

**Impact of the World Trade Organisation TRIPS Agreement on
the Intellectual Property Laws of Nigeria**

by

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Declaration of Originality

I, the undersigned, hereby declare that this thesis, which I submit for the degree Doctor Legum in the Faculty of Law at the University of Pretoria, is my own work and has not previously been submitted for a degree at another university.

I have correctly cited and acknowledged all my sources.

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Abstract

The primary purpose of this study is to determine the consequence of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) on the intellectual property laws in Nigeria. The discussion centers on the examination for compliance of the three main laws on intellectual property in Nigeria, as well as the enforcement mechanism for these laws. As the field of intellectual property continues to expand and impact on vital spheres, such as health care, foreign direct investment, technology transfer and access to information, there is a need to safeguard and sustain a beneficial response to concerns about the impact of the relevant provisions of the TRIPS Agreement and its application to intellectual property in Nigeria. The impact of the TRIPS Agreement on developing countries has been a subject of extensive and intense debate, however very little has been focused on Nigeria.

The thesis demonstrates, despite the fact that the Nigerian intellectual property laws have not been reviewed since Nigeria's adoption of the TRIPS Agreement, that the laws are mostly compliant and capable of being adapted to encourage the vital spheres. However, it is noted in this study that the flexibilities provided in the TRIPS Agreement are glaringly absent but are needed to tolerate and sustain a beneficial response to the queries on the impact of the TRIPS Agreement and its implication for intellectual property in Nigeria.

The challenges facing intellectual property from a legal, educational and developmental perspective were highlighted as having a great effect on the growth of intellectual property. The thesis concludes that although the present legal framework provides a measure of compliance, the benefit of a reformed legal framework to Nigeria cannot be overstated.

Dedication

To the Almighty God

&

Luqman Oloko

(For your immeasurable sacrifice)

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I boast of no strength of my own, all the glory must be unto the LORD who is worth of my praise. JESUS IS LORD!

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Abbreviations and Acronyms

A2K	Access to Knowledge
AIDS	Acquired Immune Deficiency Syndrome
ANC	Antenatal Clinics
APIs	Active Pharmaceutical Ingredients
ARV	Anti-Retroviral
ASEAN	Association of South East Asian Nations
BIRPI	United International Bureau for the Protection of Intellectual Property
CBD	Convention on Biotechnological Diversity
CCIG	China Certification & Inspection Group CCIG
CGRFA	Commission on Genetic resources for Food and Agriculture
CIPIH	Commission on Intellectual Property Rights, Innovation and Public Health
CLE	Continuing Legal Education
COP	Conference of Parties
CPC	Consumer Protection Council
CTM	EU Community Trade Mark
CTMR	Community Trade Mark Regulation
DC	Developing Countries
DFID	Department for International Development
DSU	Dispute Settlement Understanding
ECOWAS	Economic Community of West Africa
EPC	European Patent Convention
EPO	European Patent Office
EU	European Union
FDA	Food and Drug Administration
FDI	Foreign Direct Investment
FHC	Federal High Court
FTAs	Free Trade Agreement
GATS	General Agreement on Trade in Services
GATT	General Agreement on Tariffs and Trade
GDP	Gross Domestic Product
GIs	Geographical Indications
GMOs	Genetically Modified Organisms
GSPA-PHI	Global Strategy and Plan of Action on Public Health, Innovation and Intellectual Property
HIV	Human immunodeficiency virus
ICs	Industrial Countries

IGWG	Intergovernmental Working Group
IMF	International Monetary Fund
IP	Intellectual property
IPAS	Intellectual Property Automated System
IPRs	Intellectual property Rights
IPTTOs	Intellectual Property and Technology Transfer Offices
ITO	International Trade Organisation
LDCs	Least Developed Countries-
LMOs	Living Modified Organisms
MAS	Mobile Authentication Service
MFN	Most Favourable Nation
MOU	Memorandum of Understanding
MSF	<i>Medecins Sans Frontieres</i>
MTN	Multilateral Trade Negotiations
NACA	National Agency for the Control of AIDS
NCC	Nigerian Copyright Commission
NERDC	Nigerian Educational Research and Development Council
NIOP	National Office of Industrial Property
NIPCOM	Nigerian Intellectual Property Commission
NMA	Nigerian Medical Association
NOA	Notice of Allowance
NPF	Nigerian Police Force
NSC	Nigeria Customs Service
OAU	Organisation of African Unity
OECD	Organisation for Economic Co-Operation and Development
OHIM	Office for the Harmonisation of the Internal Market
OJ EPO	Official Journal European Patent Offices
OXFAM	Oxford Committee for Famine Relief
PCT	Patent Cooperation Treaty
PDA	Patent and Design Act
PIDC	Patent Information and Documentation Centre
PLHIV	People Living with HIV
PMD	Priority Medical Devices
PMTCT	Prevention of mother-to-child HIV transmission
PWLHIV	pregnant women living with HIV
QAMSA	Quality of Anti-malarial Medicines in Sub-Saharan Africa
R&D	Research and Development
RECs	Regional Economic Communities
RPET	Regional Patent Examination Training program

RTA	Regional Trade Agreement
SCCR	Standing Committee on Copyright and Related Rights WIPO
SCP	Standing Committee on the Law of Patents WIPO
SME	Small Medium Enterprises
SON	Standard Organisation of Nigeria
SSA	Sub-Saharan Africa
SSFFC	surveillance and monitoring of Substandard, Spurious, Falsely, Labelled, and Falsified Counterfeit
STRAP	Strategic Action against Piracy
TAC	Treatment Action Campaign
TBA	Technical Board of Appeal
THPs	Traditional Health Practitioners
TNCs	Trans-national Corporations
TPR	Trade Policy Reviews Mechanism
TRIPS	Trade-Related Aspects of Intellectual Property Rights
TWN	Third World Network
UN	United Nations
UNAIDS	Joint United Nation programmes on HIV/AIDS
UNCTAD	United Nations Conference on Trade and Development
UNDP	United Nations Development Programme
UNESCO	United Nations Educational, Scientific and Cultural Organisation
UNFCCC	United Nations Framework Convention on Climate Change
UNIDO	United Nations Industrial Development Organisation
USTR	United States Trade Representative
WHA	World Health Assembly
WHO	World Health Organisation
WIPO	World Intellectual Property Organisation
WPPT	WIPO Performances and Phonograms Treaty
WTO	World Trade Organisation

CHAPTER 1

General Introduction

Summary

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1.1 Background

*If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it.... That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space,...*¹

Thomas Jefferson 1813

Since the inception of the TRIPS Agreement many have expressed concern about the effect it might have on developing countries. These concerns have led to a change in the perception of intellectual property (IP) over the last couple of years.² Intellectual property has become extremely diverse in nature and the concept continues to expand. Intellectual property has

¹ Thomas Jefferson letter to Isaac McPherson, August 13, 1813, reprinted in H. A. Washington, ed., Writings of Thomas Jefferson 1790-1826, vol. 6 (Washington, D. C: Taylor & Maury 1854), 180-81.

² Peter K Yu 'The Global Intellectual Property Order and its Undetermined Future' [2009] 1 *World Intellectual Property Organisation Journal* 8.

grown from mere rights into a doctrine of a knowledge-based³ system, reflecting its growing importance as a component of national and international policy.⁴

IP is widely used in legal and commercial practice, not only in Nigeria, but across the world. Like many other aspects of law, intellectual property is inter-territorial, often it functions in more than one jurisdiction. Moreover, in recent times intellectual property has figured more prominently on the global stage, making it an issue that has to be taken into account by all state parties and making it an area of necessary research for Nigeria

IP is used to facilitate the commercial exploitation of the outcomes of scientific, technological and cultural creation that stem from the expression of ideas: the utilisation of which is essential for the development and growth of any society.⁵ The protection of IPRs⁶ is vital for the advancement of societies, thereby implying that changes in IPR rules must progress in conjunction with developments in the legal and market systems, as well as cultural norms.⁷

Generally, IP denotes a class of legal regimes with distinct degrees of rights of ownership in different subject matters.⁸ The common genres of rights included within this generic term are patents, trademarks, copyrights, trade names, and indication of origin.⁹ Intellectual property rights (IPRs) traditionally are categorised into two areas: first, those rights which relate to

³ Roya Ghafele, *Perceptions of Intellectual Property: A review* Intellectual Property Institute London 1-42 available at <http://www.iam-magazine.com/blog/articles/PerceptionsofIP.pdf> (accessed 25 March 2014).

⁴ Michael W Carrol, 'A Framework for Tailoring Intellectual Property Rights' in Annette Kur and Vytautas Mizaras, *The Structure of Intellectual Property Law Can One Size Fit All* Edward Elgar Cheltenham 2011 p 15-39 15.

⁵ UNCTAD, *Training Tools On The TRIPS Agreement: The Developing Countries' Perspective* Division on International Trade in Goods Geneva January 2002 p. 6

⁶ Intellectual Property Rights (hereinafter referred to as IPRs).

⁷ Zorina Khan, *Intellectual Property and Economic Development: Lessons from American and European History* Commission on Intellectual Property Rights Study Paper 1a. National Bureau of Economic Research. This report has been commissioned by the IPR Commission as a background paper 4.

⁸ Peter Drahos, 'The Universality of Intellectual Property Rights: Origins and Development' p. 1 available at www.wipo.int/edocs/mdocs/tk/en/.../wipo_unhchr_ip_pnl_98_1.doc accessed 02 February 2014; see also Paul Craig and Grainne de Burca, *EU Law Text, Cases and Materials* Oxford University Press 3rd ed 2003 p. 5.

⁹ Craig and Grainne de Burca p. 5; A striking feature of intellectual property is that, despite its early historical links to the idea of monopoly and privilege, the scope of its subject matter continues to expand. See also Drahos p. 1; Intellectual property rights are also among the most controversial forms of trade and business regulation in the global economy. See Keith E. Markus *Introduction. The WTO, Intellectual Property Rights and the Knowledge Economy*, in Keith Markus (ed) *Critical Perspective on the Global Trading System and the WTO* Elgar Cheltenham 2004 p. 34.

industrial property (patents, industrial designs and models, trade marks, and geographical indications) and, second, copyright (those relating to literary and artistic property).

Prior to 1995, IPRs were principally regulated at the international level by a number of Treaties¹⁰ administered by the World Intellectual Property Organisation (WIPO): of particular importance to the thesis are the Berne Convention, the Paris Convention and the Rome Convention.¹¹

In 1995, following almost 8 years of fraught multilateral trade discussions, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)¹² emerged as part of the World Trade Organisation (WTO) Agreements on trade. The agreement signifies the relevance of intellectual property to global trade liberalisation and the need for the protection of such rights.

Accordingly, the adoption of the TRIPS Agreement introduced a major revolution in IP policy making and till now remains the most comprehensive multilateral agreement on intellectual

¹⁰ Beijing Treaty on Audio-visual Performances (adopted by the Diplomatic Conference on the Protection of Audio-visual Performances in Beijing, on June 24, 2012); Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, revised at Paris July 24, 1971, 828 U.N.T.S. 221; Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite Done at Brussels on May 21, 1974; Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of April 14, 1891; Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled adopted by the Diplomatic Conference to Conclude a Treaty to Facilitate Access to Published Works by Visually Impaired Persons and Persons with Print Disabilities in Marrakesh, on June 27, 2013; Nairobi Treaty on the Protection of the Olympic Symbol adopted at Nairobi on September 26, 1981; Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at Stockholm July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 ;Patent Law Treaty adopted on June 1, 2000 at Geneva entered into Force on April 28, 2005. Nigeria ratified it on 19 December, 2002 and it came into force 28 April, 2005;Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms of October 29, 1971; Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Done at on October 26, 1961. Singapore Treaty on the Law of Trade Marks adopted at Singapore on March 27, 2006; Trademark Law Treaty (adopted at Geneva on October 27, 1994); WIPO Copyright Treaty adopted on December 20, 1996 at Geneva entered into force on March 6, 2002. Nigeria became a signatory on 24 March, 1997; WIPO Performances and Phonograms Treaty Adopted on December 20, 1996 at Geneva entered into force on May 20, 2002Nigeria became a signatory on March 24, 1997.

¹¹ Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Done at on October 26, 1961.

¹² Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organisation (WTO Agreement) Annex 1C (hereinafter referred to as the TRIPS Agreement.

property:¹³ it is a single IP framework that covers all the main categories of intellectual property law¹⁴ as well as new areas which previously were not protected internationally.¹⁵

The TRIPS Agreement was established to set out minimum universal standards for the protection of all areas of intellectual property,¹⁶ and allows members to provide more extensive protection of intellectual property if they so wish.¹⁷ The intention of the Agreement is to implement these standards globally through a WTO enforcement mechanism. Intellectual property protection was ‘married’ to international trade¹⁸ as part of a complex body of international law that governs relations between states on trade matters,¹⁹ and generally, it sets the standards that define what trading partners can legitimately expect of one another in the protection IP.²⁰

Placing IP in the trade forum has created fundamental conflict and tension by pitching the aim of liberalising trade into the arena intellectual property. There is a fear that the enhanced protection given to IPRs will not effectively promote the development process, but, instead

¹³ WTO: *Overview: the TRIPS Agreement* http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm accessed on 14 July 2011.

¹⁴ The World Trade Organization ‘The 5th Ministerial Conference ‘TRIPS Agreement, Public Health a Challenging Battle p 6 http://www.iprsonline.org/ictsd/docs/trips_healthbackgrpund_cairo_univ.pdf accessed 23 March 2014.

¹⁵ Daniel J Gervais, ‘The TRIPS Agreement: Interpretation and Implementation’ *European Intellectual Property Review* 1999 21 156-162) 156. The TRIPS Agreement covers not only all areas already protected under extant agreements, but also protects for the first time rights that did not benefit from any multilateral protection.

¹⁶ Copyright and Related Rights, Trademarks, Geographical Indications, Industrial Designs, Patents, Layout-Designs (Topographies) of Integrated Circuits Protection of Undisclosed Information, Control of Anti-Competitive Practices in Contractual Licences.

¹⁷ WTO, *Overview: the TRIPS Agreement*.

¹⁸ Keith Maskus (ed), *The WTO, Intellectual Property Rights and the Knowledge Economy TRIPS and the WTO: An Uneasy Marriage*, by Arvind Pangariya *Critical Perspective on the Global Trading System and the WTO* Elgar Cheltenham 2004; See also Robert M. Sherwood, ‘The Trips Agreement: Implications for Developing Countries’ 1997 PTC Research Foundation of Franklin Pierce Law Center IDEA: The Journal of Law and Technology 1997 37 IDEA 491 See also Antony Taubman, *A Practical Guide to Working with TRIPS* Oxford University Press 2011 p. 5; See also Peter Yu, ‘Intellectual Property Rulemaking in the Global Capitalist Economy, The International Enclosure Movement’ (2007) 82 *Indiana Law Journal* 827 6.

¹⁹ Antony Taubman, *A Practical Guide to Working with TRIPS*. Oxford University Press 2011 p. 17.

²⁰ Taubman p. 17; The TRIPS Agreement, presents a statement of the intellectual property standard to which all World Trade Organization member countries have made a commitment, the areas of intellectual property that it covers are: copyright and related rights;²⁰ trademarks including service marks; geographical indications including appellations of origin; industrial designs; patents including the protection of new varieties of plants; the layout designs of integrated circuits; and undisclosed information including trade secrets and test data.

limit access to technology, which has been voiced by many developing countries.²¹ It has been claimed that the TRIPS Agreement will place an intolerable burden on developing countries as the standards promoted in the TRIPS Agreement are beyond the capacities of developing countries and those of least developing countries. The current extension given to LCDs to comply with the TRIPS Agreement answers to this claim. Presently LDCs have up until 2021 to comply with TRIPS. The TRIPS Agreement has been viewed as a desperate attempt to retain the precious comparative advantage of industrialised countries.²² Whatever the argument, it seems clear that the ‘one-size-fits-all or rather one-standard-fits-all approach of TRIPS’ is seen as being a great disservice to developing countries.²³

The initiation of the TRIPS Agreement marks a peculiar time in the history of intellectual property by creating standard levels of protection which are to be enforced worldwide. This modification has been criticised because, to a large extent it reflects the views of the United States and other industrialised countries and raises many unanswered questions.²⁴

The debates and queries in relation the TRIPS Agreement revolve round concerns relating to the ‘rich versus the poor, developed versus developing, greedy pharmaceutical industries versus dying AIDS patients in many developing countries’.²⁵ In these circumstances developing countries and least developed countries question the genuineness of the effort and some aspects on the implementation of the TRIPS Agreement, particularly ‘the continuous use of unilateral pressures and the lack of actual implementation of Article 66.2²⁶ and Article 67’ on technical assistance to developing countries.²⁷

²¹ Carlos Correa, ‘Review of the TRIPS Agreement: Fostering the Transfer of Technology to Developing Countries’ (1999) 2 *Journal of World Intellectual Property* 939.

²² Taubman p. 40.

²³ Martin Khor, Rethinking Intellectual Property Rights and TRIPS in Peter Drahos & Ruth Mayne (Ed.) *Global Intellectual Property Rights Knowledge, Access and Development*. Palgrave Macmillan 2002 Ch 12 p 205.

²⁴ Endeshaw Assafa, ‘Paradox of Intellectual Property Law making in the New Millennium: Universal Templates as Terms of Surrender for Non-Industrial Nations; Piracy as an Offshoot’ (2002) 10 *Cardozo Journal of International Comparative Law* 47 – 78 74.

²⁵ Justin Malbon and Charles Lawson ed, *Interpreting and Implementing the TRIPS Agreement. Is it Fair? Multilateral TRIPS and Developing Countries* by Xu Yi-chong Elgar Cheltenham 2008 p. 49

²⁶ Provides for the incentives for the transfer of technology to Least Developed Countries (LDCs).

²⁷ See Carlos Correa. ‘Review of the TRIPS Agreement: Fostering the Transfer of Technology to Developing Countries’ (1999) 2, *Journal of World Intellectual Property* p 939. It is presumed that the TRIPS Agreement

Concerns around the impact of the TRIPS Agreement on innovation and technology transfer, continue, particularly in developing countries. The flexibilities in the TRIPS Agreement have not produced results that assist in the development of local innovation and technology transfer.

Carlos Primo Braga of the World Bank declares, ‘TRIPS is the most ambitious international agreement on intellectual property rights. The main challenge for developing countries is to transform it from a rent transfer mechanism into an effective instrument for technological development.’²⁸ Over the last two decades efforts have been made by international organisations²⁹ and scholars³⁰ alike to determine the effect of the TRIPS Agreement on developing countries.³¹

The TRIPS Agreement is a legal document which cuts across different issues. Thus, it is important that its effects on legislation of member states is first examined to establish the likely impact it will have, overall, upon development and economic growth. Nigeria as a developing country and a member of the WTO,³² is obligated to comply with all WTO Agreements.³³ The impact of the TRIPS Agreement is of special interest, considering the fact

would increase, on a global scale, incentives to invest in the research and development of new ideas and technologies.

²⁸ Carlos A. Primo Braga, *Trade-Related Intellectual Property Issues: The Uruguay Round Agreement and Its Economic Implications*, in *The Uruguay Round and the Developing Economies* (World Bank discussion Paper No. 307, William Martin & L.

²⁹ Germán Velásquez and Pascale Boulet, *Globalization and Access to Drugs: Perspectives on the WTO/TRIPS Agreement* (Revised) Geneva, World Health Organization, 1999 (document reference WHO/DAP/98.9). W. Lesser, ‘The Effects of Trips-Mandated Intellectual Property Rights on Economic Activities in Developing Countries’, prepared under WIPO Special Service Agreements http://www.wipo.int/export/sites/www/about-ip/en/studies/pdf/ssa_lesser_trips.pdf accessed 08 May 2014.

³⁰ Somesh. K. Mathur, TRIPS: Issues, Impact and the Way Forward for Developing Countries Including India http://www.ifw-kiel.de/konfer/esf-ifw/newtech_0507/mathur.pdf accessed 08 May 2014.

³¹ Germán Velásquez and Pascale Boulet *Globalization and Access to Drugs: Perspectives on the WTO/TRIPS Agreement*; World Health Organization *A Briefing on TRIPS. Pharmaceuticals in the Trade-Related Aspects of the Intellectual Property Rights (TRIPS) Agreement of the World Trade Organization (WTO)* Manila, World Health Organization, Regional Office for the Western Pacific, August 2000; see also, The managementor available at <http://www.themanagementor.com/enlightenmentorareas/sm/sfm/TRIPSAgree.htm> accessed 21 March 2012; It is believed that stronger enforcement of IPR might lead to the transfer of income from less developed countries to more affluent innovation producing nations and that stricter IPR enforcement regime might curb the flow of technological knowledge to less developed countries.

³² Nigeria became a WTO member 1 January 1995.

³³ Gerald Fitzmaurice, Third Report on the Law of Treaties UN doc. A/CN.4/115, YILC, Vol. II, 20 27 Art 9 para 1 & 2.; Consent in general Article 9, 1. The mutual consent of the parties, and reality of consent on the part of each party, is an essential condition of the validity of any treaty, or, as the case may be, of the

that Nigeria has not reviewed its laws since the adoption of the TRIPS Agreement and that, when a treaty is passed, it is impossible to comprehend the overall effect it may have until the treaty begins to take effect. A treaty, no matter how well drafted, in all respect cannot be agreeable to all countries and parties concerned. This situation, coupled with ever-changing technology and trade treaties, means that no end is in sight to these tensions. Developing countries and countries in transition need to consider the introduction of a sustainable system for the protection of intellectual property with regards to their peculiar needs.

A study on Nigeria is multifaceted for the reason that the economic, social and developmental levels that currently exist do not correspond with the indices used to measure a developing country. In essence, it makes the impact of the TRIPS Agreement fundamental in determining the approach to be utilised when adopting an intellectual property regime that will be balanced and beneficial to the nation in light of its economic, social and development outcomes.

Nigeria presently has three main substantive laws on intellectual property, namely, the Copyright Act,³⁴ Trade Marks Act³⁵ and the Patent and Design Act.³⁶ Nigeria is a signatory to a number of international IP treaties, such as the Berne Convention,³⁷ the Paris Convention,³⁸ and the Rome Convention,³⁹ the WIPO Copyright Treaty,⁴⁰ the WIPO Performances and Phonograms Treaty,⁴¹ Patent Cooperation Treaty,⁴² and the Patent Law Treaty.⁴³

participation of any particular party. 2. There must accordingly be a *consensus ad idem* on the part of the parties; but the existence of such a consensus will be presumed unless the contrary is established.

³⁴ Copyright Act 1988 Cap C28, Laws of the Federation of Nigeria, 2004 as amended.

³⁵ Trade Marks Act 1965 Cap T 13 Laws of Federation of Nigeria 2004.

³⁶ Patent and Design Act Laws 1970 Cap P2 (Vol. 13), Laws of Federation of Nigeria 2004.

³⁷ Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, revised at Paris July 24, 1971, 828 U.N.T.S. 221.

³⁸ Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, *as last revised* at Stockholm July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

³⁹ Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Done at on October 26, 1961.

⁴⁰ WIPO Copyright Treaty adopted on December 20, 1996 at Geneva entered into force on March 6, 2002. Nigeria became a signatory on 24 March, 1997.

⁴¹ WIPO Performances and Phonograms Treaty Adopted on December 20, 1996 at Geneva entered into force on May 20, 2002 Nigeria became a signatory on March 24, 1997.

⁴² Patent Cooperation Treaty adopted on June 19, 1970 at Washington D.C. entered into force on January 24, 1978. Nigeria acceded to the treaty on 8 February, 2005 and entered into force 8 May, 2005.

⁴³ Patent Law Treaty adopted on June 1, 2000 at Geneva entered into Force on April 28, 2005. Nigeria ratified it on 19 December, 2002 and it came into force 28 April, 2005.

Although Nigeria has developed case law on intellectual property which is unique to the country,⁴⁴ intellectual property governed by this distinctive system is involved in cross-border dealings. Moreover, foreign intellectual property rights holders often transact businesses in Nigeria.⁴⁵

1.2 Research Problem and Statement

This research was inspired by the absence of a comprehensive study on the impact of the WTO TRIPS Agreement on intellectual property laws in Nigeria. This thesis investigates the TRIPS Agreement *vis-à-vis* the Nigerian intellectual property laws on copyright, trademarks and patents. The TRIPS Agreement recognises seven categories of IP: Copyright and Related Rights, Trade marks, Geographical Indications, Industrial Designs, Patents, Layout-Designs of Integrated Circuits and Protection of Undisclosed Information. However, due to constraints with regard to the length of the thesis my focus will only be on copyright, trade marks and patents, and discussions of the other species of IP fall outside the scope of the thesis.

The TRIPS Agreement has an impact on developing countries in regards to each country's legislation and the amendments that are needed to ensure compliance. The effects of the TRIPS Agreement have been majorly anchored on the need to adapt legislation of WTO members to the requirements of the TRIPS Agreement.⁴⁶ Currently Nigeria is among the bottom 10 countries in the International Property Rights Index which annually examines the

⁴⁴ Trade mark case of *Alliance International Limited v Saam Kolo International Enterprises Limited* (2010) 13 NWLR (Pt. 121) C.A. 270; Copyright case of *Music Copyright Society (NIG) Ltd/GTE v Nigerian Copyright Commission*. Suit No. FHC/L/CS/478/2008, decided on March 17, 2010; Patent case of *Rev (Dr.). C.J.A. Uwemedimo v Mobil Producing (NIG) Unlimited*. Decided December 8, 2009, Court of Appeal Calabar and Design case of *Uzokwe v Dansy Industires (NIG) Ltd.* (2002) 2 NWLR (Pt 752) 528. Asein John, *Nigeria Copyright Law and Practice WIPO & NCC Abuja 2004* Greg Uloko, *Modern Approach to Intellectual Property Laws in Nigeria* (Princeton Publishing Co. 2010).

⁴⁵ Three are lots of multinationals from different parts of the world that have a lot of dealing in Nigeria. For example Shell, BP, Chevron, Pfizer and Exxon Mobil.

⁴⁶ The area of interest and concern relate to issues such as (1) technology transfer, (2) enhancing Africa's export potential, (3) access to drugs, (4) innovation, (5) food security, (6) foreign direct investment (FDI), (7) employment, (8) biodiversity, biotechnology and traditional knowledge,(9) education, and (10) enforcement and administrative costs. See Adede A.O, 'Streamlining Africa's Responses to the Impact of Review and Implementation of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement' International Centre for Trade and Sustainable Development (ICTSD) Geneva, 2007 p. 1.

protection of property rights by comparing three core components⁴⁷ of property rights systems.⁴⁸ The impact of the change in law will be felt in the areas such as the law itself, development, education and research. This section is divided into the three areas to capture the issue more accurately.

Law/ Legislation: It is commonplace that review of the laws has been ignored and most laws in Nigeria do not meet the current changes in cultural, social and economic situations. Although access to black letter laws on intellectual property laws in Nigeria are well established, legal issues such as court decisions and policies on intellectual property rights remains a challenge. Local material for the interpretation and application of the laws and international treaties and convention is scarce. In addition, IP laws need to be seen in the perspective of the current international developments, particularly annexing the flexibilities in the TRIPS Agreement to provide adequate channels for the beneficial use of intellectual property rights. Even though Nigeria has had an IP legal framework for almost a century, an in-depth assessment of the effectiveness of the framework as provided by the various laws has not been undertaken.

Development: Challenge which is linked to the above problems relates to development and the potential contribution of intellectual property in fostering development and alleviating poverty in Nigeria. Intellectual property is a powerful tool for economic growth.⁴⁹ Intellectual property laws in Nigeria have not made an appreciable impact on development. It is pertinent to ask the question whether Nigeria can use intellectual property law as a tool for the advancement of developmental strategies to foster economic growth considering the explicit

⁴⁷ The three core components are Legal and Political Environment (Judicial independence, rule of law, political stability and control of corruption); Physical Property Rights (Protection of physical property rights, registering property, access to loans; Intellectual Property Rights (Protection of intellectual property rights, patent protection, copyright piracy).

⁴⁸ Francesco Di Lorenzo and Hernando de Soto, 2013 INTERNATIONAL PROPERTY RIGHTS INDEX The 2013 edition ranks 131 countries, representing 98% of world Gross Domestic Product and 93% of world population.
<http://www.propertyrightsalliance.org/userfiles/2013%20International%20Property%20Rights%20Index-PRA.pdf> accessed 21 March 2014.

⁴⁹ Kamil Idris, *Intellectual Property: A Power Tool for Economic Growth* World Intellectual Property Organization publication Intellectual Property p.1. See also Adede A.O, 'Streamlining Africa's Responses to the Impact of Review and Implementation of the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Agreement' International Centre for Trade and Sustainable Development (ICTSD) SADAG Imprimerie p. 3.

difficulties faced by Nigeria. Moreover, it is important to establish if IP laws are relevant to sustainable development and how should Nigeria promote sustainable development and at the same time provide an incentive to invest in and develop new technologies.

Education and Research: Africa is largely lacking in the area of IP education and research.⁵⁰ Developed countries, and some developing countries use the resources at their disposal for research and development, whereas Africa⁵¹ in general, and Nigeria, in particular, consume the products of these researches. There is a dire need for access to educational materials and resources,⁵² without which technology transfer, access to drugs, innovation, food security, foreign direct investment (FDI) and employment will continue to elude Nigeria. In Benjamin Franklin's words 'If a man empties his purse into his head, no man can take it away from him. An investment in knowledge always pays the best interest.'⁵³

Pursuant to the above, an in-depth analysis of the effect of the TRIPS Agreement on intellectual property laws in Nigeria is indispensable at this stage of Nigeria's development.

1.3 Purpose of the Research

The aim of the research is to determine, accurately and meaningfully, the specific implications and potential consequences of the TRIPS Agreement, on the legal regime of intellectual property in Nigeria. As the field of IP continues to expand and has an impact on vital spheres, such as health care, foreign direct investments, technology transfer and access to information, there is a need to safeguard and sustain a beneficial response to the queries on the impact of the relevant articles of the TRIPS Agreement and their implication for intellectual property law in Nigeria. It should be noted that, although these issues are important to Nigeria and its

⁵⁰ Byaruhanga Joseph Kadoma, 'Strengthening Higher Education Stakeholder Relations through Intellectual Property Rights in African Universities' January 2013 Policy Brief <http://www.aau.org/sites/default/files/english/SHERA/Applied%20Policy%20Research%20Brief%20No.%203%20-%20Intellectual%20Property%20Rights%202013%20-%20FOR%20AAU%20GENERAL%20CONFERENCE.pdf> accessed 22 June 2013; Alphonsus Neba, 'IPR systems and technology transfer' at Research institutions in southern Africa Regional and Thematic Papers on Research Management 2009–2013 [http://www.rimi4ac.net/site_media/CONTENT_uploads/IPRSystems&TechTransfer_v2%20\[SINGLE%20PAGES\].pdf](http://www.rimi4ac.net/site_media/CONTENT_uploads/IPRSystems&TechTransfer_v2%20[SINGLE%20PAGES].pdf) accessed 23 March 2014.

⁵¹ Except a few countries like South Africa and Botswana.

⁵² Adejoke Oyewunmi, 'The Intellectual Property Law Reports' - A Review *Vanguard* Lagos 7 May 2009.

⁵³ Quotation Book available at <http://quotationsbook.com/quote/11912/> accessed 1 April 2012.

economy and development, this thesis will not primarily address these matters. An evaluation of the international and national legal frameworks on IP, such as treaties, statutes and relevant case laws will also be examined and compared with other jurisdictions so as to guide recommendations to resolving the current uncertainties in Nigerian law. The object of the TRIPS Agreement, as it relates to the Nigerian IP system, will be identified, analysed and explained. As far as possible the legal gaps or deficiencies in the scope and substance of the Nigerian law with respect to the protection of IPR will also be probed.

1.4 Research Question

The major question that the research seeks to answer is: What is the impact of the TRIPS Agreement on Nigeria's intellectual property legislation?

It raises further questions:

- (a) Whether or not Nigerian IP laws as they are currently in compliance with the TRIPS Agreement.
- (b) If they are not compliant, in which aspects do the Nigerian IP laws fail to comply with the TRIPS Agreement?
- (c) Will subsequent compliance have a negative effect on the sectors affected by IP?
- (d) Will compliance with the TRIPS Agreement improve the protection of IP in Nigeria, or will a more flexible system be appropriate?
- (e) What are the shortcomings of the current Nigerian IP legislation?

1.5 Existing Studies

The implication of the TRIPS Agreement on developing countries has been a subject of intense and extensive debate, at national and international levels, in different forums⁵⁴ for expert and political bodies,⁵⁵ as well as global bodies.⁵⁶ The debate has created a divide

⁵⁴ WIPO; WHO; FAO; Conference of Parties (COP); Convention on Biotechnological Diversity (CBD) and commission on Genetic resources for Food and Agriculture (CGRFA).

⁵⁵ UN Commission on Human Right and Sub-Commission on the Protection and Promotion of Human Rights.

⁵⁶ UNCTAD-ICTSD.

amongst policy makers and commentators alike, with each side ‘talking past, rather than to, each other.’⁵⁷

Notably, research relating to the TRIPS Agreement is mostly written from the perspective of developed countries. A range of research has been done in relation to the effect on developing countries as well.⁵⁸ The implications of the TRIPS Agreement will differ from country to country; therefore this research has a narrow focus on the impact on Nigeria where very little work has been done. Accordingly, selective studies, which are of relevance to this research, will be examined.

There are instruments,⁵⁹ reports,⁶⁰ contributions by writers⁶¹ on different aspects of IP and IPR theories in relation to the impact of the TRIPS Agreement on developing countries. IP concerns which engage scholars include the globalisation of intellectual property rights through the WTO TRIPS Agreement, issues of access to medicine and access to knowledge. These areas have been regarded as problematic by numerous commentators⁶² whereas others

⁵⁷ Yu (2009) 1 *World Intellectual Property Organisation Journal* 8

⁵⁸ Germán Velásquez ‘Trade agreements, intellectual property and access to medicines: An introduction’ in WHO *Intellectual property and access to medicines: papers and perspectives* World Health Organization South-East Asia 2010 p.2; Mohamed Abou El Farag Balat and Mohamed Hossam Loutfi, The TRIPS Agreement and Developing Countries: A Legal Analysis of the Impact of the New Intellectual Property Rights Law on the Pharmaceutical Industry in Egypt, (2004) 2 *Web Journal for Current Legal Issues* 2-25; Mohammad Towhidul Islam ‘TRIPS Agreement and Economic Development: Implications and Challenges for Least-Developed Countries like Bangladesh’ (2010) 2 *Nordic Journal of Commercial Law* 1- 48; Ryan Cardwell and Pascal L. Ghazalian ‘The Effects of the TRIPS Agreement on International Protection of Intellectual Property Rights’ (2012) 26 *The International Trade Journal* 19-36

⁵⁹ Doha Declaration on TRIPS. See Also the Doha Declaration on TRIPS and Public Health Ten Years Later: The State of Implementation South Centre 2011 7 POLICY BRIEF 1.

⁶⁰ Jorn Sonderholm, Intellectual property rights and the TRIPS Agreement: an overview of ethical problems and some proposed solutions The World Bank, Policy Research Working Paper Series 01/2010, March 2010 WPS5228; Gower’s Review of Intellectual Property (HM Treasury, 2006 Report of UK Commission on Intellectual Property Rights (2002) available at <http://www.iprcommission.org> and http://www.hm-treasury.gov.uk/d/pbr06_gowers_report_755.pdf accessed 21 April 2012.

⁶¹ Keith E. Maskus, ‘Intellectual Property Rights and Economic Development’ 2000 32 *Case Western Reserve Journal of International Law* 471 available at <http://heinonline.org> Tue Mar 27 12:31:26 2012; Robert P. Merges *Justifying Intellectual Property* Harvard University Press Cambridge, Massachusetts 2011; Mark A. Lemley, ‘Property, Intellectual Property, and Free Riding’ Stanford Law School John M. Olin Program in Law and Economics Working Paper No. 291 August 2004; Frederick M. Abbott, ‘The Enduring Enigma of TRIPS: A Challenge for the World Economic System’ *Journal of International Economic Law* (1998) 497-521; Carlos M. Correa, *Intellectual Property Rights, the WTO and Developing Countries: The TRIPS Agreement and Policy Options* Zed book 2000.

⁶² Ulf Petrusson, ‘Patent and Open Access in the Knowledge Economy’ in Annette Kur and Vytautas Mizaras *The Structure of Intellectual Property Law Can One Size Fit All* Edward Elgar Cheltenham 2011 pp.56-96;

view them as presenting new opportunities for developing countries.⁶³ Among other controversial issues is access to patented innovations either through transfer of technology or foreign direct investments. These views are representation of various scholars.

For Levin⁶⁴ the TRIPS Agreement provokes a change in the lense with which to view IP, in order to promote new forms of discourse which are characterised by moral and human rights in relation to public health and powerful corporations.

Yu,⁶⁵ in a paper on the global intellectual property order, reviews the debate on intellectual property law and policy in the context of the TRIPS Agreement. The author raises concerns regarding the fundamental impact of the TRIPS Agreement, particularly in Africa, which have not been satisfactorily documented. According to him, policy makers erroneously ‘rely on data supplied by interested parties’ such as ‘trade groups and industry lobbies’ rather than undertake their own ‘analyses that are based on substantive evidence’. His view aptly captures the current situation in Nigeria.

The Commission on Intellectual Property Right⁶⁶ in its study⁶⁷ focuses on how developing countries have implemented the TRIPS Agreement and, in particular tries to determine whether the flexibilities provided within the Agreement have been utilised. The study primarily examines the implementation of section 5 of TRIPS Agreement, which covers patents, since this is the area in which most concerns have been raised. Many developing countries seem to ignore the flexibilities and pursue aims they cannot fulfil.

J.H. Reichman, ‘The TRIPS Agreement comes of Age: Conflict and Cooperation with Developing Countries’ 32 *Case Western Reserve Journal of International Law* pp. 442-470; Peter K Yu ‘The Global Intellectual Property Order and its Undetermined Future’ [2009] 1 *World Intellectual Property Organisation Journal* 8.

⁶³ J.H. Reichman, ‘The TRIPS Agreement comes of Age: Conflict and Cooperation with Developing Countries’ 32 *Case Western Reserve Journal of International Law* pp 442-470.

⁶⁴ Marianne Levin, ‘The Pendulum keeps Swinging- present discussion on and around the TRIPS Agreement’ in Annette Kur with Marianne Levin *Intellectual Property Rights in a Fair World Trade System* Edward Elgar Cheltenham 2011 3-60 p.27.

⁶⁵ Yu, *The Global Intellectual Property Order* p.9.

⁶⁶ The Commission was set up by the British government to look at how intellectual property rights might work better for poor people and developing countries. The aim was ‘...to look at the ways that intellectual property rules need to develop in the future in order to take greater account of the interests of developing countries and poor people.’ The first Commission meeting was in London on the 8th-9th May 2001, and the final report was published on 12th September 2002 available at <http://www.iprcommission.org/graphic/about.htm> accessed 21 April 2012.

⁶⁷ Phil Thorpe ‘Study on the Implementation of the TRIPS Agreement by Developing Countries’ Commission on Intellectual Property Rights Study Paper 7.

A recent study was commissioned by the Sweden Parliament and undertaken by the National Board of Trade to evaluate the effect of the WTO Agreements, especially on developing countries. The study pinpoints financial and economic implications, access to medicines, agriculture and genetic resources as the most important consequences of implementing the TRIPS Agreement.⁶⁸

WIPO⁶⁹ has contributed immensely to intellectual property rights. It administers 24 treaties that deal with IPRs. WIPO, through conferences, meetings, seminars and colloquiums has tried to analyse intellectual property issues and encourage the growth of international common principles and rules governing intellectual property by engaging in extensive consultations with states and other interested groups.⁷⁰ Among WIPO's principal tasks are the promotion of progressive development and the harmonisation of intellectual property laws, standards, and practices among its member states.⁷¹ In line with this goal, the WIPO recently initiated a Development Agenda to foster the realisation of these goals in developing countries. Its most recent campaign is to ensure that the intellectual property treaty regime empowers developing countries to modify their intellectual property laws as they deem essential in order to promote development and serve the welfare of their citizens.

Abbot⁷² explains that the correlation of IPRs and economic development is important. He opines that there is a likelihood that delays in implementing policies may help in closing the 'knowledge-based wealth' gap. On his part, Walker⁷³ posits that the paramount concern when reviewing the TRIPS Agreement should be to ascertain that the public interest elements of the TRIPS Agreement provisions permit governments to balance private rights with the public interest and allow for broad interpretation and application. Levin further notes that a

⁶⁸ National Board of Trade Sweden, 'Consequences of the WTO Agreements for Developing' p. 42 Countries.

⁶⁹ The World Intellectual Property Organisation (WIPO)[1] is the United Nations specialised agency that coordinates international treaties regarding intellectual property rights.

⁷⁰ WIPO, Development of Intellectual Property Law available at http://www.wipo.int/activities/en/development_iplaw.html accessed on the 21 April 2012.

⁷¹ WIPO, *Development of Intellectual Property Law*.

⁷² Abbott, Frederick M., 'The WTO TRIPS Agreement and Global Economic Development' (1997). Public Policy and Global Technological Integration, p. 57.

⁷³ Simon Walker, 'The TRIPS Agreement, Sustainable Development and the Public Interest' Discussion Paper IUCN, Gland, Switzerland and Cambridge, UK and CIEL, Geneva, Switzerland. 2001 xiv + 60pp. p.50.

motivation for the protection of intellectual property is in the interest of society if it creates a balance between the creators and interest of the society. The ‘advances in technology, economics and entrepreneurial market’ have changed the rule of normal exploitation and are dominated by the strengthening IP as private and personal rights⁷⁴ rather than the need for a balance.

A judge⁷⁵ of the court of appeal of South Africa has noted that the gap between the rich and poor countries is widening, in discussing the general question of the significance of IP to ordinary people in DCs’:

Many of those living in the South⁷⁶ reside in insulated communities cut off by a lack of infrastructure and education.⁷⁷ They cannot benefit from IP how can they understand the merit of its protection? People do not vote for their leaders because of their IP policies and their leaders have therefore no incentive to be concerned about IP. If one does not have bread, why should one protect gourmet recipes? It is to be argued that the provision of relevant information relating to the importance and relevance of IP to economic growth is inadequate and that there is need to consciously increase the awareness.

His statement captures the Nigeria situation, especially in relation to the lack of incentive by the government to protect IP, a lack of infrastructure and education and the fact that there is a high level of unawareness that IP can foster development.

Adebe,⁷⁸ in a policy brief, identifies a key element to the implementation and usage of intellectual property which is necessary to create the right environment for intellectual property protection in the need to ‘inform African policymakers about the full implications of implementing the TRIPS Agreement and its impacts upon their respective economies and societies’

⁷⁴ Marianne Levin, ‘The Pendulum keeps Swinging- present discussion on and around the TRIPS Agreement’ in Annette Kur with Marianne Levin *Intellectual Property rights in a Fair World Trade System* Edward Elgar Cheltenham 2011 3-60 p.5.

⁷⁵ L.T.C. Harms, ‘Offering Cake to the South,’ 22(10) *European Intellectual Property Review* 451 October 2000 p.451 (discussing the need for finding solution for the widening gap between the rich north and the poor south).

⁷⁶ Four-fifths of the world population cited in L.T.C. Harms ‘Offering Cake to the South’, p.451.

⁷⁷ Kamusella, ‘Globalisation or Semi-Globalisation’ (January 2000) *African Insight* p. 1 cited in L.T.C. Harms ‘Offering Cake to the South,’ 22(10) *European Intellectual Property Review* 451 October 2000 p.451.

⁷⁸ Adebe A. O, p. 3.

Apart from the importance of IP and the effect of the TRIPS Agreement on developing countries, scholars have examined the relevance of certain flexibilities in the TRIPS Agreement. The scope and interpretation of the TRIPS Agreement in relation to the flexibilities remains a challenge, particularly in the area of implementation, which has led scholars to provide guidelines to complying with the TRIPS Agreement which demonstrate that developing countries should embrace provisions that allow flexible interpretation.⁷⁹

From the above it is clear that the issues have been dealt with from the general perspective of developing countries. The situation in Nigeria, which has an unbalanced development, does not fit into that model.

The unavailability of statistical data and resources to carry out empirical research has led to a dearth of literature on IP generally, and research is relatively scarce on how the existing normative and institutional framework of the TRIPS Agreement impacts on Nigeria. A scant effort has been made to examine the effectiveness of the global structure in Africa, and Nigeria specifically, in the context of a developing country in relation to the above mentioned issues. Accordingly, it is proposed that the starting point of the research will be an examination of the nature and key features of intellectual property under Nigerian law based on the level of IP protection in the country's laws before the TRIPS Agreement. The TRIPS Agreement framework will then be used to examine the implications on Nigeria by highlighting the trends and prospects.

1.6 Significance of the Research

Considering the importance of IP globally today, it is important that a measure of the impact of the WTO TRIPS Agreement is carried out in all developing countries' to determine the effect on the various areas of IP covered by the TRIPS Agreement. The study aims to analyse Nigeria's laws and policies relating to IP with a view to determining whether or not they are consistent with the country's obligation under the TRIPS Agreement. By a review the government can determine the necessary policies to put in place to assist in developing the

⁷⁹ J.H. Reichman, 'From Free Riders to Fair Followers Global Competition under the TRIPS Agreement' (1996-1997) 9 New York University Journal of International Law and Politics 11- 94 p.92

educational, health and research and development sector, including the legal framework that best suits the country's purposes.

IP is vital to Nigeria's socio-economic existence and, thus, there is a strong justification for an evaluation of the impact of WTO TRIPS Agreement on the ability of certain sectors to fulfil their underlying goals and objectives. Over the last two decades, Nigeria has emerged as a major producer of intellectual resources such as entertainment works⁸⁰ and educational materials⁸¹ and, therefore, is an important player in the global IP scheme.

The work in this study aims to enhance the understanding of the options and legal strategies for striking a balance between the protection of the private interest of right owners and the public interest of users in ensuring access to intellectual property creations. In particular, the work will examine issues from the peculiar context of a developing economy as a primary producer and consumer of IP contents. By drawing lessons from the international arena, the research will examine the adequacy or otherwise of the existing framework on the protection of IPRs in Nigeria to deal with the challenges posed by the TRIPS Agreement. The thesis thus, will contribute towards developing legal strategies needed to enable Nigeria to respond positively to challenges. To this end this thesis emphasises the positive gains that can be derived from a balanced and beneficial human-oriented approach to intellectual property laws in Nigeria and in developing countries in general with a view to utilising the full benefits of the TRIPS Agreement..

1.7 Research Methodology

The methodology that will be used to undertake the research study consists of a situation analysis based on a literature review of available relevant research, data and statistical analyses.

⁸⁰ Nigeria has the third largest film industry in the world, and a thriving music industry evidenced by the various collaborations among Nigerian artist and Americans. For example, D'bang and Kanye West in the song Oliver Twist.

⁸¹ Such as literary works like books and articles. Nigerian are known contributors to various scholarly publication.

There has been no extensive review of the practical implications of the TRIPS Agreement on Nigeria, but there are some studies on Africa and other developing countries on relevant issues which may be used to analyse certain areas of the law. Legal instruments in the form of Conventions, Multilateral Treaties, local legislations and most especially the primary documentation of significance in this study, the WTO/TRIPS Agreement will be carefully examined and extensively assessed.

Due to the initial upheaval created by the TRIPS Agreement, there have been subsequent conferences and discussions relating to this Agreement which have produced numerous writing on the difference aspects of the TRIPS Agreement which will be examined where necessary. For a proper assessment of the issue, judicial decisions, text books and relevant articles in journals will be used for this study, including relevant research reports on the subject from the WTO and the WIPO. The research will refer to the international debates, including an analysis of several key negotiations.

Given the common law heritage of Nigeria, the importance of case law as a veritable source of the law, especially in non-statutory areas like the common law of tort on passing off, cannot be overemphasised and therefore will be used in the study if necessary.⁸²

1.8 Limitation of Research

Intellectual property is a wide area and touches on almost all facets of life. The focal concept of this research is on the impact of TRIPS Agreement on the intellectual property laws of Nigeria.

The main emphasis of this research is copyrights, trade marks and patents. This study does not include industrial designs, layout-designs (topographies) of integrated circuits, protection of undisclosed information and control of anti-competitive practices in contractual licences.

Despite the focus on copyrights, trade marks (geographical indications) and patents it is not possible to traverse the wide range of legal issues attached to them. For the analysis, the

⁸² Adejoke Oyewunmi, *Vanguard*, *op.cit.*

research focuses principally on the Copyrights Act, the Trade Marks Act and the Patents and Design Act. Other instruments will be referred to only where necessary.

A sector-specific analysis of the impact of IP will be looked at in terms of the consequence of compliance or non-compliance, as the case may be. The thesis will present only an estimate of the problems likely to be encountered.

The dearth of materials on intellectual property in Nigeria limits the available resources, however.

1.9 Chapter Overview

The research is organised into eight chapters, including the present one, as follows:

Chapter one encompasses the general introduction to the research which gives an overview of the importance of intellectual property to development and, as such, to developing countries. The research is located within the Nigerian context in order to explore the compliance of the Nigerian IP legislation with the TRIPS Agreement. To this end, the reason for the research is articulated to include the research questions that the study seeks to put into perspective. The research problem, as well as specific objectives of the study, the significance and limitation of the study and the methodology adopted is explained. The chapter concludes with a chapter overview.

Chapter two focuses on the international regulation of intellectual property rights. The chapter gives a brief overview of the major international organisations dealing with intellectual property rights. Nigeria is a member of the WTO and has adopted the WTO Agreements on trade and the TRIPS Agreement. The chapter traces the origin of international organisations to put in context the derivation of the Conventions and the Agreements.

Chapter three: The TRIPS Agreement is examined in this chapter as the basis upon which the Nigerian legislation will be analysed, compared and contrasted for the purposes of determining compliance. The chapter examines the objectives and principles of the TRIPS Agreement. This discussion is followed by an examination of the substantive provisions of the

TRIPS Agreement on copyright, trade marks and patents to determine the basic meaning given to the various provisions. Enforcement proceedings under the TRIPS Agreement also are examined here.

Chapter four deals with the copyright aspect of intellectual property rights. The origin of the Copyright Act in Nigeria is examined as well as the amendments to the law. An overview is offered of the protection afforded by the Copyright Act, such as eligibility for copyright, authorship and ownership, moral rights, scope and duration of copyright and neighbouring rights as embodied in the Copyright Act and Regulations. The chapter assesses the compliance of the Copyright Act to the relevant copyright provisions in the TRIPS Agreement. The purview of this chapter covers related rights. The chapter examines the relationship of the TRIPS Agreement to the Berne Convention. The impact of the TRIPS Agreement will be investigated to determine its possible socio-economic effect on Nigeria. The chapter additionally examines the flexibilities in the TRIPS Agreement and the necessary modification required for a better and more effective Copyright Act.

Chapter five focuses on the trade marks legislation. The chapter examines the origin and specific provision on the protection of trade marks such as the various definitions of marks, the requirements for an application, duration and renewal of a trade mark, cancellation and removal of a trade mark, requirement of use, assignment and licensing, rights conferred by registration and foreign applications. The compliance of the Trade Marks Act to the TRIPS Agreement is undertaken in this chapter to determine if the Trade Marks Act complies with the required provision of the TRIPS Agreement and its possible effect on the law. The chapter briefly examines geographical indication, its rationale for protection and the possible protection under the Trade Marks Act and other laws. Also the impact of the TRIPS Agreement in relation to socio- economic development and society is assessed. The chapter also includes the flexibilities available under the TRIPS Agreement for trade marks protection.

Similarly, chapter six provides an overview of the patent law from its origin, nature and scope of protection, to the grant of protection, revocation and administration of protection. The

chapter compares the compliance of the substantive law on patents in Nigeria with specific legal aspects of the TRIPS Agreement on patent protection and examines patentable subject matter, rights conferred, exceptions and uses without authorisation, amongst others. The effect of the TRIPS Agreement on patent law will be examined, particularly in relation to public health, transfer of technology and FDI, highlighting the difficulties encountered so far. The flexibilities which the TRIPS Agreement provides in relation to patent protection are discussed in relation to Nigeria's taking advantage of them and using them to formulate patent laws that will foster a sound and viable technological base. NOTAP⁸³ is briefly discussed in regard to its work with patents and the transfer of technology.

Chapter seven discusses the enforcement measures and challenges. This chapter is divided into two sections: A and B. Section A of the chapter covers the legal system in relation to IP protection, the courts and the laws responsible for the protection of IP are explored. Civil and criminal procedures, as well as remedies such as damages, injunctions and imprisonment are analysed to ascertain their compliance with the TRIPS Agreement. Border measures available for IP enforcement are discussed, as well as other agencies responsible for the protection of IP. Flexibilities in relation to enforcement are also examined. Section B touches on some of the challenges to IP development in relation to the law, policy, education, research and development in Nigeria.

Chapter eight on conclusions and recommendations provides a summary of the research findings, draws together the various conclusions reached in the study and proffers suggestions and recommendations aimed at improving the *status quo*.

⁸³ NOTAP means National Office Technology Acquisition and Promotion, National Office Technology Acquisition and Promotion (NOTAP) Act was specifically enacted in 1979 'to monitor, on a continuing basis, the transfer of foreign technology to Nigeria' and at that time it was known as the National Office of Industrial Property (NIOP).

CHAPTER 2**Intellectual Property in International Context****Summary**

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2.1 Introduction

This chapter briefly examines the key organisations that regulate the area of intellectual property at the international level, mainly WIPO and the WTO, outlining their focal areas and stating their divergences in approaching intellectual property rights. In addition, other organisations, such as the World Health Organisation (WHO) where the impact of the TRIPS Agreement has featured prominently for some years and the United Nations Educational, Scientific and Cultural Organisation (UNESCO) which houses a number of intellectual treaties, will be examined. The administration of international intellectual property was carried out mainly by the World Intellectual Property Organisation (WIPO). WIPO is the internationally designated body responsible for the supervision of intellectual property matters. However, in the last two decades, the discussion of intellectual property has shifted to other forums,¹ particularly to the World Trade Organisation (WTO), on account of the inclusion of intellectual property rights (IPRs) in the WTO Agreements.

The WTO Agreement on intellectual property, which is the crux of this study, was negotiated as part of a bundle of WTO Agreements from 1986 to 1994 in the course of the ‘Uruguay

¹ World Health Organization, International Labor Organization (ILO), Convention on Biological Diversity (the CBD) and Non-Governmental Organizations (NGO’s).

Round'. The Agreement launched intellectual property rules into the multilateral trading system for the first time.² The adoption of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS),³ as an international IP treaty forming part of the WTO bundle of trade-related agreements, by providing a link between IP and trade, has given IPRs a different face.

The protection of intellectual property has become an issue of specific attention for most developing countries since the TRIPS Agreement came into force in 1995. The TRIPS Agreement, for the first time in the history of intellectual property conventions and treaties covers seven classes of intellectual property in one instrument, consisting of Copyright and Related Rights, Trade marks, Geographical Indications, Industrial Designs, Patents, Layout-Designs of Integrated Circuits and Protection of Undisclosed Information. The intent of the TRIPS Agreement was that it would be used to strengthen and harmonise specific features relating to the protection of intellectual property at the global level.⁴

Following the adoption of the TRIPS Agreement, the WIPO and the WTO signed a Cooperation Agreement⁵ to establish a mutually supportive relationship between them,⁶ making these two organisations the main international organisations responsible for the protection of IPRs at the international level. These two international organisations, as provided under the Cooperation Agreement, are expected to establish appropriate arrangements for the collection of laws and regulations, implement Article 6*ter* of the Paris Convention for the purposes of the TRIPS Agreement,⁷ and provide legal-technical assistance and technical cooperation.⁸

² Understanding the WTOThe Agreements, Intellectual Property: Protection and Enforcement available at http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm accessed 27 February 2012.

³ The Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as 'the TRIPS Agreement').

⁴ Globalization and Access to Drugs - Health Economics and Drugs Series, No. 007 Health Economics and Drugs DAP Series No. 7 Revised.

⁵ WTO-WIPO Cooperation Agreement 1995.

⁶ The preamble WTO-WIPO Cooperation Agreement 1995.

⁷ Article 3 WTO-WIPO Cooperation Agreement 1995.

⁸ Article 4 WTO-WIPO Cooperation Agreement 1995.

In addition, this chapter will also examine the theories proffered by scholars to justify compliance or non-compliance to the TRIPS Agreement by countries and also assess how they fit within the context of this study.

2.2 Theories on the Recognition and Reception of International Law

This section seeks to determine the theoretical concept that supports the basic assumption that underpins this study. A brief overview of the theories on the recognition and reception of international law into domestic law that have been advanced by legal and non-legal scholars in the literature will be examined. As noted by Oppong the ‘role of law in economic integration can be discussed from multiple perspectives’,⁹ accordingly the various theories relating to the recognition and reception will be outlined.

Some of theories relating to the reception of international laws include the dualism and the monism theories. Dualism as discussed by Schütze¹⁰ is where international law is considered separate form domestic law. This theory views international law as between states and national law is the law as within a state. He further explains that ‘while international treaties are thus binding “on” states they cannot be binding “in” states’. Accordingly this theory requires international law to be incorporated into national laws or the domestic realm in order to have the effect of law. Monism on the other hand, is where a state makes international law part of the national law. This theory is based on the fact that national laws are derived from international laws.¹¹

Another theory that has been advanced in relation to the recognition and reception of international law is the relational theory. Downie and Llewellyn explain relational theory has

⁹ Richard Frimpong Oppong *Legal Aspects of Economic Integration in Africa* Cambridge University Press Cambridge 2011 p.9.

¹⁰ Robert Schütze *European Constitutional Law* Cambridge University Press Cambridge 2012 p.306; see also Borchard, Edwin, "Relation Between International Law and Municipal Law" (1940). *Faculty Scholarship Series*. Paper 3498.

¹¹ Emilian Ciongaru, The monistic and the dualistic theory in European law Institute of Legal Research „Acad. Andrei Radulescu” of Romanian Academy available at http://www.ugb.ro/Juridica/Issue1EN/10_Teoria_monista_si_dualista_in_dreptul_europeanCiongaruEN.pdf accessed 01 November 2014.

been ‘grounded in a shared core belief that the object/subject of attention should be understood in relation to others and as *being in* relation to others.’¹²

These perspectives provide a rationale for the examination of the nexus between the TRIPS Agreement and the Nigerian laws. The relational theory is relevant to this study in the sense that there is a need to determine the relationship between the TRIPS Agreement and the Nigerian IP laws *vis-a-vis* the need to comply with its WTO obligations. In addition the dualism theory is preferred because the TRIPS Agreement is an international treaty that can only become meaningful when it is implemented into law in the various countries.

The Nigerian legal structure supports the relational and dualism theories: First the Nigerian constitution includes an important element, which makes it clear that international treaties will only have an effect if they are domesticated,¹³ meaning that the international treaty has to be passed into law by the National Assembly for it to have the effect of law contemplated in the international instrument. In addition the various Nigerian IP laws require that a declaration be made in the Federal *Gazette* for the treaty to have effect in Nigeria.¹⁴ It is clear that treaties made by the executive arm of the government needs to pass through the legislative arm to be passed into law.

The idea behind these theories is that the TRIPS Agreement is only enforceable in Nigeria if it is implemented into the national laws of Nigeria. It is clear that in Nigeria the Constitution and the domestic laws prevail over international treaties. This provision may be a two-edged sword meaning that certain obligations may not be incorporated, but certain important rights¹⁵ may also not be implemented into law by the legislature. For instance Nigeria is a signatory and has ratified several international conventions on Human Rights¹⁶ for over 20 years and more but they have still not been domesticated into national laws.

¹² Jocelyn Downie and Jennifer Llewellyn ‘Relational Theory & Health Law and Policy’ 2008 Special edition *Health Law Journal* 195.

¹³ Section 12. (1) of the Constitution of Nigeria provides ‘No treaty between the Federation and any other country shall have the force of law to the extent to which any such treaty has been enacted into law by the National Assembly.

¹⁴ Section 44(5) Trademarks, Section 27 PDA 2004

¹⁵ Right to health and right to development.

¹⁶ International Covenant on Civil and Political Rights (ICCPR) 29 July, 1993; International Covenant on Economic, Social and Cultural Rights (ICESCR) 29 July, 1993; Optional Protocol on ICCPR concerning

In the case of the TRIPS Agreement, this is a significant provision that gives domestic discretion in matters of IP law and policy. It offers more flexibilities to Nigeria in determining how to formulate IP laws in such a way that it would be compliant with Nigeria's WTO obligations. At the same time it protects the advancement of intellectual property rights to contribute to the promotion of technological innovation in a manner conducive to social and economic welfare and to balance the rights and obligations¹⁷ as well as to promote the public interest in sectors of vital importance to their socio-economic and technological development.¹⁸

More fundamentally, this theory justifies that the TRIPS Agreement is only meaningful if implemented into the Nigerian law. This supports Cann's suggestion that national constitutions should create a hierarchy of values¹⁹ considering the fact that the protection of intellectual property has become an issue of specific attention from a developing country's perspective since the TRIPS Agreement came into force in 1995. The major issue relating to the impact of the TRIPS Agreement is the harmonisation of national intellectual property laws with the global 'minimum standards in virtually all areas of intellectual property protection' in order to achieve compliance with the TRIPS Agreement, without taking into consideration the level of the development of the member. This is a key feature and raises concern among developing countries (DCs), in view of the fact that the TRIPS Agreement is binding on all members with no reservations possible.

individual petition; Convention against Torture and other Cruel, Inhuman or Degrading Treatment or Punishment (CAT) 28 June, 2001; International Convention on the Elimination of all Forms of Racial Discrimination (CERD) 16 October, 1967; Convention on the Elimination of All Forms of Discrimination Against Women (CEDAW) 23rd April, 1984; Optional Protocol on the Elimination of all Forms of Discrimination Against Women (22nd November, 2004); Convention on the Rights of the Child (CRC) 19th April, 1991; Convention relating to the Status of Refugees (23rd October, 1967); Protocol relating to the Status of Refugees (2nd May, 1968); Geneva Convention relative to the Protection of Civilian Persons in Time of War (10th October, 1988); United Nations Convention Against Corruption (9th December, 2003).

¹⁷ Article 7 TRIPS Agreement.

¹⁸ Article 8 TRIPS Agreement.

¹⁹ Wesley A Cann, On the Relationship between Intellectual Property Rights and the Need of Less-Developed Countries for Access to Pharmaceuticals: Creating a Legal Duty to Supply under a Theory of Progressive Global Constitutionalism (2004) 25 *University of Pennsylvania Journal of International Economic Law* 755 at 784.

2.3 World Intellectual Property Organisation

The World Intellectual Property Organisation (WIPO) is a specialist international organisation for the regulation and protection of intellectual property.²⁰ WIPO, in its current form, was founded by the ‘Convention Establishing the World Intellectual Property Organisation,’ signed at Stockholm on July 14, 1967. This Convention entered into force in 1970.

The need for an international organisation on intellectual property dates back to 1883. This became necessary because of the refusal of foreign exhibitors to attend the International Exhibition of Inventions in Vienna in 1873. The fear of the exhibitors was the possibility of the misappropriation and exploitation of their ideas in foreign countries without their consent and there was no law or institution preventing such use.

Accordingly, in 1883, the first step towards an international treaty on intellectual property was taken which resulted in the Paris Convention for the Protection of Industrial Property.²¹ The Convention was designed to assist nationals of one country to secure protection for their intellectual creations in the form of inventions, trade marks and industrial designs in other countries. When the Paris Convention entered into force in 1884, there were only 14 member states and an International Bureau was established to carry out administrative tasks, such as organising meetings of the member states.²²

In 1886, the Berne Convention for the Protection of Literary and Artistic Works²³ heralded the arrival of copyright into the international arena. As in the case of the Paris Convention,

²⁰ Peter Drahos, ‘Global Property Rights in Information: The Story of TRIPS at the GATT’ in Christopher May (ed) *The Political Economy of Intellectual Property Rights* Vol. II Edward Elgar Cheltenham 2010 p. 4.

²¹ Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979 (hereinafter referred to as the Paris Convention or the Convention) .

²² WIPO - *A Brief History* available at <http://www.wipo.int/about-wipo/en/history.html> accessed 09 November 2012.

²³ Berne Convention for the Protection of Literary and Artistic Works 1 of September 9, 1886, completed at PARIS on May 4, 1896, revised at BERLIN on November 13, 1908, completed at BERNE on March 20, 1914, revised at ROME on June 2, 1928, at BRUSSELS on June 26, 1948, at STOCKHOLM on July 14, 1967, and at PARIS on July 24, 1971, and amended on September 28, 1979(hereinafter referred to as the Berne Convention or the Convention).

the purpose of this Convention was to assist nationals of a particular member state to attain international protection in relation to their right to control, receive payment, and regulate the use of their creative works.²⁴ The two Conventions allowed for the formation of an ‘International Bureau’ or secretariat.²⁵ Both Bureaus unified in 1893 and functioned under the name ‘United International Bureau for the Protection of Intellectual Property’, known by its French acronym BIRPI²⁶ and referred to as the WIPO’s predecessor.²⁷

As intellectual property became more important the functions of BIRPI changed, which caused it to move to Geneva.²⁸ The Convention establishing WIPO was concluded in 1967. In 1970 WIPO Convention became effective as the WIPO was established to take over from BIRPI.²⁹ The structure and the administration of the Organisation were modified and the secretariat became answerable to member states.³⁰

In 1974, WIPO joined the United Nations system of organisations to become a specialised agency.³¹ As a specialised agency, WIPO retains its independence and has its own

²⁴ Novels, short stories, poems, plays, songs, operas, musicals, sonatas, drawings, paintings, sculptures and architectural works.

²⁵ World Intellectual Property Organization <http://www1.american.edu/initeb/qj8944a/wipo.htm> accessed 09 November 2012.

²⁶ Anthony Taubman, *A Practical Guide to Working with TRIPS* Oxford University Press, Oxford 2011, p. 4 See also World Intellectual Property Organization <http://www1.american.edu/initeb/qj8944a/wipo.htm> accessed 09 November 2012.

²⁷ WIPO, A Users’ Guide. *An Introduction to the Organisation*, WIPO Publication No. 1040E 2012 Edition p.4.

²⁸ Geneva is where most of the International Organization Headquarters are so BIRPI moved from Berne to Geneva in 1960 to be closer to the United Nations and other international organizations.

²⁹ WIPO, *Intellectual Property Handbook: Policy, Law and Use* WIPO PUBLICATION No. 489 (E) 2008 p.3.

³⁰ WIPO, *A Brief History*. The revision necessary because member States wanted to assume the position of full governing body of the Organization (WIPO), thereby, removing the supervisory authority of the Swiss Government, giving WIPO the status comparable to other intergovernmental organizations and to create a suitable for becoming a specialized agency of the United Nations.

³¹ Article 1 Agreement between the United Nations and the World Intellectual Property Organization December 17, 1974.

membership.³² Currently there are 187 member states,³³ with each member state having an equal vote according to the general UN policy.³⁴ Today, WIPO, administers 25 treaties.³⁵

The principal responsibility of WIPO is twofold:

- i. to promote the protection of intellectual property throughout the world through cooperation among States and, where appropriate, in collaboration with any other international organisation; and
- ii. to ensure administrative cooperation among the intellectual property Unions,³⁶ that is, ‘the Paris Union, the Special Unions and Agreements established in relation with that Union, the Berne Union, and any other international agreement designed to promote the protection of intellectual property whose administration is assumed by the Organisation according to Article 4(iii).’³⁷

According to Okediji, WIPO’s inclusion in the UN system was not about improving its responsibility to the global community; rather it was about strengthening its authority in the area of intellectual property.³⁸

Undeniably, WIPO’s establishing documents did not take into consideration a ‘global IP system’ nor did it reflect on the possibility of an ‘integrated global economic system’.³⁹

³² Article 5 Convention Establishing the World Intellectual Property Organization (Signed at Stockholm on July 14, 1967 and as amended on September 28, 1979 Membership. *Ibid.* WIPO *Intellectual Property Handbook* p.3.

³³ Member States available at <http://www.wipo.int/members/en/> accessed 03 June 2014.

³⁴ Daniel Gorman World Intellectual Property Organization (WIPO) generated from the Globalization and Autonomy Online Compendium. The electronic original is available at http://www.globalautonomy.ca/global1/glossary_entry.jsp?id=OR.0015 accessed 09 November 2012.

³⁵ WIPO-Administered Treaties available at <http://www.wipo.int/treaties/en/> accessed 09 November 2012; Notably, three Treaties are jointly administered by WIPO with other international organizations. The Rome Convention 1961 for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations is administered in cooperation with UNESCO and the International Labour Office (ILO), the Geneva Convention for the Protection of Producers of Phonograms against unauthorized duplication of their phonograms administered in cooperation with UNESCO and the Brussels Convention relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite 21 May 1974 administered in cooperation with UNESCO.

³⁶ Article 3 Convention Establishing the World Intellectual Property Organization (Signed at Stockholm on July 14, 1967 and as amended on September 28, 1979).

³⁷ Article 2(vii) Convention Establishing the World Intellectual Property Organisation (Signed at Stockholm on July 14, 1967 and as amended on September 28, 1979).

³⁸ Ruth L. Okediji, *WIPO-WTO Relations and the Future of Global Intellectual Property Norms*, *Legal Studies Research Paper Series Research Paper No. 09-07*, electronic copy available at: <http://ssrn.com/abstract=1338902> accessed 7 November 2011 p.9.

³⁹ Okediji, p.14.

However, from 1980-1984⁴⁰ an attempt to revise the Paris Convention through WIPO was initiated at the request of developing countries.⁴¹ The rationale for the revision was to bring the Convention in line with modern requirements of the developing nations, by assisting developing countries to fashion their own patent systems that will foster the transfer of technology and promote a unified system among countries which have diverse systems of industrial property protection.⁴² The revision ended in a deadlock⁴³ and, as remarked by Oguamanam, the status of WIPO as a reliable venue became questionable.⁴⁴

The United States and Europe were dissatisfied and were critical of the negotiations that took place at the WIPO. They thus demanded a more institutionalised framework that could provide stricter intellectual property protection and enforcement standard.⁴⁵ Consequently, negotiations in the WTO culminated in the adoption of the TRIPS Agreement. Generally, it is thought that more powerful countries used their economic resources and skills to influence the systems to express their interests. According to Helfer, it is ‘a belief borne out by the success of the United States and the EU in shifting intellectual property lawmaking from WIPO to GATT to TRIPS’.⁴⁶

This shift has occasioned a fundamental change in the scope of protection and services provided by WIPO which has profoundly developed overtime to now focus on:

- i. harmonisation of national intellectual property laws, provision of services for international applications for industrial property rights,⁴⁷

⁴⁰ Diplomatic Conference on the revision of the Paris Convention PR/DC/INF/1-50; PR/DC/1-57

⁴¹ Regina Loughran, ‘The United Sate Position on Revising the Paris Convention: Quid Pro Quo or Denunciation’ (1981-1982) 5 *Fordham International Law Journal* 411 p.412; Chidi Oguamanam *Intellectual Property in Global Governance: A Development Question* Routledge Oxon 2012 p.60.

⁴² WIPO: ‘Revision of the Paris Convention,’ 13 *Journal World Trade Law* 564, 575-77.

⁴³ Subrata Roy Chowdhury, Erik M. G. Denters, Paul J. I. M. de Waart (eds) *The Right to Development in International Law* Martinus Nijhoff Publishers The Netherlands 1992, p. 299.

⁴⁴ Chidi Oguamanam *Intellectual Property in Global Governance: A Development Question* Routledge Oxon 2012 p.60.

⁴⁵ Laurence R. Helfer, ‘Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Law making’ 2004 *Yale Journal of International Law*, 29, available at <http://ssrn.com/abstract=459740> accessed 04 April 2012.

⁴⁶ Helfer, *Regime Shifting* p. 4 citing Steve Lohr, ‘The Intellectual Property Debate Takes a Page from 19th Century America’, *New York Times*, Oct. 14, 2002, at C4.

⁴⁷ For Example the PCT application system.

- ii. exchange of intellectual property information, providing legal and technical assistance to developing and other countries
- iii. facilitation of the resolution of private intellectual property disputes and positioning information technology as a tool for storing, accessing, and using valuable intellectual property information'.⁴⁸

In addition, in October 2007 the General Assembly adopted a 'Development Agenda' consisting of 45 recommendations aimed at 'strengthening the development dimension in all areas of WIPO's work' which has been incorporated into the conventional WIPO program.⁴⁹ The Development Agenda has been lauded as 'a milestone in achieving the historic aspiration of developing countries for a paradigm shift in the international perspective of intellectual property, a shift from viewing IP as an end in itself, to viewing it as a means to serve the larger public goals of social economic and cultural development'.⁵⁰ The Development Agenda is seen as a turning point in the interpretation of IP globally. The implementation of which is yet to be accomplished.

After the adoption of the TRIPS Agreement, WIPO and WTO signed a bilateral Agreement to cooperate on issues of the protection and enforcement of intellectual property given that WIPO presides over the Paris and the Berne Conventions, which constitute substantive part of the TRIPS Agreement. In essence the WTO acknowledges that WIPO is the expert in the field of IP. This creates a focal point for interactions between WIPO and the WTO.⁵¹

2.4 World Trade Organisation (WTO)

2.4.1 Background: The General Agreement on Tariffs and Trade

The establishment of the World Trade Organisation (WTO) as an international organisation with a legal identity and the responsibility for managing international trade began on 1 January 1995. Prior to the adoption of the WTO Agreements, for 47 year⁵² the General

⁴⁸ WIPO - *A Brief History*.

⁴⁹ WIPO A Users' Guide An Introduction to the Organization WIPO Publication No. 1040E 2012 Edition p.10

⁵⁰ Statement by Egypt on behalf of the Developmental Agenda Group (DAG) WIPO Committee on Development and Intellectual Property (CDIP) Fifth Session, 26-30 April 2010.

⁵¹ Taubman, *A Practical Guide to Working with TRIPS* p. 4.

⁵² The GENERAL AGREEMENT ON TARIFFS AND TRADE ("GATT 1947") was born on 30 October 1947 and came into effect on Jan. 1, 1948. The GATT was signed by 23 nations at the Palais des Nations in Geneva.

Agreement on Tariffs and Trade (GATT)⁵³ was the provisional international arrangement which oversaw international commerce.⁵⁴

After the Second World War, there was a desire to establish institutions that would enhance peace and eliminate the economic causes of war by establishing three international economic institutions, namely, the International Monetary Fund (IMF), the World Bank and the International Trade Organisation (ITO): these are known as the ‘Bretton Woods’ institutions.⁵⁵ The discussions concerning the establishment of IMF and the World Bank were successful whereas the discussion on an ITO collapsed, largely due to the apathy shown by certain governments⁵⁶ concerning the ratification of the Havana Charter. Accordingly, the GATT was used as a stop gap pending the formation of the commercial-policy provisions of the ITO, positioning GATT as an international instrument overseeing international trade, enforcement and dispute settlement.⁵⁷

The motive behind the GATT was to establish an arrangement that would create a ‘substantial reduction of tariffs and other barriers to trade and eliminate discriminatory treatment in international commerce’.⁵⁸ From 1947 to 1967, the GATT trade rounds focused mainly on decreasing tariffs. However, during the Kennedy Round,⁵⁹ the issue of dumping⁶⁰

⁵³ The GATT was a set of multilateral trade agreements intended for the abolition of quotas and the reduction of tariff duties among the contracting nations. When GATT was concluded there were only 23 countries at Geneva, in 1947. The 23 founding members were: Australia, Belgium, Brazil, Burma, Canada, Ceylon, Chile, China, Cuba, Czechoslovakia, France, India, Lebanon, Luxembourg, Netherlands, New Zealand, Norway, Pakistan, Southern Rhodesia, Syria, South Africa, United Kingdom and the United States.

⁵⁴ Encyclopædia Britannica Online, s. v. ‘General Agreement on Tariffs and Trade (GATT),’ accessed 01 November 2012, <http://www.britannica.com/EBchecked/topic/228333/General-Agreement-on-Tariffs-and-Trade>.

⁵⁵ Understanding the WTO: The GATT years: from Havana to Marrakesh available at http://www.wto.org/English/thewto_e/whatis_e/tif_e/fact4_e.htm accessed 1 November 2012.

⁵⁶ The United States Congress showed the most opposition despite the fact that the US government had been one of the driving forces, and the announcement by the US government in 1950, that it would not seek Congressional ratification of the Havana Charter caused its failure.

⁵⁷ Press Brief Fiftieth Anniversary of the Multilateral available at http://www.wto.org/english/thewto_e/minist_e/min96_e/chrono.htm accessed 01 November 2012.

⁵⁸ The Preamble, THE GENERAL AGREEMENT ON TARIFFS AND TRADE (“GATT 1947”) available at <http://www.worldtradelaw.net/uragreements/gatt.pdf> accessed 01 November 2012.

⁵⁹ The Kennedy Round which lasted from 1964-1967 was the sixth session of General Agreement on Tariffs and Trade (GATT) trade negotiations held in Geneva, Switzerland.

⁶⁰ This refers to ‘a situation of international price discrimination, where the price of a product when sold in the importing country is less than the price of that product in the market of the exporting country. Thus, in the simplest of cases, one identifies dumping simply by comparing prices in two markets.’ Explained in the

was presented as a result of lower tariff rates which, in turn, led to anti-dumping duties being increasingly charged. The original GATT agreement⁶¹ was inadequate in dealing with the issue. This led to the negotiation of the Kennedy Round Anti-dumping Code of 1967 containing an agreement on Anti-dumping practice and the Tokyo Round Anti-dumping Code of 1980 which was an Agreement on the implementation of Article VI⁶² of the GATT.⁶³

The Tokyo Round served as a platform for greater reforms to come. During the Round a series of agreements were negotiated,⁶⁴ but they were not multilateral and the adoption of the agreements was not mandatory. The agreements were informally called Codes since they were not acknowledged by all members.⁶⁵ One major achievement of the Round was the ‘reduction of import duties as well as other trade barriers by industrial countries on tropical products exported by developing countries’.⁶⁶ This Round set the stage for the more important Uruguay Round.

2.4.2 The Uruguay Round

The eighth Round of the GATT the ‘Uruguay Round’ brought about more significant changes to the traditional discussion of GATT issues. The Uruguay Round, called ‘the Rounds of all Rounds’, is the largest trade negotiation ever to have taken place. In 1986 there

Technical Information on anti-dumping on the WTO website available at http://www.wto.org/english/tratop_e/adp_e/adp_info_e.htm#gattwto accessed 01 November 2012.

⁶¹ Article VI The General Agreement On Tariffs And Trade (“GATT 1947”).

⁶² Article VI: Anti-dumping and Countervailing Duties General Agreement on Tariffs and Trade 1994.

⁶³ Rüdiger Wolfrum, Peter-Tobias Stoll, Michael Köbele (eds.), *WTO: Trade Remedies* Max Planck Commentaries on World Trade Law, Martinus Nijhoff Publishers. The Netherlands 2008 p.201-203; see also Technical Information on anti-dumping available at http://www.wto.org/english/tratop_e/adp_e/adp_info_e.htm#gattwto.accessed 01 November 2012.

⁶⁴ Subsidies and countervailing measures — interpreting Articles 6, 16 and 23 of GATT, Technical barriers to trade — sometimes called the Standards Code, Import licensing procedures, Government procurement, Customs valuation — interpreting Article 7, Anti-dumping ,interpreting Article 6, replacing the Kennedy Round code, Bovine Meat Arrangement, International Dairy Arrangement, Trade in Civil Aircraft.

⁶⁵ Understanding the WTO: The GATT years: from Havana to Marrakesh accessed 01 November 2012, http://www.wto.org/English/thewto_e/whatis_e/tif_e/fact4_e.htm.

⁶⁶ Press Brief Fiftieth Anniversary of the Multilateral available at http://www.wto.org/english/thewto_e/minist_e/min96_e/chrono.htm.accessed 01 November 2012.

were originally 15 subjects⁶⁷ on the agenda, which was extended⁶⁸ before the completion of the round. Considering the number of subjects on the agenda it was not easy for members to come to a consensus on all these issues. In particular, the issue of intellectual property on the agenda made a lot of contracting parties⁶⁹ very uneasy, considering the fact that intellectual property was under the auspices of the WIPO.

Before the launch of the Ministerial Conference in Punta del Este in September 1986, the United States⁷⁰ and Japan had submitted proposals to the preparatory Committee which covered all areas of intellectual property rights and their enforcement. Other countries, such as Brazil and Argentina, opposed the introduction of IP in the new Round.⁷¹ The majority text of Colombia and Switzerland was passed on to the preparatory Committee which later represented the foundation of the Uruguay Round.⁷² The negotiations of the issues during the Round were concluded in April 1994, with the signing of the WTO Agreements⁷³ in Marrakesh, Morocco, which led to the creation of the WTO. The WTO was established by a single Treaty with many annexed-agreements.⁷⁴

2.4.3 The Emergence of the WTO

As a result of these developments,⁷⁵ the WTO was established and substituted for the GATT as an international organisation dealing with trade. The process took seven and a half years,

⁶⁷ Tariffs, Non-tariff barriers, Natural resource products, Textiles and clothing, Agriculture, Tropical products, GATT articles, Tokyo Round codes, Anti-dumping, Subsidies, Intellectual property, Investment measures, Dispute settlement, The GATT system Services.

⁶⁸ New point of conflict includes Regionalism, the environment, investment, electronic commerce and labour standards.

⁶⁹ The signatories to the GATT were called 'contracting parties' because the GATT was basically a contract.
⁷⁰ PREP.COM (86) W/46 8 July 1986.

⁷¹ The evidence of this can be seen in the proposals submitted by the Group of Ten (Argentina, Brazil, Cuba, Egypt, India, Nicaragua, Nigeria, Peru, Tanzania and Yugoslavia) PREP. COM(86)W/41 23 June 1986.

⁷² Gervais, *The TRIPS Agreement* para 1.11 p.10.

⁷³ Stoll, Busche and Arend, *WTO-Trade related aspects of Intellectual Property Rights*, Max Planck Commentaries on World Trade Law, Martinus Nijhoff Publishers 2009 Vol.7 para.18 p. 5: This led to the signing of 40 individual agreements by members States.

⁷⁴ Peter Van Den Bossche and Werner Zdouc *The Law and policy of the World Trade Organisation* Cambridge university Press New York 2013 p. 41

⁷⁵ That is the conclusion of the Uruguay Round and the signing of a bundle of Agreements on Trade related matters.

with 123 countries involved in the trade negotiations at the conclusion of the Round. Presently, there are 159 members of the WTO⁷⁶ and 25 observers.

The structure of the Final Act of WTO Agreements includes three main categories: the Multilateral Agreements on Trade in Goods⁷⁷ which contains the General Agreement on Tariffs and Trade 1994 and other Agreements,⁷⁸ the General Agreement on Trade in Services (GATS)⁷⁹ and Trade-Related Aspects of Intellectual Property Rights (TRIPS).⁸⁰ Other areas of the multilateral Agreement include Disputes Settlement,⁸¹ Trade Policy Reviews Mechanism (TPRM)⁸² and Plurilateral Trade Agreements.⁸³ The TRIPS Agreement was not the first international treaty on intellectual property. IP was well established internationally,⁸⁴ which led to the retention of the existing Conventions on intellectual property⁸⁵ to be integrated into the TRIPS Agreement.

⁷⁶ 159 members as at 2 March 2013 available at http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm accessed 6 March 2014.

⁷⁷ General Agreement on Tariffs and Trade 1994, Marrakesh agreement Establishing the World Trade Organisation (WTO Agreement Annex 1A http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012.

⁷⁸ General Agreement on Tariffs and Trade 1994 (GATT 1994) Agreement on Agriculture, Agreement on the Application of Sanitary and Phytosanitary Measures, Agreement on Textiles and Clothing, Agreement on Technical Barriers to Trade, Agreement on Trade-Related Investment Measures, Agreement on Preshipment Inspection, Agreement on Rules of Origin, Agreement on Import Licensing Procedures, Agreement on Subsidies and Countervailing Measures, Agreement on Safeguards.

⁷⁹ General Agreement on Trade in Services, Marrakesh agreement establishing the World Trade Organisation (WTO Agreement Annex 1B available at http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012.

⁸⁰ Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organisation (WTO Agreement) Annex 1C available at http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012.

⁸¹ Understanding on Rules and Procedures Governing the Settlement of Disputes, Marrakesh Agreement Establishing the World Trade ORGANISATION (WTO Agreement) Annex 2 available at http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012.

⁸² Trade Policy Review Mechanism, Marrakesh agreement establishing the World Trade ORGANISATION (WTO Agreement) Annex 3 available at http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012.

⁸³ Plurilateral Trade Agreements, Marrakesh agreement establishing the World Trade ORGANISATION (WTO Agreement) Annex 4 available at http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm accessed 02 November 2012. This also includes agreements such as Agreement on Trade in Civil Aircraft, Agreement on Government Procurement, International Dairy Agreement, and International Bovine Meat Agreement.

⁸⁴ Susy Frankel, *The Applicability of GATT Jurisprudence to the Interpretation of the TRIPS Agreement*. In Carlos M Correa (ed.), *Research Handbook on the Interpretation and Enforcement of Intellectual Property under WTO Rules, Intellectual Property in the WTO* Cheltenham Edward Elgar, 2010 chapter 1 p. 4.

⁸⁵ The Berne Convention 1883, the Paris Convention 1886 and the Rome Convention of 1961.

The WTO is overseen by its member governments, consisting of the Trade Ministers of all member states. The WTO Ministerial Conference is the highest decision making body, and the Conference takes place once every two years at which all the final decisions are taken and new negotiations launched and contentious issues are determined.⁸⁶ The General Council is the next in line in decision-making at the WTO, carrying out the functions of the WTO and representing usually, by ambassadors or corresponding office holders from all member governments with the authority to act on behalf of the Ministerial Conference and to perform day-to-day work between Ministerial Conferences.⁸⁷ The General Council's responsibilities are delegated to three bodies: the Councils for Trade in Goods, Trade in Services and Trade-Related Aspects of Intellectual Property, with all having different functions.⁸⁸ The Council for Trade in Services and Trade-Related Aspects of Intellectual Property oversees the implementation and functioning of the WTO agreements (Annexes 1C)⁸⁹ and may establish its own subsidiary bodies as necessary.

The responsibility of the WTO is to oversee matters relating to the agreements and associated legal instruments regarding the common institutional framework for the administration of trade relations among its members, as well as to ensure the conduct of international trade on a non-discriminatory, substantially free and reciprocal basis.⁹⁰ Other tasks include raising the standard of living and incomes, ensuring full employment, expanding production and trade. It is to realise these aims consistent with sustainable development and environmental protection, in addition to ensuring that developing countries, especially the least developed countries (LDCs), secure a proper share in the growth of international trade. Also, it is the responsibility of the WTO members to 'ensure conformity of its laws, regulations and administrative procedures with its obligation as provided in the annexed Agreements.'⁹¹

⁸⁶ Article IV (1) URUGUAY ROUND AGREEMENT Marrakesh Agreement Establishing the World Trade Organisation (Hereinafter called the Marrakesh Agreement).

⁸⁷ Article IV (2) Marrakesh Agreement.

⁸⁸ Article IV (5) Marrakesh Agreement.

⁸⁹ Agreement on Trade-Related Aspects of Intellectual Property Rights.

⁹⁰ Kyle Bagwell and Robert W. Staiger, 'The Economics of the WTO' available at <http://www.ssc.wisc.edu/~rstaiger/plenary.miamislides111201> accessed 05 November 2012.

⁹¹ Article XVI (4) WTO Agreements.

Although, the objectives of the WTO are quite clear and lean towards the public interest, it has been said that the ‘WTO’s emphasis has slipped from concentrating on these public interest goals to seeing itself primarily as an organisation for liberalising trade’.⁹² The WTO maintains it is not just about liberalising trade. However, in observing the sequence of events that has happened in the WTO it is more likely that the Organisation will be viewed in that light. Some of the provisions in the multilateral agreements, in particular the TRIPS Agreement have caused tensions between the developing countries and some industrialised countries on a number of issues, such as public health and the access to medicine and the use of traditional knowledge by pharmaceutical companies.⁹³ Dommen argues that the WTO undermines the national policy space of members, in that:

WTO efforts to liberalise trade in services are part of a broader global trend towards increasing private sector participation (and increasingly, participation of large and powerful multinational corporations) in the provision of state-like functions, provoking competition in areas that were once under the responsibility of government as service supplier.⁹⁴

The diminishing public interest goal of the WTO affects services and it extends to areas of intellectual property such as health, human rights, culture and education policy, environment and bio-diversity and biotechnology. These developments are burning issues in the WTO and other forums. Access to medicines is an area of grave concern.⁹⁵ Some writers argue that the ‘high prices of innovating medicines pose a major barrier to poor countries access to

⁹² 3D and FORUM ASIA.2004.*Practical Guide to the WTO, Objectives and Organisation of the WTO for Human Rights Advocate* 3D Trade – Human Rights-Equitable Economy and FORUM-ASIA. December 2004 chapter 1 p.103; Lam, Esther et al, *Practical Guide to the WTO for Human Rights Advocates* 3D-Trade-Human Rights-Equitable Economy and Forum Asia, cop Genève 2004 97.

⁹³ C. Juma, ‘Intellectual Property Rights and Globalization: Implications for Developing Countries. Science, Technology and Innovation’ Discussion Paper No. 4, 1999; Center for International Development, Harvard University, Cambridge, MA, USA.

⁹⁴ Caroline Dommen, ‘The WTO, International Trade, and Human Rights, Mainstreaming Human Rights in Multilateral Institutions’ Michael Windfuhr (ed.) *3D-Trade - Human Rights - Equitable Economy*, Geneva, Switzerland accessed 05 November 2012 http://www.3dthree.org/pdf_3D/WTOmainstreamingHR.pdf accessed 05 November 2012.

⁹⁵ In the ‘Selected drugs used in the care of people living with HIV: sources and prices’ October 2000 Joint UNICEF-UNAIDS-WHO/EDM-MSF Project cost of Antiretroviral medicine in Nigeria was up to 79% higher than counties in Europe. According to the MDG Gap Task Force Report 2012, little improvement has been seen in recent years in regarding availability and affordability of essential medicines in developing countries. Only 51.8 per cent of public and 68.5 per cent of private health facilities are able to provide patients with essential medicines available at http://www.haiweb.org/medicineprices/21092012/MDG_Gap2012web.pdf accessed 05 November 2012.

essential and life-saving medicines’ but the protection of intellectual property is a crucial incentive for innovation.⁹⁶

Obligations under the WTO and IP claims do not always coincide, which raises the question, why the trade related approach of TRIPS that places IP in the WTO Agreements instead of it remaining in WIPO? There has been no clear answer as to what intellectual property is doing in a trade organisation. The inclusion of intellectual property in the WTO Agreement has been attributed to the impetus of the United States, the European Union (EU) and Japan. It is arguable that intellectual property is what sustains trade, and without IP, trade would be restricted. IP is to trade in the same way the blood is to the body, blood pumps through the body without being seen, so does intellectual property function in trade. IP may not be out of place in a trading agreement.

The area of conflict rest on the way the negotiations were packaged in the form of a carrot and stick approach. The negotiation of a single package was intended to lure developing countries into consenting to higher IPR standards by promising them trade-offs in agriculture and textiles.⁹⁷ The subsequent inclusion of IP in Trade Agreements led to a historic, though controversial, development in the world of trade law. It allowed for the governing of intellectual property matters by the WTO Ministerial Conference in conjunction with the WIPO which hitherto, had exercised exclusive control over the administration of IP internationally.⁹⁸

2.4.4 Summary

This section examined the two dominant regulators of intellectual property internationally. It outlines the origin, function and nature of the organisation. The chronological development of the WTO from the ITO to the GATT was examined. The Uruguay Round that was

⁹⁶ M. Berger, *et al Strengthening pharmaceutical innovation in Africa. Council on Health Research for Development (COHRED); New Partnership for Africa's Development (NEPAD) 2009* p.28 available at http://www.policycures.org/downloads/COHRED-NEPAD_Strengthening_Pharmaceutical_Innovation_AfricaREPORT.pdf accessed 05 November 2012.

⁹⁷ Stoll, Busche and Arend, (Preface to the Volume) *WTO-Trade related aspects of Intellectual Property Rights*, Max Planck Commentaries on World Trade Law, Martinus Nijhoff Publishers 2009 Vol.7 para.18 p. xi.

⁹⁸ Prior to the Uruguay Round, the WIPO enjoyed exclusive autonomy over the administration of intellectual property matters internationally. The level of authority was watered down with the subsequent creation of the WTO which has jurisdiction to oversee the administration of IP matters, especially as they relate to trade.

responsible for the development of the multilateral agreement that culminated in the TRIPS Agreement was discussed as well. The advent of the TRIPS Agreement has led to an explosion of intellectual property law, internationally and has led to the discussion of IP in other forums, apart from WIPO and WTO. The debate on the relation of the effect of intellectual property law, in particular, has resulted in the WHO taking an interest in IP. The United Nations Educational, Scientific and Cultural Organisation (UNESCO) is very interested in the effects on copyrights in relation to education and access to information and knowledge as well as the cultural heritage and property and the expression of folklore. These international organisations will be discussed below.

2.5 World Health Organisation

The most contentious issue in relation to the TRIPS Agreement is the effect on public health and access to medicines. After World War II the world recognised that in the interest of peace and security the development of international action in matters of health was vital.⁹⁹ The WHO was established in 1945 as the principal international organisation in charge of coordinating health at the United Nations. Its primary objectives are to provide directives on global health matters and engaging in partnerships where joint action is required, shaping the health research agenda, setting norms and standards and promoting and monitoring their implementation, articulating evidence-based policy options, providing technical support to countries and monitoring and assessing health trends.¹⁰⁰

The issue of intellectual property and the WHO stems from the debates on the effect of the TRIPS Agreement on public health. It led to the establishment of the Commission on Intellectual Property Rights, Innovation and Public Health (CIPIH) in 2003 by the World Health Assembly (WHA).¹⁰¹ The WHA took cognisance of the concerns about the current

⁹⁹ The Constitution of the World Health Organization signed 22 July 1946, entered into force on 7 April 1948. Amendments adopted by the Twenty-sixth- resolution WHA26.37 3 February 1977, Twenty-ninth- resolution, WHA29.38 20 January 1984, Thirty-ninth- resolution WHA39.6 11 July 1994 and Fifty-first resolution WHA51.23 15 September 2005 of the World Health Assemblies respectively and are incorporated in the present text.

¹⁰⁰ WHO (World Health Organization) (2006). *Engaging for Health. Eleventh General Programme of Work 2006–2015. A Global Health Agenda.* Geneva, Switzerland: WHO A63/30.p. 1 http://apps.who.int/gb/ebwha/pdf_files/WHA63/A63_30-en.pdf 6 March 2014.

¹⁰¹ Resolution of the World Health Assembly Fifty-Sixth World Health Assembly WHA56.27.

patent protection system, especially as regards access to medicines in developing countries. It reiterated that the Declaration on the TRIPS Agreement and Public Health (Doha Declaration) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) do not and should not prevent members from taking measures to protect public health, particularly for the promotion of access to medicines for all and pointed out that the TRIPS Agreement contains flexibilities which can be used only with the adoption of a national patent legislation.¹⁰² The Commission's mandate is to assess the interface between intellectual property rights, innovation and public health by collecting 'data and proposals from the different actors involved and produce an analysis of intellectual property rights, innovation, and public health, including the question of appropriate funding and incentive mechanisms for the creation of new medicines and other products against diseases that disproportionately affect developing countries'.¹⁰³

As a result of this mandate the CIPIH undertook several meetings, workshops and open fora which culminated in the Report of the Commission on Intellectual Property, Innovation and Public Health in 2006.¹⁰⁴ On completion of the CIPIH Report the WHO set up an intergovernmental working group (IGWG)¹⁰⁵ to examine the recommendations.¹⁰⁶ After due consideration and negotiation by members states a draft of a global strategy and plan of action on public health, innovation and intellectual property was conceived, and subsequently adopted by a World Health Assembly as the Global Strategy and Plan of Action on Public Health, Innovation and Intellectual Property (GSPA-PHI).¹⁰⁷ The strategy consists of eight elements, 25 sub-elements and 108 specific actions. The aim of the GSPA-PHI is

¹⁰² Resolution of the World Health Assembly Fifty-Sixth World Health Assembly WHA56.27.

¹⁰³ Resolution of the World Health Assembly Fifty-Sixth World Health Assembly WHA56.27.

¹⁰⁴ WHO, Public health innovation and intellectual property rights Report of the Commission on Intellectual Property Rights, Innovation and Public Health available at <http://www.who.int/intellectualproperty/documents/thereport/ENPublicHealthReport.pdf> accessed 6 March 2014 (Herein after referred to as the CIPIH Report).

¹⁰⁵ Resolution of the World Health Assembly Fifty-ninth WORLD HEALTH ASSEMBLY on Public health, innovation, essential health research and intellectual property rights: towards a global strategy and plan of action. WHA 59.24 The intergovernmental working group (IGWG) were WHO member States from more than 100 countries who are stakeholders on public health, innovation and intellectual property.

¹⁰⁶ WHO, Global Strategy and Plan of Action on public health, innovation and intellectual property available at http://www.who.int/phi/publications/Global_Strategy_Plan_Action.pdf accessed 6 March 2014.

¹⁰⁷ Resolution of the World Health Assembly, Sixty-first WORLD HEALTH ASSEMBLY WHA61.21.

to promote new thinking on innovation and access to medicines, as well as, based on the recommendations of the Report of the Commission on Intellectual Property Rights, Innovation and Public Health, provide a medium-term framework for securing an enhanced and sustainable basis for needs driven essential health research and development relevant to diseases which disproportionately affect developing countries, proposing clear objectives and priorities for research and development, and estimating funding needs in this area.¹⁰⁸

The elements for the strategic promotion of new thinking designed to promote innovation, build capacity, improve access and mobilise resources are outlined as:

- i. Prioritising research and development needs.
- ii. Promoting research and development
- iii. Building and improving innovative capacity
- iv. Transfer of technology North-south and South- South Development Cooperation
- v. Application and management of intellectual property to contribute to innovation and promote public health
- vi. Improving delivery and access
- vii. Promoting sustainable financing mechanisms
- viii. Establishing monitoring and reporting systems

The GSPA-PHI, in particular, restates certain provisions of the TRIPS Agreement, such as Article 7 of the TRIPS Agreement¹⁰⁹ as well as the Doha Declaration on the TRIPS Agreement and Public Health which it stated confirms that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health.¹¹⁰ The GSPA-PHI noted that the Declaration reiterated its commitment to the TRIPS Agreement, affirming that the TRIPS Agreement can and should be interpreted and implemented in a manner supportive of the rights of WTO members to protect public health and, in particular, to promote access to medicines for all.¹¹¹

¹⁰⁸ WHA61.21 Annex 13 Global Strategy on Public Health, Innovation and Intellectual Property available at http://apps.who.int/gb/ebwha/pdf_files/WHA61-REC1/A61_Rec1-part2-en.pdf accessed 6 March 2014.

¹⁰⁹ Article 7 TRIPS Agreement states that ‘the protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation into the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations’.

¹¹⁰ Paragraph 4 Declaration on the TRIPS Agreement and Public Health Ministerial Conference Fourth Session Doha, 9 - 14 November 2001.

¹¹¹ Paragraph 4 Declaration on the TRIPS Agreement and Public Health Ministerial Conference Fourth Session Doha, 9 - 14 November 2001.

Although the WHO is concerned about public health and access to medicines, it acknowledges the importance of intellectual property as a driving force for innovation.

2.6 United Nations Educational, Scientific and Cultural Organisation (UNESCO)

The United Nations Educational, Scientific and Cultural Organisation (UNESCO) is a United Nations agency founded in 1945 by thirty-seven countries. However, the Constitution was ratified by only twenty countries¹¹² and came into force in 1946.

The purpose of the UNESCO as stated in its Constitution is:

to contribute to peace and security by promoting collaboration among nations through education, science and culture in order to further universal respect for justice, for the rule of law and for the human rights and fundamental freedoms which are affirmed for the peoples of the world, without distinction of race, sex, language or religion, by the Charter of the United Nations.¹¹³

Notably, the preamble to the Constitution acknowledges

[T]hat since wars begin in the minds of men, it is in the minds of men that the defences of peace must be constructed and [T]hat ignorance of each other's ways and lives has been a common cause, throughout the history of mankind, of that suspicion and mistrust between the peoples of the world through which their differences have all too often broken into war.¹¹⁴

Presently UNESCO administers 19 intellectual property related Treaties,¹¹⁵ including the Universal Copyright Convention (UCC) which is a principal international convention

¹¹² Australia, Brazil, Canada, China, Czechoslovakia, Denmark, Dominican Republic, Egypt, France, Greece, India, Lebanon, Mexico, New Zealand, Norway, Saudi Arabia, South Africa, Turkey, United Kingdom and United States.

¹¹³ Article 1 Constitution of the United Nations Educational, Scientific and Cultural Organization available at http://portal.unesco.org/en/ev.php-URL_ID=15244&URL_DO=DO_TOPIC&URL_SECTION=201.html accessed 10 March 2014.

¹¹⁴ Preamble of the Constitution of the United Nations Educational, Scientific and Cultural Organization available at http://portal.unesco.org/en/ev.php-URL_ID=15244&URL_DO=DO_TOPIC&URL_SECTION=201.html accessed 10 March 2014.

¹¹⁵ Convention on the Protection and Promotion of the Diversity of Cultural Expressions 2005 (October 20, 2005); Convention for the Safeguarding of the Intangible Cultural Heritage (October 17, 2003); Convention on the Protection of the Underwater Cultural Heritage (November 2, 2001); Second Protocol to the Hague Convention of 1954 for the Protection of Cultural Property in the Event of Armed Conflict (March 26, 1999); Additional Protocol to the Multilateral Convention for the Avoidance of Double Taxation of Copyright Royalties (December 13, 1979); Multilateral Convention for the Avoidance of Double Taxation of Copyright Royalties (December 13, 1979); Protocol to the Agreement on the Importation of Educational, Scientific or Cultural Materials (November 26, 1976); Convention concerning the Protection of the World Cultural and Natural Heritage (November 16, 1972); Protocol 1 annexed for Universal Copyright Convention as revised at Paris on 24 July 1971 concerning the application of that Convention to works of Stateless persons and refugees (July 24, 1971); Protocol 2 annexed for Universal Copyright Convention as revised at Paris on 24

protecting copyright. The Universal Copyright Convention (UCC) was revised in 1971, with an Appendix Declaration relating to Article XVII and a Resolution concerning Article XI.

The UCC came into being as a result of divergent views over certain provisions of the Berne Convention among some developing countries, the Union of Soviet Socialist Republics, the United States of America, as well as most of Latin American countries.

As the UCC had more flexible requirement for protection than the Berne Convention it was appealing to developing countries. At that time, the United States of America was the champion of formalities which required the © symbol, name and year of first publication be placed in a way that gives reasonable notice of claim of copyright ownership.¹¹⁶ The absence of the requirement of formalities¹¹⁷ and the protection of moral rights¹¹⁸ were basically the reasons why the United States was not a member of the Berne Convention.¹¹⁹

Under the UCC adequate and effective protection is required by the Contracting parties for authors and other copyright proprietors in literary, scientific and artistic works, including writings, musical, dramatic and cinematographic works, and paintings, engravings and sculpture.¹²⁰ Although the UCC evolved out of disagreements on certain provisions of the

July 1971 concerning the application of that Convention to works of certain international organizations (July 24, 1971); Universal Copyright Convention as revised on 24 July 1971, with Appendix Declaration relating to Article XVII and Resolution concerning Article XI (July 24, 1971); Convention on the Means of Prohibiting and Preventing the Illicit Import, Export and Transfer of Ownership of Cultural Property (November 14, 1970); Convention for the Protection of Cultural Property in the Event of Armed Conflict (May 14, 1954); Protocol to the Convention for the Protection of Cultural Property in the Event of Armed Conflict (May 14, 1954); Protocol 1 annexed to the Universal Copyright Convention as signed at Geneva on 6 September 1952 concerning the application of that Convention to works of stateless persons and refugees (September 6, 1952); Protocol 2 annexed to the Universal Copyright Convention as signed at Geneva on 6 September 1952 concerning the application of that Convention the works of certain international organizations (September 6, 1952); Protocol 3 annexed to the Universal Copyright Convention as signed at Geneva on 6 September 1952 concerning the effective date of instruments of ratification or acceptance of or accession to that Convention (September 6, 1952); Universal Copyright Convention of 6 September 1952, with Appendix Declaration relating to Article XVII and Resolution concerning Article XI (September 6, 1952); Agreement on the Importation of Educational, Scientific and Cultural Materials (November 22, 1950).

¹¹⁶ Article III of the Universal Copyright Convention as revised on 24 July 1971, with Appendix Declaration relating to Article XVII and Resolution concerning Article XI (July 24, 1971). (Hereinafter referred to as Universal Copyright Convention).

¹¹⁷ Article 5 Berne Convention.

¹¹⁸ Article 6bis Berne Convention.

¹¹⁹ Joseph S. Dubin, *The Universal Copyright Convention*, 42 Cal. L. Rev. 89 (1954) citing Testimony of E. P. Kilroe, Hearings before Committee on Patents, 74th Cong., 2d Sess. 1012 (1936).

¹²⁰ Article I Universal Copyright Convention.

Berne Convention, the UCC, nonetheless, recognises that it will not in any way affect the provisions of the Berne Convention in the Union created by the Berne Convention.¹²¹ Consequently, there are certain similarities between the two Conventions, such as national treatment.¹²²

The major differences between the two Conventions relates to the term of protection for works protected. Under the UCC it is the life of the author and twenty-five years after his death. In other classes of works the term shall not be less than twenty-five years from the date of publication,¹²³ The Berne Convention provides a term of protection based on the life of the author and fifty years after his death and all other works are protected for fifty years.¹²⁴ The UCC limits publication or published works to ‘the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived’¹²⁵ the Berne Convention allows whatever form of manufacture of the copies provided it satisfies the reasonable requirements of the public.¹²⁶

The UCC is of little relevance as most countries are now members of the WTO responsible for the administration of the TRIPS Agreement which incorporates the provisions of the Berne Convention.¹²⁷ Consequently countries that were not members of the Berne Convention, by virtue of being a WTO member have had to adopt the Berne Convention. In addition, the revision of the Berne Convention in the 1967 Stockholm revision incorporated

¹²¹ Article XVII Universal Copyright Convention.

¹²² Article II Universal Copyright Convention.

1. Published works of nationals of any Contracting state and works first published in that state shall enjoy in each other Contracting state the same protection as that other state accords to works of its nationals first published in its own territory.

2. Unpublished works of nationals of each Contracting state shall enjoy in each other contracting state the same protection as that other state accords to unpublished works of its own nationals.

3. For the purpose of this Convention any Contracting state may, by domestic legislation, assimilate to its own nationals any person domiciled in that state. And Article 5 (1) Berne Convention.

¹²³ Article IV Universal Copyright Convention.

¹²⁴ Article 7 Berne Convention.

¹²⁵ Article VI Universal Copyright Convention. See also Michael D. Scott *Information Technology Law*, Third Edition Aspen Publishers 2013p. 2.361.

¹²⁶ Article 3 (3) Berne Convention.

¹²⁷ Article 2 TRIPS Agreement.

some of the concerns of developing countries and allowed for exceptions based on the three-step test.¹²⁸

Other Conventions under the purview of the UNESCO, although jointly convened by WIPO, are the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations¹²⁹ and the Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of their Phonograms.¹³⁰

The Rome Convention, like the Berne Convention, was assimilated into the TRIPS Agreement.¹³¹ The Rome Convention protects the ‘rights of performers, producers of phonograms, and broadcasting organisations’: they are called ‘neighboring rights’ or ‘related rights.’¹³²

2.7 Conclusion

In this chapter the two principal organisations¹³³ regulating intellectual property are examined in order to create a logical sequence in the establishment of the TRIPS Agreement. These international organisations - WIPO and the WTO - through the TRIPS Agreement regulate IP. The chapter examined the WTO in relation to intellectual property rights and the run up to its establishment during the Uruguay Round, the legal institution that created the TRIPS Agreement.

WIPO remains the primary international organisation governing IPRs despite the existence of the TRIPS Agreement. The two organisations, through a Cooperation Agreement, between them provide cooperation in areas such as access to and translation of national laws and

¹²⁸ Julien Hofman *A plain language guide to copyright in the 21st century* Commonwealth of Learning Vancouver 2009 p.16.

¹²⁹ International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Done at Rome on October 26, 1961 (Hereinafter referred to as the Rome Convention.

¹³⁰ Convention for the Protection of Producers of Phonograms against Unauthorized Duplication of their Phonograms Geneva, 29 October 1971.

¹³¹ Article 2 TRIPS Agreement.

¹³² Mihály Ficsor, *Guide to the Copyright and Related Rights Treaties Administered by WIPO and Glossary of Copyright and Related Rights Terms* WIPO publication Geneva, 2003 p.133.

¹³³ WIPO and WTO.

regulations, implementation of procedures for the protection of national emblems and technical cooperation.

Other international organisations, such as the WHO and the UNESCO, are also examined in relation to intellectual property related issues. The chapter points out that the WHO, in relation to intellectual property currently, has a Global Strategy and Plan of Action on intellectual property and innovation which elevates the importance of intellectual property in society.

The creation of the WTO and the TRIPS Agreement has further moved intellectual property into the international arena, where it is looked at not only by lawyers but is now of global significance to other professions and international actors. Accordingly, the WHO, WIPO and WTO have formed a Trilateral Cooperation on Public Health, IP and Trade to strengthen their discussions in relation to intellectual property and public health with regard to improving access to medicines and to make available new and more effective medicine.¹³⁴

UNESCO's involvement is not as a result of the TRIPS Agreement. As a UN agency that which promotes education makes intellectual property of concern to it, particularly in relation to the propagation of knowledge and information without strict regulation.

Separately all these international organisations promote IPR protection. Although these institutions engage in the same task of IP protection, they differ from each other not only in their historical, organisational and institutional perspectives, but also in objectives and mode of functioning.¹³⁵

Intellectual property no doubt is a source of wealth to spur growth and development. However, there is a need to balance economic gains against global welfare for the common good. The focus of the study shifts to analysing the TRIPS Agreement, that is, the general

¹³⁴ WTO, TRIPS: ISSUES Trilateral cooperation on intellectual property and public health available at http://www.wto.org/english/tratop_e/trips_e/who_wipo_wto_e.htm accessed 10 March 2014. See also WHO/WTO/WIPO study: Promoting Access to Medical Technologies and Innovation Intersection between Public Health, Innovation and Intellectual Property.

¹³⁵ Nimisha Pandey, 'The International Institutional Regime For Intellectual Property Protection a Comparative Study of the World Intellectual Property Organization and the World Trade Organization'; *Shodh, Samiksha aur Mulyankan (International Research Journal)*—ISSN-0974-2832 II (Nov.08-Jan.09).

principles and basic provisions as well as the substantive provisions of the TRIPS Agreement.

CHAPTER 3

Substantive Provisions of the TRIPS Agreement

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3.1 Introduction

The previous chapter sets the stage for the examination of the substantive provisions of the TRIPS Agreement. Having discussed the international organisations associated with intellectual property rights, it is logical at this point to examine the objectives and principles of the TRIPS Agreement and its applicability in the implementation of the substantive provisions which relate to this research.

The TRIPS framework will be used as the platform to assess the levels of compliance of the legal frameworks in Nigeria. Therefore, the main purpose of this chapter is to provide an understanding of the TRIPS Agreement that will be used to analyse the impacts of the TRIPS Agreement on the intellectual property laws of Nigeria.

In addition, the chapter assesses the intellectual property standards under the TRIPS Agreement by comparing it to prior conventions¹ and at the same time reviewing some of the social and legal issues that have been raised following the adoption of the TRIPS Agreement.

¹ The Berne, Paris and the Rome Convention.

Essentially the chapter will provide an overview of the objectives and principles *vis-a-vis* copyright and related rights, trade marks, and patents enforcement provisions under the TRIPS Agreement.

3.2 Agreement on Trade Related Aspects of Intellectual Property

The 1994 WTO Agreement on Trade-Related Aspects of Intellectual Property Rights² (TRIPS) was established to set out minimum universal standards for the protection of all areas of intellectual property,³ at the same time allowing members to provide more extensive protection of intellectual property rights if they so wish.⁴ The TRIPS Agreement, which came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property.⁵ The intention of the Agreement is to implement minimum universal standards globally through the WTO Agreements and enforcement mechanisms. Thus, intellectual property protection was ‘married’ to international trade.⁶ As noted by Gervais the wider coverage of intellectual property areas presents additional possibilities for protection in areas that did not benefit from any multilateral protection as a result of disagreement and opposition and, offering protections for these rights.⁷

The WTO’s Agreement on TRIPS negotiated from 1986 to 1994 at the Uruguay Round launched intellectual property rules into the multilateral trading system.⁸ The aim of the

² Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement establishing the World Trade Organisation (WTO Agreement), Annex 1C, 33 ILM 1197,1198 (1994) (TRIPS Agreement).

³ Understanding the WTO: *The Agreements Intellectual Property: Protection and Enforcement* available at http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm# accessed 14/02/2012.

⁴ WTO: *Overview: the TRIPS Agreement* available at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm accessed on July 2011.

⁵ WTO: *Overview: the TRIPS Agreement*.

⁶ Arvind Pangariya, ‘Critical Perspective on the Global Trading System and the WTO’ in Keith Maskus Ed. *The WTO, Intellectual Property Rights and the Knowledge Economy, TRIPS and the WTO: An Uneasy Marriage*, by Edward Elgar Cheltenham 2004 p.44-53; See also Robert M. Sherwood “The Trips Agreement: Implications for Developing Countries” 1997 PTC Research Foundation of *Franklin Pierce Law Center IDEA: The Journal of Law and Technology* 1997 37 *IDEA* 491; See also Antony Taubman, *A Practical Guide to Working with TRIPS*. Oxford University Press 2011 p.5; See also Peter Yu, “Intellectual Property Rulemaking in the Global Capitalist Economy, The International Enclosure Movement”, (2007) 82 *Indiana Law Journal* 827 p.6.

⁷ Gervais, Daniel, *The TRIPS Agreement Drafting History and Analysis* 4th edition Sweet and Maxwell Croydon 2012 p.3.

⁸ Understanding the WTO: *The Agreements, Intellectual Property: Protection and Enforcement* available at http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.htm accessed 27 February 2012.

WTO is trade liberalisation which might be regarded as being at variance with the rationale of the protection of IP.⁹ The TRIPS Agreement is one of the numerous WTO Agreements¹⁰ that stemmed from the Uruguay Round and forms part of a complex body of international law that governs relations between states.¹¹ It also sets standards that define what trading partners can legitimately expect of one another as to how IP is to be protected.¹² Thus, as Drahos states ‘the TRIPS Agreement is but one part of a much deeper phenomenon in which intellectual property plays a vital role of regulating the globalisation of the norms of contract and property’.¹³

The adoption of the TRIPS Agreement into the WTO Agreement arose from lobbying by the United States, supported by the European Union, Japan and other developed nations, who were of the opinion that an expanded and strengthened protection of intellectual property rights would increase the flow of foreign direct investment (FDI) and technology transfer to developing countries, thereby increasing innovation.¹⁴ It was believed that the protection of intellectual property by developing countries (DCs) and least developed countries (LDCs) will reduce infringement and loss of revenue to developed countries. Other negotiating parties held divergent views on the appropriate scope and standard of protection of intellectual property within the GATT framework.¹⁵ Despite the controversial negotiations that took place, the TRIPS Agreement emerged as part of the multilateral trade Agreements in the GATT.¹⁶

⁹ Susy Frankel, “The applicability of GATT Jurisprudence to the interpretation of the TRIPS Agreement” Carlos M. Correa, ed. *Research Handbook on the Interpretation and Enforcement of Intellectual Property under WTO Rules*. Volume II Elgar Cheltenham, 2010 p.6.

