to process applications timeously and efficiently.

Another issue is that of electronic registration. Registration of industrial designs cannot be conducted electronically. If a prospective design owner is desirous to register a design, he must go to Abuja, where the

Registrar's office is situated. This is very cumbersome and posed a challenge to effective protection of industrial designs.

(5) Inefficiency of Governmental Agencies: there is no statutory body to regulate industrial designs in Nigeria and as such the governmental agencies charged with the responsibility of regulating industrial designs do not do much. There is no adequate machinery to enable these agencies work effectively. For example, the agencies are not provided with vehicles to enable them move from one place to another to fish out infringers. Also they are not adequately funded. These bodies are not provided with fund to enable them work effectively. They also lack manpower. As a result of this, they do not function effectively.

(6) Inadequate Infrastructure: The basic infrastructure needed for the effective protection of industrial designs in Nigeria is not only grossly inadequate but also, appears to be non-existent. The problem of poor communication network has adversely hindered the protection of industrial design. The Nigerian Telecommunications Limited (NITEL) is no longer functional. Also, the introduction of Global System Communication in Nigeria (GSM) has not really help the situation, as there are still lapses in the efficiency of the communication system.

The means of transportation, particularly the roads, railways and air also contribute to the inefficiency of the governmental agencies. The railways are no longer in existence. The roads are in bad shape and in dire need of reconstruction or rehabilitation as the case may be. Due to the poor state of the roads, governmental agencies hardly perform their functions. The airlines are not left out, as the aviation industry has consistently witness dismal performances with little or nothing to show for its existence.

The power and energy situation in the country is very alarming. The much-talked about transfer of technology, has remained a mirage in the face of epileptic power supply in the country. This equally has devastating effects on the economy.

Absence of other infrastructure like buildings, also hinder the governmental agencies from working effectively.

(7) Lack of proper records of registered industrial designs: There are no proper records of all the registered industrial design in Nigeria. The Registrar does not keep data base form of all the registered designs. As a result of this, the Registrar may inadvertently register a design that is similar to the one that is already registered.

Recommendations

The government should provide basic social amenities and infrastructure, as this will bring about a conducive atmosphere for these agencies to operate.

The system of registration of industrial designs in Nigeria should be computerized for easy access.

There should be a mandatory continuing legal and technological training of agency officials, law enforcement officials and the judiciary.

There should be periodic review of existing legal provisions and rules relating to industrial designs with a view to identifying and addressing perceived weakness and gaps.

There should be coordination and cooperation among relevant government agencies. There should be effective public-private partnership.

The Patent and Design Act which regulate industrial designs matters in Nigeria should be amended to be in tune with the technologically advancement of the world.

The Federal High Court which has exclusive jurisdiction in respect of Industrial design matters should have a division of the court in all the states of the Federation to enable lawyers and litigants have an easy access to institute infringement case. Proper enlightenment should be canvassed in respect of this area of law.

Conclusion

The law of industrial design is an aspect of intellectual property which deals with the protection of design. We have examined the meaning, nature and scope of industrial design, when an industrial design will be deemed registrable, non-registrable designs, categories of persons who may apply to register an industrial design including the duration and renewal of industrial design, protection conferred to an industrial design owner, challenges to these protection and suggestions towards a balanced and effective protection of industrial design in Nigeria.