

Eligibility for Patent Protection in Nigeria

R. E. Osamor, Esq.

Robert E. Osamor, LL.B., LL.M., Barrister-at-Law is a Senior Lecturer at the Nigerian Law School, Enugu Campus.

Introduction

Intellectual property law is a fast growing body of law. "IP" or "IPR" covers copyright, patent, trade marks and names, industrial designs, trade secrets and folklore. Copyright law protects literary and artistic works and associated products. The law of Trade marks and names protects the goodwill attaching to marketing symbols. Patent law protects inventions. It gives a monopoly right in an invention, which protects the rights of inventors to the appearance of mass produced goods.

In Nigeria, a patent is granted under section 2 of the Patents and Design Acts Cap. 344 Laws of the Federation 1990 (hereinafter referred to as "the Act"). The Act does not define a patent. However, in Section 6 of the Act it states the rights conferred on the holder of a patent:

"A patent confers upon the patentee the right to preclude any other person from doing any of the following acts:

- (a) Where the patent has been granted in respect of a product, the act of making, importing, selling or using the product, or stocking it for the purpose of sale or use; and
- (b) Where the patent has been granted in respect of a process, the act of applying the process or doing, in respect of a product obtained directly by means of the process, any of the acts mentioned in paragraph (a) of this subsection.

A patent does not impose any duty or obligation on the patentee. It only gives him a right to preclude others from making, using and/or selling the invention protected by the patent. The patentee therefore has rights often referred to as "negative monopoly" rights because of their exclusionary character.

Inventions are classified into two groups for the purpose of patents, these are: Product Inventions and Process Inventions. Whatever the classification the same criteria applies in the determination of patentability. Also the conditions or criteria for patentability are cumulative. The failure of any one or more of them disqualifies an application for the grant of a patent.

Criteria for Grant

The right to a patent conferred by Section 2 of the Act does not cover all forms of inventions. Inventions that are patentable are listed in Section 1 (1)(A) & (B) of the Acts thus:

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

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

Section 1(2) (a) (b) & (c) qualifies the categories listed in Section 1 (1)

(2) For the purpose of subsection (1) of this section —

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

While Section 1(3) defines what "the art" means for the purpose of the Act.

- (3) In subsection (2) of this section, "the art" means the art or field of knowledge to which an invention relates and "the state of the art" means everything concerning that art or field of knowledge which has been made available to the public anywhere and at any time whatever (by means of a written or oral description, by use or in any other way) before the date of the filing of the patent application relating to the invention or the foreign priority date validly claimed in respect thereof, so however that an invention shall not be deemed to have been made available to the public merely by reason of the fact that, within the period of six months preceding the filing of a patent application in respect of the invention, the inventor or his successor in title has exhibited it in an official or officially recognized international exhibition.

Therefore, "an invention must meet several criteria if it is to be eligible for patent protection. These include, most significant, that the invention

must consist of patentable subject matter, the invention must be industrially applicable (useful), it must be new (novel), it must exhibit a sufficient "inventive step" (be non-obvious), and the disclosure of the invention in the patent application must meet certain standards."¹

1. Patentable Subject Matter

It is desirable and indeed a general rule that patent protection shall avail inventions in all fields of technology. However, for the advancement of science and humanitarian grounds, some inventions are not patentable. The scope of patentable subject matter is therefore limited by statute.

Section 1(4) & (5) of the act provides the following:

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

- (a) Plant or animal varieties, or essentially biological processes for the production of plants or animals (other than microbiological processes and their products); or
- (b) Inventions, the publication or exploitation of which would be contrary to public order or morality (it being understood for the purposes of this paragraph that the exploitation of an invention is not contrary to public order or morality merely because its exploitation is prohibited by law).

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

An application for a patent must not fall within any of the above listed fields of technology. The invention must fall within the scope of patentable subject matter, in addition it must not be an invention, which though otherwise qualified for a patent, the publication or exploitation would encourage offensive, immoral, or anti-social behaviour.

A similar provision is contained in Section 1(3)(a) of the Patents Act 1977 of U.K.

Once it is determined that an invention falls within the statutory classes of patentable subject matter, the prior art status must then be determined and this raises the question of Novelty.

2. Novelty

This is a fundamental condition of patentability. There can not be a grant of patent for any invention that is already in existence. The application must therefore be for a new invention. Section 1(A) covers

new inventions while Section 1(B) covers a new improvement upon a patented invention. Both are treated by the same standard of novelty.

The determination of what is novel would ordinarily appear to be a factual assessment, for instance, in the case of *Van Der Lely v. Bamfords*²; The patentee claimed a haymaking machine in which the rake-wheels were turned not by an engine but by contact with the ground. The patent was held to have been anticipated by a photograph in a journal, which showed a hayrake with this feature. The issue was whether the photograph was clear enough to reveal the invention to an informed person. It was found to do so. However in *Forento v. Mentmore*³ the patentee claimed a ball-point pen in which the housing around the ball had a groove running in a ring below the equatorial plane of the ball; this produced a smooth flow of ink. On alleged anticipation, it was found to describe a method of disclosing a housing around the ball by "peining" that is by hitting the open housing with a tool shaped like a candle-snuffer. Before there could be anticipation however, it was necessary to show that peining would inevitably produce the desired ring-like groove in the correct position, and the earlier document, it was held, only gave instructions that "might well" produce this effect.