¹⁰ The WTO Agreement is the term used to denote the whole bundle of legal texts adopted in 1995 that set out the rules that WTO members must apply and comply with, in addition to implementing and monitoring the processes of the application of these rules.

¹¹ Anthony Taubman, *A Practical Guide to Working with TRIPS*. Oxford University Press 2011 p.17

¹² Taubman, *A Practical Guide to Working with TRIPS* p. 17.

¹³ Peter Drahos, “The Universality of Intellectual Property Rights: Origins and Development.” Discussion paper available at <http://www.wipo.int/tk/en/hr/paneldiscussion/papers/pdf/drahos.pdf>. 27 February 2012.

¹⁴ Carlos Correa, ‘Review of the TRIPS Agreement: Fostering the Transfer of Technology to Developing Countries’ *Journal of World Intellectual Property* 2, 1999 p.939.

¹⁵ Hiroko Yamane, Introduction *Interpreting TRIPS Globalisation of Intellectual Property Rights and Access to Medicines* Hart, Oxford 2011 p.105.

¹⁶ Yamane, *Interpreting TRIPS* p.106.

The IPRs covered by the TRIPS Agreement include copyright and related rights,¹⁷ trade marks including service marks, geographical indications including appellations of origin, industrial designs, patents including the protection of new varieties of plants, the layout designs of integrated circuits, and undisclosed information including trade secrets and test data.¹⁸

The main elements of protection covered in the TRIPS Agreement are defined in terms of the subject matter to be protected, the rights to be conferred, including permissible exceptions to those rights; and the minimum duration of protection.¹⁹ The TRIPS Agreement addresses the applicability of basic GATT principles and those of relevant international intellectual property agreements, the adequacy of IPR provisions, the provision of effective enforcement measures for IPRs, multilateral dispute settlement and transitional arrangements.²⁰ The contentious aspects of the TRIPS Agreement relates to its impact on development, public health and access to medicines.²¹ Developing Countries are yet to see the better days promised under the TRIPS Agreement.²²

The TRIPS Agreement continues to face two forms of resistance: first, the theoretical and systemic claim that IP standards have no part in any trade deals and a critique that the actual standard set in the TRIPS Agreement is unfairly weighted against developing countries (DCs) and was extracted under economic coercion.²³ Several DCs' have voiced fears that enhanced protection of IPRs will limit their access to technology and will not adequately promote the process of development.²⁴ It has been severally advocated that the TRIPS

¹⁷ The rights of performers, producers of sound recordings and broadcasting organizations

¹⁸ Overview: the TRIPS Agreement available at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm accessed on 14 July 2011.

¹⁹ Overview: the TRIPS Agreement available at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm accessed on 14/072011.

²⁰ Agreement on Trade Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods available at http://www.wto.org/english/docs_e/legal_e/ursum_e.htm#nAgreement accessed on 21 February 2012.

²¹ Graham Dutfield, "TRIPS and its Impact on Developing Countries" 1 October 2001 | EN available at <http://www.scidev.net/en/policy-briefs/trips-and-its-impact-on-developing-countries.html>

²² Ermias Tekeste Biadgleng, The Development –Balance of the TRIPS Agreement and enforcement of Intellectual Property Rights in Malbon and Lawson (ed) *Interpreting and Implementing the TRIPS Agreement Is it Fair?* Edward Elgar Cheltenham 2008 p.97.

²³ Taubman, *A Practical Guide to Working with TRIPS* p. 39.

²⁴ Correa, *Review of the Trips Agreement* p.39.

Agreement is an intolerable burden and a last-ditch attempt by the post-industrialised world to safeguard their comparative advantage over developing countries.²⁵ And that ‘[T]he one-size-fits-all, or rather one-standard-fits-all, approach of TRIPS Agreement is a great disservice to developing countries’.²⁶ As Yi-chong explains; the TRIPS Agreement has become synonymous with the debate on rich versus the poor, developed versus developing, and greedy pharmaceutical industries versus dying AIDS patients in many developing countries.²⁷

Despite these claims, for the first time the public policy role of IP protection has been set out authoritatively to capture centuries of past legislative evolution.²⁸ When a treaty is passed, it is impossible to comprehend the overall effect it may have until the treaty begins to take effect. A treaty, no matter how well drafted, cannot be agreeable in all respects to all countries and parties concerned. This situation is coupled with the ever-changing technology and trade treaties: so there is no end in sight to the amendments.²⁹ A number of developing countries and countries in transition to a market economy are contemplating the introduction of a sustainable system for the protection of intellectual property that would take each country’s peculiar needs into consideration.³⁰ This goal, however, has been limited by several factors including legal, technical and innovative incapacity.

When the TRIPS Agreement commenced only the developed countries were, to an extent, able to assess the effect of the Agreement on their IPRs regime and to weigh the economic effect it would have. During this period a lot of developing countries had more pressing internal issues to think about other than IPRs. Further, the notion of intellectual property was

²⁵ Taubman *A Practical Guide to Working with TRIPS* p. 40.

²⁶ Martin Khor, “Rethinking Intellectual Property Rights and TRIPS” Peter Drahos and Ruth Mayne (eds) *Global Intellectual Property Rights Knowledge, Access and Development*. Palgrave Macmillan 2002 Ch. 12 p. 205.

²⁷ Xu Yi-chong, “Last Chance? Multilateral, TRIPS and Developing Countries.” Justin Malbon and Charles Lawson ed. *Interpreting and Implementing the TRIPS Agreement: Is it fair?* Edward Elgar Cheltenham 2008 pp. 46-70 p. 67.

²⁸ Taubman, *A Practical Guide to Working with TRIPS* p.5.

²⁹ Taubman, *A Practical Guide to Working with TRIPS* p.5.

³⁰ The Economics of Intellectual Property Suggestions For Further Research in Developing Countries and Countries with Economies in Transition (Preface) WIPO Publication Genève 2009.

not as developed as it is now, the awareness level was low³¹ and there was, and still is, a lack of technological know-how with a high dependency on imported technologies³² in most developing countries.

At the inception of the TRIPS Agreement the presumption was that it would lead to increase in incentives to invest in research and development of new ideas and technologies on a global scale.³³ It has been noted that research and development (R&D) resources have not been adequate while innovation cost is high in developing countries. Thus, the long term benefits of intellectual property protection have not been substantiated, particularly, in relation to access to medicines. Simultaneously, losing the possibility of importing generics to cushion the immediate effect and reduce the consequences of epidemics has been unimpressive.³⁴

Furthermore, the trepidations of DCs' over the impact of the TRIPS Agreement on innovation and technology transfer and the reality that the flexibilities in the TRIPS Agreement have not yielded results that will truly assist in the development of local innovation and technology transfer is a cause for concern.³⁵ Certain aspects relating to the implementation of the TRIPS Agreement have raised doubts in developing countries as a result of unilateral pressure and a lack of implementation of Article 66.2³⁶ and Article 67.³⁷

³¹ Methodology for the Development of National Intellectual Property Strategies Tool 3: Benchmarking Indicators p.25 available at http://www.wipo.int/export/sites/www/ipstrategies/en/pdf/benchmarking_indicators.pdf accessed 10 November 2011.

³² UNCTAD, "Africa's Technology Gap Case Studies on Kenya, Ghana, Uganda and Tanzania" available at <http://www.unctad.info/upload/STDEV/docs/gap.pdf> accessed 10 November 2011.

³³ Yamane, Introduction "Interpreting TRIPS" p.1.

³⁴ Yamane, Introduction "Interpreting TRIPS" p.1.

³⁵ Susy Frankel, "The applicability of GATT Jurisprudence to the interpretation of the TRIPS Agreement" Carlos M. Correa, ed. *Research Handbook on the Interpretation and Enforcement of Intellectual Property under WTO Rules*. Volume II Elgar Cheltenham, 2010 p.5.

³⁶ Provides for the incentives for the transfer of technology to Least Developed Countries (LDCs).

³⁷ The Article provides for technical assistance to developing countries. See Carlos Correa. *Review of the Trips Agreement: Fostering the Transfer of Technology to Developing Countries Journal of World Intellectual Property* Volume 2, Issue 6, available at Wiley Online Library at <http://onlinelibrary.wiley.com/doi/10.1111/j.1747-1796.1999.tb00100.x/pdf> accessed 10 November 2011.

The main challenge, as Braga asserts, is the ability of ‘developing countries to transform it from a rent transfer mechanism into an effective instrument for technological development.’

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International organisations have attempted to determine the effects of the TRIPS Agreement on developing countries.³⁹ Unfortunately, the one size fits all standards, which remains unachievable for developing countries, has not satisfied industrialised countries, who call for tighter measure for intellectual property protection: ‘irrespective of the fact that the TRIPS advocates got 95% of what was requested there is still a clamour for the remaining 5%’.⁴⁰ This has led to the TRIPS-plus Agreements. This demonstrates that one size cannot really fit all as there will always be those who are dissatisfied.

The following section examines the preamble, objective and principles of the TRIPS Agreement. Articles 7, article 8 and the preamble are the primary provisions of the TRIPS Agreement.⁴¹

3.2.1 Preamble

The preamble of an agreement expresses the view of the negotiating parties and the way the preamble to the TRIPS Agreement is couched reflects the ideas of the negotiators. This part of the TRIPS Agreement reflects the mandate of the Ministerial Declaration at the Uruguay

³⁸ Carlos A. Primo Braga, *Trade-Related Intellectual Property Issues: The Uruguay Round Agreement and Its Economic Implications*, in *The Uruguay Round and the Developing Economies* (World Bank discussion Paper No. 307 William Martin & L. Carlos Primo Braga of the World Bank, one of the leading observers at the Uruguay Round.

³⁹ Germán Velásquez and Pascale Boulet available at Globalization and Access to Drugs: Perspectives on the WTO/TRIPS Agreement. (Revised). Geneva, World Health Organization, 1999 (document reference WHO/DAP/98.9); see <http://www.who.int/medicines/and> World Health Organization. *A Briefing on TRIPS. Pharmaceuticals in the Trade-Related Aspects of the Intellectual Property Rights (TRIPS) Agreement of the World Trade Organization (WTO)*. Manila, World Health Organization, Regional Office for the Western Pacific, August 2000.

⁴⁰ Susan K. Sell, “TRIPS: Fifteen Years Later” *2011 Journal of Intellectual Property Law*, Vol. 18, No. 2, APSA 2011 Electronic copy available at: <http://ssrn.com/abstract=1900102> 02 May 2012.

⁴¹ Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds), *WTO Trade Related Aspect of Intellectual property Rights* Max Planck Commentaries on World Trade Law, 7 Marinus Nijhoff Publishers Leiden Boston 2009 p. 180.

Round⁴² and is considered as an important part of a treaty because it is applied in the interpretation of other parts of the treaty.⁴³ Under customary international law, treaty interpretation must be based on the text context, object and purpose, and good faith.⁴⁴ The preamble expresses the intent of the negotiating parties in balancing the rights and obligations concerning the object and purpose of the TRIPS Agreement.⁴⁵ The preamble to TRIPS Agreement sets out the desire of the negotiating parties to reduce distortions and impediments to international trade. In taking into account the need to promote effective and adequate protection of intellectual property rights, it also ensures that measures and procedures for the enforcement of intellectual property rights do not themselves become barriers to legitimate trade.

To this end, the Ministerial Conference recognised the need for new rules and disciplines concerning the application of the basic principles of GATT relevant to international intellectual property agreements or conventions. As well, it expresses the underlying public policy objectives of national systems, and the special needs of the least-developed country for the protection of intellectual property. It also emphasises the importance of reducing tensions by reaching strengthened commitments to resolve disputes on trade-related intellectual property issues through multilateral procedures. In addition, intellectual property rights are recognised as private rights.

3.2.2 Objectives and Principles

The objectives and principles developed out of several proposals advanced by many countries. The United States⁴⁶ and Europe⁴⁷ put forward a view on the objectives and

⁴² Abdulqawi A. Yusuf, TRIPS: Background, Principles and General Provisions”. Carlos Correa and Abdulqawi Yusuf (Eds) *Intellectual Property and International Trade The TRIPS Agreement*. Kluwer Law International BV The Netherlands 2008 p. 11.

⁴³ Gervais, *The TRIPS Agreement* para 2.10 p.159.

⁴⁴ James Thuo Gathii “The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties” *Harvard Journal of Law & Technology* Volume 15, Number 2 Spring 2002 p.292.

⁴⁵ UNCTAD/ICTSD, *Resource Book on TRIPS* p.3.

⁴⁶ United States Proposal for Negotiations on Trade-Related Aspects of Intellectual Property Rights, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods, MTN.GNG/NG11/W/14, 20 Oct. 1987, Nov. 3, 1987.

principles of the Agreement. Brazil and India, who championed the cause of developing countries, also submitted proposals on the content of an Agreement relating to the intellectual property, including its objectives and principles. Brazil, specifically, stated that as a preliminary to discussion on the subject of trade in counterfeit goods, as a first step, GATT contracting parties should sign the Madrid Agreement for Repression of False or Deceptive Indication of Source of Goods.⁴⁸

India declared ‘that the protection of intellectual property rights has no direct or significant relationship to international trade’⁴⁹ and further stated that ‘it would not be appropriate to establish within the framework of the General Agreement on Tariffs and Trade any new rules and disciplines on intellectual property rights’.⁵⁰ The text which reflected the model of industrialised countries became the final Agreement, whereas articles 7 and 8 mirrored the concerns of developing countries.⁵¹

The provisions on the objectives and principles of the TRIPS Agreement have been the subject to debate.⁵² The Agreement sets out its objectives in article 7:

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare and to a balance of rights and obligations.

The principles in Article 8 provide:

⁴⁷ Guidelines and Objectives Proposed by the European Community for the Negotiations on Trade Related Aspects of Substantive Standards of Intellectual Property Rights, Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods, MTN.GNG/NG11/W/26, July 1988.

⁴⁸ MTN.GNG/NG11/W11-The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods - Suggestion by Brazil (9 July 1987).

⁴⁹ MTN.GNG/NG11/W/37 - Standards and Principles Concerning the Availability, Scope and Use of Trade-Related Intellectual Property Rights – Communication from India (10 July 1989).

⁵⁰ MTN.GNG/NG11/W/39 - Applicability of the Basic Principles of the GATT and of Relevant International Intellectual Property Agreements or Conventions - Communication from India (5 September 1989).

⁵¹ Peter K. Yu, “The Objectives and Principles of the TRIPs Agreement” *Houston Law Review* [46:4 2009] pp.980-1046, p. 991.

⁵² There are many WTO cases on issue of objective of TRIPS. See Canada Patent Protection Pharmaceutical Products WT/DS/114/R adopted 7 April 2000. EC Protection of Trade Marks and Geographical Indication for Agricultural products and Food Stuff. WT/DS174/R adopted 20 April 2005.

Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.⁵³ Appropriate measures, provided that they are consistent with the provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.⁵⁴

Articles 7 and 8 of the TRIPS Agreement are discussed concurrently because they are crucial for realising the development benefits of the Agreement.⁵⁵ The provisions reflect the DCs' concerns.⁵⁶ It is presumed that the inclusion of 'Objectives' and 'Principles' in the TRIPS Agreement is done with the goal of establishing the rights and/or obligations of the members states.⁵⁷

3.2.2.1 Objectives of the TRIPS Agreement Article 7

The objective of the TRIPS Agreement as provided for in Article 7 serves as an interpretation and application for the main provisions of the TRIPS Agreement. The objectives represent an important juridical foundation of the Agreement.⁵⁸ This provision came about as a result of the proposal made by DCs⁵⁹ who were concerned about the effect strong IPRs might have on their economy, development, and social welfare⁶⁰ and the need to maintain a balance between the interest of right holders and those of users.⁶¹

It is widely believed by many scholars⁶² that there was no intention to make the provision of Article 7 operative. As Gervais⁶³ claims, and reiterated by Yu⁶⁴ and other scholars, the use of

⁵³ Article 8 (1) TRIPS Agreement.

⁵⁴ Article 8 (2) TRIPS Agreement.

⁵⁵ United Nations Conference on Trade and Development Training Module on the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) United Nations New York UNCTAD/DITC/TNCD/2008/3 p. 5.

⁵⁶ Peter K. Yu, *Objectives and Principles of TRIPS* p.1042.

⁵⁷ UNCTAD-ICTSD(2005) *UNCTAD, Resource Book on TRIPS and Development* Cambridge University Press New York p. 119.

⁵⁸ Abdulqawi A. Yusuf, *TRIPS: Background, Principles and General Provisions* p. 13.

⁵⁹ Article 2 of part II of Negotiation Group on TRIPS, including Trade in Counterfeit Goods, communication from Argentina, Brazil, China, Columbia, Cuba, Egypt, India, Nigeria, Peru Tanzania and Uruguay, MTN.GNG/NG11/W/71, 14 May 1990.

⁶⁰ Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.180.

⁶¹ Gervais.*The TRIPS Agreement* para 2.111 p.229.

⁶² Peter K. Yu, *The Objectives and Principles of the TRIPs Agreement* p.1003; Yusuf, *TRIPS: Background, Principles and General Provisions* in Carlos Correa and Abdulqawi Yusuf (Eds) *Intellectual Property and International Trade The TRIPS Agreement*. Kluwer Law International BV the Netherlands 2008 p. 13.

‘should’ in the article rather than ‘shall’ has made the provision ‘mere hortatory’:⁶⁵ ‘The protection and enforcement of intellectual property rights should contribute...’. The content of the articles implies countries are expected to structure their own IP laws for the promotion of technology, the innovation, transfer and dissemination of technology, in a way that is beneficial to social and economic welfare.⁶⁶

Yusuf indicates that the provisions are yardsticks:

They provide the overall criteria against which the adequacy and effectiveness of national legislation for the protection and enforcement of IPRs should be measured. As such they are meant to inspire and furnish the basis upon which IPR legislations should be enacted at the national level.⁶⁷

Apart from being the yardstick for national legislation, Article 7 encompasses mainly the protection and enforcement of IPR,⁶⁸ especially as it relates to technology. Yu points out:

While the first three objectives—technological innovation, transfer and dissemination of technology and the production and use of technological knowledge—focus mainly on technological development and may not affect all forms of intellectual property rights, the latter two have a much broader focus and cover virtually all forms of intellectual property rights.⁶⁹

The objective provision dwells more on technological innovations, which are patents, than on other aspects, such as copyright and related rights, trade marks, geographical indications, industrial designs, layout-designs (topographies) of integrated circuits, protection of undisclosed information and control of anti-competitive practices in contractual licences.⁷⁰ The reference to technology in the objective reflects the interest of the leading negotiators for developing countries (Brazil and India). Developing countries are still largely users and are dependent on technology produced in developed countries. Thus, the concept of ‘mutual

⁶³ Gervais. *The TRIPS Agreement* para 2.111 p.229.

⁶⁴ Peter K. Yu, *Objectives and Principles of TRIPS* p. 1003.

⁶⁵ Correa, Carlos (2007), *Trade Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement*, Oxford and New York: Oxford University Press, p. 93; Chon, Margaret (2006), ‘Intellectual property and the development divide’, *Cardozo Law Review*, 27(6): 2821–912, 2843; Jacques J. Gorlin, *An Analysis of the Pharmaceutical-Related Provisions of the WTO TRIPs (Intellectual Property) Agreement*, Intellectual Property Institute London, 1999, p. 16.

⁶⁶ UNCTAD/ICTSD. *Resource Book on TRIPS* p. 126.

⁶⁷ Abdulqawi A. Yusuf, *TRIPS: Background, Principles and General Provisions* p. 13.

⁶⁸ Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.181.

⁶⁹ Peter K. Yu, *Objectives and Principles of TRIPS* p. 1000.

⁷⁰ Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.181.

advantage of producers and users of technological knowledge' is of" of particular importance to them.⁷¹

Apart from the imbalance in the provision, Article 7 provides useful guidance for interpretation in the implementation of the TRIPS Agreement by balancing the objectives in a way that provides support for the efforts to encourage technology transfer with specific reference to articles 66⁷² and 67⁷³ of the TRIPS Agreement.⁷⁴ As the *Resource Book on TRIPS* elucidates:

Article 7 makes clear that TRIPS negotiators did not mean to abandon a balanced perspective on the role of intellectual property in society. TRIPS is not intended only to protect the interests of right holders. It is intended to strike a balance that more widely promotes social and economic welfare.⁷⁵

The objectives provide a balance of rights between the IP holder and the users. The position is clarified by Gervais. Discussing article 7 in light of the essence of an IP policy, he states that the objective establishes an equilibrium between two objectives:

- i rewarding/compensating creators and inventors for innovation and
- ii promoting the business and public at large in securing access to science, technology and culture".⁷⁶

⁷¹ UNCTAD/ICTSD , *Resource Book on TRIPS* p. 126.

⁷² Article 66 relates to the special needs and requirements of least-developed countries and it provides that:

1. In view of the special needs and requirements of least-developed country Members, their economic, financial and administrative constraints, and their need for flexibility to create a viable technological base, such Members shall not be required to apply the provisions of this Agreement, other than Articles 3, 4 and 5, for a period of 10 years from the date of application as defined under paragraph 1 of Article 65. The Council for TRIPS shall, upon duly motivated request by a least-developed country member, accord extensions of this period.
2. Developed country Members shall provide incentives to enterprises and institutions in their territories for the purpose of promoting and encouraging technology transfer to least-developed country Members in order to enable them to create a sound and viable technological base.

⁷³ Article 67. Relates to Technical Cooperation and it provides thus, In order to facilitate the implementation of this Agreement, developed country Members shall provide, on request and on mutually agreed terms and conditions, technical and financial cooperation in favour of developing and least-developed country Members. Such cooperation shall include assistance in the preparation of laws and regulations on the protection and enforcement of intellectual property rights as well as on the prevention of their abuse, and shall include support regarding the establishment or reinforcement of domestic offices and agencies relevant to these matters, including the training of personnel.

⁷⁴ UNCTAD/ICTSD , *Resource Book on TRIPS* p. 126.

⁷⁵ UNCTAD/ICTSD , *Resource Book on TRIPS* p. 126.

⁷⁶ Gervais, *The TRIPS Agreement* para. 2.112 p.231.

It is noteworthy that the objectives ‘serve as a reminder that the TRIPS Agreement is not simply about granting of rights to creators and innovators, but such rights have to be balanced by measures conducive to social and economic welfare’.⁷⁷

3.2.2.2 Article 8: Principles

Article 8 clarifies how states can formulate or amend their laws and regulations to pursue public policy objectives consistent with the TRIPS Agreement.⁷⁸ In essence, Article 8 acts as an interpretative and normative principle for the TRIPS Agreement.⁷⁹ It advises that members have the discretion to adopt internal measures they consider necessary to protect public health and nutrition and to promote the public interest in sectors of vital importance to their socio-economic and technological development.⁸⁰

The article contains two general provisions dealing with:

- (1) Public interest principle⁸¹
- (2) Prevention of abuse⁸²

The statement ‘to promote the public interest in sectors of vital importance to their socio-economic and technological development’ places substantial discretion in the hands of WTO members’ *vis-à-vis* the subject matter and the measures that may be adopted in the context of article 8.1.⁸³ However, the two paragraphs⁸⁴ in the article are constrained by the phrase ‘consistent with the provisions of this Agreement’.⁸⁵ Yusuf explains:

In evaluating the consistency of the public interest measure with the TRIPS Agreement, consideration should be given to the provision of the [A]greement as a whole, including its preamble, objectives and principles. Thus, even though certain public interest measure may

⁷⁷ Abdulqawi A. Yusuf, *TRIPS: background, principles and General Provisions* p. 13.

⁷⁸ Taubman, *A Practical Guide to Working with TRIPS* p. 83.

⁷⁹ Peter K. Yu, *Objectives and Principles of TRIPS* p. 1008.

⁸⁰ *UNCTAD/ICTSD, Resource Book on TRIPS* p. 126-127.

⁸¹ Article 8 (1) TRIPS Agreement.

⁸² Article 8 (2) TRIPS Agreement.

⁸³ *UNCTAD/ICTSD, Resource Book on TRIPS* p. 126 -127.

⁸⁴ Article 8 TRIPS Agreement.

⁸⁵ Gervais. *The TRIPS Agreement* para. 2.123, p. 238

be inconsistent with some of the specific standards laid down in the TRIPS Agreement, it is their overall consistency with the agreement that should be taken into account.⁸⁶

Yusuf argues that the consistency test was evidently considered necessary in view of the broad nature of the public interest principle, which permits members ‘to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development.’⁸⁷ Further:

Measures aimed at the protection of public health and nutrition may be easily defined but it is much more difficult to delineate the broader concept of ‘public interest in sectors of vital importance to their socio-economic and technological development. Hence the limitation imposed through the consistency test, which in the case of dispute between parties to agreement, provides a yard stick, albeit general and somewhat vague against which such measures may be evaluated.

In contrast, in Article XX (b) of the GATT and Article XIV (b) of the GATS, which use similar language to Article 8.1, there is no demand for consistency.⁸⁸ The question has been asked whether the general exceptions in Article XX of the GATT would be applicable under the TRIPS Agreement,⁸⁹ and is answered in that ‘no new exception based on the GATT would be allowed if it violated a substantive TRIPS obligation’.⁹⁰ Frankel explains that the ‘GATT jurisprudence is used to interpret the TRIPS Agreement’s broad non-discrimination principles of national treatment and MFN. The more TRIPS specific a provision is, the more panels treat TRIPS as a *lex specialis*’.⁹¹

Article 8.2 is considered rhetorical, as all the public policy objectives mentioned in the provision have been addressed elsewhere in the Agreement.⁹² Articles 30,⁹³ 31⁹⁴ and 40⁹⁵

⁸⁶ Yusuf, *TRIPS: Background, Principles and General Provisions* p. 14.

⁸⁷ Yusuf, p.14.

⁸⁸ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 126 -133.

⁸⁹ Gervais, *The TRIPS Agreement* para 2.123 p.238.

⁹⁰ United States”Section 211 Omnibus Appropriations Act of 1998 (“HAVANA CLUB”) Report of the Appellate Body, WT/DS176/AB/R (WTO 2002).

⁹¹ Susy Frankel, ‘Applicability of GATT jurisprudence to the interpretation of TRIPS’ in Carlos Correa (ed) *Research handbook on the Interpretation and Enforcement of Intellectual Property under WTO Rule. Intellectual Property in the WTO* Volume II Edward Elgar Cheltenham 2010.

⁹² Peter K. Yu, *The Objectives and Principles of the TRIPs Agreement* p.1017.

⁹³ TRIPS Agreement Article 30 provides:

Limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

⁹⁴ TRIPS Agreement Article 31(k) provides:

have similar objectives. However, the placement of these conditions in the principles shows the importance of the philosophy behind the TRIPS Agreement.⁹⁶

Article 8 performs a parallel function in clarifying the scope of public policy measures outside the regular ambit of IP Law.⁹⁷ The *Resource Book on TRIPS* points out:

[T]here is no comparable provision in the TRIPS that allows Members to generally suspend IPR protection to allow the manufacture and distribution of vitally needed medicine to save human life.⁹⁸

As summed up by Rodrigues⁹⁹ in the words of Banderia de Mello;¹⁰⁰ principles are the legal foundation of the legal system which makes them coherent. Therefore, the principles are rightly reflected in the provisions of the TRIPS Agreement and do not amount to mere rhetoric. It is expected that the placement of this provision in the body of the TRIPS Agreement would heighten its status.¹⁰¹

3.2.2.3 Applicability of the Objectives and Principles

The relevance of articles 7 and 8 has come to the fore in several cases in the WTO, notably in the *Canada-Patent Protection of Pharmaceutical Products*.¹⁰² The panel gave a restrictive interpretation of the articles in interpreting the patent provisions of the TRIPS Agreement. Regrettably, the ruling disregarded the provision of balance and mutual advantage in

Members are not obliged to apply the conditions set forth in subparagraphs (b) and (f) where such use is permitted to remedy a practice determined after judicial or administrative process to be anti-competitive. The need to correct anti-competitive practices may be taken into account in determining the amount of remuneration in such cases. Competent authorities shall have the authority to refuse termination of authorization if and when the conditions which led to such authorization are likely to recur.

⁹⁵ TRIPS Agreement Article 40 provides that:

permits member States to take appropriate measures to curb “an abuse of intellectual property rights having an adverse effect on competition in the relevant market.

⁹⁶ This provision is a view advanced by Indian delegation and other developing countries to restrain competitive abuses.

⁹⁷ Taubman, *A Practical Guide to Working with TRIPS* p. 84.

⁹⁸ UNCTAD/ICTSD. *Resource Book on TRIPS* p.133.

⁹⁹ Edson Beas Rodrigues, *The General Exception Clauses of the TRIPS Agreement: Promoting Sustainable Development*. Cambridge University Press, Cambridge 2012 p. 44

¹⁰⁰ Banderia de Mello, Celso Antônio. *Curso de direito administrativo*. São Paulo: Malheiros, 2004 841-842.

¹⁰¹ Gervais, *The TRIPS Agreement* para. 2.111 p. 230.

¹⁰² Canada - Patent Protection of Pharmaceutical Products (Generic Medicines), Report of the Panel, WT/DS114/R (Mar. 17, 2000).

benefiting the right holder in detachment from social challenges, thus significantly reducing the range of regulatory diversity permitted under TRIPS.¹⁰³

In this dispute the European Community (EC) contested the use of article 7 as a tool of interpretation and application of the TRIPS Agreement, whereas Canada cited articles 7 and 8 as the relevant provision for the interpretation of article 30. The EC construed articles 7 and 8 to be merely declaratory and argued that the balancing of goals had already been taken into consideration during the negotiation of the articles in the TRIPS Agreement.

The Panel's decision required Canada to abolish the statutory provisions that allowed generic drug manufacturers to stockpile patented products before the expiration of the patent term in readiness for marketing upon the expiration of the patents.¹⁰⁴ The decision of the panel has been widely condemned as inexplicable, considering the fact that the testing of patented products prior to the expiration of the period of protection was found to be consistent with the TRIPS Agreement, but not the stockpiling exception.¹⁰⁵ The panel failed to interpret the provision of the TRIPS Agreement to reflect the balance of 'the mutual advantage of producers and users of technological knowledge' and 'the public interest in sectors of vital importance to socio-economic and technological development' which are stipulated as the purposes of the TRIPS Agreement. This case tested the provisions of Article 7 and its value to the TRIPS Agreement.

After the *Canadian-Patent* Panel decision, in relation to the TRIPS Agreement the issue of public health was widely discussed, especially as it relates to access to essential medicines. Significantly, Articles 7 and 8 were 'singled out' for their special importance during the Doha negotiations:¹⁰⁶ paragraph 19 of the Doha Declaration provides that 'the TRIPS Council shall be guided by the objectives and principles set out in Articles 7 and 8 of the TRIPS Agreement and shall take fully into account the development dimension.' In addition,

¹⁰³ R. Howse, "The Canadian Generic Medicines Panel". A Dangerous Precedent in Dangerous Times *The Journal of World Intellectual Property*, 3: 493–507. doi: 10.1111/j.1747-1796.2000.tb00139.x.

¹⁰⁴ James Thuo Gathii, "The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties" *Harvard Journal of Law & Technology* Volume 15, Number 2 Spring 2002 p. 306.

¹⁰⁵ Howse, R. p. 498.

¹⁰⁶ Gervais *The TRIPS Agreement* para 2.114, p. 234.

and in the light of paragraph 4,¹⁰⁷ articles 7 and 8 were specifically referred to in paragraph 5 (a) which states that ‘each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles’.¹⁰⁸ In essence, the Doha Declaration has made the articles ‘helpful in the interpretation of other, “operational” yet broadly and ambiguously phrased provisions of the TRIPS’.¹⁰⁹ The approach at the Doha declaration is a far cry and a nullification of the decision of the panel in the *Canada- Patent Protection case*.

Correa claims the inclusion of sub-paragraph 5(a) of the Doha Declaration emphasises the ‘importance of TRIPS Articles 7 and 8 in the interpretation of the Agreement’ and acknowledges the input of other provisions which ‘contribute to the determination of its object and purpose’.¹¹⁰

The articles have been seen as a central to the implementation and interpretation of the TRIPS Agreement.¹¹¹ Yu, in his interpretation, expounds the role articles 7 and 8 can play in facilitating a more flexible interpretation and implementation of the TRIPS Agreement. He proposes five ways in which the provisions can be put to effective use:

- i. as a guiding light¹¹² for the interpretation and implementation of the Agreement;
- ii. as a shield¹¹³ against aggressive expansion of intellectual property rights and demands for TRIPS-plus protections;

¹⁰⁷ Paragraph 4 of the Doha Declaration provides that.

We agree that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. Accordingly, while reiterating our commitment to the TRIPS Agreement, we affirm that the Agreement can and should be interpreted and implemented in a manner supportive of WTO members' right to protect public health and, in particular, to promote access to medicines for all. In this connection, we reaffirm the right of WTO members to use, to the full, the provisions in the TRIPS Agreement, which provide flexibility for this purpose.

¹⁰⁸ Declaration on the TRIPS agreement and public health Adopted on 14 November 2001 WT/MIN(01)/DEC/2.

¹⁰⁹ Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.187.

¹¹⁰ Correa Carlos, *Implication of the Doha Declaration TRIPS Agreement on Public Health Economic and Drugs* EDM Series No 12. Available at <http://apps.who.int/medicinedocs/pdf/s2301e/s2301e.pdf> accessed 22 November 2012.

¹¹¹ Peter K. Yu, *The Objectives and Principles of the TRIPs Agreement* p.1018.

¹¹² These provisions can be used to clarify the TRIPS Agreement, in accordance with customary rules of interpretation of public international law including those stipulated in the Vienna Convention.

¹¹³ The use of Articles 7 and 8 as a shield to defend a member state's use of flexibilities that have been built into the TRIPS Agreement. The use of these provisions for defensive purposes is particularly important in the

- iii. as a sword¹¹⁴ to challenge the lack of balance in the international intellectual property system;
- iv. as a bridge¹¹⁵ to connect the TRIPS regime with intellectual property and other related international regimes; and
- v. as a seed¹¹⁶ for the development of future international intellectual property norms.¹¹⁷

Consequently, if DC's follow this model and put articles 7 and 8 in their proper use, they may be able to take the advantage of the TRIPS flexibilities to foster development.

3.3 Substantive Provisions of the TRIPS Agreement

The second part of the TRIPS Agreement consists of the substantive provisions which provide the standards concerning the availability, scope and use of intellectual property rights.¹¹⁸ In this section the three main categories of IP, that is, copyright and related rights, trade marks and patents,¹¹⁹ will be examined.

3.3.1 Copyright and Related Rights

Copyright and related rights are provided for in section 1 of Part II of the TRIPS Agreement, the section contains six articles. This section consist of the interpretation of the Berne Convention¹²⁰ as provided for by its inclusion in articles 1, 2 and 9, the protection of copyright in computer programs and compilations of data,¹²¹ rental rights,¹²² the term of

light of the fact that developed countries have been the predominant users of the WTO dispute settlement process.

¹¹⁴ This provision can also be used as a sword to challenge the existing provisions in developed countries or to enlarge the countries' policy space in the intellectual property area could be invoked to limit an obligation to protect or enforce a given intellectual property right where no promotion of intellectual innovation and/or transfer or dissemination of technology can be proven.

¹¹⁵ Articles 7 and 8 can serve as a useful bridge that connects the TRIPS regime with those other regimes that may be implicated by the protection and enforcement of intellectual property rights.

¹¹⁶ Articles 7 and 8 can be used as a seed for the development of new norms both *within* and *without* the international intellectual property regime. They can supply the needed language or provide direction for the development of these new norms. They also help remind the treaty drafters of the nature, scope, and objectives of intellectual property norms.

¹¹⁷ Peter K. Yu, "The Objectives and Principles of the TRIPS Agreement", p.1020.

¹¹⁸ See generally Part II of the TRIPS Agreement.

¹¹⁹ These areas of intellectual property chosen are the areas where there are legislations in Nigeria.

¹²⁰ Berne Convention for the Protection of Literary and Artistic Works, September 9, 1886, revised at Paris July 24, 1971, 828 U.N.T.S. 221.

¹²¹ Article 10 TRIPS Agreement.

¹²² Article 11 TRIPS Agreement.

protection¹²³ and the protection of performers, producers of phonograms (sound recordings) and broadcasting organisations.¹²⁴

3.3.1.1 Article 9.1: Rights or Obligations in respect of Copyrights

Article 9.1 of the TRIPS Agreement codifies already existing international copyright standards in practice in most countries prior to the negotiation of the TRIPS Agreement.¹²⁵ The article incorporates the provisions of the Berne Convention from articles 1 through 21. The provisions apply *mutatis mutandi* to the members of the WTO under the TRIPS Agreement with the exception of article 6*bis* of the Berne Convention which obliges members to protect the moral rights of authors.¹²⁶ In short, the provisions of the Berne Convention specify the works that are protected¹²⁷ and stipulate works that may not be protected,¹²⁸ including permissible exceptions.¹²⁹ The criteria for protection of works as provided for in the Convention requires protection for all authors who are nationals of any of the countries of the Union, for their works, whether published or not, and mandates the protection of all authors in member countries, irrespective of the nationality of the author or place of publication and provides automatic protection immediately to foreign authors upon creation without subjecting such works to any formality.¹³⁰ The term of protection¹³¹ of the

¹²³ Article 12 TRIPS Agreement.

¹²⁴ Article 14 TRIPS Agreement.

¹²⁵ UNCTAD/ICTSD, *Resource Book on TRIPS* p.141.

¹²⁶ Article 6*bis* provides:

(1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation.

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights.

(3) The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.

¹²⁷ Article 2 Berne Convention 1917. Protected works include literary and artistic works, derivative works, official texts, collections, obligation to protect, beneficiaries of protection, works of applied art, industrial designs.

¹²⁸ Article 2*bis* Berne Convention 1917.

¹²⁹ Article 10, 10*bis* and 13 Berne Convention 1917.

¹³⁰ Article 3.1 Berne Convention 1917.

¹³¹ Article 7 Berne Convention 1917.

(1) The term of protection granted by this Convention shall be the life of the author and fifty years after his death.

various works is specified and the rights guaranteed are outlined.¹³² The right to enforce protected rights¹³³ and seize infringing works¹³⁴ is provided for in the Convention. Accordingly, the TRIPS Agreement incorporated all the major substantive provisions of the Berne Convention. The TRIPS Agreement also clarifies certain copyright issues that over time have been deliberated upon;¹³⁵ such fundamental principles include that copyright does not extend to ideas but only their expression and that copyright does not comprise procedures, methods of operation or mathematical concepts.¹³⁶

3.3.1.2 Article 10: Computer Programs

The broadening of copyright protection to cover computer programs, whether in source or object code, to be protected as literary works under the Berne Convention¹³⁷ substantiates the fact that they constitute ‘intellectual creations’ under copyright. Even though the Berne Convention does not specifically provide for the protection of computer programs under literary works, this may be implied since the works enumerated are mere illustrations of the kind of work that may be covered by copyright.¹³⁸ The provision, however, affirms the inclusion of computer programs as literary works and that they should be protected as such.

The protection of databases prior to the TRIPS Agreement was a contentious issue. The provision clarifies that data collection or other materials that are machine readable are protected by copyright. Such protection accrues by reason of the selection or arrangement of

(2) In the case of cinematographic works, the term of protection shall expire fifty years after the work has been made available to the public with the consent of the author.

(3) In the case of anonymous or pseudonymous works, the term of protection granted by this Convention shall expire fifty years after the work has been lawfully made available to the public.

(4) It shall be a matter for legislation in the countries of the Union to determine the term of protection of photographic works and that of works of applied art in so far as they are protected as artistic works; however, this term shall last at least until the end of a period of twenty-five years from the making of such a work.

¹³² Article 5 Berne Convention 1917.

¹³³ Article 15 Berne Convention 1917.

¹³⁴ Article 16 Berne Convention 1917.

¹³⁵ Taubman, *A Practical Guide to Working with TRIPS*. p.94.

¹³⁶ Article 9.2 TRIPS Agreement.

¹³⁷ Article 10 TRIPS Agreement.

¹³⁸ UNCTAD/ICTSD, *Resource Book on TRIPS* p.152.

their contents which constitutes intellectual creations. The protection does not extend to the data or material aforementioned.¹³⁹

3.3.1.3 Article 11: Rental Rights

The provision on rental rights¹⁴⁰ is novel to international copyright protection, although various countries had protected the right prior to codification in the TRIPS Agreement.¹⁴¹ The rental right belongs to the distribution genre which is more commonly known; for instance, in the Berne Convention, authors of literary or artistic works shall have the exclusive right to authorise the distribution of the works.¹⁴² Generally speaking, distribution rights cover rental, lending and resale rights¹⁴³ which are classified as economic rights of the right holder.¹⁴⁴ Article 11 provides that a member shall provide authors and their successors in title the right to authorise or to prohibit the commercial rental to the public of originals or copies of their copyright works regarding computer programs and cinematographic works. Rental rights are optional for members in respect of cinematographic works, unless such rental has led to widespread copying of such works which is substantially damaging to the author. The provision is not applicable to rentals of computer programs where the program itself is not the essential object of the rental.

3.3.1.4 Article 12: Term of Protection of Copyrights

The term of protection depends on the type of work created. The calculation of the term of protection¹⁴⁵ is similar to that of the Berne Convention:¹⁴⁶ the duration of a work is determined on a basis of the life of a natural person as the basic term of protection for works and an additional 50 years after the death of the author except for photographic work or a work of applied art. For other works the basic term of protection for works shall be no less

¹³⁹ Article 10.2 TRIPS Agreement.

¹⁴⁰ Article 11 TRIPS Agreement.

¹⁴¹ The European Commission Council Directive 92/100/EEC of 19 November 1992 on rental right and lending right was in existence before the TRIPS agreement but has however been repealed and replaced by Directive 2006/115/EC.

¹⁴² Article 14 Berne Convention 1917.

¹⁴³ UNCTAD/ICTSD, Resource Book on TRIPS p.171.

¹⁴⁴ Sterling J.A.L. *World Copyright Law* 3rd edition, Sweet & Maxwell London 2008 p. 430-440

¹⁴⁵ See generally Appendix Copyright Term of protection.

¹⁴⁶ Article 7 Berne Convention 1917.

than 50 years from the end of the calendar year of authorised publication.¹⁴⁷ The TRIPS Agreement allows legal entities to be considered as authors, this interpretation is not derived from article 12, but rather from the note to article 1¹⁴⁸ of TRIPS Agreement.¹⁴⁹

3.3.1.5 Article 13: Limitations and Exceptions to Copyright

Article 13 of the TRIPS Agreement arguably has restricted scope in that it focuses more on limitations based on the author's right than exceptions available to the copyright users.¹⁵⁰ As observed, article 13 states that members shall confine limitations and exceptions to three elements, that is, 'certain special cases' that do not conflict with a 'normal exploitation of the work' and that do not 'unreasonably prejudice the legitimate interests of the author'. Accordingly, the subject of limitation and exception to copyright 'strikes directly at the issue of the appropriate balance between the rights of creators and the public interest in access to copyright works'.¹⁵¹

The TRIPS Agreement established certain limitations and exceptions in relation to the provision of copyright and related rights. Regarding copyright, article 13 of the TRIPS Agreement highlights the principle of the three-step test: (1) the limitations and exceptions are confined to certain special cases; (2) do not in conflict with a normal exploitation of the work; and (3) do not unreasonably prejudice the legitimate interests of the right holder. The three-step test was adopted from article 9.2 of the Berne Convention¹⁵² which applies only to reproduction rights.

¹⁴⁷ Article 12 TRIPS Agreement.

¹⁴⁸ Footnote 1 of the TRIPS Agreement states

When 'nationals' are referred to in this Agreement, they shall be deemed, in the case of a separate customs territory member of the WTO, to mean persons, natural or legal, who are domiciled or who have a real and effective industrial or commercial establishment in that customs territory.

¹⁴⁹ See also Bercovitz Alberto (2008) 'Copyrights and Related Rights' in Correa C.M and Yusuf A. A. (eds) *Intellectual property and International Trade the TRIPS Agreement* 2nd Edition pp. 127-147 Kluwer The Netherlands.

¹⁵⁰ Article 13 TRIPS Agreement; Okediji Ruth L. "The International Copyright System: Limitations, Exceptions and Public Interest Considerations for Developing Countries" *UNCTAD- ICTSD Project on IPRS and Sustainable Development* Issue Paper No. 15 p.12.

¹⁵¹ *UNCTAD/ICTSD, Resource Book on TRIPS* p.186.

¹⁵² Berne Convention 1917. Right of Reproduction: Article 9 (2):

Even though the TRIPS Agreement did not specify limitations and exceptions, there are certain exceptions in the Berne Convention, such as Article 2.8 which stipulates that protection shall not apply to news of the day or to miscellaneous facts. There is a list of permissible exceptions in Articles 2b, 10, 10b and Article III (Appendix) of the Berne Convention. In addition, there are other well-known exceptions to copyright protection, such as private use, educational purposes, library uses, criticism and satire, uses by the press for news of the day and so on.

The *United States–Section 110(5) of the U.S. Copyright Act*,¹⁵³ was the first case in which article 13 of the copyright provisions of the TRIPS Agreement and article 9.2 of the Berne Convention were interpreted. The Panel examined the scope of permissible limitations and exceptions under the minor exceptions doctrine and concluded that the doctrine is primarily concerned with *de minimis* use, but that its application is not limited to the examples contained in the reports of the Berne Convention¹⁵⁴ but to exclusively non-commercial uses or to exceptions in national legislation that existed prior to 1967. As the Panel noted the wording of article 13 derives largely from article 9.2¹⁵⁵ which applies, however, to reproduction rights only. Given the similarity of the wording, it was contended that the preparatory works of article 9.2 of the Berne Convention and its application in practice may be of contextual relevance in interpreting article 13 of the TRIPS Agreement.¹⁵⁶ Thus, the WTO panel resolved that both tests entailed basically the same analysis.

Consequently, as succinctly put by Hitty,¹⁵⁷ copyright is an important incentive for the creation and dissemination of works to the general public. The benefits of copyright

It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in *certain special cases*, provided that such reproduction does *not conflict with a normal exploitation of the work* and does *not unreasonably prejudice the legitimate interests of the author*.

¹⁵³ United States–Section 110(5) U.S. Copyright Act, June 15, 2000, WTO Doc. WT/DS160/R (2000).

¹⁵⁴ Revision conferences held in Brussels and Stockholm.

¹⁵⁵ The Berne Convention (1971).

¹⁵⁶ United States–Section 110(5) U.S. Copyright Act, June 15, 2000, WTO Doc. WT/DS160/R (2000) Panel Report foot note 105 p. 31.

¹⁵⁷ UNCTAD/ICTSD, Limitations and Exceptions to Copyright: Recent Developments and the Way Forward UNCTAD/ICTSD Side-event during the meeting of the WIPO Standing Committee on Copyright and Related Rights (SCCR) 29 May 2009 available at http://unctad.org/sections/dite_totip/docs/tot_ip_0011_en.pdf accessed 25 November 2013.

protection can be served well, if the rights of all parties are balanced in copyright laws, as declared under article 7 of the TRIPS Agreement’.

3.3.1.6 Article 14.1: Right of Protection of Performers

Article 14 provides for the protection of performers,¹⁵⁸ producers of phonograms¹⁵⁹ (sound recordings)¹⁶⁰ and broadcasting organisations,¹⁶¹ which are generally referred to as ‘neighbouring rights’. The term ‘neighbouring rights’, often referred to as ‘related rights’, is usually understood to mean rights that protect the interests of certain groups of right holders whose activities in most cases relate to the reproduction and dissemination of works.¹⁶² In some countries these rights are either incorporated into the copyright regime,¹⁶³ which is the case in Nigeria¹⁶⁴ and the United Kingdom¹⁶⁵ or in some countries, such as France and Germany, are protected under a separate regime.¹⁶⁶

Unlike the other provisions of this section which incorporate the Berne Convention, article 14 does not specifically mention articles which are incorporated in the TRIPS Agreement from the Rome Convention¹⁶⁷ which deals with the protection of performers, producers of phonograms and broadcasting organisations. This means that all the provision of the Rome Convention may be applicable. Notably, compliance to a minimum requirement is not

¹⁵⁸ Article 3 (a) Rome Convention defines ‘performers’ as actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works.

¹⁵⁹ Article 3 (b) Rome Convention defines phonogram to mean any exclusively aural fixation of sounds of a performance or of other sounds.

¹⁶⁰ Article 3 International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations defines ‘phonogram’ to mean any exclusively aural fixation of sounds of a performance or of other sounds. Sound recordings are defined as ‘works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audio-visual work’. Phonograms and sound recordings are used coextensively in Article 14.

¹⁶¹ Article 3 (f) Rome Convention provides that ‘broadcasting’ means the transmission by wireless means for public reception of sounds or of images and sounds.

¹⁶² Basic Notions about Copyright and Neighbouring Rights 15 May 2012 http://portal.unesco.org/culture/en/files/30671/11443368003faq_en.pdf/faq_en.pdf accessed 25 November 2013.

¹⁶³ UNCTAD/ICTSD, *Resource Book on TRIPS* p.199.

¹⁶⁴ See sec generally 26-30 Copyright Act 1988 Cap 28 Law of the Federation 2004 which contains all the provision on rights of performers

¹⁶⁵ Rights in performances is contained in Part II of the Copyright, Designs and Patents Act 1988 which consist of four chapters from ss180 -212

¹⁶⁶ UNCTAD/ICTSD, *Resource Book on TRIPS* p.199.

¹⁶⁷ Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations Done at on October 26, 1961.

required under the Rome Convention.¹⁶⁸ The content of article 14.1 is analogous to article 7.1 (b) and (c) of the Rome Convention and it provides that performers, producers and broadcasting organisations shall be able to prevent fixation of their unfixed performance and reproduction made without their consent. Performers have the possibility of preventing acts, such as broadcasting by wireless means and the communication to the public of their live performance, if obtained without their authorisation.¹⁶⁹ Arguably, the expression ‘possibility of preventing the following acts’ may not accord performers the full right to authorise or to prohibit performance.¹⁷⁰ Hence, the provision allows members to choose the way they want to implement their performer’s rights.

The question on whether the flexibilities in implementing the rights of performers under the Rome Convention extend to WTO members under the TRIPS Agreement has been debated. The importation of the language of the Rome Convention into the TRIPS Agreement may allow for a traditional interpretation and meaning according to the Rome Convention because of the direct reference to the Convention.¹⁷¹ This interpretation is doubtful, considering that under article 42 of the TRIPS Agreement, members are specifically required to make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered by the Agreement. It should be noted that a right holder includes federations and associations having legal standing to assert such rights.¹⁷²

3.3.1.7 Article 14.2: Right of Producers of Phonograms

Article 14.2 gives producers of phonograms the right to authorise or prohibit the direct or indirect reproduction of their phonograms. The provision is comparable to article 10 of the Rome Convention in which a ‘producer of phonograms’ means the person who, or the legal entity which, first fixes the sounds of a performance or other sounds.¹⁷³

¹⁶⁸ Abbott, Frederick , Cottier, Thomas & Gurry, Francis, *The International Intellectual Property System Commentary and Materials* Part I Kluwer Law International The Netherland p.987

¹⁶⁹ Article 14. 1 (b) TRIPS Agreement.

¹⁷⁰ UNCTAD/ICTSD, *Resource Book on TRIPS* p.199; see also Gervais, *The TRIPS Agreement* para. 2.203 p.305.

¹⁷¹ Gervais, *The TRIPS Agreement* para. 2.203 p.305. see also article 1.3 and 2.2n TRIPS Agreement.

¹⁷² Footnote 11 TRIPS Agreement.

¹⁷³ Article 3 Rome Convention.

3.3.1.8 Article 14.3: Broadcasting Organisations

Article 14.3 reinforces the protection for broadcasting organisations provided under article 13 of the Rome Convention.¹⁷⁴ The article grants broadcasting organisations an optional right to prohibit the fixation of television broadcasts undertaken without their authorisation. This right is not mandatory and members are not obliged to provide broadcasting organisations this right.

However, where members do not grant broadcasting organisations such rights they have to provide an alternative form of protection for owners of copyright in the broadcast with the possibility of preventing the unauthorised fixation of the broadcast.¹⁷⁵ This stipulation applies to rebroadcast by wireless means of television broadcasts undertaken without their authorisation. Therefore, where copyrights owners of broadcast works are protected under the provision of the Berne Convention, it is no longer obligatory to grant broadcasting organisations such rights.¹⁷⁶

The concept of broadcasting, to some extent, has been updated by the WIPO Performances and Phonograms Treaty (WPPT),¹⁷⁷ adopted in 1996.

¹⁷⁴ Article 13 Rome Convention states:
 Minimum Rights for Broadcasting Organisations Broadcasting organisations shall enjoy the right to authorize or prohibit:
 (a) the rebroadcasting of their broadcasts;
 (b) the fixation of their broadcasts;
 (c) the reproduction:
 (i) of fixations, made without their consent, of their broadcasts;
 (ii) of fixations, made in accordance with the provisions of Article 15, of their broadcasts, if the reproduction is made for purposes different from those referred to in those provisions;
 (d) the communication to the public of their television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee; it shall be a matter for the domestic law of the state where protection of this right is claimed to determine the conditions under which it may be exercised.

¹⁷⁵ WIPO Standing Committee on Copyright and Related Rights Protection of Broadcasting Organizations: Terms and Concepts *Working Paper Prepared by The Secretariat SCCR/8/INF/1*.

¹⁷⁶ Article 10*bis* and 11*bis*; Frederick Abbott, Thomas Cottier & Francis Gurry, *The International Intellectual Property System: Commentary and Materials* Kluwer 1999 p. 988.

¹⁷⁷ WIPO Performances and Phonograms Treaty (adopted in Geneva on December 20, 1996); article 2(f) of the WPPT states that: 'Broadcasting means the transmission by wireless means for public reception of sounds or of images and sounds or of the representations thereof; such transmission by satellite is also 'broadcasting';

Article 13 of the Rome Convention provides minimum rights for a broadcasting organisation, which members of the TRIPS Agreement may, in relation to the rights conferred under article 14.3, allow as well. Article 13 of the Rome Convention provides corresponding rights to article 14.3. Broadcasting organisations shall enjoy the right to authorise or prohibit the rebroadcasts, fixation of their broadcasts, the reproduction of fixations, made without their consent and broadcasts and fixations made in accordance with permitted exemptions.¹⁷⁸

Article 14.3 grants a right to prohibit reproduction of fixations of their broadcasts without the above-mentioned qualifications.

3.3.1.9 Article 14.4: Rental Rights

This article grants producers exclusive rental rights with regard to their phonograms (Sound Recordings). The provisions of article 11 of the TRIPS Agreement in respect of computer programs shall apply *mutatis mutandis* to producers of phonograms and any other right holders in phonograms as determined in a member's law. Members who have a system of equitable remuneration for right holders in respect of the rental of phonograms may maintain such a system provided that the commercial rental of phonograms does not give rise to material impairment of the exclusive rights of reproduction of right holders.

Unlike the TRIPS Agreement, Articles 9 and 13 of the WIPO Performances and Phonograms Treaty (WPPT) grant exclusive rental rights to performers and phonogram producers in respect of commercial rental of the original and copies of their performances and phonograms. Like the TRIPS Agreement, the treaty leaves rental rights of performers to be 'determined in the national law of contracting parties'. However, the extension of the rental

transmission of encrypted signals is 'broadcasting' where the means for decrypting are provided to the public by the broadcasting organisation or with its consent.'

¹⁷⁸

Article 15 Rome Convention-

Any Contracting State may, in its domestic laws and regulations, provide for exceptions as regards (a) private use; (b) use of short excerpts in connection with the reporting of current events; (c) ephemeral fixation by a broadcasting organisation by means of its own facilities and for its own broadcasts; (d) use solely for the purposes of teaching or scientific research.

right to other right holders in phonogram may include the author of the musical work and probably the performers.¹⁷⁹

3.3.1.10 Article 14.5: Term of Protection

The term of protection for various rights holders differs under the TRIPS Agreement. For performers and producers of phonograms the protection shall last at least until the end of a period of 50 years from the end of the calendar year in which fixation of the performance took place. The term of protection granted to broadcasting organisations shall be for at least 20 years from the end of the calendar year in which the broadcast took place. These are minimum standards expected from members: members can provide a longer term of protection. Unlike the Rome Convention, which provides a uniform term of protection of only 20 years to performers and producers of phonograms and broadcasting organisation,¹⁸⁰ the TRIPS Agreement provides a longer term of protection for performers and producers of phonograms only.

3.3.1.11 Article 14.6: Conditions, Limitations, Exceptions and Reservations

This article contains two sets of provisions: one relates to conditions, limitations, exceptions and reservations to the extent permitted by the Rome Convention and the other deals with the application of Article 18 of the Berne Convention, which applies *mutatis mutandis* to the rights of performers and producers of phonograms. The first provision incorporates Articles 7, 13, 15 and 16 of the Rome Convention.¹⁸¹ The provision appears to allow a traditional interpretation, according to the Rome Convention.

Arguably, limitations, exceptions and reservations are allowed to the extent permitted by the Rome Convention. ‘Exceptions provisions’ permit the use of IP by someone other than the rights-holder. Thus, exceptions in article 15,¹⁸² which relate to private use, use of short excerpts in connection with the reporting of current events, ephemeral fixation by a

¹⁷⁹ WIPO Standing Committee on Copyright and Related Rights Protection of Broadcasting Organizations: Terms and Concepts *Working Paper Prepared by The Secretariat SCCR/8/INF/1*.

¹⁸⁰ Article 14 Rome Convention.

¹⁸¹ Gervais, *The TRIPS Agreement* para.2.206 p.308.

¹⁸² Rome Convention on 1961 International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations.

broadcasting organisation by means of its own facilities and for its own broadcasts and used solely for the purposes of teaching or scientific research, extends to paragraphs 1, 2 and 3 of this provision.¹⁸³ It is submitted, since this provision is largely dependent on the Rome Convention, that members are free to adopt laws that suit them.

The second part of the paragraph provides that Article 18 of the Berne Convention should be applied *mutatis mutandis* to the rights of performers and producers of phonograms: simply, it provides for works that are protectable and non-protectable at the inception of the TRIPS Agreement. Works that have not yet fallen into the public domain through the expiry of the term of protection will still be protected.¹⁸⁴ However, if the work has fallen into the public domain through the expiry of the term of protection it will not be protected anew.¹⁸⁵ Article 18 of the Berne Convention is comparable to article 70.3 of the TRIPS Agreement.¹⁸⁶ The principle is subject to the provisions in special agreements between countries of the Berne Union: special agreement may include the TRIPS Agreement where a member is not obliged to apply the provisions of article 11 and article 14.4 with respect to originals or copies purchased prior to the date of application of this Agreement for that member.¹⁸⁷ Preceding provisions shall apply in the case of new accessions to the Union and to cases in which protection is extended by the application of article 7.¹⁸⁸

3.3.1.12 Conclusion

Although the provisions on copyright in the TRIPS Agreement seem few, they fulfil the function of establishing what is protectable and non-protectable. This section examined the provisions of the TRIPS Agreement on copyright and related right in relation to its likely interpretation and implementation. The rights and obligation of members in relation to the Berne Convention were highlighted, as article 9 of the TRIPS Agreement assimilates articles 1 through 21 of the Berne Convention. A number of comparisons have been drawn between

¹⁸³ Article 14.1, 14.2, 14.3 TRIPS Agreement.

¹⁸⁴ Article 18.1 Berne Convention.

¹⁸⁵ Article 18.2 Berne Convention.

¹⁸⁶ Article 70.3 TRIPS Agreement states that “there is no obligation to restore protection to subject matter which on the date of application of this Agreement for the member in question has fallen into the public domain”.

¹⁸⁷ Article 70.5 TRIPS Agreement. See also Gervais, *The TRIPS Agreement* para. 2.206 p.309.

¹⁸⁸ Such as the case of the Doha Declaration on TRIPS.

the provisions of the TRIPS Agreement on copyright and the Berne Convention and it appears, in the articles compared, that the Berne Convention has enhanced the application and interpretation of the TRIPS Agreement. Significant changes to copyright, such as the specific inclusion of computer programs as literary works, compilations of data where selection or arrangement of their contents constitutes intellectual creations, and the provision of rental rights for computer programs and cinematographic works, were examined in this section.

3.3.2 Trade Marks

The TRIPS Agreement signifies a noteworthy advance in the development of trade mark law.¹⁸⁹ Section 2 of part II of the TRIPS Agreement consists of seven articles. Articles 15 to 21 provide for the protection of trade marks in the TRIPS Agreement. Like the copyright section, this section is based on the relevant provisions of the Paris Convention.¹⁹⁰ As a basic principle of the TRIPS Agreement, article 2.1 provides that members shall comply with articles 1 through 12, and article 19, of the Paris Convention (1967). The relevant provisions in the Paris Convention to this section, are articles 4, 5C, 6, 6*bis*, 6*ter*, 6*quarter*, 6*quinquies*, 6*sexes*, 6*septies*, 7, 7*bis*, 8, 9, 10*ter*, 11 and 12. Part of the motive for the negotiation of the TRIPS Agreement was the concern for trade mark counterfeiting and ‘the straightforward misappropriation of the persona of a producing enterprise.’¹⁹¹

3.3.2.1 Article 15: Protectable Subject Matter

Article 15.1 establishes a uniform definition of a trade mark that had been absent from the Paris Convention.¹⁹² The provision defines ‘trade mark’ not previously defined in any of the WIPO administered Conventions.¹⁹³ A trade mark is:

¹⁸⁹ UNCTAD/ICTSD, *Resource Book on TRIPS* p.217.

¹⁹⁰ Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, *as last revised* at Stockholm July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

¹⁹¹ UNCTAD/ICTSD, *Resource Book on TRIPS* p.216.

¹⁹² Schmidt-Szalewski, Joanna “International Protection of Trademarks after Trips Agreement” *Duke Journal of Comparative & International Law* [Vol. 9:189- 212]1998] p.206.

¹⁹³ Gervais, *The TRIPS Agreement* para. 2.223 p.318. see also Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.307.

[A]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

The definition is extensive and accommodates various types of signs that may be contemplated as a trade mark.¹⁹⁴ The definition permits members to adopt an extensive scope of protection of trade mark.

The use of ‘[a]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark’ makes it possible to extend protection to include registered and unregistered trade marks in so far as they are capable of distinguishing the goods or services.¹⁹⁵ However, there is no automatic protection without distinctiveness regarding all marks.¹⁹⁶ Even if signs are distinctive, members may still require that the sign be visually perceptible as a condition for registration; meaning that distinctiveness does not impose an obligation on the member to register the mark.¹⁹⁷

The provision extends protection to include service marks as it refers to goods and services jointly, thus putting them on equal footing with trade marks for goods.¹⁹⁸ Article 6*sexies* of the Paris Convention provides that the countries of the Union undertake to protect service marks: however, they shall not be required to provide for the registration of such marks. In contrast, under the TRIPS Agreement, members are required to provide registration for service marks as in the case of trade marks.

The second part of the definition lists subject matters that are eligible for protection as signs, in particular words, including personal names, letters, numerals, figurative elements and

¹⁹⁴ Gervais, *The TRIPS Agreement* para. 2.223 p.318.

¹⁹⁵ Gervais, *The TRIPS Agreement* para. 2.223 p.318.

¹⁹⁶ Keon, Jim. ‘Intellectual Property Rules for Trademark and Geographical Indications: Important Part of the New World Trade Order’ in Carlos Correa and Abdulqawi Yusuf (Eds) *Intellectual Property and International Trade: The TRIPS Agreement*. Kluwer Law International BV the Netherlands 2008 p. 153.

¹⁹⁷ Phillips, Jeremy & Simon, Ilanai, *Trade Mark Use* Oxford University Press Oxford 2005 p. 293.

¹⁹⁸ Keon, Jim, ‘Intellectual Property Rules for Trademark and Geographical Indications.’ 153.

combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. As a condition for registration it may be required that signs be visually perceptible.

The third part of the definition facilitates secondary meanings where signs are not inherently capable of distinguishing the relevant goods or services. Marks that require secondary meaning or need to acquire distinctiveness through use are usually marks that describe the goods or service for which it is used as against marks that are arbitrary or suggestive.¹⁹⁹ It means that actual use must have occurred and relevant consumers must associate the goods and services to the mark.

3.3.2.2 Article: 15.2: Denial Grounds

Article 15.2²⁰⁰ provides, apart from the mark not been inherently capable of distinguishing the relevant goods or services, that members may deny registration only on grounds specified in the Paris Convention.²⁰¹

3.3.2.3 Article 15.3: Use

Registrability may be dependent on use, but actual use of a trade mark is not a condition for filing an application for registration. However, a refusal of an application cannot be based on non-use before the expiration of three years from the date of the application. This means that an intention to use a mark is sufficient at the point of registration, provided there is intent to actually use the mark. In essence, a mark registered with intent to use may be cancelled only after the expiration of three years²⁰² even where the registration took place *mala fide*.

This flexibility may allow for fraudulent applications, since the application can sit in the registry for more than three years. Also it can bring about a proliferation of unused marks in the trade mark registry.

¹⁹⁹ UNCTAD/ICTSD. *Resource Book on TRIPS* p.230-231.

²⁰⁰ TRIPS Agreement.

²⁰¹ Article *6bis*, *6ter* and *6quinquies*, Paris Convention.

²⁰² Antony Taubman, Hannu Wager, Jayashree Watal (eds) *A Handbook on the WTO TRIPS Agreement* Cambridge Press 2012 p. 63.

3.3.2.4 Article 15.4: Nature of the Goods or Services

This provision is comparable to article 7 of the Paris Convention, which provides that the nature of the goods or services to which a trade mark is to be applied shall in no case form an obstacle to registration of the trade mark. The ‘nature of the goods or services to which a trade mark is to be applied’ is ambiguous and might intrude into the arena of morality and public order. The TRIPS Agreement may permit marks with religious connotations, vulgar and profane content, marks involving innuendo, marks suggesting or promoting illegal activity. However, if the Article 6*quinquies* B (iii)²⁰³ is read in conjunction with this provision the essence of this provision is changed giving it another meaning when a mark is considered for registration.²⁰⁴ In addition, taking into cognisance article 2 of the TRIPS Agreement which provides that members shall comply with articles 1 through 12 and article 19, of the Paris Convention; marks that are contrary to morality or public order and, in particular, of such a nature as to deceive the public²⁰⁵ can be denied registration and invalidated. However, it still leaves what is moral or contrary to public order to the discretion of member States.²⁰⁶

Since the provision is the minimum standards required, several countries object to registration of marks that are contrary to morality and public order. In December 2005, Alvito Holdings, a clothing and fashion manufacturer based in Gibraltar (UK), filed an application before the Office for the Harmonisation of the Internal Market (OHIM) for two graphic trade marks and one text trade mark: ‘Not Made in China’. Worldwide outrage

²⁰³ Article 6*quinquies* B (iii) Paris Convention.
 Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

- (ii) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
- (iii) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

²⁰⁴ UNCTAD/ICTSD, *Resource Book on TRIPS* p.235.

²⁰⁵ Article 6*quinquies* B (iii) Paris Convention.

²⁰⁶ Justin Malbon, Charles Lawson, Mark Davison *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights A Commentary* Edward Elgar 2014 p.291

followed the publication of this application in early 2006. OHIM acknowledged the observations and took into consideration article 7 (1) f of CTMR that objects to trade marks which are contrary to public policy or to accepted principles of morality. The OHIM agreed that the trade mark ‘conveys an insult to all the goods made in China’ and considered that it would ‘harm Sino-European diplomatic ties’.²⁰⁷ The foregoing reveals that where necessary, countries can prevent the use of a mark that would be contrary to public order and morality.

3.3.2.5 Article 15.5: Publication

This provision comprises of the procedural issues which consist of publication, cancellation and opposition.²⁰⁸ Members are required to publish each trade mark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions for those seeking to cancel the registration on one ground or the other. In addition, members are required to put an opposition system in place to allow for fairness in the process of registration. Since the TRIPS Agreement does not have its own system of registration, like the Madrid Protocol, individual members are to provide a system of cancellation, publication and opposition, however, it still remains optional.²⁰⁹

3.3.2.6 Article 16: Rights Conferred

The TRIPS Agreement requires members to provide the owner of a registered trade mark the exclusive right to prevent all third parties, not having the owner's consent, from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered. This provision deals only with registered marks. The right conferred here is against all third parties who do not have the owner's consent to use the mark. Preventable uses relate to identical and similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion.²¹⁰ This practice is also

²⁰⁷ China Intellectual Property at <http://www.chinaipmagazine.com/en/journal-show.asp?id=320> 20, May 2012.

²⁰⁸ UNCTAD/ICTSD. *Resource Book on TRIPS* p.235.

²⁰⁹ Gervais, *The TRIPS Agreement* para.2.227 p.323.

²¹⁰ UNCTAD/ICTSD *Resource Book on TRIPS* p.236.

known as trade mark counterfeiting²¹¹ where the trade mark is similar and the goods are similar and is likely to cause confusion.²¹² The rights described above shall not prejudice any existing prior rights and may include rights available under the Paris Convention, but existing prior rights of any kind remain unaffected by the right holder's exercise of the trade mark rights.²¹³

3.3.2.7 Article 16.2: Well Known Marks

Article 6bis of the Paris Convention²¹⁴ provides protection for a well-known mark used in relation to goods. Article 16.2 extends the rights of protection to service marks, thus requiring well-known service marks to be protected just like well-known marks used on goods. Well-known trade and service marks enjoy protection in most countries against signs which are considered a reproduction, imitation or translation of that mark if they are likely to cause confusion in the relevant sector of the public.²¹⁵ In determining whether a trade mark is well-known, members shall take into account knowledge of the trade mark in the relevant

²¹¹ For the purposes of the TRIPS Agreement: Note 14 of the TRIPS Agreement provides the following interpretation.

(a) 'counterfeit trademark goods' shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation.

²¹² UNCTAD/ICTSD, *Resource Book on TRIPS* p.236.

²¹³ Schmidt-Szalewski. Joanna "International Protection of Trademarks after Trips Agreement" *Duke Journal of Comparative & International Law* [Vol. 9:189- 2121998].

²¹⁴ Article 6bis Paris Convention provides:

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

²¹⁵ Well-known marks available at http://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm accessed 18 May 2012.

sector of the public, including knowledge obtained as a result of the promotion of the trade mark. According to Bodenhausen,²¹⁶ the purpose of the provision under consideration is to:

...avoid the registration and use of a trade mark, liable to create confusion with another mark already well known in the country of such registration or use, although the latter well-known mark is not or not yet protected in that country by a registration which would normally prevent the registration or use of the conflicting mark.²¹⁷

The justification for the protection given to such marks stems from the fact that such uses amount to unfair competition and may be prejudicial to the interest of the public who are deceived.²¹⁸

Another notable issue in article 6bis is the protection of unregistered marks that qualify as ‘well-known’ in a member nation.²¹⁹ It has been observed that a trade mark may be well-known in another country before its registration even before it is used in such countries due to advertisement in other countries. Whether a trade mark is well-known in a country may have to be resolved by a competent administrative or judicial authority.²²⁰ In the South African case of *McDonald’s Corporation v Joburgers Drive-Inn Restaurant (PTY)*,²²¹ a number of McDonald’s trade mark had been registered in South Africa in respect of a variety of goods and services relating to their fast food services and foodstuffs. However there were no McDonald’s outlets in operation in South Africa as at the time of instituting this case. Joburgers Drive-Inn Restaurant proposed to open a chain of McDonald’s fast food outlets selling Big mac, McMuffins and Egg McMuffins etc. The Supreme Court of South Africa held that the mark McDonald’s was entitled to protection as a “well-known trademark” under

²¹⁶ G. H. C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised in 2007 p.90.

²¹⁷ Cf. LADAS: “International Protection of Well-known Trademarks. To Trademark Reporter. 1951. p. 661; TROLLER: “*La marque de haute renommée*,” P.I. 1953, p. 73; BLUM: “*La marque de haute renommée*. P.I” 1954, p. 110.cited in G. H. C. Bodenhausen *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised in 2007 p.90.

²¹⁸ Actes de La Haye, pp. 241/2, 246 (proposal), 341/3 (observations), 453/6 (report of Third Sub-Committee), 523 (report of General Committee), 543/4 (report of Drafting Committee), 577 (adoption in Second Plenary Session). P.455 cited in G. H. C. Bodenhausen *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised in 2007 p.90-91.

²¹⁹ Reiss, Seth M. *Commentary on the Paris Convention for the Protection of Industrial Property* at <http://www.lex-ip.com/Paris.pdf> accessed 18 May 2012.

²²⁰ G. H. C. Bodenhausen *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised in 2007 p.91; see *McDonald’s Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd. and Another* (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA); [1996] 4 All SA 1 (A); (27 August 1996).

²²¹

Article 6bis of the Paris Convention despite having never been used as such at that time within South Africa.

3.3.2.8 Article 16.3: Application of Well-Known marks to Different Goods and Services

Article 16.3 highlights the protection of the reputation of the well-known mark against confusing uses of the mark and particularly extends protection to the use of the well-known mark to goods and services that are not similar. The provision also contains an important qualifier, that is, the interest of the owner of the well-known mark may likely be damaged by such use. Noticeably, in most countries well-known marks are protected ‘irrespective of whether they are registered or not, in respect of goods and services which are identical with, or similar to, those for which they have gained their reputation.’²²² Whether the same treatment would be accorded goods and services that are different will depend on how famous the mark has become so that the use would suggest a connection to the well-known mark.

Gervais argues,²²³ article 16.3 entails the use of the well-known mark in respect of specific goods and services for which the mark is not registered and the protection of such marks will depend on two conditions, first that the owner of the mark be linked to it and, second, the possibility of damage to the interest of the owner of the well-known mark.

According to the UNCTAD/ICTSD,²²⁴ damage to the reputation of the owner may occur in two ways:

- i. The well-known trade mark holder might itself have been planning to enter the same market as the third party using the mark. It would therefore be injured by the loss of revenue.
- ii. The third party using the mark may be doing so in a way that would tarnish or injure the reputation of the trade mark holder.

²²² Well-known marks available at http://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm 18 May 2012.

²²³ Gervais. *The TRIPS Agreement* para 2.240 p.333.

²²⁴ UNCTAD/ICTSD. *Resource Book on TRIPS* p.241.

In essence, riding on the coat tails of well-known marks to gain unfair advantage will not be allowed.

3.3.2.9 Article 17: Exception

This provision gives members room for flexibility in deciding the exceptions to trade mark protection. For instance, descriptive terms may acquire protection after the use of the mark, without detriment to the legitimate interests of the owner of the trade mark and of third parties.²²⁵ This is because descriptive terms²²⁶ are considered not protectable *ab initio* except if they acquire secondary meaning, making it an exception to the requirement of initial distinctiveness. Other types of permitted uses of a trade mark without the owner's consent are, for instance, when it is used in comparative advertising. An example of comparative advertising is where an Omo advertisement claims to wash better than Ariel by mentioning those qualities that makes Omo a better detergent than Ariel or other detergents. Furthermore, permitted uses of a trade mark include news reporting and commentary²²⁷ by media houses in various events. A media house has to mention the trade marks of the various brand names of fashion designers taking part on the runway in a fashion show. Other exception not mentioned in the TRIPS Agreement may include parody and criticisms of a trade mark: it is left for each member of the WTO to decide a limited exception for this type of use.

3.3.2.10 Article 19: Requirement of Use

The requirement for use here provides a basis for non-cancellation of a trade mark²²⁸ if the trade mark has been used for an uninterrupted period of at least three years, unless the trade mark owner gives valid reasons based on the existence of obstacles to such use. Although actual use is not required, failure to use the mark may lead to cancellation.²²⁹ Non-use of the

²²⁵ Article 17 TRIPS Agreement.

²²⁶ Descriptive mark convey an immediate idea of the ingredients, qualities or characteristics of the goods it describes the product and does not denote the source of the product but rather directly describes, than suggests, a characteristic or quality of the underlying product.

²²⁷ UNCTAD/ICTSD. *Resource Book on TRIPS* p.242.

²²⁸ This provision is similar to Article 5.C (1) Paris Convention.

²²⁹ WIPO Implications of the Agreement on Trade-Related Aspects of Intellectual Property on Treaties Administered by WIPO, WIPO publication No 949CE 2003 p. 36.

trade mark within the mentioned period may lead to a loss of right in the trade mark.²³⁰ The TRIPS Agreement excuses circumstances arising independently of the will of the owner of the trade mark. The justification may include import restrictions or other government requirements for goods or services protected by the trade mark, which are recognised as valid reasons for non-use. It is believed that the provision provides for both narrow and broad justification of non- use at the same time.²³¹

3.3.2.11 Article 19.2 and 21: Licensing and Assignment

Article 19.2 relates to a situation in which a trade mark is licensed to a third party,²³² in essence, use by a licensee is recognised as use by the owner of a trade mark for the purpose of maintaining the registration. In addition, according to article 21 of the TRIPS Agreement, members may determine conditions of licensing and assignment of marks, thus permitting a trade mark owner (licensor) to control the use of the trade mark in a way that protects the source indication function of the mark. Naked licensing²³³ of the trade mark is permitted. However, the compulsory licensing of trade marks shall not be permitted. In general, apart from the above mentioned restrictions, the TRIPS Agreement allows the owner of a registered trade mark to assign the trade mark, with or without the transfer of the business. The provision is at variance with article 6*quater* of the Paris Convention which provides that an ‘assignment of a mark is valid only if it takes place at the same time as the transfer of the business or goodwill to which the mark belongs’.

3.3.2.12 Article 20: Other Requirements

Article 20 prohibits the imposition of special requirements, such as use with another trade mark, use in a special form or use in a manner detrimental to its capability to distinguish the

²³⁰ WIPO, introduction to intellectual property theory and practice. Kluwer law international the Netherlands 1997 p.197.

²³¹ UNCTAD/ICTSD, *Resource Book on TRIPS* p.245.

²³² UNCTAD/ICTSD, *Resource Book on TRIPS* p.245; see also Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.449-350.

²³³ This is where a trade mark owner fails to exercise adequate quality control over the use of the trade mark licenced to the licensee. Donald S. Chisum, Tyler T. Ochoa, Shubha Ghosh, Mary LaFrance *Understanding Intellectual Property Law 2nd ed* LexisNexis USA 2011 p 792.

goods or services of one undertaking from those of other undertakings.²³⁴ The requirement does not preclude the use of the trade mark for identifying the company producing the goods or services. However, identification does not include a link to the trade mark distinguishing the specific goods or services in question.

3.3.2.13 Conclusion

The definition of trade marks in the TRIPS Agreement brings about a change in the approach of legal presentation of trade marks. Prior to the adoption of the TRIPS Agreement, the Paris Convention had no specific definition of trade marks leaving it to countries to determine the scope of what it considers as a component of a trade mark. The definition contains protectable subject matter, but leaves non-protectable subject matter for members to determine, which gives flexibility.

As pointed out in this section, the TRIPS Agreement confers exclusive rights to use the trade mark to the exclusion of all others. Protection of well-known marks is extended to service marks, as well as to goods and services different from those to which the well-known trade mark is used. The TRIPS Agreement recognises that procedures for the registration of trade marks, such as use, opposition, cancellation and publication, are necessary for proper trade marks accountability. Furthermore, the provisions provide concise explanations of what a trade mark regulation is expected to contain.

3.3.3 Geographical Indications

The laws of intellectual property also include area of geographical indications (GIs). This area of law specifically deals with the geographical location of the product. As Gangjee notes there is a lot of disparity in this area of law the ‘nature scope and institutional forms of protection’ differ in various jurisdictions.²³⁵ The relevant provisions of the TRIPS Agreement are captured in Article 22-24.

²³⁴ UNCTAD/ICTSD, *Resource Book on TRIPS* p.246.

²³⁵ Dev Gangjee *Relocating the Law of Geographical Indications* Cambridge University Press New York 2012 p.1-8

3.3.3.1 Article 22: Protection of Geographical Indications

This article gives a definition to what will be regarded as geographical indications. Article 22.1 defines GIs as ‘indications which identify a good as originating in the territory of a member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin’.²³⁶ This is the first international treaty to define the scope of geographical indications.²³⁷ Geographical indications are restricted to goods only and in essence services may not be regarded as GIs for the purposes of the TRIPS Agreement.²³⁸

Thus, one of the most important factors in geographical indications is that goods must be attributable to its geographical origin meaning that the goods must emanate from the origin claimed. Geographical origin means essentially the location. Another important factor for a geographical indication is the ‘quality, reputation or other characteristic’ attached to the goods that originate from the location.

In terms of article 22.2 members are implored to provide the legal means for interested parties to prevent: (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967). Accordingly, members have a right to determine the method they want to use to implement the legal means.²³⁹

Article 22.3 relates to the registration of a trade mark which contains or consists of a geographical indication. This provision prevents the registration of a trade mark on goods not originating in the territory indicated. This provision should be read alongside article 24.5 which prevents the use of misleading geographical indications on wines or spirits. Accordingly any trade mark that has the tendency to mislead the public as to the true place of

²³⁶ Michael Blakeney *The Protection of Geographical Indications: Law and Practice* Edward Elgar Cheltenham 2014 para 2.43 p.21.

²³⁷ Gervias para 2.201 p.188

²³⁸ UNCTAD/ICTSD, *Resource Book on TRIPS* p.289.

²³⁹ Bernard O'Connor *The Law of Geographical Indications* Cameron May Limited London 2004 p. 55

origin may be refused or invalidated in accordance with the member's law.²⁴⁰ This discretion is left to the trade marks office.²⁴¹ This provision shows the overlap of GIs and trade marks, it should however be note that GIs are not meant to distinguish the products of a company.²⁴²

The protection of GIs stated in article 22.1, 22.2 and 22.3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate falsely represents to the public that the goods originate in another territory. This provision makes it clear that that the taste or quality of a does not make it a GI but the location or territory from which it emanates. Accordingly no matter how precise the process to manufacture whisky in Nigeria follows the Scottish tradition and no matter how similar a whisky made in Nigeria may taste to a Scotch whisky, it is not Scotch whisky and it would be a false representation to market it as such.

3.3.3.2 Article 23: Additional Protection for Geographical Indications for Wines and Spirits

Article 23.1 provides added protection to what is granted in article 22 for wines and spirits. Members may provide legal means to prevent the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question. The use of such indication may not be waived even if the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like. It is noted in footnote 4 of the TRIPS Agreement that members may provide for enforcement by administrative action despite the requirement in article 42 that members shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered in the TRIPS Agreement.

²⁴⁰ Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.403

²⁴¹ See also UNCTAD/ICTSD, *Resource Book on TRIPS* p.295.

²⁴² Davis Vivas –Eugui and Christoph Spennemann ‘The Evolving Regime for geographical Indication in WTO and in Free Trade Agreement’ in Carlos Correa and Abdulqawi Yusuf (eds) *Intellectual Property and International Trade The TRIPS Agreement* 2008 Kluwer Law International BV The Netherlands p. 175-17; see also Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.402.;

Article 23.2 is similar to article 22.3 which gives the trade marks office the right to refuse or invalidate GIs. The difference here is that it relates to only wines and spirits. Article 23.3 is also closely related to article 22.4;²⁴³ however, members are to determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled. This provision takes cognisance of a situation where there can be more than one Scotch whisky maker in Scotland and a scotch whisky made Germany.

A notification system and registration of geographical indication for wines eligible for protection shall be undertaken in the Council for TRIPS for protection in participating member state.

3.3.3.3 Article 24: International Negotiations; Exceptions

The provisions of article 24 demonstrate that the provision on GIs are not finalised and can be developed based on agreements reached through negotiations.²⁴⁴ Hence, article 24.1 allows for continuing negotiation for increased protection of individual GIs which refers to the area where consensus was not reached.²⁴⁵ Also articles 24.4 to 24.8 are not to be used as bargaining chips in bilateral or multilateral agreements. Members must consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

Article 24.2 provides for the revision of the geographical indication section by the Council for TRIPS, which also has the power to deal with matters affecting compliance with the obligations in this section. In addition, the Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.

²⁴³ Gervias para 2218 p.197

²⁴⁴ Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.419; Gervias para 2.226 p.203; UNCTAD/ICTSD, *Resource Book on TRIPS* p.300.

²⁴⁵ Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.420

The level of protection accorded to GIs in member countries shall be maintained and cannot be lowered even before the date of entry into force of the WTO Agreement which is 1 January 1995.²⁴⁶

Article 24.4 lays down a fundamental rule which is commonly referred to as the ‘grandfather clause’.²⁴⁷ Essentially, this provision gives recognition to ‘nationals or domiciliaries’ who have used a particular geographical indication for identifying wines or spirits continuously on the same or related goods or services in the territory of that Member for at least 10 years preceding 15 April 1994 or in good faith preceding that date. Consequently such continued and similar use cannot be prevented. It should be noted that this provision only relates to wines and spirits.

Registration or use of the GI in good faith prior to the application of the provision in the member state or before the geographical indication is protected in its country of origin will not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.²⁴⁸

Article 24.6 contains a principle of exclusion. Thus, protection will not be applicable to terms customary in common language as the common name of goods or services in a particular territory of a member. And in particular such protection will not relate to products of the vine where the relevant indication is identical with the customary name of a grape variety existing in the territory of that member as of the date of entry into force of the WTO Agreement. In addition trade marks that are used on GIs and in good faith will benefit from

²⁴⁶ Article 24.3 TRIPS Agreement

²⁴⁷ Gervias para 2.227 p.204; Stoll, Busche, & Arend (eds) WTO Trade Related Aspect of Intellectual property Rights p.422; see also Leign Ann Linquist ‘Champagne or Champagne? An Examination of US failure to Comply with Geographical Provisions of the TRIPS Agreement’ (1990) 27 *Georgia Journal of International and Comparative Law* 309 citing Bruce A. Lehman, *Intellectual Property Under the Clinton Administration*, 27 *Geo. WASH. J. INT’L L. & ECON.* 395,409 (1993-1994).

²⁴⁸ Article 24.4 TRIPS Agreement.

the provisions of article 22 and 23. However where the trade mark is used adversely it must be challenged within a period of five years.²⁴⁹

The use of personal names or the name of a person's predecessor in business is not prejudiced by the provisions of this section provided it is not used in a way that misleads the public.²⁵⁰ Besides, there is no obligation to protect geographical indications which are not or have ceased to be protected in their country of origin or which have fallen into disuse in that country.

3.3.2.2 Patent

This section contains substantive standards and specific issues of enforcement applicable to patents protection. These provisions are built on standards previously established by the Paris Convention.

3.3.4.1 Article 27.1: Patentable Subject Matter

This article deals with the requisites of patentability. According to De Carvalho, article 27.1 is 'the core provision and the reason for the initiation of the TRIPS Agreement'²⁵¹ and still remains contentious. Prior to the ratification of the TRIPS Agreement, the Paris Convention was the main international instrument dealing with patents.²⁵² The article has been dubbed the 'non-discrimination provision' because of the vast coverage the article provides:

Patents shall be available for any inventions, *whether products or processes*, in all *fields of technology*, provided that they are new, involve an inventive step and are capable of industrial application....²⁵³ Patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

²⁴⁹ Article 24.7 TRIPS Agreement. Stoll, Busche, & Arend (eds), *WTO Trade Related Aspect of Intellectual property Rights* p.430

²⁵⁰ Article 24.7 TRIPS Agreement.

²⁵¹ Nuno Pires de Carvalho, *The TRIPS Regime of Patent Rights* Kluwer Law International, The Netherlands' 3rd Edition, 2010 p. 245.

²⁵² Stoll, Busche, & Arend (eds), *WTO Trade Related Aspect of Intellectual property Rights* p.470.

²⁵³ For the purposes of this Article, the terms 'inventive step' and 'capable of industrial application' may be deemed by a member to be synonymous with the terms 'non-obvious' and 'useful' respectively. Emphasis mine

Article 27 establishes a ‘high standard of protection’²⁵⁴ by making it clear that inventions in all fields of technology are to be granted protection, thereby, unequivocally, making patents available for products and processes provided they are ‘new’, ‘involve an inventive step’ and are capable of ‘industrial application’. It has been noted²⁵⁵ that definitions of ‘invention’, ‘new’, ‘inventive step’ and ‘industrial application’ have been left out of the TRIPS Agreement, leaving a lot to be interpreted by member countries. The lack of definition may bring about a harmonisation challenge among members²⁵⁶ if they have to determine what constitutes the meaning of these words. It also provides enormous freedom to decide what to include or exclude, particularly has it relates to the definition of invention.²⁵⁷ Although the TRIPS Agreement does not provide a comprehensive list of exclusions, the Patent Law Treaty (PLT)²⁵⁸ explicitly mentions what is not patentable, so there is a working list that member countries can utilise. The PLT exclusions are not binding on members of the WTO, therefore, the list may be used only as a guide unless the member country has assented to the law and wants to use it.

A controversial and substantive part of this provision includes product patent inventions. According to a study carried out by Phil Thorpe²⁵⁹ on the protection of pharmaceutical products, product patent is a contentious issue and remains so. Prior to the TRIPS Agreement most countries provided patent protection only for process-related patents in the pharmaceutical field based on the presumption that process patents are weaker than patents on products.

²⁵⁴ Stoll, Busche, & Arend (eds) *WTO Trade Related Aspect of Intellectual property Rights* p.471.

²⁵⁵ Correa Carlos. ‘Patent Rights’ Yusuf Abdulqawi A. & Correa Carlos (Eds) *Intellectual Property and International Trade : The TRIPS Agreement 2008* p 227-258, p. 235; Stoll, Busche, & Arend (eds) *WTO Trade Related Aspect of Intellectual property Rights* p.472.

²⁵⁶ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p.472.

²⁵⁷ UNCTAD/ICTSD, *Resource Book on TRIPS* p.357.

²⁵⁸ Article 8 Patent Law Treaty (PLT), this is a WIPO treaty enacted after the TRIPS agreement.

²⁵⁹ Commission on Intellectual Property Rights Study Paper 7 Study on the Implementation of the TRIPS Agreement by Developing Countries p. . This report has been commissioned by the IPR Commission as a background paper. See also UNCTAD/ICTSD. *Resource Book on TRIPS* p.356, Pinelopi Koujianou Goldberg, ‘Intellectual Property Rights Protection in Developing Countries: The Case of Pharmaceuticals’ Princeton University, NBER and BREAD December 2009 available at http://www.econ.yale.edu/~pg87/Goldberg_Marshall.pdf accessed 28 September 2012.

Another highlight of article 27.1 is the fact that the place of invention is not a barrier to the enjoyment of patent protection in member countries. The provision prohibits discrimination based on the field of technology and from where the products are imported.

3.3.4.2 Article 27.2: Excludable Subject Matter

The TRIPS Agreement mentions instances for which inventions may be excluded from patentability. Some inventions may not be commercially exploitable within a member's territory to protect *ordre public*²⁶⁰ or morality.²⁶¹ For instance, the protection of human, animal or plant life, health or to avoid serious prejudice to the environment may exclude a patent provided the exclusion is not made merely because the exploitation is prohibited by a member's law. The provision makes it clear that human and animal life is not patentable.

Other subject matters excluded from patentability are diagnostic, therapeutic and surgical methods for the treatment of humans or animals. Even though article 27.1 makes it clear that all fields of technology are patentable, it is based on the assumption that it would be new, involve an inventive step and capable of industrial application, accordingly the exclusion may be due to the inability of methods of treatment to be industrially applicable. Many countries exclude methods of treatment from patent protection, these include China, India, Japan and most African countries. However, countries, like the United States and Australia, allow methods of treatment to be patented.²⁶² The United Kingdom does not allow the patenting of a method of treatment, but allows patents on inventions based on the use of a substance or composition in the method of treatment.²⁶³

²⁶⁰ These are all mandatory rules that affect the organization of the nation's economy, morality, health, safety, the public peace, human rights and basic freedoms of individual. In our organization the judicial magistrates of the Public Ministry are specifically responsible for ensuring compliance with these rules, which is why they have the power of initiative and intervention. No one can waive the rules of public order, except in the case of persons to whom they apply, if these rules were taken in their interest and their only protection. This meaning is a translation from *dictionnaire du droit prive* available at <http://www.dictionnaire-juridique.com/definition/ordre-public.php>.

²⁶¹ Conformity with recognized rules of correct conduct. See *Black's Law Dictionary* 1031 (8th ed. 2004).

²⁶² UNCTAD/ICTSD, *Resource Book on TRIPS* p. 384.

²⁶³ Patent Act 2004- Guidance Note No.7 Methods of Treatment of Diagnosis <http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-law-guidance/p-law-changes/p-law-changes-treatment.htm> accessed 30 September 2012.

3.3.4.3 Article 27.3 (b): Biotechnology Clause

Article 27.3(b) is popularly called the ‘biotechnology clause’, although the TRIPS Agreement makes no reference to biotechnology at all. The article excludes from patent protection plants and animals, other than micro-organisms and essentially biological processes for the production of plants or animals, other than non-biological and microbiological processes. However, plant varieties can be protected by patents or a *sui generis* system or by any combination thereof. In essence, plants, animals and essentially biological processes are not patentable, whereas micro-organisms, non-biological and microbiological processes are patentable. Several scholars have questioned what the production of plants or animals other than non-biological and microbiological processes means.²⁶⁴ There have been several calls for a review of this article mostly by developing and least developed countries since the article has a proviso for revision every four years from the entry into force of the WTO Agreement.²⁶⁵ Numerous proposals have been sent by developing countries asking for the meaning of article 27.3 (b) to be clarified.²⁶⁶

The section aroused heated debate because it is presumed to sanction the patenting of life forms. Since the adoption of the TRIPS Agreement many countries have spoken out against this possibility.²⁶⁷ In 2011 Bolivia presented a paper expressing its concerns about the patenting of life forms, stating that ‘in the 15 years since the adoption of article 27.3 (b), we have witnessed a rush towards patenting of life forms and parts thereof, a trend which is most concerning due to the ethical and moral implications as well as the adverse impacts in areas

²⁶⁴ Verma, Dharam Prakash, *Review of Article 27.3(B) Under TRIPs Agreement: A Critical Analysis* (April 11, 2010). Available at SSRN: <http://ssrn.com/abstract=1587584> or <http://dx.doi.org/10.2139/ssrn.1587584>, Krystyna Swiderska, ‘*Banishing the Biopirates: A New Approach to Protecting Traditional Knowledge*’ GATEKEEPER 129 International Institute for Environment and Development (IIED) 3 Endsleigh Street, London WC1H 0DD (2006) 1-29. March 2009-1-29 available at from www.iied.org/pubs/pdf/full/14537IIED.pdf accessed 30 September 2012.

²⁶⁵ WT/GC/W/251 of 13 July 1999, WT/GC/W/362 of 12 October 1999, WT/GC/W/302 of 6 August 1999, WT/GC/W/23 of 5 July 1999, WT/GC/W/282 of 6 August 1999, WT/L/326 of 22 October 1999, WT/L/317 of 1 October 1999, WT/MIN (99)/3 of 2 November 1999. See also Carlos M Correa, ‘Intellectual Property Rights under WTO and Animal Genetic resources’ (2002) *Journal of Intellectual Property rights* Vol. 7 p. 21.

²⁶⁶ The African Group WT/GC/W/302, Cuba, Dominican Republic, Egypt, El Salvador, Honduras, India, Indonesia, Malaysia, Nigeria, Pakistan, Sri Lanka and Uganda WT/GC/W/355, Kenya WT/GC/W/233 available at http://www.wto.org/english/thewto_e/minist_e/min99_e/english/about_e/prop_e.doc.

²⁶⁷ India, Africa Group, LDC Group, Boliva, Colombia, Ecuador, Nicaragua, and Perú.

of great importance for developing countries and indigenous peoples, such as food and agriculture, climate change and health, among others'. It further stated that article 27.3 (b) created a leeway for countries to enact laws that permit life forms patentability, thereby expanding the scope of patentable inventions.²⁶⁸

The African Group of countries also proposed that article 27.3 (b) should be substantively amended to clarify that life forms and living processes cannot be patented. The Group requested 'clarification that plants, animals, microorganisms and all other living organisms and their parts cannot be patented and that natural processes that produce plants, animals and other living organisms should also not be patentable'. It requested further that 'article 27.3 (b) should be clarified with a footnote which states that *sui generis* laws for plant variety protection can provide for protection of innovations of indigenous and farming communities in developing countries, preserve traditional farming practices (including the right to exchange and save seeds), and prevent anti-competitive rights or practices which may threaten food sovereignty of developing countries'.

India, particularly, made it clear that all forms of life forms should be excluded from patentable subject-matter. If this is impossible, then patents based on traditional/indigenous knowledge and essentially derived products and processes from such knowledge must be excluded or, at least there must be insistence on disclosure of the country of origin of the biological resource and associated knowledge and consent of the country providing the resource and knowledge should be obtained to ensure equitable sharing of benefits.²⁶⁹

Developed countries do not see a need for the revising article 27.3 (b). For instance, the European Community and the member states in a working document of the Commission services, stated they 'see no reason to amend article 27.3(b) as it now stands'. Further, it stated that there are ample flexibilities in the TRIPS Agreement which permit members to

²⁶⁸ Bolivia submits detailed paper on TRIPS Article 27.3(b) Published in SUNS #7101 dated 4 March 2011 available at <http://www.twinside.org.sg/title2/wto.info/2011/twninfo110306.htm> accessed 01 October 2012.

²⁶⁹ Review of the Provisions of Article 27.3 (b) - Communication from India 3 November 1999, IP/C/W/161. See also India, IP/C/M/25 and IP/C/M/29.

regulate their patent protection as a function of their needs, interests or ethical standards mentioning particularly the exclusions in article 27.3 (b), article 27.2 and article 27.1.²⁷⁰

In the 20 years of the TRIPS Agreement there has not been a review of the article due to the divergent views regarding what should be in and what should be taken out. The United States of America champions the protection of life forms. They have vehemently spoken out against any changes to article 27.3 (b). They believe that exceptions to patentability under article 27.3(b) are unnecessary, as it treats plants and animals and non-biological and microbiological processes as patentable subject matter under its patent law.²⁷¹ Articulating that naturally occurring plants and animals are still not patentable subject matter under section 101 of the U.S. Patent Law, it reiterated the position of the court in *Diamond, Commissioner of Patents and Trademarks v Chakrabarty*,²⁷² that a new, man-made micro-organism that could break down oil was patentable subject matter under section 101²⁷³ because it comprised a manufacture or composition of matter. It further stated agriculture and medicine had benefited from these types of inventions.

The article has been a source of concern for many international organisations²⁷⁴ and non-governmental organisations as well.²⁷⁵ Even though Bolivia raised the issue of the review of article 27.3 (b) again at the Council for TRIPS meeting held on 24-25 October and 17 November 2011, the discussion focused on the UN Convention on Biological Diversity (CBD) issue and traditional knowledge²⁷⁶ and nothing concrete was said about the review. The Doha Declaration in Paragraph 19, which states that the TRIPS Council should look at

²⁷⁰ The Review of Article 27.3(B) of the TRIPS Agreement and the Relationship between the Trips Agreement and the Convention on Biological Diversity (CBD) and the Protection of Traditional Knowledge and Folklore 'A Concept Paper' Executive summary available at http://trade.ec.europa.eu/doclib/docs/2005/february/tradoc_111153.pdf accessed 01 October 2012.

²⁷¹ Review of the Provisions of Article 27.3(b) Communication from the United States See IP/C/W/162; IP/C/M/29 para. 185.

²⁷² 447 U.S. 303; 100 S. Ct. 2204 (1980).

²⁷³ 35 United States Code of Patent.

²⁷⁴ United Nations Food and Agriculture Organisation (FAO), World Health Organisation(WHO).

²⁷⁵ Third World Network Tebtebba Foundation, Oxfarm, Basmati Action Group and Canada Campaign for Food Safety, USA.

²⁷⁶ See IP/C/M/67.

the relationship between the TRIPS Agreement and the CBD, the protection of traditional knowledge and folklore, till now there, has not been a review of these issues.²⁷⁷

3.3.4.4 Article 28: Patent Rights Conferred

The provision of article 28 of the TRIPS Agreement establishes the basic right of the patent owner which excludes third parties who do not have the authority or consent of the owner from the use of such patents. These rights cover making, using, offering for sale, selling, or importing of the product obtained. The provision specifically points out in a footnote that importing, ‘like all other rights conferred under this Agreement in respect of the use, sale, importation or other distribution of goods is subject to the provisions of article 6’.²⁷⁸ In the article referred to, there is nothing that points to the issue of exhaustion as it is titled. The TRIPS Agreement makes it clear, except for the provisions dealing with non-discrimination, that is ‘national treatment’²⁷⁹ and ‘most-favoured-nation treatment’,²⁸⁰ that no other provision can be used to address the issue of exhaustion of intellectual property rights in a WTO dispute.²⁸¹ In essence the rights conferred must be subject to the exhaustion rights. Patent owners shall also have the right to assign, or transfer by succession the patent and to conclude licensing contracts as provide under article 28.2

3.3.4.5 Article 29: Conditions on Patent Applicants

This is a requirement that applicants are to follow when applying for a patent. The purpose of the obligation is to ensure proper disclosure of an invention in a way that is sufficiently clear and complete for the invention to be carried out by a person skilled in the art. A patent application must consist of the specifications of the invention. A specification consists of the claims and the descriptions. Accordingly, when putting in an application for a patent, full

²⁷⁷ Article 27.3b, traditional knowledge, biodiversity.
http://www.wto.org/english/tratop_e/trips_e/art27_3b_e.htm accessed 01 October 2012.

²⁷⁸ Article 6 which relates to exhaustion of rights provides that: For the purposes of dispute settlement under this Agreement, subject to the provisions of Articles 3 and 4 nothing in this Agreement shall be used to address the issue of the exhaustion of intellectual property rights.

²⁷⁹ Article 3 TRIPS Agreement.

²⁸⁰ Article 4 TRIPS Agreement.

²⁸¹ Obligations and exceptions available at
http://www.wto.org/english/tratop_e/trips_e/factsheet_pharm02_e.htm accessed 04 October 2012.

disclosure is required by the applicant to claim the benefits of a patent protection.²⁸² The provision is essential for two main reasons: it facilitates access to information about the patent specification and gives unrestricted access to the technical information on the expiration of the patent.²⁸³

Apart from the requirement of full disclosure of the specification, the applicant may also be required to indicate the best mode of working the invention.²⁸⁴ The best mode of working the invention is left to the discretion of the member state as it is not mandatory it appears in national laws.²⁸⁵ It is a new provision not required in the Paris Convention.²⁸⁶

According to Article 29.2, members may require an applicant for a patent to provide information concerning the applicant's corresponding foreign applications and grants. Apart from the fact that the earlier grant may hasten the application in a foreign country, countries in which only formal examination exists, will benefit from the earlier application in determining if the invention is new, involves an inventive step and is capable of industrial application.

3.3.4.6 Article 30: Exceptions to Patent Rights Conferred

Even though patent owners have exclusive rights over their patents, they are subject to limited exceptions on the exclusive rights conferred by a patent. These exceptions, however, must not unreasonably conflict with a normal exploitation or unreasonably prejudice the legitimate interests of the patent owner and the legitimate interests of third parties must be acknowledged. The article consist of three conditions:²⁸⁷ as explained by the Panel in *Canada -Patent Protection of Pharmaceuticals Products*²⁸⁸ three criteria must be met in order to qualify for an exception: (1) the exception must be 'limited' (2) the exception must not 'unreasonably conflict with normal exploitation of the patent' (3) the exception must not

²⁸² UNCTAD/ICTSD *Resource Book on TRIPS* p. 458.

²⁸³ Gervais, *The TRIPS Agreement* para 2.389, p.481. UNCTAD/ICTSD *Resource Book on TRIPS* p. 458

²⁸⁴ Article 29.1 TRIPS Agreement.

²⁸⁵ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p. 527; Gervais, *The TRIPS Agreement* para 2.389, p.482.

²⁸⁶ Gervais, *The TRIPS Agreement* para 2.389, p.481.

²⁸⁷ Also referred to as one of the 'three step test'.

²⁸⁸ WT/DS114/R.

‘unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties’. In addition, the panel stated that ‘the three conditions are cumulative, each being a separate and independent requirement that must be satisfied. Failure to comply with any one of the three conditions results in the article 30 exception being disallowed’.²⁸⁹ The condition therefore, must not be interpreted as different phrases but in relation to each other.²⁹⁰

3.3.4.7 Article 31: Compulsory Licences

This is another controversial provision of the TRIPS Agreement and has also been the subject of debate. Article 31 provides for what is popularly regarded as ‘compulsory licence’ even though the term is not expressly mentioned. Compulsory licensing is when a government grants a third party the permission, for other uses²⁹¹ without the authorisation of the patent owner, of an endorsement to produce a patented product or process.²⁹² As discussed below, a lot of changes have been made to the initial article 31 of the TRIPS Agreement by virtue of the Doha Declaration on the TRIPS Agreement and Public Health. These changes have enabled a lot of countries take advantage of the provision, including a number of Africa countries, such as Cameroon, Ghana, Guinea, Eritrea, Mozambique, South Africa, Swaziland, Zambia and Zimbabwe.²⁹³ The provision is mostly used by high and middle income countries.²⁹⁴ The article consists of a number of conditions which members have to follow to enable them to access the compulsory licence, these are:

- a. **Obtaining Authorisation:** Prior to use without authorisation the proposed user must have made efforts to obtain authorisation from the right holder on reasonable commercial terms and conditions and such efforts have not been successful within a

²⁸⁹ WT/DS114/R p. 152.

²⁹⁰ WT/DS114/R p. 152.

²⁹¹ ‘Other use’ here was explained in a footnote to refers to use other than that allowed under Article 30.

²⁹² Article 31 TRIPS Agreement; see also Compulsory licensing of pharmaceuticals and TRIPS available at http://www.wto.org/english/tratop_e/trips_e/public_health_faq_e.htm accessed 04/10/12.

²⁹³ KEI RN 2007:2 Recent examples of compulsory licensing of patents available at <http://keionline.org/content/view/41/1> accessed 08 October 2012.

²⁹⁴ High Income Countries: Canada, United States, Germany, Italy, Israel. Middle-Income Countries: Malaysia, Indonesia, Korea, South Africa, Brazil, Thailand available at <http://www.cptech.org/ip/health/cl/recent-examples.html#Canada> accessed 08 October 2012.

reasonable time.²⁹⁵ Except in a situation of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use by the government or contractor, the patent holder has to be duly informed, thus authorisation must have been sought first.²⁹⁶ The Doha Declaration expressly states that members have the right to establish what comprises a situation of national emergency or other circumstances of extreme urgency.²⁹⁷ The provision has removed the barriers hindering attempts by members to use the TRIPS flexibilities.²⁹⁸

- b. Scope and Duration:** The licence shall not go beyond the purpose for which it was authorised, thus the duration and scope stated in the licence should be followed in the strict sense.²⁹⁹ A compulsory licence may be revoked if the purpose for which it was granted is no longer justifiable.³⁰⁰ The only purpose for granting a compulsory license in respect of semi-conductor technology is when it relates to public non-commercial use for remedying a practice determined by a judicial or administrative process to be anti-competitive. Article 31(g) also indicates ways in which compulsory licence can be terminated. Where the circumstance for which the compulsory licence was authorised has ceased and is not likely to recur, the issuing authority may review the circumstance upon request. The provision must fulfill two conditions before a termination can take place that is (1) the circumstances which led to the issuance must have ceased to exist and (2) are unlikely to recur.
- c. Terms of Licensing:** Generally, the holder of a patent may decide on the terms of the licence with the person to whom it intends to give a license. However, in the case of compulsory licence, where the patent holder may be involved or not, it is required that the compulsory license shall be non-exclusive. Thus, the holder of the right can grant licences to other people. Similarly, where a compulsory license has been granted to a

²⁹⁵ Article 31 (a) TRIPS Agreement.

²⁹⁶ Article 31 (b) TRIPS Agreement.

²⁹⁷ Para 5 (c) Doha Declaration.

²⁹⁸ Correa, Carlos and Matthews, Duncan. *The Doha Declaration Ten Years on and Its Impact on Access to Medicines and the Right to Health*. Discussion Paper 20 December 2011 United Nations Development Programme Bureau for Development Policy p. 9 available at http://www.undp.org/content/dam/undp/library/hiv aids/Discussion_Paper_Doha_Declaration_Public_Health.pdf accessed 05 October 2012.

²⁹⁹ Article 31 (c) TRIPS Agreement.

³⁰⁰ Gervais, *The TRIPS Agreement* para 2.409, p.494.

contractor or government, such contractor or government shall only be eligible to assign such right where the business and goodwill is assigned alongside it, thereby making article 31(e) more flexible.³⁰¹

- d. Domestic Market:** Article 31 (f) has been considered problematic in enabling the use of compulsory licences because of the requirement that such use shall be authorised ‘predominantly for the supply of the domestic market’ of the member authorising such compulsory licence.³⁰² It means that drugs produced under a compulsory licence issued by Nigeria cannot be sold to Togo, even if they do not have the industrial capacity to make the drugs. The requirement has led to a probe of what ‘predominantly’ means: it has been claimed not to be exclusive, allowing possible export.³⁰³ On the other hand, it may refer to a major share which would be more than fifty percent of the supply of products from the compulsory licence.³⁰⁴ Accordingly, if the compulsory license is intended for the use of the country, then whatever is left over or sold to other countries should not be a cause for concern in so far as it does not constitute the major part.³⁰⁵ The debate has been eroded³⁰⁶ by the Decision on Implementation of Paragraph 6 of the Doha Declaration³⁰⁷ which recognises that there are WTO members with insufficient or no manufacturing capacities in the pharmaceutical sector thereby making it difficult for them to effectively use the compulsory licensing under the TRIPS Agreement. The Ministerial Conference, realising how problematic this provision is, instructed the ‘Council for TRIPS to find an expeditious solution to this problem and to report to the General Council before the end of 2002’. The decision of the General Council makes it

³⁰¹ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 473.

³⁰² Article 31 (f) TRIPS Agreement.

³⁰³ Karin Timmermans and Togi Hutadjulu, *The TRIPS Agreement and Pharmaceuticals* Report of an Asean Workshop on the TRIPS Agreement and its Impact on Pharmaceuticals Jakarta, 2-4 May 2000 Indonesia p.33.

³⁰⁴ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 474. Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* Max Planck Commentaries on World Trade Law p.574 (cited Frederick M. Abbott ‘Compulsory Licensing for Public Health Needs the TRIPS Agenda at the WTO after the Doha Declaration on Public Health.’ Occasional Paper 9 Quaker United Nations Office – Geneva p.26 available at <http://www.quno.org/geneva/pdf/economic/Occasional/Compulsory-Licensing.pdf> accessed 05/10/2012.

³⁰⁵ Gervais, *The TRIPS Agreement* para. 2.409 p.495.

³⁰⁶ It should be noted that although the provision is affected by the Decision on Implementation of Paragraph 6 of the Doha Declaration the TRIPS Agreement has not been amended to include this amendments but it has been agreed by all member states. This Decision was adopted by the General Council.

³⁰⁷ Decision on Implementation of Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health WT/L/540, 2 September 2003.

possible for products made under compulsory licences to be exported to another country where the WTO member has insufficient or no manufacturing capacity. This was the case when Rwanda needed to import a triple combination AIDS therapy drug called TriAvir and had no manufacturing capacity: Canada manufactured the drugs and exported them to Rwanda following the conditions laid down by the General Council for the implementation of paragraph 6 of the Doha Declaration.

- e. Adequate Remuneration:** This provision provides a semblance of justice when the hands of the patent holder are tied. Even though, it is a compulsory licence, adequate remuneration has to be paid to the owner of the patent in question. The remuneration for a compulsory licence shall depend on the circumstances of each case: there is no fixed remuneration regarding compulsory licences, each licence is determined on a case by case basis.³⁰⁸ However, whatever given must be adequate. According to the UNCTAD/ICTSD, ‘the term adequate generally is used to indicate something that is sufficient or meets the minimum standard but not more than that’.³⁰⁹ Thus, the patent holder must be sufficiently rewarded for his efforts taking into account the economic worth of the compulsory licence. In essence, an industrial policy objective and public need would bring different economic revenue for the patent holder.³¹⁰
- f. Judicial or Independent Review:** It is only expedient that there should be a body or institution set up to look into the processes of issuing, reviewing, remuneration and termination of a compulsory licence.³¹¹ Compulsory licences are not granted with the consent of the holder of the patent, therefore, it can lead to legal tussles regarding whether the compulsory licence needs to be issued and after it has been issued when the circumstances have ceased. All these issues shall be subject to a judicial review or an independent review by a distinct authority in the country of the member.³¹² The use of judicial review is clear as all countries have a judicial system. Review by an

³⁰⁸ Article 31 (h) TRIPS Agreement.

³⁰⁹ Remedial measures regarding the vitamin price-fixing conspiracy, referenced in Competition in the Pharmaceutical Marketplace: Antitrust Implications of Patent Settlements, Prepared Testimony of James M. Griffin Deputy Assistant Attorney General Antitrust Division, Before the Senate Judiciary Committee, FED. NEWS SERV., May 24, 2001.

³¹⁰ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 477.

³¹¹ See generally Article 31(i) and (j).

³¹² Article 31 (c) TRIPS Agreement.

independent higher authority is ambiguous in that what constitutes a higher authority that is independent is not specified, thus leaving it for the members to determine.³¹³

What however, is clear is that the independent higher authority must be separate from the authority granting the compulsory licence.³¹⁴

- g. Anti-competitive Abuses:** The TRIPS Agreement permits an issuance of a compulsory licence to combat anti-competitive practice,³¹⁵ such as excessive pricing, refusals to licence or the denial of an essential facility.³¹⁶ The anti-competitive practice must be determined by a judicial or administrative process. This condition signals to the right owner that any abuse of rights or scarcity of product would allow a third party access to the invention, thereby acting as a deterrent for malpractice and monopoly rights.³¹⁷ The grounds stated in article 31(b) need not be present and it may not be predominantly for the use of the domestic market, thereby providing flexible terms for the compulsory licence to be issued.³¹⁸ A WTO country may issue more than one licence where anticompetitive conduct exists to accomplish its intent.³¹⁹ Remuneration regarding licences granted to tackle anti-competitive practice shall be what is necessary to correct this practice. This is so because in a monopoly situation the price is not determined by demand and supply. It is implied that WTO members may interpret this article as meaning ‘reduced remuneration or even a ‘royalty- free’ ‘licence’.³²⁰ As well as, there could be a refusal of termination if the condition which led to the authorisation is likely to recur.
- h. Dependent Patent Licence:** This refers to a situation where a compulsory licence is granted to enable the use of a patent which otherwise will infringe an earlier patent.

³¹³ Cf. UNCTAD/ICTSD, *Resource Book on TRIPS* p. 478.

³¹⁴ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 478.

³¹⁵ Article 31 (k) TRIPS Agreement.

³¹⁶ Brook K. Baker ‘Processes and Issues for Improving Access to Utilise TRIPS Flexibilities in Non-Producing Countries,’ DFID Health Systems Resource Centre, London, (2004) p. 27.

³¹⁷ Karin Timmermans and Togi Hutadjulu ‘The TRIPS Agreement and Pharmaceuticals Report of an Asean Workshop on the TRIPS Agreement and its Impact on Pharmaceuticals’ Jakarta, 2-4 May 2000 Indonesia p.33.

³¹⁸ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 479.

³¹⁹ Frederick M. Abbott, Compulsory Licensing for Public Health Needs: The TRIPS Agenda at the WTO after the Doha Declaration on Public Health. *Occasional Paper 9 Quaker United Nations Office* – Geneva p.32 available at accessed 05 October 2012.

³²⁰ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p.577.

There are three conditions that have to be met for such a use to be authorised. These are (1) the invention in the second patent must involve an important technical advance (2) a cross licence would be granted on reasonable terms to the owner of the first patent (3) use authorised in respect of the first is not assignable, the first and second patents are only assignable together.

3.3.4.8 Conclusion

In summary, patentable subject matter still remains controversial. The phrase ‘in all fields of technology’ has not gone down well with developing countries and least developed countries. It presupposes that anything is patentable provided it is new, involves an inventive step and is capable of industrial application. Accordingly, members have the flexibility to decide: what is contrary to public order or morality in one country may not be seen as such in another country.

The introduction of product patent internationally has been criticised even though some developing countries already had product patents prior to the TRIPS Agreement. The meaning and the extent of the protection of a product patent came to light with the adoption of the TRIPS Agreement.

3.4 Doha Declaration on the TRIPS Agreement

3.4.1 Basic Principles of the Doha Declaration

The only form of reconsideration made so far to the TRIPS Agreement has been the Doha Declaration even though there is a provision for regular review.³²¹ The 4th WTO Ministerial meeting at Doha, Qatar adopted, on the 14 November 2001, a Declaration on the TRIPS Agreement and Public Health.³²² Developing countries and non-governmental organisations that the TRIPS Agreement and in particular the patent provisions represent a barrier to effective access to medicines.³²³ The Declaration was conceived mainly as a result of

³²¹ See Article 71 TRIPS Agreement.

³²² Hereinafter referred to as ‘the Declaration.’

³²³ Frederick M. Abbott, ‘The TRIPS Agreement, Access to Medicines and the WTO Doha Ministerial Conference’ (October 2001). *FSU College of Law, Public Law Working Paper No. 36 and QUNO Occasional Paper No. 7* available at SSRN: <http://ssrn.com/abstract=285934> or

apprehensions about the likely impact of the TRIPS Agreement on access to medicines.³²⁴ The Declaration stresses that the TRIPS Agreement does not and should not preclude the use of the flexibilities by WTO members to protect public health. The Declaration took special notice of the gravity of the problems afflicting developing and least developed countries with regard to diseases like HIV/AIDS, tuberculosis, malaria and other epidemics.³²⁵ The Declaration clarifies that the TRIPS Agreement should be interpreted in the light of Articles 7 and 8,³²⁶ and that members have the right to grant compulsory licences and to determine the grounds upon which such licences are granted.³²⁷

Members have a right to determine what constitutes a national emergency or other circumstances of extreme urgency³²⁸ and each member is free to establish its own regime for such exhaustion without challenge, however, it is guided by the rules of most favoured nation (MFN) and national treatment (NT).³²⁹ WTO members, who may face difficulty in using the compulsory licensing under the TRIPS Agreement as a result of insufficient or no manufacturing capacities in the pharmaceutical sector, were also recognised and the TRIPS Council was instructed to find a quick solution to this problem and report to the General Council before the end of 2002. Despite the request for a quick solution, the decision that would allow the importation of cheaper generic drugs did not come till 30 August 2003.³³⁰ The decision requires that members, who intend to use the ‘Paragraph 6’ system, whether as an importer³³¹ or an exporter,³³² must notify the WTO. The 6 December 2005 amendments³³³

<http://dx.doi.org/10.2139/ssrn.285934> accessed 07 October 2012; see also Zita Lazzarini, ‘Making Access to Pharmaceuticals a Reality: Legal Options under TRIPS and the Case of Brazil’ 6 *Yale Human Rights & Development Law Journal* 2003 pp 103-138.

³²⁴ The Doha Declaration explained available at http://www.wto.org/english/tratop_e/dda_e/dohaexplained_e.htm#trips accessed 07 October 2012.

³²⁵ WT/MIN (01)/DEC/2 (*emphasis added*).

³²⁶ Paragraph 5 (a) Doha Declaration.

³²⁷ Paragraph 5 (b) Doha Declaration.

³²⁸ Paragraph 5 (c) Doha Declaration.

³²⁹ Paragraph 5 (d) Doha Declaration.

³³⁰ WT/L/540 and Corr.1.

³³¹ As an importer the notification is in two ways, first they have to announce once that they intend to make use of the system, and then they have to supply information each time they use it. Rwanda was the first country to use the paragraph 6 system in 2007. See IP/N/9/RWA/1.

³³² Exporting countries also have to notify the WTO when they export pharmaceutical products manufactured under compulsory licences under the ‘paragraph 6’ system providing information on the conditions attached to the compulsory licence. Example of a notification given by an exporter is by Canada in the Apotex-Rwanda case, see IP/N/10/CAN/1.

approved changes to the TRIPS Agreement and adopted the 30 August 2003 decision. The amendment made the decisions on patents and public health permanent, but not yet formal.

The decision will not be formally merged with the TRIPS Agreement until two thirds of the WTO's members have accepted the change. Members initially were, given till 1 December 2007 to do so. Because when two thirds had not accepted it by then, the deadline was extended by the General Council to 31 December 2009, to 31 December 2011, again to 31 December 2013, and now to 31 December 2015.³³⁴

Once two thirds of members have formally accepted it, the amendment will take effect in applicable member states and will replace the 2003 waiver. For each of the remaining members: the waiver will continue to apply until that member accepts the amendment and it takes effect. Up till now only nine African countries have accepted the decision.³³⁵ In paragraph 7, developed countries made a commitment to help with technology transfer³³⁶ and extended the date of implementation of the TRIPS Agreement for least developed countries (LDCs) to 1 January 2016.³³⁷

3.4.2 The Politics on the way to Doha Declaration on TRIPS.

The Doha Declaration is a simple and concise policy statement by the members of the WTO,³³⁸ brought about by the exigencies of the effect of the patent section of the TRIPS Agreement on public health and access to medicines. The Declaration was not an easy compromise. It took several years for members to reach an agreement on most of the issues contained in the Declaration, mainly due to a US-led effort to protect the interests of

³³³ WT/L/641 WTO document General Council.

³³⁴ Members accepting amendment of the TRIPS Agreement available at http://www.wto.org/english/tratop_e/trips_e/amendment_e.htm accessed 03 June 2014.

³³⁵ Members accepting amendment of the TRIPS Agreement available at http://www.wto.org/english/tratop_e/trips_e/amendment_e.htm accessed 05 May 2013 Mauritius (16 April 2008), Egypt (18 April 2008), Zambia (10 August 2009), Uganda (12 July 2010), Senegal (18 January 2011), Rwanda (12 December 2011) and Togo (13 March 2012).

³³⁶ This was in accordance with Article 66.2 TRIPS. Paragraph 6 Doha Declaration.

³³⁷ Paragraph 7 Doha Declaration.

³³⁸ E Alsegård, 'Global pharmaceutical patents after the Doha Declaration – What lies in the future?' (2004) 1:1 *SCRIPTed* 12, <http://www.law.ed.ac.uk/ahrc/script-ed/docs/doha.asp>. accessed 05 May 2013.

pharmaceutical companies in developed countries³³⁹ against the concerns of developing members.

There was a need to act because of the HIV/AIDS epidemic. The 2001 statistics were staggering: in South Africa one in nine persons were infected with HIV or had already developed full blown AIDS. Sub-Saharan Africa had, and still has, the highest number of people living with HIV in the world: an average of 20.5 million adults and children were living with HIV; newly infected adults and children averaged of 2.2 million annually, an average prevalence rate of 5.9% and a yearly average of adult and child deaths of 1.4 million.³⁴⁰ Africa is by far the biggest sufferer under this dreaded disease. Prior to the 2001 Declaration, the former President of South Africa, Nelson Mandela in order to circumvent the international patent rule and to allow generic drugs to become accessible to people who needed lifesaving drugs, amended section 15 of the Medicines and Related Substances Act of South Africa in 1997.³⁴¹ The United States and European Union exerted pressure to repeal the Act. Thirty-nine pharmaceutical companies, who felt their rights were being infringed,

³³⁹ Frederick M. Abbott. 'A Doha Declaration on The TRIPS Agreement on Public health: Lightening a Dark Corner in the WTO' (2002) 5 *Journal of International Economic Law* 469–505 (2) p.470 available at: <http://ssrn.com/abstract=1493725> (citing Daniel Kennedy and James Southwick (eds), *The Political Economy of International Trade Law: Essays in Honor of Robert Hudec* [Political Economy], (Cambridge University Press 2002).

³⁴⁰ UNAIDS World AIDS Day Report | 2011 available at http://www.unaids.org/en/media/unaids/contentassets/documents/unaidspublication/2011/JC2216_WorldAIDSday_report_2011_en.pdf accessed 11 October 2012.

³⁴¹ Section 15C - Measures to ensure supply of more affordable medicines
 The Minister may prescribe conditions for the supply of more affordable medicines in certain circumstances so as to protect the health of the public, and in particular may-

(a) notwithstanding anything to the contrary contained in the Patents Act, 1978 (Act 57 of 1978), determine that the rights with regard to any medicine under a patent granted in the Republic shall not extend to acts in respect of such medicine which has been put onto the market by the owner of the medicine, or with his or her consent;

(b) prescribe the conditions on which any medicine which is identical in composition, meets the same quality standard and is intended to have the same proprietary name as that of another medicine already registered in the Republic, but which is imported by a person other than the person who is the holder of the registration certificate of the medicine already registered and which originates from any site of manufacture of the original manufacturer as approved by the council in the prescribed manner, may be imported;

(c) prescribe the registration procedure for, as well as the use of, the medicine referred to in paragraph (b).

went to court in March 2000.³⁴² After a three-year battle, the case was unconditionally settled out of court in April 2003.

In 2001 developing countries in critical need of HIV/AIDS drugs, agitated in the WTO to resolve an imminent crisis.³⁴³ A special session was held in June 2001 with the aim of defining the relationship between intellectual property rights and access to medicines and providing a clarification of the relevant provision on flexibilities which members were permitted and an interpretation of the relevant provision of the TRIPS Agreement.³⁴⁴ The African Group identified vital elements to be included in the Doha Declaration, which included the importance of the objectives and principles of the TRIPS Agreement set out in articles 7 and 8: compulsory licence, parallel imports and a moratorium on all disputes limiting the capacity to promote access to medicines.³⁴⁵

Over 40 presentations were made by the least-developed countries, the African Group, the European Union, and ASEAN.³⁴⁶ The African Group maintained that an amendment to the TRIPS Agreement is essential for the protection of public health, especially in relation to life-threatening diseases. The United States in their June 2001 presentation, emphasised, patent protection stating:

[It] is universally agreed that we must provide incentives for investment in research and development of new and more effective life-saving drugs. Effective patent systems, therefore are crucial if we are to find better treatments and ultimately cure[s] for

³⁴² Pharmaceutical Manufacturers Association of South Africa and Another: In re Ex Parte President of the Republic of South Africa and Others, CCT31/99 [2000] ZACC 1; 2000 (2) SA 674; 2000 (3) BCLR 241 (25 February 2000).

³⁴³ James Thuo Gathii, 'The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties' 2002 *Harvard Journal of Law & Technology* Volume 15, Number 2 Spring p. 292.

³⁴⁴ Gervais, *The TRIPS Agreement*, para.1.57 p.54. See also James. Thuo Gathii, *The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties Harvard Journal of Law & Technology* Volume 15, Number 2 Spring 2002 p. 296 (citing TRIPS and Public Health, submission of the Africa Group and other developing countries to the Special TRIPS Council Meeting of June 2001, para 5, at <http://www.twinside.org.sg/title/twr131e.htm>.); see also TRIPS and Public Health, WTO Doc No IP/C/W/296, June 29, 2001, working paper submitted by the African group, joined by seventeen developing countries).

³⁴⁵ Special Discussion on Intellectual Property and Access to Medicines, WTO Doc No IP/C/M/31 10 July 2001, working paper submitted by the African group, joined by seventeen developing countries).

³⁴⁶ WTO members to press on, following 'rich debate' on medicines 2001 Press/233 Geneva, 22 June 2001 available at http://www.wto.org/english/news_e/pres01_e/pr233_e.htm.

HIV/AIDS and the many other diseases and health conditions that afflict the world's population.³⁴⁷

Japan a close ally of the United States during the TRIPS Agreement negotiation, strategically backed down when it was obvious they could not win concluding that it ‘would like to stress once again that Japan is ready to join the international efforts regarding drug access and intellectual property which we have started today in a positive and constructive manner.’³⁴⁸

At an informal meeting held in July 2001³⁴⁹ the African Group took the opportunity to identify substantive issues and questions raised by some delegations during the formal session in June, with the aim of attaining cooperation. They proposed procedural suggestions in preparations for the Doha Conference regarding the issue of the TRIPS Agreement and Public Health, and offered recommendations for some rudiments included in the Ministerial Declaration. The Group noted that the checklist prepared for presentation at the next formal TRIPS Council meeting in September and the WTO Ministerial Conference in Doha, Qatar in November, did not reflect the degree of agreement expressed by the WTO Members at the June special session and strongly urged that the WTO Secretariat should maintain its neutrality and reiterated that the WTO Secretariat should remain objective in matters such as the interpretations of the provisions of the TRIPS Agreement.³⁵⁰

A number on international organisations, such as WHO (World Health Organisation)³⁵¹ United Nations Program on HIV/AIDS (UNAIDS), the World Bank, the Group of 77 and regional organisations such as the Organisation of African Unity, now African Union (AU), joined in the campaign for access to medicines. Non-governmental organisations such as *Medecins Sans Frontieres* (MSF), OXFAM campaign, ‘Cut the Cost,’ the South African

³⁴⁷ Special Discussion on Intellectual Property and Access to Medicines, WTO Doc No IP/C/M/31 10 July 2001, working excerpts of United States Presentation on trips and access to medicines.

³⁴⁸ WTO Doc No IP/C/M/31 10 July 2001, working excerpts of Japans Presentation on TRIPS and access to medicines.

³⁴⁹ WTO Doc No IP/C/M/31 10.

³⁵⁰ Statement by the Africa Group: TRIPS and Public Health Informal Session of the WTO TRIPS Council 25 July 2001 Intellectual Property Rights & Sustainable Development Series N°1 TRIPS, Biological Resources p.56-60 and Public Health: Documents and Discussion Papers Presented at the ICTSD - Africa Group Roundtable on 12 June 2001. See also, Third World Network Info Service on WTO Issues. Update on Ministerial Declaration on TRIPS and Public Health. Available at www.twinside.org.sg/title/info3.htm accessed 10 October 2012.

³⁵¹ World Health Organization: Revised Drug Strategy Resolution. World Health Assembly Resolution WHA 49.14, 1996.

Treatment Action Campaign (TAC), Act Up Paris and the Health Gap Coalition in the United States pushed for a viable system of access to medicines.

When the Doha Ministerial Conference started in September 2001 it was obvious that there was a public health crisis which needed to be resolved expeditiously. The conference acknowledged the problems confronting the developing and least developed countries in relation to HIV/AIDS, tuberculosis and malaria.³⁵² Though the gravity of the situation was recognised, the content of the Declaration was not uncomplicated. According to observers the Declaration was agreed swiftly owing to three major factors: Banta³⁵³ notes:

- i. Developing countries were organised, prepared well and negotiated as a bloc.
- ii. The anthrax scare in the US³⁵⁴ and Canada³⁵⁵ informed the views of developed countries on compulsory licences.
- iii. Protests and demonstrations by AID activists showed many objections to globalisation.

Whatever factors mitigated the easy passage of the Declaration: the message is ‘the TRIPS Agreement does not and should not prevent members from taking measures to protect public health’.³⁵⁶ This phrase is regarded as the main message of the Doha Declaration.³⁵⁷ The importance of implementation and interpretation of the TRIPS Agreement was reiterated by the Ministerial Conference to be ‘supportive of public health by promoting both access to existing medicines and research and development into new medicines and, in this connection, are adopting a separate declaration’.³⁵⁸

³⁵² Yamane p. 305. Gervais, *The TRIPS Agreement* para. 1.60 p.56.

³⁵³ D. Banta, Public Health Triumphs at WTO Conference 2001 286 *Journal of the American Medical Association*, 2655, 2655-65, available at <http://jama.jamanetwork.com/article.aspx?articleid=194431> accessed 11 October 2012.

³⁵⁴ The United States resisted issuing a compulsory license but made it known that if they need to use one they would not hesitate doing so.

³⁵⁵ Canadian officials declared a compulsory licence to build a stockpile of Cipro generic drug adequate to treat 100,000 people. So, the government has ordered a million tablets of a generic version of Cipro from Apotex Inc., a company based in Toronto and placed orders with Bayer as well.

³⁵⁶ Para 4 Doha Declaration on TRIPS Agreement.

³⁵⁷ Yamane p. 306.

³⁵⁸ Para 17 Doha Declaration on TRIPS Agreement.

The legitimacy of the Declaration has not been questioned: there appears to be a middle ground between the positions embraced by developing and developed countries.³⁵⁹ The Doha Declaration has been examined based on what are the intent and commitment of the members under international law.³⁶⁰ Even though the amendment to the TRIPS Agreement came in the form of a Declaration,³⁶¹ it has legal effects on the member states and WTO bodies, in particular, the Dispute Settlement Body and the Council for TRIPS. Under article 31.3 (a) of the Vienna Convention on the Law of the Treaties, a Declaration can be regarded as a ‘subsequent agreement’ between parties when it comes to interpreting a treaty or applying its provisions.³⁶² Therefore, the Doha Declaration on the TRIPS Agreement is generally regarded as a binding commitment by WTO members, as can be deduced from the fact that provisions of the Declaration have been used by members.³⁶³

3.4.3 Article 31bis

The outcome of the Doha Declaration, namely the formulation of Article 31bis, although not yet part of the TRIPS Agreement will eventually form part of TRIPS Agreement when two thirds of the WTO members ratify the Declaration. Accordingly it is worthy of note. This article is expected to ameliorate the difficulties posed by article 31. Article 31bis consists of five paragraphs. Article 31bis lays down the procedures to be followed in the granting of compulsory licenses. This provision particularly relates to the production of a ‘pharmaceutical product’³⁶⁴ and the member’s capability as at the time when an importing or exporting member is granted a compulsory license under this system.

³⁵⁹ E. Alsegård, ‘Global pharmaceutical patents after the Doha Declaration – What lies in the future?’, (2004) 1:1 *SCRIPTed* 12, <http://www.law.ed.ac.uk/ahrc/script-ed/docs/doha.asp>.

³⁶⁰ James Thuo Gathii, ‘The Legal Status of the Doha Declaration on TRIPS and Public Health Under The Vienna Convention on the Law of Treaties’ *Harvard Journal of Law & Technology* Volume 15, Number 2 Spring 2002 292-317, p 314; see also F M Abbott, ‘The Doha Declaration on The TRIPS Agreement and Public Health: Lighting a Dark Corner at The WTO’ (2002) 5 *Journal of International Economic Law* 469.

³⁶¹ Declarations are not legally binding sets of principles but they are states that governments agree to work towards, they make up a large part of international customary law.

³⁶² Correa, Carlos. *Implications of the Doha Declaration on the Trips Agreement and Public Health - Health Economics and Drugs Series* No. 012 June 2002 available at <http://apps.who.int/medicinedocs/pdf/s2301e/s2301e.pdf> accessed 11/10/2012.

³⁶³ IP/N/9/RWA/1 Apotex-Rwanda Case.

³⁶⁴ ‘pharmaceutical product’ means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address the public health problems as recognized in paragraph 1 of the

3.4.3.1 Article 31bis 1: An Exporting Member and Eligible Importing Member

Primarily, this paragraph removes the obstacle of the compulsory licence being used or authorised predominantly for the supply of the domestic market of the authorizing member's use,³⁶⁵ by allowing the member to authorise a compulsory licence to the extent necessary for the purposes of production of a pharmaceutical product(s). In essence, exports to an eligible importing member(s) in accordance with the terms set out in paragraph 2 of the Annex to this Agreement is in compliance with the provisions of the TRIPS Agreement. Paragraph 1 c of the Annex states that 'exporting Member' means a member using the system to produce pharmaceutical products for, and export them to, an eligible importing Member. An exporting member can be any member of the WTO.³⁶⁶ On the other hand an 'eligible importing Member' can only be a least-developed country (LDC) Member or in the case of a national emergency or other circumstances of extreme urgency cases other members may notify the Council of TRIPS of their intention to use the system.

3.4.3.2 Article 31bis 2: Adequate Remuneration

This provision reiterates that adequate remuneration will be paid. Adequate remuneration pursuant to Article 31(h) must be paid in the exporting Member, taking into account the economic value to the importing Member of the use that has been authorized in the exporting Member. But where a compulsory licence is granted for the same products in the eligible importing Member, remuneration will not be paid according to the economic value of the authorisation in the exporting Member.³⁶⁷

3.4.3.3 Article 31bis 3: Predominantly Domestic Use

This provision eliminates the prerequisite that the compulsory licence must be predominantly for domestic use where a developing or least developed Member is a party to a regional trade

Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2). It is understood that active ingredients necessary for its manufacture and diagnostic kits needed for its use would be included

³⁶⁵ Article 31 (f) TRIPS Agreement.

³⁶⁶ Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.585

³⁶⁷ See generally Stoll, Busche and Arend *WTO Trade Related Aspect of Intellectual property Rights* p.587-88. Scherer F. M and Jaysashree Watal 'Post-TRIPS Options for Access to Patented Medicines in Developing Nations' (2002) *Journal of International Economic Law* 5 (4):913-939.

agreement (RTA) within the meaning of Article XXIV of the GATT 1994. This is to enable these countries take advantage of the surplus product for the purposes of enhancing purchasing power for, and facilitating the local production of pharmaceutical products.

3.4.3.4 Article 31bis 4: Challenge

Where the application and issuance of the compulsory licence conforms to the provisions of this Article and the Annex to this Agreement under subparagraphs 1(b) and 1(c) of Article XXIII of GATT 1994 members are barred from challenging the granting of a compulsory licence.

3.4.3.5 Article 31bis: Rights and Obligations

With the exclusion of article 31 (f) and (h) and those reaffirmed by the Declaration on the TRIPS Agreement and Public Health rights, obligations and flexibilities that members have under the provisions of TRIPS remain unaffected.

3.5 Other Substantive Provisions of the TRIPS Agreement.

This section looks at other provisions of the TRIPS Agreement that are important to the working of intellectual property rights. The enforcement of intellectual property rights, as provided under Part III, summarises the guidelines members must establish to permit enforcement of trade-related intellectual property rights efficiently and exhaustively. These guidelines include general obligations,³⁶⁸ civil and administrative procedures and remedies,³⁶⁹ provisional measures,³⁷⁰ special requirements related to border measures,³⁷¹ and criminal procedures and penalties³⁷² in relation to the enforcement of intellectual property rights.

³⁶⁸ Section 1 Article 41 TRIPS Agreement.

³⁶⁹ Section 2 Article 42-49 TRIPS Agreement.

³⁷⁰ Section 3 Article 50- TRIPS Agreement.

³⁷¹ Section 4 Article 51-60 TRIPS Agreement.

³⁷² Section 5 Article 61 TRIPS Agreement.

3.5.1 Enforcement of Intellectual Property Rights³⁷³

Negotiators in the Uruguay Round achieved a compromise regarding the ‘importance of providing effective enforcement tools to combat international intellectual property theft.’³⁷⁴

Combating counterfeiting and piracy is a major reason for the inclusion of intellectual property rights in the Trade Agreements.

Enforcement of intellectual property rights is a key feature of the TRIPS Agreement. Rules and the practice of enforcement such as litigation procedures and remedies were formerly developed nationally, without reference to international policy.³⁷⁵

3.5.1.1 Article 41: General Obligations

The TRIPS Agreement provides not only a minimum standard of protection, but also a minimum standard for the enforcement of intellectual property rights to be implemented according to the approach chosen by each member in line with the general principle describe in article 41.1.³⁷⁶ The TRIPS Agreement stipulates that members are responsible for providing effective and adequate minimum standards for the enforcement of intellectual property rights in their various countries.³⁷⁷ Members are expected to ensure that enforcement procedures ‘are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by the TRIPS Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements’.³⁷⁸ Article 41.5 stresses that this Part of the TRIPS Agreement does not create any obligation for members to establish a different judicial system for the enforcement of intellectual property rights and the capacity of members to enforce their law in general is not affected in anyway. The provision is of particular

³⁷³ This section summarily explains what the enforcement provisions of the TRIPS Agreement requires, a more detail impact analysis will be done in chapter seven below.

³⁷⁴ China –Measures affecting the Protection and Enforcement of Intellectual Property Rights First Submission of the United States of America January 30, 2008 p.1(WT/DS362).

³⁷⁵ Lionel Bently and Brad Sherman *Intellectual Property Law* 3rd Ed Oxford University Press, 2008 citing of *Colflexip v Stolt Comex Seaway* [199] FSR 473, 487-9.

³⁷⁶ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 575.

³⁷⁷ Part III of TRIPS Agreement, See generally Articles 41-61.

³⁷⁸ Article 41 TRIPS Agreement.

significance to least developed countries:³⁷⁹ many developing countries are concerned about having to establish specialised intellectual property courts.³⁸⁰ The provision acted as a sort of succour to developing countries: although the enforcement procedures have been criticised as being too broad and are based on US standards, and for their likely impact on developing countries.³⁸¹

Article 41 of the TRIPS Agreement encompasses the yardstick for measuring the enforcement procedures, these are:

- i. Specification of procedures to be made available in domestic laws: expeditious remedies to prevent infringement and remedies which constitute a deterrent to further infringement.³⁸²
- ii. Fair and equitable procedures to all parties concerned in the enforcement of intellectual property rights and not the right holder only.³⁸³
- iii. Judicial and administrative decision shall be based only on evidence and it shall be given in writing with reasons without undue delay.³⁸⁴
- iv. Final administrative decisions should be taken by an appellate authority within the Members.³⁸⁵

3.5.1.2 Article 42: Fair and Equitable Procedures

Section 2³⁸⁶ introduces an international minimum standard which members are bound to implement in their domestic legislation. Article 42 gives illumination to the general obligation in article 41, especially article 41.2, regarding civil and administrative procedures made available to the ‘right holders’. Article 42 deals with enforcement action in judicial proceedings and contains detailed requirements which ensure that ‘civil judicial procedures’ are ‘fair and equitable’. As well, they effectively safeguard the system of legal enforcement in favour of the right holder and describe the right of owners regarding the enforcement of their legal position. They also decide the rights of defendants, who are required to put

³⁷⁹ Peter K. Yu, TRIPS Enforcement and Developing Countries *American University International Law Review* [26:3 2011] p. 778.

³⁸⁰ Gervais, *The TRIPS Agreement*, para. 2.509, p.564.

³⁸¹ Gervais, *The TRIPS Agreement*, Para 2.5107 p.565.

³⁸² Article 41.1 TRIPS Agreement.

³⁸³ Article 41.2 TRIPS Agreement.

³⁸⁴ Article 41.3 TRIPS Agreement.

³⁸⁵ Article 41.4 TRIPS Agreement.

³⁸⁶ Section 2: Civil and Administrative Procedures and Remedies of Part Iii Enforcement f Intellectual Property Rights.

forward their defence, by giving the alleged infringer sufficient opportunity to rebut accusations and effectively to defend themselves.³⁸⁷

The fundamental obligation expected of members is to make available civil procedures for right holders.³⁸⁸ The precise meaning of ‘make available’ and ‘right holder’ was the subject of judicial interpretation in *United States – Section 211 Omnibus Appropriations Act case*.³⁸⁹

The Appellate Body, in agreement with the Panel’s interpretation of article 42, asserted that ‘making something available means making it “obtainable”, putting it “within one’s reach” and “at one’s disposal” in a way that has sufficient force or efficacy. Agreeing with the Panel that the ordinary meaning of the term “make available” suggests that “right holders” are entitled under article 42 to have access to civil judicial procedures that are effective in bringing about the enforcement of their rights covered by the TRIPS Agreement.’³⁹⁰

Apart from making the civil procedures available, there are other requirements that have to be met to make the process fair and equitable. These include:

- i. Defendant’s right to written notice which is timely and contains sufficient detail, including the basis of the claims.
- ii. Parties shall be allowed to be represented by independent legal counsel.
- iii. Procedures shall not impose ‘overly burdensome’ requirements concerning mandatory personal appearances. The wording used in this provision indicates that there is nothing wrong with mandatory personal appearances, even if they are cumbersome.
- iv. All parties shall be duly entitled to substantiate their claims and to present all relevant evidence. This provision applies to all types of civil and administrative procedures, including for the adoption of provisional measures. (e) Identification and protection of confidential information. Notably the requirement to identify and protect confidential information will not apply if it is ‘contrary to existing constitutional requirements’.

3.5.1.3 Article 43: Evidence

This article buttresses the fourth sentence in article 42. The justification of this provision is to ensure access to evidence under the control of the opposing party in certain circumstances.

Members of the WTO are mandated to empower the judicial authorities to order the

³⁸⁷ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p.702.

³⁸⁸ Article 42.1 TRIPS Agreement.

³⁸⁹ United States – Section 211 Omnibus Appropriations Act of 1998 WT/DS176/AB/R of 2 January 2002.

³⁹⁰ United States – Section 211 Omnibus Appropriations Act of 1998 WT/DS176/AB/R of 2 January 2002 para 215.

production of evidence by the opposing party.³⁹¹ A Judicial authority, in turn may order any of the parties to produce evidence in its custody, provided the following conditions are met:

- i. Before pronouncing ordering the opposing party, the claiming party must presented reasonably sufficient available evidence and³⁹²
- ii. Relevant supporting evidence to substantiate its claims is in control of the opposing party.
- iii. Where the opposing party is impeding or frustrating justice,³⁹³ by refusing access to or providing necessary information within a reasonable period or significantly impedes a procedure relating to an enforcement action.
- iv. Subject to providing the parties with an opportunity to be heard on the allegations or evidence judicial authorities have the discretion to make preliminary and final determinations on the basis of the information presented to them.³⁹⁴

This article uses the word ‘evidence’ in article 43.1 whereas in article 43.2 it mentions ‘information.’³⁹⁵ These words have separate meanings; they are intended not to mean the same thing. Article 43.1 requires evidence that is ‘proof’ whereas information means facts provided or learned about something. However, there is a possibility that the information learned may be used as evidence.

3.5.1.4 Article 44: Injunctions

Article 44 deals with injunctions. Injunctions are court orders commanding or preventing an action.³⁹⁶ Judicial authorities shall have the authority to order a party to desist from an infringement. This provision covers an infringement that has been established for the prevention of entry into the channels of commerce, such as imported goods which involve the infringement of any type of intellectual property right, immediately after customs have cleared the goods. The second sentence in article 44.1 gives protection to an innocent infringer.³⁹⁷ The issue here relates to protected subject matters and states that members cannot be compelled to make such orders provided the person had no reasonable ground to

³⁹¹ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 588.

³⁹² Article 43.1 TRIPS Agreement.

³⁹³ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* .p.712.

³⁹⁴ Article 43.2 TRIPS Agreement.

³⁹⁵ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 590.

³⁹⁶ Black’s Law Dictionary 801 (8th edition 2004).

³⁹⁷ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 591.

know that dealing in such subject matter would entail an infringement of an intellectual property right.

Article 44.2 limits the remedies a right holder is entitled to in cases of government use, or use by third parties authorised by a government but without the authorisation of the right holder, to payment of remuneration. In the circumstances of each case, taking into account the economic value of the authorisation, the right holder shall be paid adequate remuneration.³⁹⁸ With the exception of the circumstances stated above, remedies shall apply in accordance to the provision of this Part: however, where these remedies are inconsistent with the laws of the member state, declaratory judgments and adequate compensation shall be made available.

3.5.1.5 Article 45: Damages

This article empowers judicial authorities to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered.³⁹⁹ What is adequate in one jurisdiction may vary and may also depend on the size of the company of the infringer. Therefore, it is up to the member state to determine what is adequate regarding each circumstance⁴⁰⁰ and the judicial authority has the final discretion to determine what is adequate in each case. An infringer who unknowingly, or without reasonable grounds to know, engaged in infringing activities would not be required to pay damages, irrespective of the nature of the offence.⁴⁰¹ The remedy covers all the rights under the TRIPS Agreement.⁴⁰²

In addition, the provision requires members to authorise the judicial officers to order the infringer to pay the right holder expenses, which may include ‘appropriate’ attorney’s fees. Specifically, this provision mentions that members may authorise the judges to order recovery of profits and/or payment of pre-established damages even if the infringer

³⁹⁸ Article 31(h) TRIPS Agreement.

³⁹⁹ Article 45.1 TRIPS Agreement.

⁴⁰⁰ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 593.

⁴⁰¹ Jay Dratler, *Intellectual Property Law, Commercial, Creative, and Industrial Property* Law Journal Press New York 1999, pp. 1A-108.

⁴⁰² Dratler, *Law* pp. 1A-108.

unknowingly and without reasonable grounds to know engages in an infringing activity.⁴⁰³ According to Dratler, the provision is a two-edged sword, in that both a culpable infringer and culpable claimants can be liable for damages.⁴⁰⁴ In a situation in which the defendant has been wrongfully accused, the claimant must pay damages for wrongfully enjoining or restraining the defendant.

3.5.1.6 Article 46: Other Remedies

Judicial authorities in a member state shall have powers ‘to create an effective deterrent to infringement’ where goods have been effectively found to be infringing ‘without compensation of any sort’.⁴⁰⁵ These orders may include:

- i. Disposition of the goods outside the channels of commerce in such a manner as to avoid any harm caused to the right holder and destruction unless this would be contrary to existing constitutional requirements. As regards counterfeit trade mark goods, simple removal of the trade mark unlawfully affixed shall not be sufficient to permit release of the goods into commerce.
- ii. All materials and implements which are the predominantly used in the creation of the infringing goods shall be disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements.
- iii. The need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account and not only the interest of the right holder.

3.5.1.7 Article 47: Right of Information

This provision, although not mandatory for members to have in their national laws, is a vital tool to counteract professional infringers⁴⁰⁶ by providing understanding of the channel of distribution and organisational structure of the infringing product.⁴⁰⁷ Where the article is provided for in a members’ law, it is expected that the judicial authority can order the infringer to give information relating to the identity of third parties involved in the

⁴⁰³ Article 45.2 TRIPS Agreement.

⁴⁰⁴ Dratler, pp. 1A-108.

⁴⁰⁵ Article 46 TRIPS Agreement.

⁴⁰⁶ Gervais, *The TRIPS Agreement* para. 2.564 p. 588.

⁴⁰⁷ Stoll, Busche, & Arend (Eds), *WTO Trade Related Aspect of Intellectual property Rights* p. 728

production and distribution of the infringing goods or services, as well as provide information on their channels of distribution.⁴⁰⁸ Additionally, this requirement proportionality is based on the seriousness of the infringement. There is no clarification as to what constitutes ‘seriousness’ and whether the yardstick for determining seriousness is harmful to the party.⁴⁰⁹ Where the provision is implemented in a members’ law, at the end of the day, it is the judicial authority that has the discretion to determine what is a serious infringement or not.

3.5.1.8 Article 48: Indemnification of the Defendant

Where an applicant requests measures to be taken against another wrongfully, leading to enjoining or restraining of the other party, the defendant will be entitled to be indemnified for the abuse suffered and the cost of the proceeding may be awarded as well. Thus, the applicant would be responsible for two types of damages,⁴¹⁰ that is, compensation for the injury and expenses incurred, which may include appropriate attorney's fees. The provision has a preventive function, in that it prevents abuse of the judicial system.⁴¹¹

Public authority and officials who partake in the enforcement of intellectual property rights may be found liable for abuse,⁴¹² and would only be exempted if the remedial measures that were taken or intended are taken in good faith in the administration of the law. The provision intends to curb the excesses of public officials who intend to use their office as a means of intimidating producers of intellectual property particularly in cases where the litigant is a foreign party.⁴¹³ Gervais describes this provision as aimed ‘primarily at ultra vires⁴¹⁴ action and actions taken in bad faith’.⁴¹⁵

⁴⁰⁸ As simple as it sounds getting the information from a wilful infringer may be an uphill task, as the implication of blowing the whistle on the counterfeiting or piracy organization would be enormous for him, because counterfeiting and piracy organizations are run like a cartel.

⁴⁰⁹ Michael Blakeney, *Guidebook on Enforcement of Intellectual Property Rights* Queen Mary Intellectual Property Research Institute Queen Mary, University of London p. 34.

⁴¹⁰ Article 48.1 TRIPS Agreement.

⁴¹¹ Stoll, Busche, & Arend (Eds), *WTO Trade Related Aspect of Intellectual property Rights* p. 733.

⁴¹² Article 48.2 TRIPS Agreement.

⁴¹³ Blakeney, *Guidebook on Enforcement of Intellectual Property Rights* p. 34.

⁴¹⁴ *Ultra vires* means beyond the scope of power granted by corporate charter or law. Black’s Law Dictionary 1559 (8th ed 2004).

⁴¹⁵ Gervais, *The TRIPS Agreement* para. 2.572 p. 593.

3.5.1.9 Article 49: Administrative Procedures

This article indicates all the civil remedies applicable to administrative procedures. All the procedures and civil remedies in articles 41–48 shall extend to administrative procedural matters and conform to principles equivalent in substance to those set forth in this section. The procedures need not be identical must, but ‘conform to principles equivalent in substance.’⁴¹⁶ Members are not under any obligation to make provisions for equivalent principles in administration.⁴¹⁷

3.5.1.10 Article 50: Provisional Measures

Article 50 makes provision for the minimum requirements to be expected in proceedings for provisional measures. It is regarded as one of the most important provisions in the enforcement part,⁴¹⁸ containing sufficiently detailed conditions required for the granting of provisional measures reflecting a ‘check and balances’ approach.⁴¹⁹ The interest of the right holder is taken into account to obtain prompt and effective provisional legal protection and, on the other hand, providing sufficient checks and balances by taking into consideration the possibility of a wrongful proceeding.⁴²⁰ These measures are reckoned as an effective means of combating counterfeiting and piracy, since the actions are executed *inaudita altera parte*.^{421,422} Article 50.1 contains two measures:

- i. An order to prevent infringement from occurring by preventing the entry of infringing goods into channels of commerce and
- ii. An order to preserve evidence relevant to the alleged infringement.

Judicial authorities are required to have the authority to adopt provisional measures *inaudita altera parte* where appropriate and where any delay is likely to cause irreparable harm to the

⁴¹⁶ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 600.

⁴¹⁷ Stoll, Busche, & Arend (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p. 736.

⁴¹⁸ Gervais, *The TRIPS Agreement* para. 2.587, p. 602.

⁴¹⁹ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 601.

⁴²⁰ Stoll, Busche, & Arend (Eds), *WTO Trade Related Aspect of Intellectual property Rights* p. 739.

⁴²¹ Popularly known as *ex parte* which means done or made at the instance of one party only and without notice or argument by any person adversely interested for temporary or emergency relief. Black’s Law Dictionary 616 8th ed 2004).

⁴²² Gervais, *The TRIPS Agreement* para 2.587 p. 602.

right holder or where there is a demonstrable risk of evidence being destroyed.⁴²³ Measures in this section do not require that the alleged infringer be informed before they are taken, hence they can be enforced *ex parte*.⁴²⁴

The right holder has the right to seek prompt action whether or not the infringer can be notified and given opportunity to be heard.⁴²⁵ The judicial authorities are capable of requiring the applicant to provide any reasonably available evidence, this is to enable the judicial authorities to be sufficiently satisfied to a degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent. In addition, the applicant must provide, on the order of the judicial authority a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.⁴²⁶ The measure depends on the circumstance of each case, for instance, where the infringement and the right holder are obvious the judge may not need to make the order.⁴²⁷

Article 50.4 goes hand in hand with Article 50.2. Thus, *inaudita altera parte* measures that have been implemented against defendants or affected parties, they shall immediately be given notice, after the execution of the measures without delay. Moreover, a review of the *inaudita altera parte* provisional measures could be undertaken to give the defendant the right to be heard. The review would be initiated at the request of the defendant with a view to deciding whether these measures shall be modified, revoked or confirmed and must take place within a reasonable period after the notification of the measures. The authority may require the applicant to supply further information essential for the identification of the goods concerned.⁴²⁸ Also, there is a presumption that the authority executing such measure

⁴²³ Article 50.2 TRIPS Agreement.

⁴²⁴ Gervais, *The TRIPS Agreement* para. 2.590 p. 607.

⁴²⁵ F. M Abbott, 'Dispute Settlement in International Trade, Investment and Intellectual Property' United Nations Conference on Trade and Development (UNCTAD) available at http://unctad.org/en/docs/edmmisc232add18_en.pdf accessed 22 November 2012

⁴²⁶ Article 50.3 TRIPS Agreement.

⁴²⁷ Gervais, *The TRIPS Agreement* para. 2.423 p. 308.

⁴²⁸ Article 50.5 TRIPS Agreement.

may not be the ‘judicial’ authority that ordered it, for instance, the police or customs authorities execute the request of the courts.⁴²⁹

Article 50.6 makes it possible for the defendant to request the revocation of provisional measures⁴³⁰ taken on the basis of paragraphs 1 and 2 if proceedings that led to a decision on the merits of the case are not initiated within a reasonable period. Thus, a preventive measure and *inaudita altera parte* provisional measures that have been granted at the instance of the applicant can be revoked and would cease to have effect if the proceedings drag on unnecessarily. The aim of the provision is to create safeguards to protect the alleged infringer from abuses or wrongful instigation of proceedings.⁴³¹ A reasonable period shall not exceed 20 working days or 31 calendar days for the purpose of revocation or repeal. Accordingly, where a revocation measure is requested or the applicant fails to act or where the provisional measures were unsubstantiated and no infringement of intellectual property was found the defendant should receive a compensation commensurate to ‘any’ injury caused.⁴³² The compensation may include lost benefits and expenses incurred.⁴³³ Comparable to article 49, article 50.8 extends all provisional measures to administrative procedures to the extent possible in which the orders may be applicable. The provision confirms that members are not obliged to facilitate the granting of provisional measures by administrative authorities.⁴³⁴

⁴²⁹ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 606.

⁴³⁰ Judgment of the Court of 5 February 1993, *NV Algemene Transport- en Expeditie Onderneming Van Gend en Loos v Netherlands Inland Revenue Administration*, Case 26/62, [1963] ECR 3. This was a groundbreaking decision in the 1963 European Court of Justice (‘ECJ’) judgment in which established that provisions of the Treaty Establishing the European Economic Community were capable of creating legal rights which could be enforced by both natural and legal persons before the courts of the Community’s member states. This is now known as the principle of direct effect. This decision clarified that where national laws were in conflict or contravened EC laws EC laws prevailed. Available at http://en.wikipedia.org/wiki/Van_Gend_en_Loos_v_Nederlandse_Administratie_der_Belastingen accessed 18 February 2013.

⁴³¹ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 607.

⁴³² Article 50.7 TRIPS Agreement.

⁴³³ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 607.

⁴³⁴ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 607.

3.5.1.11 Criminal Procedures

Criminal measures are specifically applicable in the case of wilful trade mark counterfeiting or copyright piracy on a commercial scale. However, such measure may be extended to other cases of infringement of intellectual property rights if they are committed wilfully and on a commercial scale.⁴³⁵ Available penalties for such crimes shall include imprisonment and/or monetary fines sufficient to provide a corresponding deterrent. It is expected that the punishment will be equal to the gravity of the crime.⁴³⁶ Where appropriate, remedies, such as seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been used in the commission of the offence, may be applied as the circumstances warrant. These are minimum standards; countries may have different approaches to the application of the criminal penalties as regards IPR infringement.⁴³⁷

3.7 Conclusion

The dynamics and technicality involved in the interpretation and implementation of the TRIPS Agreement is enormous. The implementation of the TRIPS Agreement requires a legislative body that is knowledgeable in the stratagems of international trade and intellectual property as well as, the drafting history and analysis of the TRIPS Agreement. In this chapter, focus has been on the TRIPS Agreement. The substantive parts of the TRIPS Agreement which relate to the legal framework of Nigeria to be examined later, were highlighted.

The TRIPS Agreement has been heavily criticised by developing countries⁴³⁸ in relation to its very existence, the implementation of its provisions in member countries and the provisions of the TRIPS Agreement itself. The criticism as to the existence of the TRIPS Agreement is to a large extent attributable to the fact that intellectual property rights have no clear-cut relation to trade and have endorsed the substantive provisions of the Berne, Paris and Rome

⁴³⁵ Article 61 TRIPS.

⁴³⁶ Gervais, *The TRIPS Agreement* para 2.473, p.327.

⁴³⁷ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 620.

⁴³⁸ The African Group and Venezuela.

Conventions. Other criticisms include the one size fits all approach, the likelihood of protecting life forms and the way it hinders access to public health.

The chapter evaluates some of the substantive sections of the TRIPS Agreement to explain how these provisions are viewed nationally and internationally. It has been shown that the copyright section of the TRIPS Agreement largely incorporated the provisions of the Berne Convention, with the inclusion of few new areas such as computer programs and rental rights. One of the main motives for the establishment of an intellectual property agreement under the WTO was because of the counterfeiting of trade mark goods which needed to be dealt with by an organisation that could enforce sanctions on the countries which permit or allow such infringements to go on.

In addition, the chapter outlines the various subject matter that is excludable from patenting, with particular reference to the ‘biotechnology clause’⁴³⁹ and the controversy surrounding it. Despite the fact that there have been many proposals demanding the clarification of patenting of life forms, there has been no review of article 27. 3 (b) till now.

Over the years few amendments have been made to the TRIPS Agreement. There have been several proposals for the review of the TRIPS Agreement dating back to 1999, and the TRIPS Agreement expressly provides for such revisions in article 71, which provides that the Council of TRIPS ‘having regard to the experience gained in its implementation, review it two years after that date and at identical intervals thereafter’ shall review its provisions. The only semblance of a review was the Doha Declaration on Public Health.

In conclusion, it must be reiterated that the TRIPS Agreement leaves ample room for member states to manoeuvre, despite the many controversies. The TRIPS Agreement contains a number of flexibilities which have been ignored. Instead of members making use of the flexibilities they have entered into TRIPS plus Agreement in the form of Free Trade Agreement (FTAs). The enforcement of intellectual property rights is one of the flexibility features of the TRIPS Agreement: member states can develop their own enforcement rules and practice.

⁴³⁹ Article 27.3b TRIPS Agreement.

Having discussed the TRIPS Agreement extensively, the following chapters will focus on the legislative framework of Nigeria. The next chapter will discuss the national provisions on copyright with regard to how compliant the laws are with the TRIPS Agreement and how the laws have been judicially interpreted.

CHAPTER 4

Copyrights and Related Rights

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4.1 Introduction

In order to appreciate the nature and extent of the legal obligation Nigeria has under the TRIPS Agreement, it is necessary to examine the Nigeria Copyright Act in relation to the copyright and related rights provision of the TRIPS Agreement. In order to determine the possible impact of the TRIPS Agreement on the general principles of the substantive copyright law in Nigeria, it is also imperative to assess the general framework and the operation of the Copyright Act so as to understand and explain what impact the TRIPS Agreement has on the law. The impact of the TRIPS Agreement on copyright will be explored in relation to the Berne Convention.

Broadly speaking this chapter will give an overview of the legal framework of copyright in Nigeria to provide clarity about the current legal structure for the protection of copyright. Also the legislation will be examined to determine the status of the laws in relation to the TRIPS Agreement so as to assess the level of compliance and to determine if there would be significant changes to the law as well as whether the required changes would have a negative impact.

The implications of the content of the WTO/TRIPS Agreement are fundamental to all economies in the world. It is vital to assess the effect of the TRIPS Agreement on Nigeria to enable the proper formulation of laws that could empower sustainable development. The TRIPS Agreement presents a declaration of the minimum standard of intellectual property rights to which all member countries of WTO have made a commitment.

The protection of intellectual property has become an issue of specific attention from a developing country's perspective since the TRIPS Agreement came into force in 1995. The major issue relating to the impact of the TRIPS Agreement is the harmonisation of national intellectual property laws with the global 'minimum standards in virtually all areas of intellectual property protection' in order to achieve compliance with the TRIPS Agreement, without taking into consideration the level of the development of the member. This is a key feature and raises concern among developing countries (DCs), in view of the fact that the TRIPS Agreement is binding on all members with no reservations possible.

More specifically, the chapter discusses the intersections between Nigerian law and the TRIPS Agreement by examining its impact on the relevant sections of the Copyright Act, after determining the current state of Nigerian copyright law. The chapter will also consider possible modifications with reference to Articles 7 and 8 and other relevant provisions of the TRIPS Agreement, including the flexibilities available to member states.

4.2 Copyright in Nigeria

4.2.1 Historical Overview of Copyright

The development of Nigerian copyright law dates back to the British Copyright Act of 1911.¹ This Act was fashioned largely to protect the rights of British authors and publishers within the Northern and Southern Protectorates of Nigeria. Prior to the amalgamation of the North and South in 1914, the British Copyright Act of 1911 was made applicable to both the Northern Nigeria Protectorate² and Southern Nigeria Protectorate³ by an Order in Council.⁴

¹ The UK Copyright Act of 1911 was made applicable to all British Colonies by an Order in Council no 912 of 1912.

² Section 1 (b) No. 912 dated 24th June 1912.

The Nigerian Copyright Act of 1912 incorporated the British Copyright Act of 1911;⁵ this Act provided for the British 1911 Act to apply without variation. The Nigerian Copyright Act of 1912 contained three parts, which are the imperial copyright provisions, international copyright provisions and the supplementary provisions.⁶

The Copyright Decree of 1970⁷ repealed the Copyright Act of 1912. Sections 16 and 18(1) of the Copyright Decree of 1970 specifically excluded the rules of common law dealing with copyright and repealed the United Kingdom Act of 1911 in so far as was it applicable to Nigeria.⁸

Considering the contents of the law, it is obvious that the repeal of the Copyright Act of 1911 was merely a move away from the colonial era and did not reflect a need by the Nigerian people to protect copyright in their work. A major difference in the laws was a change to the existing term of protection in the Copyright Act of 1912 which provided that ‘the term for which copyright shall except as otherwise expressly provided by this Act, be the life of the author and a period of fifty years after his death’.⁹ It became the life of the author and a period of seventy years after his death.¹⁰

As the nation developed and young talent began to spring up, pressure began to mount for a review of the nation’s copyright laws.¹¹ A joint national seminar organised by the Ministries of Information and Culture, Education, Justice and Trade examined relevant aspects of copyright administration in Nigeria that needed to be reviewed.¹² After the deliberations, the

³ Section 1 (d) No. 912 dated 24th June 1912.

⁴ No. 912 dated 24th June 1912.

⁵ Generally known as the Imperial Copyright Act of 1911.

⁶ Copyright Act, 1911 [1 & 2 GEO. 5. CH. 46.]

⁷ Copyright Decree No. 61 of 1970.

⁸ Y.O. Ali, ‘The Nigerian Copyright Act and Criminal Liability’ available at http://www.yusufali.net/Articles/THE_NIGERIAN_COPYRIGHT_ACT_AND_CRIMINAL_LIABILITY.pdf accessed 11 November 2012.

⁹ Section 3 Copyright Act of 1912.

¹⁰ First Schedule Copyright Decree 1970.

¹¹ Copyright Society of Nigeria available at http://www.cosonng.com/our-people/okoroji_up/ accessed 23 February 2013.

¹² Nigerian Copyright Council available at africagogo.com/uploads/Nigerian_Copyright_Council.docx accessed 23 February 2012.

1970 Copyright Decree was repealed and replaced by the Copyright Decree 1988.¹³ Subsequently, all federal legislation were revised and the Decree was re-designated as the Copyright Act of 1988¹⁴ contained in the Laws of the Federation of Nigeria, 1990. The Act has been amended twice, in 1992¹⁵ and 1999,¹⁶ and is currently codified as part of the 2004 Laws of the Federation of Nigeria in Chapter 28.¹⁷

Nigeria has ratified some international conventions on copyright, such as the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations and the Berne Convention for the Protection of Literary and Artistic Works as well as the Universal Copyright Convention. It remains only a signatory to the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty.

Copyright is an area of IP in comparison to other aspects of IP that has received much attention in Nigeria. The reason for this development can be attributed to the rapid growth in the film and music industry and gradual progress the area of literary works. Despite these developments Nigerian law has not undergone any major change since the introduction of the TRIPS Agreement.

4.2.2 Overview of the Copyright Act, 1988

4.2.2.1 Works Protected

The Copyright Act of 1988 specifically outlines the works that shall be eligible for copyright protection under the following broad categories of works, namely literary works, musical works, artistic works, cinematograph works, sound recording and broadcasts as provided for under section 1.¹⁸ Copyright subsists in any work automatically, without formalities, however certain requirements may have to be met. Although, the Act does not define copyright the Federal High Court (FHC) in *Sarg Aims Aluminium v Stanley Akagha &*

¹³ Copyright Decree No. 47 of 1988.

¹⁴ Cap. 28, Laws of the Federation of Nigeria, 1990. All references below to the Copyright Act or the Act are unless otherwise stated, references to the Copyright Act of 1988, as amended by the Decrees below. (Hereinafter referred to as the Act.)

¹⁵ Copyright (Amendment) Decree (No. 98) of 1992.

¹⁶ Copyright (Amendment) Decree (No. 42) of 1999.

¹⁷ Copyright Act 1988 Cap 28 Laws of the Federation of Nigeria 2004.

¹⁸ Section 1 CA 1988 Cap 28 LFN 2004.

*Another*¹⁹ defined copyright as ‘the right of literary property as recognised and sanctioned by positive law. It is in essence an intangible, incorporeal right granted by statute to the author or originator of certain literary or artistic production whereby he has invested, for a specified period with the sole and exclusive privilege of multiplying copies of the same and publishing and selling them’. This definition is not comprehensive as it focuses on literary and artistic works only. The works protected will be examined as follows:

a. Literary Works

The Copyright Act defines literary works to include, irrespective of the literary quality, any of the following works or works similar thereto-

- (a) novels, stories and poetic works;
- (b) plays, stage directions, film scenarios and broadcasting scripts;
- (c) choreographic works;
- (d) computer programmes;
- (e) text-books, treaties, histories, biographies, essays and articles;
- (f) encyclopaedias, dictionaries, directories and anthologies;
- (g) letters, reports, and memoranda;
- (h) lectures, addresses and sermons;
- (i) law reports, excluding decision of courts;
- (j) written tables or complaints.

From the definition it is noted that literary works include all printed and written materials and that the meaning of a literary work is not confined to the list.²⁰ The standard of a copyright work does not come into play to necessitate protection of the work as the quality of the work does not dictate the level of protection offered. Accordingly, quality, whether high or low, and the style of creation has nothing to do with the protection of the work.²¹ Also, from the definition of literary works, the medium of fixation does not seem relevant as works

¹⁹ (1994) 3 I.P.R.L. 219, FHC/KD/1/92.

²⁰ *University of London Press v university Tutorial Press [1916] 2 ch 601.*

²¹ See section 51 Copyright Act 1988 Cap 28 LFN 2004; Lionel Bently and Brad Sherman *Intellectual Property Law* (3rd ed.) Oxford University Press Oxford 2009 p.61; Uvieghara E.E. ‘Copyright Law’ in Akanki E.O (ed.) *Commercial Law in Nigeria* 2005 University of Lagos Press 457; Peter Groves *Sourcebook on Intellectual Property Law* Cavendish Publishing Limited London 1997 p. 311.

protected as literary works vary from novels to computer programmes; accordingly it includes saving a work on a computer, CD or flash drive.

Although the meaning of literary works has not been judicially explored in Nigeria, according to Bentley and Sherman, the meaning of literary works has been examined in the context of information or instruction.²² The test for whether a work conveys an intelligible meaning is subjective as the understanding of a work need not be by the whole public.²³ Court judgements are specifically excluded from copyright protection and names and trade marks have been refused the status of a literary work.²⁴

b. Musical Works

Section 51 of the Copyright Act defines musical works to mean any musical work, irrespective of musical quality, includes works composed for musical accompaniment. From this definition or interpretation certain phrases or words are notable; these include musical quality and works composed for musical accompaniment. Accordingly, it is important to determine what music is. Music is sounds whether sung by voices or produced by a musical instrument, as well as written or printed symbols showing how music should be played or sung or the art or skill of creating or performing music.²⁵ All these types of music, come together to form different kinds of musical works. The musical quality of a work is not significant in obtaining protection by copyright. For a work to be musical, however, there must be some form of composition that has taken place. For instance, songs consist of words put together in the form of rhythm or melody, but a song becomes a musical work only when it is projected by voices or instruments for a musical accompaniment. If the words of a song are merely written down then protection may be sought only as a literary work in terms of lyric of the song.²⁶

From the meaning ascribed to musical work it is unclear whether it covers writings or other forms of graphic representation. Another challenge which may be encountered relates to

²² Lionel Bently and Brad Sherman p.62.

²³ Lionel Bently and Brad Sherman p.62. *D. P. Anderson v Computer Edge* [1984]FSR 481, 521.

²⁴ *Exxon Corp. v. Exxon Insurance Consultants International Ltd* [1982] Ch. 119.

²⁵ <http://www.merriam-webster.com/dictionary/music> accessed 02 May 2014

²⁶ *CFAO v Achibold* (1964) GLR 718.

unwritten works. This factor is of importance in a country like Nigeria which has a high rate of illiteracy as well as high creativity rates. It may be said that the requirement of fixation for copyright works fills this lacuna and, in a way, clarifies it.

c. Artistic Works

The Copyright Act particularly provides that artistic work includes, irrespective of artistic quality, any of the following works or similar works:

- (a) paintings, drawings, etchings, lithographs, woodcuts, engravings and prints;
- (b) maps, plans and diagrams;
- (c) works of sculpture;
- (d) photographs not comprised in a cinematographic film;
- (e) works of architecture in the form of buildings models; and
- (f) works of Artistic craftsmanship and also (subject to Section 1 (3) of this Act) pictorial woven tissues and articles of applied handicraft and industrial article

Generally speaking, and, as noted by Lord Oliver, the importance of an artistic copyright relates to the visual appearance of the work.²⁷ The quality of the work, whether good or bad, under the Act is irrelevant provided it is in any of the format of works mentioned. This list may not be exhaustive. The works listed above can be categorised into two dimensional²⁸ and three dimensional works.²⁹ One of the very few cases that have come up in relation to artistic works is the case of *Maurice Ukaoha v Broad Based Mortgage Finance Ltd*³⁰ which relates to a copyright claim in an architectural work of a model of 17 storey building. The defendant published a representation of the model in three national newspapers, claiming it was their proposed headquarters and giving credit for the work to someone else. The court held that copyright existed in the model which is an artistic work of art made and constructed by the plaintiff who is a qualified person under the provision of section 2 (1) of the Act.

²⁷ *Interlego AG v Tyco Industries Inc.* 1 A.C. 217.

²⁸ Paintings, drawings, etchings, lithographs, engravings, prints, maps, plans and diagrams.

²⁹ Works of sculpture and works of architecture in the form of buildings models. Folarin Shyllon *Intellectual property Law in Nigeria* Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich 2003 p. 40.

³⁰ [1992] 2 FHCLR 477.

Paragraph (f) in particular refers to protection of works of artistic craftsmanship. This category of artistic work has been said to require some skill and a degree of artistic quality with a substantial appeal to the aesthetic taste of those who look at it.³¹ The question is asked whether the use of the phrase ‘irrespective of artistic quality’ affects the interpretation of works of craftsmanship if it comes up for discussion in a court.³² It is opined, since the Act does not define works of craftsmanship, that the court may examine cases in other jurisdictions to determine its meaning within the context of ‘irrespective of artistic quality’. Paragraph (f), however, excludes artistic works intended by the author, at the time when the work is made, to be used as a model or pattern to be multiplied by any industrial process, from being eligible for copyright protection. As Shyllon rightly points out, the key test is the intent of the author and all subsequent use is irrelevant.³³ He further points out that as long as the work is not initially intended to be industrially multiplied and copyright subsists in the work, section 6 (1) allows works to be reproduced in any material form. Accordingly, it is submitted that the intent is what makes a difference in whether the artistic work is protected under copyright, even if industrially reproduced in other formats. For example, any material form may be a reproduction of the Mona Lisa portrait: by taking a photograph where the artistic skill of the author comes into play or a sculpture of the Mona Lisa in clay or glass seems to be reproduction in any material form and not reproduction in the same format, which may be almost impossible for paintings. If the Mona Lisa photograph is reproduced does the author now lose his copyright? The answer will be negative as there was no intent during the creation of the work to reproduce it industrially.

The question is: Does industrial reproduction fall under any material form? According to the *WIPO Guide to the Berne Convention* in ‘any material form’ covers all methods of

³¹ *Cuise N aire v Reed* (1963) V R 719. *Henser v Reastawile* [1976] A C 64 [1975] R P C 31 John Asein *Nigeria Copyright Law and Practice* (2nd ed.) Books and Gravel, Abuja 2012 p. 66-66; Australian Intellectual Property Law p.204.

³² John Asein, *Nigeria Copyright Law and Practice* (2nd ed.) Books and Gravel, Abuja 2012 p. 67.

³³ Folarin Shyllon, *Intellectual property Law in Nigeria* Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, 2003 p. 40.

reproduction and all other processes now known or later developed.³⁴ What makes an art unique is its singleness and industrial reproduction defeats this purpose.

d. Cinematograph Works

Cinematograph film is primarily defined to include the first fixation of a sequence of visual images capable of being the subject of reproduction and includes the recording of a sound track associated with the cinematograph film. This definition accentuates the fact that it is not all-encompassing. Cinematograph film, or motion pictures, is inclusive of the sound track regardless of the form it is in. The Court of Appeal held in *Ugwuoti v Ezenmia*³⁵ that it would amount to ‘quibbling, redolent in farcical understanding’ not to take video films into consideration under the definition of cinematograph films. In essence technology now known or later developed for a sequence of visual images can be protected as cinematograph film. Although cinematograph film includes the sound track, the term ‘sound track’ is not defined in the Copyright Act but it is commonly referred to as music complementing a film made available by the film maker.³⁶

e. Sound Recording

Sound recording is another category of work protected. Section 51 of the Act defines sound recording to mean the fixation of a sequence of sound capable of being perceived aurally and of being reproduced, but does not include the sound track associated with a cinematographic film. Sound recording presupposes that it should be heard as opposed to seeing it.³⁷ Although sound tracks are perceivable aurally, where they are included in a cinematographic film they will not be protected as sound recordings but as part of the cinematographic film.

³⁴ Para 9.2 p.54.

³⁵ [2003] 17 WRN 122.

³⁶ Mark J. Davison, Ann L. Monotti & Leanne Wiseman, *Australian Intellectual Property Law* Cambridge University Press 2008 p. 206.

³⁷ John Asein, *Nigeria Copyright Law and Practice* (2nd ed.) Books and Gravel, Abuja 2012 p. 72.

f. Broadcasts

Broadcast are defined as sound or television broadcast by wireless telegraphy or wire or both, or by satellite or cable programmes and includes re-broadcast.³⁸ Unusually, the Act not only defines ‘broadcast’, it defines cable programmes, rebroadcast and broadcasting authority as well. Accordingly, broadcast by cable programmes means visual images, sounds or other information sent by means of a telecommunication system reception at two or more places in response to a request by different users simultaneously at different times for the presentation to members of the public. On the other hand, a re-broadcast means a simultaneous or subsequent broadcast by one broadcasting authority of the broadcast of another broadcasting authority.³⁹

The Act leaves out the definitions of wireless telegraphy and satellites. However, as noted by Asien, the definition in the Wireless Telegraphy Act⁴⁰ suffices and should be incorporated into the definition.⁴¹ The providers of broadcasting services are required to be authorities, established under any law in Nigeria or elsewhere, providing broadcasting services for public reception.⁴²

In summary, one thing that is consistent in the interpretation of this section of the Act is the absence of several terminologies as used in defining literary, musical, artistic, cinematograph, sound recording and broadcast.

4.2.2.2 Eligibility for Protection

There are two basic requirements for a work to be eligible for copyright: (a) sufficient effort must have been expended⁴³ on making the work to give it an original character;⁴⁴ (b) the work must have been fixed in a definite medium of expression⁴⁵ now known or later to be

³⁸ Section 51 CA 1988 Cap 28 LFN 2004.

³⁹ Section 51 CA 1988 Cap 28 LFN 2004.

⁴⁰ Wireless Telegraphy Act, Cap W5, LFN 2004.

⁴¹ John Asein, *Nigeria Copyright Law and Practice* (2nd ed.) Books and Gravel, Abuja 2012 p. 73.

⁴² Section 51 CA 1988 Cap 28 LFN 2004.

Offrey v Chief S. O. Ola & Ors, (unreported suit no. HOs/23/68) decided 27th June 1969; *Masterpiece Investment Ltd v Worldwide Business Media Ltd* Suit No. FHC/L/120/91.

⁴⁴ Section 1 (2) (a) CA 1988 Cap 28 LFN 2004.

⁴⁵ See *Masterpiece Investment Ltd v Worldwide Business Media Ltd* Suit No. FHC/L/120/91.

developed from which it can be perceived, reproduced or otherwise communicated, either directly or with the aid of any machine or device.⁴⁶ The originality and the fixation requirements relate to literary, musical and artistic works only.⁴⁷ The other three categories of works, that is, cinematograph film, sound recording and broadcast, are not mentioned in relation to originality and fixation. However, from the definition of cinematograph film and sound recording it is obvious fixation of the work is required,⁴⁸ in the case of broadcasts it is understandable, considering the nature of the work that some broadcast, such as breaking news, may be spontaneous and any other content of a broadcast may have been protected in other ways. These requirements will be further examined below.

a. Originality

The Copyright Act contains no definition of ‘original’. However, for a work to be original sufficient effort must have been expended on making it.⁴⁹ ‘Original’, as used in copyright, means that a ‘work was independently created by the author and that it possesses at least some minimal degree of creativity’.⁵⁰ Originality does not mean the work is new; a work may be original even where it noticeably looks like other works, provided the resemblance is unintended.⁵¹ To illustrate, the *locus classicus* for the definition of originality, upon which a lot of courts in various jurisdictions have leaned on, was given in the case *University of London Press v University Tutorial Press*.⁵² Peterson J stated that the word ‘original’ need not be the expression of original or inventive thought and that copyrights is not concerned with the originality of ideas but rather the expression of thought which must be original. Over the years this definition has been applied to analyse the purpose of originality in a work.⁵³

⁴⁶ Section 1 (2) (b) CA 1988 Cap 28 LFN 2004.

⁴⁷ *Feist Publications v Rural Telephone Service Co* (1991) 499 U. S. 345. O'Connor J.

⁴⁸ Section 51 CA 1988 Cap 28 LFN 2004.

⁴⁹ Section 1 (2) (a) CA 1988 Cap 28 LFN 2004.

⁵⁰ 1 M. Nimmer & D. Nimmer, Copyright §§ 2.01[A].

⁵¹ *Sheldon v. Metro-Goldwyn Pictures Corp.* - 309 US 390 (1940) 81 F.2d 49 at 54 (1936) L. Hand J.

⁵² [1916] 2 ch 601, 608-609 Peterson J.

⁵³ *British Northrop Ltd v Texteam Blackburn Ltd* [1973] FSR 241.

The application of this definition can be seen in *Yusufu Ladan v Sha Kallo Publication Company Limited and 2 others*.⁵⁴ The plaintiffs authored a dramatic literary work entitled *Sisi Lagos* which was printed, edited and published by the defendant without the plaintiff's knowledge license or consent. The court held that *Sisi Lagos* is an original work and that the originality required to qualify a literary work under copyright is the originality in the expression of the thoughts itself. The court went on to state that the determinant factor is that the work must not be copied from another work and must originate from the person who claims to be the author.⁵⁵

Generally, originality in copyright works has been expressed in several well-known cases⁵⁶ to be determined by the degree of skill, labour, effort and judgment involved in preparing the work. In an unreported case of *Offrey v Chief S O Ola & Others*, the plaintiff and head master designed a school record book called '*New Era Scheme of Work and Record book*'. The plaintiff's work consists of several horizontal and vertical lines which the first defendant knew of. The book was printed on the instruction of the first defendant by the second defendant. The plaintiff sued for infringement. The court held that copyright would exist in any given product if the product results from substantial or real expenditure of mental or physical energies by the producer and the labour of skill was not negligible or commonplace. The court held that there was no skill, judgement or ingenuity required to support a successful claim of copyright.

In the case of *Jobela Nigeria Enterprises Ltd v Kupolati*⁵⁷ the court, in interpreting minimal standards of originality, held that the plaintiff, not having expended any effort in the creation of the work to give it an original character, is neither the author nor joint-author of the copyright despite funding the business.

⁵⁴ [1972] NCLR 428.

⁵⁵ See also *Harper & Row, Publishers, Inc. v Nation Enterprises*, 471 U. S. 539, 471 U. S. 556 (1985).

⁵⁶ *Express Newspaper Pty Ltd v Liverpool Daily Post & Echo Pty Ltd*. [1985] 3 All E R 680; *Macmillan & Co Ltd v Cooper* (1923) 93 L J P C 113; *Pan African Engineers Pty Ltd v Hydro Tube (Pty) Ltd* 1972 1 SA 471 (WLD); *Topa t/a Topring Manufacturing & Engineering v Ehrenberg Engineering (Pty) Ltd* 71 JOC Galgut J.

⁵⁷ [2005] All FWLR p 1729.

Originality basically consists of two elements: origination from the author and minimal creativity. In the US Supreme Court of *Feist Publications v Rural Telephone Service Co*,⁵⁸ the court reinforced that originality requires independent creation plus a modicum of creativity. In effect the threshold for determining originality is low, as what is required is minimal creativity that does not require uniqueness. Accordingly, originality of the work is not affected by the elementary nature of the work or by the fact that the work is visibly simple.⁵⁹

b. Fixation

Apart from the requirement of originality, the copyright law requires that literary, musical and artistic work will not be entitled to protection if the work is not fixed in any definite medium of expression now known or later developed from which the work can be reproduced. Accordingly, the work is required to be in a material form; possibly because ideas are not protectable, two people can have the same idea, and for the fact that it is easier for the owner to claim authorship if the work is reduced to a material form. The material form makes the work available to the public, which is a reward for the protection given,⁶⁰ and makes the work accessible after the death of the author.⁶¹ Another reason proffered for the need for fixation is to set boundaries in order to determine the extent of work claimed by the author and to function for evidentiary purposes as well.⁶²

The omission of other works from the list does not mean that they do not need to be fixed in material form. Such works naturally require fixation in a material form, as Bently and Sherman note, it is impossible to create a sound recording without putting it in a material form and the act of broadcasting generates a material format of what is broadcast. This means that other works will be protected, whether they are fixed or not, as a part of the work.

⁵⁸ (1991) 499 U.S. 340. O'Connor J.

⁵⁹ John Asein *Nigeria Copyright Law and Practice* (2nd ed.) Books and Gravel, Abuja 2012 p. 78.

⁶⁰ Although this position is contrary to Art. I, § 8, cl. 8 of the US Constitution which states that the primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.' It is believed especially nowadays, that reward plays a great role in enhancing creativity.

⁶¹ Lionel Bently and Brad Sherman p.92.

⁶² Stephen M. McJohn, *Copyright: Examples and Explanations* 2nd ed. Aspen 2006 p. 65.

The medium of expression of the work must be perceived, reproduced or otherwise communicated, which means that the work should be in a replicated form that is understandable to be transmitted to the public. The requirement for fixation relates to media that are currently known or later developed. This provision is of particular benefit now considering the evolution that has taken place through advances in technology and makes it possible for works fixed in mediums such as CDs and DVDs to be protected.

c. Supplementary Requirement

For a work to be protected in Nigeria the work must qualify based on certain criteria. For a work to qualify there must be some form of connection to Nigeria. This demand relates to the status of the author,⁶³ or that the work is first published in Nigeria, or that a body corporate incorporated by or under the laws of Nigeria or responsible for its reproduction.⁶⁴ In addition, foreign copyrighted works are protected in Nigeria.

i. Individual or Corporate Qualification

This criterion relates to the status of the author. The author must be or, in the case of a work of joint authorship, any of the authors must be, when the work is made, an individual who is a citizen⁶⁵ of, or is domiciled in Nigeria to qualify for copyright protection under the law.⁶⁶ A person is regarded as a citizen of Nigeria under the Nigerian Constitution if the person is born in Nigeria⁶⁷ or is registered⁶⁸ or has naturalised⁶⁹ as a Nigerian. Apart from citizens anyone resident in Nigeria can qualify for this protection. The copyright law provides that a company incorporated by or under the laws of Nigeria can qualify for copyright protection as well.⁷⁰

⁶³ Section 2 (1) (i) CA 1988 Cap 28 LFN 2004.

⁶⁴ Section 2 (1) (ii) CA 1988 Cap 28 LFN 2004.

⁶⁵ Chapter III 1999 Constitution of the Federal Republic of Nigeria.

⁶⁶ Section 2 (1) (i) Copyright Act 1988 Cap 28 LFN 2004.

⁶⁷ Section 25 Chapter III 1999 Constitution of the Federal Republic of Nigeria.

⁶⁸ Section 26 Chapter III 1999 Constitution of the Federal Republic of Nigeria.

⁶⁹ Section 27 Chapter III 1999 Constitution of the Federal Republic of Nigeria.

⁷⁰ Section 2 (1) (ii) CA 1988 Cap 28 LFN 2004.

ii. Publication

Literary, musical or artistic work or a cinematograph film may qualify for copyright protection if it is first published in Nigeria. Also, a sound recording made in Nigeria will qualify for the same protection. Publication in another country to which the Copyright (Reciprocal Extension) Order 1972 extends protection may receive protection. As a result, citizens or person domiciled in any of the countries mentioned in the Order may receive similar protection as accorded Nigerian citizens and persons domiciled in Nigeria. A publication in another country will be regarded as the first publication Nigeria if the earlier publication elsewhere took place within a period of not more than thirty days of the publication in Nigeria.⁷¹

iii. Official Works

Section 4(1) of the Act confers copyright protection on every work which is eligible for copyright and is made by or under the direction or control of the Government, a state authority or prescribed international body. In essence all laws and documents that emanate from the government are protected. Although some countries⁷² do not protect government work, the Berne Convention allows the countries of the Union to determine the protection to be granted to official texts of a legislative, administrative and legal nature and to official translations of such texts.⁷³

iv. Treaty Obligations

Qualification of copyright protection can also be conferred by reference to international agreements.⁷⁴ Hence, copyright on every work exist if on the date of its first publication, one of the authors is a citizen of or is domiciled in Nigeria or a body corporate established by or under the laws of the country that is a party to a treaty or other international agreement to which Nigeria is also a party. Copyright protection will be permitted where the work is first published in a country which is a party to a treaty obligation or other international

⁷¹ Section 51 CA 1988 Cap 28 LFN 2004.

⁷² 17 U.S. Code § 105 United States Copyright Law.

⁷³ Article 2 (4) Berne Convention.

⁷⁴ Section 5 CA 1988 Cap 28 LFN 2004.

agreements to which Nigeria is party.⁷⁵ The law provides that works published by international organisations, such as the United Nations or any of its specialised agencies, or by the Organisation of African Unity (now African Union), or the Economic Community of West Africa are protected.

In addition to this section, section 41 of the Act provides that if any country is a party to a treaty or other international agreement to which Nigeria is also a party and the country in question provides for protection of copyright in works which are protected under the Act, such provisions may be extended by the application of this Act in respect of any or all the works referred to in section 1 (1) of the Act to individuals who are citizens of or domiciled in that country; to bodies corporate established by or under the law of that country; to works, other than sound recordings and broadcasts, first published in the country; and to broadcast and sound recordings made in that country.

Section 5 of the Act makes it clear, by reference to international agreements, that copyright will be conferred on every work if on the date of its first publication at least one of the authors is a citizen of or domiciled in⁷⁶ or a body corporate established by or under the laws of the country⁷⁷ or if a work is first published in a country which is a party to an obligation in a treaty⁷⁸ or other international agreement to which Nigeria is a party.⁷⁹

Whether foreign works are protected under the Nigerian Law has been the subject of recent litigation. The situation had to be clarified by the Nigerian Copyright Commission (NCC) in a public notice⁸⁰ which was necessitated by the erroneous judgement of the Federal High Court in *Microsoft Corporation v Franike Associates Ltd.*,⁸¹ which judgement was upheld by the Nigerian Court of Appeal. The FHC dismissed the ex-parte orders and struck out the

⁷⁵ Section 5 (1) (b) CA 1988 Cap 28 LFN 2004.

⁷⁶ Section 5 (1) (a) (i) CA 1988 Cap 28 LFN 2004.

⁷⁷ Section 5 (1) (a) (ii) CA 1988 Cap 28 LFN 2004.

⁷⁸ Nigeria is a party to the Berne Convention, Universal Copyright Convention, Rome Convention, the TRIPS. Agreement, WIPO Copyright Treaty, and WIPO Performances and Phonograms Treaty.

⁷⁹ Section 5 (1) (b) (i-iv) CA 1988 Cap 28 LFN 2004.

⁸⁰ Public Notice U.S. Works Are Protected under Nigerian Copyright Act available at <http://www.copyright.gov.ng/index.php/public-notice/88-u-s-works-are-protected-under-nigerian-copyright-act> accessed 05 March 2013.

⁸¹ Suit No. FHC/L/CS/610/05 and Suit No: CA/L/573/2008.

entire suit on the grounds that it lacked jurisdiction to entertain the appellant's claims. The court ruled that:

The application of the said foreign copyright in Nigeria is subject to a reciprocal extension of protection in accordance with section 33 of the Copyright Act. And in the absence of which, this court will not in my view exercise the requisite jurisdiction over the matter. This is premised on the fact that the exclusive jurisdiction of this court pursuant to section 251(1) (f) of the 1999 Constitution is only limited to the listed Federal Enactments and does not extend beyond copyright etc. other than those listed therein. In the instant case, the copyright sought to be protected was established pursuant to a law other than the Federal Enactments listed in Section 251(1) (f) of the 1999 Constitution. There is also nothing before the court to show that there is any reciprocal extension of protection of the copyright in question...

This ruling is clearly flawed as there was no mention of sections 5 and 41; the ruling was based on the 1988 Act without taking into consideration the 1992⁸² and 1999⁸³ amendments. As far back as 1972 the Copyright (Reciprocal Extension) Order 1972 included the names of countries⁸⁴ to which Nigeria can extend protection.

4.2.2.3 Authorship and Ownership of Copyright

Ownership and authorship of copyrights are different concepts under the Nigerian Copyright Act. Accordingly, the two concepts will be examined below.

a. Authorship

The author of a work is usually said to be the person who creates the work, however in copyright terms this may not always be the case in respect of all works.⁸⁵ Authorship in Nigeria generally means the person who created the work or its material embodiment. The role of the author is significant in copyright as the author is the one who brings the subject matter of protection to life. That is why, as Davison, Monotti & Wiseman⁸⁶ note in relation to Australian copyright law and which is applicable to the Nigerian situation, the author is the viewing platform from which the rules and concepts relating to copyright are commenced.

⁸² Copyright (Amendment) Decree No 98 of 1992.

⁸³ Copyright (Amendment) Decree No 42 of 1999.

⁸⁴ The list included 57 countries in which the United States of America was one of the countries Nigeria should extend reciprocal protection too from as far back as 1972.

⁸⁵ Adams & Adams Practical Guide to Intellectual Property in Africa Pretoria University Law Press Pretoria 2012 p.515.

⁸⁶ Mark J. Davison, Ann L. Monotti & Leanne Wiseman, *Australian Intellectual Property Law* Cambridge University Press 2008 p. 215.

For instance the term of protection is based on the life of the author,⁸⁷ qualification of the author is based on the affiliation of the author,⁸⁸ moral right is attached to the author,⁸⁹ and the author is regarded as the initial owner of copyright.⁹⁰ The Act defines the author based on the type of work and does not contain a separate meaning of who the author is.⁹¹

i. Literary, Artistic or Musical Works

The Copyright Act simply states that the author is the creator of the work. The law does not say who a creator is and what the extent of his contribution to the work should be to qualify as a creator. This definition has been criticised as inadequate as a result of which the interpretation will need to be based on the common law position or definitions from other jurisdictions.⁹² Although, the Act did not provide for a definition of a creator it is believed that the creator must be the person who has contributed some skill, labour and judgement to the work.⁹³ Thus, the court held in *Oladipo Yemitan v The Daily Times (Nig) Ltd & Another*,⁹⁴ ‘that copyright belongs to the author who is the one that actually expended on the work, labour, knowledge and skill.’

Photographs are artistic works literally speaking, which are generated through a mechanical process. Despite this fact the person who took the photograph is regarded as the author⁹⁵ and not the person who generated it through a mechanical process. This provision led to the examination of ownership and authorship issues of photographic works in the case of *Joseph Ikhuoria v Campaign Services Ltd & Another*.⁹⁶ The plaintiff claimed to be the owner of copyright in the photograph. The court held that when a person commissions the taking of a photograph or the painting or drawing of a portrait or undertakes an engraving and pays or agrees to pay for it in money's worth and the work is made in pursuance of that commission,

⁸⁷ Section 2 (2), (3) and (4) CA 1988 Cap 28 LFN 2004; see First Schedule Copyright Act 1988 Cap 28 LFN 2004.

⁸⁸ Section 3, 4, 5 CA 1988 Cap 28 LFN 2004.

⁸⁹ Section 12 CA 1988 Cap 28 LFN 2004.

⁹⁰ Section 10 CA 1988 Cap 28 LFN 2004.

⁹¹ Section 51 (1) CA 1988 Cap 28 LFN 2004.

⁹² Asien p. 114.

⁹³ *Donoghue v Allied Newspapers Ltd* [1938] Ch. 106 Farwell J. said (at pp.109-110); *Ladbroke Football Ltd v William Hill Football Ltd* [1964] 1 1 WLR 273.

⁹⁴ [1990-1997] 3.I.P.L.R152.

⁹⁵ *Burrow-Giles Lithographic Co v Sarony* 1884 111 U.S. 53.

⁹⁶ 1986 F. H. C. R. 308

the person who so commissioned the work is entitled to any copyright in the work as an original work. This means that the person who commissioned the work would be considered the first owner of the copyright, unless there is an agreement to the contrary.

ii. Cinematograph Film or Sound Recording Author

In the Act the author of a cinematograph film or sound recording is the person who made the arrangements for making of the film or sound recording respectively. This situation, however, can be varied by contract by the parties making the film or sound recording. In cinematograph film and sound recording, production of the work seems to make the difference in that it brings the ingredients for making the film together. In a film production there is a producer, director, cinematographer and other persons; the producer is usually the company or corporation that selects the film to be made and bank rolls the production. Technically speaking, the producer does not make any arrangement but pays to get the arrangement done.

In the case of a sound recording the role of who makes the sound recording is not easy to determine, as noted in the case of *A & M Records Ltd v Video Collection International Ltd*.⁹⁷ Two ice skaters requested certain musical work to be recorded for them to accompany their ice skating. The agent of the ice skaters employed a conductor to arrange the music which he paid for. The agent then put together the organisation by hiring a studio, an orchestra, engaging and paying for the scoring, a sound engineer and the fixer, including all expenses. The court found, although the conductor made the recording of the music, that he was not the producer. Rather, the ice skaters' agent created the necessary arrangements for the making of the sound recording. This area of law is highly regulated by contract nowadays, accordingly persons who are part of a film or sound recording know from the outset in whom, authorship will reside.⁹⁸

⁹⁷ [1995] EMLR 25.

⁹⁸ This is not to say that mistakes or ignorance of these rights don't still occur.

For the purposes of a cinematograph film or a sound recording it is expected that the author shall conclude, prior to the making of the work, contracts in writing with all those whose works are to be used in the making of the work.⁹⁹

iii. Broadcast

The authorship of a broadcast transmitted from within any country resides in the person by whom the arrangements for the making or the transmission from within that country were undertaken. It seems more likely that the person who makes the arrangements or transmission would be the broadcasting authority and not the director or cinematographer who puts the broadcast together. Here the emphasis is on who transmits.

iv. Joint Authorship

The concept of joint authors is explained in terms of the ‘work of joint authorship’, which means a work produced by the collaboration of two or more authors in which the contribution of each author is inseparable from the contribution of the other author or authors.¹⁰⁰ Authors are not natural persons alone, but authors could include juristic persons.¹⁰¹

v. Unknown Authors

The copyright law recognises anonymous or pseudonymous literary, musical or artistic works. An anonymous author does not want his identity to be known, a pseudonymous author uses a false or fictitious name. In the case of anonymous or pseudonymous literary, musical or artistic works, the copyright is not based on the life of the author since it is impossible to know when the author dies as they are unknown. These works are protected under copyright and copyright in the works subsists until the end of the expiration of seventy years from the end of the year in which the work was first published. However, if the author

⁹⁹ Section 10 (4) CA 1988 Cap 28 LFN 2004.

¹⁰⁰ Section 51 (1) CA 1988 Cap 28 LFN 2004.

¹⁰¹ Section 2 (1) (ii) CA 1988 Cap 28 LFN 2004.

becomes known, the term of copyright shall be calculated in accordance with paragraph 1 of the First Schedule to this Act.¹⁰²

b. Ownership

As regards ownership of copyright, the Act vests initial ownership of copyright in the author,¹⁰³ except where the work is commissioned by a person who is not the author's employer under a contract of service of apprenticeship;¹⁰⁴ or, in the case of a work not having been so commissioned, the work is made in the course of the author's employment¹⁰⁵ stipulated in writing under contract.¹⁰⁶ Also, where a literary, artistic or musical work is made by the author in the course of his employment under a contract of service in a newspaper, magazine or similar periodical company the ownership of the work made by the author resides in the company or proprietor unless there is an agreement to the contrary.¹⁰⁷

The Act also permits joint ownership of a work if they possess a joint interest in the whole or any part of a copyright¹⁰⁸ or they own interest in the various copyrights in a composite production that is a production consisting of two or more works.¹⁰⁹

i. Commissioned Works

The general rule is that copyright is vested in the author who is the first owner of copyright. This position of the law, however, may be varied by contract where the work is commissioned. A work is commissioned where the commissioner, prior to the creation of the work, agrees in writing that the ownership of the work will reside in the commissioner and not the author.¹¹⁰ Contractual agreements on ownership of copyright have to be well drafted to eliminate doubt, as can be seen in the case of *Cyprotex Discovery Ltd v University*

¹⁰² The term of protection will become for the life of the author and seventy years except for photographic works.

¹⁰³ Section 10 (1) CA 1988 Cap 28 LFN 2004.

¹⁰⁴ Section 10 (2) (a) CA 1988 Cap 28 LFN 2004.

¹⁰⁵ Section 10 (2) (b) CA 1988 Cap 28 LFN 2004.

¹⁰⁶ Section 10 (2) CA 1988 Cap 28 LFN 2004.

¹⁰⁷ Section 10 (3) CA 1988 Cap 28 LFN 2004.

¹⁰⁸ Section 11 (6) (a) CA 1988 Cap 28 LFN 2004.

¹⁰⁹ Section 11 (6) (b) CA 1988 Cap 28 LFN 2004.

¹¹⁰ *Ojukwu v Anambra Motor Manufacturing Co.* Suit No. FHC/E/17/92.

of *Sheffield*.¹¹¹ The court found that the issue of copyright ownership was not addressed in the agreement, rather the clause that was supposed to address ownership only set out a complete code to be applied to all works created in the course of the project and was held it should be construed at that level of generality.

ii. Works created in the Course of Employment.

The general rule applies to work made in the course of an employment as well.¹¹² Thus, copyright in a work made by an employee belongs to the employer. Work in this classification relates to employee/employer relationship, which is that the employee must be employed under a contract of employment. For the sake of argument it may be said that an employee who is employed to create and uses the employer's facilities and material in the creation of a work still gets to keep the ownership of the work. This provision, however, may be overcome by a contractual agreement stipulated in writing by the parties.¹¹³ Oral agreements between the parties may not serve the purpose of constituting a contract to transfer ownership.¹¹⁴ Generally, it is understood that mutuality of the obligation and control are two major factors to be considered in an employee employer relationship.¹¹⁵ This requirement is, however, not conclusive as can be seen in *Community for Creative Non-Violence v Reid*.¹¹⁶ The Community for Creative Non-Violence (CCNV) and one of its trustees entered into an oral agreement with respondent Reid (a sculptor) to produce a statue dramatising the plight of the homeless for display at a Christmas pageant. CCNV paid several visits to check the progress and also gave suggestions and directions, which Reid accepted. Reid finished the sculpture and the final installment was paid. Copyright in the sculpture was never discussed by the parties, who then filed competing copyright registrations. The District Court decided in favour of CCNV holding that the statue was a 'work made for hire' vesting copyright ownership of works for hire in the person for whom

¹¹¹ [2004] EWCA Civ 380.

¹¹² Section 10 (1) CA 1988 Cap 28 LFN 2004.

¹¹³ Section 10 (2) proviso CA 1988 Cap 28 LFN 2004.

¹¹⁴ *Community for Creative Non-Violence v Reid* 490 U.S. 730 (1989).

¹¹⁵ Lionel Bently and Brad Sherman p.129.

¹¹⁶ 490 U.S. 730 (1989).

the work is prepared. The Court of Appeals reversed the decision, holding that the sculpture was not a ‘work made for hire’.

The Supreme Court, in determining whether a hired party is an employee, held that the general common law of agency should be considered to determine whether a work is made for hire and the hiring party's right to control the manner and means by which the product is accomplished. The court examined other factors as well, such as the skill required, the source of the instrumentalities and tools, the location of the work, the duration of the relationship between the parties, whether the hiring party has the right to assign additional projects to the hired party, the extent of the hired party's discretion over when and how long to work, the method of payment, the hired party's role in hiring and paying assistants, whether the work is part of the regular business of the hiring party, whether the hiring party is in business, the provision of employee benefits, and the tax treatment of the hired party. The Court further stated that no single one of these factors is determinative¹¹⁷ and held that the hire party was an independent contractor

An author of a literary, artistic or musical work under a contract of service or apprenticeship who makes a work in the course of his employment by a proprietor of a newspaper, magazine or any publishing company will not be considered to be the owner of the work but the said proprietor, in the absence of any agreement to the contrary, shall be the first owner of copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical or to the reproduction of the work for the purpose of its being so published. This is an exception to the general rule and is limited to the publication or reproduction of the work that relates to any newspaper, magazine or similar periodical. And, thereafter, gives back to the author the right of ownership in the copyright work in all other respects.¹¹⁸

In the case of a cinematograph film or sound recording, the author who is usually the producer, is required, prior to the making of the work, to conclude contracts in writing with

¹¹⁷ The court cited the Restatement 220(2) which sets out a non-exhaustive list of factors relevant to determining whether a hired party is an employee and *Hilton Int'l Co. v. NLRB*, 690 F.2d 318, 321.

¹¹⁸ Section 10 (3) proviso CA 1988 Cap 28 LFN 2004.

all those whose works are to be used in the making of the work in order to resolve where ownership will reside.¹¹⁹ Government owns the first copyright in works created on behalf of the Federal Republic of Nigeria or state authority as the case may be. Government ownership of copyright covers all works done by an employee of government, whether this provision can be varied by contract is not mentioned in the Act. The law also provides that works created by international bodies are owned by the international body.

4.2.2.4 Duration of Copyright Protection

The duration of the protection of a copyrighted work is not perpetually conferred on the author¹²⁰ but it is a 'generous one'.¹²¹ The term of protection of copyright begins when a work is fixed in a definite medium of expression; however, the term is usually calculated from the end of the year when the work was first published or made. There is no uniform term of protection for all copyright works; the term of protection varies depending on the type of work. The protection for literary, musical or artistic works, other than photographs, endures for a period of seventy (70) years after the end of the year in which the author dies. In the case of works made by government or a body corporate, protection is granted for seventy (70) years after the end of the year in which the work was first published. The term for cinematograph films and photographs endures for fifty (50) years after the end of the year in which the work was first published. Protection for sound recordings lasts for fifty (50) years after the end of the year in which the recording was first made. Protection for broadcasts persists for fifty (50) years after the end of the year in which the broadcasting first took place.¹²²

In the case of copyright in anonymous or pseudonymous literary, musical or artistic works, the copyright therein shall subsist until the end of the expiration of seventy years from the end of the year in which the work was first published.¹²³ However, if the author becomes known, the term of copyright shall be calculated in terms of the life of the author. Regarding

¹¹⁹ Section 10 (4) proviso CA 1988 Cap 28 LFN 2004.

¹²⁰ Adebambo Adewopo *Nigerian Copyright System, Principles and Perspectives Foundation of Nigerian Copyright Law* Odade Lagos 2012 p. 24.

¹²¹ OH, Dean. *Hand Book on South African Copyright Law* Juta Cape Town 2012 p. 1-49.

¹²² See generally the First Schedule CA 1988 Cap 28 LFN 2004.

¹²³ Section 2 (3) CA 1988 Cap 28 LFN 2004.

works of joint authorship, reference to the death of the author shall be taken to refer to the author who dies last,¹²⁴ whether or not he is a qualified person as required by the law.¹²⁵

4.2.2.5 Scope of Copyright Protection

The scope of copyright extends to all the types of medium into which the work can be put in definite form. These rights include the right to do and the right to authorise permitted acts, thereby giving the owner exclusive right to control the reproduction of the work. These rights include publication of the work; performance of the work in public; production, reproduction, performance or publication of the any translation of the work; and the making of any cinematograph film or a record in respect of the work. The rights also include distribution of copies of the work to the public for commercial purposes by way of rental, lease, hire, loan or similar arrangement as well as to broadcast or communicate the work to the public by a loud speaker or any other similar device. The owner of copyright can make an adaptation and translation of the work, as well as do any of the acts specified in relation to the work according to section 6 (1) sub-paragraphs (i) to (vii) of this paragraph as it relates to literary or musical work.¹²⁶ For this reason, copyright is referred to as a bundle of rights. Some of these exclusive rights will be examined below.

a. Right of Reproduction

The right of reproduction cuts across the various works and it is regarded as the oldest of the rights granted to the copyright owner.¹²⁷ This right is one of the exclusive rights bestowed on the copyright owner. Known as the heart of copyright,¹²⁸ it is the right exercised by reproducing the work in any material form¹²⁹ or in any form derived from the original.¹³⁰ This right allows the copyright owner to prevent the reproduction of the copyright work by any unauthorised person. Prior to the 1967 revision of the Berne Convention, this right was

¹²⁴ Section 2 (4) CA 1988 Cap 28 LFN 2004.

¹²⁵ See section 21 CA 1988 Cap 28 LFN 2004.

¹²⁶ Section 6 (1) (a) (i-ix) CA 1988 Cap 28 LFN 2004.

¹²⁷ Lionel Bently and Brad Sherman p.138.

¹²⁸ Richard A. Spinello & Maria Bottis *A Defense of Intellectual Property Rights* Edward Elgar Publishing Cheltenham 2009 p.89.

¹²⁹ Section 6 (1) (a) (i); section 6 (1) (b) (i); section 6 (1) (c) (i) CA 1988 Cap 28 LFN 2004.

¹³⁰ Section 7 (1)_(a); section 8 (1) (a) CA 1988 Cap 28 LFN 2004.

only ‘recognised in principle’ by member countries.¹³¹ The Act does not define the term reproduction however: reproduction comprises different forms of non-literary copying.¹³² Accordingly, authors of literary, musical and artistic work in the Act have the exclusive right to reproduce the work in any material form. ‘Any material form’ encompasses a wide range of methods of multiplication, such as design, engraving, lithography, offset and all other printing processes, typesetting, photocopying and mechanical or magnetic recording (discs, cassettes, magnetic tape, films, microfilms, etc. including all process now known or later discovered.¹³³ In the case of cinematograph works the exclusive right provides the right to make copies of the work, for sound recordings the exclusive right of reproduction can be direct or indirect reproduction of the whole or a substantial part of the recording, either in its original form or in any form recognisably derived from the original. For broadcast the exclusive right relates to the recording and the re-broadcast of the whole or a substantial part of the broadcast.

The right of reproduction is sometimes called the right to copy as reproduction and copying are synonyms. But, the concept of reproduction has been distinguished from copying. Leaffer notes, reproduction takes place when the work is copied in a material object whereas copying is wider as it can take place without fixing the work.¹³⁴ In recent times this right has been subject to various debates, especially in relation to digital works. The 1996 WIPO Treaties (WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT)) clarified the scope of the reproduction right, particularly in relation to copyright works and phonograms in the digital environment.¹³⁵ These WIPO Treaties confirm that the right applies to works in digital form.¹³⁶

¹³¹ WIPO, *Guide to the Berne Convention Berne Convention for the Protection of Literary and Artistic Works* (Paris Act 1971) WIPO Publication No. 615E para 9.1 p. 54.

¹³² William van Caenegem *Intellectual Property Law in Australia* Kluwer Law International BV The Netherlands 2010 p. 43.

¹³³ WIPO, *Guide to the Berne Convention Berne* para 9.2 p. 54.

¹³⁴ Marshall Leaffer, *Understanding Copyright Law* 2011 5th ed. Matthew Bender LexisNexis p. 304-305

¹³⁵ IFPI, *The WIPO Treaties: Reproduction Right* March 2003 <http://www.ifpi.org/content/library/wipo-treaties-reproduction-right.pdf> accessed 16 May 2014.

¹³⁶ *Agreed statement concerning Article 1(4) WCT:*

The reproduction right, as set out in Article 9 of the Berne Convention, and the exceptions permitted thereunder, fully apply in the digital environment, in particular to the use of

b. Right to Publish the Work

This right literally gives the author the right to publish the work he has created. This right is also known as the primary right.¹³⁷ This right is important as it is used to determine the duration of copyright; the year of the publication of a work is used to determine the term of protection of works such as photography, cinematography film, sound recording and broadcast, as well as anonymous and pseudonymous works. The Act gives exclusive right to the copyright owner in literary,¹³⁸ musical¹³⁹ and artistic¹⁴⁰ works of the right to publish the work. This right entails the reproduction of the work as well as the supply of the work to the public in a perceivable mode.¹⁴¹ In the case of a cinematograph film a work is published if the film, in so far as it consists of visual images, is to be seen in public; whereas publication of sound recordings and broadcast requires the work to be broadcast or communicated to the public. This right permits the copyright owner to prevent unauthorised publication of a work. The right to publish, thus, is an exclusive right to disseminate the work to the public.

c. Perform the Work in Public

Another exclusive right conferred on the copyright owner is the right to perform the work in public.¹⁴² This right is also called the performing right¹⁴³ and it is the third right in the Berne Convention. The right applies to literary and musical works.¹⁴⁴ Accordingly, the author has the right to authorise the public performance of the work, such as live performances as well

works in digital form. It is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of the Berne Convention; Agreed statement concerning Articles 7, 11 and 16 WPPT: The reproduction right, as set out in Articles 7 and 11, and the exceptions permitted thereunder through Article 16, fully apply in the digital environment, in particular to the use of performances and phonograms in digital form. It is understood that the storage of a protected performance or phonogram in digital form in an electronic medium constitutes a reproduction within the meaning of these Articles.

¹³⁷ Stephen Fisherman *The Copyright Handbook: What Every Writer Needs to Know* 11th ed. Nolo Publisher California 2011 p.225.

¹³⁸ Section 6 (1) (a) (ii) CA 1988 Cap 28 LFN 2004.

¹³⁹ Section 6 (1) (a) (ii) CA 1988 Cap 28 LFN 2004.

¹⁴⁰ Section 6 (1) (b) (ii) CA 1988 Cap 28 LFN 2004.

¹⁴¹ Mark J. Davison, Ann L. Monotti & Leanne Wiseman, *Australian Intellectual Property Law* Cambridge University Press 2008 p. 215.

¹⁴² Section 6 (1) (b) (iii) CA 1988 Cap 28 LFN 2004.

¹⁴³ Lionel Bently and Brad Sherman p.146.

¹⁴⁴ Section 6 (1) (b) (iii) CA 1988 Cap 28 LFN 2004.

as aural and visual performances of the work.¹⁴⁵ It is important to note that this right relates only to performance that is done in public, therefore a performance done in private may not be included as part of this right. The Act does not define what a performance in public is, however, the third circuit court established in *Columbia Pictures Indus v. Aveco, Inc.*,¹⁴⁶ that public performance ‘does not require that the public place be actually crowded with people. A telephone booth, a taxi cab, and even a pay toilet are commonly regarded as ‘open to the public,’ even though they are usually occupied only by one party at a time’. Therefore a place would be regarded as public if the general public have access to the place.

d. Right to Translation the Work

The right of the copyright owner to translate a work includes producing, reproducing, performing or publishing.¹⁴⁷ This right permits the copyright owner to prohibit the translation of unauthorised copies of a work. The right relates to literary or musical work,¹⁴⁸ which is logical considering the fact that these are the works that can really be changed. Hence, ‘translation means the expression of a work in a language other than that of the original version’¹⁴⁹ based upon a pre-existing work. For example, Chinua Achebe’s *Things Fall Apart* has been translated into over fifty languages but the story remains the same in a book. The author of the work has the right to authorise the translation of the work into any language to which he consents.

e. Right to make an Adaptation of the Work

The exclusive right to adapt a work protected by copyright relates to literary, musical¹⁵⁰ and artistic work.¹⁵¹ This right allows the copyright owner to prevent the adaptation of unauthorised copies of a work. The Act defines ‘adaptation’ to mean the modification of a pre-existing work from one genre of work to another and also consists of altering a work within the same genre to make it suitable for different conditions of exploitation, which may

¹⁴⁵ Davison J *et al* p. 225.

¹⁴⁶ 800 F2d 59, 63 (3d Cir. 1986).

¹⁴⁷ Section 6 (1) (b) (iv) CA 1988 Cap 28 LFN 2004.

¹⁴⁸ Section 6 (1) CA 1988 Cap 28 LFN 2004.

¹⁴⁹ WIPO, *Understanding Copyright and Related Rights* WIPO Publication No 909 E Genève p.12.

¹⁵⁰ Section 6 (1) (a) (viii) CA 1988 Cap 28 LFN 2004.

¹⁵¹ Section 6 (1) (b) (iv) CA 1988 Cap 28 LFN 2004.

also involve altering the composition of the work.¹⁵² Examples of adaptation are: adapting a novel to make a film, taking a picture of a portrait, adapting a novel into a comic to make it easy to read or making a portrait into a sculpture. As a result the right of the copyright owner is extended beyond the expression of ideas.¹⁵³

f. Right to Distribute to the Public

The right to distribute gives the copyright owner the exclusive right to make a work available to the public by sale, rental, lease, lending, or similar arrangement¹⁵⁴ and, at the same time, grants the right to prevent the distribution of unauthorised copies of a work. Accordingly sale, rental, lease, lending, or similar arrangements are all forms of commercial distribution of the work to the public. Although this right allows the copyright owner to control the first distribution of the work, the right is limited by the ‘first sale doctrine’ which provides after the first sale or distribution of a copy of the work, that the copyright owner can no longer control what happens to that copy or copies as the case may be. For example, if a book (the first sale of a copy), has been bought in a book shop, the copyright owner can no longer control how the book is further distributed. Thus, the book could be rented or resold without the permission of the copyright holder.

g. Right to Communicate the Work to the Public

Apart from the right to reproduce, perform, publish and distribute, the copyright owner has the prerogative to communicate the work to the public. The Act defines ‘communication to the public’ to include, any live performance or delivery, any mode of visual or acoustic presentation, but does not include a broadcast or re-broadcast. As a result, the copyright owner can prevent the communication of the work to the public without his authorisation. This right, like the right of publication, is a determining factor for the duration of the copyright. If a work is stolen and communicated to the public it may be argued since the work was not been communicated to the public by the owner of the work, which copyright

¹⁵² Section 51 CA 1988 Cap 28 LFN 2004.

¹⁵³ Mark J. Davison, Ann L. Monotti & Leanne Wiseman, *Australian Intellectual Property Law* Cambridge University Press 2008 p. 227.

¹⁵⁴ Section 6 (1) (a) (vi) CA 1988 Cap 28 LFN 2004; Section 6 (1) (c) (iv) CA 1988 Cap 28 LFN 2004; Section 7 (1) (b) CA 1988 Cap 28 LFN 2004.

has not yet begun and will begin only when the work is communicated by the owner.¹⁵⁵ In addition, the right allows the copyright holder to control the distribution of the work and prevent unauthorised distribution.

4.2.2.6 Moral Rights in respect of Copyright Works

In addition, the Act provides that the author of a copyrighted work has the right to claim authorship of his work and, in particular, that he should be indicated as the author in connection with any of the acts referred to in section 6¹⁵⁶ of this Act, except where the work is incidentally or accidentally included in reporting current events by means of broadcasting.¹⁵⁷ The author has moral rights in respect of the work, that is, the right to raise objection and to ‘seek relief in connection with any distortion, mutilation or other modification of, and any other derogatory action in relation to, his work where such action would be or is prejudicial to his honour or reputation.’¹⁵⁸ In *Onojovwo v Daily times*¹⁵⁹ the court held despite the fact that the newspaper article was made in the course of employment and made for the plaintiff’s employer and the newspaper owner, that the first owner of copyright, the plaintiff, still had an action for moral rights different from economic rights.

¹⁵⁵ This argument may however relate to photographs, cinematograph films, government or a body corporate works, sound recordings, broadcast and anonymous or pseudonymous literary, musical or artistic works only.

¹⁵⁶ Section 6 (a) in the case of a literary or musical work, to do and authorise the doing of any of the following acts-

- (i) reproduce the work any material form; (ii) publish the work; (iii) perform the work in public; (iv) produce, reproduce, perform or publish any translation of the work; (v) make any cinematograph film or a record in respect of the work; (vi) distribute to the public, for commercial purposes, copies of the work, by way of rental, lease, hire, loan or similar arrangement; (vii) broadcast or communicate the work to the public by a loud speaker or any other similar device; (viii) make an adaptation of the work; (ix) do in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-paragraphs (I) to (vii) of this paragraph;
- (b) in the case of an Artistic work, to do or authorise the doing of any of the following acts, that is-
 - (i) reproduce the work in any material form, (ii) publish the work. (iii) include the work in any cinematograph film, (iv) make an adaptation of the work, (v) do in relation to an adaptation of the work in subparagraphs (I) to (iii) of this paragraph;
- (c) in the case of cinematograph film, to do or authorise the doing of any of the following acts, that is-
 - (i) make a copy of the film, (ii) cause the film, in so far as it consists of visual images to be seen in public and, in so far as it consists of sounds, to be heard in public, (iii) make any record embodying the recording in any part of the sound track associated with the film by utilising such sound track, (iv) distribute to the public, for commercial purposes copies of the work, by way of rental, lease, hire, loan or similar arrangement.

¹⁵⁷ Section 12 (a) CA 1988 Cap 28 LFN 2004.

¹⁵⁸ Section 12 (b) CA 1988 Cap 28 LFN 2004.

¹⁵⁹ FHC/L/CS/98/93 Unreported case.

4.2.2.7 Neighbouring Rights

Part II of the Act protects neighbouring rights, such as performances. These are rights that are associated with copyright. These related rights give exclusive control over performance, recording, broadcasting live, as well as reproducing, in any material form and adaptation of the performance.¹⁶⁰ Performances endure for fifty years from the end of the year in which the performance first took place.¹⁶¹

Expressions of folklore are granted protection under the Nigerian Copyright Act.¹⁶² They are protected against reproduction, communication to the public by performance, broadcasting, distribution by cable or other means, adaptation, translation and other transformations, when such expressions are made either for commercial purposes or outside their traditional or customary context.¹⁶³

The administration of copyright in Nigeria is overseen by the Nigeria Copyright Commission.¹⁶⁴ The Commission is responsible for all matters affecting copyright in Nigeria as provided for in the Act.¹⁶⁵

4.3 Nigerian Copyright Law and TRIPS Agreement: Compliance

The objective in this section is to determine the extent of Nigerian's compliance with its international obligation by comparing the Nigerian copyright laws with the respective provisions of the TRIPS Agreement on copyright. The structure of this section is arranged in accordance with the presentation of the provisions in the TRIPS Agreement. The TRIPS Agreement adopted the various intellectual property Conventions, which include the Berne Convention, the Rome Convention and the Paris Convention. Before comparing the scope of protection under the Copyright Act and the TRIPS Agreement, it is beneficial to have an understanding of the Berne Convention to provide an assessment of the impact of the TRIPS

¹⁶⁰ Section 26 (1) (a-e) CA 1988 Cap 28 LFN 2004.

¹⁶¹ Section 27 CA 1988 Cap 28 LFN 2004.

¹⁶² Section 31 (1) CA 1988 Cap 28 LFN 2004.

¹⁶³ Section 31 (1) (a-c) CA 1988 Cap 28 LFN 2004.

¹⁶⁴ Section 34 (1) CA 1988 Cap 28 LFN 2004; See as well Adebambo Adewopo, *Nigerian Copyright System, Principles and Perspectives Foundation of Nigerian Copyright Law* Odade Lagos 2012 p. 11.

¹⁶⁵ F.O Babafemi, *Intellectual Property. The Law and Practice of Copyright, Trade Marks, Patent and Industrial Design in Nigeria* Justinian Ibadan 2007 p.6.

Agreement. The purpose of this overview is to highlight certain provisions of the Berne Convention which are going to be used to determine the meaning of certain provisions of the TRIPS Agreement for this research. Particularly in relation to article 9.1 of the TRIPS Agreement reference will be made to the Berne Convention, the reason for which is proffered below.

4.3.1 Relationship of the TRIPS Agreement to the Berne Convention and Protected Works

Article 2.2 of the TRIPS Agreement provides as follows:

Nothing in Parts I to IV of this Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

The TRIPS Agreement clarified that members still owe the same obligation to one another as provide under the Conventions. Thus, members of the Berne Convention are still obliged to one another. In addition, article 9.1¹⁶⁶ provides that members shall comply with articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. The rationale behind this article¹⁶⁷ has been described in two ways: firstly, to incorporate the Convention and, secondly, to express the intention of the parties to the TRIPS Agreement.¹⁶⁸ The importance of this provision relates to the potential of bringing the Berne Convention under the WTO Dispute Mechanism and by so doing, make the Convention enforceable and compel the provisions of the Berne Convention to be applicable to non-Union members of the WTO.¹⁶⁹ In addition, the TRIPS Agreement aspires to attain contemporary heights of protection which

¹⁶⁶ TRIPS Agreement.

¹⁶⁷ Article 9 TRIPS Agreement.

¹⁶⁸ Yusuf A. Abdulqawi 'TRIPS: background, principles and General Provisions' in Carlos Correa and Abdulqawi Yusuf (Eds) *Intellectual Property and International Trade The TRIPS Agreement*. Kluwer Law International BV The Netherlands 2008 p. 20.

¹⁶⁹ Gervais, Daniel, *The TRIPS Agreement Drafting History and Analysis* 4th edition Sweet and Maxwell Croydon 2012 para 2.135 p. 244; see also Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds) *WTO Trade Related Aspect of Intellectual property Rights* Max Planck Commentaries on World Trade Law, 7 Marinus Nijhoff Publishers Leiden Boston 2009 p. 209.

place copyright on an advanced path.¹⁷⁰ This provision makes it explicit that all existing obligations under the Convention are to be maintained.¹⁷¹

The selection of articles 1 through 21 of the Berne Convention seems deliberate as they contain the material provisions in the Convention. The other provisions are administrative, a role taken over by the WTO. The fact that article 21 is included and does not end at article 20 sends a signal to developing countries that they no longer have a free ride. Its inclusion necessitated the inclusion of the appendix in the provision. At the same time the article makes it clear that members are not obliged to confer moral rights.¹⁷²

4.3.2 The Berne Convention

The Berne Convention is regarded as the ‘largest and most important international copyright Convention’.¹⁷³ The intent of this Convention was to regulate and harmonise copyright provisions among European countries.¹⁷⁴ The aim of the Convention was for nationals to enjoy protection in all signatory countries.¹⁷⁵ This protection operates for the benefit of the author and his successors in title as provided for in the article. Even though the Convention was initiated by European countries and extended to their colonies,¹⁷⁶ on attaining independence they were regarded as countries that had to assent to the Convention to be part of the Union: membership was not automatic by being a former colony. Thus, Nigeria acceded to the Berne Convention June 10, 1993 and it entered into force September 14, 1993.

The fundamental attributes of the Berne Convention are provided for in article 5.¹⁷⁷ The hallmark of the Convention is in the first paragraph which makes clear that authors’ works will be protected in all countries of the Union and the enjoyment of such rights are not

¹⁷⁰ Martin Woodward. ‘TRIPS and 'NAFTA's Chapter 17: How Will Trade-Related Multilateral Agreements Affect International Copyright?’ 31 *Texas International Law Journal* 269 1996.

¹⁷¹ Article 2.2 TRIPS Agreement.

¹⁷² Article 6bis Berne Convention.

¹⁷³ Marshall Leafer, *Understanding Copyright Law* 2011 5th ed. Matthew Bender LexisNexis p.11 The Berne Convention for the Protection of Literary and Artistic Works adopted September 9, 1886.

¹⁷⁴ Lionel Bentley Brad Sherman *Intellectual Property Law* 2002 Oxford University Press Oxford p. 34.

¹⁷⁵ Article 2 (6) Berne Convention 1886, as amended on September 28 1979.

¹⁷⁶ Order in Council No. 912 dated 24th June 1912.

¹⁷⁷ *Guide to the Berne Convention Berne Convention for the Protection of Literary and Artistic Works* (Paris Act 1971) WIPO Publication No. 615E para 5.1 p.32.

dependent on the domestic laws,¹⁷⁸ a process known as the principle of ‘national treatment’,¹⁷⁹ and is regarded as the most important provision of the original Berne Convention.¹⁸⁰

Another highlight of the Convention is ‘automatic international protection’ as the enjoyment of the right is rid of formalities,¹⁸¹ which would include conditions or administrative obligations laid down by domestic laws,¹⁸² such as registration of the rights, placing the © sign on the work and notification as required in the Universal Copyright Convention. In addition, the extent of protection shall be governed exclusively by the laws of the country where protection is claimed.¹⁸³ However, it should be noted that the Berne Convention offers no protection: protection is provided by the country of origin of the work where the author is a national of that country.¹⁸⁴

4.3.3 Copyright Act 1988 and Article 9 of the TRIPS Agreement

Having examined the Act in detail in the previous section, this section examines only the provisions of Articles 9 to 14 of the TRIPS Agreement particularly in relation to the Act’s compliance with the TRIPS Agreement. The discussion in this section is structured according to the provisions of the TRIPS Agreement. Therefore, it should be noted that article 9 of the TRIPS Agreement, which incorporates articles 1 through 21 of the Berne Convention, will be discussed as a collective whole. As a result the sequence of discussion may not follow a contemporary format.

¹⁷⁸ Article 5(1) Berne Convention.

¹⁷⁹ This principle is well defined in Article 3.1 TRIPS Agreement

‘Each member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection (3) of intellectual property, subject to the exceptions already provided in, respectively, the Paris Convention (1967), the Berne Convention (1971), the Rome Convention or the Treaty on Intellectual Property in Respect of Integrated Circuits’.

¹⁸⁰ Gervais, Making Copyright Whole p.7.

¹⁸¹ Article 5 (2) Berne Convention.

¹⁸² WIPO Guide to the Berne Convention of 1971 para 5.5 p.33.

¹⁸³ Article 5 (2) Berne Convention.

¹⁸⁴ WIPO Guide to the Berne Convention of 1971 para 5.9 p.34; See also Anne Moebes, ‘Negotiating International Copyright Protection: The United States and European Community Positions,’ 14 *Loyola of Los Angeles International and Comparative Law Review* 301, 301 (1992).

4.3.3.1 Article 9.1 of the TRIPS Agreement

Article 9.1 merely provides that Articles 1 through 21 of the Berne Convention (1971) and the Appendix shall be complied with by all members. Thus, the question is: what do members have to accomplish compliance with Articles 1 through 21 of the Berne Convention (1971) and the Appendix.

The provisions of the Berne Convention which members have to comply with relate to the following:

Article 1:	Establishment of a Union
Article 2:	Protected Works
Article 2 <i>bis</i> :	Possible Limitation of Protection of Certain Works
Article 3:	Criteria of Eligibility for Protection
Article 4:	Criteria of Eligibility for Protection of Cinematographic Works, Works of Architecture and Certain Artistic Works
Article 5:	Rights Guaranteed
Article 6:	Possible Restriction of Protection in Respect of Certain Works of Nationals of Certain Countries outside the Union
Article 7:	Term of Protection
Article 7 <i>bis</i> :	Term of Protection for Works of Joint Authorship
Article 8:	Right of Translation
Article 9:	Right of Reproduction
Article 10:	Certain Free Uses of Works
Article 10 <i>bis</i> :	Further Possible Free Uses of Works
Article 11:	Certain Rights in Dramatic and Musical Works
Article 11 <i>bis</i> :	Broadcasting and Related Rights
Article 11 <i>ter</i> :	Certain Rights in Literary Works
Article 12:	Right of Adaptation, Arrangement and Other Alteration
Article 13:	Possible Limitation of the Right of Recording of Musical Works
Article 14:	Cinematographic and Related Rights
Article 14 <i>bis</i> :	Special Provisions Concerning Cinematographic Works
Article 14 <i>ter</i> :	“ <i>Droit de suite</i> ” in Works of Art and Manuscripts
Article 15:	Right to Enforce Protected Rights
Article 16:	Infringing Copies
Article 17:	Possibility of Control of Circulation, Presentation and Exhibition of Works
Article 18:	Works Existing on Convention’s Entry Into Force
Article 19:	Protection Greater than Resulting from Convention
Article 20:	Special Agreements among Countries of the Union
Article 21:	Special Provisions Regarding Developing Countries.