Therefore an invention is new if it does not exist and is not anticipated by the existing state of the earth. However, the determination of "the state of the art" and its scope is not usually so simplistic. Despite the elaborate attempt in Section 1(3) of the Act to define "the Art" and "the state of the Art" the limit of prior art at the time of an application for a patent is still doubtful.

It has been suggested⁴ that prior art should be limited to whatever technology that is known to exist only in the country where the application for patent is made. In other words, whatever the advances in technology that exists in other countries, once it is not imported into the protecting country, then it is not prior art for the purpose of the application.

This viewpoint however ignores the various international conventions on patents and designs with the reciprocal protection available to convention countries. Indeed, Section 27 of the Act clearly provides for such conventions and the legal effect of earlier applications for patents made in convention countries. The recognition of "foreign priority" dates of application cannot be without regard to the state of the art in the foreign country.

Another point of view attempts to distinguish between printed publication and other disclosures e.g. oral on the one hand and prior use on the other hand. It is notable that any form of disclosure such as:

- (1) By a description of the invention in a published writing or publication in other tangible form.

(2). By a description of the invention in spoken words uttered in public, such a disclosure being called an oral disclosure.

(3) By use of the invention in public, or by putting the public in a position that enables any member of the public to use it. Such a disclosure being a "disclosure by use" could easily undermine the claim of an inventor to a patent.

The effect of a disclosure will only negative novelty where due to the disclosure information about the invention is given out sufficient to reveal all the characteristics of the patent claimed. Thus where what is taught by the disclosure, by what ever means, will enable an ordinary skilled person engaged in the art to inevitably arrive at the same result as the one claimed by the patent application, the claim of novelty will fail.

Disclosure for the purpose of determination of state of the art shall not have the effect of destroying novelty where "within the period of six months preceding the filing of a patent application in respect of the invention, the inventor or his successor in title has exhibited it in an official or officially recognized international exhibition"⁵ otherwise absolute novelty is required for patent protection in Nigeria.

Section 2(4) U.K. Act 1977 in addition exempts disclosures within six months before application which result from:

- (1) Information which was obtained unlawfully or in breach of confidence i.e. industrial espionage and
- (2) Substances and compositions involved in treatment which do not form part of the state of the art, from being capable of destroying novelty.

However, in the United States, "the prior art includes knowledge, information and activity of others which predates the invention in the United States, more than one year prior to the filing of inventor's application for patent. Thus, a threshold question to the inventor/client should be whether any of these sales/use/publication activities has taken place, since any such activity will start a "one-year clock" running. If more than one year has elapsed since the inception of one or more of these activities within the scope of the statute, the patent rights in that invention have irretrievably been lost."⁶

The stages in the determination of prior art in Nigeria are:

1. Is the invention a product of the state of the art?
2. If it is not, has there been disclosure sufficient to make it the likely or inevitably result of the application of the disclosure?

If the two questions are answered in the negative then the invention would have scaled the huddle of novelty.

3. Inventive Step (Non Obviousness)

Inventive step or non-obviousness differs from novelty. Once there is a difference between the invention and the prior art then novelty is established. However, inventive step goes beyond the fact that the said invention is different from the state of the art i.e. new. To qualify as an inventive step the new product must be a product of creative idea i.e. inventive and it must represent an advance beyond the state of the art i.e. a step. These twin characteristics of creative idea and progressive step beyond the state of the art are the hallmarks of inventive step or non-obviousness. W. R. Cornish states the problem thus "An inventive step is considered to be present if, having regard to the state of the art the invention is not obvious to a person skilled in the art."⁷

The state of the art in this case is the same as the one earlier applied when the question of novelty was considered. In this case however, the question of prior publication does not arise for consideration.

The degree or extent of the invention is not relevant to a consideration of the presence of inventive step. Any degree of inventive step is adequate to support an application for a patent. Invention by accident is also patentable, similarly the fact that an invention is simple does not deny its patentability.

The earlier test of inventive step usually considered the following:

- (a) Does the invention have technical or commercial value?
- (b) Does the invention involve a new use for an old thing? If the invention is a simple extension of a known thing there will be no inventive step.
- (c) Does the invention satisfy a long-felt want. A history of failed attempts to reach a desired goal will be evidence of an inventive step, even if the invention is simple.
- (d) Is the invention commercially successful? (N.B.: this may not be determinative — clever advertising or marketing might be responsible).
- (e) Have independent researchers reached the same result?
- (f) Identification of the problem and formulating its solution from known features may amount to inventiveness.
- (g) Selection of the research area. In *Re Beecham Group's Ltd. (Amoxycillin) Application* (1980) it was held that the selection of a particular line or direction of inquiry can be evidence of inventive skill."⁸

This has given way to the modern test embodied in the Court of Appeal decision in *Windsurfing International v. Tabur Marine*.⁹

Oliver L.J. identified the following evaluative stages for judging inventive steps.