Notably, article *6bis* of the Berne Convention which relates to moral rights, is absent from the list as members are not under any obligation to confer the right derived therefrom.¹⁸⁵ To avoid repetition of what has been discussed in the previous section in which most of the issues have been dealt with, a summary of the compliance or not, as the case may be, will be carried out.

4.3.3.2 An Examination of Compliance of the Copyright Act with Article 9

In compliance with the TRIPS Agreement, Nigeria is a member of the Union to whom the Berne Convention applies. Under the article 9, it is compulsory for members of the WTO that are not members of the Union to adhere to the provisions of the Berne Convention.¹⁸⁶

Article 2 of the Berne Convention relates to the type of work that is protected, that is literary and artistic works;¹⁸⁷ the requirement of fixation;¹⁸⁸ derivative works;¹⁸⁹ official texts;¹⁹⁰ collections; the obligation to protect beneficiaries of works;¹⁹¹ works of applied art and industrial designs;¹⁹² and the news of the day.¹⁹³ All these are areas protected under the Copyright Act as discussed in the previous section. Section 1 of the Act provides a blanket cover for literary, musical, or artistic works provided they are original in character and fixed in any definite medium of expression now known or later to be developed.

Articles 3 and 4 of the Berne Convention provides the criteria of eligibility for protection As mentioned earlier the criteria for protection under the Act are based on the nationality of the author, the place of publication and the residence of the author at the time of publication. The author must qualify as an individual who is a citizen of, or is domiciled in Nigeria; or a body corporate, incorporated under the laws of Nigeria.¹⁹⁴ The extension of eligibility to body

¹⁸⁵ Article 9.1 TRIPS Agreement.

¹⁸⁶ Article 1 Berne Convention (Article 9 .1 TRIPS Agreement).

¹⁸⁷ Literary and artistic works are protected under section 1 CA 1988 Cap 28 LFN 2004.

¹⁸⁸ Requirement of fixation – see section 1 (2) CA 1988 Cap 28 LFN 2004.

¹⁸⁹ Derivative works are protected under section 5, 6 and 7. CA 1988 Cap 28 LFN 2004.

¹⁹⁰ Official texts are protected under section 4 CA 1988 Cap 28 LFN 2004.

¹⁹¹ Obligation to protect beneficiaries see section 5 and 41 CA 1988 Cap 28 LFN 2004.

¹⁹² Works of applied art and industrial designs excluded under section 1 (3) CA 1988 Cap 28 LFN 2004.

¹⁹³ Para (n) Second Schedule CA 1988 Cap 28 LFN 2004.

¹⁹⁴ Section 2(1) CA 1988 Cap 28 LFN 2004.

corporate came after the 1999 amendment of the Copyright Decree.¹⁹⁵ Corporate entities of other countries that have treaty obligations with Nigeria are granted copyright protection as well.¹⁹⁶

Copyright is conferred on every work made by or under the direction or control of the Government, a State authority or prescribed international body that is eligible for copyright.¹⁹⁷

Eligibility is also determined by reference to international agreements and obligations. Thus, if a work is first published in a country which has treaty obligations with Nigeria or is a party to an international agreement to which Nigeria is also a party, such party shall enjoy copyright protection in Nigeria.¹⁹⁸ This provision is partly similar to article 3.1 of the Berne Convention. The difference is that the Act¹⁹⁹ does not expressly mention the inclusion of unpublished works, but specifically mentions the first publication of the work thereby clearly excluding unpublished works. ‘Published works’ as defined in the Berne Convention means ‘works published with the consent of their authors, whatever may be the means of manufacture of the copies, provided that the availability of such copies has been such as to satisfy the reasonable requirements of the public, having regard to the nature of the work’.²⁰⁰ The Nigerian Act provides that a work will be deemed published if copies of the work have been made accessible to the public.²⁰¹ According to the Act, a publication in any treaty country shall be regarded as the first publication in Nigeria provided the earlier publication elsewhere and the subsequent publications in Nigeria took place within a period of not more

¹⁹⁵ Amendment of 1988 No. 47. Cap. 68 LFN. 1992 No. 98 Copyright (Amendment) Decree No 42 of 1999.

¹⁹⁶ Section 5 CA 1988 Cap 28 LFN 2004.

¹⁹⁷ Section 4 CA 1988 Cap 28 LFN 2004.

¹⁹⁸ *Microsoft Corporation v Franike Associates Ltd.*, Suit No. FHC/L/CS/610/05 and Suit No: CA/L/573/2008.

¹⁹⁹ Article 3.1 of the Berne Convention provide thus The protection of this Convention shall apply to:
 (a) authors who are nationals of one of the countries of the Union, for their works, whether published or not;
 (b) authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a Country of the Union.

²⁰⁰ Article 3.3 Berne Convention.

²⁰¹ Section 51 (2) (a) CA 1988 Cap 28 LFN 2004.

than thirty days,²⁰² as similarly provided for in the Berne Convention for simultaneous publication.²⁰³

Section 3 (1) (a) of the Act extends protection to cinematographic works and artistic works, which include works of architecture. This provision is in compliance with article 4 of the Berne Convention.

Article 5 of the Berne Convention is the heart of the Convention. This provision deals with one of the most important doctrines relating to the application of treaties which is the principle of national treatment. Article 5.1 gives the author of a work in a country that is part of the convention protection in all the countries of the Union. This requires that foreigners be given the same protection for their works as nationals of a country and the rights given shall be automatically bestowed without formalities. Clearly, as noted above, sections 5 and 44 of the Act make the law consistent with the provisions of article 5 of the Berne Convention.

Article 6 of the Berne Convention relates to the restriction of protection regarding works of nationals of countries outside the Union: accordingly members are not required to protect such work. On this issue the Act merely provides for countries that are members of the Union and does not make reference to countries outside the Berne.²⁰⁴ This provision is fulfilled by the 1972 Copyright (Reciprocal Extension) Order which includes the names of countries²⁰⁵ to which Nigeria can extend protection.²⁰⁶ Although, this list may no longer be relevant after Nigeria became a member of the WTO as the TRIPS Agreement has extended protection to non-Union members.

Articles 7 and 7bis of the Berne Convention relate to the term of protection which is adequately provided for in the Act under section 2 and the second schedule of the Act. A

²⁰² Section 51 (2) (c) CA 1988 Cap 28 LFN 2004.

²⁰³ Article 3 (4) Berne Convention.

²⁰⁴ Section 41 CA 1988 Cap 28 LFN 2004.

²⁰⁵ The list included 57 countries in which the United States of America was one of the countries Nigeria should extend reciprocal protection too from as far back as 1972.

²⁰⁶ Public Notice U.S. Works are protected under Nigerian Copyright Act available at <http://www.copyright.gov.ng/index.php/public-notice/88-u-s-works-are-protected-under-nigerian-copyright-act> accessed 05 March 2013.

number of provisions in the Berne Convention provide for the nature of copyright protection in various works; the rights include the right to translation in article 8, the right to reproduction in article 9, right of public performance and of communication to the public of a performance in article 11, broadcasting and related rights in article 11*bis*, the right of public recitation and of communication to the public of a recitation in article 11*ter*, right of adaptation, arrangement and other alteration in article 12, cinematographic and related rights in article 14 and 14*bis*. Similar rights are also provided for in the Act in Nigeria which has been discussed above under the scope of copyright protection.

Droit de suite or resale rights in works of art and manuscripts are substantive provisions on copyright in the TRIPS Agreement. This right is provided for in the Act in section 13: this provision will be further examined below. Another right given to the author of a work is the right to be identified to be able to enforce the protection of the work.²⁰⁷ A similar provision is set out in section 12 of the Copyright Act giving the author the right to claim authorship of his work, in particular that his authorship be indicated in connection with any of the exclusive rights. Unlike the Berne Convention which makes reference to the right in relation to unpublished works as well as anonymous and pseudonymous works,²⁰⁸ the Act makes reference only to if the work has been published and it is not clear whether the right can be extended to unpublished, anonymous and pseudonymous works. Accordingly the Act is not in total compliance with what is expected under article 15 of the Berne Convention.

Free uses or exceptions to copyright protection are laid out in article 2*bis*, 10, 10*bis*, 13 and 17. These exceptions require that use is compatible with fair practice and does not exceed that justified by the purpose. These exceptions left it to the countries of the Union to decide to exclude, wholly or in part, or to determine the conditions under which they are used. Exceptions are generally provided for in the second and third schedule of the Act. Because they are part of the substantive provisions in the TRIPS Agreement they will be examined in full detail below under limitations and exceptions of copyright.

²⁰⁷ Article 15 Berne Convention.

²⁰⁸ Article 15 (4) (a) Berne Convention.

The seizure of infringing copies is required in article 16 of the Berne Convention. This provision is comparable to in section 25 of the Act which provides, where there is reasonable cause for suspecting that there is in any house or premises any infringing copy or any plate, film or contrivance used or intended to be used for making infringing copies or capable of being used for making infringing copies, that the Nigerian Police can enter such premises and seize, detain and preserve any such infringing copy or contrivance. Article 16 is further supported by article 61 of the TRIPS Agreement which requires members to put in place appropriate remedies such as seizure, forfeiture and destruction of the infringing goods and of any materials and implements predominantly used in the commission of the offence.

Article 18 of the Berne Convention relates to works protected when the Convention' entered into force. Accordingly, works that are not yet expired in the country of origin will still be protected and will not be protected if the work has expired. This provision is further buttressed by article 70 of the TRIPS Agreement. Members are not expected to extend protection to works of new members that are already in the public domain. Neither are they expected to grant longer protection where the other party grants less. The Act does not state the position of such work, however, in the transitional provision in the fifth schedule provides that 'this Act applies in relation to works made before the commencement of this Act as it applies in relation to works made after the commencement of this Act' which may mean the works created before will benefit from the same term of protection. Whether this provision will extend the life of works that have fallen into the public domain seems very unlikely. Considering the fact that Nigeria grants a term of protection of life plus 70 year and the required term of protection in the Berne Convention is life plus fifty years, countries which grant less should receive less. The Act does not make this provision clear and may not comply with the provisions of article 18. It is important that the protection granted to Treaty members are clearly set out.

In article 19 the Berne Convention gives countries the latitude to provide greater protection than is required in the Convention. In other words, countries are allowed to give greater protection to authors if they so wish. This provision was further reinforced in article 20 of the Berne Convention, which states that the Governments of the countries of the Union reserve

the right to enter into special agreements among themselves in so far as such agreements grant to authors more extensive rights than those granted by the Convention or do not contain provisions contrary to the Convention and that the provisions of existing agreements which satisfy these conditions shall remain applicable.

Article 21 relates to special provisions regarding developing countries which are included in the Appendix. It gives developing countries added flexibility than permitted in the Convention. In addition, this article makes articles 1 through 21 a package which members of the Union are to agree to as one.²⁰⁹ The importance of this package was further reiterated in article 9.1 of the TRIPS Agreement making it part of the WTO Agreement to which member countries have to adhere for compliance with the TRIPS Agreement.

4.3.3.3 Article 9.2: Exclude Subject Matter from Copyright Protection

On the subject matter excluded from protection, the Copyright Act does not state whether ideas are protectable or not.²¹⁰ The reason for the exclusion of ideas is its value in the act of creation, which necessitates that the free flow of idea should be enhanced.²¹¹ Although, ideas have not been clearly removed from protection in the Act, it has been stated in case law that the Act is not concerned with the originality of ideas but with the expression of thought and, in the case of literary works, with the expression of thought in print or writing. The originality which is required relates to the expression of the thought as is indicated in the case of *Yusufu Ladan v Sha Kallo Publication Company Limited and 2 others*.²¹² This position of the law is fundamental and has been long established and decided by case law in many jurisdictions.²¹³

For Albert care must however be taken with regards to this principles of copyright law as he notes that a person who merely provides ideas can be regarded as ‘co-owners of the copyright in the relevant work’ where there is an agreement or failing which ‘the context and

²⁰⁹ WTO Guide p.105

²¹⁰ Section 1 CA 1988 Cap 28 LFN 2004 cf See Section 202.1(a) US Copyright Statute; *Baker v Selden* 101 U.S. 99, 103 (1879).

²¹¹ Stephen M. McJohn *Copyright: Examples and Explanations*, 2nd ed. Aspen 2006 p79.

²¹² [1972] NCLR 428.

²¹³ *Beal v Paramount Pictures Corp.*, 20 F.3d 454, 458-59 (11th Cir.), cert. denied, 513 U.S. 1062 (1994); *Kenrick & Co v Lawrence & Co* [1890] LR 25 QBD99; *Baker v Selden*, 101 U.S. 99, 103 (1879).

manner in which someone's ideas are captured will have to be examined, and these considerations could determine whether the “physical” author will also be the “intellectual” author of the work.²¹⁴

Article 9.2 of the TRIPS Agreement further excludes from copyright protection procedures and methods of operation or mathematical concepts, although these subject matters are not specifically excluded in the Nigeria Act. In essence, it is left for the courts to decide whether or not these areas can be protected under copyright law in Nigeria. However, there is ample jurisprudence in other jurisdiction and secondary sources to rely on in determining whether ideas, procedures, and methods of operation or mathematical concepts are protectable or not.²¹⁵ In view of the above, the Copyright Act cannot be said to comply with article 9.2 of the TRIPS Agreement.

4.3.3.4 Article 10: Computer Programs and Compilations of Data

Computer programs and compilations of data are defined and protected as literary works under the Act. Computer programmes are explicitly mentioned as literary works,²¹⁶ but compilations of data, on the other hand, can be surmised from machine readable or other forms of selection or arrangement of contents which constitute intellectual creations. These types of works are referred to as literary works in the Act, for example, encyclopaedias, dictionaries, directories and anthologies.²¹⁷ An example of what constitutes compilations can be seen in the case of *ICIC Directory. Publication Ltd v Ekko Delta Nig Ltd & Another*,²¹⁸ where the Federal High Court decided that the compilation must satisfy the basic requirements of eligibility, including originality and must not be a mere copy. The Copyright Act accordingly provides for the protection of computer programmes and compilations of data as required in article 10 of the TRIPS Agreement.

²¹⁴ Wim Alberts ‘Copyright in Ideas: A Lesson from the Ivory Tower’ *Juta’s Business Law* 2008 part 2 p.48-50 p.49-50

²¹⁵ *Kenrick & Co v Lawrence & Co* [1890] LR 25 QBD99, the court established that there cannot be monopoly of ideas especially where there may only be one form of expressing it.

²¹⁶ Section 51(1) CA 1988 Cap 28 LFN 2004.

²¹⁷ Section 51 (1) Literary works paragraph, CA 1988 Cap 28 LFN 2004.

²¹⁸ (1977) FHCLR 346.

4.3.3.5 Article 11: Rental rights

This provision is the only non-Berne exclusive right required to be protected under the TRIPS Agreement as discussed in chapter two. The Nigerian substantive law on copyright does not expressly provide for the protection of rental rights. However, the law provides that copyright in a work includes the exclusive right to control in Nigeria the doing of any of the following acts: that is ‘distribute to the public for commercial purposes, copies of the work by way of rental, lease, hire, loan or similar arrangement’.²¹⁹ This provision applies to literary and musical works, cinematograph films, sound recordings and broadcasts.²²⁰ Protection of rental rights can be inferred from these provisions. As to whether this right is extendable to heirs and successors-in-title, under section 12(3) of the Act, an author, as defined in the Act, includes his heirs and successors-in-title in claiming authorship.²²¹ Therefore, author’s rental rights may be applicable to his heirs and successors-in-title. It is however not clear if this provision extends to copyright owners who may be different from the author.

In addition to the above provisions, the Copyright (Video Rental) Regulation²²² provides for the procedure of renting out protected works. The NCC initiated this Regulation to curb flagrant and unauthorised video rentals of Nigerian movies by unlicensed persons. The essence of the regulation is to ‘discourage the proliferation of illegal rental activities by establishing guidelines for the operation of rental services’.²²³ The Regulation is designed to accredit persons or businesses who engage in video or film rentals, lease, hiring loan or distribution of cinematograph film for commercial purpose to the public.²²⁴ This Regulation is to encourage returns on investment to rightful owners of films in Nigeria. The Nigerian Copyright Commission, in line with this regulation, set up a Video Rental Scheme that ‘seeks to accredit, monitor and supervise video rental outlets to ensure that they operate within the framework of the law and also to enable film producers’ to benefit from

²¹⁹ Section 6 (1) (a) (vi); Section 6 (1) (c) (iv); Section 7 (1) (b); Section 8 (1) (c) CA 1988 Cap 28 LFN 2004.

²²⁰ Section 6 (1) (a) (vi); Section 6 (1) (c) (iv); Section 7 (1) (b); Section 8 (1) (c) CA 1988 Cap 28 LFN 2004.

²²¹ Section 11(3) CA 1988 Cap 28 LFN 2004.

²²² Copyright (Video Rental) Regulation September 7, 1999.

²²³ Adewopo *Nigerian Copyright System*, p. 255.

²²⁴ Rule 1 Copyright (Video Rental) Regulation 1999.

commercial exploitation of their films.’²²⁵ For this reason it may be implied that authors have the right to prohibit the commercial rental to the public, originals or copies of their copyright works and, in turn, means that the law is compliant with the article 11 of the TRIPS Agreement.

4.3.3.6 Article 12: Term of Protection of Copyright

The term of protection of copyright is calculated according to the table set out in the First Schedule to the Act.²²⁶ Literary, musical or artistic works, other than photographs, are protected for seventy years after the end of the year in which the author dies. In the case of cinematograph films and photographs the work will be protected for fifty years after the end of the year in which the work was first published, and in respect of sound recordings it will be fifty years after the end of the year in which the recording was first made, broadcasts are protected for fifty years after the end of the year in which the broadcast first took place. For government or a body corporate works, the duration is seventy years after the end of the year in which the work was first published. This is a TRIPS-plus standard: article 12 provides for 50 years from the end of the calendar year of authorised publication.

These durations seem to benefit the booming film and music industry in Nigeria. However, in a country where there is dearth of educational text books and material and there are not enough literary works, this provision may be seen as a case of cutting off your nose to spite your face. The Act clearly surpasses the standard require in article 12 of the TRIPS Agreement on the term of protection members are required to comply with.

4.3.3.7 Limitations and Exceptions under Article 13 of the TRIPS Agreement

It is generally believed that the conceptual basis of copyright is to promote public interest.²²⁷ The United States Trade Representative (USTR) describes copyright as an ‘engine of free

²²⁵ Regulatory Schemes available at <http://www.copyright.gov.ng/index.php/regulatory-schemes> accessed 06 March 2013.

²²⁶ CA 1988 Cap 28 LFN 2004; see also Article 7 Berne Convention.

²²⁷ Halpern, Nard & Port Fundamental of United States intellectual Property law: Copyright, Patent and Trademark 1999) p.1.

expression and a major building block in the world economy’.²²⁸ Although copyright may be all these, it is still a private right and as such the law is responsible for delineating what is protected and what is free for the public to use without infringing on this private right. Copyright exceptions and limitations are especially essential for addressing the challenges and opportunities posed by the lack of access to learning materials for research and educational purposes. Limitations and exceptions serve as checks and balances for copyright protection. As pointed out by Okediji ‘the unlimited grant or exercise of rights without corresponding and appropriate limitations and exceptions has serious adverse long-term implications not only for development priorities, but indeed for the creative and innovation process itself.’²²⁹ The provision on limitations and exception in article 13 in the TRIPS Agreement reads:

Members shall confine limitations or exceptions to exclusive rights to *certain special cases* which do not *conflict with a normal exploitation of the work* and do not *unreasonably prejudice the legitimate interests of the right holder*. (Emphasis added).

Article 9.2 of the Berne Convention is substantially similar to article 13, which relates to the scope of limitations of the right of reproduction alone and reads thus:

It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in *certain special cases*, provided that such reproduction does not *conflict with a normal exploitation of the work* and does not *unreasonably prejudice the legitimate interests of the author*. (Emphasis added).

Article 13 of the TRIPS Agreement has been broken down into three parts known as the three-step test.

a. Three-step Test

The above provisions are referred to as the ‘three-step test’²³⁰ because they have three stages which an intended user has to overcome to use the work without infringing on the owners

²²⁸ USTR Introduces New Copyright Exceptions and Limitations Provision at San Diego TPP Talks 07/03/2012 available at <http://www.ustr.gov/about-us/press-office/blog/2012/july/ustr-introduces-new-copyright-exceptions-limitations-provision> accessed 07March 2013.

²²⁹ Ruth L. Okediji, (executive summary) ‘Limitations, Exceptions and Public Interest Considerations for Developing Countries’ March 2006 I UNCTAD - ICTSD Project on IPRs and Sustainable Development Issue Paper No. 15.

²³⁰ See also Articles 10(2) WCT and 16(2) WPPT.

right. Historically, the ‘three-step test’ was included in the Berne Convention to limit exceptions to the right of reproduction.²³¹ The test is intended to guide national legislators as to the proper scope of exceptions to the right of reproduction. These limitations or exceptions to exclusive rights are confined to certain special cases and allows for the reduction of such rights.²³²

The meaning of the three-step test was examined in *United States–Section 110(5) of the US Copyright Act*.²³³ The Panel examined the meaning of ‘certain special cases’ which is the first condition in article 13, and it stated that a limitation or exception in national legislation should be clearly defined and should be ‘narrow in its scope and reach’.²³⁴ ‘Narrow in scope and reach’ is a concern for developing and least developed countries as the term may not serve their purpose and may be in contradiction of the essence of creating exceptions and limitations.

Certain special cases were interpreted as requiring an exception for a specific purpose.²³⁵ As Ricketson asserts ‘special’ should mean the exception must have a purpose and be justified by public policy.²³⁶ In addition, Ruse-khan states that ‘special cases’ may include those which address public interests recognised in article 7 or article 8.1 of the TRIPS Agreement.²³⁷

The second step ‘which does not conflict with a normal exploitation’ was interpreted by the Panel as accepting the US approach that ‘the second condition in article 13 implies an economic analysis of the degree of ‘market displacement’ in terms of foregone collection of remuneration by right owners caused by the free use of works due to the exemption at issue

²³¹ Berne Convention Revision Conference Stockholm 1967.

²³² WIPO Guide to the Berne Convention of 1971 para 9.6 p.55.

²³³ *United States - Section 110 (5) of the US Copyright Case WT/DS160*, Act WTO Copyright Panel decision (2000).

²³⁴ Case WT/DS160 para 6.112.

²³⁵ UNCTAD/ICTSD, *Resource Book on TRIPS* p. 193.

²³⁶ Sam Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works 1886-1986* Sweet & Maxwell London. 1987 p.482.

²³⁷ Henning Grosse Ruse – Khan, ‘Fair Use, Fair Dealing and Other Open Ended Exceptions: The Application of the Three Step Test’ WIPO African-Arab Seminar on Copyright Limitations and Exceptions Cairo, 2 November 2009 available at http://www.wipo.int/meetings/en/2009/cr_cai_09/index.html accessed 07 March 2013. See WIPO/CR/CAI/09.

only for the empirical or quantitative side of the connotation'.²³⁸ In addition, it stated that 'in developing a benchmark for defining the normative connotation of normal exploitation... emphasis is on the potential impact of an exception rather than on its actual effect on the market at a given point in time, given that, in its view, it is the potential effect that determines the market conditions.'²³⁹

As Goldstein notes²⁴⁰ and Gervais supports,²⁴¹ the intent of this condition is to 'fortify the authors' interests in their accustomed markets against local legislative inroads.' Moreover, it has been stated that 'exploitation could be considered "normal" only if it does not significantly interfere with such interests'.²⁴²

The third condition, which requires that the limitations and exceptions 'do not unreasonably prejudice the legitimate interests of the author', is regarded as the most problematic.²⁴³ The panel viewed legitimate interests in terms of the 'economic value of the exclusive rights conferred by copyright on their holders'²⁴⁴ and deduced 'that prejudice to the legitimate interests of right holders reaches an unreasonable level if an exception or limitation causes or has the potential to cause an unreasonable loss of income to the copyright owner.'²⁴⁵ The reasonable and justifiable proviso is crucial as it enables legislators to create a balance of interests between copyright holders and users.²⁴⁶

It is worthy of note that the 'dictionary approach' has been criticised as an 'incomplete and result-oriented approach' and may not be a definite method to ascertain the 'ordinary

²³⁸ Case WT/DS160 Panel Report para 6.177.

²³⁹ Case WT/DS160 Panel Report para 6.184.

²⁴⁰ Paul Goldstein, *International Copyright: Principles, Law, and Practice* (Oxford University Press, 1998) at p. 295. Daniel J. Gervais, 'Making Copyright Whole: A Principled Approach to Copyright Exceptions and Limitations' 5 *University of Ottawa Law & Technology Journal* (2008) 27.

²⁴¹ Daniel J. Gervais, 'Towards a New Core International Copyright Norm: The Reverse Three-Step Test' 9 *Marquette Intellectual Property Law Review* 1 2005 16.

²⁴² Public interests recognised *inter alia* in Article.7 or Article.8:1 TRIPS. See also Henning Grosse Ruse – Khan, 'Fair Use, Fair Dealing and Other Open Ended Exceptions The Application of the Three Step Test' WIPO African-Arab Seminar on Copyright Limitations and Exceptions Cairo, 2 November 2009 available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=19882 accessed 07 March 2013. See WIPO/CR/CAI/09/TOPIC2/1.

²⁴³ Gervais, 'Towards a New Core International Copyright Norm' 19.

²⁴⁴ Case WT/DS160 Panel Report para 6.227.

²⁴⁵ Case WT/DS160 Panel Report para 6.229.

²⁴⁶ Gervais, 'Towards a New Core International Copyright Norm' p.19.

meaning.²⁴⁷ As Gervais notes, the WTO Appellate Body has preferred to stay with the ordinary meaning of words for policy reasons so as not to introduce concessions that the WTO did not bargain for in its legal framework.²⁴⁸

However, generally speaking the three-step test seems to be highly dependent on the circumstances of each case, thus copying of the same number of pages of a different document may lead to a different conclusion as to whether it has unreasonably prejudiced the legitimate interests of the author. For example, a teacher makes a copy of an article and makes a copy of a chapter in a book: the book is in the school library and the article was bought online. He distributes ten copies of the article to his students and ten copies of the chapter to his students. The chapter in the book will most likely be considered as a special case, that is, for educational purposes, its use does not conflict with a normal exploitation of the work (whether the teacher made the copy or not the students would have made it themselves) and does not unreasonably prejudice the legitimate interests of the author. The copying of an article that has to be paid for before it can be downloaded may still be considered a special case (an educational purpose) but may conflict with the normal exploitation of the work and prejudice the legitimate interests of the author, but not unreasonably. This situation gives rise to uncertainty: nonetheless, the eventual yardstick should be ‘fairness.’²⁴⁹

Article 13 dwells on limitation rather than exception, which relates to the substance of protection of copyright that is the balance of the rights of creators and the public interest regarding the usage of copyright works.²⁵⁰ The three-step test may constitute an impediment to national policy because it establishes three general conditions to be adhered to when enacting copyright exceptions in national laws, thereby regulating the national autonomy of

²⁴⁷ Dongsheng Zang, ‘Textualism in GATT /TO Jurisprudence: Lessons for the Constitutionalization Debate,’ (2006) 33 *Syracuse Journal of International Law & Commerce* 393-444, at pp. 428-434 cited in Gervais, ‘Making Copyright Whole p. 26 note 115.

²⁴⁸ Gervais, ‘Towards a New Core International Copyright Norm’ p. 15.

²⁴⁹ WIPO Standing Committee on Copyright and Related Rights, WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment, 9th Session, June 23-27, 2003, WIPO Doc. SCCR/9/7 p.69.

²⁵⁰ UNCTAD/ICTSD, *Resource Book on TRIPS* p.186.

countries to prescribe copyright exceptions.²⁵¹ This concern is predominantly expressed with regard to developing and least-developed countries, where access to knowledge goods is centred in the availability of limitations and exceptions to the copyright owner's interest.²⁵² In the copyright structure, creators as well as users need an 'appropriate incentive structure' that would comprise the public interest of promoting progress and encouraging growth.²⁵³ According to Ruse-khan a flexible interpretation could mean the 'legitimate interests of right holders may only be those which sufficiently reconcile the public interests recognised in the WTO/TRIPS objectives'.²⁵⁴ In view of this provision and interpretation, can the exceptions and limitations under the Act pass the three- step tests?

b. Limitations and Exceptions in the Copyright Act

The Nigeria Act provides for limitations and exceptions²⁵⁵ to copyright in an attempt to balance the rights of creators and the public interest in access to copyright works'.²⁵⁶ The Act provides for a number of limitations and exceptions as outlined in the Second Schedule which contain 'purpose-specific exceptions'.²⁵⁷ The Act makes it clear that the rights a copyright holder has do not include the exceptions under this schedule: put simply, copyright holders do not have control over the issues stated under this schedule.

The Second Schedule is fairly long, containing various exceptions. They read as follows:

(a) the doing of any of the acts mentioned in the said section 6 by way of fair dealing for purposes of research, private use, criticism or review or the reporting of current events, subject to the condition that, if the use is public, it shall be accompanied by an acknowledgment of the title of the work and its authorship, except where the work is incidentally included in a broadcast;

(b) the doing of any of the aforesaid acts by way of parody, pastiche, or caricature;

²⁵¹ Henning Grosse Ruse – Khan, 'Fair Use, Fair Dealing and Other Open Ended Exceptions The Application of the Three Step Test' WIPO African-Arab Seminar on Copyright Limitations and Exceptions Cairo, 2 November 2009 available at http://www.wipo.int/meetings/en/2009/cr_cai_09/index.html accessed 07 March 2013. See WIPO/CR/CAI/09.

²⁵² Ruth Okediji, 'Limitations, Exceptions and Public Interest Considerations for Developing Countries' p.2.

²⁵³ Okediji, (executive summary) 'Limitations, Exceptions and Public Interest Considerations for Developing Countries' p.x.

²⁵⁴ Henning Grosse Ruse– Khan, 'Fair Use, Fair Dealing and Other Open Ended Exceptions'.

²⁵⁵ Second Schedule CA 1988 Cap 28 LFN 2004.

²⁵⁶ UNCTAD/ICTSD, *Resource Book on TRIPS* p.186.

²⁵⁷ Gervais, *Towards a New Core International Copyright Norm* p 15.

- (c) the inclusion in a film or a broadcast of an artistic work situated in a place where it can be viewed by the public;
- (d) the reproduction and distribution of copies of any artistic work permanently situated in a place where it can be viewed by the public;
- (e) the incidental inclusion of an artistic work in a film or broadcast;
- (f) the inclusion in a collection of literary or musical work which includes not more than two excerpts from the work, if the collection bears a statement that it is designed for educational use and includes an acknowledgment of the title and authorship of the work;
- (g) the broadcasting of a work if the broadcast is approved by the broadcasting authority as an educational broadcast;
- (h) any use made of a work in an approved educational institution for the educational purposes of that institution, subject to the condition that, if a reproduction is made for any such purpose it shall be destroyed before the end of the prescribed period, or if there is no prescribed period, before the end of the period of twelve months after it was made;
- (i) subject to the Third Schedule to this Act, the making of a sound recording of a literary or musical work, and the reproduction of such a sound recording by the maker or under licence from him, where the copies thereof are intended for retail sale in Nigeria and the work has already been previously recorded under license from the owner of the relevant part of the copyright whether in Nigeria or abroad, subject to such conditions and to the payment of such compensation as may be prescribed;
- (j) the reading or recitation in public or in a broadcast by any person of any reasonable extract from a published literary work if accompanied by a sufficient acknowledgment: Provided that such reading or recitation is not for commercial purpose;
- (k) any use made of a work by or under the direction or control of the Government, or by such public libraries, non-commercial documentation centres and scientific or other institutions as may be prescribed, where the use is in the public interest, no revenue is derived therefrom and no admission fee is charged for the communication, if any, to the public of the work so used;
- (l) the reproduction of a work by or under the direction or control of a broadcasting authority where the reproduction or any copies thereof are intended exclusively for a lawful broadcast and are destroyed before the end of the period of six months immediately following the making of the reproduction or such longer period as may be agreed between the broadcasting authority and the owner of the relevant part of the copyright in the work, so however that any reproduction of a work made under this paragraph—
 - (i) may if it is of an exceptional documentary character be preserved in the archives of the broadcasting authority (which shall for the purpose of this paragraph be deemed to be part of the National Archives) established under the Public Archives Act;
 - (ii) subject to this Act, shall not be used for broadcasting or for any other purpose without the consent of the owner of the relevant part of the copyright in the work;
- (m) the broadcasting of a work already lawfully made accessible to the public and subject (without prejudice to the other provisions of this Schedule) to the condition that the owner of the broadcasting right in the work shall receive a fair compensation determined, in the absence of agreement, by the court;
- (n) news of the day publicly broadcast or publicly communicated by any other means;

- (o) the communication to the public of a work, in a place where no admission fee is charged in respect of the communication, by any club whose aim is not profit making;
- (p) any use made of a work for the purpose of judicial proceeding or of any report of any such proceeding;
- (q) the making of not more than three copies of a book (including a pamphlet, sheet music, map, chart or plan) by or under the direction of the person in charge of a public library for the use of the library if such a book is not available for sale in Nigeria;
- (r) the reproduction for the purpose of research or private study of an unpublished literary or musical work kept in a library, museum or other institutions to which the public has access;
- (s) reproduction of published work in Braille for the exclusive use of the blind, and sound recordings made by institutions or other establishments approved by the Government for the promotion of the welfare of other disabled persons for the exclusive use of such blind or disabled persons.

A few of the exceptions will be examined in detail below to gain a proper understanding. The exceptions enumerated in the Second Schedule to the Act apply to four categories of work, namely, literary, musical, artistic works and cinematograph film; they may be indirectly applicable to sound recordings and broadcasts. Sound recordings²⁵⁸ are subject to exceptions only in paragraphs (h), (k), (l), and (p) of the Second Schedule, there are also special exceptions in respect of sound recording in the third schedule,²⁵⁹ whereas paragraphs (a), (h), (k), (n), and (o) are applicable to broadcasts.

i. Research, Private Use, Criticism or Review or the Reporting of Current Events: Paragraph (a)

Exceptions in paragraph (a) are usually referred to as fair dealing provisions.²⁶⁰ These exceptions are usually permitted uses of a copyrighted work without the author's consent or authorisation. Paragraph (a) provides that 'the doing of any of the acts mentioned in section 6²⁶¹ by way of fair dealing for purposes of research, private use, criticism or review or the reporting of current events' does not constitute an infringement of copyright. However, where the use is public the title of the work and its authorship shall be acknowledged except where the work is incidentally included in a broadcast. This provision seems to exclude

²⁵⁸ There are also some other special exceptions specified under the third schedule in respect of sound recordings of musical works. Moreover, other exceptions abound throughout the length and breadth of the Copyright Act.

²⁵⁹ Copyright Act 1988 Cap. 28, Laws of the Federation of Nigeria, 2004.

²⁶⁰ Para (a) Second Schedule CA 1988 Cap 28 LFN 2004.

²⁶¹ Section 6 CA 1988 Cap 28 LFN 2004.

performer rights or neighbouring rights from the fair dealing provision, whereas fair use of the expression of folklore is specifically mentioned.²⁶² The Act does not specify what constitutes purposes of research or private use. These exceptions have been stretched to their limits in Nigeria.

The provision is fashioned after the U.K. Copyright Act of 1911 which was applicable in Nigeria by virtue of the Statute of General Application. The U.K. Copyright Act did not define fair dealing. However, the UK Copyright, Designs and Patents Act (CDPA),²⁶³ specifically in sections 29 and 30, expounds on what fair dealing covers. The UK CDPA explains the meaning of fair dealing and what would not be considered as fair dealing²⁶⁴ in research and private use under section 29 and explains in section 30 what fair dealing in criticism or review²⁶⁵ and for reporting of current events entails.²⁶⁶ This explanation provides boundaries to work with to enable users to know to what extent they can use a work. For instance, in the UK if the use does not fall into one of the three fair dealing categories it is not fair and, in some cases, if it contains insufficient acknowledgement of the original author the use will be regarded as an infringement.²⁶⁷ The Nigerian provisions have not been reviewed to take into consideration the possible uses of copyright works that can exceed fair use even when used for research, private use criticism or review and for reporting current events.

Even though these exceptions are provided for in the Act there is no form of monitoring set up to make sure that these exceptions do not become a form of infringement of holders' rights. There are no rules or regulations on what constitute purposes of research and private use. For instance, a whole text book may be photocopied for private use, private use here meaning for the copiers' library or private study. This is a common occurrence among researchers and students who think it is cheaper to photocopy the book instead of buying it.

²⁶² Section 31 (2) (a) CA 1988 Cap 28 LFN 2004.

²⁶³ UK Copyright, Designs and Patents Act 1988 (CDPA).

²⁶⁴ Section 29(1) UK CDP Act 1988.

²⁶⁵ Section 29 (3), (4) and (4A) UK CDP Act 1988.

²⁶⁶ Section 30(1) UK CDP Act 1988.

²⁶⁷ Fair dealing in United Kingdom law available at http://en.wikipedia.org/wiki/Fair_dealing_in_United_Kingdom_law accessed 12 June 2012.

Although, some jurisdictions consider multiple copies as fair dealing²⁶⁸ it depends on the circumstances of the use.

The meaning of the doctrine of fair dealing has been well established and of particular note is the case of *Hubbard v Vospar*²⁶⁹ in which Lord Denning articulated how fair dealing can be determined by stating that:

It is impossible to define what is fair dealing. It must be a question of degree. You must consider first the number and extent of the quotations and extracts. Are they altogether too many and too long to be fair? Then you must consider the use made of them. If they are used as a basis for comment, criticism or review, that may be a fair dealing. If they are used to convey the same information as the author, for a rival purpose, that may be unfair. Next, you must consider the proportions. To take long extracts and attach short comments may be unfair. But, short extracts and long comments may be fair. Other considerations may come to mind also. But, after all is said and done, it must be a matter of impression. As with fair comment in the law of libel, so with fair dealing in the law of copyright. The tribunal of fact must decide.

The consequence of the use of the work was what Lord Denning critically looked at. Thus, if everyone is allowed to make a copy for their library how does the author of the book benefit from his labour? It is certain that permissible uses in the Act needs to be delineated to allow people to know when they are crossing the line between ‘permissible use’ and ‘infringing use’.²⁷⁰

In the interesting case of *CCH Canadian Limited v Law Society of Upper Canada*,²⁷¹ the Supreme Court of Canada clarified what fair dealing means, noting that fair dealing is to be regarded as an ‘integral part’ of the Copyright Act²⁷² rather than ‘simply a defence’. The fair dealing exceptions are users’ rights to be balanced against the rights of copyright owners.²⁷³

In this case, McLachlin C.J. examined six factors²⁷⁴ to determine fairness and concluded that:

²⁶⁸ § 107. US Copyright Statute on Limitations on exclusive rights: Fair use.

²⁶⁹ [1972] 2 QB 84.

²⁷⁰ *Hubbard v Vosper* CA 1971 ([1972] 2 WLR 389. See also *Beloff v Pressdram Ltd* Ch [1973] ([1973] 1 All E.R. 241; [1973] F.S.R. 33; [1973] R.P.C. 765) and *Ashdown v Telegraph Group Ltd* [2002] Ch 149.

²⁷¹ [2004] 1 SCR 339 [1]; 2004 SCC 13.

²⁷² Canadian Copyright Act.

²⁷³ (2004) SCC 13 at 48; (2004) SCC 13 at 60.

²⁷⁴ The purpose of the dealing; 2.The character of the dealing; 3.The amount of the dealing; 4. Alternatives to the dealing; 5.The nature of the work; 6.The effect of the dealing on the work

...the purpose of the dealing, the character of the dealing, the amount of the dealing, the nature of the work, available alternatives to the dealing and the effect of the dealing on the work are all factors that could help determine whether or not a dealing is fair. These factors may be more or less relevant to assessing the fairness of dealing depending on the factual context of the allegedly infringing dealing. In some contexts, there may be factors other than those listed here that may help a court decide whether the dealing was fair.²⁷⁵

Under Nigerian law the issue or defense of fair dealing has not been interpreted by the courts, however, if there is a lacuna in the law it is trite that the courts can look to the position of law as it is in England and other jurisdictions, not as precedents but merely as persuasive authority.²⁷⁶ In *Okediji v Osanyin*²⁷⁷ the issue of fair dealing was raised as a defense by one of the defendants, which included Obafemi Awolowo University, for the translation of a Yoruba book *Rere Run* into English titled *The Shattered Bridge* which was subsequently performed by the second defendant. The court held, subject to the exception listed in paragraph (a) of the Second Schedule to the Decree, that it is an infringement of copyright under section 5(1)(a)(iv) of the Copyright Act 1970 to publish any translation of the work in whatever language in Nigeria. Although the issue of fair dealing came up for consideration, as the performance took place in Obafemi Awolowo University, the court did not rule on the issue of fair dealing, consequently, factors that may constitute fair dealing in Nigeria were not dealt with. The same pattern was followed in the case of *Obe v Grapevine Communication*²⁷⁸ where the issue of fair dealing was raised as a defense. However, the courts did not address the issue of whether the use was fair or not as well. This might have been as a result of the fact that, in this particular case, the infringement was a flagrant one.

As noted above, fair dealing in relation to literary, musical artistic and cinematograph film if for public use must be accompanied by sufficient acknowledgement.²⁷⁹ The Act does not mention that the use has to be for a non-commercial public purpose, which means it can be used for a commercial purpose which will be unfair to the author.

²⁷⁵ 2004 SCC 13 at 60.

²⁷⁶ *FRA Williams v Daily Times (NIG) Limited* (1990) 1 WRN1 AT P.29; *Yahaya v State* (2002) 11 WRN 1 SC; *Araka v Egbue* (2003) 17 NWLR (Part 848) 1 at 22 para C-H; *Inakoju v Adeleke* (2007) 4 NWLR (Part 1025 423 at 594 para D-F; *Adetoun Oladeji (Nig) Ltd v Nigerian Breweries Plc* (2007) 5 NWLR (Pt.1027) 415 2.

²⁷⁷ *Ladejo Okediji v. Bode Osanyin, Obafemi Awolowo University, Dr Olu Akomolafe FHC/IB/12/90.*

²⁷⁸ [2003 – 2007] 5 IPLR.

²⁷⁹ Para (a) Second schedule CA 1988 Cap 28 LFN 2004.

Moreover, unpublished literary or musical works kept in a library, museum or other institution to which the public has access can be reproduced for the purpose of research or private study without infringing the work.²⁸⁰ Accordingly, can the permitted uses in paragraph (a) be regarded as special cases or do research, private use, criticism or review or the reporting of current events fall within the category of special cases. These uses are usually regarded as exceptions to copyright. However, if there are no clear cut boundaries for the use, they may be in conflict with a normal exploitation of the work in a way that will prejudice the legitimate interests of the right holder. For example a class of 200 students making photocopies of a text book for research and private use goes beyond what is permitted.

ii. Educational Purposes: Paragraph (h)

It is a commonplace that students in Nigeria hardly buy textbooks for courses they have registered for. Most students rely on photocopying books. As is the case for research and private use, educational purposes are not demarcated and therefore permit a wide interpretation of its uses. If there are 200 students in a class and they all need to have a particular textbook for class discussions and private reading, is the copying of the book by 200 students fair use or for educational purpose? Bearing in mind that other texts for the year may be copied as well. Each individual student can claim he/she is using the books for research, private use and educational purpose under the current law.

The law allows for any use²⁸¹ made of a work in an approved educational institution for educational purposes, although, the Act provides for the destruction of the material after a prescribed period or twelve months.²⁸² How does the government or the owner regulate the destruction of the book? This provision is quite wide as it may even include making a number of copies of a whole book. Reprographic process is not prohibited. Copying, performing, playing or showing and recording of any work is allowed under this section.

²⁸⁰ Para (r). Second schedule CA 1988 Cap 28 LFN 2004.

²⁸¹ This is in line with the Berne Provisions as the Convention allows for the use of the whole work for teaching purposes so far as the use is compatible with fair practice.

²⁸² Para (h) Second Schedule CA 1988 Cap 28 LFN 2004.

This provision is hailed as it does not unduly restrict education and teaching uses. On the other hand it may undermine incentives to create.

The purpose of this wide provision is to make it easier for copyright works to be used in the educational sectors so as to enrich and enhance the learning environment. As a matter of fact, most schools in Nigeria engage in and encourage flagrant²⁸³ copying of text books by providing ‘unmonitored copying centres’ owned by private business people whose aim is to make a profit without thinking they are depriving some other person of the fruit of his labour.²⁸⁴ The challenge lies in that they do not even know that what they are doing is an infringement of somebody else’s rights which they can be liable for.²⁸⁵ The reason for this flagrant copying is not obscure as most libraries are ill-equipped with essential books, current journals and magazines. Some libraries have only one copy of an essential book.²⁸⁶ In addition, there are limited publishers, books are expensive and beyond the reach of many students and very few books are in circulation.²⁸⁷

‘The socio-economic development of a country depends to a large extent on the creativity of her people and creative works cannot be encouraged without effective administration of copyright laws’.²⁸⁸ If the scope of permitted uses under the copyright law is legally restrictive and, yet, there is no strict enforcement mechanism in place an imbalance is created by the law.

²⁸³ Section 14 CA 1988 Cap 28 LFN 2004.

²⁸⁴ Even though there is a Reprographic Rights Organization of Nigeria (REPRONIG), REPRONIG is a licensed collecting society for reprographic rights since 2003 with funding support from KOPINOR, the Reprographic Rights Organization of Norway. The organization is however only available on paper and have no effect of the massive copying of text books going on the all educational institutions.

²⁸⁵ Section 14 CA 1988 Cap 28 LFN 2004.

²⁸⁶ Olatoye Olawale, ‘Challenges Currently Facing the Educational Sector in Nigeria’ *The Frontiers Post Economic Policy & Financial Markets* April 08, 2010.

²⁸⁷ Susan Štraba, *International Copyright Law and Access to Education in Developing Countries Exploring Multilateral Legal and Quasi-Legal Solutions*, Martinus Nijhoff publishers 2012 p.35; see also Basic Learning Materials Initiative - UNESCO available at http://www.unesco.org/education/blm/blmobjectives_en.php accessed 11 march 2013.

²⁸⁸ Fabunmi Beatrice, ‘The Roles of Librarians in Copyright Protection in Nigeria’ *International Journal of African & African American Studies* Vol. VI, No. 1, Jan 2007 pp. 84-93.

Paragraph (h) is unclear on other issues as well, which include whether educational purposes only consist of teaching within the four walls of a classroom alone and what the definition of an approved educational institution for educational purposes means.

Although, these issues may not have been expatiated on in the Act, the issue of teaching came to the fore and was discussed in 1967 at the Intellectual Property Conference of Stockholm where it was clearly stated that:

... the word ‘teaching’ was to include teaching at all levels—in educational institutions and universities, municipal and State schools and private schools. Education outside these institutions, for instance general teaching available to the general public but not included in the above categories, should be excluded.²⁸⁹

This interpretation, though, is regarded as restrictive²⁹⁰ in relation to developing countries considering the need to use copyright works for adult education courses and adult literacy campaigns.²⁹¹ This interpretation does not include distance learning which has become one of the ways to educate a large percentage of people who cannot afford to be in school full-time.

The omission of this vital provision in a country’s legislation clearly indicates that the laws were not reviewed with the aim of using the laws as a tool for socio-economic development. Although, the requirement for an exception that allows copyright works to be used for educational purposes is very important for Nigeria and can be regarded as a special case the exception in practice conflicts with the normal exploitation of the work where flagrant copying is allowed, which ultimately prejudices the legitimate interests of the right holder if books are not bought but copied.

²⁸⁹ *Records 1967*: Records of the Intellectual Property Conference of Stockholm, June 11 to July 14, 1967p.1187.j.

²⁹⁰ *Records 1967*: Records of the Intellectual Property Conference of Stockholm, June 11 to July 14, 1967 p.1187. The Main Committee noted that some delegates thought that this was too limiting as cited in Sam Ricketson, ‘WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment’ Standing Committee on Copyright and Related Rights’ Ninth Session Geneva, June 23 To 27, 2003 p. 15.

²⁹¹ Sam Ricketson, ‘WIPO Study on Limitations and Exceptions of Copyright and Related Rights in the Digital Environment’ Standing Committee on Copyright and Related Rights’ Ninth Session Geneva, June 23 To 27, 2003 p. 15.

iii. Public libraries, Non-commercial Documentation Centres- Paragraph k and q

This exception provides that ‘any use made of a work by or under the direction or control of the Government or by public libraries, non-commercial documentation centres and scientific or other institutions where the use is in the public interest and no revenue is derived therefrom and no admission fee is charged for the communication, to the public of the work so used’.²⁹² This provision is far-reaching as it may be extended to cover digital technology.

Regarding this exception, the question to be asked is what is the meaning of ‘public interest’. Public interest should simply mean beneficial to all concerned. In essence, private libraries, research institutions and documentation centres that are for commercial purposes cannot benefit from this exception, even though the public benefits from them.

Another issue to be pointed out relates to reproduction by libraries, which may entail reproduction of the entire work. The libraries may be used as an avenue to enable infringement since the work is put at everyone’s disposal for free reproduction, as is commonly done in most libraries in Nigeria. This practice may lead to repeated reproduction on separate, unrelated occasions, meaning that multiple copies can be made of the same work. Although, the very essence of a library is to make copies of books and related educational material that are either too expensive for people to buy or are not in circulation, in order to promote knowledge, inform people and enrich lives, reproduction of copyright works should not be done in such a way as to encourage flagrant copying.

This provision has been hailed as the law permits public libraries to make three copies of a book²⁹³ for the use of the library if such a book is not available for sale in Nigeria. The purpose must strictly be for library use. Furthermore, works stored in the National Archives or the public records of a state can be reproduced and copyright in such works will not be infringed.²⁹⁴

²⁹² Para (k) Second Schedule CA 1988 Cap 28 LFN 2004.

²⁹³ Including a pamphlet, sheet music, map, chart or plan.

²⁹⁴ Section 15(2) (a) CA 1988 Cap 28 LFN 2004.

Although, libraries may fall into special uses, if the libraries are allowed to make copies of books without buying, it leads to a conflict with the concept of the normal exploitation of the work. Books are no longer completely out of reach as the internet has made it easier for electronic transactions by which books can be ordered from anywhere in the world, therefore, the fact that the book is not on sale in Nigeria is no longer an excuse to make copies. If all the university libraries in Nigeria make 3 copies of a text that is important for research in a particular area that amounts to 3 multiplied by 114 universities, which makes 342 copies of one text. This type of reproduction clearly conflicts with the normal exploitation of the work and unreasonably prejudices the legitimate interest of the author.

iv. Visually Impaired and other Persons with Disability: Paragraph (s)

An area of acute shortage of learning material is in the area of materials for blind, visually impaired, or otherwise print disabled persons, despite the fact that the Act allows published works to be reproduced and adapted into Braille format for the exclusive use of the blind. Sound recordings also may be made by institutions or other establishments approved by the Government for the promotion of the welfare of other disabled persons.²⁹⁵

This adaptation must be for the exclusive use of such blind or disabled persons. The provision does not require the consent of the copyright owner before the work is adapted into braille or other suitable forms. Reproduction which can be done by ‘institutions’ is not qualified, and so it is not clear whether this means educational institutions or special institutions for the blind or disabled persons or both.²⁹⁶ Similarly, the Act does not make a distinction between personal use for private study or commercial purposes and there are no

²⁹⁵ Para (s) Second Schedule CA 1988 Cap 28 LFN 2004.

²⁹⁶ Article 2 (c) WIPO Treaty to Facilitate Access to Published Works for Persons who are Blind, Visually Impaired, or Otherwise Print Disabled was adopted by the Diplomatic Conference in Marrakesh, June 17 to 28, defines ‘authorized entity’ to mean an entity that is authorized or recognized by the government to provide education, instructional training, adaptive reading or information access to beneficiary persons on a non-profit basis. It also includes a government institution or non-profit organization that provides the same services to beneficiary persons as one of its primary activities or institutional obligations.

restrictions whatsoever on the sharing, export or import of such materials which is laudable. It is not clear when the exhaustion of the distribution right takes place.²⁹⁷

Besides, there is no requirement for the acknowledgement of the author, publisher and the work itself. There is no mention of whether or not the provision can be overridden by contract. Also there are no provisions regarding the interplay with digital right management (DRM) which is very important in these times of ever- changing technology. Recently, in 2013, the WIPO adopted a landmark Treaty in Marrakesh.²⁹⁸ This Treaty aims to facilitate access to published works for persons who are blind, visually impaired, or otherwise print disabled. Article 7 of the Marrakesh Treaty requires that contracting parties shall take appropriate measures, as necessary, to ensure that adequate legal protection and effective legal remedies are provided against the circumvention of effective technological measures and that this legal protection does not prevent beneficiary persons from enjoying the limitations and exceptions provided for in this Treaty. Accordingly digital right owners cannot use technologies that would prohibit access to the work.

Putting the copyright work in an accessible format for blind, visually impaired, or otherwise print disabled is a special case as photocopying is not even an option for accessing the work. It is doubtful if braille can be said to be a normal exploitation of the work by the copyright owner. The copyright owner has the right of adaptation, but creating the work in braille format or other accessible format would not seem to infringe on the copyright owners' rights as the use of the work will not cause a market displacement and, accordingly, will not prejudice the legitimate interests of the right holder.

²⁹⁷ Judith Sullivan, 'WIPO Study on Copyright Limitations and Exceptions for the Visually Impaired to Standing Committee on Copyright and Related Rights' Fifteenth Session Geneva, September 11 to 13, 2006.

²⁹⁸ WIPO Treaty to Facilitate Access to Published Works for Persons who are Blind, Visually Impaired, or Otherwise Print Disabled was adopted by the Diplomatic Conference in Marrakesh, June 17 to 28, 2013VIP/DC/8 REV.(Hereinafter referred to as the Marrakesh Treaty).

v. Compulsory Licence for Reproduction of Certain Works- License to Produce and Publish Works for Certain Purposes

In addition to the aforementioned exceptions, the Act specifically provides for compulsory licences for translation and reproduction of certain works.²⁹⁹ According to Liebowitz a compulsory licensing scheme of copyright works is one in which the government requires copyright owners to make their works available to users at a fixed price, compelling the copyright owner and not the user of the work.³⁰⁰ This definition is rather misleading as the essence of a compulsory licence is left out, which is for the interest of the public, and such licences must not prejudice the author's moral rights and fair remuneration is usually given.

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No doubt compulsory licence is one of the limitations to the right of the holders of copyright. WTO members' compliance with article 11bis (2)³⁰² provides the legal basis for compulsory licensing at the international level. The provision specifies under which conditions members of the Union may issue a compulsory licensing. The Berne Convention states that member states are free to determine in their national laws the conditions under which the author's exclusive rights may be substituted for by a compulsory licence. The Convention points out certain minimum requirements that must be followed in issuing compulsory licenses.³⁰³

According to the *Guide to the Berne Convention*,³⁰⁴ compulsory license was created in the interest of the public and with limited terms: such licences should apply only in the country which has provided for them.³⁰⁵ The Union members are required to put in place proper procedures for the use of this system.³⁰⁶ In summary, compulsory license is permitted under

²⁹⁹ The Fourth Schedule CA 1988 Cap 28 LFN 2004.

³⁰⁰ Liebowitz S. J. 'Alternative Copyright Systems: The Problems with a Compulsory License' at p.2 <http://www.serci.org/2003/liebowitz2.pdf> accessed 19 June 2013.

³⁰¹ WIPO *Guide to the Berne Convention of 1971* para 11bis 16 p.70.

³⁰² Berne Convention for the Protection of Literary and Artistic Works.

³⁰³ Article 11bis (2) Berne Convention for the Protection of Literary and Artistic Works.

³⁰⁴ WIPO *Guide to the Berne Convention of 1971* para 11bis 16 p.70.

³⁰⁵ Article 6bis Berne Convention for the Protection of Literary and Artistic Works. Moral right are specifically excluded from the TRIPS Agreements in Article 9.2.

³⁰⁶ WIPO *Guide to the Berne Convention of 1971* para 11bis 16 p.70.

article 13 of the TRIPS Agreement as a limitation and exception to the normal exploitation of the work.

The Act, under the Fourth Schedule allows any qualified person³⁰⁷ to apply to the Nigeria Copyright Commission (NCC) for a licence to reproduce or translate or both, of any literary or dramatic³⁰⁸ artistic work and broadcasting which has been produced, published in printed or any equivalent form of reproduction.³⁰⁹ This license however, may only be used for the ‘purposes of teaching, scholarship or research’³¹⁰ and dissemination of the results of specialised, technical or scientific research of experts.³¹¹

This provision gives a time frame after which a compulsory licence may be allowed: the issuance of such a licence may commence only after the expiration of the ‘relevant period’,³¹² from the date the first edition of the literary or artistic work is published and copies of such edition have not been made available in Nigeria or such copies have not been put on sale in Nigeria for a period of six months by the owner of the right of reproduction or by any person authorised by him.³¹³ However, in the case the licence relates to translation to any Nigerian language, the licence may be granted only one year after publication of the first edition,³¹⁴ a translation into English from any Nigerian language can be granted after three years of first publication.³¹⁵

The issuance of the license still depends on the NCC being satisfied that the applicant had requested and had been denied a licence by the owner of the copyright to produce and

³⁰⁷ Qualified person was so defined in the Act and therefore can be manipulated as the Commission deems fit.

³⁰⁸ It should be noted that the use of compulsory license is extended to dramatic works which are not part of the categories of works mentioned in section 1 and they are not defined in section 51 as part of literary works.

³⁰⁹ Para 2(1) Second Schedule CA 1988 Cap 28 LFN 2004.

³¹⁰ This includes purposes of instruction activity at all levels in educational institutions and purposes of all types of organised educational activity.

³¹¹ Para 4(1) Forth Schedule CA 1988 Cap 28 LFN 2004.

³¹² ‘relevant period’, in relation to any work, means a period of—(a) seven years from the date of the first publication of that work, where the application is for the reproduction and publication of any work of, or relating to fiction, poetry, drama, music or Article; (b) three years from the date of the first publication of that work, where the application is for the reproduction and publication of any work of, or relating to natural science, physical science, mathematics or technology.

³¹³ Fourth Schedule 3 (1) CA 1988 Cap 28 LFN 2004.

³¹⁴ Paragraph 6 (a) Forth Schedule CA 1988 Cap 28 LFN 2004.

³¹⁵ Paragraph 6 (b) Forth Schedule CA 1988 Cap 28 LFN 2004.

publish such a translation or after due diligence on his part, that he was unable to find the right owner.³¹⁶ Currently there is no record of such use by the government.

The use of a compulsory license is definitely a special case because the use is required only for the ‘purposes of teaching, scholarship or research’³¹⁷ and dissemination of the results of specialised, technical or scientific research of experts.³¹⁸ And clearly there must be scarcity of the work in Nigeria. Whether the work will conflict with normal exploitation is dependent on a lot of dynamics. The use of the work is normal exploitation which may not conflict with the owner’s use, if the work is adequately acknowledged by user and if, when a request for the licence was made the owner of the copyright did not deny authorisation to produce the work. A compulsory licence requires that the copyright owner be adequately compensated, thus, it is submitted that the use will not prejudice legitimate interests of the right holder.

4.3.3.8 Protection of Performers, Producers of Phonograms (Sound Recordings) and Broadcasting Organisations

As discussed in the previous chapter, the term neighbouring rights protects the interests of a group of right holders³¹⁹ who deal with the reproduction and dissemination of works.³²⁰ Traditionally, they are regarded as media rights³²¹ or second generation rights.³²² The incorporation of the Rome Convention into the TRIPS Agreement for the protection of performers, producers of phonograms and broadcasting organisations indicates how important these rights have become internationally. Considering the language of article 14 of the TRIPS Agreement members are free to implement this provision in the way they choose. The content of article 14.1 is analogous to article 7.1 (b) and (c) of the Rome Convention. In Nigeria, the description of neighbouring rights is notably different from that which obtains in

³¹⁶ Fourth Schedule 2 (7) (b) CA 1988 Cap 28 LFN 2004.

³¹⁷ This include purposes of instruction activity at all levels in educational institutions and purposes of all types of organised educational activity.

³¹⁸ Para 4(1) Forth Schedule CA 1988 Cap 28 LFN 2004.

³¹⁹ Performers, producers of phonograms and broadcasting organizations.

³²⁰ UNESCO Basic Notions about Copyright and Neighbouring Rights available at http://www.unesco.org/fileadmin/MULTIMEDIA/HQ/CLT/creativity/pdf/copyright/basic_notions_en.pdf accessed 14 March 2013.

³²¹ Performers rights are also referred to as media rights or entrepreneurial rights in the UK

³²² Olisa Agbakoba, Enhancing and Enforcing Performing Rights as Copyright available at <http://agbakoba-associates.com/media/Articles/Enhancing-and-Enforcing-Performing-Rights-as-Copyright.pdf> accessed 14 March 2013.

most other countries which refers only to performer's rights. Part two of the Nigerian Copyright Act is specifically devoted to neighbouring rights. This part consists of seven sections which provide for the protection of performers rights and the expression of folklore. Sections 26 through 30 provide for performers rights. Nigeria acceded to the Rome Convention in July 1993 and the Convention entered into force in October of the same year.³²³

a. Relationship of the TRIPS Agreement to the Rome Convention

The TRIPS Agreement equally requires that the provisions of the Rome Convention be applicable for the protection of performers, producers of phonograms (Sound Recordings) and Broadcasting Organisations.³²⁴ Members obligations under the Rome Convention are unaffected by this inclusion.³²⁵ Unlike the provision incorporating the Berne Convention on copyright which particularly mentioned the provisions that are applicable under the TRIPS Agreement, no particular provisions are referred to in relation to the protection of performers, producers of phonograms and Broadcasting Organisations. It seems that the intent of the Ministerial Conference is to apply the Rome Convention *mutatis mutandis*. The reason for this is clear: the Rome Convention, unlike the Berne Convention, does not have administrative provisions, most of the Rome Convention provisions are substantive provisions that relate to the subject matters protected.

The TRIPS Agreement particularly emphasises that members who intend to take advantage of paragraph 3 of article 5,³²⁶ or paragraph 2 of article 6³²⁷ of the Rome Convention shall

³²³ Treaties and Contracting Parties available at http://www.wipo.int/treaties/en/remarks.jsp?cnty_id=1134C 14 march 2013.

³²⁴ Article 1.3 TRIPS Agreement. See also Daniel Gervais, *The TRIPS Agreement Drafting History and Analysis* 2nd edition Sweet and Maxwell Croydon 2012 para 2.21, p.88. See also Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds) *WTO Trade Related Aspect of Intellectual property Rights Max Planck Commentaries on World Trade Law*, 7 Marinus Nijhoff Publishers Leiden Boston 2009 p. 209.

³²⁵ Article 2.2 TRIPS Agreement.

³²⁶ Article 5(3) Berne Convention provides that:

[b]y means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will not apply the criterion of publication or, alternatively, the criterion of fixation. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

³²⁷ Article 6(2) Berne Convention :

now refer all such notification to Council for Trade-Related Aspects of Intellectual Property Rights (the Council for TRIPS).³²⁸ Article 5(3) relates to the power given to members to exclude certain criteria, such as publication and fixation, whereas article 6(2) comprises members' powers to reserve rights to determine the protection of broadcast based on the place the broadcast is transmitted. These possibilities were not jettisoned in the TRIPS Agreement and members shall not derogate from such obligations.³²⁹ The provisions were singled out for the sole purpose of shifting the venue of deposit of the notification from the United Nation to the Council for TRIPS.

Notably, the TRIPS Agreement excludes performers, producers of phonograms and broadcasting organisations from national treatment (NT) obligations that are not under the TRIPS Agreement. Accordingly, NT obligation under the Rome Convention³³⁰ may not be applicable to all WTO members.³³¹ As well, members are exempt from obligations which are conferred by a function of the treatment accorded in another country and not based on national treatment.³³²

b. Protection of Performers' Rights in Nigeria

Similar to the rights enjoyed under copyright, under section 26 of the Act a performer has exclusive³³³ right to control his performances³³⁴ in relation to acts such as performing, recording, broadcasting live, reproducing in any material form and adaptation of the

[b]y means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will protect broadcasts only if the headquarters of the broadcasting organisation is situated in another Contracting State and the broadcast was transmitted from a transmitter situated in the same Contracting State. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

³²⁸ Article 1.3 TRIPS Agreement.

³²⁹ Article 2.2 TRIPS Agreement.

³³⁰ Article 2 Rome Convention.

³³¹ Article 3.1 TRIPS Agreement; see also Yusuf, Abdulqawi A. 'TRIPS: background, principles and General Provisions' in Carlos Correa and Abdulqawi Yusuf (Eds) *Intellectual Property and International Trade The TRIPS Agreement*. Kluwer Law International BV The Netherlands 2008 p. 18.

³³² Article 4(b) TRIPS Agreement.

³³³ The TRIPS Agreement does not give performers exclusive rights, but merely the possibility of preventing certain acts such as broadcasting and the communication to the public of their performances, fixation of their unfixed performances and reproduction of a fixed performance in certain cases.

³³⁴ Section 26 (2) provides that 'performance' includes-(a) a dramatic performance (which includes dance and mime); (b) a musical performance; and (c) a reading or recitation of literary act or any similar presentation which is or as far as it is, a live performance given by one or more individuals.

performance.³³⁵ Nigeria has no specific legislation on performers' rights, the right is provided for in the Copyright Act. The Act sets out certain provisions for performers' rights: these are very few and the content is limited. Nevertheless, it is an improvement on the Copyright Decree of 1970 which contained no provision on performers' rights.³³⁶ Only one section of the Act deals with acts that the performers have control over. The second section relates to the duration of performers' rights and the other three sections cover what constitutes the infringement of performances and how such infringements are actionable.

The protection of performers' rights in Nigeria is inadequate in comparison with what will be accomplished by protecting performers' rights.³³⁷ Section 26 does not define 'performers' rights' or 'performers', but defines 'performance' to include dramatic performance,³³⁸ musical performance and the reading or recitation of literary act or any similar presentation which is a live performance given by one or more individuals. As can be expected what constitutes an infringement of the performers' rights is clearly stated but what does not constitute an infringement use is vaguely stated. For instance, if consent has to be sought to use the work for research, private or domestic use, the Act states that it might not be unreasonably refused.³³⁹ This means that it can be refused which seems to be against the principle of fair dealing as provided for in relation to copyright. The provision also complicates matters in cases of research and educational purposes: each time a lecturer or student needs to use a performer's work they have to get the consent of the performer, which is not in the interest of the public.

The TRIPS Agreement mentions performers' rights only in relation to fixation of their performance on a phonogram (sound recording). This is a form of limitation of the right, in comparison to what exists in the Rome Convention.³⁴⁰ For the purpose of this discussion, it

³³⁵ Compare Article 7 Rome Convention.

³³⁶ Olisa Agbakoba, 'Enhancing and Enforcing Performing Rights as Copyright' p. 3 available at <http://agbakoba-associates.com/media/Articles/Enhancing-and-Enforcing-Performing-Rights-as-Copyright.pdf> accessed 14 March 2013.

³³⁷ Nigeria has a blooming entertainment industry.

³³⁸ Section 26(2) (a) CA 1988 Cap 28 LFN 2004. (Which includes dance and mime).

³³⁹ Section 28 CA 1988 Cap 28 LFN 2004.

³⁴⁰ Articles 3, 9, 19 Berne Convention.

is not contrary to the spirit of the TRIPS Agreement as it provides only a minimum standard to which a country is obligated.

The position of the performer in relation to a sound recording is rather uncertain under the Act because the author of the sound recording is the person who puts the arrangement together, unless a contract provides otherwise. The question is: Does the payment of remuneration to the performer take away the economic rights of the performer? If payment has been made, the performer cannot reproduce the performance without the consent of the owner of the sound recording. Under the UK Act the performer is entitled to equitable remuneration from the owner of the copyright in the sound recording: ‘an agreement is of no effect in so far as it purports to exclude or restrict the right to equitable remuneration under this section or prevent a person questioning the amount of equitable remuneration’.³⁴¹ The UK position places the performer in a better position than is the case in Nigeria.

Another important issue is the application of section 12 of the Act, which is an apparent anomaly created by the fact that only the ‘owner of the copyright’ is mentioned as being able to claim moral rights.³⁴² The position of the law is not clear whether moral rights extend to performers’ rights and section 26 does not mention them. The UK Act extended moral rights to performers in 2006³⁴³ after the adoption of the WPPT: therefore, it may be presumed that the Act could not have intended to extend moral rights to performers.

Based on the above, overall it seems that the Act complies with the provision of article 14.1 of the TRIPS Agreement though more needs to be done on the part of Nigeria in terms of the content of the Act.

c. Producers of Phonograms

The Rome Convention defines producers of phonograms as ‘the person who or the legal entity which first fixes the sounds of a performance or other sounds’.³⁴⁴ Under the Act, the

³⁴¹ Section 182D (2) UK CDP Act 1988.

³⁴² Section 12 comprises moral rights of an author.

³⁴³ Copyright Rights in performances (Moral rights etc Regulation 2006 (sI2006/18) amending UK CDP Act 1988.

³⁴⁴ Article 3 (c) Rome Convention. See also Article 1 (b) WPPT.

producer of a sound recording is not expressly mentioned,³⁴⁵ reference is made only to the ‘author’ of the sound recording, and is divided into two main categories, namely, the person who makes the arrangement of the sound recording and the author of musical works who is the artist whose name appears on the recording. Possibly, a third category could be determined by contract.³⁴⁶ The role of the producer of phonograms (sound recordings) is not clearly stated under the Act. In practice the producer of phonograms is usually the record label and the financier of the project who may or may not contribute any creative portion to the work.

The question is: Can the ‘producer’ be equated with the author under the Copyright Act? The definition of ‘producers of phonograms’ under the Rome Convention states that the person who first fixes the sounds of a performance or other sounds or the legal entity which first fixes the sounds of a performance or other sounds can be the producer. In this definition it seems that the author may be regarded as the producer in Nigeria.³⁴⁷ In the Act the relationship of the author and producer is however not clear cut, The UK CDP Act expressly states that the first copyright in sound recording is owned by the producer.³⁴⁸ Section 10 of the Act states that this sort of ownership cannot be presumed: the author shall be obliged to conclude, prior to the making of the work, contracts in writing with all those whose works are to be used in the making of the work. Ownership has to be determined as there is no mention of a producer anywhere in the Act.³⁴⁹

Despite the uncertainties regarding the application of section 51(1), the Act provides for the enjoyment of a right in sound recording in Nigeria by direct or indirect reproduction, broadcasting or communication to the public of the whole or a substantial part of the recording, either in its original form or in any form recognisably derived from the original, as required in article 14.2 of the TRIPS Agreement.³⁵⁰ At a glance, section 7,³⁵¹ granting

³⁴⁵ This is unlike the UK CDP Act 1988 which expressly provides that author, in the case of a sound recording is the producer; Section 9 (aa) UK CDP Act 1988.

³⁴⁶ Section 51 (1) on author of sound recording CA 1988 Cap 28 LFN 2004.

³⁴⁷ Article 3 (c) Rome Convention. See also Article 1 (b) WPPT.

³⁴⁸ CDPA 1988 sections 9(2) (aa) and 11(1).

³⁴⁹ Section 10 (4) CA 1988 Cap 28 LFN 2004.

³⁵⁰ Section 7 (1) CA 1988 Cap 28 LFN 2004.

³⁵¹ Section 7(1) (c) CA 1988 Cap 28 LFN 2004.

exclusive rights to control rental, lease, hire, loan or similar arrangement of the work to the public for commercial purposes, seems to be couched in such a way that enables producers, authors and other owners of rights in sound recording to be protected as well.

Generally, authors of a sound recording may not necessarily be the ones who claim the copyright in the work.³⁵² Usually, the relationship between the record producer and the performers is that of an independent contractor.³⁵³ The exception specified in paragraphs (h),³⁵⁴ (k),³⁵⁵ (l),³⁵⁶ and (p)³⁵⁷ of the Second Schedule to the Copyright Act shall apply to the copyright in sound recording in like manner as they apply to copyright in literary, musical or artistic work or a cinematograph film. Other, special exceptions in respect of records of sound recording are provided for under the third schedule.³⁵⁸

d. Broadcasting Organisations

Broadcasting is an important right under the Act because it is the fastest means to get a message across to the general populace. This right entails information, education and entertainment at the same time. The Act grants the copyright owner in broadcast an

³⁵² Section 51 (1) CA 1988 Cap 28 LFN 2004.

³⁵³ M Nimmer, Nimmer on Copyright 210[A] [3] at 2-150. See *Kolade Oshinowo v John Holt Group Co* FHC/L/60/86 ANF *Ojukwu v Anambra Motor Manufacturing Co.* FHC/E/17/92

³⁵⁴ The right conferred in respect of a work by Section 6 of this Act does not include the right to control-
 (h) any use made of a work in an approved educational institution for the educational purposes of that institution, subject to the condition that, if a reproduction is made for any such purpose it shall be destroyed before the end of the prescribed period, or if there is no prescribed period, before the end of the period of twelve months after it was made.

³⁵⁵ The right conferred in respect of a work by Section 6 of this Act does not include the right to control-
 (k) any use made of a work by or under the direction or control of the Government or by such public libraries, non-commercial documentation centres and scientific or other institutions as may be prescribed, where the use is in public interest, no revenue is derived therefrom and no admission fee is charged for the communication, if any, to the public of the work so used.

³⁵⁶ Para (l) the reproduction of a work by or under the direction or control of broadcasting authority where the reproduction of any copies thereof are intended exclusively for a lawful broadcast and are destroyed before the end of the period of six months immediately following the making of the reproduction or such longer period as may be agreed between the broadcasting authority and the owner of the relevant part of the copyright in the work, so however that any reproduction of a work made under this paragraph-

(i) may if it is an exceptional documentary character be preserved in the archives of the broadcasting authority (which shall for the purpose of this paragraph be deemed to be part of the National Archives) established under the Public Archives Act

(ii) subject to this Act, shall not be used for broadcasting or for any other purpose without the consent of the owner of the relevant part of the copyright in the work.

³⁵⁷ Para (p) any use made of a work for the purpose of judicial proceeding or of any report of any such proceeding.

³⁵⁸ Third Schedule CA 1988 Cap 28 LFN 2004.

exclusive³⁵⁹ right to control the recording³⁶⁰ and the re-broadcast of the whole or a substantial part of the broadcast³⁶¹ and the communication to the public³⁶² of the whole or a substantial part of a television broadcast, either in its original form or in any form recognisably derived from the original.³⁶³ This exclusive right includes sound or television broadcast by wireless telegraph, wire, or both, or by satellite or cable programmes³⁶⁴ and includes re-broadcast.³⁶⁵ The provision also extends copyright in a television broadcast to include the right to control the taking of still photographs from the broadcast.³⁶⁶ The author of a broadcast is the person who makes the arrangements or the transmissions from the country in which they were undertaken.³⁶⁷ Thus, the author may be a private person or broadcasting authority.³⁶⁸ Foreign broadcasts are also eligible for protection under the Act.³⁶⁹ The exceptions specified in paragraphs (a),³⁷⁰ (h),³⁷¹ (k)³⁷² and (o)³⁷³ of the Second Schedule of the Act are applicable to

³⁵⁹ The TRIPS Agreement does not give broadcasting organisation exclusive rights, but merely a right to prohibit others from fixation, the reproduction of fixations, rebroadcasting by wireless means of broadcasts and communication to the public of television broadcasts of the broadcast.

³⁶⁰ This equivalent to fixation required under the TRIPS Agreement.

³⁶¹ Section 8 (1) (a) CA 1988 Cap 28 LFN 2004.

³⁶² Section 51 (1) CA 1988 Cap 28 LFN 2004. 'communication to the public' includes, in addition to any live performance or delivery, any mode of visual or acoustic presentation, but does not include a broadcast or re-broadcast.

³⁶³ Section 8 (1) (c) CA 1988 Cap 28 LFN 2004; see Article 13 of the Rome Convention.

³⁶⁴ Section 51 (1) CA 1988 Cap 28 LFN 2004 defines 'cable programmes' means visual images, sounds or other information sent by means of a telecommunication system otherwise than by wireless telegraphy for reception- (a) at two or more places (whereas for simultaneous reception or at different times) in response to request by different users; or (b) for presentation to members of the public.

³⁶⁵ Section 51 (1) CA 1988 Cap 28 LFN 2004.

³⁶⁶ Section 8 (2) CA 1988 Cap 28 LFN 2004.

³⁶⁷ Section 51 (1) CA 1988 Cap 28 LFN 2004.

³⁶⁸ Section 51 (1) Copyright Act C28 LFN 2004 'broadcasting authority' means any authority established under any law in Nigeria or elsewhere providing broadcasting services for public reception.

³⁶⁹ Section 41 (a) and (c) CA 1988 Cap 28 LFN 2004.

³⁷⁰ The right conferred in respect of a work by Section 6 of this Act does not include the right to control- (a) the doing of any of the acts mentioned in the said Section 5 by way of fair dealing for purposes of research, private use, criticism or review or the reporting of current events, subject to the condition that, if the use is public, it shall be accompanied by an acknowledgement of the title of the work and its authorship except where the work is incidentally included in a broadcast.

³⁷¹ The right conferred in respect of a work by Section 6 of this Act does not include the right to control- (h) any use made of a work in an approved educational institution for the educational purposes of that institution, subject to the condition that, if a reproduction is made for any such purpose it shall be destroyed before the end of the prescribed period or if there is no prescribed period, before the end of the period of twelve months after it was made.

³⁷² The right conferred in respect of a work by Section 6 of this Act does not include the right to control- (k) any use made of a work by or under the direction or control of the Government or by such public libraries, non-commercial documentation centres and scientific or other institutions as may be prescribed, where the use is in public interest, no revenue is derived

copyright in broadcast in the same way as they apply to copyright in literary, musical or artistic works or a cinematograph film.

Accordingly, the Copyright Act grants the required protection to broadcasting organisations under section 8 and complies with article 14.3 of the TRIPS Agreement.

e. Rental Rights of Producers of Phonograms

The extension of the application of rental rights³⁷⁴ to producers of phonogram and other right holders as provided for under article 14.4 TRIPS Agreement is not expressly provided for under the Act but can be implied from the nature of the protection of sound recordings which grants exclusive rights of distribution to the public by way of rental.³⁷⁵ However, this provision does not mention equitable remuneration for right holders in respect of the rental of sound recording. Care must be taken, however, not to confuse³⁷⁶ the provision on fees³⁷⁶ in the Copyright (Video Rental) Regulations with the system of equitable remuneration of right holders of phonograms because the Regulation only provides for cinematograph films.

f. Term of Protection

Article 14.5 provides for the term of protection of performers, producers of phonograms (sound recordings) and broadcasting organisations. The Act provides a term of protection of 50 years from the end of the calendar year in which the fixation was made or the performance took place, which is in line with the prescribed duration of protection for performers, producers of phonograms under the TRIPS Agreement. The term of protection granted to broadcasting organisations under the TRIPS Agreement is for at least 20 years from the end of the calendar year in which the broadcast took place: the Nigerian Act sets its term of protection at 50 years. The provision in the TRIPS Agreement is the minimum

therefrom and no admission fee is charged for the communication if any, to the public of the work so used.

³⁷³ The right conferred in respect of a work by Section 6 of this Act does not include the right to control- (o) the communication to the public of a work, in a place where no admission fee is charged in respect of the communication, by any club whose aim is not profit making.

³⁷⁴ Article 11 TRIPS Agreement.

³⁷⁵ In addition to what the TRIPS Agreement provides, Articles 9 and 13 of the WPPT grant exclusive rental rights to performers and phonogram producers in respect of commercial rental of the original and copies of their performances and phonograms.

³⁷⁶ Rule 7 Copyright (Video Rental) Regulations 1991.

standard expected from members; members can provide a longer term of protection if they so wish. Unlike the Rome Convention, which provides a uniform term of protection of 20 years for performers, producers of phonograms and broadcast, the TRIPS Agreement provides a longer term of protection for performers and producers of phonograms.

g. Public domain

The second paragraph of article 14.6 provides that article 18 of the Berne Convention should be applied *mutatis mutandis*, to the rights of performers and producers of phonograms. This provision indicates that the TRIPS Agreement would apply only to works which at its coming into force had not yet fallen into the public domain through the expiry of the term of protection. The Copyright Act does not make mention of a public domain, but it is clear that works that have fallen into the public domain will not receive extended protection as a result of the TRIPS Agreement.

4.3.3.9 Conclusion

Having examined the compliance of Nigerian copyright law to the TRIPS Agreement, it is evident that the law is not in full compliance. This issue will further be examined under areas which require modification.

4.4 Impact Assessment

As stated by Thorpe ‘very little concern has been raised about the TRIPS obligations in the field of copyright.’³⁷⁷ The irony of copyright protection is that the product sort to be protected is intangible and in the ‘public domain’ and accessible to all. The law is what prevents the ‘use’ of the work without authorisation and gives flexibility in interpreting the use. Nigerian legislation requires only a few changes for it to offer adequate copyright protection. Some variation is possible in areas where the TRIPS Agreement does not prevent obligatory access to protected works: areas which are affected by stringent legislation include access to knowledge and information.

³⁷⁷ Thorpe, P. Commission on Intellectual Property Rights Study Paper 7 Study on the Implementation of the TRIPS Agreement by Developing Countries available at http://www.iprcommission.org/papers/pdfs/study_papers/sp7_thorpe_study.pdf accessed 20 March 2013.

In Nigeria the entertainment and musical industries have an active pro-copyright protection organisation that intensely and passionately advocates adequate protection of their rights.³⁷⁸ These organisations engage in lobbying for legislative amendments that adopt ‘Berne-plus’ and ‘TRIPS-plus’ provisions and help in the prevention of infringements of such rights. In particular, the Performing Musicians Employee Association of Nigeria (PMAN) was a driving force in repealing the 1970 Copyright Act and bringing copyright protection in Nigeria to a Berne-plus level. Unfortunately, this type of formidable cooperation does not exist among the owners of literary works despite the fact that there has been an Association of Nigeria Authors since 1981. A fundamental objective for the association is to ‘promote the interest of authors in all that concerns their profession and well-being and to protect their rights as authors.’ Considering the rich author base in Nigeria this strength has not translated into access to knowledge, learning materials and information.

4.4.1 Access to Knowledge in Nigeria

Knowledge as an essential currency for propagating economic growth and development cannot be over-emphasised. Access to knowledge (A2K) has come to the fore-front of many discussions and forums.³⁷⁹ In recent times it has been a source of concern to developing countries and least developed countries. Access to educational materials, especially in the field of higher scientific and technical education, is crucial for the development of human resources in order to contribute to the economic progress of developing countries. The concern is as a result of the advent of the TRIPS Agreement which raises many questions regarding the constraint on the growth of knowledge and an equitable access to knowledge resources. The challenge is how to guarantee continuous generation and dissemination of knowledge.³⁸⁰

³⁷⁸ Performing Musicians Employee Association of Nigeria (PMAN), Copyright Society of Nigeria (COSON) and Musical Copyright Society of Nigeria Ltd.

³⁷⁹ World Summit on the Information Society (WSIS).

³⁸⁰ Aman Assefa, ‘Information and Communication Technology in Ethiopia:’ Challenges and Prospects from an A2K Perspective Gathering of the Access to Knowledge Global Academy Information Society Project at Yale Law School Proceedings New Haven, CT August 2009 available at http://www.law.yale.edu/images/ISP/A2KGA_Proceedings.pdf accessed 20 March 2013.

At this juncture it is pertinent to ask if there is a problem in relation to access to knowledge in Nigeria. What is the cause of this problem? Is the problem solvable by amending the laws or not? What has been the government's response to the problem in terms of policies and strategies? These questions need to be considered in the context that access to knowledge is relative and depends on a number of factors.

A major challenge that is faced in relation to copyright is access to knowledge, mainly in the area of access to learning materials. Copyright-enabled industries determine the price and the availability of copyrighted materials. In examining the effect of copyright on access to knowledge, it is important to know what knowledge consists of.

Shaver and Rizk, in their discussion of access to knowledge, refer to 'knowledge' as including 'data, information, tools, inventions, literature, scholarship, art, popular media and other expressions of human inquiry and understanding', and 'access comprises 'not only of the right to access these products as consumers, but also the right to participate as producers in their creation, manipulation and extension.'³⁸¹ Castells defines knowledge as 'a set of organised statements of facts or ideas, presenting a reasoned judgment or an experimental result, which is transmitted to others through some communication medium in some systematic form.'³⁸²

The A2K movement advocates that knowledge that is essential for the meaningful development of a human being and of communities must be disseminated for the development of individual and communities and must be distributed extensively and equitably.³⁸³ 'Access to knowledge' is the umbrella term for a movement that aims to create more equitable public access to the products of human culture and learning.³⁸⁴ Put succinctly

³⁸¹ Shaver, Lea Bishop and Rizk, Nagla, 'Access to Knowledge in Egypt: New Research on Intellectual Property, Innovation and Development', Nagla Rizk, eds., Bloomsbury Academic, Bloomsbury Publishing, UK, USA, 2010; Hofstra Univ. Legal Studies Research Paper No. 10-48. Available at SSRN: <http://ssrn.com/abstract=1729370> accessed 20 March 2013.

³⁸² Manuel Castells, *The Rise of the Network Society*, 2nd ed. (Oxford: Blackwell, 2000), pp. 169–172.

³⁸³ Aman Assefa, p. 161.

³⁸⁴ Frederick Noronha and Jeremy Malcolm, (ed) *Access to Knowledge: A Guide for Everyone*, Consumers International Kuala Lumpur, 2010 p.2.

by Assefa ‘the proprietary system of knowledge management reinforced by intellectual property (IP) laws, is the major target of these movements.’³⁸⁵

Nigeria, obviously, has a severe problem in terms of access to knowledge in the area of learning material and open access. According to a Department for International Development (DFID) report, ‘Nigeria’s educational system as facing ‘a multi-dimensional crisis’. Access is limited and quality is poor.’³⁸⁶ Nigeria is home to 10.5 million out-of-school children (3.6 million more than in 2000) 42% of its primary school-age population which translates into over 17% of the world’s out-of-school population.³⁸⁷ The 2011 statistic report had 9 million out-of-school children or 37% of its primary school-age population. It is obvious there is a crisis.³⁸⁸

Very few books catering for primary and secondary school’s needs as educational materials are published.³⁸⁹ Statistics relating to access to learning material in Nigeria are worrisome. It was reported that 90% of the annual output of books published in Nigeria is in the area of textbooks for primary and secondary education resulting in a dearth of textbooks for tertiary institutions.³⁹⁰ As stated by Ike, several recommendations on various facets of book production and distribution have been made by task forces, study groups, conferences and committees³⁹¹ to look into ways of equipping the book sector to meet the needs of the

³⁸⁵ Aman Assefa p.162-3.

³⁸⁶ DFID’s Education Programmes in Nigeria available at <http://icai.independent.gov.uk/wp-content/uploads/2012/11/ICAI-Nigeria-Education-report2.pdf> accessed 21 March 2013.

³⁸⁷ Out-of-School Children: New Data Reveal Persistent Challenges, UNESCO Institute for Statistics, November 2012, available at <http://www.uis.unesco.org/Education/Documents/fs-18-OOSC-2.pdf> 21 March 2013.

³⁸⁸ Out-of-School Children: New Data Reveal Persistent Challenges, UNESCO Institute for Statistics, June 2011, available at http://www.uis.unesco.org/FactSheets/Documents/FS12_2011_OOSC_EN.pdf. 21 March 2013.

³⁸⁹ Chukwuemeka Ike, ‘Book Publishing In Nigeria’ available at www.sabre.org/publications/publishing-in-nigeria.pdf accessed 21 March 2013.

³⁹⁰ Adubika Thomas , ‘Assessment of The Emergence of E-Books As Antidotes To Paucity of Tertiary Textbooks In Nigeria’ *The Information Manager* Vol. 11 (1&2)2011, see also Nkechi M. Christopher ‘Applying Marketing Concepts to Book Publishing in Nigeria’ *Uluslararası Sosyal Ara tirmalar Dergisi The Journal of International Social Research* Volume 3 / 11 Spring 2010 206- 212.

³⁹¹ Panel on a Book Policy for Nigeria1987, Ministerial Committee on Provision of Books to Schools and Colleges1990, National Conference on Book Development organized by the Nigerian Book Foundation on the theme ‘Making Books Readily and Affordable,’ 1994 and most recently Bring Back the Book initiative 2010.

Nigerian educational system.³⁹² These efforts have not resulted in access or a change in strategy by the government

Publishers have raised concerns regarding piracy of locally published books in some countries in South-East Asia: these books are published in a large quantity outside the country and brought back to Nigeria. Advancements in technology make it easy for pirated copies to pass as original copies.³⁹³ Other challenges that are faced include the low production of books for tertiary institutions,³⁹⁴ the poor distribution network of books within the country³⁹⁵ coupled with the low quality of the books produced as a result of bad finishing because of a lack of skilled personnel and standard printing equipment.³⁹⁶ The printing technology used by most publishers is obsolete as is evident from the quality of the books turned out.

Despite the high turnout of articles and books by academia, access remains low. A factor that inhibits access is the absence or low level of online or open journal systems or an open access resource in most universities and tertiary institutions. Considering the fact that the major problem of access is at the level of tertiary institutions, an open access policy is necessary because it allows ‘free online access to quality scholarly material that can be defined as ‘open domain,’ meaning research information can be publicly secured, so that copyrighted scholarly material can be freely available.’³⁹⁷ Open access is used in a number of developing countries to boost their scholarly base. Open access can be realised only through

³⁹² Chukwuemeka Ike, ‘Book Publishing In Nigeria’ available at www.sabre.org/publications/publishing-in-nigeria.pdf accessed 21 March 2013.

³⁹³ Femi Olukunle ‘Reading culture not dead but poor in Nigeria’, *Nigerian Tribune* Monday, 22 March 2010 available at <http://tribune.com.ng/index.php/features/2907-reading-culture-not-dead-but-poor-in-nigeria-md-evans-publishing-company> accessed 22 March 2013; Nigerian 2009 Special 301 Report on Copyright Protection and Enforcement International Intellectual Property Alliance (IIPA) available at <http://www.iipa.com/rbc/2009/2009SPEC301NIGERIA.pdf> accessed 01 March 2013.

³⁹⁴ Because of the low production of books for tertiary institution a large number of books are imported from majorly the UK and the USA.

³⁹⁵ Nwali L. O., Book Publishing in Nigeria: Problems and Prospects Publishing Research Quarterly / Winter 1991/92 p. 67 available at http://download.springer.com/static/pdf/496/Article%253A10.1007%252F02678333.pdf?auth66=1365233316_c07bb59d8bec5b204ef1d89df9f747a&ext=.pdf accessed 22 March 2013.

³⁹⁶ Nwali L. O., Book Publishing in Nigeria p.66.

³⁹⁷ Julie M. Esanu and Paul F. Uhlir, (eds) Open Access and the Public Domain in Digital Data and Information for Science Proceedings of an International Symposium, Rajashekar T. B. Open-Access Initiatives in India 2004 The National Academies Press Washington, D.C. p.154.

digitisation,³⁹⁸ which requires technical skills and technology transfer which is not readily available currently in Nigeria. Currently, only three universities in Nigeria³⁹⁹ have a semblance of open access.

Other factors that affect access to knowledge in Nigeria are the frequent changes in the educational system and the curriculum, a lack of infrastructure, a lack of qualified teaching staff, a lack of text books, a lack of information and corruption.⁴⁰⁰

Access is determined both by availability and affordability of knowledge.⁴⁰¹ It is important to ensure that educational materials are not highly priced and remain affordable:⁴⁰² if educational materials are priced at a level that is beyond the reach of consumers in developing countries, eventually, this causes a barrier to access knowledge.

There is a campaign for an Access to Knowledge Treaty by several civil society groups. The Access to Knowledge Treaty is intended to ease the transfer of knowledge to developing nations and to secure the viability of open innovation systems all over the world: it is the initial goal of the A2K movement. The movement takes into account copyright laws and other regulations that affect knowledge.⁴⁰³ Lack of access to knowledge and information has serious implications for education, libraries and other information providers.⁴⁰⁴ In 2010, there was an African Copyright and Access to Knowledge (ACA2K) project which recognised the probable impact of copyright and other intellectual property (IP) laws, policies and regulations on access to educational and learning materials. In the book *Access to knowledge in Africa*, eight countries⁴⁰⁵ were examined, the result of the finds in the book

³⁹⁸ Chimezie .P. Uzuegbu, ‘Management of Nigerian Copyright Law and the Open Access Initiative: A Bridge to attaining information for all in Nigeria’ available at E-LISeprints.rclis.org accessed 19 March 2013.

³⁹⁹ Covenant University Ogun, University of Jos and University of Nigeria Nsukka.

⁴⁰⁰ Kwame Akyeampong, Ricardo Sabates, Fran Hunt and Jane Anthony Review of Research on Basic Education Provision in Nigeria *Centre for International Education University of Sussex* May 2009.

⁴⁰¹ Copyright and Access to Knowledge Policy Recommendations on Flexibilities in Copyright Laws Consumers International Asia Pacific Office Kuala Lumpur 2006 .2.

⁴⁰² Copyright and Access to Knowledge Policy Recommendations on Flexibilities in Copyright Laws p.3.

⁴⁰³ A2K Guide for everyone p.3.

⁴⁰⁴ IFLA and the Access to Knowledge (A2K) Treaty: Statement by IFLA (2005) Inter-sessional Intergovernmental Meeting on a Development Agenda for WIPO 1st Session, Geneva April 11-13, 2005.

⁴⁰⁵ Egypt, Ghana, Kenya, Morocco, Mozambique, Senegal, South Africa and Uganda.

is of utmost importance to Africa particularly in formulating copyright policies that would enable access to learning materials.⁴⁰⁶

The question has been asked as to ‘why and how knowledge matters in the world today,’⁴⁰⁷ and the answer is obvious: knowledge is the currency spent in every facet of life today. Without knowledge and information technology transfer foreign direct investment will be a waste and cannot function to achieve its aim. For Armstrong *et.al* ‘education is integral to development. It is a catalyst for poverty reduction and economic growth, a pillar of public health and community building’.⁴⁰⁸ In summary, repopulating what Krikorian claims the effect of a few words in a treaty may completely change the meaning of the whole treaty and the effect can be significant. In this situation the TRIPS Agreement has created immaterial legal walls to enclose information and knowledge: ‘the raw material of which immaterial goods, ideas, and inventions are made and, as such, they are key to individuals as well as collective human development and welfare’.⁴⁰⁹

4.5 Required Modifications

4.5.1 Level of Compliance with TRIPS Agreement

The issue of bringing Nigerian Copyright law into full compliance with the TRIPS Agreement is not in the fore front of issues facing in Nigeria. The extension of GATT to ‘incorporate’ the Berne Convention broadens the issues which a country has to look at to attain conformity with the TRIPS Agreement. The interpretation of the TRIPS Agreement also requires the interpretation of the pre-existing intellectual property treaties.⁴¹⁰ In addition, conformity with the TRIPS Agreement entails a balance between compliance with the TRIPS Agreement and the public interest.⁴¹¹ On the face of it, it seems that the Nigerian Copyright

⁴⁰⁶ Chris Armstrong, Jeremy de Beer, Dick Kawooya, Achal Prabhala and Tobias Schonwetter *Access to Knowledge in Africa: The Role of Copyright* UCT Press Cape Town 2010 p. 17.

⁴⁰⁷ Amy Kapczynski ‘Access to Knowledge: A Conceptual Genealogy Zone’ in Gaëlle Krikorian and Amy Kapczynski (eds.) *Access to Knowledge in the Age of Intellectual Property* One Books New York 2010 p.18

⁴⁰⁸ Armstrong *et al* p. 1.

⁴⁰⁹ Amy Kapczynski ‘Access to Knowledge: A Conceptual Genealogy Zone’ p.58.

⁴¹⁰ Carlos Correa, ‘The WTO Dispute Settlement Mechanism TRIPS Rulings and the Developing Countries’, *The Journal of World Intellectual Property* (Vol. 4, 2001), p. 253.

⁴¹¹ Peter Draho, ‘Developing Countries and International Intellectual Property Standard-Setting’, *The Journal of World Intellectual Property* (Vol. 5, 2002), p. 766.

Act complies with the TRIPS Agreement, however, a keener look reveals that this is not exactly so. As a member of the WTO Nigerian lawmakers do not have complete liberty to formulate their own copyright laws due to continual pressure to ratchet upward the protection granted to rights holders.⁴¹² Below are some of the areas which require modification as noted in the discussion above.

4.5.2 Subject Matter Protected

The protection of dramatic works⁴¹³ and dramatico-musical works⁴¹⁴ is conspicuously absent in the Act.⁴¹⁵ Dramatic works are mentioned in Third Schedule of the Act⁴¹⁶ without prior citing. The omission may not seem important, but in a country that has a thriving entertainment industry, protection of such works is necessary.

4.5.3 Expression and Idea and other Excludable Subject Matters

The ‘expression’ and ‘idea’ dichotomy is not mentioned in the Act. The TRIPS Agreement in article 9.2 clearly states expression is protected under copyright, but ideas, procedures, methods of operation or mathematical concepts are not protected under copyright. Apart from artistic works, where models or patterns to be multiplied by any industrial process are excluded from copyright protection, there is no provision that excludes other subject matters from copyright protection. Although the courts have held in *Nigerian Copyright Council v Musical Copyright Society of Nigeria*⁴¹⁷ that copyright protects works which represent the expression of thoughts but the ideas are not protected. If the Act is to conform to the TRIPS Agreement, the law must clearly exclude ideas, procedures, and methods of operation or mathematical concepts from copyright protection, as unimportant as they seem.

⁴¹² Copyright and Access to Knowledge Policy Recommendations on Flexibilities in Copyright Laws Consumers International Asia Pacific Office Kuala Lumpur 2006 p. 2.

⁴¹³ Dramatic work includes any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting form of which is fixed in writing or otherwise but does not include a cinematograph film;

⁴¹⁴ Dramatico-musical work includes works such as a musical comedy, oratorio, choral work, opera, play with music, revue or ballet.

⁴¹⁵ John Asien, *Nigerian Copyright Law and Practice* 2nd ed. Book and Gavel Abuja p. 45.

⁴¹⁶ Third Schedule of the Copyright Act on Special Exceptions in respect of Records of Sound Recording

⁴¹⁷ Suit No. FHC/L/43c/99 (unreported).

4.5.4 Rental Rights

Another area which needs to be modified in the Act is the provision on rental rights as provided by the TRIPS Agreement.⁴¹⁸ As mentioned above the provision that can be implied as rental rights is not immediately obvious from the provisions of the Act but deducible from distribution rights.⁴¹⁹ As discussed earlier there is no express provision on rental rights in the Act, though these provisions can be adapted for the purpose of protecting the wide spread copying of local works through unmonitored rental services of copyright works. The Copyright (Video Rental) Regulation⁴²⁰ requires an accreditation to engage in the business of rental, leasing, hiring, loaning or otherwise distributing cinematograph works to the public for commercial purposes. A critical examination of the regulation reveals that the regulation dwells more on the provision of licences for business owners than on the protection of the right owners and the equitable distribution of remuneration for the use of their work. The regulation contains no provision for payment to the right owner, it comprises only of a fee provision on the transaction under the Regulations.

Even though this Regulation is to provide an accredited system for renting of movies, the Regulation has not been enforced properly. Almost every street has a local renting kiosk where a single original CD or DVD is copied into a number of copies to be rented out. It is safe to say that all rental shops in Nigeria do not possess a licence from the NCC and these rental shops are part of a larger piracy enterprise.

The issue relating to rental of works has become important in ensuring the adequate protection of copyright in works. The reasoning for the inclusion of this provision in the TRIPS Agreement was to curb widespread and unauthorised copying that was preventing right holders from selling original copies of their works,⁴²¹ resulting in reduced sales volume and less revenues for the copyright holders.⁴²² When a work has been sold by the copyright

⁴¹⁸ Article 11 TRIPS Agreement.

⁴¹⁹ Section 6 (1) (a) (iv), and Section 6 (1) (c) (iv) CA 1988 Cap 28 LFN 2004.

⁴²⁰ Copyright (Video Rental) Regulation September 7, 1999.

⁴²¹ Resource Book on TRIPS p.174.

⁴²² The ABC of Copyright United Nations Educational, Scientific and Cultural Organisation (UNESCO) p. 40

holder it is difficult to control the use of the work; the holder does not benefit from activities that transpire thereafter which may include rental or borrowing of the work.⁴²³

Furthermore, the Act does not contain the meaning of ‘rental’, neither does the Regulation. The right is lumped among other distribution rights and the Regulation relates only to cinematograph films. This narrow approach in the Nigerian Act contrasts sharply with the purposive approach of other jurisdictions, such as the UK where rental rights relate to all the works protected,⁴²⁴ the meaning of ‘rental rights’⁴²⁵ and what the expression ‘rental rights’ does not consist of are explained under the UK CPD Act.⁴²⁶ It is proposed that a specific section in the Act should be devoted to rental rights: to articulate the works to be protected the definition of ‘rental rights’ including what it does not cover and with an equitable remuneration provision.

4.5.5 *Droit de suite* or ‘resale right’

Section 13 of the Act provides for *droit de suite* or ‘resale right’ which grants the copyright owner an inalienable right to share in the proceeds of any sale of that work or manuscript by public auction or through a dealer, whatever the method used by the latter to carry out the operation. The Act gives the Nigerian Copyright Commission the right determine the conditions of the right by a Regulation. Currently there is no Regulation on the provision of resale rights in Nigeria so most artist lose out on the percentage of revenue from the resale of their work.

4.5.6 Limitation and Exceptions

The Nigerian Act has a fair amount of limitations and exceptions, however, certain provisions of the exceptions need to be expounded upon so that the meanings of the provisions are expressly conveyed. The schedule does not have a definition section which makes the schedule vague. Paragraph (a) of the Second Schedule of the Act which grants exceptions from copyright control needs to be reviewed. Paragraph (a) does not define ‘fair

⁴²³ The ABC of Copyright p. 42.

⁴²⁴ Section 18 A (1) UK CPD Act.

⁴²⁵ Section 18 A (2) UK CPD Act.

⁴²⁶ Section 18 A (3) UK CPD Act.

dealing’ for purposes of research, private use, criticism or review or the reporting of current events and educational purpose. In addition, ‘research uses’, ‘private use’ and ‘educational purpose’ are not defined in the Act.

Neither the provision nor has case law stated factors that can be used to determine whether the use made of a work in any particular case is fair dealing.⁴²⁷ For instance section 107 of the US Copyright Act provides that teaching (including multiple copies for classroom use) is considered as ‘fair use’. The question is: Does fair use include multiple copies of a whole book for several students? This does not seem to be the intent of the law, as a determining factor in the law made clear that ‘the amount and substantiality of the portion used in relation to the copyrighted work as a whole’ and ‘the effect of the use upon the potential market for or value of the copyrighted work’ would be taken into consideration.⁴²⁸ The Copyright Act, therefore, has to include determining factors to curb the open-ended use of this provision. A well-regulated course pack system should be put in place to reduce the high level of copying of books in tertiary institutions. In addition, the long awaited Nigeria Book Policy⁴²⁹ should be revisited to help alleviate the problem of a lack of text books.

Paragraph (k), which relates to exceptions for public libraries, non-commercial documentation centres and scientific or other institutions, needs to be redrafted to include private libraries and documentation centres that are open to the public. The reason is that private libraries assist in providing services to the public due to the low number of public libraries available. Therefore, if they are not allowed to benefit from this provision in the law, they will eventually fold and this put pressure on the very few public libraries available. Education and libraries go hand in hand; indeed many libraries are situated in educational institutions. An excellent education service depends on good libraries, which are not only

⁴²⁷ The United State provides for a four factor balancing test which balances the rights of copyright owners against that of users. § 107. Limitations on exclusive rights: Fair use. See also *Folsom v. Marsh*, 9 F. Cas. 342, No. 4,901 (C.C.D. Mass. 1841).

⁴²⁸ *Basic Books, Inc. v Kinko’s Graphics Corp.*, 758 F.Supp. 1522 (S.D.N.Y. 1991); *Princeton University Press v Michigan Document Services, Inc.*, 99 F.3d 1381 (6th Cir. 1996).

⁴²⁹ Nigerian Educational Research and Development Council (NERDC) Act No. 53 of 1988 provides for the statutory responsibilities which shall include book Development.

physical spaces but also 24/7 digital learning environments.⁴³⁰ Libraries should be allowed to copy works only if they cannot be obtained commercially. Provision for the use of orphaned works should be included.

It is important for the Act to have a provision that allows parallel importation of copyright works as this would make more books available for use in schools and libraries. Additionally, consideration needs to be given to the use of works for adult education courses, adult literacy campaigns and distance learning which would expand the meanings of an ‘educational institution’ and ‘educational purposes’ which is necessary in a country with a high illiteracy rate.⁴³¹ The African Group at the WIPO Standing Committee on Copyright and Related Rights (SCCR)⁴³² proposes ‘the promotion of education, science and useful arts for public welfare’ to be the principal objective of a copyright system. This is a good proposal that should be taken into consideration when reviewing the law.

With regards to the disability exception, the Act should be amended to provide for acknowledgement of the author, publisher and the work. In addition, it should be expressly indicate whether or not a contract agreement can override adaptation of the works and provisions regarding the interplay with digital right management (DRM) should be included in the exception.

From the discussion above on performers’ rights, it is shown to be necessary to provide explicit exceptions for the use of performances for research, private or domestic use without hindrance. Moral right too, should expressly be extended to performers as there has been an increase in methods of dissemination of performances.

⁴³⁰ Joint intervention by IFLA: International Federation of Library Associations & EIFL: Electronic Information for Libraries & CLA: Canadian Library Association at http://www.ifla.org/files/assets/hq/topics/exceptions-limitations/documents/IFLA_SCCR24_Education%20statement_Fin.pdf accessed 22 March 2013.

⁴³¹ 40 million adults are illiterate and the overall literacy rate is close to 57 %. Available at http://www.unesco.org/new/en/dakar/about-this-office/single-view/news/major_push_for_adult_and_youth_literacy_in_nigeria/ accessed 22 March 2013.

⁴³² WIPO Standing Committee on Copyright and Related Rights, 24th Session Twenty-fourth Session Geneva, July 16 to 25, 2012 Provisional Working Document Towards an Appropriate International Legal Instrument (In Whatever Form) on Limitations and Exceptions for Educational, Teaching and Research Institutions and Persons with other Disabilities Containing Comments and Textual Suggestions.

4.5.7 Producers of Phonograms (sound recording)

The definition of owners of sound recording is ambiguous and should be made clear. The definition of the author of a sound recording should not be used to determine who is the owner of the work. Producers of sound recordings should be specifically included in the Act. In addition, equitable remuneration of right holders in respect of rental of sound recordings should be included in the Act.

Nigeria has been in the process of amending its national intellectual property laws⁴³³ for the past 12 years. There is a Bill before the National Assembly to bring its laws in compliance with the TRIPS Agreement.⁴³⁴ In Nigeria's notification to the TRIPS Council in 2002, the Council was informed that:

The Federal Government of Nigeria has given approval for the amendment of the national intellectual property laws to make them fully in compliance with the TRIPS Agreement. Approval has been given by the Government for the establishment of the Intellectual Property Commission of Nigeria (IPCON) with a view to strengthening and streamlining the administration of intellectual property system. The draft bill is being processed and will soon be presented to the National Assembly for it to be passed into law. It is anticipated that the Intellectual Property Commission will handle the administration of Copyright, Patents, Designs, Trademarks and all other aspects of intellectual property. The IPCON will be established sometime in the middle of this year. [2002]

Till now Nigeria has not passed the Bill to make the law fulfil the purpose of treaties it has ratified,⁴³⁵ neither is there any Bill before the National Assembly in relation to intellectual property or copyright.

4.6 Flexibilities in relation to Copyright and Related Rights

Profound discontent has been voiced by developing and least developing countries concerning the interpretation and implementation of the TRIPS Agreement.⁴³⁶ This is rightly so considering the terms of negotiation during the Uruguay Round. Issues of access to

⁴³³ Trademarks Act and Patent and Design Act.

⁴³⁴ A Bill for 'An Act to Provide for the Establishment of the Intellectual Property Commission of Nigeria, Repeal of Trade Marks Act Cap 436, LFN 1990 and Patents and Designs Act, Cap 344, LFN 1990 and made comprehensive provisions for the Registration and Protection of Trademarks, Patents and Designs, Plant Varieties, Animal Breeders and Farmers Rights and for other Related Matters.

⁴³⁵ Shaw M.N., *International Law* Cambridge, Cambridge University Press 2003 818.

⁴³⁶ Peter Yu, *The Objectives and Principles of the TRIPS Agreement* p. 1.

medicines, access to knowledge and information, as well as technology transfer, have been on the front burner since the implementation of the TRIPS Agreement.

Although, the industrialised countries have not lived up to their promises of assisting developing countries, the TRIPS Agreement leaves room for member countries to manoeuvre. In the words of Yu ‘the Agreement, in its defense, includes a number of flexibilities to facilitate development and to protect the public interest.’ He further states that the flexibilities are safeguarded by articles 7 and 8 which play an important role in the interpretation and implementation of the TRIPS Agreement.⁴³⁷ Flexibilities should be adapted to the various sectoral needs of a country.⁴³⁸ Several flexibilities have been highlighted relating to copyright and related rights. In particular, the Consumers International⁴³⁹ has outlined the flexibilities in relation to the Conventions and Agreement countries can ratify in terms of its maximum access to knowledge by considering the scope of copyright protection, the duration of copyright protection and limitations and exceptions.

4.6.1 Nature and Scope of Obligations under Article 1 TRIPS Agreement

The first article of the TRIPS Agreement gives WTO members the freedom to choose suitable methods of implementing the provisions of the TRIPS Agreement in their National laws.⁴⁴⁰ In effect, members are not bound to any format in executing the provisions of the TRIPS Agreement. This concession offers a substantial flexibility that is granted to members because, when combined with articles 7 and 8 of the TRIPS Agreement, it means that protection of intellectual property rights should contribute... to the mutual advantage of producers and users... in a manner conducive to social and economic welfare, to a balance of rights and obligations and members are free to formulate or amend their laws and regulations, adopt measures necessary to protect ... promote the public interest in sectors of

⁴³⁷ Peter Yu, *The Objectives and Principles of the TRIPS Agreement* p. 1.

⁴³⁸ Carlos M. Correa, ‘Integrating Intellectual Property Rights (IPRs) and Development Policy’ Africa IP Forum February 25, 2013 available at www.thedti.gov.za/business_regulation/presentation/intergrating_ip_development.pdf accessed 22 March 2013.

⁴³⁹ Consumers International (CI) is a world federation of consumer groups that, serves as the only independent and authoritative global voice for consumers. CI is a not-for-profit company.

⁴⁴⁰ Article 1 TRIPS Agreement.

vital importance to their socio-economic and technological development.⁴⁴¹ These are essential provisions for developing countries, Nigeria inclusive to take and run with.

4.6.2 The Scope of Copyright Protection

The TRIPS Agreement, by the adoption of the Berne Convention, gives member countries the right to determine the work that is protected under each member's law. Members are not required to extend protection to works that are not listed in the Berne convention: protected works can be limited to the mentioned works only, as it suits the member state. Moreover, members can determine any specified categories of works that shall not be protected unless they have been fixed in some material form.⁴⁴² The TRIPS Agreement extends the works to be protected by including computer programs and compilations of data.⁴⁴³

By the general nature of copyright there are lots of exclusive rights that are attached to it, generally referred to as a bundle of rights. Even though moral rights are not required to be granted by the TRIPS Agreement, it is a requirement of the Berne Convention⁴⁴⁴ and its inclusion in the Act does not go against the intent of the TRIPS Agreement.

WIPO advises⁴⁴⁵ that developing countries should not jump at all the flexibilities: this position is supported in the sense that flexibilities should be applied according to the needs of the country. For instance, the flexibility that governs the right to control commercial rental of cinematographic works: 'unless such rental has led to widespread copying of such works which is materially impairing to the exclusive right of reproduction conferred... on authors and their successors in title'. The exclusion of this kind of provision is detrimental to Nigeria copyright owners, because Nigeria has one of the fastest growing entertainment and film industries in the world. Countries should incorporate only works that are required under the

⁴⁴¹ See generally, articles 7 and 8 of the TRIPS Agreement

⁴⁴² Article 2 Berne Convention, Article 9.1 TRIPS Agreement. See also Section 1 Copyright Act 1988 Cap. 28, Laws of the Federation of Nigeria, 2004.

⁴⁴³ Article 10 TRIPS Agreement.

⁴⁴⁴ Article 9.1 TRIPS Agreement.

⁴⁴⁵ Advice on Flexibilities under the TRIPS Agreement available at http://www.wipo.int/ip-development/en/legislative_assistance/advice_trips.html accessed 03 March 2013.

international conventions to which they are parties and should not give words an excessively broad meaning.⁴⁴⁶

4.6.3 The Term of Protection of Copyright Works

Generally, under the Berne Convention the minimum duration of copyright protection for literary and artistic works is the life of author plus fifty years;⁴⁴⁷ cinematographic works,⁴⁴⁸ anonymous or pseudonymous works⁴⁴⁹ are protected for fifty years, works of applied art,⁴⁵⁰ insofar as they are protected as artistic works and photographic works, 25 years.⁴⁵¹

In Nigeria, the Act grants protection beyond the prescribed term in the Berne Convention and the TRIPS Agreement. This extension may be favourable in relation to some works, but may not be so for some other works. For instance, the life of the author plus seventy years for musical works is advantageous to both the author and in the public interest in Nigeria, economically speaking, considering the abundance of musical works available, and gives a boost to the industry. On the other hand, the life of the author plus seventy years may not be favourable for literary works considering the dearth of literary works for scholarly material which leads to a problem of a lack of access to knowledge and information. It may not be in the public's interest to have a long protection period for such works.⁴⁵² In India academics relinquish their rights in copyright to make works available for research and educational purposes.⁴⁵³ The Nigerian Copyright Act provides for a Berne-plus term of protection, the TRIPS Agreement reiterates the same term of protection as in the Berne Convention for literary works.⁴⁵⁴

⁴⁴⁶ Copyright and Access to knowledge p.21-22.

⁴⁴⁷ Article 7(1) Berne Convention.

⁴⁴⁸ Article 7(2) Berne Convention.

⁴⁴⁹ Article 7(3) Berne Convention; articles 9(1) & 12 TRIPS Agreement.

⁴⁵⁰ Article 7(4) Berne Convention.

⁴⁵¹ Article 7(4) Berne Convention.

⁴⁵² Poku Adusei, Kwame Anyimadu-Antwi and Naana Halm 'Ghana: Access to Knowledge in Africa – The Role of Copyright' in Chris Armstrong et al, eds., Access to Knowledge in Africa: The Role of Copyright UCT Press, Cape Town 2010 p.79

⁴⁵³ Chimezie .P. Uzuegbu, 'Management of Nigerian Copyright Law and the Open Access Initiative: A Bridge to attaining information for all in Nigeria' available at E-LISeprints.rclis.org accessed 19 March 2013.

⁴⁵⁴ Article 12 TRIPS Agreement.

4.6.4 Limitations and Exceptions

By virtue of the incorporation of the Berne Convention and the Rome Convention, the limitations and exceptions in the Berne Convention and Rome Convention⁴⁵⁵ are applicable to WTO members. Limitations and exceptions are important so as to balance the rights of the owner against the interest of the public. The Berne Convention provides for a number of limitations and exceptions. By the effective use of the TRIPS Agreement flexibilities, such as fair dealing, compulsory licensing can be used to create an access to knowledge policy which will enhance the availability of learning materials. There are several ways in which a country can take advantage of the many flexibilities that can be woven around the limitations and exceptions of the TRIPS Agreement without conflicting with the normal exploitation of the work and would not unreasonably prejudice the legitimate interests of the right holder.

For instance, a developing country such as Nigeria should incorporate all the flexibilities possible and permissible under its international obligation. As it stands, the Nigerian Act has a fair number of limitations and exceptions. However, there is still room for improvement in some areas, such as parallel importation, differentiating between ‘idea’ and ‘expression’, allowing maximum flexibilities in the area of education as well as making better use of the compulsory licensing⁴⁵⁶ option for reproduction, publication and translation of copyright works. The Nigerian government should make better use of the available exceptions in the law. For instance, compulsory licence has rarely been used as a means of creating sufficient learning material for schools, yet this provision is in the Act.⁴⁵⁷

There are various articles⁴⁵⁸ in the TRIPS Agreement which allow for flexibilities by member states. In essence, it is opined that there are ample opportunities for members to draft their laws in a way that is beneficial to their developmental stage.

⁴⁵⁵ Article 14.6. TRIPS Agreement.

⁴⁵⁶ Compulsory licence is rarely used for the purpose of reproduction and publication of copyright works that is for educational purpose whether for local books or international, this is despite fact that a number of text books used for courses like physics, chemistry, biology and further math are foreign text.

⁴⁵⁷ See the Fourth Schedule CA 1988 Cap 28 LFN 2004..

⁴⁵⁸ Article 2 Berne Convention; Article 9.1 TRIPS Agreement and Article 6bis Berne Convention; Article 14.3; Article 14.4; Article 14.6; Article 5.3 and 6.2 Rome Convention (Article 7.2(1) Rome Convention; Article 12 Rome Convention; Article 13; Article 10.1 and Article 10.2) Berne Convention.

4.7 Conclusion

The foregoing analysis reveals that the copyright law does not lag in compliance with the TRIPS Agreement. It seems from the chapter that the law makes adequate provision for protectable subject matter as provided for in the TRIPS Agreement, including computer programs and compilations of data. Rental rights in the general context needs to be streamlined. The provision for resale right can become effective only by a Regulation to be made by the Minister of Justice and, as noted, no Regulation has been made under this Act and the provision remains redundant. The outstanding regulation that needs to be enacted should be made to give effect and proper meaning to section 12 of the law.

The Act is not in total compliance with what is expected under article 15 of the Berne Convention: unpublished works as well as anonymous and pseudonymous works⁴⁵⁹ are not provided for.

Considering the fact that Nigeria grants a term of protection of life plus 70 years and the required term of protection in the Berne Convention is life plus fifty years, countries who grant less should receive less. The Act does not make this provision clear and as such may not comply with the provisions of article 18. It is important that the protection granted to Treaty members is clearly set out.

Furthermore, the term of protection under the Act provides for a TRIPS plus duration which can be an advantage or a disadvantage: a balance needs to be created according to Nigeria's level of development. The Act appropriately covers exceptions and limitations in the second, third and fourth schedules which give private users and the government an opportunity to make use of the work for various non- infringing purposes.

From the case law considered, implementation of the statutory provisions remains a problem. Despite the statutory provisions,⁴⁶⁰ access to learning materials remains at its lowest level and information is difficult to access. The Government has to be more involved in providing educational uses of content, especially when it comes to importing educational content from

⁴⁵⁹ Article 15 (4) (a) Berne Convention.

⁴⁶⁰ See generally the Fourth Schedule CA 1988 Cap 28 LFN 2004.

more industrially advanced countries. Government should remove duties on the importation of books. Awareness needs to be created to promote and coordinate open-access publishing systems. Nigerian needs to start making use of compulsory license to improve the distribution and accessibility of books and learning materials.

According to Nwauche,⁴⁶¹ ‘the profound nature of the African crisis lies in the fact that it seems that Africa does not care or is not willing to make intellectual property work for her’. This statement captures the exact situation of Nigeria. Even though Nigeria has so much intellectual property to be protected, very little is being done to harness the ample resources available and to enact statutory provisions that would develop an effective system of intellectual property protection that would of benefit the nation. As Adusei, Anyimadu-Antwi and Halm⁴⁶² in their discussion on access to knowledge in Ghana which has a similar socio- cultural and legal background as Nigeria concluded, for a balance of the objectives of rewarding creativity and preserving access for teaching/learning material copyright to be achieved, awareness has to be created, negative use of the media for selected interest has to be eradicated and the scope of permitted uses has to be demarcate by policy documents.

All said and done, care must be taken to balance the right of the owners with that of users. Justice Mansfield cautioned as far back as 1785:

We must take care to guard against two extremes equally prejudicial: the one, that men of ability...may not be deprived of their just merits, and the rewards of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.⁴⁶³

Recently, Gervais acknowledged that the principal way of dealing with copyright is to balance the rights of all concerned, stating:

THE TIME HAS COME TO MAKE COPYRIGHT WHOLE, to recognize, contrary to Manichean debates that have emerged in the past few years, that the public interest

⁴⁶¹ Enyinna S. Nwauche ‘A Development Oriented Intellectual Property Regime For Africa’ paper presented at the 11th General Assembly of the Council for the Development of Social Science Research for Africa (CODESRIA) in Maputo Mozambique 6-10 December 2005.

⁴⁶² Poku Adusei, Kwame Anyimadu-Antwi and Naana Halm ‘Ghana: Access to Knowledge in Africa – The Role of Copyright’ in Chris Armstrong et al, eds., *Access to Knowledge in Africa: The Role of Copyright* UCT Press, Cape Town 2010 p. 78

⁴⁶³ *Sayre v Moore* (1785), 1 East. 361n, 102 E.R. 139.

requires the protection of authors and users of their works, and to recognize that both authors and users require a functioning copyright system.⁴⁶⁴

In summary, Nigeria requires a proper functioning system of copyright to enhance development.

⁴⁶⁴ Gervais, Daniel J, (2008) 'Making Copyright Whole' 1

CHAPTER 5

Regulatory Framework of Trade Marks in Nigeria

Summary

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5.1 Introduction

Generally, trade marks are regarded as valuable commercial assets that have been in use for several centuries.¹ Trade marking can be said to be one of the areas of intellectual property that has been in existence in Nigeria before contact with Europe as marks were used in various forms: from the identification of the place origin of persons² to their status in society and on animals, products and crafts.³ Marks were also used in commerce by traders who marked their goods for identification of the source of origin. Some of these practices are still

¹ Groves, Peter J. *Intellectual Property Rights and Their Valuation: A Handbook for Bankers, Companies and their Advisers* Greesham Books Cambridge 1997 p.5.

² Such as the use of tribal marks, the tribal marks a Kanuri man wears are different from those of an Oyo man.

³ Bankole Sodipo, *Piracy and Counterfeiting GATT and Developing Countries* Kluwer Law International London 1997 p. 39.

in use.⁴ By and large, ‘the primary function of a trade mark is that of a source indicator’ for the protection of consumers.⁵

In the previous chapter, an analysis of the legal framework on copyright law captured a general overview of the legislation, its compliance, impact and necessary modification. This chapter will examine the legal framework for trade mark laws in Nigeria *vis-à-vis* the TRIPS Agreement.

In addition, this chapter will analyse the substantive law and regulation by exploring whether the 49 year old Act and 47 year old Regulation possibly can comply with the TRIPS Agreement and will determine the effect on the law if Nigeria has to make its laws compliant with the TRIPS Agreement taking into consideration the fact that trade marks are still largely territorial in nature despite the provisions of the TRIPS Agreement. Although the impact and implementation of the TRIPS Agreement in relation to trade marks has not been given as much attention as copyright and patents, trade mark law has undergone profound changes internationally and in domestic commerce in Nigeria. As a result, it is important to examine these changes to know how effective the law is, considering the recent proliferation of trade marks in consumer goods in Nigeria.

5.2 Trade Marks Law in Nigeria

5.2.1 Historical Overview

The first trade mark law in Nigeria was the received English Law of Patents, Designs and Trade Marks Act, 1883 which came into force January 1, 1900, known as the Trade Marks Proclamation Ordinance of 1900 and applicable to Southern Nigeria alone.⁶ Following the

⁴ For instance yams are still marked for identification of their origin or their owner/trader.

⁵ Irene Calboli, ‘Trademark Exhaustion in the European Union: Community-Wide or International? The Saga Continues,’ 6 *Marquette Intellectual Property Law Review* 47; Mohammad Amin Naser *Revisiting the Philosophical Foundations of Trade Marks in the US and UK* Cambridge Scholar Publishing Newcastle 2010 p. 61.

⁶ A.O Oyewunmi, ‘Industrial Property Law’ Akanki E.O (Ed), *Commercial Law in Nigeria* University of Lagos Press, Lagos 2007 p.507; see also Adebambo Adewopo ‘Intellectual Property Law and Prospects for Development’ in Toyin Falola, Adebayo O.. Oyebade(Eds) *The transformation of Nigeria: essays in Honour of Toyin Falola* African World Press Inc Erithea 2002 p.169; Chidi Oguamanam ‘Trade Marks Trade Names Regime in Nigeria: The Momentum’ in Lanre Fagbohun and Adebambo Adewopo (eds) *Development and Reforms in Nigeria Nigerian Commercial Law* Law Center LASU Lagos 1998 p. 60

amalgamation of Northern and Southern Nigeria in 1914, a Trade Marks Ordinance⁷ was enacted which was extended to Nigeria as a whole. The United Kingdom Trade Marks Act of 1919,⁸ which came into force in April 1920, introduced a new kind of registration which divided the register into two parts, namely Parts A and B.⁹ By extension, as a British colony, a similar Trade Marks Ordinance was enacted in Nigeria in 1923,¹⁰ repealing earlier Ordinances. Shortly after, the Trade Marks Ordinance of 1923 was repealed by the Trade Marks Ordinance¹¹ of 1926 and followed by the 1958 ‘Ordinance to Consolidate and Amend the law relating to Trade Marks’.¹²

The Trade Marks Act of 1965 is the first indigenous legislation on trade marks in Nigeria and is still the current law. Based substantially on the UK Trade Marks Act of 1938,¹³ the 1965 Act repealed the Trade Mark Act of 1958 and its regulation.¹⁴ The Trade Mark Act came into force in 1967 when the Trade Marks Regulations Order 1967¹⁵ was instituted for the administration of the system.¹⁶ The Trade Mark Acts of 1965 is now incorporated into the Laws of the Federation of Nigeria 2004 as Chapter T13.¹⁷

5.2.2 Overview of the Trade Marks Act

5.2.2.1 Trade Mark Protection

The Trade Mark Act generally provides for the protection of trade marks in respect of goods only, but has now been extended to service marks. Certification marks, defensive marks,

⁷ Ordinance No 20 of 1914, Chapter 199 of the Laws of Nigeria 1958.

⁸ 9 & 10 Geo. 5 CH 79.

⁹ Kerly D.M and Underhay F.G Kerly’s *Law on Trade Marks and Trade Names* 4th ed (being a supplement to the fourth edition) Sweet and Maxwell London p.1 This division is still in existence in Nigeria despite the fact that UK has done away with the system.

¹⁰ Ordinance No 4 of 1923, Chapter 148 of the Laws of Nigeria 1923.

¹¹ Ordinance No 13 of 1926, Chapter 148 of the Laws of Nigeria 1923.

¹² Chapter 19 of the Laws of the Federation of Nigeria and Lagos 1958, Oyewunmi A.O, *Industrial Property Law* p.507.

¹³ This act was considered to be unsatisfactory and not enough to cover all the modern issues of trade marks and was replaced by the Trade Mark Act 1994 which has been amended severally.

¹⁴ Babafemi F.O. *Intellectual Property. The Law and Practice of Copyright, Trade Marks, Patent and Industrial Design in Nigeria* Justinian Ibadan 2007 p.176.

¹⁵ Trade Marks Regulations Order 1967 (Hereinafter referred to as the Regulation).

¹⁶ Sikoyo *et al Intellectual Property Protection in Africa Status of Laws, Research and Policy Analysis in Ghana, Kenya, Nigeria, South Africa and Uganda* African Centre for Technology Studies (ACTS) Ecopolicy Series no. 16 pp.18-19.

¹⁷ Trade Marks Act, 1965 Cap T 13, Laws of Federation of Nigeria 2004 (hereinafter referred to as the Trade Marks Act or the Act).

associate trade marks and series of trade marks are all protected under the Act. There is no specific provision on collective marks and well-known marks. The Federal Ministry of Commerce, Trade and Investment houses the Trade Marks, Patents and Designs Registry in Nigeria. The Registry is responsible for all trade mark applications processed in Nigeria.

a. Definition of a Mark

A mark is defined in section 67 as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.¹⁸ In recent times marks have been defined in other jurisdictions to include colour, scent, shape, sound, pattern and container of goods or product packaging and any combination thereof. These inclusions have considerably increased the features of a product that can indicate source.¹⁹ As a result of increasing the margins of a mark, the courts have had to tread carefully in deciding whether some of these marks can, in fact, be protected or registered.

Despite the seemingly unfriendly definition and the absence of colour, scent, shape, sound pattern and container of goods or product packaging from protection under the Act, it appears to be in line with the provisions in other countries as product packaging colour, scent, shape, sound, pattern are all recent practises in countries such as the UK,²⁰ US²¹ and Japan.²² These extensions of the term to include colour, scent, shape, sound pattern and container of goods or product packaging have been the subject of much jurisprudence and it seems that it is the mark owners rather than the law that wants to stretch the boundaries

¹⁸ Section 67 TMA 1965 T13 LFN 2004.

¹⁹ Lionel Bently and Brad Sherman Intellectual Property Law (3rd ed.) Oxford University Press Oxford 2009 p. 8061.

²⁰ Shapes and packaging of goods for example, the triangular shape of Toblerone chocolate and the Coca Cola bottle, registration of which was denied by the House of Lords under the 1938 Act. In re *Coca-Cola Co.'s Application* [1986] 2 All ER 274 per Lord Templeman.

²¹ Section 43 (a) Lanham Act. *Two Pesos Inc v Taco Cabana, Inc.*, 112 S.Ct. 2753 (1992); *Qualitex Co. v Jacobson Products Co., Inc.*, No. 93-1577 (U.S. March 28, 1995).

²² Article 2 (3) and (4) Trade Mark Law Japan 1996. For years Japan patent Office held that the Coca-Cola bottle was 'within the scope of the generic form for beverage containers of its type' and thus not protectable. In 2008, the IP High Court overturned the JPO's decision to hold that 'the bottle shape itself is recognized as a brand image, and even without the Coca-Cola logo, it is easily distinguished from the products of other companies.' *Yakult Case, Tokyo High Court*, 1769 Hanreijihō 98 (July 17, 2001); see also *Suntory Case, Tokyo High Court* (August 29, 2003).

beyond what the law covers. These cases have led to several decisions, in 1986, the House of Lords unequivocally held in *Re Coca-Cola Co. Application*²³ that:

It is not sufficient for the Coca-Cola bottle to be distinctive. The Coca-Cola Co. must succeed in the startling proposition that a bottle is a trade mark. If so, then any other container or any article of a distinctive shape is capable of being a trade mark. This raises the spectre of a total and perpetual monopoly in containers and articles achieved by means of the Act of 1938. Once the container or article has become associated with the manufacturer and distinctiveness has been established, with or without the help of the monopolies created by the Patents Act, the Registered Designs Act or the Copyright Act, the perpetual trade mark monopoly in the container or article can be achieved. In my opinion the Act of 1938 was not intended to confer on the manufacturer of a container or on the manufacturer of an article a statutory monopoly on the ground that the manufacturer has in the eyes of the public established a connection between the shape of the container or article and the manufacturer. A rival manufacturer must be free to sell any container or article of similar shape provided the container or article is labelled or packaged in a manner which avoids confusion as to the origin of the goods in the container or the origin of the article.

Prior to the Coca-cola decision, an Australian High Court, in *Smith Kline and French Laboratories (Aust) Ltd v Registrar of Trade Marks*,²⁴ the applicant sought to register a pharmaceutical capsule as a mark. The capsule had one half of which was coloured and the other half of which was colourless, containing pellets of two or more colours. The registration was refused and the court upheld the decision on the ground that a trade mark must be capable of being described and depicted as something apart from the goods to which it is to be applied or in relation to which it is to be used. The court further held that a mere description of goods by shape, size or colour cannot be a trade mark in respect of those goods and that the applicant's claim was for a monopoly for 'any products it may put on the market, consisting of pellets in capsules, having the kind of colour scheme it has used for its sustained release drugs in capsules'. The Judge relied upon the observation of Lindley LJ in *In re James's Trade Mark*²⁵ that 'a mark must be something distinct from the thing marked. A thing cannot be a mark of itself.'

The need to protect three-dimensional trade marks in the UK arose as a result of the need to make its law compliant with the TRIPS Agreement and in line with its obligation in the

²³ In re *Coca-Cola Co.'s Application* [1986] 2 All ER 274 per Lord Templeman.

²⁴ (1967) 116 CLR 628.

²⁵ (1886) 33 Ch D 392 at 395.

WTO.²⁶ In Japan, prior to 1996, three-dimensional trade marks were not recognised²⁷ in the Japanese Trade Mark Law²⁸ and service marks became protectable only in 1991.²⁹

However, in the EU limits have been set for determining the registration of shapes. Thus, if the signs consist exclusively of: (i) the shape which results from the nature of the goods themselves; (ii) the shape of goods is necessary to obtain a technical result; (iii) the shape gives substantial value to the goods, they would be considered as absolute grounds for refusal of registration.³⁰

Shapes are not part of a mark in Nigeria, therefore shapes which have been found to be distinctive elsewhere may still not be able to obtain registration in Nigeria. It has been argued that some forms of protection exist for shapes,³¹ such as protection under the Patent and Designs Act by design laws. This argument may not hold in that design laws can protect the design, at most, for only 15years³² from the date of application after which the design can be copied. This kind of protection cannot be compared to trade mark protection that can be indefinite in so far as the mark is not abandoned.

The need for the protection of unconventional marks, such as packaging or trade dress, is ripe for consideration under Nigeria law, as case laws have begun to examine the issue of trade dress even though there is no provision for it under the law. The case of *Ferodo Ltd v Ibeta Industries Ltd*³³ is an example. In the case, the Court of Appeal held that what the Appellant registered was ‘Ferodo’, and that were the proprietors decide to garnish a trade mark with other colorations and devices which makes it appealing and decorative, it cannot be assumed that the fanciful and ornamental characters which colour the package form part

²⁶ Shaping Up Under the New Trade Marks Act: Shapes as Considered in Consolidated High Court Suits 619/2004 and 674/2004 (Nation Fittings (M) *Sdn Bhd vs Oystertec plc and Oystertec plc vs Best Ceramic Pte Ltd*).

²⁷ Shoen Ono, *Overview of Japanese Trademark Law* Yuhikaku 2nd ed. 1999 p.27.

²⁸ Japanese Trademark Law No. 127 of 1959.

²⁹ Shoen Ono, p.28.

³⁰ Article 7 (1) (e) Council Regulation (EC) No 207/2009 of 26 February 2009.

³¹ Mark Mordi, ‘Towards Trade Mark Law Reform in Nigeria’: A Practitioner’s Note NIALS Journal of Intellectual Property [NJIP] Maiden Edition (2011) p. 213.

³² Section 20 Patent and Design Act Cap P2, Laws of Federation of Nigeria 2004.

³³ (2004) 2 S.C. (Part 1) 1 (2004) 5 NWLR Pt. 866 pp 317 – 378 per Niki Tobi JSC.

of the trade mark. In the absence of registration by the Appellant, the alleged use of the trade dress by the Appellant was held by the court not to give them monopoly over the use of a red, black and white colour combination on checked cardboard paper. Thus the action failed. The court was of the opinion that in the absence of registration of a trade dress, a statutory action for infringement or statutory passing off cannot be sustained.

The Supreme Court discarded an opportunity to break jurisprudential ground in trade mark law³⁴ by ‘expanding the concept of a traditional notion of a word, mark or logo’³⁵ to rule that the packaging of ‘Ferodo’ was distinct in consideration of the fact that trade mark infringement could go beyond infringing the words registered to include the way the product is packaged. Although in the Ferodo case, the Supreme Court missed the opportunity, the Court of Appeal in *International Tobacco (NIG.) Ltd. v British American Tobacco (NIG.) Ltd.*,³⁶ in dismissing an appeal upheld the decision of the Federal High Court that even though the gold colour of the Benson & Hedges cigarette pack had not been expressly registered, the colour had acquired distinctiveness since it had been in use for about 33 years, and ruled that the subsequent use of the gold colour for a similar product by International Tobacco is an infringement of the proprietary rights of British American Tobacco.

b. Definition of a Trade Mark

A trade mark is defined under section 67 of the Act:

as a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43³⁷ of this Act.

³⁴ Ayoyemi Lawal Arowolo, ‘Ferodo Limited and Ferodo Nigeria Limited v. Ibeto Industries Limited; another Critical Review’ (2012) *NIALS Journal of Intellectual Property* 118-135, 135.

³⁵ Jeremy Phillips, *Trade Mark Law: A Practical Anatomy* OUP Oxford 2003 para 5.01 p.120.

³⁶ Suit No: CA/IL/54/2007. Although the court held that the infringement did not affect the goodwill of the British American Tobacco’s product since evidence showed that its consumers were not deceived by the cigarette packs.

³⁷ Section 43 (1) TMA 1965 T13 LFN 2004 provides that
 ‘a mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristic, from goods not so certified, shall be registrable as a certification trade

This definition is complex, not easily understandable and is limited in scope due to the fact that it is archaic.³⁸ Several scholars³⁹ have criticised the definition as obscure and restrictive. Some of the criticism noted is that trade marks ‘may only be affixed to goods traded by a proprietor’⁴⁰ and that the Act blindly followed the UK Act of 1938, which was not user friendly.⁴¹ Nevertheless, it has been the working definition for trade marks for the last 47 years.

i. Defensive Trade Marks

Defensive trade marks are registered to serve as protection for well-known trade marks. Defensive trade marks are invented word or invented words which can be registered for familiar goods and services which have been used and have become well-known so that if used in relation to other goods, would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the familiar goods.

Unlike other trade marks, the proprietor may register a trade mark in respect of any goods as a defensive trade mark⁴² and may register any goods not as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark⁴³ without any intention to use it or a proposed intention of using it.

mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person: provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.’

³⁸ Chidi Oguamanam ‘Trade Marks Trade Names Regime in Nigeria :The Momentum’ in Lanre Fagbohun and Adebambo Adewopo (eds) *Development and Reforms in Nigeria Nigerian Commercial Law* Law Center LASU Lagos 1998 p. 60.

³⁹ Folarin Shyllon *Intellectual property Law in Nigeria* Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, 2003 p.19; Mark Mordi, ‘Towards Trade Mark Law Reform in Nigeria: A Practitioner’s Note’ NIALS Journal of Intellectual Property [NJIP] Maiden Edition (2011) 19; Oyewunmi A.O, ‘Industrial Property Law’ p.507 Akanki E.O (Ed), *Commercial Law in Nigeria* p.507 University of Lagos Press, Lagos 2007; Chidi Oguamanam, ‘Trade Marks Trade Names Regime in Nigeria: The Momentum’ in Lanre Fagbohun and Adebambo Adewopo (eds) *Development and Reforms in Nigeria Nigerian Commercial Law* Law Centre LASU Lagos 1998 p. 60.

⁴⁰ Mark Mordi, ‘Towards Trade Mark Law Reform in Nigeria: A Practitioner’s Note’ NIALS Journal of Intellectual Property [NJIP] Maiden Edition (2011) 19.

⁴¹ Folarin Shyllon *Intellectual property Law in Nigeria* Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, 2003 p.19.

⁴² Section 32 (2) (a) TMA 1965 T13 LFN 2004.

⁴³ Section 32 (2) (b) TMA 1965 T13 LFN 2004.

Also, the proprietor cannot be challenged for non-use⁴⁴ and cannot be taken off the register. This provision, however, only applies to well-known trade marks.

ii. Associated Trade Marks

Section 24 of the Act provides that where a trade mark and any part or parts of it are registered as separate trade marks in the name of the same proprietor, they shall be deemed to be associated trade marks.⁴⁵ Provided the same proprietor is entitled to the exclusive use of any part separately, the trade mark may, accordingly, be registered as a whole or in parts as separate marks.⁴⁶ Although the trade marks may be registered separately, they must satisfy all necessary conditions of an independent trade, and, in certain cases, the use of one trade mark may be equivalent to the use of another.⁴⁷

The registrar may, at any time, require a trade mark to be registered as an associated mark if it is perceived that the use of the trade mark in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion, is registered or is the subject of an application for registration.⁴⁸

The trade marks will be deemed to be registered as a separate mark and will only be assignable and transmissible as a whole.⁴⁹ The proprietor of the associated trade marks may apply to the Registrar⁵⁰ asking for the marks, with respect to any of them, to be dissolved if the Registrar is satisfied that there would be no likelihood of deception or confusion if that trade mark were used by another person in relation to any of the goods in respect of which it is registered and the register will be amended to that effect.⁵¹

⁴⁴ Section 31 TMA 1965 T13 LFN 2004.

⁴⁵ Section 24 (3) TMA 1965 T13 LFN 2004.

⁴⁶ Section 24 (1) TMA 1965 T13 LFN 2004.

⁴⁷ Section 36 (2) TMA 1965 T13 LFN 2004.

⁴⁸ Section 27 (1) TMA 1965 T13 LFN 2004.

⁴⁹ Section 28 TMA 1965 T13 LFN 2004.

⁵⁰ Rule 63 (2) TMR L.N. 70 of 1967.

⁵¹ Section 27 (2) TMA 1965 T13 LFN 2004.

iii. Series Trade Marks

According to section 25 (1) of the Act, series trade marks consist of several trade marks resembling each other in respect of the same goods or description of goods on one application. Although series trade marks are similar in every material particularity, in order to attain registration they must differ in the following ways:

- i. statements of the goods in relation to which they are respectively used or proposed to be used; or
- ii. statements of number, price, quality or names of places; or
- iii. other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- iv. colour.

Series trade marks made in one application will be registered as associated trade marks.⁵²

c. Definition of Service Mark

Generally a service mark is registered specifically in relation to services. Prior to 2007, the protection of marks was only in relation to trade marks in Nigeria. Trade marks were defined in relation to goods only, thereby excluding services. This definition has been amended by the Federal Minister of Trade and Commerce acting in accordance with the enabling law in sections 42 and 45(1)(b) of the Act, which gives the minister the power to make regulations and prescribe such forms as he thinks expedient. Accordingly, by an executive fiat in April 2007 the Federal Minister of Trade and Commerce⁵³ enabled the registration of ‘service marks’. The executive fiat incorporated the Nice classification of goods in the Fourth Schedule of the Trade Marks Regulations, thereby extending the classes of goods to include services in classes 35-45 in the Nice classification.⁵⁴ Until now there is no official

⁵² Section 25 (1) TMA 1965 T13 LFN 2004.

⁵³ Ladi Taiwo. *IP Law in Nigeria: New Trends and Challenges* in *INSIDE THE MIND IP Client Strategies in the Middle East and Africa* Leading Lawyers on Understanding Recent Developments and Proposed Changes, Managing Client Expectations, and Recognising Regional Influences on Intellectual Property Law Aspatore books 2009 p.4.

⁵⁴ The extension include the following classes: 35 – Advertising, Business management, Business Administration, Office functions; 36 – Insurance, Financial Monetary Affairs and Real Estate Affairs; 37 – Building Construction, Repair and Installation services; 38 – Telecommunications; 39 – Transport, Packaging and Storage of goods, Travel arrangement; 40 – Treatment materials; 41 – Education, Providing of

publication in relation to this amendment on service marks, but in practise they are now registered.

d. Definition of Certification Mark

Section 43 of the Act defines certification marks as a mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristic from goods not so certified. Such a mark shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person.

Certification marks are not registrable in the name of a person who carries on a trade in goods of the kind. A certification mark is not used by the owner of the mark; rather persons other than the owner of the mark use the mark to certify to potential purchasers that their goods and services meet the standard set by the mark's owner. A certification mark allows the potential purchaser to rely on a third party, that is, the owner of the certification mark for information about a seller's goods or service. The owner must be able to control the use of the mark, must not allow the use of the mark for purposes other than to certify and may not refuse certification to those that meet the relevant criteria set by the mark holder. Otherwise, the mark may lose its status as a certification mark.

e. Limitation to Colour

Section 16 of the Trade Mark Act provides that a trade mark may be limited in whole or in part to one or more specified colours. However, if the trade mark is registered without limitation of colour, it shall be taken to be registered for all colours. The Trade Marks Regulation also provides that all representations of marks must be of a durable nature.⁵⁵

⁵⁵ training, Entertainment, Sporting and Cultural Activities; 42 – Scientific and Technological Services and Research & Design relating thereto, Industrial Analysis research services, Design and development of computer, Hardware and Software; 43 – Services for providing food and drinks, Temporary accommodation; 44 – Medical services, Veterinary services, Hygienic and Beauty care for human beings or animals, Agriculture, Horticulture and Forestry services; 45 – Legal services, Security services for the protection of property or individual, personal and social services rendered by others to meet the need of the individual. Rule 27 TMR L.N. 70 of 1967.

The courts have set boundaries within which colour as a mark may be protected. In *Libertel Groep BV v Benelux-Merkenbureau* the ECJ pointed out that colour, *per-se*, cannot be presumed to constitute a sign. A colour is a simple property of things, although it may constitute a sign depending on the context in which the colour is used. None-the-less, a colour *per-se*, is capable, in relation to a product or service, of constituting a sign. The Court held the sign must be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified and that the graphic representation, within the meaning of article 2 of the Directive, must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. A verbal description of a colour composed of words made up of letters will not constitute a graphic representation of the colour. Accordingly, a colour may be registered only if the designation of the colour is based on an internationally recognised identification code which may be considered stable enough to constitute a graphic representation.

f. Concept of Distinctiveness

Trade mark protection revolves round its distinctive abilities. Trade marks are regarded as source identifiers which, in turn, means that they are capable of differentiating the product based on their distinctive marks. In view of this, registration of a mark will be based only upon evidence of distinctiveness of the name, signature or invented word or words under section 9 of the Act. In section 9 (1) of the Act a mark is registrable only upon evidence of distinctiveness, ‘distinctive’ in this context:

means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected to in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.⁵⁶

Under part B of the register the trade mark must be capable of distinguishing the goods in respect of which it is registered or proposed to be registered.⁵⁷ The word ‘distinctive’ is not used explicitly but ‘distinguish’ which is in the same category. Thus, it can be deduced that

⁵⁶ Section 9 (2) TMA 1965 T13 LFN 2004.

⁵⁷ Section 10 (1) TMA 1965 T13 LFN 2004.

in determining whether the mark is can be used of distinguishing goods or a service it must be established that the trade mark is inherently distinctive in part A, or has acquired distinctiveness by reason of use of the mark by the proprietor which is sufficient for the registration of a mark under part B.⁵⁸ In essence, part A deals with trade marks inherently adapted to distinguish, whereas part B covers trade marks that are capable of distinguishing or have acquired distinctiveness.⁵⁹ In determining if a mark as acquired distinctiveness, in *Boot v Niger imports*⁶⁰ the court held that where the mark which seeks protection consists of words and characters in everyday or common usage, the plaintiff must prove that such has become singularly attached to the goods in question and not to any other.

g. Effects of Registration

The advantage of registration is clearly stated in section 3 of the Act and it provides that a person who registers a mark will be entitled to institute any proceeding to prevent infringement and to recover damages for such infringement. The owner of an unregistered trade mark, on the other hand, only has a right of action against any person for passing off and can recover damages only in relation to same.⁶¹

It is clear under the Act that a trade mark may either be registered or not. The difference between a registered trade mark and a non-registered trade mark lies in the ability for a registered mark to bring an action for infringement.⁶² The courts have been quite active in this area of law. The Supreme Court had this to say in the case of *Dyktrade Ltd v Omnia Nig Ltd*:⁶³ ‘Trade marks when registered will entitle the proprietor to sue or institute an action for any infringement of the trade mark. Registration entitles the proprietor to the exclusive use of the trade mark and also the right to sue for passing off the goods of the proprietor’.

⁵⁸ Section 10 (2) TMA 1965 T13 LFN 2004.

⁵⁹ In the light of section 10(3) TMA 1965 T13 LFN 2004., ‘a trade mark may be registered in part B notwithstanding any registration in part A in the name of the same proprietor of the same trade mark or parts thereof’.

⁶⁰ [1977-1989] 3 IPLR 1.

⁶¹ Elebute & Another v Olugbenga Ogunkua [1990-1997] 3 IPLR 1.

⁶² Section 3 TMA 1965 T13 LFN 2004.

⁶³ (2000) 12 NWLR (PART 680) pages 1 at page 8 paras G –H per Belgore, J.S.C.

5.2.2.2 Requirements for an Application

The trade mark definition consists of four requirements to attain registration status, these are:

- i. a mark⁶⁴
- ii. used or proposed to be used⁶⁵
- iii. in relation to goods⁶⁶ (service)
- iv. in the course of trade.⁶⁷

Apart from the above requirements the Act further stipulates other conditions that have to be met. In order for registration to be valid it must contain or consist of at least one of the following essential particulars:⁶⁸

- i. the name of a company, individual, or firm, represented in a special or particular manner;
- ii. the signature of the applicant for registration or some predecessor in his business;
- iii. an invented word or invented words;
- iv. a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- v. any other distinctive mark.

a. Classification of Goods and Services

For the purpose of trade mark registration, Nigeria follows the International Classification of Goods and Services under the Nice Agreement (Nice Agreement), although Nigeria is not a signatory to the Nice Agreement. The classification in the Trade Marks Regulation contains classes 1-34 on goods.⁶⁹ This was the only type of marks registrable before 2007 when the classes were extended to services in classes 35-45. The headings of the classes of the Nice

⁶⁴ A mark as defined in Section 67 Trade Mark Act as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

⁶⁵ The mark may have been in actual use or still be intended to be used by the proprietor. Thus use of the mark before registration is not a prerequisite for registration of the mark.

⁶⁶ The Act specifically only provides for mark to be used on goods, this automatically leaves out service marks (*Akesa v Union Bank of Nigeria*, unreported case FHC/L/95/ 81 and three-dimensional marks (*Trebor Nigeria v Associated Industries* (1972)N.C.L.R. 471).

⁶⁷ ‘This is understood as being used in relation to goods for the purpose of indicating the origin of the goods, in other words manufacture or in the course of business before they are offered for sale to the public’ see *Aristoc Ltd. v Rysta Ltd.* (1945) A.C. 68 per Lord Maugham.

⁶⁸ Section. 9 (1) TMA 1965 T13 LFN 2004.

⁶⁹ Third Schedule TMR L.N. 70 of 1967..

Classification provide information about the types of goods and services which fit into the respective classes.⁷⁰

In Nigeria a trade mark must be registered in respect of particular goods or classes of goods and any question arising as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.⁷¹ Also the registrar, in exercising the power conferred on him, may add goods or classes of goods to those in respect of which a trade mark is registered.⁷² Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications, including all cases where a trade mark is registered under the same official number for goods in more than one class.⁷³

b. Examination Procedure for Trade Mark Application

Once the requirement for the application is complete, the application process may or may not commence with a preliminary examination of the distinctiveness of the proposed trade mark; this depends on the person applying for registration.⁷⁴ The preliminary examination of distinctiveness is optional but the advantage of this process lies in the fact that if the advice given leads to an objection, the applicant shall be entitled to a refund of his filing fees if notice of withdrawal of the application is given within the prescribed period.⁷⁵

If an application is submitted without the request for a preliminary examination, the registrar will conduct a search amongst the registered marks and pending applications to ensure that there are no records in respect of the same goods or description of goods and any marks identical with the mark applied for.⁷⁶

Following the search and consideration of use or distinctiveness or of any other matter which the applicant may be required to furnish, the application may be accepted, objected to or may be accepted by the registrar subject to such conditions, amendments, disclaimer,

⁷⁰ See Regulation on the Protection of Service Marks in Nigeria available at http://aluko-oyebode.com/_uploads/publications/nl_ipmay07.pdf accessed 24 May 2014.

⁷¹ Section 4 TMA 1965 T13 LFN 2004.

⁷² Section 44 (2) TMA 1965 T13 LFN 2004.

⁷³ Rule 28 TMR L.N. 70 of 1967.

⁷⁴ Section 17 TMA 1965 T13 LFN 2004.

⁷⁵ Section 17 (2) TMA 1965 T13 LFN 2004.

⁷⁶ Rule 38 TMR L.N. 70 of 1967.

modifications or limitations as the registrar may think right to impose.⁷⁷ In the case of a refusal or conditional acceptance the decision may be subject to appeal in court.⁷⁸

c. Publication and Opposition

Where the application for registration of a trade mark has been accepted, a notice of the accepted application will be published in the Trade Marks Journal stating all the conditions and limitations, where applicable.⁷⁹

In addition, any opposition to the trade mark application must be done through a notice in writing⁸⁰ by any person within a 2 month period from the date of the publication stating the grounds of opposition.⁸¹ The outcome of the opposition is based on evidence heard from parties to the opposition and subject to the conditions or limitations, if any, that are imposed, registration is permitted.⁸²

The Registrar does not have the final say, an appeal can be made to the court for determination of the issue.⁸³ In an opposition proceeding, a reasonable extension of time may be granted to any party without hearing in which to take any subsequent step.⁸⁴ After a trade mark is registered, it can no longer be opposed.⁸⁵

d. Grounds for Opposition

The grounds of opposition of a trade mark include absolute and relative grounds. Some of the many grounds on which the Trade Marks Act and the Trade Marks Regulation prohibit registration include marks which are deceptive and scandalous,⁸⁶ identical and resembling trade mark,⁸⁷ the Nigerian Coat of Arms⁸⁸ or the Arms of a State,⁸⁹ the National Flag,⁹⁰

⁷⁷ Section 18 (1) TMA 1965 T13 LFN 2004; Rule 34 TMR L.N. 70 of 1967.

⁷⁸ Section 18 (4) TMA 1965 T13 LFN 2004.

⁷⁹ Section 19 TMA 1965 T13 LFN 2004.

⁸⁰ Section 20 (2) TMA 1965 T13 LFN 2004.

⁸¹ Section 20 TMA 1965 T13 LFN 2004; rule 48 TMR L.N. 70 of 1967. see also Rule 49 TMR L.N. 70 of 1967.

⁸² Section 20 (4) TMA 1965 T13 LFN 2004.

⁸³ Section 21 TMA 1965 T13 LFN 2004. The Federal high Court is the court of competent jurisdiction on intellectual property matters.

⁸⁴ Rule 57 TMR L.N. 70 of 1967.

⁸⁵ Section 21 (1) TMA 1965 T13 LFN 2004.

⁸⁶ Section 11 TMA 1965 T13 LFN 2004. It is generally known that

⁸⁷ Section 13 TMA 1965 T13 LFN 2004; *Hondret & Co Ltd. v Registrar of Trade marks* (1979) FHCLR. 203.

names of chemical substances,⁹¹ trade marks based upon words such as ‘Patent’, ‘Patented’, ‘Registered’, ‘Registered Design’, ‘Copyright’, ‘to counterfeit this is a forgery’,⁹² ‘Red Cross’ or ‘Geneva Cross’⁹³ and any words, such as ‘President’, ‘Governor’⁹⁴ and representation of the armorial bearings, insignia of orders of chivalry, decorations or flags of any state, city, town, place, society, body corporate, institution or person.⁹⁵

For a mark to be registered in Part A of the register, it must be inherently distinctive or by reason of the use of the trade mark or of any other circumstances the trade mark must be adapted to distinguish and consist of essential particulars.⁹⁶ In the case of registration under part B, the mark must be capable of distinguishing the goods for which it is proposed to be registered either by being inherently capable of distinguishing⁹⁷ or by reason of the use of the trade mark.⁹⁸

e. Registration

Where the requirement for an application is met the process of registration may commence⁹⁹ in the absence of the application being opposed and the time for notice of opposition has expired,¹⁰⁰ or the application has been opposed and the opposition has been decided in favour of the applicant¹⁰¹

A certificate is issued to the applicant if the application has been accepted unless it has been accepted in error.¹⁰² In addition, an application may be treated as abandoned if the application is not completed within twelve months from the date of application and the

⁸⁸ Section 62 TMA 1965 T13 LFN 2004.

⁸⁹ Rule 18 (a) Trade Marks Regulations. L.N. 70 of 1967.

⁹⁰ Rule 18 (c) Trade Marks Regulations. L.N. 70 of 1967.

⁹¹ Section 12 TMA 1965 T13 LFN 2004.

⁹² Rule 17 (a) Trade Marks Regulations. L.N. 70 of 1967.

⁹³ Rule 17 (b) Trade Marks Regulations. L.N. 70 of 1967.

⁹⁴ Rule 18 (b) Trade Marks Regulations. L.N. 70 of 1967.

⁹⁵ Rule 19 Trade Marks Regulations. L.N. 70 of 1967.

⁹⁶ Section 9 TMA 1965 T13 LFN 2004.

⁹⁷ Section 10 (1) TMA 1965 T13 LFN 2004.

⁹⁸ Section 10 (2) (b) TMA 1965 T13 LFN 2004.

⁹⁹ Section 18 (1) TMA 1965 T13 LFN 2004.

¹⁰⁰ Section 22 (1) (a) TMA 1965 T13 LFN 2004.

¹⁰¹ Section 22 (1) (b) TMA 1965 T13 LFN 2004.

¹⁰² Section 22 TMA 1965 T13 LFN 2004.

registrar will give a notice of the non-completion to the applicant.¹⁰³ This may be the law, but in practice a trade mark registration may take up to three years. A trade mark will be registered from the date it is registered and not from the date the application was filed or accepted.¹⁰⁴

5.2.2.3 Duration and Renewal of Trade Marks

With regard to the duration of trade marks in Nigeria, a trade mark is valid for an initial period of seven years, renewable for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration.¹⁰⁵ The proprietor of a trade mark is required to make an application for renewal 3 months before expiration of the last registration.¹⁰⁶

5.2.2.4 Cancellation and Removal of Trade Mark

Registered trade marks may be taken off the register if any person applies to the court or registrar on the following grounds:¹⁰⁷

- (i) the trade mark was registered without any *bona fide* intention of use and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor.¹⁰⁸
- (ii) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and not used.¹⁰⁹

Also, if the proprietor of a trade mark fails to renew the trade mark within the prescribed time the trade mark may be removed from the register.¹¹⁰ Other reasons for cancelling a mark include:¹¹¹

- (i) if the mark is used in a manner other than the permitted use or in a way likely to cause deception or confusion.

¹⁰³ Section 22 (4) TMA 1965 T13 LFN 2004; Rule 61 TMR L.N. 70 of 1967.

¹⁰⁴ Rule 64 (4) TMR L.N. 70 of 1967.

¹⁰⁵ Section 23(1) & (2) TMA 1965 T13 LFN 2004.

¹⁰⁶ Rule 61 TMR L.N. 70 of 1967.

¹⁰⁷ Section 31 TMA 1965 T13 LFN 2004; see also *Procter & Gamble Ltd. v Global Soap & Detergent Industries* [1989] FHCLR 357.

¹⁰⁸ Section 31 (2) (a) TMA 1965 T13 LFN 2004.

¹⁰⁹ Section 31 (2) (b) TMA 1965 T13 LFN 2004.

¹¹⁰ Section 23(3) TMA 1965 T13 LFN 2004; Rule 70 TMR L.N. 70 of 1967.

¹¹¹ Section 34 (5) TMA 1965 T13 LFN 2004.

- (ii) if the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application or that the circumstances have materially changed since the date of the registration.
- (iii) if the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

5.2.2.5 Requirement of Use

The use of a mark is very important for it to act as a trade mark. The Act allows a mark used or proposed to be used to be registered.¹¹² This area will be discussed fully in the next section.

5.2.2.6 Assignment and Licensing

The Act permits assignments of a registered trade mark either in connection with the goodwill of a business or not. In addition licensing of trade is recognised under the law.¹¹³ This area will be discussed fully in the next section.

5.2.2.7 Rights Conferred by Registration

The rights conferred by the registration in part A and part B varies. The proprietor of a trade mark registered in part A has exclusive rights to the use of the trade mark, whereas a proprietor of a trade mark registered under part B has similar rights except in an action for infringement, no injunction or other relief shall be granted to the plaintiff (proprietor) if the defendant can show to the satisfaction of the court that his unauthorised use of the trade mark is not likely to deceive or cause confusion. In order to avoid repetition, this is another area which will be discussed fully in the following section.

5.2.2.8 Foreign Trade Marks Application

The law provides that priority should be given to foreign applications provided such an application is made within six months from the date of the application for protection in the Convention country. However, no damages may be claimed regarding infringements prior to

¹¹² Section 18 TMA 1965 T13 LFN 2004.

¹¹³ Section 26 TMA 1965 T13 LFN 2004.

the actual date of registration in Nigeria.¹¹⁴ The Paris Convention is applicable in Nigeria only if the Convention is domesticated into local law,¹¹⁵ thus the provisions of the Paris Convention are unenforceable even though the Act makes clear reference to the protection of trade marks in Convention countries. This situation is the consequence of the fact that there has never been a Federal Gazette relating to section 44 of the Act which provides for international arrangements.¹¹⁶

5.2.3 Recent Developments in Trade Mark Laws

A recent development in the Nigerian trade marks law in 2006 is the proposed establishment of a central administration system for all intellectual property matters with the exception of copyrights. A welcome development, praised in all quarters, as it is hoped that this development will bring about a better administration of IP in Nigeria. A Nigerian Intellectual Property Commission (NIPCOM) to be supervised by the ministry of Justice was proposed to function as a full-fledged regulatory and enforcement agency in charge of IP administration in Nigeria.¹¹⁷ The initiative was followed by the drafting of a Bill in 2008 entitled, ‘A Bill for an Act to provide for the Establishment of the Intellectual Property Commission of Nigeria, Repeal of Trade Marks Act, Cap. T13, LFN 2004 and Patents and Designs Act, Cap. P2, LFN 2004 and Make Comprehensive Provisions for the Registration and Protection of Trade Marks, Patents and Designs, Plant Varieties, Animal Breeders and Farmers Rights and for other Related Matters.’¹¹⁸

The Bill was supposed to repeal the Trade Marks Act and Patents and Designs Act, and make comprehensive provisions for the registration and protection of Trade Marks, Patents and Designs, Plant Varieties, Animal Breeders and Farmers Rights and for other related matters.

¹¹⁴ Section 44 TMA 1965 T13 LFN 2004.. It should however be not that paragraph 6 state that the declaration made in section 44 shall not have effect until published in the Federal Gazette.

¹¹⁵ Section 12 (1) Chapter I, Part II of the Constitution of the Federal Republic of Nigeria.

¹¹⁶ Section 44(6) TMA 1965 T13 LFN 2004.

¹¹⁷ Bolanle Olowu Nigeria: Will Nipcom Solve the Problems? *This Day* 6 April 2009 available at <http://allafrica.com/stories/200904070095.html> accessed 21 may 2013. A long title, also known as the Bill for the Establishment of the Nigerian IP Commission (IPCOM Bill).

Part B of the IPCOM Bill encompasses the Trade Mark Act from sections 26-104. This Bill consists of a number of modifications in line with the TRIPS Agreement. Although, the idea of an IP Commission is laudable, the lumping of all intellectual property matters and repealing the Trade Marks and Patent and Design Act makes the Bill look chaotic. Necessary amendments to the existing laws and the drafting of new laws for areas such as Plant Varieties, Animal Breeders and Farmers Rights and for other Related Matters would have been sufficient to bring the law in compliance with Nigeria's international obligations. The Bill establishing the IP Commission should have been separated from the IP laws. Even if the intent of the drafters is to have all IP laws in one Bill, it is believed that each aspect of intellectual property should have a separate and distinct Act which may be brought together in one Bill.

The drafted Trade Marks Act made amendments to the trade mark definition to include service marks and defined a trade mark more concisely.¹¹⁹ As well, it introduced the possibility of registering marks that are not visually perceptible, such as sound, smell, taste and texture.¹²⁰ In addition, the registration of marks has been merged into a single register instead of the Part A and Part B registrations that currently exist.¹²¹ Section 44 of the Bill provides for the protection of trade marks that are attributable to a geographical origin and a definition of 'geographical indications' is included in the Bill. The draft Bill amends the duration for trade marks registration protection and renewal to an initial term of protection on registration of a trade marks to seven (7) years; on expiration of the original term of registration the trade mark will be renewed for another seven (7) years¹²² and thereafter to be renewed every seven (7) years in perpetuity.¹²³ The draft Bill also includes a provision for the protection of well-known marks,¹²⁴ which is a welcome development.

¹¹⁹ Section 30 (1) Bill for the Establishment of the Nigerian IP Commission.

¹²⁰ Section 30(3) Bill for the Establishment of the Nigerian IP Commission.

¹²¹ Section 27 (1) Bill for the Establishment of the Nigerian IP Commission.

¹²² The current Trade mark Act provides for the a renewal of fourteen (14), Section 23(2) TMA 1965 T13 LFN 2004.

¹²³ 51 (1) Bill for the Establishment of the Nigerian IP Commission.

¹²⁴ 32 Bill for the Establishment of the Nigerian IP Commission.

Although, the Bill amends some of the major issues in the Act, the Bill lacks structure and organisation. All the issues are jumbled together and one has to read through the Bill to decipher the amendments made.¹²⁵ An interpretation section was omitted in the Bill. Fortunately, or unfortunately, the IPCOM Bill is only a draft Bill which can still be amended. The draft Bill is currently not even part of Bills before the National Assembly for consideration.¹²⁶ It is not the only draft Bill in relation to trade marks that is a dead end; in 1988, a proposed draft, known as the Industrial Property Decree, which the Law Reform Commission reviewed and reformed with the intent of passing into law did not pass beyond the stage of a draft as it received no comments and response form the government and was never signed into law.¹²⁷

5.3 The Level of Compliance of the Nigerian Trade Mark Laws to the TRIPS Agreement.

This section will examine the substantive law on trade marks in Nigeria to determine its compliance with the minimum standard expected under the TRIPS Agreement. In the following discussion, an outline will be presented of the various minimum standards on trade mark in the TRIPS Agreement and how they impact on Nigeria's domestic laws and regulations. First, an overview of the protectable subject matter as well as the rights permitted and terms of protection allowed will be examined. Next, the specific issues, such as requirement of use and other requirements, exceptions from trade mark protection, licensing and assignment of trade marks will be discussed, as it follows in the TRIPS Agreement. Prior to the discussion, however, a brief examination of the Paris Convention will be undertaken in view of its incorporation into the TRIPS Agreement and due to the fact that reference may need to be made to certain provisions of the Paris Convention.

¹²⁵ For instance the use of a single register. Reference was made in section 27. (1) There shall continue to be kept the record called *the register of trade marks and the register was mention throughout the section.*

¹²⁶ The National Assembly Federal Republic of Nigeria available at <http://www.nassnig.org/nass2/legislation.php> accessed 21 may 2013.

¹²⁷ Chidi Oguamanam 'Trade Marks Trade Names Regime in Nigeria p. 60.

5.3.1 Relationship of the TRIPS Agreement to the Paris Convention

As noted in chapter 4, the TRIPS Agreement draws upon other international intellectual property Conventions.¹²⁸ In relation to trade marks, it is the Paris Convention which was incorporated as part of the minimum standard with which WTO members' are required to comply. The TRIPS Agreement makes it mandatory for members to comply with existing international Conventions. As in the case of the provisions on Copyright¹²⁹ where certain provisions were selected that WTO members had to comply with, a similar selection was made for trade marks and patents jointly. However, the specific provisions on trade marks are in articles 6 to 9 of the Paris Convention, which means the Convention does not apply *mutatis mutandis*, except where specified in the TRIPS Agreement.¹³⁰ Article 2.1, accordingly, in a way compels non Paris Convention members to abide with the provisions as stated.¹³¹

Articles 6 through 12 of the Paris Convention were selected purposefully as they comprise the material provisions in the Convention, all the other provisions are administrative and are intended to be performed by the WTO. The TRIPS Agreement preserves all existing obligations under the Convention.¹³²

5.3.2 The Paris Convention

The Paris Convention is the main treaty containing significant standards on international trade mark rights prior to the coming into force of the TRIPS Agreement.¹³³ The Convention is for the protection of industrial property, which includes patents, utility models, industrial designs, trade marks, service marks, trade names, indications of source or appellations of

¹²⁸ Paris Convention, the Berne Convention, the Rome Convention and the Treaty on Intellectual Property in Respect of Integrated Circuits.

¹²⁹ Article 9.1 TRIPS Agreement.

¹³⁰ Article 2.1 TRIPS Agreement.

¹³¹ Gervais, Daniel, *The TRIPS Agreement Drafting History and Analysis* 4th edition Sweet and Maxwell Croydon 2012 para 2.135 p. 244. See also Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Ed) *WTO Trade Related Aspect of Intellectual property Rights* Max Planck Commentaries on World Trade Law, 7 Marinus Nijhoff Publishers Leiden Boston 2009 p. 209.

¹³² Article 2.2 TRIPS Agreement.

¹³³ Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds) *WTO Trade Related Aspect of Intellectual Property Rights* Max Planck Commentaries on World Trade Law, 7 Marinus Nijhoff Publishers Leiden Boston 2009 p. 304.

origin, and the repression of unfair competition.¹³⁴ The Paris Convention has undergone several reviews: the most recent is the Stockholm revision of 1967.

The chief motivation for the establishment of the Paris Convention was to harmonise the national trade mark laws by allowing nationals of other states to enjoy the same protection and rights as nationals of another member state without discrimination: generally, this is known as the principle of national treatment.¹³⁵ Another vital aspect of the Paris Convention is the provision on priority right which allows an applicant to benefit from an earlier filing date in any of the Union countries: all applications filed within six months of the first application in another country will benefit from the date the first application was filed.¹³⁶

Of particular note in the Paris Convention is the provision that provides that countries of the Union can enter into special agreements for the protection of industrial property provided the agreements do not contravene the provisions of the Convention.¹³⁷ Such special agreements which countries have entered into include the Madrid Agreement Concerning the International Registration of Marks¹³⁸ and the Protocol Relating to the Madrid Agreement,¹³⁹ which are known as the Madrid system. The Madrid system facilitates obtaining international registration of marks (bundle of national registrations) in multiple jurisdictions¹⁴⁰ of Contracting Parties designated by the applicant and makes the management of protection easier for right holders. Currently there are 56 member states that have ratified the Madrid Agreement Concerning the International Registration of Marks and 89 member states for the Madrid Protocol Relating to the Agreement.¹⁴¹ Though, Nigeria is a signatory to the Paris Convention, it is not a member of the Madrid Union. The Paris Convention, Madrid Agreement and Protocol are all administered by the WIPO. The importance to this

¹³⁴ Article 1 (2) Paris Convention 1979.

¹³⁵ Article 2 and 3 Paris Convention 1979.

¹³⁶ Article 4 Paris Convention 1979.

¹³⁷ Article 19 Paris Convention 1979.

¹³⁸ The Madrid Agreement (Marks) was established (1891), revised at Brussels (1900), at Washington (1911), at The Hague (1925), at London (1934), Nice (1957) and at Stockholm (1967), and amended in 1979.

¹³⁹ The Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. Madrid Protocol (1989), amended in 2006 and in 2007.

¹⁴⁰ Contracting Parties State.

¹⁴¹ Treaties and Contracting Parties: Madrid Protocol - WIPO Status on April 15, 2013 available at http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf accessed 20 May 2013.

international arrangement has been substantiated by the fact that even though trade marks are registered in only one territory they are found in other territories: proprietors who wish to engage in international trade have to protect their marks in various territories.¹⁴²

5.3.3 Article 15.1: Protectable Subject Matter

The 1965 Trade Mark Act contains a definition of marks and¹⁴³ trade marks.¹⁴⁴ The international prescription of marks that are protectable includes any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings. Such signs, particularly, include personal names, letters, numerals, figurative elements and combinations of colours, as well as any combination of such signs.¹⁴⁵ These signs shall be capable of constituting a trade mark and shall be eligible for registration as trade marks.¹⁴⁶ Article 15.1 does not make any reference to three dimensional designs. However, it may not mean that they can or should be excluded from protection.

Section 9 establishes protection of a mark subject to its distinctiveness in relation to the goods which a trade mark is registered for or proposed to be registered for. One of the grounds for non-registration is a lack of distinctiveness of the trade mark proposed to be registered.¹⁴⁷ In *Hondret & co v Registrar of Trade marks*¹⁴⁸ the Federal High Court held that the ‘essential purpose of a trade mark is to distinguish the goods from similar goods and identify them with a particular trader’. The trade mark law is in compliance with the requirement of a sign or mark and also provides that a mark must be able to distinguish goods and services to be capable of being a trade mark.

In addition, as required by the third sentence of article 15.1 of the TRIPS Agreement, members can register marks which acquire distinctiveness through use: under section 10 of

¹⁴² Rutherford and Kelbrick, Trade Marks Law, University of South Africa, 1.1.6 – 1.7.7 cited by Elson Kaseke Trade Marks: Fundamental Elements of the New Law available at http://www.belipo.bz/wp-content/uploads/2011/12/fundamental_elements.pdf accessed 20 May 2013.

¹⁴³ Marks as defined in the Act includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof; Section 67 TMA 1965 T13 LFN 2004.

¹⁴⁴ Section 67 TMA 1965 T13 LFN 2004.

¹⁴⁵ Article 15.1 TRIPS Agreement.

¹⁴⁶ Article 15.1 TRIPS Agreement.

¹⁴⁷ Section 9 (1) (proviso) TMA 1965 T13 LFN 2004.

¹⁴⁸ (1979) 2 I.P.L.R. 102, FRC/L/M92/79.

the Act such marks are capable of registration as well. Members are not obliged to register marks that are not visually perceptible,¹⁴⁹ such as auditory, olfactory, taste and texture. The Act does not specifically state that graphic representation and visually perceptible marks are required. However, it can be argued that since the law is silent on this point the registration can be made subject to such representation, particularly when every application for the registration of trade mark is required to contain a representation.¹⁵⁰ It seems only logical that the representation will be a graphic representation and be visually perceptible. Since the requirements of graphic representation and being visually perceptible are optional the trade mark law is in compliance with this provision.

5.3.3.1 Article 15.2: Grounds for Denial of Registration

Article 15.2 states that members shall not decline registration on grounds other than those contained in article 15.1 and those contained in the Paris Convention.¹⁵¹ The requirements for registration that have to be met in order to prevent denial of trade mark registration are twofold under Nigerian trade marks law: first, the signs must be inherently capable of distinguishing relevant goods or services¹⁵² and second, distinctiveness can be acquired through use on relevant goods or services.¹⁵³ In other words, registration may be denied for other reasons as set out in article 15.1 but those reasons must conform to the provisions of the Paris Convention. Article 6 (1)¹⁵⁴ of the Paris Convention provides that each country of the Paris Union reserves the right to determine conditions for the filing and registration of

¹⁴⁹ Article 15.1 TRIPS Agreement.

¹⁵⁰ Rule 25 (1) TMR L.N. 70 of 1967.

¹⁵¹ Article 6*quinquies* (B) Paris Convention : Trade marks covered by this Article may be neither denied registration nor invalidated except in the following cases:

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order. This provision is subject, however, to the application of Article 10bis.

¹⁵² Section 9 TMA 1965 T13 LFN 2004.

¹⁵³ Section 10 TMA 1965 T13 LFN 2004.

¹⁵⁴ Paris Convention (1967).

trade marks to domestic legislations. Accordingly, conditions may vary from one country to the other in line with the Paris Convention.

Article 15.2 came up for examination in *United States – Section 211 Omnibus Appropriations Act of 1998*¹⁵⁵ and the Appellate Body concluded that ‘other grounds for the denial of registration within the meaning of article 15.2 of the TRIPS Agreement are not limited to grounds expressly provided for in the exceptions contained in the Paris Convention (1967) or the TRIPS Agreement’.¹⁵⁶ According to the Appellate Body, article 15.1 of the TRIPS Agreement limits the right of members to determine the ‘conditions’ for filing and registration of trade marks under their domestic legislation pursuant to article 6(1)¹⁵⁷ only as it relates to the distinctiveness requirements enunciated in article 15.1.

As mentioned above, section 9 (2) of the Act requires that a trade mark be inherently adapted to distinguish for registration under part A and section 10 of the Act requires that trade marks in part B should be capable of distinguishing or have acquired distinctiveness for registration.¹⁵⁸ In addition, the Act and the Regulation contain numerous grounds for denial of registration.¹⁵⁹

Even though the Paris Convention does not specifically exclude marks that are scandalous, obscene or immoral and deceptive most countries do not protect marks that fall within these categories.¹⁶⁰ Marks that fall under this category are prohibited under Nigerian law. In summary, Nigerian trade mark law is in compliance with the provision of article 15.2.

¹⁵⁵ WT/DS176/AB/R.

¹⁵⁶ WT/DS176/AB/R *United States – Section 211 Appellate Panel Report para 178.*

¹⁵⁷ Paris Convention 1979.

¹⁵⁸ In the light of section 10(3) ‘a trade mark may be registered in part B notwithstanding any registration in part A in the name of the same proprietor of the same trade mark or parts thereof’.

¹⁵⁹ See para 5.2.2.2 d of this chapter. Section 11 TMA 1965 T13 LFN 2004; section 12 TMA 1965 T13 LFN 2004; section 13 62 TMA 1965 T13 LFN 2004; Section 62 TMA 1965 T13 LFN 2004; rule 18(a) TMR L.N. 70 of 1967; rule 18 (c) TMR L.N. 70 of 1967; rule 17 (a) TMR L.N. 70 of 1967; Section 17 (b) Trade Marks Regulations. L.N. 70 of 1967; rule 18 (b) TMR L.N. 70 of 1967.

¹⁶⁰ Section 11 TMA 1965 T13 LFN 2004; see also Section 10 (12) South African Trade Marks Act No 47 of 1999; section 2(a) Trademark Act, 15 U.S.C. 1052(a); section 9(1) Canadian Trade-marks Act R.S.C., 1985, c. T-13.

5.3.3.2 Article 15.3: Registration Depends on Use

In Nigeria, registration of a trade mark does not depend on whether the mark is actually used or not, a mark may be registered if it has been in use or it is still proposed to be used by the applicant.¹⁶¹ This is against the common law position where a trade mark owner can acquire registration rights only after the mark is actually used in commerce.¹⁶² Trade mark rights are acquired through registration of the mark in Nigeria, accordingly issues of use of a trade mark do not become an issue until the mark has been registered. Thus, where a mark has been registered *mala fide* without any intention of using the mark on goods and there has not been a *bona fide* use of the mark on goods, an application can be brought to remove it from the register if five years or longer have elapsed from the date of registration and the trade mark has not been used.¹⁶³ Removal from the register based on non-use is not automatic. It must be shown that such non-use was not due to special circumstances in the trade and that it is a deliberate intent not to use or to abandon the trade mark.¹⁶⁴ This requirement of use is to ensure that the trade mark register does not become clogged with unused trademarks hereby preventing registration of trademarks which are in use or intended to be used.¹⁶⁵

Article 15.3 seems to imply that intent to use applications of trademarks are registrable and may not be refused registration. However, if the trade mark that was registered based on intent to use is not used within 3 years of registration, it may be removed.

The issue of use of trade mark was first introduced into the Paris Convention at the Revision Conference of The Hague in 1925.¹⁶⁶ The introduction was only the first paragraph of article 5C; the other two paragraphs were added in 1934¹⁶⁷ at the Conference of London Revision.¹⁶⁸

¹⁶¹ Section 18 (1) TMA 1965 T13 LFN 2004.

¹⁶² Traci L. Jones. *Remedy Holes and Bottomless Rights: A Critique of the Intent-to-Use System of Trademark Registration* (1996) *Law and Contemporary Problems* 59 p. 159-180 p.159; *See La Societd Anonyme des Parfums LeGalion v. Jean Patou, Inc.*, 495 F.2d 1265, 1270 (2d Cir. 1974).

¹⁶³ Section 31 (2) (b) TMA 1965 T13 LFN 2004.

¹⁶⁴ Section 31(4) TMA 1965 T13 LFN 2004.

¹⁶⁵ Bodenhausen G. H. C, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised at Stockholm in 1967 WIPO Publication N°611 (E) BIRPI1969 2007 p.75.

¹⁶⁶ *Actes de Londres*, pp. 178/9, 281 (proposals), 264/5 (observations), 386/90 (report of Third Sub-Committee), 460/1 (report of Drafting Committee), 515 (adoption in Second Plenary Session) cited by Bodenhausen G. H. C, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised at Stockholm in 1967 WIPO Publication N°611 (E) BIRPI1969 2007 p.75.

¹⁶⁷ Bodenhausen G. H. C, p.75.

The Paris Convention provides that where use of a registered mark is compulsory, the registration may be cancelled only after a reasonable period and if the person concerned does not justify his inaction.¹⁶⁹ What is reasonable however, is subject to the interpretation of each country of the Union. Registration in other countries of the Union is not invalidated by alterations that do not affect the distinctive character of the mark in the form it was registered in one of the countries of the Union.¹⁷⁰

Although, the TRIPS Agreement does not require the use of a trade mark before registration, some countries, such as the US, require a trade mark to be used in commerce¹⁷¹ or have a *bona fide* intention to be used in commerce.¹⁷² Canada, on the other hand, requires actual use as a requisite for registration of the trade mark in the country.¹⁷³ The Canadian position contravenes the TRIPS Agreement provision regarding actual use, which states that ‘actual use of a trade mark shall not be a condition for filing an application for registration’.¹⁷⁴ The US position and process regarding registration of marks also conflicts with article 15.3 for the reason that where actual use is not shown, only a ‘Notice of Allowance’ (NOA) to use the mark is issued, which means that the mark has been ‘allowed’ but not registered. For the trade mark to be registered in the United States a ‘Statement of Use’ has to be filed showing the mark is now used in commerce within six (6) months of the issue date of the NOA.¹⁷⁵

In conclusion, Nigerian law is clear and straight forward in this regard: As ‘no application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does

¹⁶⁸ Bodenhausen G. H. C, p.75.

¹⁶⁹ Article 5C(1) Paris Convention 1979.

¹⁷⁰ Article 5C (2) Paris Convention 1979.

¹⁷¹ 15 U.S.C. 1051(a) The term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.

¹⁷² 15 U.S.C. 1051(b).

¹⁷³ Section 40(2) Canadian Trade-marks Act R.S.C., 1985, c. T-13.

¹⁷⁴ Article 15. 3 TRIPS Agreement.

¹⁷⁵ Basic Facts About Trademarks United States Patent and Trademark Office available at <http://www.uspto.gov/trademarks/basics/BasicFacts.pdf> accessed 22 May 2013.

not use or propose to use the trade mark'.¹⁷⁶ Hence, the law is in compliance with article 15.3 of the TRIPS Agreement.

5.3.3.3 Article 15.4: Nature of the Goods or Services

Generally, in Nigeria, goods and services are registered if they are not in the categories that are excluded from registration, such as deceptive or scandalous matter.¹⁷⁷ Most countries refuse registration on the grounds that the mark is contrary to public policy or immoral. The Nigerian Trade Marks Act expressly declares such refusal. Article 15.4 replicates article 7 of the Paris Convention. The object of this article reflects a situation in which the product for which the trade mark is to be used is restricted: the restriction of a product does not preclude the registration of the trade mark.¹⁷⁸ The intent of the article is not to allow registration of trade marks without recourse to the absolute bar to registration. The trade mark registrar does not have discretion concerning the grounds for refusal.¹⁷⁹ Article 15.4 appears open-ended. The TRIPS Agreement, however, sets a minimum standard, which presupposes that members may add caveats that exclude trade marks that are deceptive, scandalous, immoral and generally contrary to public policy. But, for instance, if a trade mark is to be registered for use on guns, registration may not be refused simply because guns are used for killing.

5.3.3.4 Article 15.5: Publication, Opposition and Cancellation of Trade Marks

Prompt publication of trade marks before and after registration is required to provide reasonable opportunity for cancellation and opposition,¹⁸⁰ which is a standard practice in the registration of trade marks and is required under the TRIPS Agreement. The provision for the publication and cancellation of trade marks is in the Paris Convention of 1883, which stipulates that each member state shall publish regularly, an official periodical journal containing the reproduction of registered trade marks.¹⁸¹ This has been the practice in Nigeria

¹⁷⁶ Section 35 (1) TMA 1965 T13 LFN 2004.

¹⁷⁷ Section 11 TMA 1965 T13 LFN 2004.

¹⁷⁸ Bodenhausen G. H. C, Guide to the Application of the Paris Convention for the Protection of Industrial Property p.129.

¹⁷⁹ Catherine Colston & Jonathan Galloway. *Modern Intellectual Property Law* 3rd ed. Routledge New York 2010 p. 629.

¹⁸⁰ Article 15.5 TRIPS Agreement.

¹⁸¹ Article 12 (2) b. Paris Convention 1967. See also Article 3 (4) Madrid Agreement and Protocol.

since the inception of the first Trade Mark Ordinance of 1900 and is still the practice.¹⁸² The publication of the Nigerian Trade Mark Journal is highly irregular. Such irregularity may present problems, for instance, if a trade mark has been accepted but not published on time it might lead to double registration. The irregularity in publication of the Trade Mark Journal defeats the purpose of the requirement to publish which is to allow third parties promptly to oppose registration and initiate proceedings for cancellation where necessary.

Upon publication in the Trade Mark Journal, opposition proceedings may be lodged by any interested party within two months from the date of the publication of acceptance of the application. Such opposition is initiated by filing a notice informing the registrar of intent to oppose the registration. The notice must be in writing, state the grounds of opposition and must be filed within the specified time as extensions are not allowed.¹⁸³

The situation where an opposition is not filed within two months by an owner of an identical mark may result in identical marks on identical goods being included in the register.¹⁸⁴ In the event of this kind of situation the proprietor of a registered trade mark can institute a court action against the offender for infringement or passing off. Cancellation proceedings may be initiated in the Federal High Court as double registration is frowned upon by the law.¹⁸⁵ Cancellation of trade marks under the Nigeria Trade Mark Act can be made by the Registrar on application in writing by the proprietor or any person.¹⁸⁶

¹⁸² Section 19 TMA 1965 T13 LFN 2004.

¹⁸³ Section 20 (1) & (2) TMA 1965 T13 LFN 2004; Also Rule 48-60 TMR L.N. 70 of 1967..

¹⁸⁴ See *Omnia (Nig.) Ltd v Dyke Trade Ltd* [2007] 15 NWLR Pt 1058, p. 576 Omnia Nigeria Ltd traded with an Italian company manufacturing grinding stones for the washing of terrazzo floors under the trade mark 'Super Rocket' for grinding stones registered in Nigeria. Substantial quantities of 'Super Rocket' grinding stones were sold by Omnia all over Nigeria and had acquired reputation and goodwill in the trade mark. In December 1992, Dyke Trade Ltd began to import consignments of grinding stones branded 'Super Rocket' and distributed and sold them. An Anton Piller Order was obtained by Omnia Nigeria Ltd against Dyke Trade Ltd and an action brought seeking to restrain the company and Directors/Officers from infringing the trade mark 'Super Rocket' and for passing off or enabling others to pass off grinding stones used for the purpose of terrazzo floors inscribed with the trade mark 'Super Rocket'. See also *AYMAN Industries v AKUMA Industries* (2003) 6 S.C. 44 (ORIGINAL QUEENS was registered in error for the same type of goods as NEW QUEEN) where by acts of error or omission both mark become registered. *Patkun Industries Ltd v Niger Stores* [1998] 5 NWLR Pt 93, p.138.

¹⁸⁵ Section 13 (1) TMA 1965 T13 LFN 2004.; see also *CPL industries Ltd. v Glaxo Smithkline & Another* 6 I.P L.R 2011.

¹⁸⁶ Section 34(5) 3 c i-iii TMA 1965 T13 LFN 2004.

Furthermore, trade mark registration may be cancelled at any time by the registrar if the trade mark is no longer registered.¹⁸⁷ Overall the Trade Mark Act provides a procedure for publication, opposition and registration of trade marks as required in the TRIPS Agreement.

5.3.4 Article 16: Rights Conferred

Article 16.1 is divided into three sentences which will be discussed separately

5.3.4.1 Article 16.1: Exclusive Trade Marks Right¹⁸⁸

Rights conferred in article 16 are important in the protection of trade marks in that the article sets the boundaries between the registered owner and others users. The rights of an owner of a registered trade mark are outlined in sections 5 and 6 of the Act as the exclusive right given or deemed to have been granted to a person to use a trade mark in relation to goods and services. Unlike the provision of article 16.1 of the TRIPS Agreement, which is an exclusive right to prevent all third parties who do not have the owner's consent from using the trade mark on identical or similar signs for goods in the course of trade, the Trade Marks Act confers a positive right, 'which is an exclusive right to use'¹⁸⁹ and not a right to prevent, which is a negative right.¹⁹⁰

As acknowledged by Gervais, the TRIPS Agreement does not grant the owner of a trade mark the right to use the trademark explicitly¹⁹¹ but the spirit of TRIPS Agreement seems to permit the use of trade marks by owners. The explanation for this is based on the fact that the TRIPS Agreement provides for the maintenance of trademark registration based on use and prohibits the denial of registration based on the nature of the goods or services.¹⁹²

¹⁸⁷ Section 34(7) TMA 1965 T13 LFN 2004. Thus where the registration of a trade mark is not renewed within the specified period such marks can be removed from the register.

¹⁸⁸ Article 16.1 is divided into three sentences which will be discussed separately. This section discusses the first part of Article 16.1

¹⁸⁹ Section 5 and 6 TMA 1965 T13 LFN 2004.

¹⁹⁰ Daniel Gervais Report for Japan Tobacco International, *Analysis of the Compatibility of certain Tobacco Product Packaging Rules with the TRIPS Agreement and the Paris Convention paras 22 p.9 and 29 p.11*

¹⁹¹ Daniel Gervais Report for Japan Tobacco International, *para 30 p.11*

¹⁹² Daniel Gervais Report for Japan Tobacco International, *para 22 p.9*; See also Annette Kur, 'The right to use one's own trade mark: a self-evident issue or a new concept in German, European and international trade mark law?' (1996) 18 (4) *European Intellectual Property Review* 198, 203.

The exclusive right is purported to be used without the owner's consent by any person who is not the proprietor of the trade mark or is a registered user who uses a mark identical with the trade mark, or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade in relation to the goods for which it is registered.¹⁹³ In the same vein article 10bis (3) of the Paris Convention provides for the prohibition of 'all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities of a competitor.'¹⁹⁴ It has been noted that article 16¹⁹⁵ creates an internationally agreed minimum level of exclusive rights for trade mark owners against unauthorised third parties that must be guaranteed in domestic legislations.¹⁹⁶ This right is guaranteed in the trade marks law in Nigeria and, accordingly, it is compliant with the TRIPS Agreement.

5.3.4.2 Article 16.1: Likelihood of Confusion¹⁹⁷

The Trade Mark Act specifies that it is unlawful to register as a trade mark or part of a trade mark that which, by reason of its use, would be is likely to cause confusion.¹⁹⁸ In addition, no trade mark can be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.¹⁹⁹ In the recent past trade mark litigation, especially in the area of a likelihood of confusion, has progressed in Nigeria, for instance, in the case of *Beecham Group Limited v Esdee Food Products Nigeria Ltd.*²⁰⁰ The main issue that went to the Court of Appeal was whether the appellant's product, named GLUCOS-AID, infringed the respondents trade mark LUCOZADE. The Court of Appeal dismissed the appeal unanimously stating that the law of trade marks is aimed at the subtle as well as the obvious

¹⁹³ Article 16.1 TRIPS Agreement 1994. This provision now relates to services marks as well.

¹⁹⁴ Article 10bis (3) of the Paris Convention.

¹⁹⁵ TRIPS Agreement 1994.

¹⁹⁶ World Trade Organization, United States - Section 211 Omnibus Appropriations Act of 1998, WT/DS176/AB/R para 186 Doc. No. 02-001 (Jan. 2, 2002), available at http://www.wto.org/english/tratop_e/dispu_e/176abr_e.doc accessed 15th May 2013.

¹⁹⁷ This section discusses the second part of Article 16.1.

¹⁹⁸ Section 11 TMA 1965 T13 LFN 2004.

¹⁹⁹ Section 13(1) TMA 1965 T13 LFN 2004.

²⁰⁰ (1980) FHCL 17.

infracton of the law: both the ears and the eyes together are involved in the exercise of comparison of the two marks. The Court categorically stated that the criterion for determining whether or not there is an infringement of a trade mark is that the mark complained of, when compared with what is already registered, must not deceive the public or cause confusion. Accordingly, the Nigerian Courts have been active in the area of preventing the use of similar marks that are likely to cause confusion.²⁰¹

The second sentence in article 16.1 of the TRIPS Agreement specifies that where an identical sign is used for identical goods or services there is a presumption of a likelihood of confusion. As a general rule marks that are used on similar or identical goods would not be registered in Nigeria. Section 13 of the Trade Mark Acts proscribes the registration of identical marks, as stated below:

...no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

The Nigerian Courts, over the years, have had to determine what ‘substantially identical marks’ entails. A side by side comparison was utilised in *IRC International Limited v Jena Trading*,²⁰² which took into account the sound, visual similarities and pronunciation as deciding factors in holding that DOSEX GOSSAMER and SENSITOL are substantially similar to DUREX GOSSAMER and SENSITIVELY as the two marks were used on the same kind of goods.²⁰³ Thus, it is clear that the law will not permit the use of a trade mark on the same kind of goods, which is straightforward trade mark counterfeiting.²⁰⁴

²⁰¹ *Alban Pharmacy v Sterling Products (1968) All N.L.R. 292* where it was held that CASORINA is similar to CASTORIA; *Bell Sons & Co v Godwin Aka & Anor (1972) Wellcome v Joint Pharmaceuticals*, unreported case FHC/L/102/82 where Septin was held to be similar to Septrin; *Seven-up Compant & Anor v Warri Bottling Company Ltd.* (1984) FHCLR 183 where Thumbs-Up was held to be similar to Seven-Up; *Wellcom v Ranbaxy (1993) FHCRL 353* where Actid was held to be similar to Actified; *International Tobacco (NIG) Ltd v British American Tobacco (NIG) Ltd (2009) 6 NWLR (Pt. 1138) 577*; *Alliance International Limited v Saam Kolo International Enterprises Limited (2010) 13 NWLR (Pt. 121) C.A. 270.*

²⁰² (1976) FHCL 146.

²⁰³ See also *Wellcom v Foods Pharmarceutical Manufacturing Company unreported case FHC/L/55/89* WHERE Septin was held to be similar to Septrin.

²⁰⁴ UNCTAD/ICTSD, *Resource Book on TRIPS Agreement* p. 237.

On the other hand the presumption that this type of use leads automatically to a likelihood of confusion is subject to examination and dependent on the facts of each case. For instance, a Nike shoe that sells for \$300 is offered for \$50: the buyer knows it is either a fake or a stolen commodity and the buyer is not confused as to the origin of the good. It seems that ‘a likelihood of confusion shall be presumed’ where there is no confusion to make sure that persons who engage in counterfeiting of goods do not evade the law on a technicality.

5.3.4.3 Article 16.1: Prior Trade Marks Rights²⁰⁵

From the third sentence of article 16.1 it can be deduced that the TRIPS Agreement is trying to balance the concept of the use of a mark against the registration of a trade mark. The TRIPS Agreement makes it clear that the exclusive rights of the owner attained through registration shall not prejudice any existing prior rights and the possibility of registering a mark that has acquired secondary meaning through use. This provision is not novel as the Paris Convention has a provision on priority rights²⁰⁶ and it is a common position in most trade mark laws.²⁰⁷ The Nigeria Act explicitly provides that prior rights shall not be interfered with by a registered user of the trade mark, used in relation to identical or closely resembling goods, provided the trade mark has been ‘continuously used’ prior to the date of the registration of the trade mark in the name of the proprietor.²⁰⁸

The issue was brought to fore in the case of *American Cyanamid Company v Vitality Pharmaceutical Ltd.*²⁰⁹ The appellant claimed that the respondent’s mark, GONORCIN, infringed its own GONOCIN trade mark used for an antibiotic. The appellant is the registered proprietor of trade mark: ‘GONOCIN’ No. 27409 Schedule 4 in respect of the following goods to wit antibiotic preparations.’ The first plaintiff (appellant) is a corporation registered and existing under the Laws of the State of Maine USA. The respondent was first registered in 1956 as Vitality Medicine Stores and incorporated as a limited liability

²⁰⁵ This section discusses the second part of Article 16.1.

²⁰⁶ Article 4 Paris Convention 1967.

²⁰⁷ Section 5 UK Trade Marks Act 1994; section 34 India Trade Marks Act 1999; Section 21(1) Canadian Trade-Marks Act R.S.C., 1985, c. T-13 as amended 2008; § 7c(1) (15 U.S.C. § 1052) Trademark Act of 1946 as Amended; section 124 Australian Trade Marks Act 1995 No. 119, 1995 as amended Act No. 13, 2013 and Article 44 UAE Trade Marks Law 1992 of Federal Law no. 37.

²⁰⁸ Section 7 (1) TMA 1965 T13 LFN 2004.

²⁰⁹ (1991) All NLR 257; (1991) 2 S.C 47; see also *Emegokwe v Okadigbo* (1971) 4 S.C. 113.

pharmaceutical company in 1980. The respondent, since 1963, has been the sole agent of one Herbrand K.G. Hornonforsonung-Laboratorium, Gengenbach/Baden, West Germany which manufactures antibiotic preparations. Since 1968 the Vitality Medicine Stores has put in the market and sold antibiotic preparation manufactured by Herbrand Company, bearing the word 'GONORCIN' in bold green letters and other words in smaller forms. Accordingly, the Federal High Court held that the respondent was entitled to the protection afforded by section 7 of the Act. On appeal the Court of Appeal dismissed the case upholding the lower court's decision. The Supreme Court in dismissing the appeal stated: 'there has been a continuous use by the defendant of the name GONORCIN since 1968. The plaintiff is therefore not entitled to interfere with the use of the defendant's trade mark GONORCIN. Defendant is entitled to the protection of section 7 of the Trade Marks Act, 1965.'²¹⁰ This provision of section 7 is premised on the fact that a prior user of a trade mark should not be denied continuing use of the mark merely because a subsequent user registered his right.

The Act makes provision for international arrangements by granting protection to trade marks that have been registered in other convention countries to be registered within six month from the date of filling an application for protection in that Convention country and the registration shall have the same the date of application as in the initial Convention country.²¹¹ Curiously, this provision cannot be enforced in Nigeria unless a declaration is made and published in the Federal Gazette.²¹² Therefore, international priority rights for now are not obtainable in Nigeria: but this does not mean that foreign trade marks are not registrable, it only means that the priority date cannot be claimed.

In addition, the law permits an honest concurrent use of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor.²¹³ In all, this provision is not at variance with the expected level of protection stipulated in the TRIPS Agreement.

²¹⁰ Per A. G. KARIBI-WHYTE, J.S.C.

²¹¹ Section 44 (a) TMA 1965 T13 LFN 2004.

²¹² Section 44(b) TMA 1965 T13 LFN 2004.

²¹³ Section 13 TMA 1965 T13 LFN 2004; For a similar provision see section 14 Trade Marks Act NO. 194 of 1993.

5.3.4.4 Article 16.2 and 16.3: Protection of Well-Known Marks

The protection of well-known marks stem from the fact that the world has become a global village and local traders and business owners like to take advantage of the reputation of well-known marks.²¹⁴ Article 6bis of the Paris Convention on the protection of well-known trademarks²¹⁵ provides that a competent authority²¹⁶ in the country of registration may refuse, cancel the registration or prohibit the use of a trademark which constitutes a reproduction, an imitation, or a translation that is liable to create confusion if the legislation so permits or at the request of an interested party. In addition, the mark must be for a person entitled to the benefits of the Convention and the use must be on identical or similar goods. The same rights under article 6bis that accrue to well-known trade marks on goods would be extended to services marks, as stated in article 16.2.

The protection of well-known marks is to avoid granting protection to conflicting marks by their being registered to the detriment of a well-known mark.²¹⁷ What is a well-known trade mark is subject to determination in accordance with various factors such as the relevant sector of the public and knowledge obtained as a result of the promotion of the trademark in the member state.²¹⁸ This requirement can be interpreted in such a way that a mark, at least, must be in use in a WTO member state for it to be recognised as well-known: a well-known mark in South Africa may not be regarded as well-known in Nigeria. For example LUCKY STAR is a well-known trade mark used on Pilchards in South Africa; if that trade mark and product is not on the Nigeria market and, therefore, unknown, for it to gain protection in

²¹⁴ Mostert, Frederick W. Famous and Well Known marks Butterworth London 1997 p.2

²¹⁵ Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p. 325; article 6bis of the Paris Convention protects the use for identical or similar goods a reproduction or an imitation or a translation of which is liable to create confusion.

²¹⁶ ‘Competent authority’ means an administrative, judicial or quasi-judicial authority of a member State which is competent for determining whether a mark is a well-known mark, or for enforcing the protection of well-known marks. Definition is from the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the WIPO at the Thirty-Fourth Series of Meetings of the Assemblies of the member States of WIPO September 20 to 29, 1999.

²¹⁷ UNCTAD/ICTSD, *Resource Book on TRIPS* p.239.

²¹⁸ *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* provides additional factors which may be used to determine if a mark is well-known available at http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub833.pdf accessed 23 May 2013.

Nigeria, the relevant sector of the public must have knowledge of it as a result of the promotion of the trademark.

It has been observed that a trade mark may be well-known in another country before its registration even before it is used in such countries due to advertisement in other countries. Whether a trade mark is well-known in a country may have to be resolved by a competent administrative or judicial authority.²¹⁹ In the South African case of *McDonald's Corporation v Joburgers Drive-Inn Restaurant (PTY)*,²²⁰ a number of McDonald's trade marks had been registered in South Africa in respect of a variety of goods and services relating to fast food services and foodstuffs. However there were no McDonald's outlets in operation in South Africa at the time of instituting this case. Joburgers Drive-Inn Restaurant proposed to open a chain of McDonald's fast food outlets selling Big mac, McMuffins and Egg McMuffins, and including the golden arches design. The Supreme Court of Appeal in South Africa held that the mark McDonald's was entitled to protection as a 'well-known trade mark' under Article 6bis of the Paris Convention despite never having been used as such at that time within South Africa.

Also, in *Nasdaq Stock Market Inc./Antarctica Srl*,²²¹ the European Court of Justice decided a case concerning the scope of protection of well-known trade marks according to article 8 (5) of the Community Trade Mark Regulation. The NASDAQ Stock Market Inc., the owner of the earlier trade mark NASDAQ registered for financial services, opposed the application of a figurative trade mark 'Nasdaq' for sport equipment by Antarctica Srl. pursuant to article 8(5) of the Community Trade mark Regulation.²²² The Court of first instance held that

²¹⁹ G. H. C. Bodenhausen *Guide to the Application of the Paris Convention for the Protection of Industrial Property* as Revised in 2007 p.91.

²²⁰ *McDonald's Corporation v Joburgers Drive-Inn Restaurant (Pty) Ltd. and Another* (547/95) [1996] ZASCA 82; 1997 (1) SA 1 (SCA); [1996] 4 All SA 1 (A); (27 August 1996).

²²¹ *Nasdaq Stock Market Inc. / Antarctica Srl* (12.3.2009 – C-320/07) see also *Davidoff / Gofkid* (DURFFEE) (ECJ 9.1.2003 – C-292/00), *Intel / CPM (Intelmark)* ECJ 27 (November 2000 – C-252/07), *Japan Tobacco / Torrefaccio Camela* (30.1.2008 / T-128/06 and 30.4.2009 – C-136/08), *Amen Corner SA / Comercio Eléctronico Ogal* (17.12.2010 / T-192/09), *L'Oréal / Bellure* (18.6.2009 C-487/07).

²²² Article 8 (5) Community Trademark Regulation COUNCIL REGULATION (EC) No 40/94 provides: '...upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier

Antarctica's use of the figurative mark NASDAQ without due cause would take unfair advantage of or be detrimental to the distinctive character and repute of the earlier mark. The trade mark NASDAQ presents a certain image of modernity which establishes the existence of a future risk that this reputation could be transferred to the goods of Antarctica. The court held that NASDAQ is a very distinctive mark and has a strong reputation. The court made a link between the two marks and stated that the marks are identical and that Antarctica sought to exploit this reputation by using the trade mark NASDAQ.

Unfortunately, in Nigeria there is no specific provision for the protection of well-known marks: however, well-known marks can be protected as defensive marks.²²³ Section 32 of the Trade Marks Act implies that a registered proprietor of a well-known trade mark may apply for the registration of the trade mark in respect of any goods that the proprietor has already registered in his name and for other goods or classes as a defensive trade mark. A defensive trade mark is registered for goods which the proprietor has no intention of using. Also, variation or similar marks to the registered trade mark which is in use can be registered. The purpose of this registration is to create a defensive perimeter around the registered well-known trade mark.²²⁴ Although well-known marks are not expressly protected, the defensive registration of well-known invented words gives well-known trade marks the necessary protection required under the Paris Convention and the TRIPS Agreement. However, it should be noted that although the Trade Marks Act refers only to goods, services are now covered under the law.²²⁵ The criteria for the protection of well-known marks are well established in other jurisdictions such as the United Kingdom,²²⁶ Canada,²²⁷ the United States²²⁸ and Japan.

Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the member state concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.⁷

²²³ Section 32 TMA 1965 T13 LFN 2004.

²²⁴ Workshop on the Revision of Trade Mark Law, Diqing (Yunnan Province), P.R. China from 13 to 15 May 2010 available at http://www.ipr2.org/storage/Ravn-What_is_a_defensive_mark-EN1030.pdf accessed 23 May 2013.

²²⁵ See para 5.2.2.1 above.

²²⁶ Section 56 UK Trade Marks Act 1994.

The protection of the reputation of well-known marks extends protection of well-known marks to non-identical and non-similar goods and services alike.²²⁹ The Nigerian Trade Marks Act grants a similar protection by the use of defensive trade mark. By allowing this form of registration of trade marks on different goods and other variations or similar marks on different goods may create a form of dilution of the mark, however, since the marks are not used in commerce, the self-dilution of the marks may not occur. The argument that has been raised is that failure to register in all available classes could lead to a loss of protection, resulting in infringement of the trade mark.²³⁰ There is a slim possibility of infringement in the same class of goods, but there is a higher possibility where the mark is a variation on different goods.

5.3.5 Article 17: Exceptions

Exceptions are an important part of any law. The broad nature of trade mark rights, which is further extended by the continuous growth of new technologies and concepts, has made the rights easily traversed without the owner's permission.²³¹ The Nigerian Act, unfortunately, does not have a specific section on exception or limitation on trade mark registration. Similarly, the Paris Convention does not have specific articles on exceptions. According to article 17 members are expected to provide limited exceptions to trade mark rights. The TRIPS Agreement does not state what limited exceptions consist of, a reasonable interpretation is expected to be given to it.²³² In the case of *Canada Generic Pharmaceuticals*,²³³ the Panel stated that the 'term limited exception must be read to connote a narrow exception one which makes only a small diminution of the rights in question'.²³⁴ The Trade Marks Act does not have a section regarding defences to trade mark infringement, however, exceptions can be sought throughout the Trade Marks Act.

²²⁷ Section 5 Canadian Trade Marks Act.

²²⁸ Section 43 (c) US Statute Trademarks Act of 1946 as amended.

²²⁹ Article 16.3 TRIPS Agreement.

²³⁰ Mark Mordi, Towards Trade mark Law Reform in Nigeria: A Practitioner's Note NIALS Journal of Intellectual Property [NJIP] Maiden Edition (2011) p.p 193.216 p. 214.

²³¹ John Onyido, Making a Case for the Trademark Misuse Doctrine available at http://www.spaajibade.com/admintoolnew/uploads/making_a_case_for_the_trademark_misuse_doctrine-2spaaco.pdf accessed 29 May 2013.

²³² UNCTAD/ICTSD, *Resource Book on TRIPS* p243.

²³³ WT/DS114/R.

²³⁴ *Canada Generic Pharmaceuticals para. 7.31 p. 155.*

Some of the statutory exceptions to the exclusive use of a trade mark include the right conferred by concurrent registration.²³⁵ The Act provides, where one or two or more registered trade marks that are identical or similar to each other are used, that the exercise of the right by one party shall not constitute an infringement of the right to use the trade mark by the other.²³⁶ Although, this type of concurrent use may cause confusion at the beginning,²³⁷ it is not sufficient justification to stop an honest concurrent user, especially if it relates to the use of personal names.²³⁸ The rationale for the protection of concurrent-user rights is based on ‘the interest of the public in not being deceived about the origin of goods had and has to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill.’²³⁹ For Albert the goodwill of a trade mark can be shared by more than one person.²⁴⁰

Another limitation to trade mark protection in the Act is that a registered trade mark is not infringed by *bona fide* use of a person’s own name, name of his place of business or any of his predecessors in business.²⁴¹ The example given in article 18 of the TRIPS Agreement makes fair use of the descriptive terms an acceptable limited exception for members. Similarly, the Act allows registrations of trade marks by any person to describe the character or quality of his goods, in so far as it does not serve as a notice²⁴² or a certification²⁴³ of the product.²⁴⁴

²³⁵ Section 5 TMA 1965 T13 LFN 2004.

²³⁶ Section 5(4) TMA 1965 T13 LFN 2004.

²³⁷ Tanya Aplin and Jennifer Davis Intellectual property Law Text, Cases and Materials. OUP New York 2009 p. 225.

²³⁸ *Reed Executive PLC v Reed Business Information ltd. Reed Elsevier UK Ltd., Totaljobs .com Ltd.* [2004]RPC 40 *Habib Bank Limited V. Habib Bank A.G. Zurich* [2001] PRC 42; *Mercury Communications Ltd. v Mercury Interactive (UK) Ltd.*, [1995] F.S.R. 850 (Ch.).

²³⁹ *General Electric Co Ltd (USA) v General Electric Co Ltd* [1972]1 1 WLR 729

²⁴⁰ Wim Albert Concurrent trademark use in the common law 2006 14 *Juta's Business Law* 136-140 p. 140

²⁴¹ Section 8(a) ; see also *Scandecor v Scandecor* [2001] 2CMLR 30; *In Newmans limited v Richard T Adlem* [2005] EWCA Civ 741; *Reed Executive PLC v Reed Business Information ltd. Reed Elsevier UK Ltd., Totaljobs .com Ltd.* [2004]RPC 40 cf *Celine Sarl v Celine SAC-17/06* [2007] ECR I-7041.

²⁴² Section 65(2)(b) TMA 1965 T13 LFN 2004.

²⁴³ Section 43(4) (b) TMA 1965 T13 LFN 2004.

²⁴⁴ Section 8(b) TMA 1965 T13 LFN 2004.

Description of the character or quality may relate to the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods.²⁴⁵ This type of use is usually regarded as fair use especially where the mark is used for its ‘primary rather than secondary meaning’ and there is no likelihood of confusion to the public.²⁴⁶ Furthermore, the law provides that the use of a registered mark does not extend to the conditions and limitation entered on the register, thus any use by another person relating to such conditions and limitations will not amount to an infringement of that right.²⁴⁷

Prior rights preserve the common law rights of ownership of a trade mark which accrued as a result of the continuous use of the mark. The person who first uses a trade mark in connection with specific goods has the exclusive rights thereto.²⁴⁸ The Act is clear regarding this point as noted earlier: the rights of a prior user are superior to those of a registered user provided he has used the mark continuously before the proprietor’s use and registration of the mark. Prior rights seem to give protection to a continuous user who did not register his mark. Even though the provision did not mention that the mark is unregistered, it may be implied, since it is the registered user that is required not to interfere or restrain the continuous user.²⁴⁹ The Act does not state whether such prior use will be limited to a particular locality or area,²⁵⁰ in essence the two marks may be found in the same market.

According to section 49 of the Act registration of a trade mark creates an assumption that the proprietor of the trade mark is entitled to use the registered mark as he deems fit. This use, however, may not include certain exceptions which, although the law did not expressly provide for, are necessary for the smooth running of commercial activities in the society.

²⁴⁵ *Michael Holterhoff v Ulrich Freiesleben* C-2/00[2002]ECR I-4187.

²⁴⁶ Overview of Trademark Law available at <http://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> accessed 29 May 2013.

²⁴⁷ Section 5 (3) TMA 1965 T13 LFN 2004.

²⁴⁸ *McClellan v Fleming*, 96 U.S. 245, 24L.Ed.828(1877).

²⁴⁹ Section 7 TMA 1965 T13 LFN 2004.

²⁵⁰ Cf § 33b (5) (15 U.S.C. § 1115) which provide that:

this defence or defect shall apply only for the area in which such continuous prior use is proved. See also section 11(3) (b) UK TMA which provides that an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by virtue of any rule of law.

These exceptions include normative fair use, such as parody,²⁵¹ reporting, commentary,²⁵² criticism, and comparative advertising. There is a presumption that these exceptions are allowed without the consent of the registered owner.

In the South African case of *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International*²⁵³ the court interpreted section 34(1) (c)²⁵⁴ in relation to freedom of expression²⁵⁵ and stated that all speech is protected and must be appropriately balanced against other rights, of which the right to property (including intellectual property) is one. Sabmark International, a company registered in Rotterdam in the Netherlands, is the holder and owner of the registered trade marks at issue. South African Breweries Ltd (SAB) uses the CARLING BLACK LABEL trade marks in class 32²⁵⁶ largely for alcoholic beverages, particularly beer. The applicant had produced and was offering for sale to the public T-shirts, which had prints that were markedly similar in lettering, colour

²⁵¹ *Hormel Foods Corp. v Jim Henson Prods.*, 73 F.3d 497 (2d Cir. 1996). where the use of a pig-like character named ‘Spa’am’ in a Muppet movie was found not to violate Hormel’s rights in the trademark ‘Spam.’ cf ‘Enjoy Coca-Cola’ *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) Where posters bearing the logo ‘Enjoy Cocaine’ were found to violate the rights of Coca-Cola in the slogan

²⁵² *New Kids on the Block v News America Publishing* 971F.2d 302 (9th Cir. 1992).

²⁵³ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International* 2005 (2) SA 46 (SCA).

²⁵⁴ Section 34 (1) (c) South African Trade Marks Act provides ‘Infringement of registered trade mark.–

(1) The rights acquired by registration of a trade mark shall be infringed by– . . .

(c) the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70(2).’⁵.

²⁵⁵ Section 16 South African Constitution of the provide that : Freedom of expression

(1) Everyone has the right to freedom of expression, which includes:

(a) freedom of the press and other media;
 (b) freedom to receive or impart information or ideas;
 (e) freedom of artistic creativity; and
 (d) academic freedom and freedom of scientific research.

(2) The right in subsection (1) does not extend to-

(a) propaganda for war;
 (b) incitement of imminent violence; or
 (c) advocacy of hatred that is based on race, ethnicity, gender or religion, and that constitutes incitement to cause harm.

²⁵⁶ The three trade marks are registered as: (1) no. 1979/03675 CARLING BLACK LABEL label in respect of alcoholic brewery beverages, including beer, ale, lager; porter and stout; shandy; non-alcoholic drinks; preparations for making all such drinks, dated 19 July 1979; (2) no. 1991/09236 CARLING BLACK LABEL neck and body label (colour) in respect of beer, ale and porter, dated 1 November 1991; and (3) no. 1991/09237 CARLING BLACK LABEL neck and body label in respect of beer, ale and porter, dated 1 November 1991.

scheme and background to the respondent's CARLING BLACK LABEL trade marks. The only difference was in the wording. The words 'Black Label' on the respondent's registered trade marks were replaced, on the T-shirt, with 'Black Labour'; the respondent's 'Carling Beer' was substituted with 'White Guilt' and where it is written 'America's lusty lively beer' and 'enjoyed by men around the world', the applicant had printed 'Africa's lusty lively exploitation since 1652' and 'No regard given worldwide', respectively.

'The court found that the expression on the T-shirt is substantially detrimental to the repute of the marks; that it is likely to create in the minds of consumers a 'particularly unwholesome, unsavoury, or degrading association' with the marks because it is an 'unfair' and 'unjustified racial slur' on the trade mark owner.' The SCA rightly accepted that parody is a relevant factor in determining whether the use of earlier work is fair within the meaning of section 34(1) (c) but not an absolute defense to a claim of infringement of a trade mark. The SCA endorsed the definition of parody found in US jurisprudence.²⁵⁷ However, the SCA held 'that the mark on the T-shirts conveys the message that Sabmark was and still is guilty of exploiting black labour and of racial discrimination, and that the message is likely to take unfair advantage or cause detriment to the trade marks'. The SCA further held that the 'constitutional right to freedom of expression did not protect the mark on the T-shirts because Laugh It Off fed off the reputation of the trade mark in order to sell T-shirts, and it can still express itself in other ways that do not harm Sabmark'.

In an Indian case, the debate on 'fair use' was employed to defend an allegation of trade mark infringement in *Tata Sons Limited v Greenpeace International*.²⁵⁸ Greenpeace International is an environmental organisation and as part of its campaign it launched a Pac-Man inspired video Game project of TURTLES VERSUS TATA. The online game was designed as a creative, peaceful and non- confrontational platform to draw attention to the threat that the Olive Ridley Sea Turtles are facing due to the construction and setting up of

²⁵⁷ In *Campbell v Acuff-Rose Music Inc* 510 US 569 (1994) that court noted that 'the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works . . . whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.'

²⁵⁸ *Tata Sons Limited v. Greenpeace International*, 2011 (45) PTC 275 (Del).

the Port in Gahiramatha by TATA. The court stated clearly that ‘the use of a trade mark, as the object of a critical comment, or even attack, does not necessarily result in infringement. If the user’s intention is to focus on some activity of the trade mark owner and is “denominative”, drawing attention of the reader or viewer to the activity, such use can *prima facie* constitute “due cause” under section 29 (4),²⁵⁹ which would disentitle the plaintiff to a temporary injunction, as in this case. The use of TATA, and the ‘T’ device or logo, is clearly denominative. The court noted that describing the TATA as having demonic attributes is hyperbolic and parodic’.²⁶⁰

The two cases, although decided differently, illustrate the principle that parody is an allowed exception. In essence nominative fair use defence only arises when the use of the trade mark is necessary for purposes of identifying a trade mark owner or its goods or services.²⁶¹ These are common law exceptions that would be enforced provided the use of the mark does not indicate the source of origin to the detriment of the registered owner. There are no statutory provisions for these defences but judicial notice has been taken in this regard. The Act accordingly provides exceptions as expected and in accordance with the Paris Convention, which makes it compliant with the TRIPS Agreement.

5.3.6 Article 18: Term of Protection of Trade Marks

In Nigeria, trade marks can be used indefinitely or in perpetuity, although the law allows for an initial term of protection of seven years²⁶² which can be renewed from time to time provided it meets the requirement laid down by the Act. On the expiration of the original registration a trade mark can be renewed for another fourteen years, and it can subsequently be renewed every fourteen years after the last registration.²⁶³ Renewals of trade marks are vital to the existence of the mark as the mark may be deemed abandoned and subsequently

²⁵⁹ Section 29 (4) Indian Trade Marks Act. 24. (1) Save as provided in sub-section (2), nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently, or propose to use it, as joint proprietors thereof.

²⁶⁰ 2011 (45) PTC 275 (Del).

²⁶¹ Jane Ginsburg, Jessica Litman, Mary Kevlin, *Trademark and Unfair Competition Law Cases and Materials, Foundation* 4th ed. Press New York 2007 p. 462.

²⁶² Section 23(1) TMA 1965 T13 LFN 2004.

²⁶³ Section 23(2) TMA 1965 T13 LFN 2004.

cancelled if it is not renewed, and it would be taken off the register.²⁶⁴ Article 18 of the TRIPS Agreement, on the other hand, provides for an initial registration of seven years and subsequent renewals for a period of seven year intervals between renewals, which shall be indefinitely. Prior to the TRIPS Agreement there was no provision in the Paris Convention relating to the term of protection of a trade mark: the duration of the mark was left for each country to decide. Article 6 (1) of the Madrid Protocol grants international registration of a trade mark an initial period ten years with a possible renewal for another ten years provided the conditions specified in article 7 and article 8 (2) and (7) of the Madrid Protocol are met. The term of protection of trade marks in Nigeria falls within the standard required in the TRIPS Agreement to the detriment of the trade marks registry. The long period between renewals means a loss of income for the registry. In essence, this provision may be regarded as being not only compliant but a TRIPS-plus provision.

5.3.7 Article 19: Requirement of Use

Article 19.1²⁶⁵ deals with maintenance of registration.²⁶⁶ The value of a trade mark hinges on its use in the course of trade concerning the goods or service for which it is registered. As discussed above, under the Act a trade mark is cancelled only after a continuous period of five years or longer of non-use has elapsed during which the registered trade mark was not put to genuine use in Nigeria by the proprietor in relation to the goods or services for which it is registered, and there are no proper reasons for non-use of those goods by the proprietor.²⁶⁷ Use of a trade mark can also be use by a registered user.²⁶⁸ A registered user, being a person other than the proprietor of a trade mark, is someone who has been statutorily declared and authorised by the proprietor to act on his behalf and approved by the registrar in

²⁶⁴ Section 23(3) TMA 1965 T13 LFN 2004.

²⁶⁵ TRIPS Agreement.

²⁶⁶ Article 5C (1) Paris Convention provides if in any country, use of the registered mark is compulsory, the registration may be cancelled only after a reasonable period, and then only if the person concerned does not justify his inaction.

²⁶⁷ Section 31 TMA 1965 T13 LFN 2004.; *Proctor and Gamble v Global Soap* (1989) F.H.C.L.R. 357.

²⁶⁸ Section 33 (3) TMA 1965 T13 LFN 2004.; Article 5C (3) of the Paris Convention:

Concurrent use of the same mark on identical or similar goods by an industrial or commercial establishments considered as co-proprietors of the mark according to the provisions of the domestic law of the country where protection is claimed shall not prevent registration or diminish in any way the protection granted to the said mark in any country of the Union, provided that such use does not result in misleading the public and is not contrary to the public interest.

respect of all or any of the goods which the proprietor registered either with or without conditions or restrictions.²⁶⁹ At first glance one might assume that this provision protects the interest of the proprietor fully. A closer look reveals that products carrying the trade mark lawfully placed on the market not by the proprietor or registered user would not be regarded as use by the proprietor.²⁷⁰ This position presents a problem in that all uses that are without the consent of the proprietor or that of the registered user do not amount to use.

As indicated already, and as required by the TRIPS Agreement,²⁷¹ where use by another person cannot be recognised as use under the law for the purpose of maintaining registration, the situation is very challenging in a country like Nigeria, especially, where a lot of importation is done from around the world by small business owners. For instance, there are no Louis Vuitton stores in Nigeria but a lot of people buy original Louis Vuitton bags to sell in Nigeria, Louis Vuitton has not entered the Nigerian market but a lot of stores sell their genuine products which are unrelated to Louis Vuitton. The presumption is Louis Vuitton can lose their right to the mark in Nigeria if the trade mark is registered but is not used by the proprietor or registered user.

Therefore, requirement of use of a trademark by another person to be recognised as use of the trademark for the purpose of maintaining the registration is not complied with as section 33 (3) of the Trade Marks Act recognises only the proprietor and the registered user.

5.3.8 Article 20: Other Requirements

This provision relates to encumbrances by means of special requirements which are unjustified. Thus, where a trade mark is encumbered with special requirements such as its use with another trade mark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings such requirements are unjustified.

²⁶⁹ Section 33 and 34 TMA 1965 T13 LFN 2004.

²⁷⁰ Section 33 (3) TMA 1965 T13 LFN 2004.

²⁷¹ Article 19.2 TRIPS Agreement, WT/DS176/AB/R *United States – Section 211* Appellate Panel Report para 193. The Appeal Board noted that Article 19.1 addresses the situation where a member's domestic legislation requires use of the trade mark for the purposes of maintaining its registration and those circumstances when use by a person other than the owner of the trade mark is recognized as use for the purposes of maintaining a registration.

Under the Act in Nigeria, there are no special requirements in relation to the use of a mark: trade marks need not be used in any special form in Nigeria. Sections 9 and 10 requires only that the trade mark to be registered be distinctive or capable of being distinguished respectively. It is submitted that this provision does not permit measures that would be detrimental to the ability of the mark to be distinguished. The Nigerian Government does not impose any conditions on the use of foreign trade marks. The Trade Mark Act is therefore compliant in this regard.

5.3.9 Article 21: Licensing and Assignment

Trade mark licensing and assignment, initially, were seen as impossible due to the nature of the right. Formerly, the belief that a trade mark as a property rights was not assignable in gross²⁷² hinged on the assumption that trade marks cannot be assigned or licensed without the essential goodwill associated with the mark. This position has seen been reversed by several laws which has made it possible for a trade mark to be assignable without its goodwill.²⁷³

In terms of article 21 of the TRIPS Agreement members may determine conditions of licensing and assignment of trade marks; owners of registered trade mark shall have the right to assign the trade mark with or without the transfer of the business to which the trade mark belongs. The Act allows registered trade marks to be assignable and transmissible, either in connection with the goodwill of a business or not.²⁷⁴

Curiously, the Act does not mention licences but the use of the word transmissible suggests, apart from assignments, that there are other ways in which the law allows trade marks to be transmitted, which may include operation of law, licensing and testamentary disposition. This interpretation is supported by sections 33 and 34 of the Act which expressly provide that a trade mark may be used by a person other than the registered proprietor.²⁷⁵ In addition, section 67 defines transmission to mean by operation of law, devolution on a personal

²⁷² Jeremy Phillips, *Trade Mark Law ,A Practical Anatomy* OUP Oxford 2003 para 18.01 p.519.

²⁷³ UK Trade Marks Act 1938 from which the Nigerian Trade Marks Act got its own section 26.

²⁷⁴ Section 26 (1) TMA 1965 T13 LFN 2004.

²⁷⁵ See section 33 and 34 TMA 1965 T13 LFN 2004. as discussed above.

representative of a deceased person and any other mode of transfer not being assignment. Even though the word licence was not used in section 26 and also is not used in section 67 in which reference is made only to other modes of transfer not being assignment, presumably, all types of licences are covered, which may include exclusive licences, sole licences, non-exclusive licences and sub-licences.

The TRIPS Agreement specifies that compulsory licensing of trade marks shall not be permitted.²⁷⁶ However, it is not certain whether compulsory licences are included or excluded from the possible modes of transfer that will be permitted under the Act. Prior to the TRIPS Agreement, there was no provision relating to compulsory licensing of trade marks, as the Paris Convention only mentioned compulsory licensing in relation to patents²⁷⁷ and utility models.²⁷⁸

The assignment or transmission of a registered trade mark under Nigerian law may be in relation to all of the goods and services for which the trade mark is registered, or limited to some, but not all, of the goods or services for which the trade marks are registered.²⁷⁹ A trade mark used in the course of trade is assigned in respect of any goods; if the assignment is made otherwise than in connection with the goodwill of that business, the assignment is not effective unless the following requirements have been satisfied, that is, the assignee:²⁸⁰

- i. must within six months from the date of the assignment or within such extended period, if any, as the Registrar may allow, apply to the Registrar for directions with respect to the advertisement of the assignment; and
- ii. must advertise the assignment in such form and manner and within such period as the Registrar may direct.

Furthermore, where such advertisement has been approved, notice of the assignment must be published in the Trade Marks Journal.²⁸¹ In like manner all assignees of a registered trade

²⁷⁶ Article 21 TRIPS Agreement.

²⁷⁷ Article 5A(2) Paris Convention 1967.

²⁷⁸ Article 5A(5) Paris Convention 1967.

²⁷⁹ Section 26 (2) TMA 1965 T13 LFN 2004.

²⁸⁰ Section 26 (4) Trade Marks Act, Cap T 13, Laws of Federation of Nigeria 2004; *A.B Chami & Co Ltd. v W.J. Bush & Company Ltd.* (1996) 3I.P.L.R. 284, FHC/K/CS/115/95.

²⁸¹ Section 26 (5) TMA 1965 T13 LFN 2004.

mark shall register the assignment for proof of title.²⁸² A document or instrument of which no entry has been made in the register shall not be admitted in evidence in court as proof of the title to a registered trade mark unless the court otherwise directs.²⁸³ Although registration is not compulsory it is advisable.

Section 26 (3) of the Act provides an awkward protection for an unregistered trade mark, as it conveys that unregistered trade marks enjoys the same treatment as the registered trade mark. Then it goes on to lay down confusing conditions: first, at the time of the transmission it is used in the same business as a registered trade mark;²⁸⁴ second, it should be assigned or transmitted as a registered trade mark at the same time;²⁸⁵ and third, it should be assigned and transmitted in respect of goods to which the unregistered trade mark is used in business and which the registered trade mark is assigned or transmitted.²⁸⁶ This provision is very unclear: the Act does not particularly state if the unregistered trade mark relates to a prior right, a concurrent user or use by the proprietor before the registration of the trade mark.

Accordingly, the Nigerian Act differs minutely from the TRIPS Agreement and its obligation under the Agreement is not undermined by the difference.

5.4 Geographical Indications

Geographical indications (GIs) were given international recognition for the first time in the TRIPS Agreement²⁸⁷ and have remained controversial and the subject of debate ever since.²⁸⁸ Despite the reservations, it is believed that the inclusion of GIs in the TRIPS Agreement is a starting point for the development of an international frame work for GI protection.²⁸⁹ The

²⁸² Section 30 (1) TMA 1965 T13 LFN 2004.

²⁸³ Section 30 (3) TMA 1965 T13 LFN 2004.

²⁸⁴ Section 26 (3) (a) TMA 1965 T13 LFN 2004.

²⁸⁵ Section 26 (3) (b) TMA 1965 T13 LFN 2004.

²⁸⁶ Section 26 (3) (c) TMA 1965 T13 LFN 2004.

²⁸⁷ Article 22 TRIPS Agreement; Daphne Zografos Geographical Indications & Socio-Economic Development Working Paper 3December 2008 p.1.

²⁸⁸ Jeremy Phillips, *Trade Mark Law ,A Practical Anatomy* OUP Oxford 2003 para 18.01 p.603.

²⁸⁹ Okediji, Ruth L. (2007) ‘The International Intellectual Property Roots of Geographical Indications’ *Chicago-Kent Law Review*: Vol. 82: Issue. 3 available at: <http://scholarship.kentlaw.iit.edu/cklawreview/vol82/iss3/9> accessed 6 June 2013.

inclusion of GIs in the TRIPS Agreement was not by chance: it was as a result of consistent and arduous lobbying by the European Community.

Geographical indications are defined as indications which identify a product as originating in the territory or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.²⁹⁰ GIs are used for identification of craft, textile, agricultural and manufacturing goods from the particular territory that, over time have acquired goodwill in the market due to special characteristics like temperature, humidity, soil, etc., which are associated with that particular territory and are unique to it. The rationale for the protection of GIs is embedded in the principle of consumer protection, which is to prevent consumers from been misled by allowing others to free-ride on the reputation of a mark that is on a product that originates from a particular geographic area.²⁹¹

Although, GIs were brought to the fore by the TRIPS Agreement, the Paris convention had some form of protection for industrial property²⁹² which aimed at protecting indications of source or appellations of origin.²⁹³ This provision is supported by article 10 of the Paris Convention which makes it unlawful for a product to bear a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant. The Paris Convention, however, did not define appellation of origin. But the Lisbon Agreement²⁹⁴ defines it to mean, ‘the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due

²⁹⁰ Nikhil Dattawadkar and Harit Mohan, ‘The Status of Geographical Indications in India: A Stellarix Review available at <http://www.stellarix.com/blog/the-status-of-geographical-indications-in-india-a-short-review/> accessed 6 June 2013.