1. The court must identify the inventive concept embodied in the patent;
2. It must assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and impute to him what was, at that date, common general knowledge in the art in question;
3. It must identify what, if any, differences exist between the matters cited as being "known or used" and the alleged invention;
4. It must ask itself whether, viewed without any knowledge of the alleged invention, those differences constituted steps which would have been obvious to the skilled man or whether they required any degree of invention.¹⁰

The determinedly prosaic individual which these stages of evaluation conjures up is not different from the ubiquitous "reasonable man". He does not have to possess the agility of an acrobat or the foresight of a Hebrew prophet. He is merely a notionally skilled worker who has the common general knowledge of the art at the date of the invention and is familiar with the relevant literature in the particular field of technology.¹¹

In the evaluation of these stages of inquiry into the existence of an inventive step, the court relies on the opinion of expert witnesses. The inquiry then considers the following: Is there an inventive step or non-obvious development? What is the current state of art? And is there difference between the claimed invention and the state of art? And is there an obvious difference?

The answers to these questions will determine if there has been an inventive step or non-obviousness in the invention claimed.

4. Industrial Application

The act also requires that an application for patent must establish the fact that the invention claimed is capable of industrial application.¹² The invention must be a vendible product or a new way of achieving a process. Consequently, inventions that claim the impossible will not be patented. A machine that claims to produce perpetual motion is not patentable.¹³

There is currently a liberal interpretation of the requirement of industrial application. The rational is that "a claim to something unusable does not directly incommode any one else."¹⁴

5. Clear and Complete Disclosure

Upon the filing of an application for patent, the applicant must disclose the invention clearly and completely. The disclosure must be sufficient

for the invention to be performed by a person skilled in that art or field of knowledge to which the invention relates. This is the combined effect of Section 3 (1) (a) (ii) and Section 3 (2) of the Act.

"It is this requirement that aims to extract the essential "consideration" for the patent grant-revelation of the invention for the information of the rest of industry and any others interested."¹⁵

Absence of complete disclosure can be a bar to the grant of a patent as well as a ground for objection to a patent after grant.

For machines, the applicant has to disclose how it is to be made. While for a chemical substance the procedure involved in the invention has to be disclosed.

Where the disclosure contains errors or omissions the patent application will not be invalid if a person skilled in the art can correct the errors or supply the omissions. The test to be applied for this purpose was laid down by Romer L.J. in *No Frame v. Pitchford*¹⁶ thus "can he rectify the mistakes or readily supply the omissions without the exercise of any inventive faculty? If he can, then the description of the specification is sufficient. If he cannot, the patent will be void for insufficiency."

In the case a claim for a "smokeless" ash-tray which contained a drawing illustrating one construction of the ash-tray by way of example was held not be void for want of sufficiency.

The disclosure of the patent was required to be made in utmost good faith. In his disclosure, an applicant must be "fair, honest and open." However, the current requirement is that the disclosure must be clear and complete.

In *Hokoune*¹⁷

A European applicant claimed a step of etching stone by cathode bombardment. It was not known how to do this in the art, and the applicant admitted that it had not described the necessary steps in order to prevent them from being copied from the specification. There was found to be no sufficient description.

The law therefore requires the clear and complete disclosure of an invention sufficient for a person engaged in the particular art or field of technology to which the invention relates to be able to produce what the invention claims without inventive step.

Conclusion

These are the conditions for patentability.

They are cumulative requirements and when one or more of these requirements are not met by a patent application, it will fail.

Demanding as they appear, they are necessary considering the right, which the grant of a patent confers on the patentee, and the forbearance of society during the life span of the patent.

Unfortunately, these requirements are not complied with to the letter in Nigeria. Though the Act adequately provides for these conditions, Nigeria lacks the manpower and material necessary for adequate investigation of patent claims. The question of inventive step particularly demands the attention of experts. It is to be noted however that the types of inventions put forward for verification in Nigeria are equally not sophisticated. Both factors might therefore be responsible for each other.

NOTES

1. Intellectual Property Reading Material Wipo 1998 at page 14.
2. (1963) R.P.C. 61 H.L.
3. (1956) R.P.C. 87, C.A.
4. At page 15, Supra.
5. S. 1(3) Patents and Designs Act Cap 344 L.F.N. 1990.
6. Stephen J. Hulquist — Intellectual Property Law at pg 2.
7. W. R. Cornish — Intellectual Property Law Third Edition at page 163
8. Intellectual Property Law — Cavendish Lawcards 1999 at page 36
9. (1985) R.P.C. 59.
10. W. R. Cornish — Intellectual Property Third Edition at page 163
11. Intellectual Property Law — Cavendish Lawcards 1999 at page 35
12. S. 1(1) (B) Patents and Designs Act Cap 344 L.F.N. 1990.
13. Epo Guidelines. C IV 4. 1 at page 176 W.R. Cornish Third Edition.
14. W. R. Cornish Intellectual Property at page 176
15. Page 197 Supra
16. (1935) 52 R.P.C. 231 (C.A.)
17. (1986) O.J. EPO376