²⁹¹ Dwijen Rangnekar, Geographical Indications: A Review of Proposals at the TRIPS Council: Extending Article 23 to Products other than Wines and Spirits Issue Paper No. 4 UNCTAD-ICTSD Project, Geneva, June 2003.

²⁹² Such as agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

²⁹³ Article 1(2) Paris Convention.

²⁹⁴ Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958, as revised at Stockholm on July 14, 1967, and as amended on September 28, 1979.

exclusively or essentially to the geographical environment, including natural and human factors.²⁹⁵

GIs and trade marks regimes are closely related. According to Phillip,²⁹⁶ both ‘are applied to goods and serve to distinguish them from other goods’. Furthermore, it is believed the regimes control the use and misuse of geographical signs cooperatively used in the market, which dates back to the nineteenth century.²⁹⁷ Although, there seems to be much similarity between the two regimes, the two regimes cannot be fitted into one. GIs are protected on the national and regional levels by various legal concepts which are used to describe the presence of a regime.²⁹⁸ Generally, the concepts of ‘unfair competition and passing off, protected appellations of origin and registered geographical indications, collective and certification trade marks, and administrative schemes of protection’ have at their core conditions of protection, entitlement to use and scope of protection of marks.²⁹⁹

The definition in McCarty³⁰⁰ for certification marks was used by the Standing Committee³⁰¹; it states:

Certification marks are marks which indicate that the goods or services on which they are used have specific qualities, which may also include geographical origin. The owner of the certification mark undertakes to certify that the goods or services on which the certification mark is used have those qualities.³⁰²

Certification marks are not the preserve of any person, whoever ‘complies with the standards of production as defined by the owner of the certification mark has the right to use that mark.’³⁰³ In addition, the ‘owner of the certification mark must ensure that the goods or

²⁹⁵ Article 2 (1) Lisbon Agreement for the Protection of Appellations of Origin and their International Registration

²⁹⁶ Jeremy Phillips, *Trade Mark Law, A Practical Anatomy* OUP Oxford 2003 para 18.01 p.603.

²⁹⁷ Dev Gangjee, *Overlap between Trade Marks and Geographical Indications*, Neil Wilkof and Shamnad Basheer(eds), *Overlapping Intellectual Property Rights* Oxford University Press 2012 para 13.03, p.278.

²⁹⁸ WIPO SECRETARIAT, Document SCT/6/3 Rev. on Geographical Indications: Historical Background, Nature of Rights, Existing Systems for Protection and Obtaining Effective Protection in other Countries See also SCT/8/4.

²⁹⁹ SCT/6/3 para 9 p. 6.

³⁰⁰ McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition* (fourth edition), page 19-179.

³⁰¹ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

³⁰² SCT/6/3 para 26 p. 10.

³⁰³ SCT/6/3 para 27 p. 10.

services on which the certification mark is used possess the certified quality'.³⁰⁴ Generally, as pointed out by the Standing Committee on GIs, geographical indications can be protected in the form of a certification mark which is enforced under general trade mark law.³⁰⁵

Accordingly, the Nigerian Act³⁰⁶ provides:

A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark...

A person trading in the goods certified cannot register the certification mark in his own name. In the same vein, the entity which applies for a certification mark to be registered must be competent to certify the goods or services concerned. Hence, the certification mark is not an individual's trade mark: it is used alongside a trade mark on the goods certified as 'evidence that the company's products meet the specific standards required for the use of the certification mark'.³⁰⁷ Certification marks, however, are not assignable or transmissible except with the consent of the Minister.³⁰⁸ In light of the above, a certification mark can be used to protect and certify a specific geographical origin of goods in the absence of a *sui generis* system of protection for geographical indication in Nigeria.

In addition, there are various regulations on the protection of wine,³⁰⁹ spirits,³¹⁰ food and drinks.³¹¹ The Labelling Regulation of 2005, in particular, gives protection against false, misleading and deceptive advertising and the likelihood of creating an erroneous impression regarding its character, quality, quantity and origin to all sorts of pre-packaged food and

³⁰⁴ SCT/6/3 para 27 p. 10.

³⁰⁵ SCT/6/3 para 28 p. 11.

³⁰⁶ Section 43(1) TMA 1965 T13 LFN 2004.

³⁰⁷ Certification marks-WIPO available at http://www.wipo.int/sme/en/ip_business/collective_marks/certification_marks.htm accesses 12 June 2013.

³⁰⁸ Section 43 (9) TMA 1965 T13 LFN 2004.

³⁰⁹ National Agency For Food and Drug Administration and Control Act 1993 (as Amended) Wine Regulations 2005.

³¹⁰ National Agency For Food and Drug Administration and Control Act 1993 (as Amended) Spirit Drinks Regulations 2005.

³¹¹ Drugs and Related Products (Registration etc) Act 1999 (as amended) Pre-Packaged Food (Labelling) Regulations 2005.

drinks.³¹² It also prohibits words, pictorial or other means which refer to any other product or suggests, either directly or indirectly, that the food is connected with such other product.³¹³

The requirement for additional protection for wine and spirits in article 23 of the TRIPS Agreement can be met by the various provisions in the Wine and Spirit Regulations.³¹⁴ For instance, rule 1 of the Wine Regulation and Spirit Regulation prohibits the manufacture, import, export, advertising, sale or distribution of wine in Nigeria unless it has been registered in accordance with the provisions of the Regulations which provide that the name of every wine³¹⁵ and spirit³¹⁶ shall indicate its accurate nature.

In particular, the Spirit Regulation makes it clear that whisky distilled and matured only in Scotland, which qualifies in accordance with the laws applicable in Scotland, can be called Scotch Whisky; only whisky distilled in Northern Ireland or in the Republic of Ireland can be referred to for domestic consumption in accordance with the laws applicable in Northern Ireland or in the Republic of Ireland as Irish Whisky.³¹⁷ The Regulation also encourages honest uses of homonymous geographical indications, which is the aim of the TRIPS Agreement.

These Regulations are legal means for interested parties to prevent the misuse of a geographical indication for identifying wines and spirit in Nigeria. These regulations not only prevent the use of false indications, but prevent the products from reaching the market place if the requirements are not complied with, due to the fact that National Agency for Food and Drug Administration and Control (NAFDAC)³¹⁸ is authorised to regulate and

³¹² Rule 2 (a) Drugs and Related Products (Registration etc) Act 1999 (as amended) Pre-Packaged Food (Labelling) Regulations 2005.

³¹³ Rule 2 a (b) Labelling Regulation 2005.

³¹⁴ National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Wine Regulations 2005 and National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Spirit Regulations 2005.

³¹⁵ Rule 4 Wine Regulation 2005.

³¹⁶ Rule 4 Spirit Regulation 2005.

³¹⁷ Schedule 1 Spirit Regulation 2005.

³¹⁸ National Agency for Food and Drug Administration and Control (NAFDAC), Decree 15 of 1993 as amended by Decree 19 of 1999 and now Act Cap N1 Laws of the Federation of Nigeria (LFN) 2004.

control the importation, exportation, manufacture, advertisement, distribution, sale and use of regulated products and compile standard specifications of regulated products.³¹⁹

5.5 Sector-specific Implication of the TRIPS Agreement on Trade Marks

‘Trademarks have become even more fundamental in our commercial lives due to the basic changes taking place in the intensely competitive international markets in consumer goods.’³²⁰

The impact of the TRIPS Agreement on trade marks is multifaceted. This is so because trade mark issues are intertwined with the product itself which may be patented or copyright protected. Where a trade mark is used on a patented product, the manufacturer has time to build its brand as it is the only producer in the market. After the patent expires, other manufacturers begin to produce the same product under different names: these names may or may not attract consumers. A trade mark may attract consumers if the manufacturer is known in that field or is a well-known multinational; a product may not interest consumers if it is a new local company. Sometimes a patent can give a company a competitive edge.

As noted by Harper the harmonisation of international intellectual property rights is directed towards a repositioning in order to enable the liberalisation of trade.³²¹ Considering the fact that the use of trade marks comes with trading, the liberalisation of trade makes the impact of the TRIPS Agreement apparent and its effect can be seen in the areas discussed below.

5.5.1 Market Access/Competitive Advantage

A criticism arising from the international protection of marks relates to the alleged exploitation of consumers by famous brand names³²² which crush upcoming small and medium scale companies as a result of their financial might in order to create a monopoly. Until recently, and due to the rise of the Chinese market, Nigerians have had to use particular

³¹⁹ Section 5 National Agency for Food and Drug Administration and Control (NAFDAC) Act Cap N1 Laws of the Federation of Nigeria (LFN) 2004.

³²⁰ Marshall A. Leaffer, ‘The New World of International Trademark Law’ 2 *Marquette Intellectual Property Law Review* 1 p. 5. TMR L.N. 70 of 1967.

³²¹ Bruce Harper, ‘TRIPS Article 27.2: An Argument for Caution,’ 21 (1997) *William & Mary Environmental Law and Policy Review* 381-420 381; see also Preamble 13 TRIPS Agreement.

³²² Leaffer, *The New World of International Trademark Law* p. 6.

brands of consumer goods to the extent that all other product brands are called by the brand that has been in the market for so long. For example seasoning cubes are generally called Maggi, detergents are generally called Omo or Surf, toothpaste is called Macleans or Close up, all powdered instant full cream milk is called Peak or Nido, all four wheel drive and sport utility vehicles (SUVs) are called Jeep. These are a few examples. Until about twenty to fifteen years ago certain brands were never commonly found in the Nigeria market:³²³ including brands such as Ariel and Kiln for detergent; Cowbell, Dano, and Kilm for full cream milk.

Most companies in ICs have gained competitive advantage³²⁴ in brand names which allows them to outperform companies in developing and least developed countries. Most of the trans-national corporations (TNCs) have more resources at their disposal which they can use to advertise their product, package their product in more attractive ways and push their products in the market. In addition, the financial resource that is available to TNCs makes it easy to distribute their product to all areas. For example, Coca-Cola and Pepsi-cola can be found in every village in Nigeria, whereas local soft drink makers are confined to the locality in which they produce.

These advantages are exaggerated by the lack of adequate technology to produce better-looking packages which make up the total brand and product look that attract customers. That Nigeria has a high level of illiterates who cannot pronounce the names of the product but describe the look of the package in their local dialects makes packaging very important. For instance, a brand of cigarettes has been called *oloyinbo*³²⁵ because a European man is drawn on the pack; Peak milk has been referred to as *olope*³²⁶ because a palm tree is drawn

³²³ This is not to say private person who travelled across the borders did not bring them into Nigeria for use or sale to a selected few.

³²⁴ A superiority gained by an organization when it can provide the same value as its competitors but at a lower price, or can charge higher prices by providing greater value through differentiation. Competitive advantage results from matching core competencies to the opportunities. (Definition of competitive advantage from business dictionary .com available at <http://www.businessdictionary.com/definition/competitive-advantage.html> accessed 15 June 2013.

³²⁵ *United Kingdom Tobacco v Carreas* (1931) N.L. R. 1.

³²⁶ *In Re-Marketing and Shipping Enterprise v Cooperation Conderfabriek 'Friesland'* (1971) 1 I.P.L.R 231

on the tin as part of the package; Fanta has been referred to as *olomi osan* which means made from orange.

Competitive advantage is created by having access to highly trained and skilled human resources personnel who enhance the product in the production process or business process by better identification and understanding of customers.³²⁷

The gap of competitive advantage has been widened by trade liberalisation that has made products from Asia cheaply available while growth that is beneficial is not realised due to weak industrial and technological base and because technical innovation and transfer have not been realised under the TRIPS Agreement.³²⁸

5.5.2 Foreign Direct Investment

It is deemed that strong IPRs³²⁹ attract more foreign direct investment (FDI) to developing countries. FDI simply means a foreign investor investing in a local economy. Generally speaking, Nigeria has had an increase in FDI in recent years because of the reforms in foreign investment policy embarked upon since the mid-1980s³³⁰ and subsequent privatisation programs in the late 1990s.

FDI inflow in Nigeria was raised to unprecedented levels between 2000-2007.³³¹ The World Investment Report 2006 indicates that FDI inflow to West Africa was largely composed of inflow to Nigeria which had 70% of the sub regional total and 11% of Africa's total.³³² In

³²⁷ Competitive Advantage available at http://en.wikipedia.org/wiki/Competitive_advantage accessed 15 June 2013.

³²⁸ UNCTAD, Investment and Innovation Policy Review Ethiopia United Nations New York. UNCTAD/ITE/IPC/Misc. 4 UNCTAD para 69.

³²⁹ IPRs here means Intellectual property rights and not investment policy review.

³³⁰ United Nations Conference on Trade and Development Investment Policy Review Nigeria 2008 p.8 available at http://unctad.org/en/Docs/diaepcb20081_en.pdf accessed 17 June 2013; Anyanwu, J.C.. 'An econometric investigation of determinants of foreign direct investment in Nigeria'. In Investment in the Growth Process: Proceedings of the Nigerian Economic Society Conference 1998, pp. 219–40. Ibadan, Nigeria; Janet Olatundun Adelegan Foreign Direct Investment and Economic Growth in Nigeria: A Seemingly Unrelated Model. African Review of Money Finance and Banking, (2000), pp. 5-25 Published by: Giordano Dell-Amore Foundation Article Stable URL: <http://www.jstor.org/stable/23026281>.

³³¹ United Nations Conference on Trade and Development Investment Policy Review Nigeria 2008 p.8 available at http://unctad.org/en/Docs/diaepcb20081_en.pdf accessed 17 June 2013.

³³² Soumyananda Dinda, Factors attracting FDI to Nigeria: an Empirical Investigation 2009 p.3 available at accessed 18 June 2013.

2011, the overall inward FDI flows to West Africa expanded by 36 per cent to \$16.1 billion, FDI to Nigeria accounted for over one fifth of all flows to Africa, making it the largest recipient of FDI flows of \$8.92 billion, which includes the service projects by Western Goldfields (Canada) to construct a coal-fired power station in Nigeria for \$15 billion.³³³ In contrast, West African FDI flow declined by 5 per cent in 2012 to \$16.8 billion, to a large extent because of decreasing flows to Nigeria due to political insecurity and the weak global economy.³³⁴ In Nigeria, the sector that receives the most FDI, however, is still the oil industry.³³⁵

Trade marks are used in FDIs, depending on the type of FDI agreement between the direct investor and the enterprise or the country as the case may be. More often than not the foreign direct investor has an industry in his home country which he intends to extend to another country usually using the already known trade name and trade mark. The trade mark that is used in the country of the investor, which is already a known product/trade mark in both the country of the investor and the host country through previous importation, definitely has a head start compared to a host country startup company. Investment may even be for export purposes to other countries because of the abundant human resource available in the host country.³³⁶ The company benefits and the country of the foreign investor benefits as well. The foreign company is not under any obligation to reinvest the profits in the economy of the host country. On the other hand, in a joint venture FDI, in which the foreign investor has 10% or more of the voting stock and allows the use of its trade mark on similar products, the licensee and the country benefit more from the investment.

The most common kind of FDI in Nigeria is distributorship: a company or an individual is appointed as the distributor of a foreign company's product. In this instance the distributor

³³³ UNCTAD, World Investment Report 2012: Towards a New Generation of Investment Policies CHAPTER II Regional Trends in FDI p. 41 available at http://unctad.org/en/PublicationsLibrary/wir2012_embargoed_en.pdf accessed 20 June 2013.

³³⁴ UNCTAD, World Investment Report 2013: Towards a New Generation of Investment Policies CHAPTER II Regional Trends in FDI p. 40 http://unctad.org/en/publicationslibrary/wir2013_en.pdf accessed 14 June 2014.

³³⁵ Akinlo A. Enisan Foreign direct investment and growth in Nigeria: An empirical investigation *Journal of Policy Modeling*, Volume 26, Issue 5, July 2004, Pages 627-639 p. 628.

³³⁶ China has been a major beneficiary of FDI from other countries.

may or may not be given the right to register the trade mark as a licensee.³³⁷ The powers the licensee has depend on the type of agreement the foreign investor has with the distributor: he may be a sole distributor for the whole of Nigeria or sometimes West Africa, in which case the distributor may be given the right to register the trade mark. However, if there are several distributors, the company itself registers the trade mark based on the use by the distributors.

There is no doubt that FDI is a ‘key to driving international economic integration’.³³⁸ But it needs to be done with the right policy framework to promote financial stability and economic development that improves societal welfare.³³⁹ According to the IMF, FDI is a ‘long-term investment reflecting a lasting interest and control, by a foreign direct investor (or parent enterprise), of an enterprise entity resident in an economy other than that of the foreign investor’.³⁴⁰

UNCTAD explains, in strategising to attract FDI, two important points must be taken into consideration:

- i. FDI is a complement rather than a substitute to domestic investment.
- ii. Therefore, efforts to attract foreign investment must not overshadow those aimed at boosting domestic investment through higher domestic savings³⁴¹

Ayanwale, on the impact of FDI on economic growth in developing countries, points to the fact that evidence of growth is not conclusive and the ‘potential contribution of FDI to growth depends strictly’ on individual countries, the results of which may be positive, negative or insignificant taking into consideration the economic, institutional and technological circumstances of the recipient country.³⁴²

³³⁷ *Eli Lilly & Co.v Salenab Nigeria Ltd* FHC/L/CS/534/99.

³³⁸ OECD (2013) Fact book 2013: Economic, Environmental and Social Statistics OECD Publishing available at <http://www.oecd-ilibrary.org/sites/factbook-2013-en/04/02/01/index.html?itemId=/content/chapter/factbook-2013-34-en> accessed 09 June 2012.

³³⁹ OECD, Benchmark Definition of Foreign Direct Investment FOURTH EDITION 2008 Vol. XX.

³⁴⁰ IMF ‘Growth in sub-Saharan Africa: Performance, impediments and policy requirements’, *World Economic Outlook*, chapter VI. 1999, Washington, DC: IMF.

³⁴¹ UNCTAD, Investment and Innovation Policy Review Ethiopia United Nations New York UNCTAD/ITE/IPC/Misc. 4.

³⁴² Adeolu B. Ayanwale, ‘FDI and Economic Growth: Evidence from Nigeria2 AERC Research Paper 165 *African Economic Research Consortium*, Nairobi April 2007 p.6.

Maskus submits, and it is a matter of that fact, IPRs play an important role in a regulatory system, such as taxation, investment regulations, production incentives, trade policies, and competition rules.³⁴³ Whether it translates into economic growth, however, is debatable, considering the unusual socio-economic make-up of Nigeria.

In a study conducted by Seyoum,³⁴⁴ it was determined through empirical evidence:

Trademarks are significant and positive for less-developed and developed countries. However, the coefficient is negative and significant for the newly industrializing countries. The negative coefficient may reflect increased investment activity in these newly industrializing countries when the level of trademark protection remained somewhat unchanged or the level of enforcement deteriorated.

Maskus, in his examination of IPRs and FD, comes to the conclusion:

The means by which IPRs influence FDI are complex and subtle. Furthermore, strong IPRs alone are not sufficient incentives for firms to invest in a country. If they were, recent FDI flows to developing economies would have gone mainly to sub-Saharan Africa and Eastern Europe. In contrast, China, Brazil, and other high-growth, large market developing economies with weak protection would not have attracted nearly as much FDI.³⁴⁵

Although it has been argued that a flourishing trade mark system encourages FDI, to say that stronger IPRs lead to more FDI is an oversimplification of the equation. An improvement in the law, nevertheless, is recommended as empirical surveys show that trade liberalisation and FDI are complements.³⁴⁶ The role of FDI is uncertain as ‘output depends on the variables that are entered alongside the test equation.’³⁴⁷

³⁴³ Keith E Maskus, Role of Intellectual Property Rights in Encouraging Foreign Direct Investment and Technology Transfer, 9 *Duke Journal of Comparative & International Law* 109 (1998-1999) p.3.

³⁴⁴ Seyoum Belay, ‘The impact of intellectual property rights on foreign direct investment’ *The Columbia Journal of World Business* Volume 31, Issue 1, Spring 1996, Pages 50–59.

³⁴⁵ Keith E. Maskus, (non-technical summary) ‘Intellectual Property Rights and Foreign Direct Investment Policy’ Discussion Paper No. 0022 May 2000 Centre for International Economic Studies p.v.

³⁴⁶ Andre Martens Trade Liberalization and Foreign Direct Investment in Emerging Countries: An Empirical Survey available at www.pep-net.org/fileadmin/medias/pdf/Martens-trade-FDI-final.pdf accessed 09 June 2014.

³⁴⁷ Ayanwale, FDI and Economic Growth: Evidence from Nigeria p.4, UNCTAD. 1999. Foreign Direct Investment in Africa: Performance and Potential. United Nations Publications UNCTAD/ITE/IIT/Misc.15. New York and Geneva: United Nations.

5.5.3 Other Implications

5.5.3.1 Cost

The cost implication of putting a functioning trade mark system in place is one of the concerns raised as a likely impact of the TRIPS Agreement on DCs and LDCs. Cost implication is raised in terms of administration, enforcement by the judiciary, police and customs and the displacement of counterfeit products. There are also cost pertaining to infrastructure, as well as cost passed to consumers as a result of high prices of imported goods which are largely owned by companies in industrialised countries.

Generally speaking, in Nigeria imported products are far more expensive than locally produced goods because of several factors. These factors include the view that imported products are better than locally made ones, that they have better packaging and as a result of high import duties. Sometimes these products are contraband which has been smuggled into Nigeria: a high price has been paid to get them to market to corrupt officials.³⁴⁸

The Administration of trade marks in Nigeria until January 2014 followed the system inherited from Britain. It was very much paper based: the registry did not have a computerised system of registration and searches, every part of the registration process had to be carried out manually. This system caused a waste of time, man power and the limited resources available and extends duration of processing applications. The process can result in numerous errors and the not so reliable data and retrieval systems culminate in attendant delays.³⁴⁹

However, this changed with the introduction of the Intellectual Property Automated System (IPAS) in January 2014 which creates an automated processing of applications for the registration of trade marks patents and industrial designs. It is expected that this system will improve the integrity, quality of examinations and quality of applications that originate from

³⁴⁸ Femi Adekoya Smuggling in Nigeria: An Untameable Beast? The Guardian Wednesday, 07 August 2013 <http://www.ngrguardiannews.com/industry-watch/129163-smuggling-in-nigeria-an-untamable-beast> accessed 10 August 2013.

³⁴⁹ Femi Olubanwo and Chinasa Uwanna The International Comparative Legal Guide to: Trade Marks 2012 A Practical cross-border insight into trade mark work First Edition Global Legal Group Ltd. London 2012.

Nigeria as well as provide a more efficient, quicker, cheaper and transparent and accountable system.³⁵⁰

5.5.3.2 Substandard and Counterfeit Goods

Product counterfeiting is a form of consumer fraud: a product is sold purporting to be something that it is not and under an original trade mark.³⁵¹ Counterfeiting has been on the rise in Nigeria owing to trade liberalisation that has brought about the influx of goods from different parts of the world into Nigeria especially from China³⁵² and Dubai.³⁵³ As well, there has been an invasion of substandard products. The menace is at an alarming level and is reflected in every facet of life in Nigeria. The magnitude of fake products on the market causes one to wonder what the Nigerian Customs and the Standard Organisation of Nigeria (SON) are doing. Fake products in Nigeria range from toothpaste to drugs to car parts to electronic and electrical materials and cable, as well as phones and its accessories. These goods pose a grave danger to the health and safety of human life.

In addition, the fragile manufacturing sector is weakened as it is unable to compete with cheap, imported, substandard or counterfeit goods, thereby destroying the market for made in Nigeria goods. Most Asian goods that come in to Nigeria are much cheaper³⁵⁴ and greater variety than is produced in Nigeria. Consumers buy such products to the detriment of made in Nigeria goods. Well-known and widely-used made in Nigeria products, such as textiles, are now produced in China at a lower cost and exported to Nigeria as made in Nigeria.³⁵⁵

³⁵⁰ Sunday Michael Ogwu 'FG gets automated trade mark' system 100 years after', *Daily Trust* (Lagos Friday 31 January 2014).

³⁵¹ United Nations Office on Drugs and Crime, Counterfeit Products pp.171-190 p. 173 Available at http://www.unodc.org/documents/data-and-analysis/tocta/8.Counterfeit_products.pdf 20 June 2013.

³⁵² 'Product dumping: How Asians are killing made-in-Nigeria goods' Vanguard Monday, April 02, 2012. available at : <http://www.vanguardngr.com/2012/04/product-dumping-how-asians-are-killing-made-in-nigeria-goods/#sthash.9YSp2p8C.dpuf> accessed 20 June 2013.

³⁵³ Vera Samuel Anyagafu 'China vs Dubai: The battle for the Nigerian market' Vanguard Friday, July 21, 2013 - available at: <http://www.vanguardngr.com/2013/07/china-vs-dubai-the-battle-for-the-nigerian-market/#sthash.zdZkY6Q1.dpuf> accessed 20 June 2013.

³⁵⁴ Chinese goods come in cheaper because the government give manufacturers as much as 20 per cent export grant.

³⁵⁵ In a recent tip off which led to the arrest of some counterfeit drugs king pin, Neurogesic Ointment was labelled as manufactured in Nigeria even when it was imported. See Chioma Obinna Fake drugs: NAFDAC records big haul Vanguard May 22, 2013 available at <http://www.vanguardngr.com/2013/05/fake-drugs-nafdac-records-big-haul/> accessed 20 June 2013; Waziri K.M Intellectual Property Piracy and Counterfeiting

Manufacturers are not only losing market share, they are losing revenue as well.³⁵⁶ It is a form of economic sabotage: as the slowdown in the economy, ‘leads to job losses, stifles legitimate trade, and deters foreign investors’.³⁵⁷

The human cost is very serious and fundamental. Poor quality products have caused loss to life and property: fake medicines have caused irreversible damage to people’s organs and have resulted in death.³⁵⁸ There is an abundance of non-toxic and less dangerous counterfeit materials, such as apparel, footwear, handbags and belts. In 2011, as a result of the wanton counterfeiting of Louis Vuitton products, a buy back scheme was initiated by Louis Vuitton to enable the company buy back fake LV bags from consumers.³⁵⁹ It is estimated that over 80 per cent of goods imported into Nigeria are fake or substandard with an annual loss of 15 billion naira in tax revenues.³⁶⁰ In addition, the poor level of compliance to government import regulations causes a loss of over ₦50 billion annually from fake, substandard and counterfeit products.³⁶¹

The influx of substandard and counterfeit goods cannot be attributed to trade liberalisation only. There are other issues like ‘chronic institutional incapacity and vulnerability’ of the Nigerian Customs, the Standard Organisation of Nigeria (SON) and Consumer Protection Council (CPC). There is a clear recognition that this menace adversely affects the economy

in Nigeria: The Impending Economic and Social Conundrum *Journal of Politics and Law* Vol. 4, No. 2; September 2011.

³⁵⁶ Victor Emejuiwe Towards A People-driven Economy *The Guardian*, Sunday, 28 July 2013.

³⁵⁷ *Vanguard* Nigeria: Who Bears the Brunt of Fake Goods? 9 December 2012 available at <http://www.vanguardngr.com/2012/12/who-bears-the-brunt-of-fake-goods/> accessed 20 June 2013.

³⁵⁸ The ‘My Pikin saga’ which claimed the lives of 84 innocent children who given the fake My Pikin teething mixture by their unaware parent. Akunyili Dora *Lessons from Nigeria: The fight against Counterfeit drugs in Africa* Diabetes Voice September 2006 Volume 51 Issue 3.

³⁵⁹ Louis Vuitton to open store in Nigeria: For purchase of fake goods available at <http://www.wazobiareport.com/reports/Louis-Vuitton-to-open-store-in-Nigeria-For-purchase-of-fake-goods> accessed 14 August, 2013 accessed 14 August 2013.

³⁶⁰ Sub-Standard Products: Nigeria’s Growing Menace Monday 6 December 2010 available at <http://www.thenigerianvoice.com/nvnews/40238/1/sub-standard-products-nigerias-growing-menace.html> accessed 14 August, 2013 See also Lawal Bello Dogarawa Overview of the Socio-economic Implications and Management of Product Faking and Adulteration Greener *Journal of Business and Management Studies* ISSN: 2276-7827 Vol. 3(3), pp. 119-131, available at <http://www.gjournals.org/GJMBS/PDF/2013/April/Dogarawa.pdf> accessed 14 August, 2013.

³⁶¹ Rita Ohai SON to tackle fake goods importation *The Nation* Sunday 01 January 2012 available at <http://www.thenationonlineng.net/2011/index.php/business/31720-son-to-tackle-fake-goods-importation.html> accessed 14 August, 2013.

and social well-being of the country.³⁶² Several government initiatives, such as the Memorandum of Understanding (MOU) signed by China³⁶³ and Nigeria in 2010, are expected to help curb the importation of substandard goods that do not meet Nigerian specifications.³⁶⁴ According to the agreement, China Certification & Inspection Group (CCIG) and SON, jointly are to monitor and survey products coming into Nigeria in order to eliminate Chinese origination of substandard products.³⁶⁵

Additionally, Operation Zero Tolerance for substandard products by the Ministry of Trade and Investment, through the Standards Organisation of Nigeria, is another effort initiated to ‘boost productive capacity of local industries and make them more competitive³⁶⁶ in the global market’ and to provide a friendlier environment which is vital for economic growth and development.³⁶⁷ Over the years NAFDAC has been at the fore-front in fighting counterfeit drugs. The organisation has had many successes with regards to drugs, but the battle is far from over. As recently as May 2013, NADFAC, following a tip-off raided a ware-house and seized various counterfeits of well-known drug products worth over ₦106, 210 million that had been shipped in from China.³⁶⁸ These drugs had successfully bypassed all enforcement agencies involved in clearing goods out of the ports. Although, NADFAC

³⁶² Lawal Bello Dogarawa Overview of the Socio-economic Implications and Management of Product Faking and Adulteration Greener *Journal of Business and Management Studies* ISSN: 2276-7827 Vol. 3(3), pp. 119-131, April 2013. Available at <http://www.gjournals.org/GJMBS/PDF/2013/April/Dogarawa.pdf> accessed 14 August, 2013.

³⁶³ Specifically with the Chinese Certification and Inspection Group (CCIG).

³⁶⁴ Layi Adeloje Substandard products: SON, Chinese certification body sign MoU *The PUNCH* December 7, 2012 available at <http://www.punchng.com/business/industry/substandard-products-son-chinese-certification-body-sign-mou/> accessed 20 June 2013.

³⁶⁵ Nigeria has also partnered with Korea.

³⁶⁶ Nigeria’s Global Competitiveness Index (GCI) was 3.45 with a ranking of 127th out of 142 countries in 2011-2012. While the GCI for 2012-2013 was 3.67 with a ranking of 115th of 144 countries. And currently the 2013-2014 report ranked Nigeria 120 with a score of 3.57. See World Economic Forum’s Global Competitiveness Report for 2011-2012, 2012-2013 and 2013-2014 available at the World Economic Forum’s website at <http://www3.weforum.org/> accessed 20 June 2013.

³⁶⁷ Roseline Okere & Henry Okereke Stakeholders strategies to raise global competitiveness of made-in-Nigeria products Wednesday, 09 November 2011 available at <http://www.ngrguardiannews.com/industry-watch/67003-stakeholders-strategise-to-raise-global-competitiveness-of-made-in-nigeria-products> accessed 20 June 2013.

³⁶⁸ Chioma Obinna Fake drugs: NADFAC records big haul *Vanguard* May 22, 2013 available at <http://www.vanguardngr.com/2013/05/fake-drugs-nafdac-records-big-haul/> accessed 20 June 2013.

stands out in the fight against fake drugs, its efforts are not always successful as there are several other factors involved the equation of stamping out fake and substandard products.³⁶⁹

Regardless of the merits of these initiatives, the success of counterfeiter and producers of substandard products is attributable to endemic systemic failures, a decaying infrastructure and a poor regulatory environment which inhibit investment. The Minister of Trade and Investment recently pinpointed the lack of enabling laws to deal with offenders,³⁷⁰ it merely is one of the many reasons that the importation of substandard goods is thriving.

5.6 Flexibilities under the TRIPS Agreement

The flexibilities afforded by the TRIPS Agreement in relation to trade marks provide a space for WTO members to manoeuvre in implementing the minimum standards required. Even though the TRIPS Agreement provides for a minimum standard it does not require the harmonisation of the laws of WTO member states: all that is required is for the minimum standards to be implemented.³⁷¹ In the definition by Deere,³⁷² flexibilities simply means ‘a range of rights, safeguards and options that WTO members can exploit in their implementation of the TRIPS Agreement’.

The first article on trade marks in the TRIPS Agreement creates the option to choose the statutory formulation that each country can select depending on the level of development of the country’s trade mark system. This submission is based on the following justifications.

First, article 15.1 provides a definition of a mark that is non-exhaustive. For example, in the definition a ‘sign’ provides that a mark may be either ‘capable of distinguishing’ or ‘distinctiveness acquired through use’; making registration of either type protectable. The list of signs represents only a likely subject matter granted for mark protection. Accordingly,

³⁶⁹ The presence of a NAFDAC registration number presupposes authentication of products as it is presumed that it has been tested and found worthy of human consumption. Not only does the number represent originality it also give trade mark owners the right to bring a successful action of passing off.

³⁷⁰ Raheem Akingbolu, Fake Products: Industrialist Calls for Investment in Technology, Research *This Day* 17 Feb 2012 available at <http://www.thisdaylive.com/articles/fake-products-industrialist-calls-for-investment-in-technology-research/109465/> accessed 22nd June 2013.

³⁷¹ UNCTAD IPU, Christoph Spennemann TRIPS flexibilities: comparing access to medicines and tobacco control.

³⁷² Carolyn Deere, *The Implementation Game*, Oxford University Press, New York 2009, p.68.

members may provide a more comprehensive list of signs. As well, the members may exclude the requirement of ‘visually perceptible’.

Second, article 15.2 gives WTO members the freedom to design their own grounds for denying registration of a trade mark in so far as they are in line with the provisions of article 6 (1) of the Paris Convention. Third, in article 15.3 the use of the word ‘may’³⁷³ clearly shows that WTO members are permitted not to make registration of a trade mark dependent on use. Moreover, in article 19.1 registrations may be cancelled only after an uninterrupted period of at least three years of non-use. The expiry period of three years and the three-year period of non-use is far below the five-year period provided for in the legislations of most Commonwealth countries.³⁷⁴ As a consequence trademarks that are not used remain on the register for over five years in countries such as Nigeria,³⁷⁵ India³⁷⁶ and South Africa.³⁷⁷

The flexibility under article 16 relates to the fact that a trade mark is a negative right: a right to exclude others. It means that WTO members can determine the extent of exclusive rights in their domestic laws by giving the owner of a trade mark the right to deal with the trade mark as its absolute owner.³⁷⁸ It makes it possible for exclusive rights to include the use of a registered trade mark as personal property; making equities for a registered trade mark enforceable as equities like any other personal property.³⁷⁹

Furthermore, the TRIPS Agreement provides WTO members with possible exceptions to the rights conferred by a trade mark.³⁸⁰ These specifically include fair use of descriptive terms³⁸¹ by which it is impossible for one person to have the monopoly of the descriptions of characteristics and features of the product or service for which the trade mark is intended. It has been argued that the inclusion may cause an exploitation of the reputation where the description relates to the quality, exploitation of reputation is not fair use, leaving room for

³⁷³ ‘May’ means to be permitted or to be a possibility; see Black Law’s Dictionary 1000 (8th ed. 2004).

³⁷⁴ Most Commonwealth countries followed the British Trade Marks Act of 1938, section 26(1) (a).

³⁷⁵ Section 31 (2) (b) TMA 1965 T13 LFN 2004.

³⁷⁶ Section 47 (1) (b) India Trade Marks Act No. 47 of 1999.

³⁷⁷ Section 27 (1) (b) South African Trade Marks Act No. 194 of 1993.

³⁷⁸ Section 22 Australia Trade Marks Act 1995.

³⁷⁹ Section 21 Australia Trade Marks Act 1995.

³⁸⁰ Article 17 TRIPS Agreement.

³⁸¹ Article 17 TRIPS Agreement.

national legislation to manoeuvre and ‘formulate in an indefinite way’.³⁸² Although, fair use of descriptive terms is expressly included, it does not foreclose other fair use exceptions such as parody, news reporting, commentary, criticism, and for comparative advertising. It is presumed that the exclusive right given to the owner entails the right to exclude third party uses, but do not exclude marketing of the product by mentioning the trade mark and all other types of mention that does not involve the use of the mark in commerce provided the legitimate interest of the trade mark owner is taken into account. In essence, the provision of limited exception can be interpreted to mean defined exceptions if the exception is defined in national laws and does not go against the letter of the TRIPS Agreement.

Prior to the TRIPS Agreement most legislation had a renewal period that varied from ten years³⁸³ to fourteen³⁸⁴ or fifteen years.³⁸⁵ The TRIPS Agreement provides for a term of seven years which makes frequently it more flexible for registries to determine trade marks that are still in use and those that are no longer in use. It also provides an additional source of income for the WTO member in that the more frequently the trade mark is renewed the more funds the registry gains.

Furthermore, WTO members are given the liberty to determine conditions upon which they can licence and assign trade marks, giving the licensor or assignor the option to assign the trade mark with or without the transfer of the business to which the trade mark belongs.³⁸⁶

It is the responsibility of each WTO member to formulate laws that will incorporate the flexibilities in a way that benefits society and caters for public policy. There are instances where certain constraints prevent the effective implementation of these flexibilities, such as a lack of technical legal expertise and insufficient technical and infrastructural capacity. At this juncture it is pertinent to ask, if these constraints really apply to the Nigerian situation. The situation of Nigeria is peculiar in that it cannot be said that we lack technical legal expertise,

³⁸² Stoll, Peter Tobias, Busche, Jan & Arend Katrin (Eds) *WTO Trade Related Aspect of Intellectual property Rights* p. 334.

³⁸³ See section 74A Australia Trade Marks Act 1995.

³⁸⁴ Section 23 (1) proviso & (2) TMA 1965 T13 LFN 2004.

³⁸⁵ Section 46 (1) Canadian Trade-marks Act R.S.C., 1985, c. T-13.

³⁸⁶ Article 21 TRIPS Agreement.

neither is there insufficient infrastructural capacity to put in place a legal frame work that complies with the TRIPS Agreement and, at the same time, takes advantage of the flexibilities. It is submitted that the main problem affecting implementation is the lack of will among policy makers,³⁸⁷ who lack awareness of the benefits of IP protection and the ensuing economic and social damage that inadequate protection can cause.

5.7 Modifications Required to the Trade Marks Act by TRIPS Agreement

It is submitted that the Trade Marks Act requires a general overhaul. There is indeed a need for a more comprehensive and better arranged law. The Act requires division into parts, each consisting of sections that relate to the same subject matter.³⁸⁸

5.7.1 Paris Convention

A fundamental reform that is required to be made to the Trade Marks Act is the domestication of the Paris Convention to make it applicable in Nigeria. This amendment can be done simply by issuing a declaration specifying countries that are to be recognised in Nigeria as Convention countries, published in a Federal Gazette by the Minister of Trade and Investment. Subsequently, the international arrangement provision that has been in the Trade Marks Act since 1965 can take effect, making it possible for a Nigerian trade mark owners to claim priority in Convention countries as well as opening the trade mark registry to applications from other convention countries.

5.7.2 Protectable Subject Matter

Another change relates to protectable subject matter. The Act has protectable subject matter as well as non-protectable subject matter scattered all over the Act making it difficult to pick out.³⁸⁹ It is suggested that the provisions relating to protectable subject matter be sited in the same part of the Act. Furthermore, the definition of a trade mark is limited to the

³⁸⁷ See Para 5.2 on the current state of the IPCOM Bill.

³⁸⁸ The Australian Trade Marks Act is a good model to copy in this instance.

³⁸⁹ The fact protectable subject matters are not concentrated in a part of the Trade Marks Act makes it difficult for ordinary business people, who are the main users of trade marks to miss out certain protectable subject matters.

traditional forms of marks.³⁹⁰ It is suggested that the aspects of packaging, shape, colour, sound or scent should be included in the definition.

The Act does not mention graphical representation of marks and visual perceptibility. These are important requirements for a trade mark to be sufficiently described to enable a person inspecting a trade mark Register to clearly identify the features, nature, and scope of protection of the mark. This requirement is even more important if the trade mark registry is moving to a computerised phase. To avoid any doubt it is important that such provision should be made clear and easily comprehensible.

5.7.3 Defensive Registration/Well-known Marks

Although, well-known marks may be protected under the Act by defensive registration of the mark³⁹¹ there is a need specifically to protect well-known mark not as defensive marks because defensive registration unnecessarily clogs up the trade marks data base with useless as well as or useful trade marks. The system of defensive trade mark registration can lead to trade mark clutter especially in an automated system of registration. Trade mark clutter is described in a United Kingdom Intellectual Property Office Report as ‘registers containing such a large number of unused or overly broad trade marks that the costs of creating and registering new marks substantially increase for other applicants’,³⁹² thereby constituting an obstacle to new marks.³⁹³

According to the report it is ‘mainly a problem of absence of housekeeping mechanisms’,³⁹⁴ which is typical of what is happening in Nigeria. It is important that Nigeria amends its laws to protect well-known marks of Nigerian proprietors and other countries to which Nigeria has treaty obligation. However, registration of well-known trade marks should be done with restraint, in that, foremost, the requirement of use in Nigeria need to be enforced and proposed use should not be accepted for registration. For a mark to be well-known in

³⁹⁰ Section 67 TMA 1965 T13 LFN 2004.

³⁹¹ Section 32 TMA 1965 T13 LFN 2004.

³⁹² The Intellectual Property Office (IPO) (2012). Trade Mark Cluttering: An Exploratory Report p. 10 available at <http://www.ipo.gov.uk/ipresearch-tmcluttering.pdf> accessed 25 June 2013.

³⁹³ Shane Smyth ‘A Crowded CTM Register’ European Community Trade Marks Association 29 annual Conference June 19- 2010 http://www.ecta.org/IMG/pdf/full_textsmyth_letterhead.pdf

³⁹⁴ Ibid. IPO (2012) Trade Mark Cluttering.

Nigeria, the extent to which the mark is used in the relevant sector of the public, as well as whether as a result of promotion of the trade mark the mark has become known in Nigeria must be taken into account.³⁹⁵

5.7.4 Use

As the law stands in Nigeria it is possible for marks that are proposed to be used to be registered.³⁹⁶ The Act gives a blanket registration to marks. There is no particular distinction between a mark that is used in commerce and the one intended to be used. It is not the situation in other jurisdictions,³⁹⁷ for example, in the US system a person who proposes to use a mark does not have the mark registered until there is actual use³⁹⁸ and no rights exist in the mark until it is used in commerce. In the EU Community Trade Mark (CTM) system there is no provision for intent to use: marks must be used or registration will be revoked.³⁹⁹

Although it is important to be certain if a trade mark proposed to be used on a product is available for registration and the priority established thereof, the system has been subject to a lot of abuse in Nigeria by persons who register a trade mark to block a foreign mark owner.

Considering the fact that Nigeria is a developing country, small medium enterprises (SMEs) should be encouraged. The practise of intent to use needs to be reformed so that the number of conflicts that arise due to the number of trade marks registered and protected is consequently reduced. As is the case in the US system,⁴⁰⁰ marks that are proposed to be used should be allowed registration, but not full registration.⁴⁰¹ Registration should only ensue if there has been a declaration by submitting some form of documentation showing the mark is in use, followed by evidence of the manner of its use. Such documents should be submitted

³⁹⁵ Section 120(4) Australia TMA.

³⁹⁶ Section 18 (1) TMA 1965 T13 LFN 2004.

³⁹⁷ See generally sections 30 (a)- (i) and 40 (2) Canada Trade-marks Act (R.S.C., 1985, c. T-13).

³⁹⁸ Basic Facts About Trademarks United States Patent and Trademark Office available at <http://www.uspto.gov/trademarks/basics/BasicFacts.pdf> accessed 22 May 2013.

³⁹⁹ Recital 9 of the Harmonisation Directive 2009/25

⁴⁰⁰ See generally (Section 1(b) 1 (15 U.S.C. § 1051). U. S. Trademark Law Federal Statutes (Lahman Act).

⁴⁰¹ A Notice of Allowance (NOA) is issued to the applicant, NOA indicates that your mark has been allowed, but does not mean that it has registered.

within a specified period, however, an extension of time may be allowed subject to the satisfaction of the examining officer.⁴⁰²

It is my opinion that marks proposed to be used should be expunged from the Act if these basic requirements cannot be met. Accordingly, the registration process needs to be reformed in such a way that *mala fide* trade marks registration cease to occur.

As indicated, and as required by the TRIPS Agreement,⁴⁰³ use by another person cannot be recognised as use under the law⁴⁰⁴ for the purpose of maintaining registration. This requirement is very challenging, as noted in the case in *Procter & Gamble v. Global Soap & Detergent Industries Ltd*⁴⁰⁵ above.

As Kur points out, the criterion of use of a mark is important and directly proportional to that of function as the concept upon which trade marks are founded.⁴⁰⁶ To sum up proposal to use or intention to use do not meet the purpose upon which the theory of a trade mark is created. An EU Directive states the value of the use requirement as set out Recital 9:⁴⁰⁷

In order to reduce the total number of trademarks registered and protected... and, consequently the number of conflicts which arise between them, it is essential to require that registered trademarks must actually be used or, if not used, be subject to revocation.

It is submitted that the position taken by the EU is a better system that can be used to regulate the use requirement.

⁴⁰² See generally Basic Facts About Trademarks United States Patent and Trademark Office available at <http://www.uspto.gov/trademarks/basics/BasicFacts.pdf> accessed 22 May 2013.

⁴⁰³ Article 19.2 TRIPS Agreement, WT/DS176/AB/R United States – Section 211 Appellate Panel Report para 193; the Appeal Board noted that Article 19.1 addresses the situation where a member's domestic legislation requires use of the trade mark for the purposes of maintaining its registration and those circumstances when use by a person other than the owner of the trade mark is recognized as use for the purposes of maintaining a registration.

⁴⁰⁴ Section 33 (3) (a) and (b) TMA 1965 T13 LFN 2004.

⁴⁰⁵ CA/L/369/2008.

⁴⁰⁶ Annette Kur *Fundamental Concerns in the Harmonization of (European) Trade Mark Law*, Greame Dinwoodie and Mark Janis, (eds) *Trade mark :aw and Theory , A hand book of Contemporary Research* Edward Elgar Cheltenham 2008 p. 165; Traci L. Jones. 'Remedy Holes and Bottomless Rights: A Critique of the Intent-to-Use System of Trademark Registration Law and Contemporary Problems' [Vol. 59: No. 2] p. 159-180 p.162.

⁴⁰⁷ Recital 9 of the Harmonisation Directive 2009/25.

5.7.5 Registration Processes

Now that the trade marks registry has been computerised for automated registration, a major reform that has long been overdue, there is a need to make provision for an online trade mark journal and data base. All previously published trade mark journals must be uploaded for search purposes. This transformation will not be easy as a number of methodologies for management are required. A development life-cycle will need to be set up to achieve a functional system of registration.

Other issues, such as opposition, in which the application is required to be made within two months without the option of an extension of time, should be amended to allow a further extension of time for another period of two months, as this is beneficial to the applicant and the party opposing the registration. It gives the opposing party time and there will be no need for the matter to go to court before it is resolved and, consequently, will prevent unnecessary double registration. The anomaly may simply be corrected by the minister as the Act specifically confers powers on the minister to regulate the practice under the Act⁴⁰⁸ and to extend the time limit required in the Act for the performance of any act, whether generally or in particular cases and at the discretion of the Registrar or otherwise,⁴⁰⁹ provided such Regulations are published in the Federal Gazette.⁴¹⁰

5.7.6 Exceptions

5.7.6.1 Geographical Limitation

The Act gives earlier right holders the right to continue to use the trade mark concurrently with the registered owner of a trade mark, provided the mark has been continuously used by the earlier right holder⁴¹¹ which creates a problem of the likelihood of confusion. The problem with this right is that it is extensive and likely to cause confusion among consumers. The prior right is presumed to be an unregistered right and probably used within a small locality; otherwise the registered trade mark would not have been registered as it would have

⁴⁰⁸ Section 45 (1) (a) TMA 1965 T13 LFN 2004.

⁴⁰⁹ Section 45 (1) (g) TMA 1965 T13 LFN 2004.

⁴¹⁰ Section 45 (2) TMA 1965 T13 LFN 2004.

⁴¹¹ Section 7 TMA 1965 T13 LFN 2004.

been a known trade mark. To resolve this conflict it is proposed that the earlier rights need to be limited to a particular locality that it is already doing business unless circumstances provide otherwise. For instance, in the United Kingdom, section 11 (3) (b)⁴¹² provides that ‘an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by virtue of any rule of law’. This provision may sound harsh, especially in relation to illiterate business owners, but an unqualified right is bound to cause confusion. Even illiterate traders know the importance of demarcating one trade name from another and the consequent need to protect it properly. As a Yoruba proverb says ‘a farm cannot be for a father and the son without demarcation.’

5.7.6.2 Functionality

A review of the Act needs to include a provision on functionality as a defence against trade mark infringement. The useful features of product should not be allowed to be protected as a trade mark, as this creates a monopoly over useful features for an indefinite period. This situation has led trade marks legislation, as in the US Statute, expressly to provide that any matter that as a whole is functional will not be protected as a trade mark; this makes it impossible for useful features to be permanently taken out of the reach of other manufacturers. The possibility of such an issue arising can be seen in the case of *TraFFix Devices, Inc. v Marketing Displays, Inc.*⁴¹³ The Marketing Displays, Inc. (MDI) (respondent), was owner of an expired utility patent for a ‘dual-spring design’ mechanism that keeps temporary road and other outdoor signs upright in adverse wind conditions. MDI claimed its sign stands were recognizable to buyers and users because the patented design was visible near the sign stand’s base. On expiration of the patent, TraFFix Devices, Inc. (petitioner) began marketing sign stands with a dual-spring mechanism copied from MDI’s design. MDI sued for trade dress infringement. The Supreme Court held that ‘in general terms a product feature is functional, and cannot serve as a trade mark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’⁴¹⁴ The court

⁴¹² UK Trade Marks Act 1994.

⁴¹³ 532 U.S. 23 (2001).

⁴¹⁴ The Court quoting *Inwood Laboratories, Inc. v Ives Laboratories, Inc.*, 456 U S 844, 850.

further observed that a functional feature is one ‘the exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage’.⁴¹⁵

5.7.6.3 Other Exceptions

Equitable principles, such as laches, estoppel, and acquiescence are exceptions as well. Although, these equitable principles will apply whether they are laid out or not it is better expressly to outline the defences or exceptions rather than for it to be subject to doubt or the discretion of the courts.

5.7.7 Parallel Imports

Parallel imports refers to a situation in which genuinely branded product which has been purchased from the owner of the brand in country A either with a licence to sell to or manufacture in Country B has been imported into country C without the permission of the incumbent authorised licensee or has been imported into country A without the permission from the trade mark owner. These products may have been formulated or packaged differently for sale and are not intended for sale domestically in the markets of country A.⁴¹⁶ Succinctly put, parallel importation involves the importation of goods⁴¹⁷ unconnected to the distribution channels negotiated and agreed upon contractually by the manufacturer.⁴¹⁸ Parallel imports are not counterfeited products: they are legitimate products authorised by the manufacturer.⁴¹⁹ Parallel imports can be profit driven and are usually sold at a lower price

⁴¹⁵ The Court quoting *Qualitex Co v Jacobson Products Co* 514 U S 159 165.

⁴¹⁶ *Colgate - Palmolive Ltd. & Anor. v Markwell Finance & Anor.* [1989] R.P.C. 497. Trademark Owner’s Guide to Parallel Imports in the United States Working with U.S. Customs and Border Protection to Prevent Importation of Gray Market Goods February 2012 INTA Publication available at <http://www.inta.org/Advocacy/Documents/INTA%20Trademark%20Owners%20Guide%20to%20Parallel%20Imports%20in%20the%20United%20States.pdf> accessed 28 June. 2013.

⁴¹⁷ Imported goods are sometimes called ‘grey market goods’

⁴¹⁸ Bernard M. Hoekman, Aaditya Mattoo, Philip English (eds.) *Development, Trade, and the WTO: A Handbook*, Volume 1 World Bank; Oxford University Press USA 2002 p. 376; Timothy H. Hiebert Parallel Importation in U.S. Trademark Law Greenwood Press Connecticut 1994 p. 1 International Exhaustion and Parallel Importation available at http://www.wipo.int/sme/en/ip_business/export/international_exhaustion.htm accessed 29 June 2013.

⁴¹⁹ Correa, C., (2000) ‘Integrating Public Health Concerns into Patent Legislation in Developing Countries,’ South Centre, Geneva p.72; Mueller-Langer Frank, ‘Does Parallel Trade Freedom Harm Consumers in Small Markets?’ (September 14, 2008). *Croatian Economic Survey*, No. 11, pp. 11-41, 2008 available at SSRN: <http://ssrn.com/abstract=1885539> accessed 13 July 2013.

than similar goods in particular countries, which may be as a result of international pricing policies or currency differences.⁴²⁰

According to Abbot⁴²¹ parallel importation is an economic issue which involves the necessary balance of interest between the consumer and the producers. His view is spot-on: he explains that consumers and producers have varied interests which have to be determined by the order of importance. He mentions that the interest of the consumer is a low price coupled with a quality product, availability of variety and support for the use of the product. On the other hand, the interest of the producer is solely to maximise his investment.

Parallel importation has its legal basis in the doctrine of exhaustion of rights.⁴²² Generally, exhaustion of rights is regarded as a limitation on intellectual property rights.⁴²³ Parallel importation has come to the fore since the implementation of the TRIPS Agreement, especially in relation to patents. Although the TRIPS Agreement does not define parallel importation, nor exhaustion of rights, but cursorily mentions exhaustion of intellectual property rights. This mention is in article 6: first in relation to dispute settlement under the TRIPS Agreement and, second providing only an implied approach for WTO members to follow in determining the structure of its exhaustion policy by making it subject to the provisions of articles 3⁴²⁴ and 4⁴²⁵ of the TRIPS Agreement.

⁴²⁰ Trademark Owner's Guide to Parallel Imports in the United States Working with U.S. Customs and Border Protection to Prevent Importation of Gray Market Goods February 2012 available at <http://www.inta.org/Advocacy/Documents/INTA%20Trademark%20Owners%20Guide%20to%20Parallel%20Imports%20in%20the%20United%20States.pdf> accessed 28 June. 2013.

⁴²¹ Abbott FM 'First Report (final) to the Committee on International Trade Law of the International Law Association on the subject of parallel importation' (1998) 1 *Journal of International Economic Law* (4) 607-636, 612 doi:10.1093/jiel/1.4.607.

⁴²² Abbot Frederick M 'Parallel Importation: Economic and social welfare dimensions International' Institute for Sustainable Development Canada June 2007 available at: <http://ssrn.com/abstract=1915395> accessed 29 June 2013.

⁴²³ International Exhaustion and Parallel Importation available at http://www.wipo.int/sme/en/ip_business/export/international_exhaustion.htm accessed 29 June 2013.

⁴²⁴ This article provides for *National Treatment*-Each member shall accord to the nationals of other member state, treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property.

⁴²⁵ This article provides for the *Most-Favoured-Nation Treatment* -With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other members.

Exhaustion of rights refers to a situation where a product protected by intellectual property rights has been put on the market by the manufacturer or with his consent. Subsequently, IPR of commercial exploitation over this given product can no longer be exercised by the manufacturer and the right to monitor or prevent sales is deemed ‘exhausted’.⁴²⁶ The reason for this principle is to maintain a balance between the public interest and the IP right owner.⁴²⁷ Generally, it is believed that this doctrine limits trade mark owner rights.⁴²⁸

There are different forms of exhaustion of right: they include national,⁴²⁹ regional⁴³⁰ and international exhaustion.⁴³¹ Nigeria has no provision on the exhaustion of rights and parallel importation in trade marks law, however, there is a regional provision on the doctrine of exhaustion, which has to be domesticated for the provisions to be applicable and enforced in Nigeria.⁴³² This situation has also lead to the dearth of case law in this area. Although, provisions relating to this issue are absent, there are two recent decisions in the Federal High Court on parallel importation. *The Honda Place Limited, Honda Motor Company Limited of Japan v Globe Motors Holding Limited & others*.⁴³³ the crux of the Honda case parallel importation of Honda cars made in the United States of America imported by Globe Motors Ltd into the Nigeria market and said to be ill-adapted for Nigerian conditions and fuel specifications. The importation was said to be detrimental to Honda Place, which has the license to distribute Honda cars in Nigeria. In addition, Honda Place sought to protect their reputation and business. The defendants, on the other hand, contended that genuine goods imported ‘from elsewhere outside Japan’ did not alter the rights of the licensee. The court

⁴²⁶ International Exhaustion and Parallel Importation available at http://www.wipo.int/sme/en/ip_business/export/international_exhaustion.htm accessed 17 July 2013.

⁴²⁷ Marco Slotboom, *A Comparison of WTO and EC Law: Do Different Objectives and Purposes Matter for Treaty Interpretation* Cameron May London 2006 p. 180.

⁴²⁸ James B. Kobak, ‘Exhaustion of Intellectual Property Rights and International Trade’ *Fordham University School Of Law* available at http://www.hugheshubbard.com/ArticleDocuments/Exhaustion_IP_Rights_2003 accessed 17 July 2013.

⁴²⁹ National exhaustion means that the IP owner can no longer control the commercial exploitation of goods put on the domestic market by the IP owner or with his consent.

⁴³⁰ Regional exhaustion refers to the initial sale of a product protected under IP, with the IP owner consent exhausts any IP rights over these given products not only domestically, but within the whole region, and parallel imports within the region can no longer be opposed based on the IP right.

⁴³¹ Where a country applies the concept of international exhaustion, the IP rights are exhausted once the product has been sold by the IP owner or with his consent in any part of the world.

⁴³² Article 5 Supplemental Act Adopting Community Competition Rules and the Modalities for their Application within ECOWAS.

⁴³³ FHC/L/CS/1442/97; See also (2005) LPELR-SC.161/2001.

ordered the defendants to cease importing Honda cars from the United States or any other country except Japan. In an earlier case, *Honda Company Ltd and Another v Bright Motors and 4 others*,⁴³⁴ an injunction was granted in favour of the claimant restraining the ‘sale and importation of Honda products into Nigeria except through the authorised main dealer of Honda products in Nigeria’

These judgements favour Honda Place, the question to be asked is whether Honda Place should be the only seller of Honda cars in Nigeria. Would this not amount to a sort of monopoly? What the two judgements are driving at is unclear in that it is a known fact that most American cars have better specification than the ones made for the Nigerian market, as the dealer compromises on the standards of the cars imported.⁴³⁵ In addition, cars bought in Honda Place are far more expensive than cars bought outside and this system serves only to protect the foreign pricing policy.

Section 5⁴³⁶ grants a trade mark owner the exclusive right to use the trade mark in relation to the goods. This provision was used against the doctrine of exhaustion and parallel importation to prevent importation into Nigeria by any person other than the owner of the trade mark and, as a result restricting trade and, at the same time, encouraging monopoly.

In a country like Nigeria where the domestic manufacturing of goods is very low and imported goods make up most of the goods used, it is important that consumers are able to choose from a variety available to them and are not limited by the law and bound to only one source. There are many international precedents on this issues which the court could have followed. In the European Union, article 7 (1)⁴³⁷ modified by Annex 17 of the European Economic Area Agreement makes it clear that ‘the trade mark right shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in a

⁴³⁴ (1998) 12 NWLR Part 577 at p. 230.

⁴³⁵ In addition, America has a policy that allows only used cars to be exported out of the country, in essence the cars in questions are used cars which are more affordable to most people than new ones. See generally 19 C.F.R. §§192.0-192.4.

⁴³⁶ Trade Marks Act, Cap T 13, Laws of Federation of Nigeria 2004.

⁴³⁷ Article 7 (1) of the First Council Directive dated December 21, 1988 (89/104/EEC)

Community⁴³⁸ under that trade mark by the proprietor or with his consent'. The ECJ has decided several cases on exhaustion of trade marks such as *Silhouette International Schwied GmbH & Co KGU. Hartlauer Handelgesellschaft mbh.*⁴³⁹ The Nigeria court could have taken these judgements into consideration in its decision to ameliorate the jurisprudential cessation on parallel importation and exhaustion of rights.⁴⁴⁰

In summary, the absence of a provision on parallel importation and exhaustion of rights in the Nigerian legislation gives judges the discretion to interpret some section⁴⁴¹ as providing exclusive rights for the trade mark owners to the detriment of consumers. Consumers are producers and producers are consumers a balance between the rights of the two is therefore necessary.

5.7.8 Licensing

Licensing is an important medium for propagating an adequate and profitable use of intellectual property in a global economy. Licensing is known to facilitate commercialisation of IP and allows for the expansion of business into new markets which, otherwise, it would not have ventured into.⁴⁴²

Licensing, under the Nigerian Trade Marks Act, was passed over as merely part of other transmissible understandings which can be carried out by the trade mark proprietor. For an economy like Nigeria, where most of the products or goods used are not made in Nigeria,⁴⁴³ a clear and concise definition is crucial to support effective licensing contracts. Nigeria can benefit from the manufacturing capacity of other countries through trade mark licensing by

⁴³⁸ Community includes all member States of the European Union (France, Germany, Italy, United Kingdom, Ireland, Belgium, Luxembourg, Holland, Greece, Spain, Portugal, Austria, Denmark, Sweden, Finland) and member States of the European Free Trade Agreement (Iceland, Liechtenstein, Norway).

⁴³⁹ *Zino Davidoff S.A. v AL & G Imports Ltd* Case C414/99, *Levi Strauss & Co ltd v Tesco Stores Ltd* C415/99; and *Levi Strauss & Co and Levis Strauss Ltd v Costco UK Ltd* C416/99.

⁴⁴⁰ Although foreign authorities cannot replace the case law it may serve as a persuasive basis for determining the case. See the Supreme Court decision of *E. O. Araka v Don Egbue* (2003) 17NWLR 848 AT 1 SC. Per Niki Tobi J.S.C. See also *Air Via Ltd. v Oriental Airlines Ltd.* (2004) 9 N.W.L.R 298 AT 325.

⁴⁴¹ Section 5 TMA 1965 T13 LFN 2004.

⁴⁴² Licensing of Intellectual Property Assets; Advantages And Disadvantages available at <http://www.wipo.int/export/sites/www/sme/en/documents/pdf/licensing.pdf> accessed 19 July 2013.

⁴⁴³ Nigeria imports mainly: industrial supplies (32% of total), transport equipment and parts (23%), capital goods (24%), food and beverage (11%) and consumer goods. Main import partners are: China (17% of total), Albania (11.3%), United States (7.5%), France and Belgium.

partnering with other companies to manufacture, distribute, sell and market their products. This practise would help in identifying the source of the goods that come into the country, thereby eliminating counterfeit and substandard goods.

The Act, as noted earlier, essentially copied the British Trade Mark Act of 1938⁴⁴⁴ and this provision is no exception. However, the UK Trade Marks Act of 1994 jettisoned the provision and replaced it with specific provisions on licensing.⁴⁴⁵ Consumers usually are attracted to known brands, therefore, if more companies obtain licences from known brands, licensing would increase the FDI and would make genuine brands available at affordable prices.

Licensing is a win-win situation for the licensor and brand owner and the licensee and manufacturer or distributor. It is necessary to have a well-drafted and concise provision on licensing.

5.8. Conclusion

The trade marks legal framework and the necessary modifications seem deceptively simple. However, a closer examination reveals many problems inherent in the framework which leaves numerous logical questions unanswered.

It is unfortunate that trade marks law has remained stagnant for so long without any changes considering the expansion that have taken place in the trade marks field over the last two decades. Despite the changing ways of trade marking, the Nigerian law has refused to change. Nigeria, as a country with high proliferation of consumer products, needs a trade mark legislation that is abreast with the influx of various trade marks for health, security and socio economic safeguards.

With regards to the question of whether the Nigerian Trade Marks Act complies with the TRIPS Agreement which was investigated, it is submitted, to a large extent that the Trade Marks Act fulfils a majority of the required provisions on trade marks that were examined

⁴⁴⁴ Section 22- 25 British Trade Mark Act of 1938.

⁴⁴⁵ Section 28- 31 British Trade Mark Act of 1994.

with regard to the TRIPS Agreement. However, one issue that was not in compliance with the TRIPS Agreement was the requirement of use of a trademark by any person to be recognised as use of the trademark for the purpose of maintaining the registration, where section 33 (3) of the Act recognises only the proprietor and the registered user.

Specific issues that were noted for reform relate to the enforceability of the Paris Convention and the absence of an express provision for the protection of well-known marks. Protectable subject matter also needs to be defined in terms of graphical representation of marks and visual perceptibility as it forms a critical foundation for evaluating and determining what the appearance of a trade mark should be. The issue of proposed use required by the trade marks law is a vital aspect of a trade mark and must be clarified by putting a system in place to determine such use.

And finally, the process of registration of trade marks that bestows title on a trade mark's owner needs to be reassessed by the legislature to enable trade mark evaluation and accuracy in light of the former process and the current effort to computerise. Also, the list of exceptions to trade marks requires clarification and amplification.

In this study it is observed although with constraints, that the legal boundaries are in place to deal with the evolving issues in trade mark protection.

The following chapter will undertake the evaluation of the Patent Law and Design in terms of variations against the TRIPS Agreement to illustrate the impact and modifications required.

CHAPTER 6

Statutory Framework of Patent Law in Nigeria

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6.1 Introduction

The purpose of this chapter is to explore the conformity of the Patent and Design Act¹(PDA) with the Agreement on Trade Related Aspect of Intellectual Property (TRIPS Agreement). Patents have been the most controversial aspect of intellectual property since the TRIPS Agreement came into being, particularly with regards to what are patentable subject matters and uses without authorisation of the right holder, especially, with reference to public health.

Patents today are associated with economic, health, cultural and social conditions prevailing in a country. There is no doubt that patents have assisted in national development and have created a lot of benefits for the human race. Inventions have been an important part of human development and have made life much easier.²

¹ Cap P2 (Vol. 13) Laws of Federation of Nigeria 2004. (Herein after ‘the PDA’ or the ‘Act’.)

² Such inventions include electricity, telephones, cars, airplanes, ships, refrigeration, television and medicines which are essential to life.

The history of patent protection dates back to 1421.³ The modern patent system as it is now known began in 1623 with the Statute of Monopolies.⁴ This was the first of several statutes⁵ which initially progressed to promote innovation by encouraging the importation of new technologies and by making new inventions,⁶ as well as rewarding the inventor for his efforts⁷ with an opportunity to enjoy the exploitation of his invention for a limited period. This chapter will examine the patent law, beginning with an overview of the current status of the legal framework. After which, an examination to determine its compliance TRIPS and the interpretation thereof will be carried out.

As in previous chapters, a scrutiny of compliancy with TRIPS in relation to its impact on the legal framework and the flexibilities available to create a balanced framework that is beneficial to the country will be examined and potential modifications will be proffered. This chapter will limit its discussion to patents only.

6.2 Patent Laws in Nigeria

6.2.1 Historical Development of Patents in Nigeria

The historical development of the Nigerian patent system can be traced back to the Paris Patent Conference of 1879 at which the decision to extend patent laws and systems to colonial territories was initiated.⁸ The first Nigerian patent legislations were enacted in 1900. These were the Patents Ordinance No. 17 of 1900⁹ and the Patents Proclamation Ordinance No. 27 of 1900¹⁰ applicable to the colony of Lagos and Southern Nigeria respectively. A similar provision was later applied to Northern Nigeria by virtue of the Patents Proclamation

³ An architect Brunelleschi was granted a patent for barge with hoisting gear in 1421 in Florence for three years. The first patent Statute was said to be issued by the Republic of Venice in Italy under the Venetian Statute of 1474. See Christine MacLeod, *Inventing the Industrial Revolution: The English Patent System, 1660-1800*, Cambridge University Press, 2002 pp10-11.

⁴ The Statute of monopolies is an Act of the Parliament in England it is regarded as the first statutory expression of English Patent Law.

⁵ Statute Law Revision Act 1863, Patents, Designs and Trade Marks Act 1883, Statute Law Revision Act 1948, Administration of Justice Act 1965, Statute Law (Repeals) Act 1969.

⁶ Boulet, P., Garrison, C. and Hoen E *Drug Patents under the Spotlight Sharing Practical Knowledge about Pharmaceutical Patents* Médecins Sans Frontières Campaign for Access to Essential Medicines Geneva p. 5

⁷ Susy Frankel and Geoff McLay, *Intellectual Property in New Zealand* Wellington, Butterworth's Lexis Nexis, (2002) p.324.

⁸ Edith Penrose *The Economics of International Patent System* John Hopkins Press Baltimore 1951 p.53.

⁹ Ordinances of the Colony of Lagos , 892 (1901).

¹⁰ Laws of the Protectorate of Southern Nigeria Ch. 48, 653 (1908).

Ordinance No.12 of 1902.¹¹ These ordinances provided for an independent patenting system in the various parts of the country.¹²

Following the amalgamation of Northern and Southern Nigeria in 1914, the Patent Ordinance and Patent Proclamation Ordinances were repealed and replaced with the Patents Ordinance No 30 of 1916¹³ which abolished the independent patenting system under the previous Ordinances. It was renamed and re-enacted in 1925 as the Registration of United Kingdom Patents Ordinance of 1925.¹⁴ Under the 1925 Ordinance, patents could be granted only in the United Kingdom, however, they would be valid in Nigeria if an application is registered within three years of the grant of the patent in the United Kingdom.¹⁵

After independence in 1960, the Registration of United Kingdom Patents Act¹⁶ Ordinance of 1925, the Patents Rights (Limitation) Act 1968¹⁷ and Patents Act 1949 of the United Kingdom and amendments thereof remained in force in Nigeria until 1970. Subsequently, all these laws were repealed by the Patents and Designs Act No. 60 of 1970.¹⁸ Notably, this means that there was no Nigerian legislation empowered to grant patents from 1924 to 1970.¹⁹ In 1970 when the patent law was first reviewed after independence, apart from the fact that there was no tangible reason behind the enactment of Patents and Designs Act

¹¹ Laws of the Protectorate of Northern Nigeria 415 (1910).

¹² Charles Mwalimu *Nigeria Legal System Private law* Vol 2 Peter Lang New York 2009 pp.518-519. The independent patenting system has been regarded as an anomaly and ambitious within the period of its occurrence considering the standard of western civilization and level of western technological know-how available in the indigenous population at the time. See Patents – The Requirement for Patentability in Nigeria p. 2 available as <http://www.allanogunkeye.com/allan/Requirement15.pdf> access 15 June 2012.

¹³ Nigerian Ordinance 401 (1916) Cap 141 Laws of Nigeria.

¹⁴ Registration of United Kingdom Patents Ordinance No 6 of 1925, Cap 182 Laws of the Federation of Nigeria and Lagos 1958.

¹⁵ An Overview of the Law of Patents in Nigeria p.2 available at <http://www.nigerianlawguru.com/articles/intellectual%20property%20law/AN%20OVERVIEW%20OF%20THE%20LAW%20OF%20PATENTS%20IN%20NIGERIA.pdf> access 15 July 2013.

¹⁶ Ordinance No 6 of 1925.

¹⁷ This law was enacted in 1968 to enable the government of Nigeria and third parties use certain inventions.

See also Charles Mwalimu *Nigeria Legal System Private law* Vol 2 Peter Lang New York 2009 p. 519.

¹⁸ Section 31(1) PDA 1970 P2 LFN 2004.;Sikoyo et al *Intellectual Property Protection in Africa Status of Laws, Research and Policy Analysis in Ghana, Kenya, Nigeria, South Africa and Uganda* African Centre for Technology Studies (ACTS) Ecopolicy Series no. 16 p.18 see also See Patents – The Requirement for Patentability in Nigeria available at <http://www.allanogunkeye.com/allan/Requirement15.pdf> access 15 June 201; Babafemi F.O. *Intellectual Property The Law and Practice of Copyright Trade Marks, Patent and Industrial Design in Nigeria* Justinian Ibadan 2007 p. 89.

¹⁹ Charles Mwalimu *Nigeria Legal System Private law* Vol 2 Peter Lang New York 2009 p. 519; J. Ola Orojo *Nigerian Commercial Law and Practice*, Publisher Sweet & Maxwell, 1983 p.1106.

beyond nationalising the patent application and the grant process, there appeared to be no policy rationale or consideration as such behind adopting the Model Law for developing countries. There was no national policy with regard to industrial and technological development and the PDA was simply fashioned after the Model Law for developing countries created by United International Bureau for the Protection of Intellectual Property (BIRPI).²⁰ As Adewopo confirms, it was not based on any defined or underlying policy consideration.²¹ The Patents and Designs Act of 1970²² remains the substantive law on Patents and Designs without any subsequent amendments. The Patent and Designs Act of 1970 is in chapter 2 of the 2004 Laws of the Federation of Nigeria.²³

6.2.2 Overview of the Patent law

6.2.2.1 Conferment of Patent

Patent rights are protected under the Patent and Designs Act of 1970.²⁴ The conferment of a patent is effected by section 2 of the PDA. The right to a patent is vested in the statutory inventor: this is the person who, whether or not he is the true inventor, is the first to file or validly claim a foreign priority for a patent application in respect of an invention.²⁵ The true inventor, whether or not he is also the statutory inventor, is entitled to be named in the patent as such, and the entitlement in question shall not be modifiable by contract.²⁶ The law regards the statutory inventor as the applicant that is, the person who files the application for patent, whereas the true inventor is the person who invented the product or process, that is, the person who conceives the subject matter in question, as opposed to someone who only contributes suggestions about the invention before or after conception.²⁷

²⁰ World Intellectual Property Organisation's predecessor.

²¹ Adebambo Adewopo, 'Public Health, Access to Medicines and the Role of Patents System in Nigeria' *NIALS Journal of Intellectual Property* Maiden Edition (2011) 171 164-190.

²² PDA 1970 P2 LFN 2004.

²³ PDA 1970 P2 LFN 2004.

²⁴ PDA 1970 P2 LFN 2004.

²⁵ Section 2(1) PDA 1970 P2 LFN 2004. The PDA does not define statutory inventor or true inventor.

²⁶ Section 2(2) PDA 1970 P2 LFN 2004.

²⁷ Mark J. Davison, Ann L. Monotti & Leanne Wiseman *Australian Intellectual Property Law* Cambridge University Press 2008 p. 482.

This depiction makes it impossible for companies sponsoring research and innovation to be named as inventors, as the law does not allow this provision to be modified by contracts.²⁸ On the other hand, the right to a patented invention created in the course of employment is vested in the employer,²⁹ likewise inventions that result from the execution of a contract for the performance of a specified work vest in the person who commissions the work.³⁰

The patent rights of employee and employer are not balanced in the PDA as it creates a blanket provision. For instance, if the employee's contract does not require inventive activity but he uses his employer's data or means at his disposal, the invention will be regarded as the employer's.³¹ Does the employer still have a patent right if the invention does not relate in any form to the employer's works? In subsection (ii),³² if the invention is of exceptional importance, the inventor will be given a fair remuneration which will depend on his salary and the importance of the invention.³³ Again the employer takes all, as this provision cannot be modified by contract.³⁴ Although the provision gives some form of remuneration to the employee, what is 'exceptional importance' may be relative and may not be determinable immediately³⁵ which gives the employer room to manoeuvre. It is submitted that, since the intent of patent law is to reward the inventor for his efforts, that patent rights should vest in the employee even though he uses the resources of the employer. Adequate compensation should be given to the employer whose resources were used and not the other way round. Clearly, these issues come up due the fact that PDA is over forty years old. In other jurisdictions these issues have been corrected in most legislation and case law relating to such issues is well-defined.

²⁸ Section 2(2) PDA 1970 P2 LFN 2004.

²⁹ This follows the Common Law position where inventions created in the course of employment belongs to the employer. See *Patchet v Sterling* [1955] AC 534.

³⁰ Section 2(4) PDA 1970 P2 LFN 2004.

³¹ Section 2(4) (a) (i) PDA 1970 P2 LFN 2004.

³² Section 2(4) (a) (ii) PDA 1970 P2 LFN 2004.

³³ Section 2 (4) (a) (ii) PDA 1970 P2 LFN 2004.

³⁴ Section 2 (4) (b) PDA 1970 P2 LFN 2004.

³⁵ An invention may not worth anything at the time of invention but may after a few years become a money spinning invention; if the invention was not of any exceptional importance at the time of invention the employee gets nothing even where the invention had nothing to do with the employers business.

The foundation of the Nigerian legal system is based on the United Kingdom law. However, the United Kingdom has since changed its laws on employee/employer statutory rights on patented inventions made in the course of employment.³⁶ Sections 39-43 of the UK Patents Act 1977 relates in detail to employees' inventions. Employees are owners of their invention even if it is made at work, except if the invention arises from an employee's normal duties or duties specifically assigned to him and such invention might reasonably be expected,³⁷ or the invention was made in the course of the duties of the employee and at the time of making the invention because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a 'special obligation' to further the interests of the employer's undertaking.³⁸

6.2.2.2 Requirements for Patentability

The PDA in section 1 provides that a patent may be granted for an invention if it is new,³⁹ results from inventive activity⁴⁰ and is capable of industrial application.⁴¹ In addition, inventions that result from an improvement upon a patented invention which is new, result from inventive activity and are capable of industrial application are patentable.⁴² This provision is one of the hallmarks of the PDA as it is capable of stimulating indigenous invention,⁴³ although it has been underutilised. Remarkably, nowhere in the PDA are inventions defined, so what constitutes an invention is not known or may be subject to

³⁶ The Patents Act 1977 (as amended) an unofficial consolidation produced by Patents Legal Section 1 October 2013.

³⁷ Section 39 (1) (a) UK Patents Act 1977.

³⁸ Section 39 (1) (b) UK Patents Act 1977.

³⁹ 'New' according to the PDA mean an invention is new if it does not form part of the state of the art. ('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) See section 1(2) (a) PDA 1970 P2 LFN 2004.

⁴⁰ Inventive activity according to the PDA must be an invention that 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. See section 1(2) (b) PDA 1970 P2 LFN 2004.

⁴¹ Section 1(1) (a) PDA 1970 P2 LFN 2004.

⁴² Section 1(1) (b) PDA 1970 P2 LFN 2004.

⁴³ Oyewunmi A.O. *Industrial Property Law* Akanki E.O ed. *Commercial Law in Nigeria* University of Lagos Press 2005 p. 45.

known definitions. Inventions and patentability are two distinctly separate concepts⁴⁴ which have been merged together under the PDA. The PDA does not specifically provide that products and processes are patentable, however, section 3 provides that applications may include claims for products and manufacturing processes.⁴⁵

6.2.2.3 Excluded Subject Matter

Under the PDA a number of exceptions to a patentable subject matter are mentioned. Plant or animal varieties, or essentially biological processes for the production of plants or animals are expressly excluded from patent protection, with the exception of microbiological processes and their products.⁴⁶ In addition, inventions contrary to public order or morality are not patentable whether they are prohibited by law or not.⁴⁷ Also, principles and discoveries of a scientific nature are not regarded as inventions under the PDA.⁴⁸

6.2.2.4 Obtaining a Patent

The procedure for granting a patent in Nigeria includes certain formalities which must be complied with. Patent applications require specific features for the application to be processed. All patent applications are to be made to the Registrar, Patents Branch of the Trademarks, Patent and Design Registry.⁴⁹

Under section 3, the patent application should be made in the prescribed format which shall include the applicant's⁵⁰ full name and address,⁵¹ a description of the relevant invention with any appropriate plans and drawings,⁵² a specification,⁵³ a claim or claims⁵⁴ and other matters

⁴⁴ *Novartis AG v Union of India (UOI) and Ors.; Natco Pharma Ltd. v UoI & Ors.; M/S Cancer Patients Aid Association v UoI & Ors.* Citations: Civil Appeal No. 2706-2716 of 2013 para 9.

⁴⁵ Section 3(3) (a) & (b) PDA 1970 P2 LFN 2004.

⁴⁶ Section 1(4) (a) PDA 1970 P2 LFN 2004.

⁴⁷ Section 1(4) (b) PDA 1970 P2 LFN 2004.

⁴⁸ Section 1(5) PDA 1970 P2 LFN 2004.

⁴⁹ Commercial Law Department, Federal Ministry of Trade and Investment in Nigeria Federal Capital Territory, Abuja.

⁵⁰ The applicant can be the true inventor, the statutory inventor or an agent enable with a power of attorney; section 3 (1) (b) (iii) PDA 1970 P2 LFN 2004.

⁵¹ If that address is outside Nigeria, an address for service in Nigeria.

⁵² The PDA states that the description shall disclose the relevant invention in a manner sufficiently clear and complete for the invention to be put into effect by a person skilled in the art or field of knowledge to which the invention relates. Section 3 (2) PDA 1970 P2 LFN 2004; rule 11(c) Patent Rules L.N. 96 of 1971.

as may be specified accompanied by the prescribed fee. A declaration by the true inventor is signed requesting that he be mentioned in the patent where appropriate.⁵⁵ A signed power of attorney or authorisation of the agent is required if the application is made by an agent.⁵⁶

6.2.2.5 Formal Examination

The patent application shall contain only one invention but may include claims for any number of products, manufacturing processes for those products, and applications of those products.⁵⁷ In addition, claims for any number of processes, means of working those processes, the resulting product or products, the application of those products have to be taken into account when considering the patent application for the invention.⁵⁸

A claim as to a priority date in respect of an earlier application made in a country outside Nigeria may be possible only if made not more than three months after the making of the application⁵⁹ with a written declaration attached to the application showing the date and number of the earlier application, the country in which the earlier application was made and the name of the person who made the earlier application.⁶⁰ A certified copy of the earlier applications collected by the industrial property office will be handed over to the Registrar.⁶¹

All patent applications are examined by the registrar as to conformity with section 3 (1), (3) and (4) of the PDA.⁶² Only non-compliance with section 3 (1) brings about an outright rejection of the application,⁶³ other requirements may be addressed by inviting and notifying the applicant to make appropriate corrections, failing which the application will be rejected.⁶⁴

⁵³ The specification shall describe the relevant invention in a manner sufficiently clear and complete for the invention to be put into effect by a person skilled in the art or field of knowledge to which the invention relates. Rule 12 (1) Patent Rules L.N. 96 of 1971.

⁵⁴ Claims are required to define the protection sought and shall not go beyond the limits of the said description. See Section 3 (2) PDA 1970 P2 LFN 2004 and rule 12(2) Patent Rule L.N. 96 of 1971.

⁵⁵ Section 3 (1) (b) (ii) PDA 1970 P2 LFN 2004.

⁵⁶ Section 3 (1) (b) (iii) PDA 1970 P2 LFN 2004. See also rule 11 (e) Patent Rules L.N. 96 of 1971.

⁵⁷ Section 3 (3) (a) PDA 1970 P2 LFN 2004.

⁵⁸ Section 3 (3) (b) PDA 1970 P2 LFN 2004.

⁵⁹ Section 3 (4) (b) PDA 1970 P2 LFN 2004.

⁶⁰ Section 3 (4) PDA 1970 P2 LFN 2004.

⁶¹ Section 3 (4) (b) PDA 1970 P2 LFN 2004.

⁶² Rule 11(e) Patent Rules L.N. 96 of 1971.

⁶³ Section 4 (1) (a) PDA 1970 P2 LFN 2004.

⁶⁴ Section 4 (1) (b) PDA 1970 P2 LFN 2004.

If a claim for foreign priority has not been complied with it will be disregarded. Unfortunately, where all the requirements have been met the patent is granted without further examination as to whether it is patentable, the description and claims meet the definition according to section 3(2) or if there has been a prior application benefiting from foreign priority made in Nigeria in respect of the same invention and whether the patent has been granted as a result of such an application.⁶⁵ In essence, there is no substantive examination of patent applications, administrative requirements alone are required to be met for patents to be granted.⁶⁶ This method of examination is not limited to Nigeria alone, other countries, like South Africa, have examination of patent application as a formality as well.⁶⁷ Patents in Nigeria are granted at the risk of the patentee and without guarantee of their validity.⁶⁸ The system is set up merely to give the applicant a letter and record his name in a register.

A lack of expertise and facilities has been proffered as reasons for the present state of affairs.⁶⁹ However, these explanations may not be totally correct as examination of the applications can be carried out by outsourcing on behalf of the country.⁷⁰ The lack of an inventive culture has kept the law where it is for so long: if there were a community of inventors in Nigeria there would have been an outcry to reform the law.⁷¹ The few inventors there are prefer to have their inventions patented in the US or elsewhere. Inadequate infrastructure to enable research and development has resulted in very low turnout of inventions and even improvements on inventions.

⁶⁵ Section 4 (1) (b) PDA 1970 P2 LFN 2004.

⁶⁶ See generally Ikechi Mgbogji 'African Patent Offices Not fit for Purpose' in Jeremy de Beer, Chris Armstrong, Chidi Oguamanam and Tobias Schonwetter innovation and Intellectual Property collaborative Dynamics in Africa University of Cape Town Press Claremont 2014 p.234

⁶⁷ However, there is a major difference in the provisions of the South African Patent Act and the Nigerian Patent Act, in that the South African Patent Act categorically states that the specification of the application must comply with the requirements of this Act. See section 34 South African Patent Act 57 of 1978 compare with section 4 (1) (a) PDA 1970 P2 LFN 2004.

⁶⁸ Section 4 (4) PDA 1970 P2 LFN 2004.

⁶⁹ Folarin Shyllon *Intellectual property Law in Nigeria*. Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, 2003 p.147.

⁷⁰ Singapore and United Arab Emirate outsource patent search and examination.

⁷¹ The outcry for better copyright protection in the late 1980s was as a result of performing artists needing better protection for their works this has not been the case for inventors.

6.2.2.6 Grant

After the grant of patent, a document is issued to the patentee containing the number of the patent, name and address of the patentee, dates of the patent application⁷² and, where the grant is based on foreign priority claim, an indication of the fact and the number and date of the application and the name of the country where the application was made.⁷³ Also, the description of the invention, including the particulars of the true inventor where appropriate will be in the patent document. A register of duplicate copies of the patent document is kept by the Registrar⁷⁴ and a notice of the patent granted is published, stating the name of the true inventor.⁷⁵

The right conferred on the patentee is a right to prevent other persons from making, importing, selling or using a product, or stocking it for the purpose of sale or use where the grant is for a product patents. However, rights in relation to a process patent include any act of applying the process or doing, in respect of a product obtained directly by means of the process as well as making, importing, selling or using the product, or stocking it for the purpose of sale or use.⁷⁶

What is protected by the patent is limited to the terms of the claims and the description included in the patent which shall be used to interpret the claims.⁷⁷ The scope of protection covers only what has been claimed in the patent application and cannot be extended to claims that are not in the application.⁷⁸ The PDA, however, provides in section 6 (3) that the rights granted by a patent extends only to acts done for industrial or commercial purposes⁷⁹ and such rights shall not include acts done on a product covered by the patent after the product

⁷² Section 5 (1) PDA 1970 P2 LFN 2004; rule15 Patent Rules L.N. 96 of 1971.

⁷³ Section 5 (1) (d) PDA 1970 P2 LFN 2004.

⁷⁴ Section 5 (2) PDA 1970 P2 LFN 2004.

⁷⁵ Section 5 (3) PDA 1970 P2 LFN 2004; rule16 Patent Rules L.N. 96 of 1971.

⁷⁶ Section 6 (1) PDA 1970 P2 LFN 2004.

⁷⁷ Section 6 (2) PDA 1970 P2 LFN 2004.

⁷⁸ Section 6 (2) PDA 1970 P2 LFN 2004.

⁷⁹ Section 6 (3) (a) PDA 1970 P2 LFN 2004.

has been lawfully sold in Nigeria except the patentee has made special application for the product, in which case it would be reserved.⁸⁰

6.2.2.7 Priority

Section 6 (4) on the issue of patent rights based on a foreign priority is a curiously worded provision:

Where, at the date of the filing of a patent application in respect of a product or process or at the date of a foreign priority validly claimed in respect of the application, a person other than the applicant-

(a) was conducting an undertaking in Nigeria; and

(b) in good faith and for the purposes of the undertaking, was manufacturing the product or applying the process or had made serious preparations with a view to doing so, then, notwithstanding the grant of a patent, there shall exist a right (exercisable by the person for the time being conducting the undertaking, and not otherwise) to continue the manufacture or application, or to continue and complete the preparations and thereafter undertake the manufacture or application, as the case may be, and in respect of any resulting products to do any other act mentioned in subsection (1) of this section.

The section 6 (4) provision is overreaching in its intent to protect indigenous inventions against competing foreign inventions. At the time the PDA was enacted, Nigeria, as a new nation, was eager to protect its own people who had to compete with foreigners who had better infrastructure and technical know-how. This provision was necessary in the 70s to encourage Nigerian inventors once they have made serious preparations. However, it seems to have worked against encouraging foreign patent applications and investment in technology and has been made worse by the Nigerian Enterprises Promotion Act.⁸¹

The provision has been questioned as it conflicts with other provisions⁸² of the PDA in that it negates the provision on newness and obviousness.⁸³ Once a product is manufactured it can no longer be regarded as new, therefore no patent should be granted. However, if serious preparations are still being made for such as experimental use, then this provision may apply to the benefit of the Nigerian inventor where the foreign inventor claims a foreign priority

⁸⁰ Section 6 (3) (b) PDA 1970 P2 LFN 2004.

⁸¹ Nigerian Enterprises Promotion Act No 4 of 1972.

⁸² Section 1 (1) and section 9 especially subsection 9 (1) (2) (c) PDA 1970 P2 LFN 2004; Section 17 Patent Rules L.N. 96 of 1971. See also *Janssen Pharmaceutical M.V. v Registrar of Patent and Designs* (1991) 3 NWLR 116

⁸³ Oyewunmi A.O. *Industrial Property Law* p. 467-8.

date. It seems that the first inventor would not be impeded by this provision as the PDA grants patents to the first to file, but there would be a concurrent user with the same rights conferred as on the patentee.

With regards to international obligations, as in the case of trade marks, a ministerial declaration by an order in the Federal Gazette has to be made for treaty, convention and international obligations to be enforceable in Nigeria.⁸⁴ The declaration is to contain the countries with which Nigeria has treaty obligations. Without such an order a foreign priority cannot be claimed. Curiously, unlike for trade marks, a ministerial declaration was passed in 1971 in which the Paris Convention countries were listed.⁸⁵ Notably, the declaration came into force at the same time the PDA and the Patent Rules came into force.⁸⁶ there has been no update of the declaration.

6.2.2.8 Term of Protection of Patent

As in many other countries,⁸⁷ the PDA provides a twenty year term of protection from the date of the filing of the patent application.⁸⁸ Patents are required to be renewed annually failing which they lapse. However, a grace period of six months is set to allow payment of such fees with a surcharge for late payment.⁸⁹ The issue of payment of an annual fee will be entertained only after the grant of the patent, as stated in *Pfizer Inc. v Ployking Pharmaceutical Ltd & Another*.⁹⁰ Also, when the patent expires or lapse, notice shall be given of such and that shall be registered.⁹¹

6.2.2.9 Surrender of Patent

A patentee may surrender a patent by a declaration in writing directed to the registrar:⁹² this surrender may pertain to all or any of the claims made by the patent. Such surrender must be

⁸⁴ Section 27 (1) PDA 1970 P2 LFN 2004.

⁸⁵ Patents and Designs (Convention Countries) Order of 1971

⁸⁶ 1st December 1971.

⁸⁷ Germany, Switzerland, United Kingdom and United States.

⁸⁸ Section 7 (1) PDA 1970 P2 LFN 2004 and section 18 Patent Rules L.N. 96 of 1971.

⁸⁹ Section 7 (2) PDA 1970 P2 LFN 2004.

⁹⁰ (1997-2003) 4 I.P.L.R 215 1998 F.H.C. 1.1.

⁹¹ Section 7 (3) PDA 1970 P2 LFN 2004.

⁹² Section 8 (1) PDA 1970 P2 LFN 2004.

registered and the consent of any licensees regarding the patent needs to be obtained where there is a registered contractual licence or licences.⁹³

6.2.2.10 Revocation

A patent may be declared null and void if any of the patentability requirements are not met.⁹⁴ The declaration may be made by any person, including a public officer of the court. Furthermore, if the description or the claim of the invention does not conform to section 3 (2) of the Act or if the same invention has been granted in Nigeria as the result of a prior application or an application benefiting from an earlier foreign priority the patent can be revoked. Whether section 6 (4) of the Act, by allowing the exploitation of a product or process where serious reparations have been made as well as manufacturing the product, complies with the patentability requirement or will be ineffective, thereby rendering it null and void, is yet to be decided in the court.⁹⁵ The nullification of the patents may apply to the whole patent or to a particular claim or claims.⁹⁶

If the application is granted and a declaration made, the patent will be deemed null and void from the date the application was granted and the declaration shall be registered and notice given of the declaration.⁹⁷

6.2.2.11 Transmission of Patent Rights

Patents are transmissible under the PDA as licenses, assignment and transferred by succession: offering several ways the patentee can exploit the invention within the limited period given.⁹⁸

Assignment is a common mode of exploiting an invention. The patentee may assign his interest in the patent to another person by way of sale or transfer by succession. An assignment is a transfer of rights and gives the assignee the same rights as the patentee: it

⁹³ Section 8 (2) PDA 1970 P2 LFN 2004.

⁹⁴ Section 9 (1) PDA 1970 P2 LFN 2004.

⁹⁵ Section 9 (2) PDA 1970 P2 LFN 2004.

⁹⁶ Section 9 (2) PDA 1970 P2 LFN 2004.

⁹⁷ Section 9 (4) PDA 1970 P2 LFN 2004.

⁹⁸ Section 24 PDA 1970 P2 LFN 2004.

may be an assignment of the application or the patent itself.⁹⁹ Such an assignment must be in writing and signed by the parties.¹⁰⁰ In addition, assignments are required to be registered and the prescribed fee paid until this is done the assignment shall have no effect against third parties. In *Arewa Textiles Plc and others v Finetex Ltd*, the Court of Appeal held that ‘the right to apply for letters patent in respect of an invention by an assignee under his own name is not a mere moral adjuration. It is a duty under section 24 (1) of the Act, to register assignment, transfer or interest held in joint ownership of a patent.’ The court further held in the absence of such evidence, that the respondent’s (Arewa Textile) cause of action is inchoate and has no effect.

One of the foremost ways in which patents are exploited is by licencing, which may be voluntary, contractual or compulsory. It may also be an exclusive or a non-exclusive licence which may be express or implied. An exclusive license is if the patent holder grants patent rights to a sole party, thereby excluding others. This type of license may be limited to a particular geographical area or to a specific market.¹⁰¹ A non-exclusive licence, on the other hand, entails the granting of patent rights to several licensees without giving exclusivity to any.¹⁰² These licenses however, are contractual agreements and the terms and conditions depend on the parties involved.

A licence, unlike assignment, grants permission to the user. Accordingly rights given may vary or even overlap depending on the nature of the licence. Under section 10 of the PDA a patentee can apply to the registrar for a licence of right to be registered in respect of his patent. This licence is initiated voluntarily by the patentee. Where an entry of such registration is made, licence of right will be entered in the register and notice of it will be given accordingly.¹⁰³ After such registration any person shall have the right to obtain a licence from the patentee to exploit the patent on agreed terms. If an agreement is not

⁹⁹ Section 24 (1) PDA 1970 P2 LFN 2004.

¹⁰⁰ Section 24 (2) PDA 1970 P2 LFN 2004.

¹⁰¹ John T. Pienkos *The Patent Guidebook* American Book Publishing American Bar Association Chicago 2004 p. 27.

¹⁰² William J. Murphy, John L. Orcutt, Paul C. Remus *Patent Valuation: Improving Decision Making through Analysis* Wiley Publishers New Jersey 2012 p.37.

¹⁰³ Section 10 (1) PDA 1970 P2 LFN 2004.

reached between that person and the patentee, the court shall fix the terms. All fees payable in respect of the patent by the patentee shall be reduced by half.¹⁰⁴ However, if the licence of right is cancelled by the patentee all annual or other fees, which would have been payable if the entry had never been made, will be paid in full.¹⁰⁵

Another form of licencing under the PDA is a contractual license in which the patentee enters into a contract to grant a licence to any person to exploit the invention. Joint owners may exploit their own share of the invention separately. However, it must be jointly licensed.¹⁰⁶ The licence must be in writing and signed by the parties.¹⁰⁷ Importantly, the contractual licence must be registered and all prescribed fees paid to be effective against third parties.¹⁰⁸ A licence may be declared null and void if the contract imposes industrial or commercial field restrictions which do not derive from the rights conferred by the patent.¹⁰⁹

A compulsory license, as the name suggests, is imposed on the patentee.¹¹⁰ Although imposed on the patentee, certain conditions have to be met for the license to be effective. Subject to the first schedule of the PDA compulsory licences may be applied only after a period of four years from the filing of a patent application or after three years from the date of grant.¹¹¹ The compulsory licence will be granted if the required grounds are met. Some of the required grounds include:

- i. the patented invention has not been worked in Nigeria,
- ii. that the existing degree of working of the invention does not meet on reasonable terms the demand for the product in Nigeria
- iii. the working of the patented invention in Nigeria is being hindered or prevented by the importation of the patented article and

¹⁰⁴ Section 10 (2) PDA 1970 P2 LFN 2004.

¹⁰⁵ Section 10 (3) PDA 1970 P2 LFN 2004; For cancellation no licences may have been granted or all the grantees agree to the cancellation.

¹⁰⁶ Section 24 (4) PDA 1970 P2 LFN 2004.

¹⁰⁷ Section 23 (1) PDA 1970 P2 LFN 2004.

¹⁰⁸ Section 23 (2) (a) PDA 1970 P2 LFN 2004.

¹⁰⁹ Section 23 (3) PDA 1970 P2 LFN 2004.

¹¹⁰ Lionel Bentley and Brad Sherman *Intellectual Property Law* Oxford University Press Oxford 2002 p. 519.

¹¹¹ Para. 1 (First Schedule PDA 1970 P2 LFN 2004.

- iv. by reason of the refusal of the patentee to grant licences on reasonable terms, the establishment or development of industrial or commercial activities in Nigeria is unfairly and substantially prejudiced.¹¹²

A compulsory licence may be granted to the patentee of a later patent if an invention, patented in Nigeria, cannot be worked without infringing the rights of an earlier patentee to the extent necessary for the working of the later invention. If it serves an industrial purpose different from that served by the earlier patent or if it constitutes substantial technical progress.¹¹³ However, if the inventions serve the same industrial purpose, a cross compulsory licence may be issued to the earlier patentee and the later patentee.¹¹⁴

The compulsory license is decided by the court.¹¹⁵ Compulsory licences may be granted before the expiration of four years after the filing of a patent application or three years after the grant of a patent¹¹⁶ for certain patented products and processes declared by the Minister by an order in the Federal Gazette to be of vital importance for the defence or the economy of Nigeria or for public health.¹¹⁷

The PDA also provides for government use, which is a special type of compulsory licence. It gives the minister the power to authorise any person to purchase, make, exercise or vend any patented article or invention for the service of a government agency in the Federal Republic provided the minister is satisfied that it is in the interest of the public¹¹⁸ and during a period of emergency.¹¹⁹ This power relates only to uses in the interest of the public or in times of emergency, saving which, the state will be bound by the same laws and which will have the same effect as against individuals.¹²⁰

¹¹² Para. 1 (a) - (d) First Schedule PDA 1970 P2 LFN 2004.

¹¹³ Para. 2 First Schedule PDA 1970 P2 LFN 2004.

¹¹⁴ Para. 3 First Schedule PDA 1970 P2 LFN 2004.

¹¹⁵ Para 1 First Schedule PDA 1970 P2 LFN 2004.

¹¹⁶ See Para 1 First Schedule PDA 1970 P2 LFN 2004.

¹¹⁷ Para 13 First Schedule PDA 1970 P2 LFN 2004.

¹¹⁸ Para 15 First Schedule Part II PDA 1970 P2 LFN 2004.

¹¹⁹ Para 20 First Schedule Part II PDA 1970 P2 LFN 2004

¹²⁰ Section 29 PDA 1970 P2 LFN 2004.

6.2.2.12 Jurisdiction

The Federal High Court has jurisdiction to hear and dispose of all legal proceedings under the PDA.¹²¹ The court may sit with and be advised by two assessors having expert knowledge of matters of a technological or economic nature,¹²² and all procedural rules must be followed.¹²³

6.2.2.13 International Arrangement of Patent Protection

The PDA provides for international arrangements or agreements, to which Nigeria is a party. However, the minister must declare, by an order in a Federal Gazette, that any country specified in the order is a Convention country and therefore, may benefit from protection under the PDA.¹²⁴ The provision is to enable a Convention country to benefit from earlier applications made within twelve months of registration in other Convention countries.¹²⁵ In addition, as a WIPO member of the Patent Cooperation Treaty (PCT),¹²⁶ national phase applications can be filed.¹²⁷

6.2.2.14 Administration

The Patent Office is housed in the Trademarks, Patents and Designs Registry, Federal Ministry of Trade and Investment. Section 30 vests authority in the minister (now Minister for Trade and Investment)¹²⁸ to make rules regulating registration, administration and the procedural regulations necessary or expedient to facilitate the operation of the PDA. In addition, rules establishing schemes to encourage inventive activity can be embarked on by the Minister of Industries.¹²⁹

¹²¹ Section 26 (1) PDA 1970 P2 LFN 2004.

¹²² Section 26 (2) PDA 1970 P2 LFN 2004.

¹²³ Section 26 (3) PDA 1970 P2 LFN 2004.

¹²⁴ Section 27 (1) PDA 1970 P2 LFN 2004.

¹²⁵ Section 27 (2) (a) PDA 1970 P2 LFN 2004.

¹²⁶ The World Intellectual Property Organization (WIPO) manages the PCT which is an international treaty between 140 Members of the Paris Convention countries. The PCT creates an avenue for patents to protect the inventions in a large number of countries simultaneously with a single international patent application without having to fill in several countries.

¹²⁷ Nigeria in 2003 signed the PCT and deposited its instrument of accession at the World Intellectual Property Organization (WIPO) Office in 2005.

¹²⁸ Formerly Minister meant Minister for Trade and Tourism. Section 32 (1) PDA 1970 P2 LFN 2004.

¹²⁹ Section 30 (2) PDA 1970 P2 LFN 2004. This provision has been ignored by Ministers over the years.

6.2.3. National Office Technology Acquisition and Promotion Act

The National Office of Technology Acquisition and Promotion (NOTAP) Act¹³⁰ was specifically enacted in 1979 ‘to monitor, on a continuing basis, the transfer of foreign technology to Nigeria’. At that time it was known as the National Office of Industrial Property (NIOP);¹³¹ the name was changed in 1992 to the National Office of Technology Acquisition and Promotion (NOTAP) to reflect its operations. The NOTAP Act established the National Office of Technology Acquisition and Promotion (NOTAP) to carry out certain functions that promote a more efficient process of identification and selection of foreign technology, as well as the adaptation of imported technology.¹³² The NOTAP office also helps with the development of negotiating skills to acquire the best contractual terms and conditions for Nigerian parties and for the registration of all contracts or agreements having effect in Nigeria.

Technology transfer is a vital aspect for developing a strong technological base necessary for economic growth. Access to technology transfer has been underscored as an approach of achieving indigenous inventiveness.¹³³ For this reason, NOTAP is significant, as it renders services which include preparation of technology transfer agreements, intellectual property right promotion and provision of the state of the art technology information, commercialisation of research and development results, research-industry linkage, monitoring, consultancy and extension services and technology advisory services.¹³⁴

In addition, NOTAP assists indigenous inventors, such as in government funded Research Institutes¹³⁵ and the private sector, with filing patent applications as well as evaluating the

¹³⁰ National Office Technology Acquisition and Promotion Act 1979 No. 70 Cap N62 (Vol. 11) Laws of Federation of Nigeria 2004.

¹³¹ National Office of Industrial Property Act 1990 (Vol XVII) Cap 268 Law of the Nigerian Federation 1990. See also National Office of Industrial Property (Change of name, etc.) Decree 1992 Cap 82 Law of the Nigerian Federation 1990.

¹³² Section 4 NOTAP Act 1979 Cap N62 LFN 2004.

¹³³ Adejoke Oyewunmi, The Patent System and Transfer of Technology in Nigeria Olanrewaju Fagbaohun and Bambo Adewopo (ed.). *Developments and Reform, Nigeria's Commercial Law s Essays in honour of Chief Dr Chris Ogunbanjo* The Law Center LASU Lagos, 1998, 78-92 p.79.

¹³⁴ NOTAP website <http://notap.gov.ng/content/technology-transfers> accessed 09 September 2013.

¹³⁵ NOTAP website <http://notap.gov.ng/content/our-services> accessed 09 September 2013.

compliance of the invention with the PDA requirement¹³⁶ by conducting a state-of-the-art search on inventions to be patented and the procedure for drafting appropriate patent specifications to facilitate the filing and processing of the application for a patent.

Between 1999 and 2010, one thousand two hundred and thirty seven (1237) technology agreements have been registered with NOTAP.¹³⁷ NOTAP has also established thirty (30) Intellectual Property and Technology Transfer Offices (IPTTOs) in some Nigerian Universities, Polytechnics and Research Institutes for the promotion, interaction and to strengthen the linkage between university/research institutions and industries. Specifically, the IPTTO system is designed to develop a robust intellectual property rights portfolio through patenting, copyright and technology licensing to support the institution's initiative in developing a patent culture. The system also establishes a formal system of incentives and rewards that is meant to encourage individual researchers to be involved in partnerships with the private sector.¹³⁸

In conjunction with WIPO, in 1991 NOTAP established a Patent Information and Documentation Centre (PIDC). The PIDC is a computerised databank with access to patent information available globally.¹³⁹ The objective and the role of PIDC is to provide access to technological information in patent documents in a manner suited to the needs of the users.

NOTAP has been of immense help to small and medium enterprises (SMEs) in patenting their inventions.¹⁴⁰

¹³⁶ Patenting Inventions through NOTAP, NOTAP website <http://notap.gov.ng/content/technology-transfers> accessed 09 September 2013.

¹³⁷ Data collected from the NOTAP website <http://notap.gov.ng/content/technology-transfers> accessed 09 September 2013.

¹³⁸ Establishment of IPTTOs available at <http://www.notap.gov.ng/content/establishment-ipttos> accessed 09 September 2013.

¹³⁹ Assisting SMEs to Make Effective Use of Patent Information: The NOTAP Case available at http://www.wipo.int/sme/en/best_practices/notap.htm accessed 09 September 2013.

¹⁴⁰ 15 SMEs/local inventors have been assisted to patent their inventions Assisting SMEs to Make Effective Use of Patent Information: The NOTAP Case available at http://www.wipo.int/sme/en/best_practices/notap.htm accessed 09 September 2013.

6.2.4 Recent Development in Patent Law

In 2006, there was an attempt to reform industrial property laws in Nigeria. The process culminated in a Bill, fashioned to reflect the current lacuna in the law. The Bill was to establish an Intellectual Property Commission of Nigeria and at the same time repeal the Trade Marks Act and Patents and Designs Act and to make comprehensive provisions for the registration and protection of trade marks, patents and designs, plant varieties, animal breeders and farmers rights and for other related matters.¹⁴¹

The patent part of the bill attempted to revise the law to deal with the many issue that are currently been debated internationally or have been debated if there is no provision for those issues under the PDA. Starting at the first section¹⁴² of Part C, which relates to patents in the Bill, there are obvious changes in relation to public use and to subject matter excluded from patenting in the PDA.

Section 105 (4)¹⁴³ is a new insertion which exempts official or officially recognised international exhibition as public use if the exhibition is within six months of filing the application.¹⁴⁴ Also, more exceptions have been added to the paragraph on subject matters for which a patent cannot be obtained, which expressly includes diagnostic, therapeutic and surgical methods for the treatment of humans or animals, section 105 (5) (c)¹⁴⁵ not only states that inventions, the publication or exploitation of which will be contrary to public order or morality, are not patentable but that ‘inventions, the publication or exploitation of which are contrary to public order or morality and the protection of human, animal or plant life or health or which are likely to be seriously prejudicial to the environment, are not patentable.’¹⁴⁶

¹⁴¹ The bill is formerly called the An Act to Provide for the Establishment of the Intellectual 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 Registration and Protection of Trademarks, Patents and Designs, Plant Varieties, Animal Breeders and Farmers Rights and for other Related Matters.

¹⁴² Section 105 IPCOM Bill 2006.

¹⁴³ IPCOM Bill 2006.

¹⁴⁴ This provision is not new to the PDA as a similar provision exist in section 13 (4) PDA in relation to industrial design however no such provision exist for patent.

¹⁴⁵ IPCOM Bill 2006.

¹⁴⁶ See Article 27 (2) TRIPS Agreement.

The provision on the right of patent of an employee/employer remains the same. Ownership of intellectual property, especially patents is a major issue and cannot be dealt with in two paragraphs.¹⁴⁷ The Bill provides for applications still to be made to the registrar, instead of the Patent office, who, in a sense personifies the office.¹⁴⁸

Section 109,¹⁴⁹ which relates to patent application, was reviewed and the facility for patenting any number of products and manufacturing processes is no longer available. The Bill still does not make provision for substantive examination¹⁵⁰ and maintains that patents are granted at the risk of the patentee and without guarantee of their validity.¹⁵¹ This provision is surprising the same Bill mandates the IP commission to maintain an effective intellectual property documentation and information centre.¹⁵²

Exceptions from patentability were well-highlighted in comparison with the current PDA.¹⁵³ A whole range of exceptions that are vital for encouraging innovations and the development of technology are included, such as private and non-commercial use, scientific research and, experimental uses, teaching purposes and individual prescription.¹⁵⁴ Other requirements include early working of an invention for development, the submission of information required for the manufacture, construction¹⁵⁵ and use of any product, including provisions on the international exhaustion of patent rights.¹⁵⁶

Another new aspect which the Bill introduces is the protection of undisclosed tests or data against unfair commercial use,¹⁵⁷ which replicates article 39.3 of the TRIPS Agreement. The

¹⁴⁷ Section 106 (5-7) IPCOM Bill 2008.

¹⁴⁸ Section 107 IPCOM Bill 2008.

¹⁴⁹ This section is equivalent to section 3 PDA 1970 P2 LFN 2004.

¹⁵⁰ Section 110 (1-2) IPCOM Bill 2008.

¹⁵¹ Section 110 (4) IPCOM Bill 2008.

¹⁵² Section 4 (g) IPCOM Bill 2008.

¹⁵³ Section 6(4) PDA 1970 P2 LFN 2004.

¹⁵⁴ Section 112 (3) (a) – (d) IPCOM Bill 2008.

¹⁵⁵ Known as the Bolar Exception.

¹⁵⁶ Section 112 (3) (e) & (f) IPCOM Bill 2008. This section is different from section 6(3) PDA which provides for national exhaustion.

¹⁵⁷ Section 113 IPCOM Bill 2008.

international treaties to which Nigeria adheres shall apply to matters dealt with by this Bill without the need for a ministerial declaration.¹⁵⁸

The Second Schedule of the Bill provides for ‘Compulsory licences for the Exportation or Importation of Pharmaceutical Products’, thereby implementing the ‘Paragraph 6 system’, which is an amendment to the TRIPS Agreement.¹⁵⁹ The Second Schedule outlines the process as stated under article 31b, covering both sets of circumstances in which Nigeria is either an importer or exporter of pharmaceutical products.¹⁶⁰

Although the Bill is an advance on what exists in the PDA, generally, it lacks proper structuring and does not have a comprehensive interpretation section, leaving many terminologies to the discretion of the user.¹⁶¹ The Bill, which was presented to the National Assembly in 2008 is still an ongoing process. Recently, the Bill was said to have been divided. The IPCOM has a separate Bill and the intellectual property laws are in a separate bill.¹⁶² However, no Bill relating to intellectual property in any form or manner is before the National Assembly.¹⁶³ These reforms are only suggestions for amending the law: they have not yet been brought to fruition and currently are not under consideration.

6.3 Patents: Compliance

This section looks at the Patent and Design Act and the TRIPS Agreement in relation to international practices and obligations and determines if the PDA is in compliance with the TRIPS Agreement or not. Suggestions for modification of the Act that will protect the

¹⁵⁸ Section 133 IPCOM Bill 2008. This is unlike section 27 PDA where the Minister has to make a declaration in a Federal gazette on the matter. This provision may however conflict with the Constitution of the Federal Republic of Nigeria which provides that all international agreements or arrangement must be domesticated for it to be justiciable in Nigeria. Section 12 of the Constitution of the Federal Republic of Nigeria.

¹⁵⁹ Article 31 (b) TRIPS Agreement.

¹⁶⁰ Cecilia Oh, *Domestic Legislation and Court Decisions on Intellectual Property Rights and Public Health in Nigeria* UNCTAD p.8.

¹⁶¹ The Bill still left out what the definition of an invention.

¹⁶² Communique issued following ACC INTA Round table held in Lagos on the 15th of November 2012 available at <http://anticounterfeiting.com.ng/site/wp-content/uploads/2012/12/Communique-Roundtable2012.pdf> accessed 24 September 2013.

¹⁶³ The National Assembly Federal Republic of Nigeria available at <http://www.nassnig.org/nass2/legislation.php> accessed 24 September 2013.

national and public interest as well as encourage inventions will be given in later sections of this chapter.

As stated in previous chapters, the TRIPS Agreement adopted the various intellectual property Conventions, which include the Paris Convention which comprises provisions on patent protection. Prior to comparing the scope of protection under the Patent and Design Act and the TRIPS Agreement, it is advantageous to examine the Paris Convention for a better understanding to provide a thorough assessment of the impact of the TRIPS Agreement. The aim of examining the relationship between the Paris Convention and the TRIPS Agreement is to highlight provisions that relate to patents which may come up in later discussions in the chapter.

6.3.1 Relationship of the TRIPS Agreement to the Paris Convention and Patent Protection

Article 2.1 states that members shall comply with Articles 1 through 12 and article 19, of the Paris Convention, accordingly members are obligated to conform to these provisions. The particular articles that relate to patent are articles 4 to *5quater*. Unlike the provisions on copyrights and trade marks, which are very much similar to what is in the Convention, the provision on patents created new provisions that were not specifically provided for in the Paris Convention and were left for countries to decide how they are to be protected. As noted in chapter 5 these provisions were carefully selected as they are the material provision in relation to patent protection in the Paris Convention.

As expected, members are required to treat other nationals in the same way it treats its own nationals with regard to intellectual property protected under the Paris Convention. The protection of patents was in the fore-front of intellectual property issues during the Uruguay Round, which was central to the objective of moving intellectual property matters from WIPO to WTO.

6.3.2 Article 27: Patentable Subject Matter

Patentable subject matter consists of the subject matter which is permissible under the patent law as protectable. Conflict and uncertainty surround the issue of what ought to be patented or not.¹⁶⁴ There are certain conditions that have to be fulfilled for an invention to be patentable. As stated earlier pursuant to the PDA, an invention is patentable if it is new, results from inventive activity and is capable of industrial application, or if it constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.¹⁶⁵ The requirement for patent protection is similar to article 27.1 of the TRIPS Agreement. However, the PDA does not expressly mention products and processes in section 1 on patentable inventions: the PDA merely refers to products and processes in relation to patent applications.¹⁶⁶ Protection of product patents is a source of concern for industrialised countries and they have continuously pushed for the protection of all products and process that meet the requirement for patenting.¹⁶⁷ The protection of product patent that particularly relates to pharmaceutical products could not be patented in many countries¹⁶⁸ till the second half of the last century.¹⁶⁹ However, the PDA does not limit patents to particular fields of technology: in essence all fields of technology can be patented under the PDA except for specific exemptions.

Pharmaceutical patents, or the patenting of medicine, have been a controversial issue under the TRIPS Agreement. Patented medicines are a multi-billion dollar industry highly protected by industrialised countries. Over the years there have been many arguments for and against the protection of medicines. Right holders, such as pharmaceutical companies, claim to have invested resource on R&D and, therefore, need to recoup such investments;¹⁷⁰

¹⁶⁴ Bently and Sherman *Intellectual Property Law* Oxford University Press UK 2002 p. 362.

¹⁶⁵ Section 1 (1) (a) and (b) PDA 1970 P2 LFN 2004.

¹⁶⁶ Section 3 (3) (a) and (b) PDA 1970 P2 LFN 2004.

¹⁶⁷ Julio Nogués, 'Patents and Pharmaceutical Drugs: Understanding the Pressures on Developing Countries' (1990) 24 *Journal of World Trade*, Issue 6, pp. 81–104 p. 83.

¹⁶⁸ Germany France Italy Japan Sweden Switzerland.

¹⁶⁹ Michele Boldrin and David Levine *Against Intellectual Monopoly* Cambridge University Press New York 2008 chapter 9 p. 3-5 <http://levine.sscnet.ucla.edu/papers/ip.ch.9.m1004.pdf> 30 September 2013.

¹⁷⁰ Chandra Nath Saha and Sanjib Bhattacharya *Intellectual property rights: An overview and implications in pharmaceutical industry Journal of Advance Pharmaceutical Technology & Research*. 2011 Apr-Jun; 2(2): 88–93.p.90.

consumers claim such patents are detrimental to their right to health and that patents kill.¹⁷¹ Product patents may be allowed, but it must be borne in mind that drugs are manufactured to save life or to assist in prolonging life or to cure a particular disease.

A major problem that arises out of product patent protection is the prevention of competition by generic products: brand-name companies refuse to grant licenses and attempt to extend the life of the patent.¹⁷² The process of extending the life of patents is known as the evergreen patent system or ever greening, which is a strategy used to apply for ‘secondary patents over related or derivative technologies’.¹⁷³ The strategy has been the subject of litigation in developing countries: a recent case in India is *Novartis AG v Union of India (UOI)*.¹⁷⁴ Novartis sought to patent an updated version of an existing cancer drug called Imatinib, a therapeutic drug for chronic myeloid leukemia and certain kinds of tumours, marketed under the names ‘Glivec’ or ‘Gleevec’. Jürg Zimmermann invented a number of derivatives of N-phenyl-2- pyrimidine amine, one of which is CGP 571481 in a free base form (later given the International Nonproprietary Name ‘Imatinib’ by the World Health Organisation). These derivatives, including Imatinib2, are capable of inhibiting certain protein kinases, especially protein kinase C and PDGF (platelet-derived growth factor)-receptor tyrosine kinase and have valuable anti-tumour properties. They can be used in the preparation of pharmaceutical compositions for the treatment of warm-blooded animals, for example, as anti-tumoral drugs and as drugs against atherosclerosis. The N-phenyl-2-pyrimidine-amine derivatives, including Imatinib, were submitted for patent in the US.

¹⁷¹ See Ruth Mayne, ‘The Global Campaign on Patents and Access to Medicines: An Oxfam Perspective’, in Peter Drahos and Ruth Mayne (Eds), *Global Intellectual Property Rights: Knowledge Access and Development*, MacMillan Press, UK, 2002, Chp. 15. Me’decins Sans Frontie`res (2003) ‘Trading health away: Intellectual property and access to medicines in the Free Trade Area of the America’s (FTAA) Agreement’, New York, September. Available at: [http:// www.doctorswithoutborders.org/publications/reports/2003/FTAA_Advocacy.pdf](http://www.doctorswithoutborders.org/publications/reports/2003/FTAA_Advocacy.pdf). 30 September 2013.

¹⁷² Robert Weissman *Victory and Betrayal: The Evergreen Patent System of Pharmaceutical Company Tactics to Extend Patent Protections* Multinational Monitor JUN 2002 VOL 23 No. 6 <http://www.multinationalmonitor.org/mm2002/062002/weissman.html> 30 September 2013

¹⁷³ Robert Chalmers *Evergreen Or Deciduous? Australian Trends in Relation to the ‘Evergreening’ of Patents* Melbourne University Law Review [Vol 30 2006] pp 29-61 p. 29.

¹⁷⁴ *Novartis AG v Union of India (UOI) and Ors.; Natco Pharma Ltd. v UoI & Ors.; M/S Cancer Patients Aid Association v UoI & Ors.* Citations: Civil Appeal No. 06-16 of 2013. This decision has been criticised in the USTR report 2013 and remains on the Priority Watch List in 2013. See available at <http://www.ustr.gov/sites/default/files/05012013%202013%20Special%20301%20Report.pdf> 07 November 2013.

The application was made on April 28, 1994 and a patent was granted on May 28, 1996 under US Patent No. 5,521,184 (hereinafter referred to as ‘the Zimmermann Patent’). The Zimmermann compounds (i.e., derivatives of N-phenyl-2-pyrimidine-amine) were also granted a European patent under Patent No. EP-A-0 564 409. The appellant filed the application (Application No.1602/MAS/1998)¹ for a grant of patent for Imatinib Mesylate in beta crystalline form at the Chennai Patent Office in India on July 17, 1998. In the application it was claimed that the invented product, the beta crystal form of Imatinib Mesylate, has (i) more beneficial flow properties; (ii) better thermodynamic stability; and (iii) lower hygroscopicity than the alpha crystal form of Imatinib Mesylate. These properties make the invented product ‘new’ as it ‘stores better and is easier to process’; has ‘better processability of the methane sulfonic acid addition salt of a compound of formula I’, and has a ‘further advantage for processing and storing’.¹⁷⁵ After extensive consideration of the evidence before the court, the Supreme Court of India held that it was unable to accept that Imatinib Mesylate or even Imatinib was not a known substance with known efficacy.¹⁷⁶ ‘It is seen above that Imatinib Mesylate was a known substance from the Zimmermann patent. We thus find no force in the submission that the development of Imatinib Mesylate from Imatinib is outside the Zimmermann patent and constitutes an invention as understood in the law of patent in India’.¹⁷⁷

This case has been pitched as acting against the incentive for continued research and development in the pharmaceutical fields. It is submitted that the decision does not prevent

¹⁷⁵ Paragraph 8-9 *Novartis AG v Union of India (UOI) and Ors.; Natco Pharma Ltd. v UoI & Ors.; M/S Cancer Patients Aid Association v UoI & Ors.* Citations: Civil Appeal No. 06-16 of 2013.

¹⁷⁶ The decision of the Supreme court was based on section 3 (d) India Patents Act, 1970 (as last amended by Patents (Amendment) Act, 2005) which provides that

‘the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.’

¹⁷⁷ Para 133 *Novartis AG v Union of India (UOI) and Ors.; Natco Pharma Ltd. v UoI & Ors.* See also *Bristol-Myers Squibb Co v FH Faulding & Co Ltd* 39 (1998) 41 IPR 467 in relation to a petty patent for a more efficient method of administering an anti-cancer drug. At first instance, Heerey J revoked the patent on various grounds, most controversially that it was a method of treatment, the patenting of which would be generally inconvenient. (Ibid 479–82) Heerey J quoted Cooke J: ‘there remains ... a deep-seated sense that the art of the physician or the surgeon in alleviating human suffering does not belong to the area of economic endeavour or trade’ (Ibid 481, citing *Wellcome Foundation Ltd v Commissioner of Patents* [1983] NZLR 385, 388).

the patenting of a new drug for the same disease if it is really new and not a minor change in the physical properties of a drug or improved efficacy of a drug due to altering some of the properties.

Developing countries are held to the same standard as developed countries, however, many developed countries did not provide protection for product patents or completely excluded them as patentable subject matter at an earlier stage of their development.¹⁷⁸ As Li remarks, legally such protection prevent all other processes and methods of production of similar chemical product while economically it creates monopoly regime.¹⁷⁹ Regardless of Nigeria's stance, the patent law complies with its obligation as required under article 27 of the TRIPS Agreement.

6.3.2.1 Article 27.2: Exclusion from Patentability

The PDA¹⁸⁰ excludes plant or animal varieties or plant or animal production essentially biological processes (other than microbiological processes and their products) and inventions the publication or exploitation of which would be contrary to public order or morality¹⁸¹ as well as scientific principles and discoveries.¹⁸² Unlike article 27.2 of the TRIPS Agreement, section 1 (4) (b)¹⁸³ does not require that the exploitation of the invention be of a 'commercial nature'. As well as, an invention is excluded provided the exploitation is contrary to public order or morality, and it would be rendered invalid.¹⁸⁴ all types of exploitation contrary to public order or morality may be excluded from patentability.¹⁸⁵ The PDA does not specifically exclude the protection of inventions on human health, neither is there a provision

¹⁷⁸ Developed countries that prohibited product patent include France until 1966, Germany until 1967, Switzerland until 1977, Italy until 1978, Spain until 1986 however took effect in 1992

¹⁷⁹ Xuan Li 'The Impact of Higher Standards in Patent Protection for Pharmaceutical Industries under the TRIPS Agreement A Comparative Study of China and India' UNU World Institute for Development Economics Research (UNU-WIDER) Helsinki, Finland Research Paper No. 2008/36 p.1-2.

¹⁸⁰ Section 1(4) (a) and (b) PDA 1970 P2 LFN 2004.

¹⁸¹ According to section 1(4) PDA the exploitation of an invention is not contrary to public order or morality merely because its exploitation is prohibited by law.

¹⁸² Section 1(5) PDA 1970 P2 LFN 2004.

¹⁸³ PDA 1970 P2 LFN 2004.

¹⁸⁴ Section 24(4)(a) of the South African Patent Law has a similar provision. A similar provision obtains in Ghana, Kenya, Mozambique and Tunisia.

¹⁸⁵ Nuno Pires de Carvalho, *The TRIPS Regime of Patent Rights* Kluwer Law International, The Netherlands' 3rd Ed. 2010 p. 301.

that inventions that cause serious prejudice to the environment should be avoided. It must be borne in mind that the Act is a 1970 Act with no amendments, therefore the issue of the protection of human life and health such as gene technology or engineering¹⁸⁶ and environmental concerns are more recent issues which were not envisaged at the time. In particular, the human genome, which is still a developing area in science and biotechnology, was not understood then. The issue of climate change¹⁸⁷ and global warming¹⁸⁸ and the need to avoid serious prejudice to the environment were not raised in the 60s.

Another issue, related to article 27.2, is the perception that ‘some environment-related inventions’ have been excluded from patent protection. Of particular note are the new chemicals which may contain harmful substances that are not predictable.¹⁸⁹ This area has generated a lot of discussion on the relationship of the TRIPS Agreement, the Convention on Biological Diversity (CBD)¹⁹⁰ and traditional knowledge.¹⁹¹

The aspect of the TRIPS Agreement which is of great concern to developing countries, Nigeria in particular, relates to the dependence on traditional knowledge based on plant remedies by about 80% of the population. These herbal remedies have been passed down by generations of traditional health practitioners (THPs)¹⁹² and they play a major role in

¹⁸⁶ Modern genetic engineering began in 1973 when Herbert Boyer and Stanley Cohen used enzymes to cut a bacteria plasmid and insert another strand of DNA in the gap. Available at <http://library.thinkquest.org/20830/Manipulating/Experimentation/GenEngineering/history.htm> accessed 18 June 2012.

¹⁸⁷ ‘Climate change’ means a change of climate which is attributed directly or indirectly to human activity that alters the composition of the global atmosphere and which is in addition to natural climate variability observed over comparable time periods. See Article 1 United Nations Framework Convention on Climate Change (UNFCCC).

¹⁸⁸ ‘Global warming is caused by massive increase in greenhouse gasses such a carbon dioxide in the atmosphere resulting from the burning of fossil fuels and deforestation.’ See Mark Maslin *Global Warming: A Very Short Introduction* Oxford University Press Oxford 2009 p. 1.

¹⁸⁹ Bruce Harper, ‘TRIPS Article 27.2: An Argument for Caution’, 21 (1997) *William & Mary Environmental Law and Policy Review* 381-420 381; see also Preamble 13 TRIPS Agreement. See also U.S. Gen. Accounting Office, *Toxic Substances Control Act-Legislative Changes Could Make The Act More Effective* 8 (1994). RCED-94-103

¹⁹⁰ Nigeria ratified the Convention on Biological Diversity (CBD) in 1994. The goals of the CBD are tripartite (1) the conservation of biological diversity, (2) sustainable use of its components, and (3) the fair and equitable sharing of the benefits arising from genetic resources for commercial use.

¹⁹¹ Nuno Pires de Carvalho, *The TRIPS Regime of Patent Rights* Kluwer Law International, The Netherlands’ 3rd Ed. 2010 p. 199.

¹⁹² Traditional health practitioners (THPs) in Nigeria consist of traditional healers and traditional herbal sellers (known as elewe omo) who have over the years sold all forms of herbal products used for different ailments.

healthcare provision,¹⁹³ even though they remain largely unregulated and the herbs they use have not undergone laboratory screening before use.

The exclusion of patentable inventions that relate to human health is conspicuously absent in the PDA. The situation is expected to be amended in consideration of the desperate need for patented drugs for tropical diseases that affect a major part of the country. For example, Nigeria has a 30% rate of childhood mortality, 11% rates of maternal mortality and loses about ₦132 billion annually because of the high susceptibility rate to the scourge of malaria.¹⁹⁴ Malaria is said to be responsible for over 63% of all clinical attendances in Nigeria.¹⁹⁵ According to the 2011 World Report on Malaria 100% of the population are at high risk of contracting the disease.¹⁹⁶

Another issue which the TRIPS Agreement requires before an invention is excluded from patentability is that the exclusion should not be based on the fact that it is prohibited by law in the member state. The PDA complies with this requirement as the law clearly provides that exclusion is not contrary to public order or morality merely because its exploitation is prohibited by law.¹⁹⁷

6.3.2.2 Article 27.3 (a): Methods of Treatment

The TRIPS Agreement allows members of the WTO to exclude from patentability diagnostic, therapeutic and surgical methods for the treatment of humans or animals.¹⁹⁸ This is an important exception which is not specifically exempted in the PDA. The silence of the PDA can mean that diagnostic, therapeutic and surgical methods for the treatment of humans or animals may be patentable. However, since such methods are not industrially applicable

¹⁹³ Traditional Medicine as a Tonic for Development <http://www.wipo.int/ipadvantage/en/details.jsp?id=3229> 2 October 2013.

¹⁹⁴ Emmanuel Adeniyi, 'Global malaria cases: Is Nigeria highest contributor?' *Nigeria Tribune* Sunday, 06 May 2012 See also Monitoring and Evaluation Plan for Malaria Control in Nigeria 2010-2-13 Second Edition September 2011 National Malaria Control Project, Federal Ministry of Health.

¹⁹⁵ National Malaria Control Project, Federal Ministry of Health See also, John C.T. *Overview of Malaria Illness in Nigeria*. Department of Obstetrics & Gynaecology, U.P.T.H. Port Harcourt

¹⁹⁶ World Malaria Report 2011, WHO Library Cataloguing-in-Publication Data p.52.

¹⁹⁷ Section 1(4) (b) PDA 1970 P2 LFN 2004.

¹⁹⁸ Article 27.3 (a) TRIPS Agreement.

they may not be patentable even in the absence of specific exclusion.¹⁹⁹ Generally, speaking, most countries do not patent methods of treatment;^{200 201} however, the United States (US) stands out as an exception to the rule.²⁰² It is believed in the US that ‘everything under the sun made by man is patentable’²⁰³ Some countries, like India, have extended the provision further to read ‘any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products’²⁰⁴ are exclude from patent protection. The European Patent Act, in two separate articles, in different ways state that methods of treatments are not inventions²⁰⁵ and are not patentable.²⁰⁶ The reason for the emphasis on this exception was given by the Technical Board of Appeal (TBA) in THOMPSON/Cornea,²⁰⁷ it states:

The intention underlying [Article 52(4)] is to ensure that nobody who wants to use the methods specified in this Article as part of the medical treatment of humans or animals should be prevented from this by patents. Such medical treatments need not necessarily be carried out by physicians...However, where, in view of the health risks connected

¹⁹⁹ UNCTAD. Resource Book on TRIPS p.384.

²⁰⁰ According to Piper there are approximately 80 countries around in the world that exclude methods of medical treatment from being granted patent protection. These include all European countries (Article 53(c) & Article 52 (4)European Patent Convention 1973), some countries in Asia, Africa (In South Africa section 25 (11) of the current Patent Act 57 of 1978 last amended by (Patents Amendment Act, No. 58 of 2002) provides that:

‘An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall be deemed not to be capable of being used or applied in trade or industry or agriculture.), North America, South America, and Central America. See Tina, Commentary in response to ‘Are Patents for Methods of Medical Treatment contrary to the *Ordre Public* and Morality or ‘Generally Inconvenient’?, (2004) 30 *Journal of Medical Ethics* 470 476; section 4A(1) of the UK Patents Act 1977 (as amended).

²⁰¹ Albania, Algeria, Andorra, Argentina, Austria, Bahrain, Barbados, Belgium, Belize, Bolivia, Bosnia & Herzegovina, Brazil, Canada, Chile, China, Colombia, Costa Rica, Croatia, Dominica, Ecuador, Egypt, El Salvador, Estonia, Ethiopia, Finland, France, Georgia, Germany, Ghana, Greece, Guatemala, Hungary, Iceland, India, Indonesia, Ireland, Israel, Italy, Japan, Jordan, Kenya, Latvia, Lebanon, Liechtenstein, Lithuania, Luxembourg, Malaysia, Malta, Mauritius, Mexico, Mongolia, Morocco, Mozambique, Netherlands, Nicaragua, Norway, Pakistan, Panama, Papua New Guinea, Peru, Philippines, Poland, Portugal, Qatar, Romania, Santa Lucia, Saudi Arabia, Serbia, Singapore, Slovak Republic, Slovenia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Tanzania, Thailand, Former Yugoslav Republic of Macedonia, Trinidad & Tobago, Tunisia, Turkey, Uganda, United Kingdom, Uruguay.

²⁰² Eddy Ventose *Medical Patent Law The Challenges of Medical Treatment* Edward Elgar 2011 p.9

²⁰³ *Diamond v Chakrabarty* - 447 U.S. 303 (1980).

²⁰⁴ Section 3 (1) India Patents Act, 1970 (as last amended by Patents (Amendment) Act, 2005).

²⁰⁵ Article 52 (4) European Patent Convention 1973).

²⁰⁶ Article 53 (c) European Patent Convention 1973).

²⁰⁷ T 24/91 THOMPSON/Cornea OJEP 1995, 512.

with such a treatment, a claimed method of treatment has to be performed by a physician or under his supervision, it will normally fall within the exclusion....

Therefore methods of treatment have been distinguished by the mode of treatment to enable protection. For instance appetite suppressants²⁰⁸ have been held to be patentable, however, contraceptive methods²⁰⁹ an apparatus for skin resurfacing²¹⁰ and hair removal methods²¹¹ are not patentable.

Consequently, in the absence of this provision in the PDA, it can develop in either direction. However, some of the methods of treatment may be disallowed as being contrary to public order or morality which is an exception under the PDA,²¹² especially if it is held that ‘ethical grounds’ mean ‘public policy grounds’.²¹³

6.3.2.3 Article 27.3 (b): Micro-organisms Non-biological and Microbiological Processes

Article 27.3 (b) contains issues which are still controversial.²¹⁴ This article essentially provides that members may exclude plants and animals, but not micro-organisms, and essentially biological processes for the production of plants or animals may not be protected, but non-biological and microbiological processes may be. However, any country excluding plant varieties from patent protection must provide an effective *sui generis* system of protection. In addition, the whole provision is subject to review four years after entry into

²⁰⁸ T144/83 – DU PONT [1986] OJEPO 301-5 The Board allowed the protection of an appetite suppressant the summary of the Board decision is stated as follows: The fact that a chemical product has both a cosmetic and therapeutic effect when used to treat the human or animal body does not render the cosmetic treatment patentable (as in the present case where it may be used to cause loss of weight or to cure obesity)’.

²⁰⁹ T 0820/92 1994 <http://www.epo.org/law-practice/case-law-appeals/recent/t920820ep1.html> 1 October 2013.

²¹⁰ T 1172/03 of 4.5.2005 Held ‘The patentability of a surgical method claimed as a cosmetic method must be excluded, if the cosmetic use of the method is only expressed in the claim as a mere intention of the person using the method.’

²¹¹ T 383/03 (2005) OJEPO 159-General Hospital Corp/Hair removal method. Method of treatment by surgery not excluded from patentability ‘if a method involving a physical intervention on the human or animal body (treatment by surgery) is clearly neither suitable nor potentially suitable for maintaining or restoring the health, the physical integrity, or the physical well-being of the person or animal, then the method does not fall under the exclusion from patentability provided for in Article 52(4) EPC.’

²¹² Section 1 (4) PDA 1970 P2 LFN 2004.

²¹³ Per Finkelstein J. in *Bristol Myers Squibb Co v F H Faulding & Co Ltd* (2000):46 IPR 553 586.

²¹⁴ Gervais, Daniel, *The TRIPS Agreement Drafting History and Analysis* 4th edition Sweet and Maxwell Croydon 2012 para. 2 371p. 454. See also UNCTAD. Resource Book on TRIPS p.388.

force of the Agreement.²¹⁵ The PDA excludes plant or animal varieties or essentially biological processes for the production of plants or animals, but does not specifically exclude micro-organisms and non-biological processes from patentability.²¹⁶ Protecting micro-organisms, non-biological and microbiological processes of plants and animals has been a source of serious debate internationally. The provision aligns with the Nigerian position on the issue of patenting of life forms.²¹⁷

There was an attempt in 1999 to review article 27.3 (b) which, in turn, raised several issues at the TRIPS Council discussions amongst which was the application of this provision. Issues that were raised included whether patentability extends to plants and animals and whether the provisions need to be modified and how moral and ethical issues are dealt with, for example, to what extent invented life forms should be eligible for protection under the provision.²¹⁸ For these reasons several developing countries have called for the review of this section. In 2003 the African Group²¹⁹ maintained its reservations about patenting any life forms: they declared such patenting to be unethical and that the TRIPS Agreement should prohibit it by modifying the requirement to exclude from protection all patents on micro-organisms and on non-biological and microbiological processes for the production of plants or animals.²²⁰

The African group, and certain other members of the WTO, consider patents on life forms to be contrary to the fabric of their society and culture and to be immoral. Such protection, they feel is contrary to the exception in article 27.2 regarding *ordre public* and morality, which

²¹⁵ This is the only section which is subject to review every four year, thus the first review should have been 1999 and subsequently 2003, 2007, 2011. This review was inserted as a result of biotechnology which was and is still a developing area.

²¹⁶ Section 1 (4) PDA 1970 P2 LFN 2004.

²¹⁷ IP/C/W/404- Taking forward the review of article 27.3(b) of the TRIPS Agreement. Joint Communication from the African Group. Council for Trade-Related Aspects of Intellectual Property Rights. 26 June 2003

²¹⁸ TRIPS: Reviews, Article 27.3(b) and related issues http://www.wto.org/english/tratop_e/trips_e/art_3b_background_e.htm 1 October 2013.

²¹⁹ WTO Members (42): Angola, Benin, Botswana, Burkina Faso, Burundi, Cameroon, Cape Verde, Central African Rep., Chad, Congo, Congo (Democratic Rep.), Côte d'Ivoire, Djibouti, Egypt, Gabon, Gambia, Ghana, Guinea, Guinea Bissau, Kenya, Lesotho, Madagascar, Malawi, Mali, Mauritania, Mauritius, Morocco, Mozambique, Namibia, Niger, Nigeria, Rwanda, Senegal, Sierra Leone, South Africa, Swaziland, Tanzania, Togo, Tunisia, Uganda, Zambia, Zimbabwe.

²²⁰ IP/C/W/404- Joint Communication from the African Group. Council for Trade-Related Aspects of Intellectual Property Rights. 26 June 2003; Boniface Guwa Chidyausiku Article 27.3 (b) of the TRIPS Agreement the review process and development at national and regional level in Christophe Bellmann, Ricardo Melendez-Ortiz (eds) *Trading in Knowledge: Development Perspectives on TRIPS, Trade and Sustainability* Earthscan 2003 101-108 p.104.

otherwise would be meaningless.²²¹ Bolivia expressed serious concerns, contending that ‘the patent system has become an instrument of privatisation and commoditisation of life itself on a worrying scale and magnitude’.²²² It stressed: ‘for the indigenous peoples of Bolivia and of many other peoples of the world, life is something sacred that under no circumstances should it be subject to private appropriation or considered as a commodity’.²²³

As remarked by Dutfield,²²⁴ this aspect of the TRIPS Agreement is undoubtedly extremely important for developing countries, Nigeria as well. Reflecting on what article 27.3 (b) means to developing countries, he suggests ways to advance the debate and explicitly states that although the TRIPS Agreement requires WTO members to protect biotechnological inventions, article 27.3 (b) nevertheless provides the possibility of members regulating the degree of protection that would be offered for technological invention²²⁵ by providing an option to protect plant varieties through patents or by an effective *sui generis* system.

The dilemma most developing countries face is explained by Dutfield. He gives several reasons why biotechnology is not out-right bad and patentability should not be discarded without looking at the benefits that can be attained from such protection. He explains that there seems to be a disconnection in the interpretation of biotechnologies and that the bone of contention is the ‘new biotechnologies’.²²⁶ ‘Longer-established biotechnologies’²²⁷ are acceptable, and the main issue is that ICs and DCs ‘are applying the word “biotechnology” differently.’²²⁸ He opines developing countries are expected to take a TRIPS *de minimis*

²²¹ IP/C/W/404 - African Group.

²²² TRIPS Council discusses Art. 3 (b) review, ‘Para 6’ system Published in SUNS #6945 dated 16 June 2010 TWN Info Service on Health Issues Third World Network 6 July 2010 available at <http://www.twinside.org.sg/title2/health.info/2010/health20100701.htm> accessed 2 October 2013.

²²³ TRIPS Council discusses Art. 3 (b) review, ‘Para 6’ system.

²²⁴ Graham Dutfield, ‘Biotechnology and Patents: What Can Developing Countries Do About Article 27.3(b)?’ BRIDGES between Trade and Sustainable Development ICTSD ANALYSIS Post-Doha Ministerial Issue November/December 2001 Year 5 No.9 p.17 available at <http://ictsd.org/downloads/bridges/bridges5-9.pdf> accessed 2 October 2013.

²²⁵ Tshimanga Kongolo, *Unsettled International Intellectual Property Issues* Kluwer Law International 2008 p.89; Boniface guwa Chidyausiku Article 27.3 (b) of the TRIPS Agreement the review process and development at national and regional level in Christophe Bellmann, Ricardo Melendez-Ortiz (eds) *Trading in Knowledge: Development Perspectives on TRIPS, Trade and Sustainability* Earthscan 2003 101-108 p.108.

²²⁶ Such as recombinant DNA, monoclonal antibodies and genomics.

²²⁷ Beer brewing and bread making.

²²⁸ Graham Dutfield, ‘Biotechnology and Patents: What Can Developing Countries Do About Article 27.3(b)?’ p.17.

approach: to define the terms restrictively where it is advantageous to do so. He advises that it is in the interest of developed countries ‘to heed the concerns of developing countries and respond sympathetically’: He states that it is unreasonable to pressure developing countries into implementation and that developed countries should ‘refrain from imposing their own interpretations of article 27.3 (b) based on their own legislation, jurisprudence and economic interests’.²²⁹

Although Nigeria has rudimentary biotechnological means at the moment there is a movement toward better access to biotechnology that suits the current level of development. National programmes that will empower Nigerians and impart ‘the capacity to decide on how to use these technologies in consideration of national regulatory system’²³⁰ are being introduced systematically.

On the continental level in 2001 the African Union drafted an African Model Law on Safety in Biotechnology²³¹ which was confirmed by the 37th Assembly of Heads of State and Government, including Nigeria.²³² The African Model Law on Biosafety²³³ was developed to assist African countries in crafting their national laws on biosafety by giving the necessary technical options in dealing with the regulation of issues on biosafety that are readily adaptable to suit local needs and to meet national objectives. The Cartagena Protocol on Biosafety²³⁴ informed the enactment of the African Model Law on Biosafety to ensure more rigorous standards and additional bio-safety measures in Africa in relation to biotechnology.²³⁵

²²⁹ Dutfield ‘Biotechnology and Patents’ p.18.

²³⁰ Dele Ogbodo Gates Foundation to Build Standard Biotech Lab in Nigeria Tuesday 09 Jul 2013 available at <http://www.thisdaylive.com/articles/gates-foundation-to-build-standard-biotech-lab-in-nigeria/152816/> 3 October 2013.

²³¹ Revised August, 2007 and now called African Model Law on Biosafety.

²³² African Model Law on Biosafety Overview http://www.africa-union.org/root/AU/AUC/Departments/HRST/biosafety/AU_Biosafety_2b.htm accessed 4 October 2013.

²³³ An African Position on GMOS in Agriculture African Union Commission Directorate of Rural Economy and Agriculture available at <http://hrst.au.int/en/sites/default/files/2007-Presentation-AfricanGMOPosition.pdf> accessed 2 October 2013.

²³⁴ Cartagena Protocol on Biosafety to the Convention on Biological Diversity. Montreal, 29 January 2000 available at <http://www.cbd.int/doc/legal/cartagena-protocol-en.pdf> accessed 2 October 2013.

²³⁵ African Ministerial Conference on Science and Technology (AMCOST III) Third Ordinary Session 12-16 November 2007 Mombasa, Republic Of Kenya Au/Exp/St/17(Iii) African Model Law on Safety in

Apart from the African Union Model Law there are other initiatives by Regional Economic Communities (RECs). In relation to Nigeria, the Economic Community of West African States (ECOWAS) in 2005 held a Ministerial Conference of ECOWAS States on Biotechnology in Bamako, Mali.²³⁶ The Conference was a summation of meetings and workshops held in Ouagadougou²³⁷ and Abuja²³⁸ with the aim of proposing recommendations for a better understanding of biotechnology and its potential applications. The conference recommended some guidelines which ECOWAS countries should adopt to ensure the safe utilisation of biotechnology and suggested the following: (i) the development and use of biotechnologies (ii) a regional approach for biosafety (iii) an information and communication strategy and policy in biotechnology, and (iv) the institutionalisation of a ministerial conference on biotechnology.²³⁹ In 2007, there was a follow up meeting in Ghana of the ministers of agriculture, environment, science and technology to discuss the issues surrounding biotechnology in agriculture.²⁴⁰ The aim of the Conference was to come up with an action plan on biotechnology and bio-safety and ‘to stimulate competitiveness, while maintaining the natural resource base and creating an enabling environment.’²⁴¹ It also agreed to reduce food insecurity in the region by using appropriate technology, including biotechnology. Nevertheless, it was proposed to set up safety measures at national and

Biotechnology http://www.africa-union.org/root/AU/Conferences/2007/November/HRST/AMCOST/docs/pdf/AU-EXP-ST-17_III_-ENG-Report%20of%20Experts%20on%20Model%20Law.pdf accessed 4 October 2013.

²³⁶ ECOWAS Ministerial Conference on Biotechnology: Strategies and actions for sustainable agricultural production, safe for humans and environment Bamako, June 21st –24th, 2005.

²³⁷ Conference on ‘Controlling sciences and technologies to increase agricultural productivity in Africa: a West African perspective’ was held in June 2004 in Ouagadougou, Burkina Faso.

²³⁸ Conference on ‘The Utilization of Science and Technology to Increase Agricultural Productivity in Africa’ was held in June 2004 in Ouagadougou, Burkina Faso. Conference of the Ministers in Charge of Science and Technology was held in Abuja in November 2004 with the theme of ‘Agriculture and Biotechnology.’

²³⁹ Recommendation Establishing a Technical Commission on Biotechnologies Applied to Agriculture. Briefing Document ECOWAS Ministerial Conference on Biotechnology: Strategies and actions for sustainable agricultural production, safe for humans and environment Bamako, June 21st –24th, 2005 available at http://www.hubrural.org/IMG/pdf/cedea0_bamako_group_report3_recommendations_eng.pdf 7 October 2012.

²⁴⁰ ECOWAS Ministerial Conference on Biotechnology: ‘Adoption of 2006-2010 Action Plan for Meeting of the Challenges of Biotechnology and Bio safety.’ Accra Ghana 28–30 March 2007.

²⁴¹ Action plan for the development of biotechnology and bio-safety in the ECOWAS sub-region available at <http://www.coraf.org/documents/Action%20Plan%20for%20Biotech%20of%20ECOWAS.pdf> accessed 7 October 2013.

regional levels and to set aside independent fund to assess the socio-economic impact of using genetically modified organisms. (GMOs)²⁴²

Obviously, West Africa, including Nigeria, is taking steps toward the use of biotechnology. However, they are still skeptical about the implementation of article 27.3 (b). Patentable or non-patentable subject matter will be a topic of discussion for a long time to come as the DCs and the LDCs are not at a level of development already attained by countries such as the US, Canada, Europe and Japan. Regrettably, Nigeria has not reached the level of technological development required to use a lot of the inventions that are a source of concern for ICs. This is evident in the fact that there has been no real push by ICs for Nigeria to comply with its international obligation. The first sentence of article 27.3 (b) is an optional provision which countries may adopt if they deem fit, accordingly, Nigeria's position is not at variance with what is expected under the TRIPS Agreement.

6.3.2.4 Article 27.3 (b): Plant and Animals

The TRIPS Agreement, in addition, requires members to protect plant varieties either by patents or an effective *sui generis* system or by any combination.²⁴³ The TRIPS Agreement excludes plant life form protection, however, it provides for the protection of plant varieties. What are plants and what are plant varieties? A plant has been defined as 'first of all, a living thing and shares the characteristics which are recognised as life with other living things.'²⁴⁴ Plant variety is defined in the UPOV Convention as²⁴⁵ 'a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be (1) defined by the expression of the characteristics resulting from a given genotype or combination of genotypes (2) distinguished from any other plant grouping by the expression of at least one

²⁴² West Africa to boost food crops with biotechnology available at <http://www.scidev.net/sub-saharan-africa/biotechnology/news/west-africa-to-boost-food-crops-with-biotechnology-ssa.html> accessed 7 October 2013.

²⁴³ Article 27.3 (b) TRIPS Agreement.

²⁴⁴ James C. Forbes and R Drennan Watson *Plants in Agriculture* Cambridge University Press Cambridge 2006 p.2.

²⁴⁵ Article 1 (vi) UPOV Convention.

of the said characteristics and (3) considered as a unit with regard to its suitability for being propagated unchanged’.

A variety must be recognisable by its characteristics, be recognisably different from any other variety and remain unchanged through the process of propagation.²⁴⁶ It is the contention of developing countries and for this reason that they ask whether plant varieties should be included in genetically-engineered plant varieties and, therefore, get patent protection as such.²⁴⁷ The interpretation leads to the discussion on the patenting of life forms, which is why most developing countries are apprehensive, Nigeria inclusive.

The Doha Declaration broadened the discussion.²⁴⁸ It declared that the TRIPS Agreement Council should look at the relationship between the TRIPS Agreement and the UN Convention on Biological Diversity, the protection of traditional knowledge and folklore. The declaration specifically provides that the TRIPS Agreement Council’s work on these topics should be guided by the TRIPS Agreement’s objectives²⁴⁹ and principles²⁵⁰ and must take developmental issues fully into account.²⁵¹ This is essentially so because there have been reports that intellectual property rights on plant varieties erode biological diversity, especially in agriculture.

The treaty for the protection of plant varieties internationally, is the International Convention for the Protection of New Varieties of Plants (UPOV).²⁵² Nigeria is not a party to the UPOV. UPOV has been said to be an effective system of plant protection: it is not obligatory to choose this system of protection.²⁵³ Nigeria has a National Crop Varieties and Livestock

²⁴⁶ The UPOV System of Plant Variety Protection
http://www.upov.int/about/en/upov_system.html#what_is_a_pv 3 October 2013.

²⁴⁷ Dutfield G *Biotechnology and Patents* p.18.

²⁴⁸ Paragraph 19 of the 2001 Doha Declaration.

²⁴⁹ Article 7 TRIPS Agreement.

²⁵⁰ Article 8 TRIPS Agreement.

²⁵¹ WTO DOHA MINISTERIAL DECLARATION 2001 Adopted on 14 November 2001 WT/MIN(01)/DEC/1 Paragraph 19 ‘We instruct the Council for TRIPS, in pursuing its work programme including under the review of Article 27.3(b), In undertaking this work, the TRIPS Council shall be guided by the objectives and principles set out in Articles 7 and 8 of the TRIPS Agreement and shall take fully into account the development dimension.’

²⁵² Act of 1991 International Convention for the Protection of New Varieties of Plants of December 2, 196, as Revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991.

²⁵³ Gervais. *The TRIPS Agreement* para 2.370 p.456.

Breeds Registration and Release Committee²⁵⁴ and a National Agricultural Seed Service,²⁵⁵ which were promulgated to regulate the system of naming, release and registration of crop varieties and livestock breeds and, consequently, to keep a check on the seed industries.²⁵⁶ The objective has not been realised as a result of structural and functional defects in the law.²⁵⁷

Nigeria signed the Convention on Biological Diversity (CBD) at the United Nations Earth Summit in June 1992 and ratified it in August 1994. Nigeria is a party to the Cartagena Protocol and its Supplementary Protocol,²⁵⁸ but is not a party to the Nagoya Protocol.²⁵⁹ There is no specific domestic legislation on biological diversity: however there are other legislations on environmental protection of significance which may be taken into account.²⁶⁰

As stated earlier,²⁶¹ the IPCOM Bill included an Act on Plant Varieties, Animal Breeders and Farmers Rights²⁶² largely this reflects the intent of the African Model Law on Safety in Biotechnology. The Bill provides for the registration of plant varieties and animal breeds²⁶³ and for registering the description of the plant variety or animal breed. As well, the denomination and name of the variety or breed as may be prescribed if it conforms to such criteria of distinctiveness, uniformity and stability as shall be specified by regulations of the

²⁵⁴ National Crop Varieties and Livestock Breeds (Registration, etc.) Act Cap N27 Decree 33 of 1987.

²⁵⁵ National Agricultural Seeds Act 1992 Cap N5 LFN 2004.

²⁵⁶ Ibigbami and Orji. A Review of the Nigerian System of Intellectual Property A Case Study Under NABDA/CAS-IP NPI Collaboration Project Intellectual Property Desk National Biotechnology Development Agency
<http://www.iccwbo.org/uploadedFiles/BASCAP/Pages/A%20Review%20of%20the%20Nigerian%20System%20of%20Intellectual%20Property.pdf> accessed 2 October 2013.

²⁵⁷ Review of the National Agricultural Seeds Act and Proposed Amendments. A report of Seed law review Committee. At http://pdf.usaid.gov/pdf_docs/PNADC079.pdf accessed 2 October 2013.

²⁵⁸ Nigeria signed the protocol in May 2000 and ratified it in October 2003.

²⁵⁹ Nagoya – Kuala Lumpur Supplementary Protocol on Liability and Redress.

²⁶⁰ These include Harmful Waste (Special Criminal provisions etc); Decree, 1988, the Environmental Impact Assessment decree 1992, Public Health Act, 1917 Antiquities Act, 1915, Live Fish (Control of Importation) Act, 1965, Navigable Waters Declaration Decree, 1978, Natural Resources Conservation Council Decree, 1989 River Basins Development Authorities Decree, 1987, Sea Fisheries (licensing) Regulations, 1992, Quarries Decree, 1969, National Parks Decree, 1991 NIGERIA, National Biodiversity Strategy and Action Plan at <http://www.cbd.int/doc/world/ng/ng-nbsap-01-en.pdf> accessed 19 June 2012.

²⁶¹ Paragraph 6.2.4 above ‘Recent development in Patent laws’.

²⁶² The Plant Varieties, Animal Breeders and Farmers Rights in Part D of the IPCOM Bill is up till now still a Bill.

²⁶³ Section 172- 175 IPCOM Bill 2006.

Bill.²⁶⁴ The registration of plant varieties and animal breeds unlike patent applications which are based on mere formalities demanded that with the application samples of the variety or breed will be sent to the National Crop Varieties and Livestock Breeds Registration and Release Committee for the purpose of conducting tests to evaluate whether such a variety, along with parental material, conforms to the standards specified by regulations.²⁶⁵ The Bill, as stated above, has not been passed into law.

From the above discussion it can be seen that Nigeria, along with other African countries, is moving towards compliance with the TRIPS Agreement. However, it is safe to say Nigeria has not complied with its obligation for the protection of plant varieties, either by patents or by an effective *sui generis* system or by any combination thereof under article 27.3(b) of the TRIPS Agreement.

6.3.3 Article 28 Rights Conferred by Patents

Article 28 of the TRIPS Agreement expressly provides that a patent right holder is entitled to certain exclusive rights. The extent of the rights conferred by patents under the TRIPS Agreement in relation to a product patent entails the exclusive rights to prevent third parties not having the owner's consent from making, using, offering for sale, selling, and importing²⁶⁶ such products.²⁶⁷ A process patent grants exclusive rights not only over use of the process but also over products obtained directly by using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.²⁶⁸ As stated by the WIPO Standing Committee on the Law of Patents (SCP)²⁶⁹ 'the granting of exclusive patent rights is considered as an incentive for investment in innovative activities

²⁶⁴ Section 175 (2) IPCOM Bill 2006.

²⁶⁵ Section 180 (2) IPCOM Bill 2006.

²⁶⁶ This right, like all other rights conferred under this Agreement in respect of the use, sale, importation or other distribution of goods, is subject to the provisions of Article 6. (This footnote was inserted as footnote 6 in the TRIPS Agreement explaining what importing means).

²⁶⁷ Article 28.1 (a) TRIPS Agreement.

²⁶⁸ Article 28.1 (b) TRIPS Agreement.

²⁶⁹ The Standing Committee on the Law of Patents (SCP), formed in 1998 is composed by all member States of WIPO and or of the Paris Union including a number of intergovernmental and non-governmental organizations. It facilitates, coordinates and provides guidance concerning the progressive international development of patent law and is a forum for discussing issues on patent law as well.

and the production of knowledge'.²⁷⁰ It may be said the rights that accrue from undertaking an invention are not necessarily an incentive for investment.

Section 6 (1)²⁷¹ of the PDA reads like this article,²⁷² except that section 6 also bestows upon the patentee the right to preclude any other person from stocking the product for the purpose of sale or use. This provision is considered important because of its usefulness in practice for the seizure of counterfeit products,²⁷³ but it works against parallel imports and the exhaustion of rights. Article 28 reflects the standard used by many countries prior to the TRIPS Agreement.²⁷⁴ Both the TRIPS Agreement and the PDA provide a negative right as no specific rights are granted. It should be noted that the scope of the protection conferred by a patent shall be determined by the terms of the claims included in the patent.²⁷⁵

In addition, in article 28.2 patent owners have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.²⁷⁶ A similar provision is provided for in section 24 of the PDA which provides that a person's rights in a patent may be assigned, transferred by succession or held in joint ownership. Accordingly, this provision is compliant with the TRIPS Agreement.

6.3.4 Article 29: Conditions on Patent Applicants

The provision of article 29 of the TRIPS Agreement is important and is essential for any country intending to develop technologically. The objective of this obligation is to ensure proper disclosure of an invention in a way that is sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

Section 3 (1) of the PDA provides that every patent application shall consist of a description of the relevant invention with any appropriate plans and drawings and a claim or claims. The

²⁷⁰ WIPO, Standing Committee on the Law of Patents Exclusions From Patentable Subject Matter And Exceptions And Limitations To The Rights Thirteenth Session Geneva, March 23 To 27, 2009 SCP/13/3 p. 3.

²⁷¹ PDA 1970 P2 LFN 2004.

²⁷² Article 28 TRIPS Agreement.

²⁷³ Gervais, *The TRIPS Agreement* para.2.381 p.462.

²⁷⁴ UNCTAD. Resource Book on TRIPS p.415; Gervais, *The TRIPS Agreement* para. 2.381 p.462. Similar provision exist in the US Code Title 35(Patent Act) s.271; See also Article 60 of the British Patent Act.

²⁷⁵ Section 6 (2) PDA 1970 P2 LFN 2004.

²⁷⁶ Article 28.2 (b) TRIPS Agreement.

description is required to disclose the relevant invention in a manner sufficiently clear and complete for the invention to be put into effect by a person skilled in the art or field of knowledge to which the invention relates.²⁷⁷

Although full disclosure is required, the best mode of working the invention is not required. This is also optional in the TRIPS Agreement. Although optional in the TRIPS Agreement, the need of the best mode requirement is essential in patent law to enable the best method envisaged by the inventor for carrying out his invention.

According to the USPTO the ‘best mode requirement is a safeguard against the desire on the part of some people to obtain patent protection without making a full disclosure as required by the statute. The requirement does not permit inventors to disclose only what they know to be their second-best embodiment, while retaining the best for themselves.’²⁷⁸

Regarding information concerning the applicant’s corresponding foreign applications and grants, the PDA requires a similar process for the applicant to avail himself of a foreign priority in respect of an earlier application made outside Nigeria.²⁷⁹ Such information is required to include a written declaration showing the date and number of the earlier application, the country in which the earlier application was made, and the name of the person who made the earlier application and a certified copy of the earlier application by the Industrial Property Office in the country where the earlier application was made.²⁸⁰ In this regard, the Nigerian patent law conforms to the requirement of the TRIPS Agreement.

6.3.5 Article 30: Exception to Rights Conferred

The inclusion of the exceptions to patent right is to balance the objective of patenting. Over the last two decades patentable inventions have been questioned and more limitations and greater access have been demanded.

²⁷⁷ Section 3 (2) PDA 1970 P2 LFN 2004; rule 12 Patent Rules L.N. 96 of 1971.

²⁷⁸ U.S. Patent and Trademark Office *Manual of Patent Examining Procedure (MPEP)* Ninth Edition, March 2014 Chapter 2100 Section 2165 The Best Mode Requirement [R-11.2013] available at <http://www.uspto.gov/web/offices/pac/mpep/s2165.html>; see also *In re Nelson*, 280 F.2d 172, 126 USPQ 242 (CCPA 1960).

²⁷⁹ Section 3(4) PDA 1970 P2 LFN 2004.

²⁸⁰ Section 3(4) (a) and (b) PDA 1970 P2 LFN 2004.

The TRIPS Agreement stipulates that members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.²⁸¹ It has been argued that article 30 provides ‘a general and flexible authority for members to adopt measures that balance the interests of patent owners with the interests of others, as article 7 of the TRIPS Agreement expressly stated was an objective of the TRIPS Agreement.’²⁸² This provision is slightly different from article 13 of the TRIPS Agreement on copyright which also allows limited exceptions provided they do not unreasonably conflict with the normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties. However, here the exceptions are not confined to certain special cases.²⁸³

Article 27 of the TRIPS Agreement, generally, contains certain exclusions²⁸⁴ from patentability, this article give members the rights to create exception in so far as they do not conflict with normal exploitation. Exceptions which have been in existence prior to the TRIPS Agreement include exceptions such as private and non-commercial use, experimental/scientific use,²⁸⁵ prior use, regulatory review (‘Bolar’ exceptions) and the exhaustion of patent rights.²⁸⁶ The Paris convention does not mention exceptions to patentable subject matter,²⁸⁷ but case law has helped develop this area of law.²⁸⁸

²⁸¹ Article 30 TRIPS Agreement. See also Andries van der Merwe *The Law of Patents* in Andries van der Merwe et. al in *Law of Intellectual Property LexisNexis Durban* 2011 p. 306.

²⁸² Panel Report, *Canada – Patent Protection of Pharmaceutical Products*, WT/DS114/R, adopted 7 April 2000, DSR 2000:V, para. 4.12 p.18.

²⁸³ Panel Report, *Canada – Patent Protection of Pharmaceutical Products*, para 4.13 p.19-20.

²⁸⁴ Exclusions have been differentiated from exceptions.

²⁸⁵ Section 60 (5)(b) UK Patents Act.

²⁸⁶ Christopher Garrison, *Exceptions to Patent Rights in Developing Countries UNCTAD - ICTSD Project on IPRs and Sustainable Development Issue Paper No. 17 August 2006* 1 p.2 available at http://unctad.org/en/Docs/iteipc200612_en.pdf 6 Oct 2013.

²⁸⁷ WIPO Secretariat, *Exclusions from Patentable Subject Matter and Exceptions and Limitations to the Rights Standing Committee on the Law of Patents Thirteenth Session Geneva, March 23 to 27, 2009* available at http://www.wipo.int/edocs/mdocs/scp/en/scp_13/scp_13_3.pdf 6 Oct 2013.

²⁸⁸ *Monsanto v Stauffer (No. 2)* [1985] RPC 515 (CA) (experimental work for commercial purpose); *Klinische Versuche (Clinical Trials) I* [1997] RPC 623; *CoreValve Inc v Edwards Lifesciences AG & Anor* [2009] EWHC 6 (Pat), [2009] FSR 8; *Roche Products Inc. v Bolar Pharmaceuticals Co. Inc.*, 733 F.2d 858 (Fed. Cir. 1984).

It is agreed that Bolar exceptions and research exemptions are excluded from rights conferred on a patentee under article 28.²⁸⁹ Bolar exception emanated in the United States, the exemption came into prominence in the case of *Roche Products Inc. v Bolar Pharmaceuticals Co. Inc.*²⁹⁰ The decision of the court led to a change in the law which addressed Bolar's concerns and culminated in the passing of the Hatch-Waxman Act.²⁹¹ Although, the court did not decide in favour of Bolar, the Hatch-Waxman Act set out to strike a delicate balance between promoting inventions and the competing interests of brand name drug companies and generic drug companies to benefit the public by the provision of better access to drugs.²⁹² The intent of the Hatch-Waxman Act was not only to encourage immediate access to generic drugs but also to ensure their efficiency for their intended purposes. This allowed early Food and Drug Administration (FDA) approval for generic drugs in order to ensure that the generics immediately become accessible once the brand name drug companies' patents either expired or were found invalid or not infringed upon, thereby given generic drug companies authorisation to partially evade patent restrictions.²⁹³

The Hatch-Waxman Act gave rise to what is now known as the Bolar exception and was thereafter incorporated into the laws of several other countries.²⁹⁴ The Bolar exception is a

²⁸⁹ Panel Report, *Canada – Patent Protection of Pharmaceutical Products*, WT/DS114/R, adopted 7 April 2000.

²⁹⁰ 733 F.2d 858 (Fed. Cir. 1984).

²⁹¹ Drug Price Competition and Patent Term Restoration Act of 1984 known as the Hatch-Waxman Act Public Law 98-417. An Act To amend the Federal Food, Drug, and Cosmetic Act to revise the procedures for new drug applications, to amend title 35, United States Code, to authorize the extension of the patents for certain regulated products, and for other purposes.

²⁹² Vinod V. Sople, *Managing Intellectual Property: The Strategic Imperative* 3rd ed. 2012 PHI Learning Private Limited New Delhi p.285 LEDA at Harvard Law School The Hatch-Waxman (Im)Balancing Act <http://dash.harvard.edu/bitstream/handle/1/10015297/Paper1.html?sequence=2> Ricardo Meléndez-Ortiz, Pedro Roffe (eds) *Intellectual Property and Sustainable Development: Development Agendas in a Changing World* Edward Elgar publishing Cheltenham 2009 p.110.

²⁹³ See generally 21 U.S.C.) & 35 USC § 271 - Infringement of patent particularly at 271(e)(1) (1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products. Graham Dutfield, Uma Suthersanen *Global Intellectual Property Law* Edward Elgar publishing Cheltenham 2008 p.129 Ricardo Meléndez-Ortiz, Pedro Roffe (eds) *Intellectual Property and Sustainable Development: Development Agendas in a Changing World* Edward Elgar publishing Cheltenham 2009 p.110.

²⁹⁴ The EU Directive 2004/27/EC, Article 10(6) of the Directive; section 68B New Zealand Patents Act of 1953; Section 55.2(6) Canadian Patent Act 1985 as amended.

research exception that enables manufacturers of generic drugs to prepare production and regulatory processes necessary to enable marketing of the generic version of the patented drug as soon as the patent expires. It prevents a situation in which the patent owner will continue to have undue advantage and extend its market dominance. It also reduces the time within which the generic version of a drug gets to the market. Unfortunately, there is no such provision in the PDA.²⁹⁵ However, the PDA provides that the rights of a patentee are limited to industrial and commercial purposes only,²⁹⁶ which makes it possible for a non-commercial purpose, such as the Bolar exception, to be allowed, thereby enabling generic manufacturers of drugs to use the patented technology to prepare for production and marketing regulation while the patent is in force. The matter is yet to be subject to jurisprudential discussion in Nigeria.

Article 30 explicitly gives members the authority to provide ‘limited exceptions to patent rights under certain conditions’.²⁹⁷ The exception provides three conditions that must be complied with; if one of the three conditions is not complied with it will result in the exception being disallowed.²⁹⁸ The three step test, as it is generally known, is:

- i. exceptions do not unreasonably conflict with normal exploitation of the patent
- ii. do not unreasonably prejudice the legitimate interests of the patent owner and
- iii. takes account of the legitimate interests of third parties.

The three step test²⁹⁹ in article 30 was scrutinised in the *Canada–Patent Protection of Pharmaceutical Products*³⁰⁰ case. In this case it was alleged that Canada’s pharmaceutical invention were not protected under Canadian legislation and that the legislation was not compatible with the TRIPS Agreement because of the reduction in the term of protection for pharmaceutical inventions that are patented as provided for under Articles 27.1, 28 and 33 of

²⁹⁵ Federal Ministry of Health in collaboration with the World Health Organization Nigeria Pharmaceutical Country Profile Published June 2011 p.11.

²⁹⁶ Section 6 (2) PDA 1970 P2 LFN 2004.

²⁹⁷ Abbott, Frederick M., Compulsory Licensing for Public Health Needs: The TRIPS Agenda at the WTO after the Doha Declaration on Public Health. Quaker United Nations Office (Geneva) (QUONO), Occasional Paper 9, February 2002. Pp. 1-57 p.33.

²⁹⁸ Panel Report WT/DS114/R, para 7.20, p.152.

²⁹⁹ The three step test is synonymous with copyright protection but has been extended to patent laws in the TRIPS Agreement.

³⁰⁰ Panel Report, Canada – Patent Protection of Pharmaceutical Products, WT/DS114/R, adopted 7 April 2000.

the TRIPS Agreement. The request was made because section 55.2 (1)³⁰¹ provided a regulatory review exception and section 55.2 (2)³⁰² a stockpiling exception in the Canadian legislation. Canada argued that its section 55.2 (2) complied with each of the three conditions of article 30 of the TRIPS Agreement³⁰³ and called attention to Articles 7 and 8.1 of the TRIPS Agreement as relevant to the purpose and objective of article 30.³⁰⁴

In analysing article 30 the panel started by examining the meaning of ‘limited exception’, and it concluded that ‘limited’ should be used in the narrow context, especially when it is used with exception; and ‘exception’ connoted a ‘limited derogation, one that does not undercut the body of rules from which it is made’. The panel then stated that ‘when a treaty uses the term “limited exception”, the word “limited” must be given a meaning separate from the limitation implicit in the word “exception” itself.’³⁰⁵ And it concluded:

[L]imited exception express a requirement that the exception make only a narrow curtailment of the legal rights which Article 28.1 requires to be granted to patent owners, and that the measure of that curtailment was the extent to which the affected legal rights themselves had been impaired.³⁰⁶

The second requirement under article 30 which the panel looked at was that ‘the exception does not unreasonably conflict with a normal exploitation of the patent’. The panel looked mainly at ‘normal exploitation’ by defining ‘exploitation’ as referring ‘to the commercial activity by which patent owners employ their exclusive patent rights to extract economic value from their patent’, and ‘normal’ was defined as ‘an empirical conclusion about what is common within a relevant community, or to a normative standard of entitlement’.³⁰⁷ The panel stated the normal practice of exploitation is to ‘exclude all forms of competition that could detract significantly from the economic returns anticipated’ by the patent owner, and

³⁰¹ Section 55.2 (1) Canadian Patent Act. ‘It is not an infringement of a patent for any person to make, construct, use or sell the patented invention solely for uses reasonably related to the development and submission of information required under any law of Canada, a province or county other than Canada that regulates the manufacture, construction, use or sale of any product’.

³⁰² Section 55.2 (2) Canadian Patent Act 1985 as amended. ‘It is not an infringement of a patent for any person who makes, constructs, uses or sells a patented invention in accordance with subsection (1) to make, construct or use the invention, during the applicable period provided for by the regulations, for the manufacture and storage of articles intended for sale after the date on which the term of the patent expires.’

³⁰³ Panel Report, WT/DS114/R, para 7.22, p.153.

³⁰⁴ Panel Report, WT/DS114/R, para 7.23, p.153.

³⁰⁵ Panel Report, WT/DS114/R, para. 7.30, p.155.

³⁰⁶ Panel Report, WT/DS114/R, para. 7.44, p.158.

³⁰⁷ Panel Report, WT/DS114/R, para. 7.54, p.161.

concludes that ‘the additional period of market exclusivity in this situation is not a natural or normal consequence of enforcing patent rights.’³⁰⁸

In interpreting article 30, Abbott³⁰⁹ states that ‘unreasonably’ means acts that do not appeal to logic, or are inequitable, ‘conflict’ means to stand in opposition, ‘normal’ means to be within the generally accepted parameters of conduct, and ‘exploitation’ means use. He concludes that the ‘deviations from the enumerated rights of patent holders should not operate inequitably in the context that patents are ordinarily used’.

On the requirement of taking account of the legitimate interests of third parties, the panel defined ‘legitimate interest’ as it is usually used in legal discourse ‘as a normative claim calling for protection of interests that are “justifiable” in the sense that they are supported by relevant public policies or other social norms.’³¹⁰

On the third requirement, Abbott provides a meaning based on the definition of the various words in this step, and states that it ‘means that subject deviations should not inequitably affect expected entitlements of the patent holder, considering the effect on persons that are not directly within the government-patent holder relation’.³¹¹ This definition is even more complex what is in the TRIPS Agreement itself.

According to Taubman, Vagger and Watal the approach adopted by a negotiator in article 30 is simply meant to provide a general principle and by so doing avoid an exhaustive list.³¹² As noted by Cavahlio, unlike Articles 13³¹³ and 26.2,³¹⁴ exceptions in article 30 do not unreasonably conflict with a normal exploitation of the patent and relate to the exploitation

³⁰⁸ Panel Report, WT/DS114/R, para. 7.57, p.161.

³⁰⁹ Abbott, Frederick M., *Compulsory Licensing for Public Health Needs: The TRIPS Agenda at the WTO after the Doha Declaration on Public Health*. Quaker United Nations Office (Geneva) (QUNO), Occasional Paper 9, February 2002. Pp. 1-57 p.35; Abbott use the NEW SHORTER OXFORD DICTIONARY to further define the terminologies in the footnotes.

³¹⁰ Panel Report WT/DS114/R, para 7.69, p.164.

³¹¹ Abbott, Frederick M., ‘Compulsory Licensing for Public Health Needs: The TRIPS Agenda at the WTO after the Doha Declaration on Public Health.’ Quaker United Nations Office (Geneva) (QUNO), Occasional Paper 9, February 2002. Pp. 1-57 p.36.

³¹² Antony Taubman, Hannu Wager, Jayashree Watal (eds) *A Handbook on the WTO TRIPS Agreement* Cambridge University Press Cambridge 2012 p.109.

³¹³ Article 13 TRIPS Agreement relation to Limitations and Exceptions of copyrights.

³¹⁴ Article 26.2 in Agreement relation to Limitations and Exceptions of industrial designs.

of the patents and not the invention, which is an exploitation of the right and not the working of the invention or derivation of revenues from it.³¹⁵ He compares the meaning of normal exploitation in *United States—section 110 (5) of the U.S. Copyright Act*³¹⁶ and points out that the panel added: ‘If “normal” exploitation were equated with full use of all exclusive rights conferred by copyrights, the exception clause of article 13 would be left devoid of meaning. Therefore, “normal” exploitation clearly means something less than full use of an exclusive right.’³¹⁷ He states that ‘the problem with the interpretation of both Panels³¹⁸ is that there is a clear difference between using intellectual property right and using the invention or reproducing the work.’³¹⁹ This assumption is based on the fact that a patent holder has certain rights which he cannot wield without the other party who is infringing. Although, patent rights under the TRIPS Agreement are negative rights, which may mean that the right can be invoked only if it is interfered with,³²⁰ it may be assumed, as well, that the right to prevent another form doing a certain act is the exclusive right an inventor has. Whether the exception relates to the invention, or to the patent right is still subject to much debate after 20 years of the TRIPS Agreement.

In 2007, the 34th WIPO General Assembly requested the Secretariat to submit a Report on the International Patent System to the Standing Committee on Patents (SCP). The Report covers the various needs and interests of member states in the international patent system, such as the economic rationale of the patent system and its role in innovation and technology dissemination, legal and organisational aspects relating to the patent system and issues that are particularly relevant to broader policy considerations and developmental concerns.³²¹ In 2008, WIPO members requested that the Secretariat expound on the preliminary study,

³¹⁵ Nuno Pires de Carvalho *The TRIPS Regime of Patent Rights* Kluwer Law International The Netherland 2012 p.420.

³¹⁶ Panel Report, *United States – Section 110 (5) of the US Copyright Act*, WT/DS160/R, adopted 27 July 2000, DSR 2000:VIII, p. 3769 .

³¹⁷ Panel Report WT/DS160/R, para 6.167, p.44.

³¹⁸ That is the panel and the appellate Body.

³¹⁹ Nuno Pires de Carvalho *The TRIPS Regime of Patent Rights* Kluwer Law International The Netherland 2012 p.420.

³²⁰ ‘Negative rights are non-interference rights’ see Eugene Schlossberger *A Holistic Approach to Rights: Affirmative Action, Reproductive Rights, Censorship and other Generations*. University Press of America Lanham Maryland 2008 p. 32; ‘Negative right is a right of forbearance against others.’ see Jack Donnelly *Universal Human Rights in Theory and Practice*. 3rd ed. Cornell University Press New York 2013 p. 42 .

³²¹ SCP/12/3.

particularly on the issue of exclusions from patentable subject matter and exceptions and limitations to patent rights. At the next session in 2009 there was an agreement to commission external experts to study the exclusions, exceptions and limitations.³²² The study was conducted and published in 2010,³²³ providing useful information for policymakers.

As a follow up, in 2010 Brazil proposed a three phase step³²⁴ which received wide acceptance from other delegations and consequent action, such as commissioning external experts and drafting questionnaires regarding the subject and the replies to the questionnaires. Again in 2013, Brazil insisted on the implementation of the next stage in its 2010 proposal, and at the same time proposed two elements³²⁵ that would effectively address developmental concerns and the conditions for their implementation.³²⁶ Consequently, the

³²² The focus was on, but not limited to, issues suggested by members, such as public health, education, research and experimentation and patentability of life-forms, including from a public policy, socio-economic development perspective, bearing in mind the level of economic development. (Document SCP/13/7, para. 9(c) (i). For more elaborate terms of reference see 14th session of SCP (January 25 and 29, 2010) (document SCP/14/INF/2).

³²³ 15th session of the SCP.

³²⁴ Brazil proposal of a work program on exceptions and limitations to patent rights:

- (i) an exchange of detailed information on all provisions of exceptions and limitations in national or regional legislation, as well as on the experience of implementation of such provisions, including jurisprudence. The first phase should also address why and how countries use – or how they understand the possibility of using – the limitations and exceptions provided in their legislation;
- (ii) an investigation of what exceptions or limitations are effective to address development concerns and what are the conditions for their implementation. It is also important to evaluate how national institutional capacities affect the use of exceptions and limitations; and
- (iii) the elaboration of an exceptions and limitations manual, in a non-exhaustive manner, to serve as a reference for WIPO Members.

³²⁵ The first element is to ask the Secretariat to prepare an analysis of Exceptions and Limitations which are most commonly used by member States in each of the 10 clusters of the questionnaire. This document should take into account public policy objectives and society needs as a whole, including, inter alia, development needs, public health goals and competition.

It should also consider the obstacles member States found when implementing such E&Ls. The second element is a one-day seminar to be held at the next session of the SCP. The seminar would have three segments, as follows:

- (a) A presentation, by the Secretariat, of the findings of the above-mentioned analysis;
- (b) A presentation by the Chief Economist plus two experts from different backgrounds on, inter alia, the effectiveness of exceptions and limitations when addressing developing concerns and how national capacities affect the use of exceptions and limitations; and
- (c) Presentations by member States of case studies on implementation of E&L. This segment would be an opportunity for member States to share their experience, focusing on the conditions for the implementation of E&L, the actual difficulties they have faced, and the solutions to overcome those difficulties. Brazil volunteers to make a presentation and share its experience in this field.

³²⁶ Proposal by the Delegation of Brazil Regarding Exceptions and Limitations to Patent Rights

full application of article 30 by members of the WTO is yet to be determined. A member can propose what they deem fit as an exception or limitation that effectively addresses its own peculiar situation. It should be noted that the series of proposals put forward in WIPO is meant only to assist developing countries in crafting their laws it is the WTO Ministerial Conference alone that can make definite changes regarding the context in which article 30 should be perceived for enacting laws.

6.3.6 Article 31 Other Use without Authorisation of the Right Holder-Compulsory Licence

Article 31 is one of the most controversial aspects of the TRIPS Agreement. This provision is generally referred to as the ‘compulsory licence’ provision as it gives members authorisation to use a patent without the patent holders permission. Although commonly known as the compulsory licences provision, the TRIPS Agreement entitles it ‘other use without authorisation of the right holder’, which includes uses by governments and third parties to meet specific needs.³²⁷ The provision is an additional exception that members can provide in their legislations apart from the limited exceptions mentioned under article 30.³²⁸ The PDA in the First schedule provides for the use of compulsory licences. The provision generally specifies the guidelines and conditions that government and third parties should follow to access the benefit of this provision;³²⁹ it is discussed as follows:

6.3.6.1 Individual Merits

Paragraph (a) makes it clear that permission for other uses without authorisation of the right holder shall be considered on their individual merits. Therefore, there is no general specification that the application has to fit: it is on a case by case basis that such permission will be granted.³³⁰ Granting of automatic license is precluded by this requirement,³³¹ but does

³²⁷ Standing Committee on the Law of Patents Nineteenth Session Geneva, February 25 to 28, 2013 SCP/19/6. Article 31 TRIPS Agreement.

³²⁸ UNCTAD/ICSTD *Resource Book on TRIPS Agreement* p. 462.

³²⁹ Hand book on the WTO p. 132 Hans Morten Haugen, *The Right to Food and the Trips Agreement: With a Particular Emphasis on Developing Countries Measures for Food production and distribution*. Martinus Nijhoff Publishers. BHILL 2007 p. 244.

³³⁰ Hans Morten Haugen, *The Right to Food and the Trips Agreement: With a Particular Emphasis on Developing Countries Measures for Food production and distribution*. Martinus Nijhoff Publishers. BHILL 2007 p. 244; UNCTAD/ICSTD *Resource Book on TRIPS* p.468 Ping Xiong *An International Law Perspective on the Protection of Human Rights in The TRIPS Agreement An Interpretation of the TRIPS*

not prohibit such use in particular circumstances.³³² In Nigeria, the automatic granting of a license still exists in law, and a compulsory license is not limited to any particular field, therefore, all fields of technology can be licensed.³³³ A compulsory licence may be applied for at any time after the expiration of a period of four years from the filing of a patent application or three years after the grant of a patent, on grounds that:

- i. the patent is not worked or not capable of being worked in Nigeria,³³⁴
- ii. the demand for the product is not being met,³³⁵
- iii. the working of the patent is hindered by importation of the same article³³⁶ and
- iv. industrial and commercial activities are unfairly and substantially prejudiced by the patentee's refusal to grant licence on reasonable terms.³³⁷

If any of these grounds are met there is a presumption that the compulsory licence will be issued. Although the PDA does not specifically make reference to consideration on an individual basis, it may be presumed, however, that the procedure for consideration of the application may not be onerous and restrictive. Succinctly as Zaveri³³⁸ states it is 'merely a matter of procedure'. He further states that procedural issues cannot be put above the substantive provisions and the essence of the law: however, an interpretation should be in accordance with the ethical objects and purposes of the TRIPS Agreement.³³⁹ Accordingly,

Agreement in Relation to the Right to Health Martinus Nijhoff Publishers. 2012 p. 194 Chung, Laura, 'Use of Paragraph 6 System for Access to Medicine' (November 13, 2010); North Carolina Journal of International Law & Commercial Regulation, Vol. 36, p. 137, 2010. Available at SSRN: <http://ssrn.com/abstract=1907373>.

³³¹ Ping Xiong *An International Law Perspective on the Protection of Human Rights in The TRIPS Agreement An Interpretation of the TRIPS Agreement in Relation to the Right to Health* Martinus Nijhoff Publishers. 2012 p. 194 Hand book on the WTO p. 112.

³³² K. R. G. Nair *Intellectual Property Rights* Allied Publishers 1994 p.141; UNCTAD/ICSTD *Resource Book on TRIPS Agreement* p. 462.

³³³ See generally the First schedule PDA 1970 P2 LFN 2004.

³³⁴ Paragraph 1 (a) First Schedule PDA 1970 P2 LFN 2004.

³³⁵ Paragraph 1 (b) First Schedule PDA 1970 P2 LFN 2004.

³³⁶ Paragraph 1 (c) First Schedule PDA 1970 P2 LFN 2004.

³³⁷ Paragraph 1 (d) First Schedule PDA 1970 P2 LFN 2004.

³³⁸ Narendra B. Zaveri *TRIPS Agreement and Generic Production of HIV/AIDS Drugs Trading in Knowledge: Development Perspectives on TRIPS, Trade and Sustainability* Christophe Bellmann, Graham Outfield and Ricardo Melendez-Ortiz Earthscan Publication London 2003 p.152.

³³⁹ Narendra B. Zaveri *TRIPS Agreement and Generic Production of HIV/AIDS Drugs* p.152.

because individual merits of each application needs to be considered, broad categories of patent may not be granted compulsory licenses.³⁴⁰

6.3.6.2 Scope

Paragraph (b) lays down situations when such use will be permitted. These include a national emergency, circumstances of extreme urgency and cases of public non-commercial use. Preceding such permitted use there must be efforts to obtain authorisation from the right holder on reasonable commercial terms and conditions and such efforts must not have been successful within a reasonable period of time. Further exceptions to the permitted uses are given for the use of the patent without notifying the patent holder in cases of national emergency or extreme urgency, however, notice must be given to the patent holder as reasonably practicable.³⁴¹ For public non-commercial use by the government or contractors with knowledge of a valid patent, the right holder must be promptly informed. The Nigeria PDA gives the minister or the state commissioner the power to authorise any person in the public interest to purchase, make and exercise or vend any patented article or invention for the service of a government agency in the Federal Republic.³⁴² Public interest is not defined in the PDA and leaves room for different interpretations which may include national emergency, circumstances of extreme urgency and cases of public non-commercial use. It is evident that for a compulsory license to be issued there must be an attempt to obtain a contractual licence on reasonable terms and within a reasonable time.³⁴³ The PDA does not state that the patent holder needs to be informed of the use.

In addition, in a period of emergency the Minister can exercise his power to purchase, make and use an invention for any purpose which he considers expedient. A period of emergency is defined to mean ‘any period of emergency however declared or notified by or on behalf of the Government’.³⁴⁴ Conditions of national emergency and circumstances of extreme

³⁴⁰ Peter Van Den Bossche and Werner Zdouc *The Law and policy of the World Trade Organisation* Cambridge University Press New York 2013 p. 998.

³⁴¹ Article 31(b) TRIPA Agreement.

³⁴² Paragraph 15 First Schedule PDA 1970 P2 LFN 2004.

³⁴³ Paragraph 5 (a) First Schedule PDA 1970 P2 LFN 2004.

³⁴⁴ Paragraph 20 (a) First Schedule PDA 1970 P2 LFN 2004.

urgency may include situations such as, but not limited to, times of war,³⁴⁵ maintaining supply and services essential to life,³⁴⁶ to secure sufficient supply and services essential to life,³⁴⁷ as well as to promote productivity of industry, commerce and agriculture,³⁴⁸ to foster a trade balance³⁴⁹ and to ensure adequate use of resources available.³⁵⁰ Not all these grounds sit well with other members of the WTO, especially the last three, which may not be accepted as a national emergency or extreme urgency. The fact is, paragraph (b) gives members the leeway to define its own grounds according to the specific needs of the country.³⁵¹

Although, Nigeria has adequate compulsory license provisions, the government has not taken advantage of this provision, even in the face of epidemics and a lack of access to the required medication. Clearly national emergencies include access to affordable essential medicines in the situation of a public health crisis such as HIV/AIDS, tuberculosis, malaria and other epidemics.³⁵² In essence, public health crises should include both long term and short term crises³⁵³ and should not be limited to the above mentioned categories of diseases.³⁵⁴

³⁴⁵ Paragraph 23 (d) First Schedule PDA 1970 P2 LFN 2004.

³⁴⁶ Paragraph 20 (b) First Schedule PDA 1970 P2 LFN 2004.

³⁴⁷ Paragraph 20 (c) First Schedule PDA 1970 P2 LFN 2004.

³⁴⁸ Paragraph 20 (d) First Schedule PDA 1970 P2 LFN 2004.

³⁴⁹ Paragraph 20 (e) First Schedule PDA 1970 P2 LFN 2004.

³⁵⁰ Paragraph 20 (f) First Schedule PDA 1970 P2 LFN 2004.

³⁵¹ Narendra B. Zaveri *TRIPS Agreement and Generic Production of HIV/AIDS Drugs Trading in Knowledge: Development Perspectives on TRIPS, Trade and Sustainability* Christophe Bellmann, Graham Outfield and Ricardo Melendez-Ortiz Earthscan Publication London 2003 p.153.

³⁵² Fourth Ministerial Conference Doha Declaration on the TRIPS Agreement and Public Health WT/MIN(01)/DEC/2 20 November 2001 Paragraph 5 (c) provides ‘Each member has the right to determine what constitutes a national emergency or other circumstances of extreme urgency, it being understood that public health crises, including those relating to HIV/AIDS, tuberculosis, malaria and other epidemics, can represent a national emergency or other circumstances of extreme urgency.’

³⁵³ Peter Van den Bossche, Werner Zdouc *The Law and Policy of the World Trade Organization* Cambridge University Press Cambridge 2013 p. 998.

³⁵⁴ Poku Adusei ‘Exploiting Patent Regulatory ‘Flexibilities’ to Promote Access to Antiretroviral Medicines in Sub-Saharan Africa’ (2011) 14 *Journal of World Intellectual Property* 1-23 p.3; see also Outtersson, K. (2008) ‘Should Access to Medicines and TRIPS Flexibilities be Limited to Specific Diseases?’, *American Journal of Law and Medicine*, 34(2–3), 279–301 p. 281

6.3.6.3 Duration

The duration of the compulsory licence shall be limited to the purpose for which it was authorised.³⁵⁵ No mention is made in the PDA of the duration of the compulsory license, however, where the court decides to grant the licence and parties cannot agree on the terms of the licence, it shall be fixed by the court.³⁵⁶ The PDA does not limit the use of a compulsory licence to any specific technology, neither does it limit the use to non-commercial use. Paragraph I of Part 1 of the first schedule does not state that the compulsory licence will be issued only for public non-commercial use, therefore, the compulsory licence can be issued for commercial purposes, especially where the patented invention is capable of being worked in Nigeria but has not been worked,³⁵⁷ or the reasonable demand for the product is not been met by the current degree of working.³⁵⁸ In addition, Paragraph 6³⁵⁹ entitles the licensee to do any act mentioned in section 6 of this PDA.³⁶⁰ On the issue of the use to prevent anti-competitive practises,³⁶¹ Nigeria, at present, does not have an anti-competition law³⁶² which can take care of such situations. However, it is not clear whether the courts can order the use of a compulsory license for such purposes. As there is no law in this field, therefore there is no jurisprudence or decision of a competent court of law in this regard.

³⁵⁵ Article 31 (c) TRIPS Agreement.

³⁵⁶ Paragraph 8 First Schedule PDA 1970 P2 LFN 2004.

³⁵⁷ Paragraph 1 (a) First Schedule PDA 1970 P2 LFN 2004.

³⁵⁸ Paragraph 1(a) First Schedule PDA 1970 P2 LFN 2004.

³⁵⁹ First Schedule PDA 1970 P2 LFN 2004.

³⁶⁰ Section 6 (1) PDA states:

‘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.’

³⁶¹ Article 31(k) TRIPS Agreement.

³⁶² There are six Bills before the National assembly on the issue of anti- competition these are Federal Competition Bill 2002; National Anti-Trust (Prohibitions, Enforcement) Bill 2004; Competition (Anti-Trust) Bill 2007; Nigerian Trade and Competition Commission Bill 2008; Nigerian Anti-Trust (Enforcement, Miscellaneous Provisions), 2008; Competition and Consumer Protection Bill 2009.

6.3.6.4 Non-exclusive Use

Both the TRIPS Agreement³⁶³ and the PDA³⁶⁴ provide that the use shall be non-exclusive. The PDA further provides that the use of the compulsory licence does not entitle the licensee to grant further licences.³⁶⁵ However, it does not specifically mention that it would be non-assignable. Notably, the TRIPS Agreement allows for assignment of the compulsory licence provided it is assigned with the enterprise or goodwill.³⁶⁶ Under the PDA a similar provision exist: which allows the transfer of the compulsory licence with the industrial undertaking. However, such transfers are valid only with the consent of the court.³⁶⁷

6.3.6.5 Domestic Market

Awkwardly, the rights conferred on the patentee under section 6 do not preclude the exporting of the patented product or the process by third parties, unlike the TRIPS Agreement which limits the use of a compulsory licence predominantly to the domestic market. The PDA, on the other hand, makes it clear that a compulsory license shall not be used for importation.³⁶⁸ It does not mention that such uses shall be predominately for the domestic market but rather mentions that the uses of patents for the services of government agencies will be to foster exports³⁶⁹ and defines export as export from Nigeria. The position in the TRIPS Agreement has been changed by Paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health³⁷⁰ which allows exports from country A to country B if it is established that country B has insufficient or no manufacturing capacity in the pharmaceutical sector or could face difficulties in making effective use of the compulsory licence. The ‘Paragraph 6 System’ was put to the test in the case of Canada- Rwanda in 2007, Canada being the exporting member³⁷¹ and Rwanda the eligible importing member³⁷²

³⁶³ Article 31 Paragraph (d) TRIPS Agreement.

³⁶⁴ Paragraph 6 (c) First Schedule PDA 1970 P2 LFN 2004.

³⁶⁵ Paragraph 6 (b) First Schedule PDA 1970 P2 LFN 2004.

³⁶⁶ Article 31 Paragraph (e) TRIPS Agreement.

³⁶⁷ Paragraph 7 First Schedule PDA 1970 P2 LFN 2004.

³⁶⁸ Paragraphs 6 (a) and 20 (e) First Schedule PDA 1970 P2 LFN 2004.

³⁶⁹ Paragraph 20 (e) First Schedule PDA 1970 P2 LFN 2004.

³⁷⁰ Paragraph 6 Doha Declaration on the TRIPS Agreement and Public Health WT/MIN(01)/DEC/2 20 November 2001.

³⁷¹ General Council Decision WT/L/540 Paragraph 1 (c) Paragraph 1 ‘exporting member’ means a member using the system set out in this Decision to produce pharmaceutical products for, and export them to, an eligible importing member.

The ‘paragraph 6 solution’ is a WTO waiver to allow countries with insufficient or no manufacturing capacity to import a drug. It should be noted that the provision relates to public health issues only.³⁷³

6.3.6.6 Termination

Termination of a compulsory licence shall take into consideration the legitimate interest of the licensee under the TRIPS Agreement. The compulsory licence will be discontinued once the circumstance which brought about its use no longer exists. Under the PDA in Paragraph 9³⁷⁴ a similar provision exists giving the licensee reasonable time within which to cease working the invention if an abrupt cessation would cause substantial damage to the licensee. However, termination of the compulsory licence can be done on only the application of the patentee showing that the conditions for granting the licence no longer exist.³⁷⁵ The patentee may apply to the court for the terms of the compulsory licence to be reviewed if the circumstances of the grant cease to exist. On the other hand, the licensee can apply to the court for the variation of the terms of the compulsory licence if the patentee has granted a more favourable contractual licence to another person.³⁷⁶ Termination of the compulsory licence is dependent on the facts put before the court.

6.3.6.7 Remuneration

Under the TRIPS Agreement adequate remuneration is required to be paid to the right holder, taking into account the economic value of the licence. This provision however, has been waived by the decision of the General Council implementing paragraph 6 of the Doha

³⁷² General Council Decision WT/L/540 Paragraph 1 (b) ‘eligible importing member’ means any least-developed country member, and any other member that has made a notification (2) to the Council for TRIPS of its intention to use the system as an importer, it being understood that a member may notify at any time that it will use the system in whole or in a limited way, for example only in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. It is noted that some Members will not use the system set out in this Decision as importing Members (3) and that some other Members have stated that, if they use the system, it would be in no more than situations of national emergency or other circumstances of extreme urgency.

³⁷³ WTO General Council Decision on Implementation of Paragraph 6 Doha Declaration on the TRIPS Agreement and Public Health of 30 August 2003 (“2003 Decision”, WTO document WT/L/540 and Corr.1.)

³⁷⁴ Paragraph 9 (b) First Schedule PDA 1970 P2 LFN 2004.

³⁷⁵ Paragraph 9 (b) First Schedule PDA 1970 P2 LFN 2004.

³⁷⁶ Paragraph 10 First Schedule PDA 1970 P2 LFN 2004.

Declaration for the exporting member.³⁷⁷ It should be noted that this provision on waiver relates only to countries that have insufficient or no manufacturing capacity, therefore, countries with adequate manufacturing capacity cannot benefit from this provision. Paragraph 8³⁷⁸ of the PDA provides adequate royalties to be paid to the right holder having regard to the extent to which the invention is to be worked. The TRIPS Agreement further provides for the review of remuneration by a judicial or distinct higher authority. The PDA on the other hand allows for the terms of the licence to be varied if new facts justify the variation.³⁷⁹

6.3.6.8 Reviews

The validity of a compulsory licence shall be dependent on a review by judicial or distinct higher authority in any member state.³⁸⁰ In Nigeria, the PDA provides that it is a court that reviews applications for compulsory licences,³⁸¹ however, a minister is empowered to authorise such licences where the patent is used for the services of government agencies and where the minister is satisfied that the issue concerns the public interest.³⁸²

6.3.6.9 Anti-competitive Practice

In remedying anti-competitive practices, the use of such a licence does not have to be for a national emergency, extreme urgency or public non-commercial use.³⁸³ The compulsory licence need not be limited to predominantly the domestic market of the issuing member.³⁸⁴

As stated earlier, the PDA makes no reference to anti- competitive practices, but if the

³⁷⁷ Implementation of Paragraph 6 Doha Declaration on the Trips Agreement and Public Health General Council Decision of 30 August 2003 paragraph 3 provides as follows: Where a compulsory licence is granted by an exporting member under the system set out in this Decision, adequate remuneration pursuant to Article 31(h) TRIPS Agreement shall be paid in that member taking into account the economic value to the importing member of the use that has been authorized in the exporting member. Where a compulsory licence is granted for the same products in the eligible importing member, the obligation of that member under Article 31(h) shall be waived in respect of those products for which remuneration in accordance with the first sentence of this paragraph is paid in the exporting member.

³⁷⁸ Paragraph 8 First Schedule PDA 1970 P2 LFN 2004.

³⁷⁹ Paragraph 10 First Schedule PDA 1970 P2 LFN 2004.

³⁸⁰ Article 31 Paragraph (i) TRIPS Agreement.

³⁸¹ Paragraph 1, 4, 8, 9, 10, and 11 First Schedule PDA 1970 P2 LFN 2004.

³⁸² Paragraph 15 First Schedule PDA 1970 P2 LFN 2004.

³⁸³ Article 31(k), with reference to Article 31(b) TRIPS Agreement.

³⁸⁴ Article 31(k), with reference to Article 31(f) TRIPS Agreement.

working of a patent is being hindered by importation of the patented product,³⁸⁵ this may be seen as an anti-competitive practice. The need to correct an anti-competitive practice influences the payment of remuneration to the right holder. A compulsory licence granted for this purpose is not easily terminated, especially where there is a likely recurrence of the situation.³⁸⁶

6.3.6.10 Dependent Patents

Like the TRIPS Agreement, the PDA makes provision for dependent patents.³⁸⁷ Thus, a compulsory licence may be issue to allow the working of a second patent which cannot be exploited without infringing an earlier patent. The licence will be granted only if it performs an industrial function different from the earlier patent³⁸⁸ and the second patent constitutes substantial technical progress in relation to the earlier invention.³⁸⁹ In addition, a compulsory licence will be granted only on condition that there would be a cross licence between the first patentee and the second, if the first patentee makes the request.³⁹⁰ The PDA does not limit the use of the cross licence for either party, therefore it can be presumed that both parties may engage in further licencing and assignment of their rights. The TRIPS Agreement provides that there cannot be an assignment of one without the other.³⁹¹ Whether paragraph 6³⁹² would apply to the issue of cross licencing is questionable.

6.3.7 Revocation/Forfeiture

An opportunity for judicial review of any decision to revoke or forfeit a patent is required to be made available by members.³⁹³ Failure to meet the requirement for the rights granted leads to revocation of such rights. On the other hand, a failure to comply with a condition to

³⁸⁵ Paragraph 1(c) First Schedule PDA 1970 P2 LFN 2004.

³⁸⁶ Article 31(k), with reference to Article 31(f) TRIPS Agreement.

³⁸⁷ Paragraph 2 First Schedule PDA 1970 P2 LFN 2004.

³⁸⁸ Paragraph 2(a) First Schedule PDA 1970 P2 LFN 2004.

³⁸⁹ Paragraph 2(b) First Schedule PDA; This provision is similar to Article 31 (l) (i) TRIPS Agreement.

³⁹⁰ Paragraph 3 First Schedule PDA 1970 P2 LFN 2004.

³⁹¹ Article 31(l) (iii) TRIPS Agreement.

³⁹² Paragraph 6 (b) and (c) First Schedule PDA 1970 P2 LFN 2004; See generally paragraph 6 First Schedule PDA which provides: A compulsory license- (a) entitles the licensee to do any act mentioned in section 6 of this Act except importation; (b) does not entitle the licensee to grant further licences; (c) Shall be non-exclusive, and (d) may contain additional obligations and restrictions as regards both the licensee and the patentee.

³⁹³ Article 32 TRIPS Agreement.

maintain a right, also results in forfeiture.³⁹⁴ It is clear that both acts involve the withdrawal and removal of patent rights.³⁹⁵ No grounds for revocation or forfeiture are stated in the TRIPS Agreement, which leaves room for members to determine on what grounds a patent may be revoked or forfeited. Carvalho, notes this situation has ‘opened a possibility of endless debate and controversy’. The removal or withdrawal is required to be done through a judicial process; this requirement is based on the fact that if the review is done administratively the patent holder may still seek redress in court.

In Nigeria, under section 9 of the PDA, a court may declare a patent null and void if the subject of the patent is not patentable or if the description of the invention or the claim does not conform to the provisions of the PDA.³⁹⁶ Also, if the same invention has been granted a patent in Nigeria as a result of a prior application or an application benefiting from an earlier foreign priority it will be declared null and void.³⁹⁷ Where a declaration that the patent is null and void is made the patent in question shall be deemed to have been null and void since the date it was granted.³⁹⁸ In Nigeria the Federal High Court is the judicial authority responsible for deciding patent issues. The Federal High Court (Civil Procedure) Rules 2009 stipulate the process for nullification of patents.³⁹⁹ Nigeria does not have a stringent examination procedure: there is a tendency that a lot of applications may be subject to this process coupled with the fact that patents are granted at the patentee’s risk and without guarantee of its validity.⁴⁰⁰

6.3.8 Term of Protection of Patent

According to article 33 of the TRIPS Agreement a patent shall be protected for a period of 20 years. The 20 year term cannot be broken down into different stages it must begin from the

³⁹⁴ Nuno Pires de Carvalho *The TRIPS Regime of Antitrust and Undisclosed Information* Kluwer Law International The Netherland 2008 p.151.

³⁹⁵ Thomas Cottier and Pierre Véron (eds) *Concise International and European IP Law: TRIPS, Paris Convention, European*. 2nd ed. Kluwer Law International, The Netherland 2011 p.104.

³⁹⁶ Section 3(2) PDA 1970 P2 LFN 2004.

³⁹⁷ Section 9 (1) (c) PDA 1970 P2 LFN 2004.

³⁹⁸ Section 9 (4) PDA 1970 P2 LFN 2004.

³⁹⁹ Order 53C Rule 8 Federal High Court (Civil Procedure) Rules 2009.

⁴⁰⁰ Section 4 (4) PDA 1970 P2 LFN 2004.

date of filing the patent application.⁴⁰¹ The term of protection of a patent under section 7 is 20 years from the date of filling the application, subject to the payment of the prescribed annual fees by the patentee.⁴⁰² Failure to renew the patent annually may lead to the lapse of the patent. There is a grace period of six months allowed for the payment of such fees and the patent shall continue as if the fees had been duly paid.⁴⁰³ There is no provision in the PDA for the extension of the 20 year term. Neither can the term of protection be reduced.

The requirement of a 20 year term in the TRIPS Agreement is a minimum standard and members are free to provide a longer term of protection.⁴⁰⁴ Generally, most countries provide a period of 20 years.⁴⁰⁵ This provision has however been extended in countries where considerable time has passed from the time of the grant to placing the product on the market.⁴⁰⁶ In 1992 the EU came up with a Council Regulation (EEC) concerning the creation of a supplementary protection certificate for medicinal products.⁴⁰⁷ This regulation was set up to remedy the disparities and shortcomings in national patenting systems for pharmaceutical research and to guarantee sufficient protection for the development of medicinal products in the EU. The decision was based on the fact that adequate amortisation of investment in research will be compromised and insufficient protection may lead to company flight to other countries. However, such an extension may not exceed 5 years⁴⁰⁸ or 15 years maximum duration of protection of the patent from the holder's first marketing authorisation.⁴⁰⁹

This regulation serves as a sort of extension for pharmaceutical patents. However, a semblance of a reduction in the term of protection has been met with resistance. In *Canada*–

⁴⁰¹ Canada – Patent Protection of Pharmaceutical Products, WT/DS114/R.

⁴⁰² Section 7 (2) PDA 1970 P2 LFN 2004.

⁴⁰³ Section 7 (2) (a) and (b) PDA 1970 P2 LFN 2004.

⁴⁰⁴ Thomas Cottier and Pierre Véron (eds) Concise International and European IP Law: TRIPS, Paris Convention, European 2nd ed. Kluwer Law International The Netherlands 2011 p.106.

⁴⁰⁵ Section 46 (1) South Africa Patents Amendment Act, No. 58 of 2002.

⁴⁰⁶ Are Patents Renewable or may the Term of Protection be Extended? available at http://www.wipo.int/sme/en/faq/pat_faqs_q7.html. accessed 11 October 2013.

⁴⁰⁷ Council Regulation (EEC) No 1768/92 of 18 June 1992 Concerning the Supplementary Protection Certificate for Medicinal Products. REGULATION (EC) No 469/2009 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 6 May 2009 Concerning the supplementary protection certificate for medicinal products.

⁴⁰⁸ Article 13 Council Regulation (EEC) No 469/2009.

⁴⁰⁹ Recital 9 Council Regulation (EEC) No 469/2009. See also Thomas Cottier and Pierre Véron (eds) Concise International and European IP Law p.106.

Term of Patent Protection,⁴¹⁰ the US requested consultations with Canada contending that section 45 of the Canadian Patent Act,⁴¹¹ which provided only 17 years of patent protection from the date of grant or 20 years from the filing date instead of an outright term of 20 years from the date of filing as required by the TRIPS Agreement, is inconsistent with article 33 of the TRIPS Agreement. Canada argued that the ‘substantive’ or ‘effective’ term of protection contemplated by both section 45 and article 33 are equivalent,⁴¹² taking into consideration the regulatory procedures and practices, a patent has to go through before it is issued. The Appellate Body stated:

to demonstrate that the patent term in Article 33 is ‘available’, it is not sufficient to point, as Canada does, to a combination of procedures that, when used in a particular sequence or in a particular way, may add up to twenty years.... The grant of the patent must be sufficient in itself to obtain the minimum term mandated by Article 33. The use of the word ‘available’ in Article 33 does not undermine but, rather, underscores this obligation.⁴¹³

Consequently, WTO members are obligated to make available a minimum of 20 years for the protection of patents, which Nigeria already does.

6.3.9 Process Patents: Burden of Proof

Article 34 shifts the burden of proof in process patent to the infringer, which is logical, considering the nature of a process patent. The rule of evidence that he who asserts must prove does not apply to the case of infringement of a process patent.⁴¹⁴ This reversal of the burden of proof dates back to 1891 when it was first incorporated⁴¹⁵ in the *German*

⁴¹⁰ *Canada – Term of Patent Protection* WT/DS170/AB/R.

⁴¹¹ Section 45. (1) Subject to section 46, where an application for a patent is filed under this Act before October 1, 1989, the term limited for the duration of the patent is *seventeen years* from the *date on which the patent is issued*. (emphasis added) Term from date of issue or filing (2) Where the term limited for the duration of a patent referred to in subsection (1) had not expired before the day on which this section came into force, the term is *seventeen years from the date on which the patent is issued or twenty years from the filing date, whichever term expires later*. (emphasis added).

⁴¹² WT/DS170/AB/R Report of the Appellate Body para. 20 p.6.

⁴¹³ WT/DS170/AB/R Report of the Appellate Body para. 92 p.27.

⁴¹⁴ Sisule F Musungu *The TRIPS Agreement and Public Health* Carlos María Correa, Abdulqawi Yusuf. (eds) *Intellectual Property and International Trade: The TRIPS Agreement* Kluwer Law International The Netherlands p. 439.

⁴¹⁵ Miguel Vidal-Quadras Trias de Bes *Process patents on new products and reversal of the burden of proof: factors contributing to the interpretation of its scope* E.I.P.R. 2002, 24(5), 237-243 p.237 Sisule F Musungu ‘*The TRIPS Agreement and Public Health*’ Carlos María Correa, Abdulqawi Yusuf. (eds) *Intellectual Property and International Trade: The TRIPS Agreement* Kluwer Law International The Netherlands p. 439.

Patentgesetz.⁴¹⁶ Thus, where a process patent is concerned, he, who is alleged to have infringed a process for obtaining a product, must prove that the process of obtaining an identical product is different from the patented process. The purpose of reversing this rule of evidence is to achieve an impossible proof. Vidal-Quadras Trias de Bes observes that the impracticality of the plaintiff getting access to the manufacturing process of the infringer is the motive behind the reversal of this procedural rule.⁴¹⁷ In addition, Musungu points out that right holder would not have been able to prevent uncontrolled manufacturing of generic products if the burden of proof remained on the plaintiff.

Members are under the obligation to empower judicial authorities where there is no such procedure in regards to patent infringement. It is now required that such a procedure be included in their procedural rules. In Nigeria, where he who asserts must prove means that this specific provision has to be added to the Federal High Court (Civil Procedure) Rules⁴¹⁸ to enable the court give such orders that the defendant must prove that the process of obtaining an identical product is different from the patented process. In Nigeria, where no reversal rule exist if the plaintiff cannot prove that the identical product produced without his consent is the same process, the defendant cannot be held guilty of infringing the patented process. However, if an identical product is produced without the consent of the patent owner and the product obtained by the patented process is new⁴¹⁹ or there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used,⁴²⁰ in the absence of proof to the contrary it will be deemed to have been obtained by the patented process. No reversal rule is in place, but the defendant will not be successful if the above circumstances exist.

⁴¹⁶ German Patent Law.

⁴¹⁷ Miguel Vidal-Quadras Trias de Bes 'Process patents on new products and reversal of the burden of proof: factors contributing to the interpretation of its scope' *European Intellectual Property Review* 2002, 24(5), 237-243 p.237.

⁴¹⁸ See generally Order 53 Appeals and Applications under the Trade Marks Act and Patents and Designs Act Federal High Court (Civil Procedure) Rules 2009.

⁴¹⁹ Article 34.1 (a) TRIPS Agreement.

⁴²⁰ Article 34.1 (b) TRIPS Agreement.

Where it has been determined that the product obtained by the patented process is new or there is a substantial likelihood that the identical product was made by the process and the owner of the patent is unable through reasonable efforts to determine the process actually used, members are free to employ the reversal burden of proof⁴²¹ in relation only to newly patented products and products made through a process which the patent owner has not been able to determine.

As further provided by the TRIPS Agreement, in the event of the plaintiff's failure to prove infringement, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taking into consideration as well.⁴²²

6.4 Sector-specific Implication of the TRIPS Agreement on Patents

This section focuses on the implications of TRIPS Agreement on the Patents legislation. The impact of the minimum standard provided by the TRIPS Agreement on patents has aroused wide interest, especially with regards to public health. Other issues such as technology transfer, innovation, research and development (R&D) and foreign direct investment (FDI) are also affected by the TRIPS Agreement and will be examined in this section.

6.4.1 Public Health

Public health refers to public or privately organised measures to prevent disease, promote health, and prolong life among people generally with the aim of offering people healthy living conditions as well as the eradication of disease.⁴²³ Two of the main functions of public health are to formulate public policies intended to solve local and national health problems by identifying priorities to ensure that all populations have access to appropriate and cost-effective care, including health promotion and disease prevention services.⁴²⁴

How does the TRIPS Agreement affect the proper functioning of the public health care system in Nigeria in particular? It is believed that patent rights block access to drugs and

⁴²¹ Article 34.2 TRIPS Agreement.

⁴²² Article 34.3 TRIPS Agreement.

⁴²³ WHO, Public health, available at <http://www.who.int/trade/glossary/story076/en/#> accessed 16 October 2013.

⁴²⁴ WHO, Public health, available at <http://www.who.int/trade/glossary/story076/en/#> accessed 16 October 2013.

create a monopoly by which the price can be determined by the patent holder.⁴²⁵ Other beliefs include the view that granting exclusive commercial rights can lead to an increase in the cost of the drugs, thereby affecting access to essential affordable medicines,⁴²⁶ especially has generic medicines may not be readily available. For Adusei, the fact that compulsory license are still subject to the approval of the WTO and cannot be automatically utilised creates a form of inflexibility of the flexibility and as a result limits access to life saving medicines.⁴²⁷

6.4.1.1 Access to Essential Medicine

The effect of patent laws on public health was highlighted in the South Africa HIV/AIDS saga: the lack of access or inadequate access to medicines can cause a pandemic if patented drugs are beyond the reach of many and access to the generic versions is hindered by the enforcement of patent rights. The 1997 Medicines and Related Substance Control Amendment Act of South Africa⁴²⁸ was enacted in response to the HIV/AIDS pandemic. The Act was aimed at making medicines more affordable through the generic substitution of off-patent medicines and medicines produced under compulsory licenses, as well as through

⁴²⁵ International Institute for Sustainable Development. TRIPS and Public Health IISD Trade and Development Brief No. of a Series 2003.p.1 available at http://www.iisd.org/pdf/2003/investment_sdc_dec_2003_9.pdf 16 October 2013.

⁴²⁶ 3D Trade - Human Rights - Equitable Economy (3D THREE) The impact of trade-related intellectual property rights on access to affordable medicines and human rights Outline of a presentation to the NGO Forum for Health 30 September 2004 available at http://www.humanrights.ch/upload/pdf/051111_tripsandaffordablemedicine_3D2004.pdf accessed 16 October 2013.

⁴²⁷ Poku Adusei 'Regulatory Diversity as Key to the "Myth" of Drug Patenting in Sub-Saharan Africa' (2010) 54, *Journal of African Law*, 26-50 p.41

⁴²⁸ Medicines and Related Substances Control Amendment Act 90 of 1997 see section 15C - Measures to ensure supply of more affordable medicines. The Minister may prescribe conditions for the supply of more affordable medicines in certain circumstances so as to protect the health of the public, and in particular may-

- (a) notwithstanding anything to the contrary contained in the Patents Act, 1978 (Act 57 of 1978), determine that the rights with regard to any medicine under a patent granted in the Republic shall not extend to acts in respect of such medicine which has been put onto the market by the owner of the medicine, or with his or her consent;
- (b) prescribe the conditions on which any medicine which is identical in composition, meets the same quality standard and is intended to have the same proprietary name as that of another medicine already registered in the Republic, but which is imported by a person other than the person who is the holder of the registration certificate of the medicine already registered and which originates from any site of manufacture of the original manufacturer as approved by the council in the prescribed manner, may be imported;
- (c) prescribe the registration procedure for, as well as the use of, the medicine referred to in paragraph (b).

parallel importation of patented drugs from countries in which these drugs are sold at a lower price.

The question needs to be asked concerning the accessibility of medicines by Nigerians. The lack of access cannot be overstated. In 2010, the Federal Ministry of Health in Nigeria, in conjunction with the World Health Organisation (WHO) and the European Union (EU), carried out a study on adequate supplies of effective, affordable, safe and good quality medicines in order to promote the rational use of medicines.⁴²⁹ The study showed that over 76% of the chronically ill were unable to obtain medicines for a 30 day supply.⁴³⁰ In addition, it stated that the cost of medicines is excessive and constitutes a barrier to access.⁴³¹ Access to medicines was illustrated by determining factors, such as a patient's access to various medical products and services.⁴³² Hassim, Heywood and Berger acknowledge that access to medicines is certain only if there are affordable medicines which are consistent and enduring.⁴³³ Therefore, in the absence of this guarantee of affordable medicine supply there is an exclusion from access to medicines, which is more evident in the case of certain diseases⁴³⁴ in Nigeria.

There is no doubt that Africa carries the largest burden in relation to many diseases such as HIV/AIDS, malaria and cancer. Nigeria in particular is known to have over two million people with some type of invasive cancer or the other, annually about 100,000 are diagnosed of which at least 80,000 die, 'making cancer one of the nation's highest causes of death'.⁴³⁵

⁴²⁹ Federal Ministry of Health, Nigeria Access To And Rational Use of Medicines at the Household Level 2010 p. 4 available at <http://apps.who.int/medicinedocs/documents/s16887e/s16887e.pdf> 16 October 2013.

⁴³⁰ Federal Ministry of Health, Nigeria Access to and Rational Use of Medicines at the Household Level 2010 p.26 available at <http://apps.who.int/medicinedocs/documents/s16887e/s16887e.pdf> 16 October 2013.

⁴³¹ Federal Ministry of Health, Nigeria (2005). Prices people pay for Medicines in Nigeria. Published by the Federal Ministry of Health in collaboration with the World Health Organization, EC&DFID.

⁴³² Local Production for Access to Medical Products: Developing a Framework to Improve Public Health. Geneva, World Health Organization, 2011 available at http://www.who.int/phi/publications/Local_Production_Policy_Framework.pdf accessed 18 October 2013.

⁴³³ Adila Hassim, Mark Heywood, Jonathan Berger Health and Democracy: A Guide to Human Rights, Health Law and Policy in Post-Apartheid South Africa, Siber Ink Westlake, 2007 p.438.

⁴³⁴ Such disease include HIV/AIDS, cancer and Tuberculosis.

⁴³⁵ Sola Ogundipe Nigerians pay for cancer treatment with their lives Vanguard Sunday September 22, 2013 available at <http://www.vanguardngr.com/2013/09/nigerians-pay-for-cancer-treatment-with-their-lives/#sthash.2GET1oKO.dpuf> accessed 20 November 2013

According to the National Agency for the Control of AIDS (NACA), Nigeria carries the second largest burden of HIV in Africa and the third in the world, with an expanding population of People Living with HIV (PLHIV).⁴³⁶ Currently, the population of Nigeria is estimated at over 160 million,⁴³⁷ making it the most populated country in Africa.⁴³⁸ It is estimated that there are 3,459,363 people now living with HIV in Nigeria with an estimated 1,449,166 requiring Anti-Retroviral (ARV) treatment. In a Nigerian daily newspaper alarm was sounded concerning the prevention of mother-to-child HIV transmission (PMTCT), stating that only 4.7 per cent of antenatal clinics (ANC) administered such services in Nigeria. In 2011 only 18 per cent of pregnant women living with HIV (PWLHIV) received more effective ARVs for prevention of mother to child transmission (PMTCT), only 11 per cent of children born to PWLHIV received ARVS for PMTCT and 4 per cent of infants born to PWLHIV were tested for HIV within two months of birth in 2010.⁴³⁹

According to the 2013 progress report on the ‘Global Plan towards the elimination of new HIV infections among children by 2015 and keeping their mothers alive’, ‘Nigeria accounts for one third of all new HIV infections among children, in the 21 priority countries in sub-Saharan Africa,⁴⁴⁰ the largest number for any country. Progress here is therefore critical to eliminating new HIV infections among children globally.’⁴⁴¹ The report states that 8 out of 10 PWLHIV do not have access to antiretroviral therapy for their own health, 8 out of 10

⁴³⁶ National Agency for the Control of AIDS Federal Republic of Nigeria Global Aids Response Country Progress Report Nigeria GARPR 2012 p.10 available at <https://www.unaids.org/en/dataanalysis/knowyourresponse/countryprogressreports/2012countries/Nigeria%202012%20GARPR%20Report%20Revised.pdf> 17 October 2013.

⁴³⁷ United Nation Statistic Division available at <http://data.un.org/CountryProfile.aspx?crName=NIGERIA> accessed 17 October 2013.

⁴³⁸ World Gazetteer Nigeria: Administrative Divisions (Population and Area) available at <http://archive.is/20130105070103/http://www.world-gazetteer.com/wg.php?x=&men=gadm&lng=en&des=wg&geo=-158&srt=npan&col=abcdefghinoq&msz=1500> accessed 17 October 2013.

⁴³⁹ Chioma Umeha 23.9% pregnant women access ARV in Nigeria: As gap in mother-to-child HIV infection widens Daily Newswatch Thursday August 29 2013 available at <http://www.mydailynewswatchng.com/2013/08/29/23-9-pregnant-women-access-arv-nigeria/> 17 October 2013.

⁴⁴⁰ Angola, Botswana, Burundi, Cameroon, Chad, Côte d’Ivoire, Democratic Republic of the Congo, Ethiopia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Nigeria, South Africa, Uganda, United Republic of Tanzania, Swaziland, Zambia and Zimbabwe.

⁴⁴¹ UNAIDS 2013 Progress Report on the ‘Global Plan towards the elimination of new HIV infections among children by 2015 and keeping their mothers alive’ UNAIDS / JC2509/1/E (English original, June 2013) p. 60. http://www.unaids.org/en/media/unaids/contentassets/documents/unaidspublication/2013/20130625_progress_global_plan_en.pdf .

women or their infants did not receive antiretroviral medicines during breastfeeding to prevent mother-to-child transmission and 8 out of 10 PWLHIV did not receive antiretroviral medicines to prevent MTCT of HIV.⁴⁴² It was reported in the 2012 United Nations Programme on HIV/AIDS (UNAIDS) Regional Fact Sheet that one in five, 20 percent, of the people living with HIV feel suicidal because of their HIV status.⁴⁴³

Malaria is a dreaded disease common in tropics and prevalent in Nigeria. Currently Nigeria has one of the highest populations at risk: a 100% of its population is at risk as at 2011.⁴⁴⁴ Although, there is insufficient consistent data, the report established that less than 20% of cases are potentially treated with anti-malarial medicines, and found that Nigeria had a cumulative proportion of the global estimated cases of less than 30% and deaths of less than 40%. The percentage of malaria deaths among children under five in Nigeria ranges between 16 and 20%.⁴⁴⁵ The Democratic Republic of the Congo and Nigeria account for over 40% of the estimated total of malaria deaths globally.⁴⁴⁶

6.4.1.2 Access to Medical Devices

Access to essential medicines is not the only problem faced in relation to public health. A lack of access to high-quality, safe, and appropriate, priority medical devices⁴⁴⁷ which have an essential role to play, from screening to diagnosis and treatment,⁴⁴⁸ may lead to a deprivation of health services.

⁴⁴² UNAIDS 2013 Progress Report p.60-61.

⁴⁴³ UNAIDS Regional Fact Sheet 2012 available at https://www.unaids.org/en/media/unaids/contentassets/documents/epidemiology/2012/gr2012/2012_FS_regional_ssa_en.pdf accessed 17 October 2013.

⁴⁴⁴ World Malaria Report 2012 p. 72 available at http://www.who.int/malaria/publications/world_malaria_report_2012/report/en/index.html accessed 17 October 2013.

⁴⁴⁵ UNICEF, Invest in the Future: Defeat Malaria World Malaria Day 2013 Focus on Africa p.4 available at http://www.unicef.org/health/files/Malaria_brochure_18April2013.pdf accessed 17 October 2013.

⁴⁴⁶ World Malaria Report 2012 p. 72.

⁴⁴⁷ Medical device is defined as “An article, instrument, apparatus or machine that is used in the prevention, diagnosis or treatment of illness or disease, or for detecting, measuring, restoring, correcting or modifying the structure or function of the body for some health purpose. Typically, the purpose of a medical device is not achieved by pharmacological, immunological or metabolic means.”

⁴⁴⁸ WHO, Medical Devices, Priority medical devices available at http://www.who.int/medical_devices/access/en/ accessed 17 October 2013.

The WHO Assembly passed its first resolution on Health Technologies⁴⁴⁹ in May 2007.⁴⁵⁰ The resolution was based on a project called Priority Medical Devices (PMD) which was launched by the WHO at the request of the Government of the Netherlands to identify inequalities in the available preventive, diagnostic, therapeutic and assistive medical devices on the market by determining whether the needs of health care providers and end-users throughout the world are been met and if not, to propose remedies to resolve such inadequacies or shortcomings.⁴⁵¹

Access to medical devices has been defined in terms of the various factors that determine the extent of a patient's access to medical devices and services. These factors include the availability, affordability, accessibility, appropriateness, acceptability and quality of the medical device.⁴⁵² The focus also encompasses an 'accessory to a medical device', which is an 'article intended specifically by its manufacturer to be used together with a particular medical device to enable or assist that device to be used in accordance with its intended use'.⁴⁵³ The WHO Report on improving access to medicines in developing countries through technology transfer and local production states:

These dimensions interact; for example, a medicine may be available within the private sector but may not be accessible to poor people if the price is too high. Similarly, there is an interdependence of products and services, such that medicines may be available

⁴⁴⁹ This term refers to the application of organized knowledge and skills in the form of devices, medicines, vaccines, procedures and systems developed to solve a health problem and improve quality of life. It is used interchangeably with 'health care technology'. Resolution WHA60.29. Health Technologies. In: Sixtieth World Health Assembly. Geneva, 23 May 2007. Available at http://www.who.int/medical_devices/resolution_wha60_29-en1.pdf accessed 17 October 2013. See also WHO, Local Production and Technology Transfer to Increase Access to Medical Devices Addressing the barriers and challenges in low- and middle-income countries 2012 available at http://www.who.int/medical_devices/1240EHT_final.pdf accessed 17 October 2013.

⁴⁵⁰ WHO Sixtieth World Health Assembly Health Technologies WHA60.29 available at http://www.who.int/medical_devices/resolution_wha60_29-en1.pdf accessed 17 October 2013.

⁴⁵¹ WHO. Medical Devices, Priority medical devices.

⁴⁵² Local Production and Technology Transfer to Increase Access to Medical Devices Addressing the barriers and challenges in low- and middle-income countries 2012 available at http://www.who.int/medical_devices/1240EHT_final.pdf 17 October 2013; Local Production for Access to Medical Products: Developing a Framework to Improve Public Health. Geneva, World Health Organization, 2011 available at http://www.who.int/phi/publications/Local_Production_Policy_Framework.pdf accessed 18 October 2013.

⁴⁵³ Global Harmonization Task Force Definition of the Terms 'Medical Device' and 'In Vitro Diagnostic (IVD) Medical Device' (revision of GHTF/SG1/N29:2005) available at <http://www.imdrf.org/docs/ghtf/final/sg1/technical-docs/ghtf-sg1-n071-2012-definition-of-terms-120516.docx> accessed 18 October 2013.

within a country but access is denied if the person does not have access to diagnosis or screening.

A major reason for health care problems in Nigeria can be attributed to outdated medical devices and insufficient medical equipment and supplies. According to a professor of Haematology and Blood Transfusion, the lack of adequate laboratory equipment in Nigeria has accounted for a high wastage of blood components.⁴⁵⁴ The Nigerian Medical Association (NMA) notes that Lokoja, the capital of Kogi State, does not have equipment to handle kidney-related diseases.⁴⁵⁵ Treatment and management of cancer is an uphill task as there is little radiotherapy equipment and it is available only at a high cost in Nigeria.⁴⁵⁶ It has been widely reported that over ₦41 billion is spent annually on ‘medical tourism’⁴⁵⁷ to India alone as a result of the unsafe conditions of most hospitals in Nigeria.⁴⁵⁸ The country lacks essential equipment and supplies for handling trauma cases caused by road traffic crashes and injury accidents.⁴⁵⁹ Needless to say, there is critical shortage of infrastructure and know-how to produce effective health care in Nigeria.

Industrialised countries have a better research and development culture and infrastructure. They have access to state of the art medical devices for the better investigation of disease. In Nigeria, most of the pharmaceutical companies have outdated technology and cannot cope

⁴⁵⁴ Chijioke Iremeka Inadequate Modern Equipment, Ill-trained Manpower Create Fresh Challenges. *The Guardian*, Sunday, 28 July 2013 00:00 available at <http://www.ngrguardiannews.com/sunday-magazine/newsfeature/128278-inadequate-modern-equipment-ill-trained-manpower-create-fresh-challenges> accessed 18 October 2013.

⁴⁵⁵ Isiaka Wakili Kogi Hospitals Not Equipped for Kidney Diseases –NMA Daily Trust, Tuesday, 14 September 2010 available at <http://allafrica.com/stories/201009140519.html> accessed 18 October 2013.

⁴⁵⁶ Chukwuma Muanya When ignorance, ill-equipped hospitals complicate breast cancers in Nigeria *The Guardian*, Monday, 29 October 2012 01:00 available at http://www.ngrguardiannews.com/index.php?option=com_content&id=103128%3Awhen-ignorance-ill-equipped-hospitals-complicate-breast-cancers-in-nigeria&Itemid=414 accessed 18 October 2013.

⁴⁵⁷ Medical tourism refers to travelling from one country to another by people seeking medical treatment usually people from less developed countries with low quality health care to countries with affordable quality and cheap medical treatment that is unavailable in their own countries. Also people in countries with expensive health care seek medical treatment in countries with cheaper but good quality medical expertise. Michael D. Horowitz, Jeffrey A. Rosensweig, Christopher A. Jones, ‘Medical Tourism: Globalization of the Healthcare Marketplace’. *MedGenMed*. 2007; 9(4): 33.

⁴⁵⁸ ‘Nigerians spend ₦41bn annually on medical treatment in India.’ *Vanguard*, Wednesday, July 24, 2013 available at <http://www.vanguardngr.com/2013/07/nigerians-spend-n41bn-annually-on-medical-treatment-in-india-gov-orji/> accessed 18 October 2013.

⁴⁵⁹ *Vanguard*, Most Nigerian hospitals lack equipment – FRSC on June 26, 2013 available at <http://www.vanguardngr.com/2013/06/most-nigerian-hospitals-lack-equipment-frsc/> accessed 18 October 2013.

with the current innovations in medicines needed for public health solutions. Medical devices, as well, may be out of reach in developing countries. Some technologies needed for healthcare purposes are protected by patents as are the processes of making them. These are barriers to accessing proper health care.

6.4.1.3 Summary

It has been said that the TRIPS Agreement pays insufficient attention to the level of development, varying interests and priorities of developing and least developed countries. The protection of medicine leading to an adverse effect on public health is held up as an example.⁴⁶⁰ The Coalition of Civil Society Groups on Access to Essential Medicines Report points out that ‘patent monopoly can affect the availability and affordability of essential medicines’. The report compared prices of essential drugs in Nigeria to the cost in other countries and found that prices were up to 79% lower in European countries despite the fact that these drugs were imported by the brand name companies into Nigeria.⁴⁶¹ Prices are lower in other less developed countries: Colombia and Guatemala are not European countries and are developing.⁴⁶² An absence of generic competitors causes a form of monopoly and is held responsible for the high cost.⁴⁶³

In 2011, the United Nations Industrial Development Organisation (UNIDO) undertook a study to determine the capability of pharmaceutical manufacturing industries in Nigeria to provide needed drugs for priority diseases, such as HIV/AIDS, malaria, tuberculosis and neglected tropical diseases.⁴⁶⁴ The report observed that only about 40 per cent of the

⁴⁶⁰ UN Millennium Project Investing in Development a practical plan to achieve the Millennium Development Goals ch.14 p.219 available at <http://www.unmillenniumproject.org/documents/MainReportComplete-lowres.pdf> accessed 18 October 2013.

⁴⁶¹ Coalition of Civil Society Groups on Access to Essential Medicines a Price Comparison of Selected Drugs in Nigeria available at <http://www.nigeria-aids.org/Reports/AccessPriceComparison.doc> accessed 18 October 2013.

⁴⁶² Roche’s rocephine (branded version of ceftriaxone), is 58% less expensive in Colombia and Glaxo’s Combivir (association of AZT+lamivudine for HIV) is 43% less expensive in Guatemala than in Nigeria.

⁴⁶³ The Patent for Combivir expired 15 May 2012. The drug is now in the public domain and manufacturers that have the capacity to produce it are free to do so although less expensive generic have been permitted since 1997.

Global UNIDO Project: Strengthening the local production of essential generic drugs in least developed and developing countries Pharmaceutical Sector Profile: Nigeria available at http://www.unido.org/fileadmin/user_media/Services/PSD/BEP/Nigeria_Pharma%20Sector%20Profile_032011_Ebook.pdf accessed 18 October 2013.

manufacturing capability is being utilised and, although some of the national and regional demand can be met with the currently available production capacity, there are other socio-economic factors which inhibit production.⁴⁶⁵

The WHO's annual World Health Statistics Report 2013, which presents the most current health statistics for member states, shows that in relation to access to essential medicines the median availability of selected generic medicines in the public sector is 26.2% and the private sector 36.4%. The median consumer price ratio of selected generic medicines in the public sector is 3.5% and in the private sector is 4.3%, in Nigeria.⁴⁶⁶ These fall within a very low access range as grouped by the WHO Department of Essential Drugs and Medicines Policy. Currently Nigeria ranks 197 out of 200 WHO nations.⁴⁶⁷

Why are drugs for priority diseases still expensive in Nigeria? The answer is complex. Nigeria has many legal barriers in the PDA that makes it difficult to take advantage of the flexibilities in the TRIPS Agreement and the Doha Declaration on the TRIPS Agreement. If the law is not amended or if the government fails to create special provisions that use the advantages offered by the flexibilities, there will be an inadequate supply of essential medicines and medical devices resulting in needless deaths. In addition, other non-legal initiatives such as collaboration with EUROPEAID, the Global Fund, Medicines Patent Pool (MPP) PEPFAR (the US President's Emergency Plan for AIDS Relief) and the World Bank⁴⁶⁸ is important to create access to quality, appropriate and affordable medicines.

⁴⁶⁵ Global UNIDO Project: Strengthening the local production of essential generic drugs in least developed and developing countries Pharmaceutical Sector Profile: Nigeria p.29 available at http://www.unido.org/fileadmin/user_media/Services/PSD/BEP/Nigeria_Pharma%20Sector%20Profile_032011_Ebook.pdf accessed 18 October 2013.

⁴⁶⁶ WHO, World health Statistic 2013 available at http://apps.who.int/iris/bitstream/10665/81965/1/9789241564588_eng.pdf accessed 17 October 2013.

⁴⁶⁷ WHO, World health statistics 2013. available at http://www.who.int/gho/publications/world_health_statistics/EN_WHS2013_Full.pdf accessed 17 October 2013.

⁴⁶⁸ Poku Adusei 'Exploiting Patent Regulatory 'Flexibilities' to Promote Access to Antiretroviral Medicines in Sub-Saharan Africa' (2011) 14 *Journal of World Intellectual Property* 1-23 p.9.

6.4.2 Technology Transfer

The developed countries offered technology transfer as an incentive during the negotiation of the TRIPS Agreement⁴⁶⁹ in maintaining the protection of intellectual property right in developing and least-developed countries.⁴⁷⁰ The expectation of developing countries was that stronger intellectual property protection would encourage technology transfer, this perception has shifted dramatically.⁴⁷¹

According to the United Nations Conference on Trade and Development (UNCTAD): ‘technology transfer is the process by which commercial technology is disseminated’.⁴⁷² Access to the right technology is vital to the growth of any nation. Twelve years later Correa notes that the North-South technological gap is widening and there has been no increase in technology transfer to the developing countries. Instead he observes, big companies are forming ‘strategic alliances’⁴⁷³ which increase their dominance in the generation and use of technology⁴⁷⁴ whereas developing countries are still struggling to obtain technology transfer that enhances economic development. It has been observed that technology transfer is a

⁴⁶⁹ Tú Thanh Nguyễn Competition Law, Technology Transfer and the TRIPS Agreement: Implications for Developing Countries Edward Elgar Cheltenham 2010 p. 29-30; see also Poku Adusei ‘Regulatory Diversity as Key to the ‘Myth’ of Drug Patenting in sub-Saharan Africa’ (2010) 54 *Journal of African Law* 26-27.

⁴⁷⁰ WTO, Technology transfer available at http://www.wto.org/english/tratop_e/trips_e/techtransfer_e.htm accessed 19 October 2013.

⁴⁷¹ Tana Pistorius ‘The Impact of Intellectual Property Law and Policy on Sustainable Development’ 32 (2007) *South African Yearbook of International Law* 376-395 p.381 ; See also Du Plessis ‘Perspectives from a 33 developing country’ Extraordinary Session I: IP and the global economy AIPPI Lisbon (Exco Meeting) (17 21 June 2002) available at: http://www.aippi.org/reports/Vortrag_DuPlessis.pdf accessed 19 April 2013.

⁴⁷² United Nations Conference on Trade and Development (UNCTAD) Series on issues in international investment agreements UNCTAD/ITE/IIT/28 available at <http://unctad.org/en/Docs/psiteitd28.en.pdf> accessed 17 October 2013.

⁴⁷³ For example Ranbaxy Laboratories (a leading Indian pharmaceutical company) and Bayer AG, (a German pharmaceutical company) for the development of a new generation of antibiotics called ciprofloxacin. See also UNCTAD/UNDP, Transfer of Technology for Successful Integration into the Global Economy UNCTAD/ITE/IPC/2003/6 p.18 available at http://unctad.org/en/Docs/iteipc20036_en.pdf accessed 20 October 2013.

⁴⁷⁴ Carlos M. Correa Review of the TRIPS Agreement: Fostering the Transfer of Technology to Developing Countries TWN Trade & Development Series 13 p.21-22 <http://www.twinside.org.sg/title2/t&d/tnd13.pdf> The Journal of World Intellectual Property (Vol. 2, No. 6).

major global economy challenges⁴⁷⁵ and economic advancement will be realised only if ideas, experience and practice are borrowed from more advanced countries.⁴⁷⁶

Unlike the situation in relation to public health, which arose as a result of so much outcry that the TRIPS Agreement impeded access to essential medicines, transfer of technology was in the TRIPS Agreement from the inception.⁴⁷⁷ The encouragement of technology transfer is said to be an important objective of the TRIPS Agreement, however, acts only as a platform for and does not actually transfer technology from developed to developing countries.⁴⁷⁸

Nigeria has a high minimum standard of protection for patents, but there has not been a high level of technology transfer. The PDA should attract technology transfer and other government policies and laws such as the Nigeria Enterprises Promotion Decree of 1972 amended by Decree no 3 of 1977 commonly referred to as the indigenisation policy have not achieved their aims because, though laudable, they were wrongly implemented. The objective of the Decree was to give Nigerians more control over the economy by reducing foreign domination, creating training chances for indigenous personnel to generate more employment for Nigerians and preventing profit exodus to foreign countries. Some of the problems which the Decree sought to cure were major obstacles to the proper execution of the indigenisation policy: a lack of trained personnel to take over the jobs of the foreign expatriates,⁴⁷⁹ and with political instability.⁴⁸⁰ Yet, Nigeria has a large indigenous commercial class with a dynamic commercial orientation.⁴⁸¹

⁴⁷⁵ David B. Audretsch, Erik E. Lehmann, Albert N. Link, Alexander Starnecker (eds) (introduction) *Technology Transfer in a Global Economy* Springer Group 2012 p. 2.

⁴⁷⁶ UNCTAD/UNDP, *Transfer of Technology for Successful Integration into the Global Economy* UNCTAD/ITE/IPC/2003/6 p.6 available at http://unctad.org/en/Docs/iteipc20036_en.pdf accessed 20 October 2013.

⁴⁷⁷ Article 7 TRIPS Agreement.

⁴⁷⁸ Tú Thanh Nguyễn *Competition Law, Technology Transfer and the TRIPS Agreement: Implications for Developing Countries* Edward Elgar Cheltenham 2010 p. 29-30.

⁴⁷⁹ Wilfred A. Ndongko and Emmanuel T. Abraham *The Problems and Prospects of Implementing Nigeria's Indigenisation Policy* *Africa Spectrum* Vol. 17, No. 1 (1982), pp. 67-86 p.67.

⁴⁸⁰ Nigeria prior to 1999 had been under military rule for 30 years since 1966, with the exception of the second republic which was 1979 to 1983.

⁴⁸¹ Ernest J. Wilson III *Strategies of State Control of the Economy: Nationalization and Indigenization in Africa* *Comparative Politics*, Vol. 22, No. 4 (Jul., 1990), pp. 401-419 <http://www.jstor.org/stable/421971> 20 October 2013.

In recent years there has been an attempt to encourage the flow of technology transfer by enacting enabling laws and policies, such as the National Office of Industrial Property (NOIP),⁴⁸² now the National Office for Technology Acquisition and Promotion (NOTAP).⁴⁸³ Despite the efforts of the NOTAP to attract technology transfer in the past ten years there have been only 1237 technology agreements.⁴⁸⁴ The UNCTAD/UNDP case study on Brazil, India and South Africa demonstrates, in relation to technological capacity building, that there were consistent government support policies modified according to changing times and current knowledge based on their various market liberalisation policies following different ways.⁴⁸⁵ The inability of a country to meet the ever increasing demand for electricity supply is a big factor in technology transfer issues, low power generation has made it hard for existing manufacturing companies to compete effectively with their foreign counterparts and the production capacity is low. Monthly, the manufacturing sector spends ₦2billion (\$1.33million) on fuel generators.⁴⁸⁶ Mayer argues ‘the interdependence between globalisation, technology upgrading and skill accumulation is determined by many factors’.⁴⁸⁷

Patents protection has not encouraged technology transfer. As Odetunde notes, genuine investors cannot be attracted in an environment of constant destabilisation and chaos; meaningful progress in areas of socio-political, economic and technological development cannot be made without encouragement within its structures.⁴⁸⁸

⁴⁸² National Office of Industrial Property (NOIP) Decree No. 70 of 1979.

⁴⁸³ National Office for Technology Acquisition and Promotion (NOTAP) Decree No. 82 of 1992, Privatisation and Commercialisation Decree No. 25 of 1988 (amended 1999) now know National Office Technology Acquisition and Promotion Act 1979 No. 70 Cap N62 (Vol. 11) Laws of Federation of Nigeria 2004.

⁴⁸⁴ Technology Transfers available at <http://notap.gov.ng/content/technology-transfers> accessed 20 October 2013.

⁴⁸⁵ UNCTAD/UNDP, Transfer of Technology for Successful Integration into the Global Economy UNCTAD/ITE/IPC/2003/6 p.9 available at http://unctad.org/en/Docs/iteipc20036_en.pdf accessed 20 October 2013.

⁴⁸⁶ Dayo Oketola Manufacturers Fuel Generators with N42bn in 20 Months Wednesday 25 September, 2013 available at <http://www.punchng.com/business/business-economy/manufacturers-fuel-generators-with-n42bn-in-20-months/> accessed 20 October 2013.

⁴⁸⁷ Jörg Mayer Globalization, Technology Transfer and Skill Accumulation in Low-Income Countries No. 150 August 2000 UNCTAD/OSG/DP/150 p. 2 available at http://unctad.org/en/Docs/dp_150.en.pdf 20 October 2013.

⁴⁸⁸ Christopher Odetunde Technology transfer: Kwara State can be the new model for Nigeria Official Launching of Kwara State Association of Nigeria, U.S.A., Inc. (Georgia Chapter) available at

6.4.3 Innovation and Research and Development

Innovation and research and development (R&D) are fundamental to strategic and sustainable growth. Innovation cuts across the boundaries of various subjects and disciplines and is essential for the development of knowledge and technology. Scientific innovation and commercial innovation create competitive advantage that is vital for economic development.⁴⁸⁹

Over the 20 years of the TRIPS Agreement questions have been raised in relation to innovation and R&D with reference to patents. Do patent right impede innovation and research, or does patenting encourage research and development?

Patent rights are given as a result of R&D carried out in a particular field that results in an innovation. Without research and development, there can be no innovation that leads to an invention and, thus, there would be no patent right. Whether the knowledge of the grant of a patent inspires R&D or if the target of R&D and the entire patent system is based on mere economics has been subject to a lot of debate. Patents protection and economic incentives play a role in innovation,⁴⁹⁰ although the statement is supported by little empirical evidence.⁴⁹¹

Torrance and Tomlinson, using a multi-user interactive simulation of patent and non-patent systems (PatentSim) compare the rates of innovation, productivity and societal utility. The

http://nigeriaworld.com/feature/speech/kwara_technology_transfer.html accessed 20 October 2013; See also Oyewunmi Adejoke, 'The Patent System and Transfer of Technology in Nigeria' Olanrewaju Fagbaohun and Bambo Adewopo (ed.) *Developments and Reform, Nigeria's Commercial Law s Essays in honour of Chief Dr Chris Ogunbanjo* The Law Center LASU Lagos, 1998, 78-92 p.79.

⁴⁸⁹ Sadi Koray Demircan. The Role of R&D and Innovation in Us Economy as a Benchmark for Turkish Economy the Eli Broad College of Business Michigan State University available at http://www.ekonomi.gov.tr/upload/bf09ae98-d8d3-8566-520b0d124e5614d/koray_demircan.pdf accessed 23 October 2013.

⁴⁹⁰ Petra Moser, How Do Patent Laws Influence Innovation? Evidence from Nineteenth-Century World Fairs Working Paper 9909 National Bureau of Economic Research <http://www.nber.org/papers/w9909>; Organisation for Economic Co-Operation and Development (OECD) Patents and Innovation: Trends and Policy Challenges p.1 available at <http://www.oecd.org/science/sci-tech/24508541.pdf> accessed 21 October 2013.

⁴⁹¹ Andrew W. Torrance & Bill Tomlinson, Patents and the Regress of Useful Arts, *Colum. Sci. & Tech. L. Rev.* 10 (2009) 130-168 p.130.

study showed that patent protection did not spur innovation.⁴⁹² On the other hand, Moser, using nineteenth-century exhibition data to determine the effects of patent laws on innovation, resolved that weak patent laws encourage innovation where effective alternative methods of protection exist and concludes that patent laws charts the course of innovative production.⁴⁹³

In terms of the level of patent protection in Nigeria, there may be a correlation with the study that claims that patents do not stimulate innovation and R&D.⁴⁹⁴ since 1970 the Nigeria PDA has provided a term of protection for 20 years and allows products and process patents with little examination yet, there are not many registered patents, both locally and by foreign applicants.⁴⁹⁵ Therefore, stronger patent protection alone does not stimulate innovation and R&D, other variable need to be taken into consideration.

Strong patent protection may not necessarily lead to increased innovation and R&D. The exercise of maximum patent right, however, may create a strangle-hold on people's lives as a result of their inability to acquire the necessary knowledge to use such technologies or products. Especially, in relation to innovations in the treatment of diseases that has become resistant to existing drugs, as well as better drugs for the treatment of pandemic scale disease. If these drugs are beyond the reach of most people who need them, then innovation fails to have a positive impact on society. The required minimum standard in the TRIPS Agreement has not resulted in an improvement in technological development in Nigeria. It is submitted, more than ever Nigeria should not protect product patents to encourage production and to facilitate development in the pharmaceutical industry to meet the demand in the treatment of diseases such a HIV/AIDS and Malaria. Currently, Nigeria has 146 licensed pharmaceutical manufacturers. Some of the manufacturers have the capacity to discover new active substances and produce formulations for starting materials but there is no production of

⁴⁹² Andrew W. Torrance & Bill Tomlinson, Patents and the Regress of Useful Arts, 10 Colum. Sci. & Tech. L. Rev. 4 (2009) 130-168 p.131.

⁴⁹³ Petra Moser, 'How Do Patent Laws Influence Innovation? Evidence from Nineteenth-Century World Fairs' National Bureau of Economic Research Working Paper No. 9909 2003 available at <http://www.nber.org/papers/w9909> accessed 21 October 2013.

⁴⁹⁴ Andrew W. Torrance & Bill Tomlinson, 'Patents and the Regress of Useful Arts', (2009) Columbia Science and Technology Law Review 10 130-168 p.130.

⁴⁹⁵ . Get statistic on current patent application.

active pharmaceutical ingredients (APIs)⁴⁹⁶ itself in Nigeria.⁴⁹⁷ Over 85% of Nigeria's API needs is imported from India, the US and Germany costing Nigeria over ₦1.5billion (US\$9.4million) annually. Nigeria's inability to produce APIs locally stems from the underdeveloped chemical and petrochemical industry and the lack of infrastructure and poor government attention in this essential area.⁴⁹⁸ The Federal Ministry of Health confirms in its report that there is no capacity building initiative to utilise intellectual property rights to promote innovation.⁴⁹⁹

Since 1986, when the first National Science and Technology Policy was created, the policy has been reviewed in 1997, 2003 and 2008, attempts have been made to tackle the long term dearth of innovation and R&D in several government policies. The current National Science, Technology and Innovation Policy was introduced in 2012 with the objective of creating a strong science, technology and innovation capacity required to progress to a modern economy. The political strategy in the policy is aimed mainly at creating awareness of the essence of innovation by encouraging stakeholder. It is government's responsibility to create an enabling environment, first and foremost, by establishing or renovating already existing dilapidated science and technology colleges, faculties and institutes:⁵⁰⁰ there is no serious commitment to funding science and technology in the policy.⁵⁰¹ Gross domestic expenditure

⁴⁹⁶ Active pharmaceutical ingredient (API) is defined as "Any substance or combination of substances used in a finished pharmaceutical product (FPP), intended to furnish pharmacological activity or to otherwise have direct effect in the diagnosis, cure, mitigation, treatment or prevention of disease, or to have direct effect in restoring, correcting or modifying physiological functions in human beings." These are basically the active ingredient of any drug. WHO *Definition of Active Pharmaceutical Ingredient* Revised Draft for Comment Working document QAS/11.426/Rev.1 July 2011.

⁴⁹⁷ Federal Ministry of Health *Nigeria Pharmaceutical Country Profile 2011* Federal Ministry of Health in collaboration with the World Health Organization available at <http://apps.who.int/medicinedocs/en/m/abstract/Js19090en/> accessed 22 October 2013.

⁴⁹⁸ Business Day. Drug manufacturing in Nigeria, Tuesday 18 June, 2013 available at <http://businessdayonline.com/2013/06/drug-manufacturing-in-nigeria/> accessed 22 October 2013.

⁴⁹⁹ Federal Ministry of Health *Nigeria Pharmaceutical Country Profile 2011* Federal Ministry of Health in collaboration with the World Health Organization available at <http://apps.who.int/medicinedocs/en/m/abstract/Js19090en/> accessed 22 October 2013.

⁵⁰⁰ Paragraphs 3.1.2 and 3.1.3. of the National Science, Technology and Innovation Policy available at <http://workspace.unpan.org/sites/internet/Documents/UNPAN048879.pdf> accessed 22 October 2013.

⁵⁰¹ Paragraph 4.0 of the National Science, Technology and Innovation Policy available at <http://workspace.unpan.org/sites/internet/Documents/UNPAN048879.pdf> accessed 22 October 2013.

on R&D (GERD) in 2007 was about ₦46 million; expressed as 0.2% of gross domestic product (GDP) devoted to R&D activities in 2007.⁵⁰²

In summary there is a need to generate an intermediary knowledge and technology flow that targets the various actors and, at the same time, tackle systemic failure in the policy requirements. The solution lies in the adequate dissemination of know-how: to invent, to protect as well as to use.

6.4.4 Plant Varieties

The requirement of patents for plant varieties or a *sui generis* system of protection under the TRIPS Agreement⁵⁰³ constitutes a major concern for Nigeria: 58% of the population live in rural areas (in one form or the other) and depend largely on agriculture. Access to plant varieties and animal breeds is fundamental to the stability and existence of Nigeria. In a country where over 60% are employed in the agricultural sector and farming accounts for 40% of GDP⁵⁰⁴ and a population of over 160 million access to the necessary agricultural varieties is crucial.

In view of the fact that Nigeria currently imports a large amount of its food spending a total of US\$11 billion annually. According to the Minister of Agriculture, Nigeria spends ‘₦356 billion, or roughly ₦1 billion per day, importing parboiled rice, ₦217 billion on sugar, and ₦97 billion on fish’.⁵⁰⁵ Nigeria faces food shortages and requires drastic measures to grow the ailing agricultural sector so as to feed it’s to population.⁵⁰⁶

⁵⁰² UNESCO, UIS Data Center Custom Table <http://stats.uis.unesco.org/unesco/TableViewer/tableView.aspx> accessed 22 October 2013.

⁵⁰³ Article 27. 3b TRIPS Agreement.

⁵⁰⁴ Central Bank of Nigeria The Nigerian Incentive-Based Risk Sharing System for Agricultural Lending (Nirsal) available at <http://www.cenbank.org/OUT/2011/PUBLICATIONS/REPORTS/DFD/BRIEF%20ON%20NIRSAL.PDF> accessed 23 October 2013.

⁵⁰⁵ Punch, That disgraceful food import bill Wednesday, July 31, 2013 by available at <http://www.punchng.com/editorial/that-disgraceful-food-import-bill/> accessed 23 October 2013.

⁵⁰⁶ National Centre for Genetic Resources and Biotechnology , Country Report on the state of Plant Genetic Resources for Food and Agriculture in Nigeria (1996-2008) A Country Report National, National Centre for Genetic Resources and Biotechnology, Ibadan / Federal Department of Agriculture, Abuja October 2008 available at <http://www.fao.org/docrep/013/i1500e/nigeria.pdf> accessed 23 October 2013.

There is a vast diversity of plant life in Nigeria:⁵⁰⁷ it is depended on by many people for food and medicines. Cullet, notes that the protection of plants is novel: sharing knowledge in farming is common place⁵⁰⁸ and seed is freely exchanged among farmers and communities.⁵⁰⁹ The traditional knowledge and skills of farmers' have not been documented in most developing countries,⁵¹⁰ including Nigeria. The protection of plant varieties and the removal of varieties from use by local farmers will be shocking and not understandable to them.⁵¹¹ Because of the significant contribution of agriculture to GDP, concerns have been raised about the possibility of transferring important knowledge from the public domain to private domain which includes the probable effect on poor farmers' livelihood, the consequences for consumer's access to affordable, safe and nutritious food and the environmental effect of GMO seeds.⁵¹²

6.4.5 Foreign Direct Investment

Patents have been dubbed the tool for economic growth and development. Foreign direct investment (FDI)⁵¹³ can be a channel for conveying technology to developing countries.⁵¹⁴ It has been projected that strong patent protection attracts foreign direct investment (FDI). The relationship between patents and FDI has been focused on by many scholars⁵¹⁵ from various

⁵⁰⁷ Albert Philip Ekanem and Francis Vincent Udoh The Diversity of Medicinal Plants in Nigeria: An Overview, H. Rodolfo Juliani, James E. Simon, Chi-Tang Ho African Natural Plant Products: New Discoveries and Challenges in Chemistry and Quality. American Chemical Society 2010, 135-147.

⁵⁰⁸ Philippe Cullet, Plant Variety Protection in Africa: Towards Compliance with the TRIPS Agreement Journal on African Law 45 1 2001 97-122.

⁵⁰⁹ Vandana Shiva, 'Farmers' Rights and the Convention on Biological Diversity', in Vicente Sanchez & Calestous Juma eds, Biodiplomacy - Genetic Resources And International Relations 107 (Nairobi: African Centre for Technology Studies, 1994) cited in Philippe Cullet Plant Variety Protection: Patents, Plant Breeders' Rights & Sui Generis Systems IELRC Briefing Paper 2003-4 available at <http://www.ielrc.org/content/f0304.htm> accessed 22 October 2013.

⁵¹⁰ Dilani Hirimuthugodage Trade Related Intellectual Property Rights (TRIPS) Agreement and the Agriculture Sector in Sri Lanka Asia-Pacific Research and Training Network on Trade Working Paper Series, No. 92, January 2011 pp 1-37 p.7.

⁵¹¹ Bearing in mind that 90% of farming in Nigeria is done by local farmer, mechanised farming is very few.

⁵¹² FAO, Panel of Eminent Experts on Ethics in Food and Agriculture p.32. <http://www.fao.org/docrep/014/i2043e/i2043e02d.pdf> 22 October 2013.

⁵¹³ Fully discussed in Chapter five, at paragraph 5.4.2 of this thesis.

⁵¹⁴ Mansfield, E. Intellectual property protection, foreign direct investment and technology transfer. Discussion paper No 19, Washington, DC: World Bank. (1994).

⁵¹⁵ Nikolaos Antonakakis & Gabriele Tondl, 2012. 'Do determinants of FDI to developing countries differ among OECD investors? Insights from Bayesian model averaging,' Discussion Papers 1/12, Europa-Kolleg Hamburg, Institute for European Integration. Mansfield, E. Intellectual property protection, foreign direct investment and technology transfer. Discussion paper No 19, Washington, DC: World Bank. (1994).

disciplines. Maskus was one of the first to examine the issue. He notes that FDI comprises two kinds of assets, namely, capital and technology or some intangible advantage.⁵¹⁶ Exporting companies feel more comfortable with stronger IPs as it provides a sense of market dominance. He further observes that patents have ‘potentially ambiguous effects’: an ambiguity China clearly exemplifies.⁵¹⁷ On the one hand, a strong IP system can facilitate information transfer of invention specifications that eventually allows local firms to develop and, on the other hand, may create restrictive licences that can hamper the technology flow to local firms.⁵¹⁸

Seyoum, in his study on the role of patent rights protection in influencing FDI flow, examines, the effect against a background of other variables using data collected from 63 countries.⁵¹⁹ The findings of the study show that patent protection has a positive effect on FDI,⁵²⁰ however, other ‘variables such as market size, unemployment rate, and levels of corruption have a greater influence on FDI flows than patents’.⁵²¹

According to the data studied by Maskus, 1% in the degree of patent protection could influence US investment by 0.45% in a country, all things being equal.⁵²² Because all things are not equal in most developing countries that is the cause for concern. In essence, patents work hand in hand with other important determinants. The level of corruption has a negative effect on FDI, as investors tend to shun countries with high levels of corruption: in the case of Nigeria which has been rated continuously for the last 20years to be one of the most

⁵¹⁶ Keith E. Maskus, The role of intellectual property rights in encouraging FDI and technology transfer, *Duke Journal of Comparative and International Law*(1998) 9, 109–139, 120 citing Richard E. Caves, *Multinational Enterprise and Economic Analysis* 25 (2d Ed. 1996).

⁵¹⁷ Peter K. Yu, ‘Intellectual Property, Foreign Direct Investment and the China Exception’ available at <http://www.peteryu.com/fdi.pdf> accessed 22 October 2013.

⁵¹⁸ Keith E. Maskus, ‘The role of intellectual property rights in encouraging FDI and technology transfer.’ *Duke Journal of Comparative and International Law* (1998) 9, 109–139, 134.

⁵¹⁹ Belay Seyoum Patent Protection and Foreign Direct Investment *Thunderbird International Business Review* Volume 48, Issue 3, 389–404, 393May–June 2006.

⁵²⁰ Khan, M.A. & Samad, G., 2010. ‘Intellectual Property Rights And Foreign Direct Investment: Analysis Of 14 South And South East Asian Countries, 1970-2005,’ *Applied Econometrics and International Development*, Euro-American Association of Economic Development, vol. 10 (1) p. 227.

⁵²¹ Belay Seyoum Patent Protection and Foreign Direct Investment p.400.

⁵²² Keith E. Maskus, (non-technical summary) ‘Intellectual Property Rights and Foreign Direct Investment Policy’ Discussion Paper No. 0022 May 2000 Centre for International Economic Studies p.v.

corrupt countries in the world,⁵²³ FDI in the oil sector, especially, is ever increasing. This fact suggests that exporting firms, to a great extent, are resource⁵²⁴ and profit driven. In summary, it is evident that FDI is determined by a number of variables, no single factor can be responsible for the inflow of investment.⁵²⁵ FDI's are determined to a large extent by the kind of investment contemplated.⁵²⁶

6.5. Flexibilities under the TRIPS Agreement and the Doha Declaration

The TRIPS Agreement permits WTO members to implement certain flexibilities available under the agreement. These flexibilities are significant for the implementation of the TRIPS Agreement in developing countries.⁵²⁷ The TRIPS Agreement requires a minimum standard of intellectual property protection to be put in place at the national level, the flexibilities guarantee the required balance between the patentee's exclusive rights⁵²⁸ and the interests of the public, consumers and competitors.⁵²⁹ In 2001, the flexibilities in the TRIPS Agreement were highlighted and affirmed in the Doha Declaration on the TRIPS Agreement and Public Health.⁵³⁰ The TRIPS flexibilities will be discussed below.

⁵²³ Nigeria is currently ranked 139 out of 176 countries with a score of 27 out of 100. see <http://transparency.org/country#NGA> accessed 22 October 2013.

⁵²⁴ Nikolaos Antonakakis & Gabriele Tondl, 2012. 'Do determinants of FDI to developing countries differ among OECD investors? Insights from Bayesian model averaging,' Discussion Papers 1/12, Europa-Kolleg Hamburg, Institute for European Integration p.32.

⁵²⁵ Isabel Faeth, 'Determinants Of Foreign Direct Investment - A Tale Of Nine Theoretical Models,' *Journal of Economic Surveys*, Wiley Blackwell 2009. vol. 23(1), pages 165-196, 02.

⁵²⁶ Mansfield, E. 'Intellectual property protection, foreign direct investment and technology transfer' Discussion paper No 19, Washington, DC: World Bank. (1994).

⁵²⁷ Correa C. *Intellectual Property Rights, the WTO and Developing Countries. The TRIPS Agreement and Policy Options* London and New York, Zed Books, 2000 p. 221.

⁵²⁸ Sunil Mani and Richard R.Nelson (Introduction) *The TRIPS Compliance, National Patent Regimes and Innovation Evidence and Experience from developing Countries* Edward Elgar Cheltenham, UK 2013 p 4-8; Article 28 TRIPS Agreement.

⁵²⁹ Elijah Munyuki and Rangarirai Machemedze 'Implementation of the TRIPS flexibilities by east and southern African countries: Status of patent law reforms by 2010' Southern and Eastern African Trade, Information and Negotiations Institute (SEATINI) in the Regional Network for Equity in health in East and Southern Africa (EQUINET) EQUINET Discussion paper 80 January 2010p. 4;UNAIDS Doha+10 TRIPS flexibilities and access to Antiretroviral Therapy: Lessons from the Past, Opportunities for the Future UNAIDS Technical Brief 2011 UNAIDS / JC2260E available at accessed 24 October 2013.

⁵³⁰ Fourth Session Ministerial Conference Declaration On The TRIPS Agreement and Public Health adopted on 14 November 2001 WT/MIN(01)/DEC/2 20 November 2001.

6.5.1 Nature and Scope of Obligations in Article 1 of the TRIPS Agreement

As observed in chapter four, article 1 is an essential guide to using the TRIPS flexibilities. It provides a platform on which governments can build, to ensure that other flexibilities in relation to the protection of intellectual property rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, as well as to provide mutual advantage for producers and users of technological knowledge in a manner conducive to social and economic welfare by balancing rights and obligations⁵³¹ needed in the area of patents.

6.5.2 Principles

Although WTO members must adhere to the minimum standard required in the TRIPS Agreement, they have the freedom to formulate and amend their laws and regulations in ways obligatory for the protection of public health and nutrition, as well as to promote the public interest in sectors of vital importance to socio-economic and technological development, provided these laws and regulations are consistent with the TRIPS Agreement provisions.⁵³² For instance, article 27.1 provides for the protection of all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. The TRIPS Agreement does not define these requirements,⁵³³ so member are free to define what each requirement means, thereby formulating laws that suit their socio-economic and technological development level. Members may also formulate or amend their laws to reflect all the exclusions in article 27.2 and 27.3 which cover the commercial exploitation of human, animal or plant life or health, inventions prejudicial to the environment, diagnostic, therapeutic and surgical methods for the treatment of humans or

⁵³¹ Article 7 TRIPS Agreement.

⁵³² Article 8 TRIPS Agreement.

⁵³³ Carlos M. Correa 'Medicines Flexibilities in the Trips Agreement: An Overview', Session 2.2 TRIPS flexibility and access to medicine, the case of new ARV' available at http://www.pmaconference.mahidol.ac.th/index.php?option=com_docman&task=doc_download&gid=68&Itemid=25 October 2013.

animals and plants and animals and essentially biological processes for the production of plants or animals. All these may be excluded as consistent with the TRIPS Agreement.⁵³⁴

In addition, a member may enact laws and regulation against abuse and practices which unreasonably restrain trade or adversely affect the international transfer of technology.⁵³⁵ In essence any anti-competitive practice engaged in by the right holder is not an exclusive right that should be permitted by law or the regulation of a member country.⁵³⁶ Members may provide measures against unfair contractual agreements and exorbitant pricing of patent holders, as well.⁵³⁷

6.5.3 Exhaustion of Patent Rights (Parallel Importation)

Exhaustion of rights provides an avenue for parallel importation.⁵³⁸ The TRIPS Agreement is not explicit about what constitutes exhaustion of intellectual property rights⁵³⁹ or whether members are required to provide for it in their laws, though there seems to be acknowledgment of the concept in the TRIPS Agreement.⁵⁴⁰ The provision however, has

⁵³⁴ Allan Maleche 'Legislation and Use of TRIPS Agreements' Kenya Legal & Ethical Issues Network (Kelin) available at accessed 24 October 2013; UNAIDS 'Doha+10 TRIPS flexibilities and access to Antiretroviral Therapy: Lessons from the Past, Opportunities for the Future' UNAIDS Technical Brief 2011 UNAIDS / JC2260E available at accessed 24 October 2013.

⁵³⁵ Article 8.2 TRIPS Agreement.

⁵³⁶ Jonathan Michael Berger Advancing Public Health by Other Means: Using Competition Policy to Mitigate the Impact of Patent Protection 'Intellectual Property Rights (IPRs), Innovation and Sustainable Development in Eastern and Southern Africa' ICTSD / UNCTAD / TIPS Regional Dialogue 29 June – 1 July 2004; Cape Town, South Africa p. available at accessed 25 October 2013

⁵³⁷ 3D Trade - Human Rights - Equitable Economy, 'The impact of trade-related intellectual property rights on access to affordable medicines and human rights' Outline of a presentation to the NGO Forum for Health 30 September 2004 available at http://www.humanrights.ch/upload/pdf/051111_tripsandaffordablemedicine_3D2004.pdf accessed 24 October 2013; Poku Adusei 'Exploiting Patent Regulatory 'Flexibilities' to Promote Access to Antiretroviral Medicines in Sub-Saharan Africa' (2011) 14 Journal of World Intellectual Property 1-23 p.7.

⁵³⁸ Exhaustion of right refers to a situation where products containing intellectual property rights are put into the market with the owner's consent, the rights of the owner are exhausted and the owner cannot prevent the free movement of those goods.

⁵³⁹ Esmé du Plessis and Danie Dohmen 'Exhaustion of Rights: A South African Perspective Regional Seminar for Certain African Countries on the Implementation and Use of Several Patent-Related Flexibilities' Durban, South Africa January 29 to 31, 2013.

⁵⁴⁰ Article 6 TRIPS Agreement. Abbott, Frederick M., First Report (Final) to the Committee on International Trade Law of the International Law Association on the Subject of Parallel Importation (1998). *Journal of International Economic Law*, Vol. 1, No. 4, pp. 607-636, 1998; Carlos M. Correa 'Medicines Flexibilities in the Trips Agreement: An Overview', Session 2.2 TRIPS flexibility and access to medicine, the case of new ARV' p. 162 available at http://www.pmaconference.mahidol.ac.th/index.php?option=com_docman&task=doc_download&gid=68&Itemid=25 25 October 2013.

been amended by the Doha Declaration to enable members to choose their own regime of exhaustion without challenge, subject to the most-favoured-nation (MFN)⁵⁴¹ and national treatment (NT)⁵⁴² provisions.⁵⁴³ Accordingly, members are free to choose either the national, regional or international exhaustion regime they want to operate.⁵⁴⁴ Members who adopt the international exhaustion regime have access to patented products put in circulation anywhere in the world, making it the best option for a country like Nigeria and most Sub-Saharan Africa (SSA) countries⁵⁴⁵ in consideration of its public health and developmental issues.⁵⁴⁶

Countries are enabled, to engage in parallel importation of cheaper patented products from countries where they are less expensive.⁵⁴⁷ It is a strategic way of delivering access to affordable medicines in view of the fact that pharmaceutical drug prices vary in different markets.⁵⁴⁸ This flexibility does not infringe in any way on the right of the patent holder as the right does not include making the patented product, the right extends only to buying and

⁵⁴¹ Article 3 TRIPS Agreement.

⁵⁴² Article 4 TRIPS Agreement.

⁵⁴³ Paragraph 5(d) Doha Declaration on TRIPS Agreement and Public Health.

⁵⁴⁴ Patrick Lumumba Osewe, Yvonne Korkoi Nkrumah, Emmanuel K. Sackey *Improving Access to HIV/AIDS Medicines in Africa: Trade-Related Aspects of Intellectual Property Flexibilities* World Bank 2009 p. 20.

⁵⁴⁵ Ghana, Kenya, Mauritius, Namibia, South Africa and Zimbabwe have incorporated the international exhaustion regime in their national laws therefore permitting parallel imports from anywhere in the world.

⁵⁴⁶ Health Action International (HAI) Africa - A Briefing paper on the utilization of trips flexibilities in the EAC Region available at http://www.haiafrica.org/index.php?option=com_content&view=article&id=273:a-briefing-paper-on-the-utilization-of-trips-flexibilities-in-the-eac-region&catid=78:news accessed 24 October 2013; Esmé du Plessis and Danie Dohmen 'Exhaustion of Rights: A South African Perspective' Regional Seminar for Certain African Countries on the Implementation and Use of Several Patent-Related Flexibilities Durban, South Africa January 29 to 31, 2013; Cynthia M. Ho, 'Current Controversies Concerning Patent Rights and Public Health in a World of International Norms' Toshiko Takenaka (ed) *Patent Law and Theory: A Handbook of Contemporary Research* Edward Elgar Publishing 2009 p.697.

⁵⁴⁷ 3D Trade - Human Rights - Equitable Economy, 'The impact of trade-related intellectual property rights on access to affordable medicines and human rights' Outline of a presentation to the NGO Forum for Health 30 September 2004 available at http://www.humanrights.ch/upload/pdf/051111_tripsandaffordablemedicine_3D2004.pdf accessed 24 October 2013.

⁵⁴⁸ Coalition of Civil Society Groups on Access to Essential Medicines a Price Comparison of Selected Drugs in Nigeria available at <http://www.nigeria-aids.org/Reports/AccessPriceComparison.doc> accessed 18 October 2013; UNAIDS Doha+10 TRIPS flexibilities and access to Antiretroviral Therapy: Lessons from the Past, Opportunities for the Future UNAIDS Technical Brief 2011 UNAIDS / JC2260E available at accessed 24 October 2013.

offering for sale and probably, to stockpiling.⁵⁴⁹ At the same time the rights of the patent holder are balanced against those of the consumer.⁵⁵⁰

6.5.4 Exceptions to Exclusive Rights

Article 30 grants members the right to provide exceptions in their national laws and regulations provided the exception is consistent with a normal exploitation of the patent and does not unreasonably prejudice the legitimate interests of the patent owner and third parties. As mentioned earlier there are certain exceptions which have become part and parcel of the functioning of the patenting system. Therefore, countries are free to include these exceptions in their laws. The exceptions include private and non-commercial use, prior use,⁵⁵¹ experimental use, research and teaching purposes, individual prescription (pharmacy) and a regulatory purpose (Bolar exception).

The exceptions are to prevent the unnecessary hampering of the use of patent for the development of new knowledge. As a result the Bolar exception to allow manufacturers of generic medicines to conduct clinical tests and trials to ensure that generic version or bioequivalent of the patented drugs is safe and effective for the required purpose before they are put on the market.⁵⁵² As noted in discussing exceptions to rights conferred, the Bolar exception is important for enabling quick access to generics at a lower cost.⁵⁵³ It also prevents the unnecessary extension of the patent life beyond the 20 year term.

Furthermore, article 27.3 gives members the option to protect plant varieties through patent protection or a *sui generis* system or by any combination. It leaves it to the discretion of the member to choose which type of protection it wants to use: the TRIPS Agreement does not

⁵⁴⁹ Nuno Pires de Carvalho *The TRIPS Regime of Patent Rights* p. 176-177.

⁵⁵⁰ Abbott, Frederick M., First Report (Final) to the Committee on International Trade Law of the International Law Association on the Subject of Parallel Importation (1998). *Journal of International Economic Law*, Vol. 1, No. 4, pp. 607-636, 1998.

⁵⁵¹ This exception is clearly provided for in the PDA section 6 (4).

⁵⁵² Patrick L. Osewe, Yvonne K. Nkrumah and Emmanuel K. Sackey Improving Access to HIV/AIDS Medicines in Africa Trade-Related Aspects of Intellectual Property Rights Flexibilities World Bank 2008 p.22.

⁵⁵³ UNAIDS Doha+10 TRIPS flexibilities and access to Antiretroviral Therapy: Lessons from the Past, Opportunities for the Future UNAIDS Technical Brief 2011 UNAIDS / JC2260E available at accessed 24 October 2013.

⁵⁵³ Article 8.2 TRIPS Agreement.

mention the standard to be applied in the protection of such plant varieties. In summary, according to Ravi, the ‘*sui generis* system flexibility’ is important for developing countries for three major reasons, namely, it protects and improves livelihood by balancing the protection of plant breeding against the essential public good, it gives members the opportunity to harmonise the conflict between the TRIPS Agreement and various international laws⁵⁵⁴ that have binding effect on them and members have the option of choosing a less stringent form of protection through the use of a *sui generis* system.⁵⁵⁵

6.5.5 Compulsory Licence and Government Use

These are uses permitted without the patent holder’s permission. The TRIPS Agreement gives government of member states the authority to issue compulsory licences to third parties, in cases of national emergency or extreme urgency, for governmental non-commercial use,⁵⁵⁶ for resolving anti-competitive practices,⁵⁵⁷ as well as for cross licencing.⁵⁵⁸ Compulsory licences are used to remedy situations of an acute lack of essential medicines, not only when there is an epidemic outbreak of a disease but when there is a shortage of medicines.⁵⁵⁹ Concisely put by Visser: ‘compulsory license is a crucial element in a health-sensitive patent law’.⁵⁶⁰

⁵⁵⁴ UN Convention on Biological Diversity (CBD) Adopted in 1992, entry into force in 1993, the International Treaty on Plant Genetic Resources; (ITPGR) adopted by the 31st Session of Conference of the Food and Agriculture Organization, Rome, 3 November 2001, entry into force on 29 June 2004; Food and Agriculture and UN International Covenant on Economic, Social and Cultural Rights (CESCR) adopted by UN General Assembly resolution 2200A (XXI) of 16 December 1966 and entry into force on 3 January 1976; Universal Human Rights Declaration (UHRD) adopted and proclaimed by General Assembly resolution 217 A(III) of 10 December 1948 and UN Declaration on the Right to Development (DRD) adopted by the UN General Assembly resolution 41/128 of 4 December 1986.

⁵⁵⁵ Bala S. Ravi Effectiveness of Indian Sui Generis Law on Plant Variety Protection and its Potential to Attract Private Investment in Crop Improvement Journal of Intellectual Property Rights Vol. 9, November 2004, pp. 533-548.

⁵⁵⁶ Article 31(b) TRIPS Agreement.

⁵⁵⁷ Article 31(k) TRIPS Agreement.

⁵⁵⁸ Article 31(l) TRIPS Agreement.

⁵⁵⁹ Ghana in October 2005 the Minister of Health issued a government use compulsory licenses for importation of generic HIV-AIDS medicines into Ghana from Indian. Guinea in April 2005 the Ministry of Health issued compulsory licenses to import drugs to treat HIV-AIDS. Eritre June 2005 the Minister of Health issued compulsory licenses to import of generic HIV-AIDS medicines. Zimbabwe in 2002 issued a notice declaring a period of emergency on HIV/AIDS (General Notice No. 240 of 2002).

⁵⁶⁰ Coenraad Visser Patent Exceptions and Limitations in the Health Context SCP/15/3 Annex V p. 3

Apart from making the product more affordable through lower prices a compulsory license also ensures that the product gets to the people who need it as well as putting a sufficient supply in the market. The use of compulsory licence was reaffirmed in the Doha Declaration: members have the right to grant compulsory licences and the freedom to determine the grounds upon which such licences are granted.⁵⁶¹ The provision made it clear that article 31 included compulsory licences and at the same time creates awareness of its use.⁵⁶²

Paragraph 6 of the Doha Declaration recognised that there are some members with insufficient or no manufacturing capacity in the pharmaceutical sector that would not be able to use the compulsory licence scheme as such. Consequently, a strategy has been implemented to enable such countries benefit from this provision.⁵⁶³ The paragraph 6 provision is usable by countries with insufficient or no manufacturing capacity to meet their required needs for access to essential medicines.⁵⁶⁴

Apart from compulsory licencing in article 31, there is a provision for use without permission by the government in similar circumstances as third party compulsory licensing. This provision requires authorisation to be given by the government to a government department or a contractor for the utilisation of the patents without the patent holder's permission.⁵⁶⁵ However, government use is usually associated with public non-commercial uses by the government.⁵⁶⁶

6.5.6 Anti-Competitive Practices

Aside from article 31 (k), the TRIPS Agreement, in article 40, specifically stipulates that a member shall have the right to prevent licensing practices or conditions that may constitute an abuse of intellectual property rights having an adverse effect on competition in the relevant market in their legislations. Members therefore, can enact, in their national laws,

⁵⁶¹ Paragraph 5(b) Doha Declaration on TRIPS Agreement and Public Health.

⁵⁶² Implications of the Doha Declaration on the Trips Agreement and Public Health-Health Economics and Drugs Series No. 012 2002 p. 15.

⁵⁶³ WTO, The TRIPS Agreement and Public Health Decision of 30 August 2003, 2 September 2003 WT/L/540.

⁵⁶⁴ Canada – Rwanda compulsory licence of ApoTriAvir (a combination of Zidovudine, Lamivudine and Nevirapine) used for the treatment of HIV/AIDS.

⁵⁶⁵ Carlos M. Correa Guide for the Application and Granting of Compulsory Licences and Authorization of Government Use of Pharmaceutical Patents 2009 p.1 WHO/PHI/2009.1.

⁵⁶⁶ Article 31(b) TRIPS Agreement.

measures that are consistent with the TRIPS Agreement provision⁵⁶⁷ appropriate to prevent or control such practices which may include exclusive grant back conditions, conditions preventing challenges to validity and coercive package licensing. Therefore practices or conditions pertaining to intellectual property rights that restrain competition or that may impede the transfer and dissemination of technology should not be permitted in member countries and members may even request consultations base on this practices. This flexibility curbs monopoly situations, thereby creating a healthy and competitive environment for trade. As a result prices are lowered and the availability of the product is improved, enabling access to required products or technology.⁵⁶⁸

6.5.7 Areas not covered by the TRIPS Agreement

The TRIPS Agreement provides a minimum standard in certain basic areas of intellectual property rights: member states are free to enact laws to govern areas that are left out of the TRIPS Agreement according to the protection needed for such areas with regards to the member's level of development. Areas suggested by WIPO are utility models, traditional knowledge and handicrafts.⁵⁶⁹

6.6 Modification required in the Patent and Designs Act

The Patent and Designs Act mostly complies with the TRIPS Agreement. However certain aspects of the PDA need to be amended to fully comply, as well as to take the necessary flexibilities into account. The PDA also requires better structuring in plain and simple language.

6.6.1 Patentable Inventions

Section 1 of the PDA is the core provision of the patent legislation. For a better understanding of the PDA, patentable inventions need to be defined more comprehensively.

Patents and inventions are not defined in the PDA: this is important; as it gives meaning to

⁵⁶⁷ Article 40.2 TRIPS Agreement.

⁵⁶⁸ UNAIDS Doha+10 TRIPS flexibilities and access to Antiretroviral Therapy: Lessons from the Past, Opportunities for the Future UNAIDS Technical Brief 2011 UNAIDS / JC2260E available at accessed 24 October 2013.

⁵⁶⁹ Advice on Flexibilities under the TRIPS Agreement available at http://www.wipo.int/ip-development/en/legislative_assistance/advice_trips.html accessed 26 October 2013.

what is patentable.⁵⁷⁰ The section consists of the three requirements under the TRIPS Agreement as well as improvements: an all-inclusive meaning of each requirement is needed. In addition, patentable subject matter is completely absent from the PDA which leaves it open to varying interpretation.⁵⁷¹

6.6.2 Exceptions to Rights Conferred by Patents

Plant varieties or essentially biological processes for the production of plants or animals are specifically excluded from patent protection under the PDA, which is at variance with the minimum standard of protection required by the TRIPS Agreement. It has been a contentious issue in the TRIPS Agreement, given that the TRIPS Agreement allows members to create their own *sui generis* system. This concession is a TRIPS flexibility because countries are not obliged to follow any specific pattern in enacting their own laws. Therefore, a member can enact laws that are effective and suitable for their own purpose.⁵⁷² Accordingly, members can comply with the protection of plant variety as required by the TRIPS Agreement and at the same time protect the public good. Although the PDA provides that inventions that are contrary to public order or morality cannot be exploited⁵⁷³ it is important to make it abundantly clear that human, animal or plant life or health are not protectable, including inventions that can cause serious prejudice to the environment. Whether these options would be regarded as a violation of the provision of the WTO is still subject to debate. There is a need to expressly exempt diagnostic, therapeutic and surgical methods for the treatment of humans or animals from protection: currently there is no such provision.

Another exception that is completely absent in the PDA is the Bolar exception which allows early regulatory approval for generic drugs to ensure that they immediately become accessible at the expiration of the brand name drug companies' patents. It is essential that the well-known exceptions to patent protection be outlined specifically to eliminate uncertainty

⁵⁷⁰ Andries van der Merwe *The Law of Patents* in Andries van der Merwe *et. al* in *Law of Intellectual Property* LexisNexis Durban 2011 p. 271.

⁵⁷¹ Section 1 PDA 1970 P2 LFN 2004.

⁵⁷² Bala S. Ravi Effectiveness of Indian *Sui Generis* Law on Plant Variety Protection and its Potential to Attract Private Investment in Crop Improvement *Journal of Intellectual Property Rights* Vol. 9, November 2004, pp. 533-548.

⁵⁷³ Section 1 (4) (b) PDA 1970 P2 LFN 2004.

regarding their uses. Such uses should include private and non-commercial use, prior use, experimental use, research and teaching purposes and individual prescription (pharmacy). Individual prescription is a vital exception as it allows medicines prepared by pharmacies and medical professionals for individuals to be used without infringing the patent holder's right. It is of particular importance to patients in to a country like Nigeria, who to a large extent, are dependent on herbal medicinal concoctions.

6.6.3 Ownership of Patent in Employment

Appropriate clarification concerning patent ownership between employees and employers is essential for the encouragement of invention. As noted previously,⁵⁷⁴ the right of the employee needs to be adequately balanced against the rights of the employer who benefits from the employee's invention by virtue of the employee working in his company. There should be a distinction between employees that work for the employer as inventors, employees who use the employer's resources in the course of his invention and the employee whose employer has nothing to do with the invention and where the employer's resources are not used for the invention.

It is submitted that since the intent of patent law is to reward the inventor for his efforts, patent rights should vest in the employee even-though he uses the resources of the employer. Adequate compensation should be given to the employer whose resources were used, and not the other way round.

6.6.4 Patent Application

The best mode for working a patent is not specified in the PDA for patent applications. The best mode requirement is important to ensure full disclosure of the invention and to restrain the inventor from applying for patents and at the same time concealing the preferred embodiments of their inventions from the public.⁵⁷⁵ This requirement prevents the inventor from saving the best and disclosing his second-best embodiment. Although, the PDA requires a description of the invention in a manner sufficiently clear and complete for the

⁵⁷⁴ Paragraph 6.2.2 of this chapter.

⁵⁷⁵ *Glaxo, Inc. v Novopharm Ltd.*, 52 F.3d 1043, 1050 (Fed. Cir. 1995).

invention to be effectively used by a person who is in the art or field of knowledge to which the invention relates,⁵⁷⁶ an indication of the best mode for carrying out the invention known to the inventor at the filing date is required in the TRIPS Agreement

Moreover, the essence of a patent system is defeated if the validity of a patent cannot be assured based on the examination system. One of the major problems with the Nigerian patent system is the lack of substantive examination of patent applications. Therefore there is a need for proper patent examination, which, as stated previously, can be outsourced. Nigeria, as a member of Patent Cooperative Treaty (PCT), can thereby benefit from the international preliminary examination system to determine the potential patentability of the invention. In addition, there are several other ways to assist patent examiners which are organised regularly by WIPO. Recently, IP Office in Australia and the Association of South East Asian Nations (ASEAN) with the support of WIPO, initiated a Regional Patent Examination Training programme (RPET) to enhance the knowledge and skills of patent examiners in South East Asia and Africa.⁵⁷⁷

6.6.5 National Treatment

Section 6(4) provides a concurrent right to any person in Nigeria, who in good faith was manufacturing the product or applying the process or had made serious preparations with a view to manufacturing despite a patent application in respect of such product or process.

According to the TRIPS Agreement, members are to accord to the nationals of other members states treatment no less favourable than it accords to its own nationals with regard to the protection of intellectual property.⁵⁷⁸ This provision is at variance with the national treatment principle of the TRIPS Agreement. Therefore, this provision needs to be reviewed to make it applicable to other nationals, particularly, because the provision relates only to the exclusion of foreign priority application.

⁵⁷⁶ Section 3 (2) PDA 1970 P2 LFN 2004.

⁵⁷⁷ PCT in the News Sharing expertise to boost patent quality available at <http://www.wipo.int/pct/en/news/index.html> accessed 27October 2013.

⁵⁷⁸ Article 3 TRIPS Agreement.

The confusion the provision⁵⁷⁹ creates needs to be resolved. If there is a manufacturer of the patented invention, how can another inventor patent the same invention as new and non-obvious. In the same vein, if the process has been applied or serious preparations have been made by another person, he can use the process despite the grant of a patent for the same invention. In essence the two inventions can be on the market concurrently. Although this is not a strange phenomenon; ‘simultaneous invention’ has been recognised in case law and statute⁵⁸⁰: there is a ‘possibility of near simultaneous invention by two or more equally talented inventors working independently, that occurrence may or may not be an indication of obviousness when considered in light of all the circumstances’.⁵⁸¹ Yamashita explains in his proposition that simultaneous invention after an enabling technology indicates obviousness.⁵⁸² The proposition may only be true in the case of certain inventions for instance, presently there are numerous scientists working in various pharmaceutical companies to find a cure for HIV, cancer and other dreaded diseases. The first to develop the curative drug or vaccine cannot be deprived of the exclusive use of the patent because other people have made serious preparations working on the same or similar invention.

The provision also seems to defeat the essence of the first to file system⁵⁸³ and does not justify even the first to invent system. The section makes a mockery of the entire patent legislation. In consideration of the fact that patents are given as a reward for the public disclosure of the invention, if an invention has been manufactured or used in good faith then such invention cannot be patented by another as it is no longer new and no disclosure has been made to the public. According to section 1 (2) an invention is new if it does not form part of the state of the art to which the invention relates: ‘the state of the art’ meaning everything concerning that art or field of knowledge which has been made available to the public anywhere and at any time by means of a written or oral description, by use or in any

⁵⁷⁹ Section 6(4) PDA 1970 P2 LFN 2004.

⁵⁸⁰ 35 U.S.C. Sec. 135.

⁵⁸¹ *Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Company, Harris Press and Shear Division, Commercial Metals Company*, 730 F.2d 1452 (Fed. Cir. 1984).

⁵⁸² Brent Yamashita, ‘Secondary Considerations of Obviousness in a Patent Case: The Seldom-Used ‘Simultaneous Invention’ Factor’ available at <http://patentlyo.com/patent/2008/07/secondary-consi.html> accessed 27 October 2013.

⁵⁸³ Section 2(1) PDA 1970 P2 LFN 2004.

other way. Section 1 clearly eliminates all public uses. How then can there be concurrent rights?

The second inventor, who has reached the manufacturing stage of the invention, must have intended that the invention be kept as a trade secret⁵⁸⁴ for his own personal use so as to benefit from it for a long time. As a result, such an inventor should not benefit from the patent system since he has not disclosed anything to the public that warrants rewarding him with patent like protection.

6.6.6 Reformation to reflect the TRIPS Flexibilities

The flexibilities in the TRIPS Agreement go a long way in ameliorating the effects that the TRIPS Agreement would otherwise have had on the general outlook of the national laws of member states. As stated in the previous sections, exhaustion of rights and parallel imports go hand in hand to alleviate issues of access to affordable essential medicines and medical devices. Apart from public health uses, they allow, generally for the importation of cheaper but good quality products which as a result can curb the importation of substandard and counterfeit products. As stated,⁵⁸⁵ international exhaustion is the most suitable type of exhaustion for Nigeria as it provides immediate access to products once the product has been sold anywhere in the world.

Additionally, the TRIPS Agreement recognises that there are some licensing practices or conditions concerning intellectual property rights which impede competition, have adverse effects on trade and may restrain the transfer and dissemination of technology. Consequently, members have been given the freedom to enact laws that prevent these practices. Anti-competition laws are important in any society to discourage monopoly as well as to foster competition which results in lower prices, better quality products and more choice.⁵⁸⁶ There is the need to amend the law to enable the use of compulsory licences and or to rectify provisions that discourage anti- competitive practices.

⁵⁸⁴ Trade secrets encompass manufacturing or industrial secrets and commercial secrets and any confidential business information which give an enterprise a competitive edge. See 'What is Trade secrets' http://www.wipo.int/sme/en/ip_business/trade_secrets/trade_secrets.htm accessed 15 November 2013

⁵⁸⁵ Paragraph 6.5.2 of this chapter.

⁵⁸⁶ Office of Fair Trading <http://www.oft.gov.uk/about-the-oft/legal-powers/legal/competition-act-1998/>

For WTO members to use the Paragraph 6 system⁵⁸⁷ it has to be adopted by two thirds of the members of the WTO, which Nigeria, among others, have not done. Also, national laws should support its use. The granting of compulsory licence under the PDA relates only to the local use of the licence, it does not include importation of the products.⁵⁸⁸ Therefore, areas in which Nigeria has no manufacturing capacity or insufficient capacity are not provided for under the law. In addition, remuneration should be made determinable by the importing member's capacity.

In summary, the incorporation of these modifications will assist Nigeria to offer a beneficial patenting system that will encourage inventions, technology transfer, and foreign direct investment, as well as provide access to essential medicines and products.

6.7. Conclusion

The discussion on the patent system in Nigeria reveals that the Patent and Design Act does not have numerous shortcomings with regard to the protection of right holders. However, the flexibilities afforded by the TRIPS Agreement are absent.

With regard to the requirements needed for protection there is compliance with the TRIPS Agreement, although criticism may be levied against the implicit nature of the way the provision⁵⁸⁹ is drafted which leaves a possibility for misinterpretation. The absence of a well-defined interpretation section for the requirements makes it vague and subject to misuse. It is submitted that the provision is outdated and not in line with developments in other jurisdictions.

Therefore, it is proposed that section 1, which provides for the requirements of patentable inventions, should be explicit in its definition of new results from inventive activity and which are capable of industrial application. Also, a provision on patentable subject matter needs to be included in the Act to enable easy recognition of what is patentable, although the TRIPS Agreement does not leave many options because of the requirement that patents shall

⁵⁸⁷ Paragraph 6 Doha Declaration on the TRIPS Agreement and Public Health.

⁵⁸⁸ Paragraph 1(c) and 4 PDA 1970 P2 LFN 2004.

⁵⁸⁹ Section 1 PDA 1970 P2 LFN 2004.

be available for any inventions, whether products or processes, in all fields of technology. Also, provisions on the ability to obtain patents on improvements should be explored to the fullest.

Furthermore, the fact that the patent system does not take advantage of all the possible flexibilities that are available constitutes a strangle-hold on users as well as producers. Consequently, there is a need for reform, taking into consideration the socio-economic and public health issues facing Nigeria. Accordingly harnessing all the possible flexibilities will develop the present stagnant technological expertise and industry which are required for economic and social advancement.

Other practical concerns relate to the employee/employer relationship which may limit incentives to invent and, as a result, affect innovation and the patenting system generally. A weak institutional framework for the transfer of technology is another barrier to the effective use of the patent system as the use of technology, even in the public domain, constitutes a challenge.

As it is clear from the discussion above that patents alone cannot spur development. There is a need for government policy on intellectual property, which will include rewards for inventors whether or not the invention becomes a money spinning venture. The purpose is to encourage innovation, as well as to boost the inventing culture to yield development.

Patent laws should not be seen as a clog in the wheel of progress, rather they should be seen as a document which inspires innovation for all and can be use as an instrument for managing the political economy of the country⁵⁹⁰ to foster development.

⁵⁹⁰ Report on the Revision of Patent Law Justice N. Rajagopala Ayyangar Committee September 1959.

CHAPTER 7

Enforcement and Challenges to Intellectual Property Rights and Laws in Nigeria

Summary

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7.1 Introduction

Enforcement is the back bone of legislations, the absence of which creates lawlessness and chaos. Without enforcement the workability of the legislation will almost be impossible. Enforcement is one of the most complex areas of the law as it involves other mechanisms of the government which may or may not be trained in the area of the law involved.

Enforcement of intellectual property rights presupposes there is a right and it is likely that the right may be infringed. There are various forms of enforcement mechanism, which include criminal and civil actions, culminating in remedies such as injunctions, seizures and imprisonment.

Currently, Nigeria bears the burden of a lot of counterfeit products from different parts of the world, especially China.¹ Enforcement of intellectual property rights is a matter of utmost urgency to deal with this menace. As a country with a viable film and music industry there is a huge loss of revenue in this sector of the economy as a result of counterfeiting and piracy.

¹ Chinese flooding Nigeria with substandard goods —SON – available at <http://www.vanguardngr.com/2014/06/chinese-flooding-nigeria-substandard-goods-son/#sthash.5YLUBEUL.dpuf> accessed 03 June 2014; NAFDAC identifies China, India as source of fake drugs into Nigeria available at <http://theguardianmobile.com/readNewsItem1.php?nid=28458> accessed 03 June 2014.

The enforcement section in the TRIPS Agreement is one of the main achievements recorded in the Uruguay Round and is important in facilitating a reliable implementation of the substantive provisions of the TRIPS Agreement.²

The focus of this chapter is to examine the effect of the enforcement provision of the TRIPS Agreement on Nigeria's enforcement procedures in regards to the infringement of intellectual property rights. Considering the various enforcement provisions on intellectual property rights examined in the previous chapters, including border measures that Nigeria is taking to enforce the protection of intellectual property rights, the primary objective will be to examine the adequacy of the procedures and enforcement mechanism as they appear in various intellectual property legislations as opposed to what is expected under the TRIPS Agreement. Some of the structures that are imperative for the obligations under the law to be sustained will also be discussed.

Having examined the effect of the enforcement provision of the TRIPS Agreement on Nigeria's enforcement laws, for the sake of completeness, it is also important to outline some of the challenges that have created and still create the stagnancy in the law. In order to effectively fulfil the intention highlighted above, the chapter is divided into two parts: Section A deals with the enforcement of intellectual property rights and section B scrutinises the challenges to intellectual property protection in Nigeria.

7.2 Sections A: Enforcement of intellectual Property Rights

7.2.1 The Nigerian Legal System and Intellectual Property Rights

The Nigerian Constitution, which is the *grundnorm*³, does not specifically provide for the

² Correa Carlos *Trade Related Aspects of Intellectual Property*. A Commentary on the TRIPS Agreement Oxford University Press, Oxford, 2007 p. 905.

³ The Grundnorm known as the fundamental norm in German is the basic norm expounded by Hans Kelsen which postulated the pure theory of law which is a positive law. This theory is the "final norm's validity cannot be derived from a higher norm, the reason for its validity cannot be questioned. Such a presupposed highest norm is referred to in this book as basic norm. All norms whose validity can be traced back to one and the same basic norm constitute a system of norms, a normative order. The basic norm is the common source for the validity of all norms that belong to the same order it is their common. Reason of validity. The fact that a certain norm belongs to a certain order is based on the circumstance that its last reason of validity is the basic norm of this order. It is the basic norm that constitutes the unity in the multitude of norms by

protection of intellectual property rights. The constitution, however, provides that the Federal High Court has jurisdiction, to the exclusion of all other courts, in civil causes and matters relating to copyright, patent, designs, trade marks and passing-off, industrial designs and merchandise marks.⁴ Although this provision relates to only civil matters, the Constitution extends the jurisdiction of the Court to criminal causes and matters in respect of which jurisdiction is conferred.⁵ The Federal High Court Act⁶ emphasises the fact that criminal proceedings before the Court shall be conducted substantially in accordance with the provisions of the Criminal Procedure Act.⁷

The Federal High Court also sits as an appellate court on matters from the Tribunals⁸ mentioned in the Trade Marks Act⁹ and the Patents and Designs Act.¹⁰ Where parties are dissatisfied, the Court of Appeal¹¹ and, finally, the Supreme Court¹² exercise appellate jurisdiction on matters originating from the Federal High Court (FHC). Furthermore, access to legal representation is provided under the law,¹³ as required in the TRIPS Agreement.¹⁴

The various regulatory frameworks for intellectual property laws contain provisions for the enforcement of intellectual property rights. The Copyright Act,¹⁵ beginning from sections 14 to 22,¹⁶ sections 25 to 27¹⁷ and section 29,¹⁸ provides for the enforcement of copyright.

representing the reason for the validity of all norms that belong to this order.” See Hans Kelsen, *Pure Theory of Law*, Berkeley and Los Angeles: University of California Press 1967 pp. 194-5

⁴ Section 251(1) (f) Constitution of the Federal Republic of Nigeria 1999.

⁵ Section 251 (3) Constitution of the Federal Republic of Nigeria 1999.

⁶ Section 33 (1) Federal High Court Act Cap F21 Laws of the Federation of Nigeria 2004.

⁷ Criminal Procedure Act Cap 41 Laws of the Federation of Nigeria 2004.

⁸ Tribunal means the Registrar or the court, as the context or circumstances may require. Section 67 Trade Mark Act T13 LFN 2004.

⁹ Section 9 (3), section 10 (2); section 15 (b) (i) ; section 16 (1) section 31; section 36 Cap T13, Laws of Federation of Nigeria 2004.

¹⁰ Cap P2 vol. 11 Laws of the Federation of Nigeria.

¹¹ Section 240 and 241 Constitution of the Federal Republic of Nigeria (1999).

¹² Section 233 Constitution of the Federal Republic of Nigeria (1999).

¹³ Section 36 (6) (b) Constitution of the Federal Republic of Nigeria (1999).

¹⁴ Article 42 TRIPS Agreement.

¹⁵ Cap C28 Laws of the Federation of Nigeria 2004.

¹⁶ These provisions relate to infringement of copyright See generally Copyright Act Cap C28 Laws of the Federation of Nigeria 2004.

¹⁷ These provisions relate to infringement of neighbouring rights. See generally Copyright Act Cap C28 Laws of the Federation of Nigeria 2004.

¹⁸ This provision relates to infringement of folklore protection. See generally Copyright Act Cap C28 Laws of the Federation of Nigeria 2004.

Unlike the Copyright Act, which has specific provisions on infringement proceedings, the Trade Marks Act¹⁹ merely makes cursory reference to the issue of infringement in sections 3, 5, 6, 43 (5) & (6) and 44 of the Act. The Patent and Design Act,²⁰ although it contains express provisions on infringement, these consist of only two sections, sections 25 and 26.

Apart from the intellectual property rights' provisions there are other legislations which also provide for the enforcement of certain intellectual property rights, such as the Nigerian Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act²¹ Food, Drugs and Related Products (Registration, etc.) Act,²² Food and Drugs Act,²³ Trade Malpractices (Miscellaneous Offences) Act,²⁴ Criminal Code²⁵ and the Penal Code.²⁶ In addition, there are government agencies and bodies responsible for monitoring and controlling the quality of products, as well as safeguarding consumers' rights, namely, the Standard Organisation of Nigeria (SON)²⁷ and Consumer Protection Council (CPC).²⁸ Other agencies empowered with enforcement rights include the Nigerian Copyright Commission (NCC). Of particular note is an anti-piracy scheme known as Strategic Action against Piracy (STRAP) and Copyright Litigation Alternative Mediation Programme (CLAMP), both were initiated in 2005 to foster public enlightenment and education, the enforcement of rights as well as to administer rights. Although intellectual property enforcement is low there has been an amount of case law and legal jurisprudence in this area of law, which have been decided by the Federal High Court and all the way to the Supreme Court. The following section will deal with the various intellectual property rights in order to examine their compliance with the TRIPS Agreement.

¹⁹ Cap T13 Laws of the Federation of Nigeria 2004.

²⁰ Cap P11 Laws of the Federation of Nigeria 2004.

²¹ Cap C34 Laws of the Federation of Nigeria 2004.

²² Cap F33 Laws of the Federation of Nigeria 2004.

²³ Cap F32 Laws of the Federation of Nigeria 2004.

²⁴ Cap F32 Laws of the Federation of Nigeria 2004.

²⁵ Cap Cap.12 Laws of the Federation of Nigeria 2004.

²⁶ Cap Cap.89 Laws of the Federation of Nigeria 2004.

²⁷ Cap S30 Laws of the Federation of Nigeria 2004. Formerly known as Nigeria Standards Organisation (NSO)

Cap S30 Laws of the Federation of Nigeria 2004.

²⁸ Cap C23 Laws of the Federation of Nigeria 2004.

7.3 Enforcement required under the TRIPS Agreement

To enable effective action against any act of infringement of intellectual property rights members are required to formulate laws that ensure enforcement procedures, which should include expeditious remedies to prevent infringements as well as provide remedies. These procedures should not constitute barriers to legitimate trade and shall provide safeguards against abuses.²⁹ It is expected of member states to design procedures that are fair, equitable and uncomplicated.³⁰ Decisions shall be in writing, based on merit and without delay. Cases shall be adjudicated by a judicial authority having final administrative decision. Nigeria has a judicial system which deals with the issue of enforcement of intellectual property along with other matters on the exclusive legislative list³¹ as provided under the Constitution, although it is not separate from that used for its general laws. Generally, the TRIPS Agreement requires civil and administrative procedures and remedies³² and criminal procedure,³³ as well as border measures³⁴ to be provided in member states.

7.3.1 Copyright

Under the Copyright Act, an infringement of any of the bundle of rights³⁵ is actionable as a breach of the statutory duty owed to the person entitled to the right.³⁶ The owner, assignee or an exclusive licensee of the copyright, as well as the Nigeria Copyright Commission (NCC), can file a cause of action for copyright infringement of an unauthorised use of a work. The Copyright Act provides a number of remedies, civil actions can be filed and criminal actions can be taken as well. The Act permits both criminal and civil actions to be taken simultaneously in respect of the same infringement.³⁷ Apart from the Copyright Act, there are several other regulations that have been enacted to curb the spate of entertainment and software piracy. These include the Copyright (Video Rental) Regulations 1999 Copyright

²⁹ Article 41 TRIPS Agreement.

³⁰ Article 41.2 TRIPS Agreement.

³¹ Second Schedule Part II of the Constitution of the Federal Republic of Nigeria.

³² Articles 42-49 TRIPS Agreement.

³³ Articles 61 TRIPS Agreement.

³⁴ Articles 50-60 TRIPS Agreement.

³⁵ Section 6- 9 CA 1988 Cap C28 LFN 2004.

³⁶ Section 16 CA 1988 Cap C28 LFN 2004.

³⁷ Section 21 CA 1988 Cap C28 LFN 2004.

Act,³⁸ Copyright (Security Devices) Regulations 1999,³⁹ Copyright (Optical Discs Plants) Regulations, 2006.⁴⁰

The Optical Discs Plants Regulations empower the NCC to oversee and monitor the manufacturing of optical discs⁴¹ or production parts,⁴² raw materials and manufacturing equipment⁴³ in Nigeria as a means of combating optical disc piracy by mandating manufacturers and importers to register with the NCC. Failure to abide by the registration requirements as laid down in the regulation is an offence which is punishable upon conviction to imprisonment for a term not exceeding three years or to a fine of not less than ₦1 million or both.⁴⁴ The Copyright (Video Rental) Regulations is another way of regulating the lawless copying of entertainment optical disc rented out at every street corner. The Regulation is designed to enable video renting businesses to be properly regulated and registered for easy monitoring and supervision from the NCC so as to enable film producers to recoup their investment as well as benefit from the commercial exploitation of their work. A Video Rental Scheme is created where such users are required to be registered and a

³⁸ Copyright (Video Rental) Regulations 1999 Copyright Act (As amended by the Copyright (Amendment) Decree 1999) *Commencement: 7th September, 1999.*

³⁹ Copyright (Security Devices) Regulations 1999³⁹ Copyright Act (As amended by the Copyright (Amendment) Decree 1999) *Commencement: 7th September, 1999.*

⁴⁰ Copyright (Optical Discs Plants) Regulations, 2006 *Commencement: 15th September, 2006.* Federal Republic of Nigeria Official Gazette No. 63, Vol. 93 of 20th December, 2006. Government Notice No. 47.

⁴¹ An ‘optical disc’ means any medium or device, other than a production part, on which data in digital form, readable by means of an optical scanning mechanism employing a high-density light source such as a laser, has been stored or is capable of being stored, and includes but is not limited to: CD (compact disc); CD-ROM (compact disc read-only memory); CD-R (compact disc recordable); CD-RW (compact disc rewritable); DVD (digital versatile disc); DVD-RAM (digital versatile disc random access memory); LD (laserdisc); MD (minidisc); VCD (video compact disc); CVD (China video disc); SVCD (super video compact disc); SACD (Super audio compact disc). See generally rule 13 Copyright Act Copyright (Optical Discs Plants) Regulations, 2006.

⁴² A ‘production part’ includes: (a) Any other device, usually referred to as a ‘master’, ‘father’ or ‘mother’, embodying data from which a stamper may be produced by means of an electroplating process. (b) The component of a mould usually referred to as a ‘stamper’ that embodies data in a digital form and is capable of being used to mould optical discs, “Professional organization” means an organisation whose membership consists wholly or substantially of intellectual property right holders, and which is mandated by those members to enforce their rights against counterfeiting and/or piracy. See Rule 13 Copyright Act Copyright (Optical Discs Plants) Regulations, 2006.

⁴³ Rule 4 Copyright Act Copyright (Optical Discs Plants) Regulations, 2006.

⁴⁴ Rule 11 Copyright (Optical Disc Plants) Regulations, 2006.

certificate of accreditation, renewable every year, is given to the person who wants to carry on the business of renting videos.⁴⁵

7.3.1.1 Enforcement procedures

As stated above the Copyright Act provides for both civil and criminal action to be taken against an infringer.⁴⁶ A civil action is taken by the plaintiff or the person who suffers the loss or is injured as a result of the infringer's acts. On the other hand, a criminal action is instituted by the state or the government.⁴⁷ Generally, if an infringement is committed, it is the owner who is responsible for instituting an action, unless the infringement has become wide scale so that the police or the customs have become involved in the matter. Accordingly, these measures comply with procedures required in the TRIPS Agreement.⁴⁸

7.3.1.2 Cause of Action

Section 15 of the Copyright Act lays down a set of facts which, if infringed, enables the right owner to seek redress in a court of law. There are different causes of action available to a right owner where his work has been used without authorisation: if,

- (a) does, or cause any other person to do an act, the doing of which is controlled by copyright;
- (b) imports into Nigeria, otherwise than for his private or domestic use, any article in respect of which copyright is infringed under paragraph (a) of this subsection;
- (c) exhibits in public any article in respect of which copyright is infringed under paragraph (a) of this subsection;
- (d) distributes by way of trade, offer for sale, hire or otherwise or for any purpose prejudicial to the owner of the copyright, any article in respect of which copyright is infringed under paragraph (a) of this subsection;
- (e) makes or has in his possession, plates, master tapes, machines, equipment or contrivances used for the purpose of making infringed copies of the work;
- (f) permits a place of public entertainment or of business to be used for a performance in the public of the work, where the performance constitutes an infringement of the copyright in the work, unless the person

⁴⁵ Rule 3 Copyright (Video Rental) Regulations 1999 Copyright Act (As amended by the Copyright (Amendment) Decree 1999) *Commencement: 7th September, 1999.*

⁴⁶ Section 21 CA 1988 Cap C28 LFN 2004.

⁴⁷ Daniel E. Hall *Criminal Law and Procedure* Cengage Learning 5th ed. 2009 p.18 John T. Cross *Civil Procedure: Keyed to Yeazell*, 7th ed. Wolter Kluwer Aspen publisher 2009 p.3-4.

⁴⁸ Article 42 and 60 TRIPS Agreement.

- permitting the place to be used is not aware, and had no reasonable ground for suspecting that the performance would be an infringement of the copyright;
- (g) performs or cause to be performed for the purposes of trade or business or as supporting facility to a trade or business or as supporting facility to a trade or business, any work in which copyright subsists.

Section 28 of the Copyright Act also lays down specific causes of action in relation to unauthorised use of performances: if,

- (a) makes a recording of the whole or substantial part of a live performance:
- Provided that where the consent sought is to make a recording of the work for research, private or domestic use, such consent shall not be reasonably refused;
- (b) broadcasts live, or includes live in a cable programme, the whole or a substantial part of the live performance;
- (c) performs in public the whole or a substantial part of the live performance;
- (d) shows or plays in public the whole or a substantial part of the live performance for commercial purposes;
- (e) broadcast, or includes in a cable programme, a substantial part of the performance by means of recording which is, and which that person knows or has reason to believe was made without the performer's consent;
- (f) imports into the country otherwise than for his private or domestic use, a recording of a performer's work which is an infringing recording; or
- (g) in the course of trade or business, sells or lets for hire, offers, distributes or displays for sale or hire a recording of a performer's work which is an infringing recording.

In essence, no one, apart from the owner of a copyright work or licensee, is allowed to reproduce, copy, publish, publicly perform, translate, adapt, distribute, import or broadcast a copyrighted work.

The Act clearly states that archives and public records of states do not constitute infringement of a work by making or reproducing the work, apart from other authorised uses mentioned in the Second, Third and Fourth Schedule of the Act.⁴⁹ The Act classifies the causes of action into direct infringement and indirect infringement:⁵⁰ Direct infringement is provided for in section 15(1) (a) and indirect infringement is provided for in section 15(1)

⁴⁹ Section 15 (2) CA 1988 Cap C28 LFN 2004.

⁵⁰ Folarin Shyllon, *Intellectual Property Law in Nigeria* IIC Studies Max-Planck Institute 2003 p. 81.

(b)-(g). As well, the use of an expression of folklore without authorisation from the Nigerian Copyright Commission (NCC) constitutes a breach of statutory duty.⁵¹

7.3.1.3 Remedies and Reliefs

a. Civil remedies

The Copyright Act primarily gives a right owner three civil remedies for infringement: damages, injunction and accounts for profit.

i. Damages

A copyright owner⁵² can seek damages in respect of an infringement of his right.⁵³ Where infringement has affected proprietary rights of a copyright owner and as a result loss is suffered, damages are awarded in a bid to restore the owner to the position the person ought to have been in had the infringement not occurred. Under article 45 the infringer who knowingly and with reasonable grounds to know engages in an infringing activity shall pay the right holder damages adequate to compensate for the injury the right holder has suffered. Although not as clearly stated in the Copyright Act, the award of damages can be implied from the following subsection which states that damages will not apply where the infringer was not aware or has no reasonable ground for suspecting that copyright subsisted in the work.⁵⁴ It can be extrapolated that if the infringer is aware he must pay damages for losses suffered. If the infringer is not aware he will not be liable for damages, but will, however, be required to account for all the profits made as a result of the infringement.⁵⁵ In addition, where the court is satisfied that the relief granted to the plaintiff would not be effective, in assessing damages for infringement, the court may award additional damages as it considers appropriate where an infringement is proved and admitted taking into consideration the

⁵¹ Section 32 CA 1988 Cap C28 LFN 2004.

⁵² Copyright owner include performance in section 23 copyright Act as well as Nigeria Copyright Commission (NCC) responsible for the protection of the expression of folklore.

⁵³ Section 16 (1) CA 1988 Cap C28 LFN 2004.

⁵⁴ Section 16(3) CA 1988 Cap C28 LFN 2004; See also *Federal Republic of Nigeria (FRN) v Asika* FHC/A/2CR/92 (unreported).

⁵⁵ Section 16(3) CA 1988 Cap C28 LFN 2004.

flagrancy of the infringement as well as benefits that have accrued to the infringer as a result of the infringement.⁵⁶

In this regard it is questionable whether the law provide for adequate damages to compensate for the injury suffered, as is required in article 45 of the TRIPS Agreement.⁵⁷ For civil remedies the Copyright Act does not state an amount neither does it provide a means for deriving such damages. It is left to be decided by the court and it was held in *Masterpiece Investment Ltd. v Worldwide Business Media*⁵⁸ that such discretion must be exercised judicially and judiciously.

The damages may be in form of general damages, special damages⁵⁹ and/or exemplary or punitive damages.⁶⁰ The type of damages or combination of damages awarded depends mainly on the facts and circumstances of each case. Damages may also include the copyright owner's expenses, which may comprise appropriate attorney's fees as well as an order for recovery of profits⁶¹ and/or payment of pre-established damages, even where the infringer did so unknowingly.⁶² Proof of intentional or non-intentional infringement and the degree of the infringement may be taken into consideration in determining the damages awarded.

In practice, the courts have used damages as relief for copyright infringement. The courts awarded exemplary damages in *Oladijo Yemitan v Daily Times and Another*⁶³ because of the flagrancy of the infringement and the profit that accrued to the defendant. In *Peter Obe v Grapevine Communication Ltd*⁶⁴ the court awarded damages in addition to the ordinary damages sought by the plaintiff. In what remains one of the few cases where judgement was not only done but was seen to be done, the judge took into consideration the flagrancy of the infringement as provided for under section 16(4) of the Copyright Act and the current economic situation of the country, considering the fact that the judgement was delivered 10

⁵⁶ Section 16(4) CA 1988 Cap C28 LFN 2004.

⁵⁷ Article 45.1 TRIPS Agreement.

⁵⁸ [1990-1997] 1997 3.I.P.L.R 345.

⁵⁹ *Yusufu Ladan v Shakallo Publication Co.Ltd.* [1917-1996] 1.I.P.L.R 270.

⁶⁰ *Masterpiece Investment Ltd. v. Worldwide Business Media* (1997) 3.I.P.L.R 345.

⁶¹ Section 16(1) and 29(1) CA 1988 Cap C28 LFN 2004.

⁶² Section 16(3) CA 1988 Cap C28 LFN 2004.

⁶³ [1990-1997] 3.I.P.L.R152.

⁶⁴ [2003-2007] 5 IPLR 372 ; see also *Sonora Gentil v Tabansi Agencies* [1977-1989] 2.I.P.L.R 1.

years after the filing of the suit. The court awarded damages general of ₦ 5, 000,000 and additional damages of ₦ 1, 000,000.

ii. Injunctions

This is another form of relief or an order provided under the Copyright Act: it gives the court the authority to order a party to desist from an infringement.⁶⁵ Injunctions are equitable remedies which are an important form of relief⁶⁶ as they are used to assist, clarify as well as decide legal proceedings⁶⁷ by requiring parties to litigation to maintain the *status quo*⁶⁸ and refrain from acts that can be detrimental to the outcome of the proceeding. There are two main categories of injunctions: permanent injunctions and temporary injunctions.⁶⁹

Injunctions are granted at the discretion of the court based on the facts available before it. Injunctions are utilised mainly where there has been an infringement of the plaintiff's right and other remedies would not adequately compensate the plaintiff.⁷⁰ Where a person is not aware of the infringement at the time it was committed, the Act seems to imply that an injunction can be used in such cases as part of other relief granted.⁷¹ Where copyright infringement requires a completed or partly completed building to be demolished or prevents the completion of a partly completed building no injunction shall be issued for that purpose.⁷² In *Oladijo Yemitan's case*⁷³ the defendant, a newspaper and magazine publishing company, infringed the plaintiff's work 'The Day the Lagoon Caught Fire' by publishing it verbatim in its magazine called 'Headlines': printing and publishing the plaintiff's work without a licence or the plaintiff's approval. The court held that the defendant infringed the copyright of the plaintiff taking advantage of the fact that very few artists in this country are aware of

⁶⁵ Sections 16(1), 29 (1) and 25(1) CA 1988 Cap C28 LFN 2004.

⁶⁶ Folarin Shyllon p.110.

⁶⁷ Samantha Hepburn Principles of Equity & Trusts (Aus) 2/e Psychology Press p. 209.

⁶⁸ Folarin Shyllon p.110.

⁶⁹ These may further be divided into common injunction, mandatory injunction, prohibitive injunction, *ex parte* or *inter parte* injunction *quia timet* injunction, interlocutory injunction *mareva* order, and Anton Piller Order- See *Ferodo Limited v Unibros Stores* (1980) F.S.R 489 per Anyaegbunam C.J First Anton Piller Order made in Nigeria.

⁷⁰ Orders 26-28 Federal High Court (Civil Procedure) Rules 2009.

⁷¹ Section 19 (2) CA 1988 Cap C28 LFN 2004.

⁷² Section 16 (5) CA 1988 Cap C28 LFN 2004.

⁷³ *Oladijo Yemitan v Daily Times & Another*[1990-1997] 3.I.P.L.R152.

their copyright under Copyright law. The court, in addition to the damages awarded, ordered an injunction against the defendant from any further sale, use or dealings in the plaintiff's work.

One of the hallmarks of the Copyright Act is the fact that it allows *ex parte* applications where there is reasonable cause for suspecting that there are infringing materials on a particular premises.⁷⁴ The provision constitutes the granting of an Anton Piller order in cases of copyright infringement⁷⁵ and provides, specifically, for an order to seize, detain and preserve any such infringing copy or contrivance as well as to inspect all or any documents in the custody or under the control of the defendant relating to the action⁷⁶ the 'essence of an effective Anton Piller order, which is granted on an *ex parte* application by the plaintiff, is the element of surprise'.⁷⁷ An *ex parte* application is granted if it has been shown that the interest of the adverse party will not be affected and time is of the essence for the application.⁷⁸

b. Criminal remedies

Apart from the civil remedies which are given to the copyright owner, the infringer is also faced with criminal sanctions. Criminal liability is based on direct and indirect infringement.

i. Cause of action

Section 20 (1) specifies that a person is criminally liable: if ,

- (a) makes or causes to be made for sale, hire, or for the purpose of trade or business any infringing copy of a work in which copyright subsists; or
- (b) imports or causes to be imported into Nigeria more than two infringing copies of such work; or
- (c) makes, causes to be made, or has in his possession, any plate, master tape, machine, equipment or contrivance for purpose of making any infringing copy of any such work.

Section 20 (2) on the other hand makes it a criminal offence if any person:

⁷⁴ Section 25 (1) CA 1988 Cap C28 LFN 2004.

⁷⁵ Anton Pillar K.G v Manufacturing Process⁹ (1976) 1 All E.R. 779.

⁷⁶ Section 22(1) (a) & (b) CA 1988 Cap C28 LFN 2004; see also section 18(4) (1).

⁷⁷ Bigger, Stephen Notes from Other Nations 71 Trademark Rep. 258 (1981).

⁷⁸ *Leedo v Bank of the North* (1998) 7 SCNJ 328 at 353.

- (a) sells or lets hire or for purpose of trade or business, exposes or offers for sale, or hires any infringing copy of any work in which copyright subsists; or
- (b) distributes for the purposes of trade or business any infringing copy of any such work; or
- (c) has in his possession other than for his private or domestic use, any infringing copy of any such work,

Section 20 (3) provides that:

Any person who, without the consent of the owner, distributes, in public for commercial purposes by way of rental, lease, hire, loan or similar arrangement copies of a work in which copyright subsists.

Under section 30 (1) criminal liability is imposed where the performer's right is infringed arising from the same cause of action under civil remedies.

ii. Penalties

The Copyright Act provides penalties such as imprisonment and/or monetary fines. One of the major concerns of this provision is that the imprisonment and monetary fines are not sufficient to provide deterrence in view of the current scale of infringement in Nigeria. For instance, for the cause of action under section 20 (1) of the Copyright Act, an infringer will be liable on conviction to a fine of an amount not exceeding ₦ 1,000 for every copy dealt with or to a term of imprisonment not exceeding five years or, in the case of an individual, to both fine and imprisonment.⁷⁹ ₦ 1,000 (\$6) per every infringing copy may be insignificant if the book cost ₦20,000 and taking into account the fact that the individual is a direct infringer who has made plates, master tapes, and bought machines, equipment or contrivances for the purpose of infringing a copy of any such work. The fine does not even cover the price of the paper the work is printed on, let alone all other expenses that come with publishing a book.

For an indirect infringer the punishment is similar, except for the maximum term of imprisonment which shall not exceed two years.⁸⁰ If copies of the work are distributed, to the public for commercial purposes, by way of rental, lease, hire, loan or similar arrangement or any infringing copy of any work is in possession of a person other than for his private or domestic use,⁸¹ the infringer shall be liable upon conviction to a fine of ₦ 100 (\$0.60) for

⁷⁹ Section 20 (1) (c) CA 1988 Cap C28 LFN 2004.

⁸⁰ Section 20 (2) proviso CA 1988 Cap C28 LFN 2004.

⁸¹ Section 20 (2) (c) Copyright Act; See also *NCC v Nwore Anayo* FHC/ABJ/CR/10/2012.

every copy dealt with or imprisonment for six months or to both a fine and imprisonment.⁸² The provision is adverse to public order. The distribution channel is key to getting works out, if infringers are allowed to escape with a slap on the wrist it will encourage further pirating of copies of works, thereby blocking the original copy from getting to the market.

The guilt of copyright infringement committed by corporate bodies is shouldered by the company and everyone in charge at the time of the infringement: they will be guilty of an offence and proceeded against accordingly.⁸³ Similarly, where performers rights are infringed, individuals are liable to a fine not exceeding ₦ 10,000 (\$62) and corporate bodies ₦50, 000 (\$310).⁸⁴ In other cases there is a fine of ₦ 100 per copy of the infringed work or 12 months imprisonment or both.⁸⁵ The penalties for infringing a performer's right are trivial, especially for corporate bodies that make a lot of money from the use of such work.

The consequences of the inadequate term of imprisonment and the fines awarded are evidenced by the current levels of piracy. Nigeria is loses over \$1 billion annually as a result of the magnitude of the infringement.⁸⁶ These measures visibly have no deterrent effect, making piracy a thriving business.

c. Other enforcement measures

i. Conversion rights

This is another form of relief granted to the plaintiff. This relief converts all infringing copies of any work in which copyright subsists, or of any substantial part thereof, and all plates, master tapes, machines, equipment or contrivances used, or intended to be used for the production of such infringing copies to the property of the owner, assignee or exclusive licensee of the copyright.⁸⁷ In addition, performers are entitled to an order to forfeit and deliver up all infringing material in the possession, custody or control, in the course of trade

⁸² Section 20 (2) proviso CA 1988 Cap C28 LFN 2004.

⁸³ Section 22 CA 1988 Cap C28 LFN 2004.

⁸⁴ Section 30(1) (a) and (b) CA 1988 Cap C28 LFN 2004.

⁸⁵ Section 30 (1) (c) CA 1988 Cap C28 LFN 2004.

⁸⁶ Chris Ochayi Nigeria loses over \$1bn annually to Piracy – NCC Vanguard Tuesday 30 July 2013 available at: <http://www.vanguardngr.com/2013/07/nigeria-loses-over-1bn-annually-to-piracy-ncc/#sthash.R0AuYibB.dpuf> accessed 13 November 2013.

⁸⁷ Section 18(1) CA 1988 Cap C28 LFN 2004.

or business of the infringer, otherwise than for a private or domestic use, including unauthorised recording of a performance by the infringer.⁸⁸ In *Haritz Ibezim Okilo v Dick Francis & Another*⁸⁹ the plaintiff has instituted an action for recovery of his master or DAT (master) tape of “Happiness De Answer”. The 1st defendant’s admitted to receiving the DAT tape and failed to return the tape, the court held by the provisions of section 18 of the Copyright Act relating to conversion right, the plaintiff has proved his entitlement to an Order to compel the 1st Defendant to return the DAT tape of the plaintiff’s musical work, “Happiness De Answer”.

ii. Anti-piracy measures

The 1999 Copyright Act Amendment created a section on anti-piracy measures.⁹⁰ This section is a very important provision in the Act as it empowers the Nigerian Copyright Commission to take certain actions which, prior to the amendment, were not possible. The provision recognises the importance of providing adequate protection for an effective enforcement of copyright by giving the NCC these powers. The provision includes the power to recommend any anti-piracy device for works in which copyright subsists.⁹¹ Permission must be sort from the NCC to import machines, equipment or any anti-piracy device and to have such in one’s possession.⁹² A failure to obtain such permission or register such anti-piracy device is an offence and punishable with a fine not exceeding ₦500, 000 (\$3100) or a maximum of 5 year imprisonment or both. Apart from this, it is an offence for a person to sell rent, hire offer for sale any work which the anti- piracy device has circumvented. This act is punishable with imprisonment of 12 months and a possible fine of up to ₦100, 000. Furthermore, any person who reproduces or counterfeits any anti-piracy device is liable for an offence punishable by up to 5 years of imprisonment or a fine of ₦50, 000 or both.⁹³

⁸⁸ Section 29 (2) CA 1988 Cap C28 LFN 2004.

⁸⁹ (2003- 2007) 5 I.P.L.R 230, per Ukeje J.

⁹⁰ See generally section 21 CA 1988 Cap C28 LFN 2004.

⁹¹ Section 21 (1) CA 1988 Cap C28 LFN 2004.

⁹² Section 21 (3) CA 1988 Cap C28 LFN 2004.

⁹³ Section 21 (4) CA 1988 Cap C28 LFN 2004.

The NCC, in the Copyright (Security Device) Regulation,⁹⁴ prescribes the use of hologram stamps in relation to sound recording and cinematograph films for sale, rental, lending, hiring and distribution of any kind.⁹⁵

iii. Copyright Inspectors

These are special officers' who are responsible for inspecting and examining any premises which may be reasonably suspected of being used for infringing activities. This is another provision which came out of the 1999 amendment of the Copyright Act.⁹⁶ These officers are usually appointed by the NCC. They have the power to arrest any person whom they reasonably suspect of committing a copyright infringement.⁹⁷ One important duty of the inspector is to inspect, examine and to make copies of the register of publishers, printers, producers or manufacturers of works in which copyright subsists. This register is useful in determining original copyright works from pirated copies.⁹⁸ The inspectors have the same powers rights and privileges of a police officer as provided for under the Police Act and under any other relevant enactment pertaining to investigation, prosecution, conduct, defence of civil or criminal matters under the Copyright Act.⁹⁹

7.3.2 Trade Marks

A proprietor and registered user may institute an action for the infringement of a trade mark.¹⁰⁰ Unlike the Copyright Act which clearly states that civil and criminal remedies are available to the owner of copyright, the Trade Marks Act merely makes reference to the civil remedies that a trade mark proprietor may be entitled to if his right is infringed.

⁹⁴ Copyright (Security Device) Regulations, 1999 *Commencement: 7th September, 1999*. Federal Republic of Nigeria Official Gazette No. 63, Vol. 86 of. 10th September, 1999. Government Notice No. 145.

⁹⁵ Section 38 (2) CA 1988 Cap C28 LFN 2004.

⁹⁶ Copyright (Amendment) Decree No 42 of 1999.

⁹⁷ Section 38 (2) CA 1988 Cap C28 LFN 2004.

⁹⁸ Section 38 (2) (d) CA 1988 Cap C28 LFN 2004.

⁹⁹ Section 38 (5) CA 1988 Cap C28 LFN 2004.

¹⁰⁰ Section 3and 33 (4) TMA 1965 T13 LFN 2004.

7.3.2.1 Cause of Action

A trade mark is infringed when a person, who is not the proprietor or registered users, uses in the course of trade, on the same kind of goods registered, an identical or similar mark in a way that is likely to deceive or cause confusion or be taken to be used by the proprietor. Such uses include use upon the goods or in physical relation or in an advertising circular or other advertisement issued to the public imparting reference to some person having the right either as proprietor or as registered user of a mark.¹⁰¹ For a trade mark proprietor to institute any proceedings, the trade mark must be duly registered to recover damages for infringement.¹⁰² In effect, registration is *prima facie* evidence of the validity of the trade mark and of all subsequent assignments and transmissions thereof.¹⁰³

The infringement of a proprietor's right does not include the limitations entered in the register.¹⁰⁴ The use of one or two or more registered trade marks that are identical or nearly resembling each other in respect of the same goods or description of goods,¹⁰⁵ by one of the proprietors will not constitute an infringement.¹⁰⁶

7.3.2.2 Remedies

The relief that can be sought by the owner of a trade mark includes damages for the compensation of the wrongful act and injunctions to stop the infringing activity. Furthermore, the law provides for criminal actions to be instituted in cases of false representation of trade mark.

a. Criminal Remedies

Criminal sanction in the Trade Marks Act relate to particular causes of action. Where a person makes a false entry in the register, or falsely purports a writing to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence

¹⁰¹ Section 5(2) TMA 1965 T13 LFN 2004.

¹⁰² Section 3 TMA 1965 T13 LFN 2004.

¹⁰³ Section 49 TMA 1965 T13 LFN 2004.

¹⁰⁴ Section 5(3) TMA 1965 T13 LFN 2004.

¹⁰⁵ Section 13(2) TMA 1965 T13 LFN 2004.

¹⁰⁶ Section 5(4) TMA 1965 T13 LFN 2004.

any such writing, knowing the entry or writing to be false shall be liable to imprisonment for a term not exceeding seven years.¹⁰⁷ A person will be criminally liable if he makes a false representation in respect of a mark not registered as being registered,¹⁰⁸ parts of a trade mark not registered as registered¹⁰⁹ and goods not registered in respect of a mark as registered.¹¹⁰

Trade mark offences such as counterfeiting, are dealt with by other legislations that criminalise such acts, these include, the Merchandise Act 1916,¹¹¹ Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act,¹¹² Food, Drugs and Related Products (Registration, etc) Act,¹¹³ Food and Drugs Act,¹¹⁴ Trade Malpractices (Miscellaneous Offences) Act¹¹⁵ and the Penal Code.¹¹⁶

The Merchandise Act, in particular, criminalises the forgery of any trade mark,¹¹⁷ false labelling calculated to deceive,¹¹⁸ make, dispose, possess any dye, block, machine or other instrument for the purpose of forging, or of being used for forging, a trade mark,¹¹⁹ or false trade description.¹²⁰ Moreover, a person selling, exposed to, or has in his possession for sale, trade or the manufacture of any goods or things with any forged trade mark or to which false trade description is applied or to which any trade mark or mark so nearly resembling a trade mark is falsely applied as to be calculated to deceive is guilty of an offence as well.¹²¹ Such persons shall be liable on conviction to imprisonment for two year, a fine or both.¹²² The Act also provides for a conviction of six months imprisonment on summary conviction.¹²³ Furthermore, the courts can give an order of forfeiture of every chattel, article, instrument or

¹⁰⁷ Section 60 TMA 1965 T13 LFN 2004.

¹⁰⁸ Section 61 (1) (a) TMA 1965 T13 LFN 2004.

¹⁰⁹ Section 61 (1) (b) TMA 1965 T13 LFN 2004.

¹¹⁰ Section 61 (1) (c) TMA 1965 T13 LFN 2004.

¹¹¹ Cap M10 Laws of the Federation of Nigeria 2004.

¹¹² Cap C34 Laws of the Federation of Nigeria 2004.

¹¹³ Cap F33 Laws of the Federation of Nigeria 2004.

¹¹⁴ Cap F32 Laws of the Federation of Nigeria 2004.

¹¹⁵ Cap F32 Laws of the Federation of Nigeria 2004.

¹¹⁶ Cap Cap.89. Laws of the Federation of Nigeria 2004.

¹¹⁷ Section 3(1) (a) Merchandise Act 1916.

¹¹⁸ Section 3(1) (b) Merchandise Act 1916.

¹¹⁹ Section 3(1) (c) Merchandise Act 1916.

¹²⁰ Section 3(1) (d) Merchandise Act 1916.

¹²¹ Section 3(2) Merchandise Act 1916.

¹²² Section 3(2) (a) Merchandise Act 1916.

¹²³ Section 3(3) (b) Merchandise Act 1916.

thing by means of or in relation to which the offence has been committed.¹²⁴ The penalty provided for these grievous offences is albeit trivial when compared to the offence: the provision is understandable as this is a 1916 Act which is outdated and ill-equipped to deal with the current level of technologically sophisticated counterfeiting and the spate at which it is carried out.

Additionally, any person who produces, imports, manufactures, sells, distributes or is in possession of,¹²⁵ sells or displays for the purpose of sale,¹²⁶ aids or abets any person to produce, import, manufacture, sell, distribute or display for the purpose of sale,¹²⁷ counterfeit, adulterated, banned or fake, substandard or expired drugs or unwholesome processed food, in any form whatsoever commits an offence which is punishable under the Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act. Such offences are punishable by a fine of not exceeding ₦ 500,000 and imprisonment of 5 to 15 years.¹²⁸

As well as the above, the Act makes it an offence to hawk, sell,¹²⁹ display for the purpose of sale¹³⁰ or aid or abet any person to hawk, sell, display for the purpose of sale any drug or poison in any place not duly licensed or registered by the appropriate authority, including any market, kiosk, motor park, road-side stall or in any bus, ferry or any other means of transportation.¹³¹ Persons who engage in such acts are liable on conviction to a fine not exceeding ₦500, 000 or imprisonment for a term of not less than 2 years or both.¹³² Also,

¹²⁴ Section 3(3) (c) Merchandise Act 1916.

¹²⁵ Section 1 (a) Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act Cap C34 Laws of the Federation of Nigeria 2004.

¹²⁶ Section 1 (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹²⁷ Section 1 (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹²⁸ Section 3 (1) (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹²⁹ Section 2(1) (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹³⁰ Section 2 (1) (b) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹³¹ Section 2(1) (c) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004; this may sound funny but drugs are frequently hawked in public transport bus and ferries. There is also a trading cartel that specializes in getting street boys to hawk products. Hawking on the road is used as a means of selling a lot of substandard products.

¹³² Section 3 (1) (b) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

obstructing or resisting arrest, as well as interference with seized goods is an offence which may result in a fine of ₦ 50,000 or imprisonment for a term not exceeding 5 years or both.¹³³

The Trade Malpractices (Miscellaneous Offences) Act criminalises false or misleading labels, packages, sale, offer for sale or advertisement of any product in a manner likely to create a wrong impression as to its quality,¹³⁴ and creates a special Trade Malpractices Investigation Panel to investigate such offenses.¹³⁵ The offence is punishable by a fine on conviction of not less than ₦50, 000.¹³⁶

Although, there is no specific counterfeiting law in Nigeria, the Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) adequately cover issues of drugs and food counterfeiting but the Trade Malpractices (Miscellaneous Offences) Act does not provide adequate sanctions that would deter counterfeiters from making products dangerous to the life and health of people using them and from exposing people to substandard cosmetics, car parts, electrical appliances, toys, phones, etc.. As noted in chapter 5, Louis Vuitton was so concerned about its name and logo on all manner of goods ranging from earrings and bangles to phone covers, bags, belts, tee shirts, that it initiated a buy back store in Nigeria.

To sum up, there may be some deterrent or adequate punishment lapses in the laws due to the fact that some of the laws are ancient, nevertheless, trade mark enforcement is adequately provide for by various laws in Nigeria. Judicial authorities have used various means, such as damages, to order the infringer to pay the right holder compensation for the injury the right holder has suffered.¹³⁷ As well, injunctions ordering a party to desist from an infringement have been granted severally. In view of this it can be surmised that Nigeria provides enforcement procedures to deal with trade mark infringement and counterfeiting as well.¹³⁸

¹³³ Section 12 (2) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹³⁴ Section 1 (a) Trade Malpractices (Miscellaneous Offences) Act, Cap F32 Laws of the Federation of Nigeria 2004.

¹³⁵ Section 2 the Trade Malpractices (Miscellaneous Offences) Act.

¹³⁶ Section 1 (h) the Trade Malpractices (Miscellaneous Offences) Act.

¹³⁷ Article 45 TRIPS Agreement.

¹³⁸ Article 44 TRIPS Agreement.

7.3.3 Patent

A patentee may institute an action for patent infringement if any of the rights granted by the Patent and Design Act are infringed.¹³⁹ The fact that patents are granted mainly on a formality basis poses a risk of patent infringement as patents granted in another country may be granted afresh in Nigeria without the patent office being aware that is an existing patent or an expired patent. Although it may be argued that the nullity provision may take care of this type of situation,¹⁴⁰ nonetheless, it may still cause a high rate of patent infringement.

7.3.3.1 Cause of action

According to section 25 of the Patent and Design Act, a patent is infringed if another person, without permission of the patentee or the licensee of the patent, does or causes the doing of any act such as making, importing, selling or using the product, or stocking it for the purpose of sale or use or applying the process or doing, in respect of a product obtained directly by means of the process which are precluded under the Act.¹⁴¹ Infringement is divided into direct infringement and indirect infringement¹⁴² The Act makes no mention of an infringer who is not aware of the patent protection. This may be due to section 6 (4) (b) which excludes acts done in good faith.

7.3.3.2 Remedies

The Patent and Design Act sets out only civil relief that is available to the plaintiff. However, if the patent infringement constitutes a crime such as the counterfeiting of pharmaceutical products, then the infringer may be criminally liable.¹⁴³ Although, the provisions are available, determining a patent infringement is a different scenario entirely. As Shieh and Lee note: ‘patent enforcement lies in determining the connection between scope protected by the patent and the alleged infringing product or method’.¹⁴⁴

¹³⁹ Section 25 (2) Patent and Design Act Cap P13 Laws of the Federation of Nigeria 2004.

¹⁴⁰ Section 9 (1) PDA 1970 P2 LFN 2004.

¹⁴¹ Section 6 PDA 1970 P2 LFN 2004.

¹⁴² Section 25 (1) PDA 1970 P2 LFN 2004.

¹⁴³ Section 1 (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹⁴⁴ Ming- Yan Shieh & Su-Han Lee, ‘The Enforcement of Patent in Taiwan’, in Kung-Chung Liu & Reto M. Hitty *Enforcement of Intellectual Property Rights* Kluwer Law international The Netherlands 2012 p.184.

a. Civil remedies

The remedies include damages, injunctions and accounts of profit which are available to the owner of the patent as a form of compensation for the injury suffered as a result of the infringers actions and to stop the infringing act from continuing. An action for infringement may be brought by the patentee or a grantee of a licence.¹⁴⁵

i. Damages and Injunctions

A patentee or a grantee of a licence may seek damages as compensation against any person provided he proves that such person knowingly acted to cause such injury. As mentioned above damages can be awarded in various forms, depending on the circumstances of each case. Civil proceedings are brought in the Federal High Court by general procedural rules and, where there are no specific rules, modifications can be made where necessary.¹⁴⁶ The Federal High Court (Civil Procedure) Rules sets out the procedure for an action of patent infringement.¹⁴⁷ All patent infringement actions must be commenced by a writ of summons.¹⁴⁸ In *James Oitomen Agboronto v Grain Haulage*¹⁴⁹ the plaintiff's water-activated and out of water inactivate boiler, christened Oitomen Harmless Boiler (OHB), was infringed by the defendant's innovation, Mr Hot Pot (MHP). The court held that the defendant infringed the plaintiff's invention as the invention employed the same means by having a perforated inner base material mounted on stainless steel as the heating mechanism of OHB and which falls squarely within the protection claimed by the plaintiff, the Court granted an injunction restraining the plaintiff from further use of the invention. An account of profit was ordered by the court but not damages as the plaintiff could not prove damages and the relief was not granted.

¹⁴⁵ Section 25 (4) PDA 1970 P2 LFN 2004; see also *Nigerian Breweries v Olumo Agro Allied* (1985) HCNLR 615.

¹⁴⁶ Order 53 Rule 1 (1) Federal High Court (Civil Procedure) Rules 2009.

¹⁴⁷ Order 53 Rule 10 Federal High Court (Civil Procedure) Rules 2009.

¹⁴⁸ Order 53 Rule 10 (1) (a) Federal High Court (Civil Procedure) Rules 2009.

¹⁴⁹ *James Oitomen Agboronto v Grain Haulage* [1997-2003] 4 I.P.L.R 139-177.

b. Criminal remedies

As earlier noted, there are no clear cut criminal sanctions for patent infringement. The Patent and Design Act particularly does not provide for criminal liability in infringement cases. This does not mean that infringements which consist of elements of a crime will not be prosecuted. Infringement of patented drug and food that measures up to the scale of counterfeiting can be adequately taken care of by the Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act.¹⁵⁰ Offences which relate to manufacturing, importing and selling of counterfeit drugs and food can be punishable with a fine of up to ₦500 000 and imprisonment of 5 to 15 years.¹⁵¹ Similarly, the trade malpractices that relate to the infringement of one or more patent claim can be dealt with under the Trade Malpractices Act.¹⁵²

In conclusion, patentees will get justice as damages will be awarded by the courts and an order of injunction restraining the defendant from continuing the infringing act will be granted.

7.3.4 Border Measures

Only the Copyright Act expressly provides for such measures: infringing works can be stopped before they get to the market.¹⁵³ The owner of a copyright work may request by a notice in writing that the Department of Customs and Excise treat as prohibited goods, copies of the work during a specified period in a notice.¹⁵⁴ The restriction on imported works applies to works printed outside Nigeria which if it had been made in Nigeria will still constitute an infringing work.¹⁵⁵ Although, the provision expressly prohibits the importation of infringing copyright works into Nigeria,¹⁵⁶ the reality presently is that Nigeria is saddled with imported pirated copies of almost every type of educational text and optical disc in the

¹⁵⁰ Counterfeit and Fake Drugs and Unwholesome Processed Food (Miscellaneous Provisions) Act Cap C34 Laws of the Federation of Nigeria 2004. See generally paragraph 7.4.3.

¹⁵¹ Section 3 (1) (a) CFDPF Act Cap C34 Laws of the Federation of Nigeria 2004.

¹⁵² Trade Malpractices (Miscellaneous Offences) Act, Cap F32 Laws of the Federation of Nigeria 2004.

¹⁵³ Section 44 (1) CA 1988 Cap C28 LFN 2004.

¹⁵⁴ Section 44 (1) (b) CA 1988 Cap C28 LFN 2004.

¹⁵⁵ Section 44 (2) CA 1988 Cap C28 LFN 2004.

¹⁵⁶ See generally Section 36 CA 1988 Cap C28 LFN 2004.

last couple of years. Recently, the NCC was able to intercept seven (7) containers of suspected pirated books imported illegally from China estimated to be worth over ₦1.5 billion (\$10 million). The pirated books consisted of various local and foreign publishers, such as Penguin, Macmillan, Longman, Universal Press Limited (UPL) Oxford and Vanguard Press, among others and the books were mainly educational text.¹⁵⁷

Although, the Patent and Design Act does not expressly provide for border measures, a patentee has an exclusive right to preclude any other person from importing infringing products.¹⁵⁸ For trade marks, border measures may hinge on the fact that a trade mark owner has the exclusive right to use the registered trade mark in relation to the goods and services in which it is registered,¹⁵⁹ therefore, any infringing use by any unauthorised person will constitute an infringement.

Moreover, the minister of Internal Affairs is empowered to make regulations to restrict the importation or exportation of all goods or of any class or description of goods as may be prescribed by the regulations.¹⁶⁰

The Nigeria border monitoring situation goes from bad to worse: almost everything sold in Nigeria is a counterfeit or seriously substandard. The borders have been left open for all sorts of counterfeited products to roll in. The customs are not doing a good job in inspecting goods, the Standard Organisation of Nigeria (SON), which is responsible for standardisation of goods that come into Nigeria, has been removed from the ports. Even when they were there it did not make a difference. The problem has spilled over to neighbouring countries, fake and substandard good imported into Nigeria are exported to these countries.

The current high level of malaria deaths is mainly due to fake drugs which are ineffective for curing the disease. After so many doses of different fake drugs, death is bound to occur and

¹⁵⁷ Copyright Commission Impounds 10,000 Cartons Of Pirated Books Worth ₦1.5billion available at <http://www.copyright.gov.ng/index.php/news-and-events/99-copyright-commission-impounds-10-000-cartons-of-pirated-books-worth-n1-5billions> accessed 10 November 2013.

¹⁵⁸ Section 6 (1) PDA 1970 P2 LFN 2004.

¹⁵⁹ Section 5 TMA 1965 T13 LFN 2004.

¹⁶⁰ Section 1(1) Customs and Excise Act Cap C45 Laws of the Federation of Nigeria 2004.

will be attributed to malaria. The issue of counterfeit drug is serious and counterfeiters are not backing down. They are using every means possible to make these drugs look like the originals and they come up with new marketing strategies to beat law enforcement agencies. Another major problem is the importation of expired drugs which are meant for destruction in other countries: these are imported into Nigeria and the expiry date is extended for up to another two years. The situation in Nigeria is inexcusable as deaths occur every day due to one substandard product or the other: from death due to ingestion of fake drugs to accidents caused by fake brake pads. It is an issue that needs to be tackled head on by the government. Although this menace is not peculiar to Nigeria, if fakes also find their way into the US and UK and other developed countries despite the use of sophisticated machinery to detect such counterfeits, Nigeria's borders are a walk over for them as there is so much connivance between the importers and the authorities responsible for manning Nigeria's borders.

7.3.4.1 Nigeria Customs

The Nigeria Customs Service (NSC) is in charge of border control and examining goods that come in and go out of Nigeria. The Customs and Excise Management Act (CEMA),¹⁶¹ is the principal law guiding the Administration of Customs and Excise in Nigeria. One of the core functions of the Nigerian Custom Service is the prevention and suppression of smuggling. In addition, the NCS collaborates with other government agencies, such as Nigerian Police, Standard Organisation of Nigeria (SON), National Agency for Food and Drug Administration and Control (NAFDAC). The NSC supports the combatting of illegal commercial activities and trade in illicit goods, for example, the import of fake and substandard goods, the infringement of intellectual property rights and the illegal importation of toxic and hazardous substances.¹⁶²

¹⁶¹ Customs and Excise Management Act Cap C45 Laws of the Federation of Nigeria 2004.

¹⁶² Nigeria Customs Service, function available at <https://www.customs.gov.ng/About/function.php> accesses 11 November 2013.

In 2009, over 250 NSC officials went on a three day training course on intellectual property enforcement which was organised by the United States' Mission in Nigeria in collaboration with the U.S. Patent and Trademark Office.¹⁶³

Despite the fact that combatting the importation of pirated material and counterfeit goods is part of the functions of the NSC, pirated books still find their way into the market. A recent raid conducted by the NCC in October 2013 at different locations in Nigeria shows that piracy is not diminishing. In Ajegunle Boundary Market alone books worth ₦ 125 million, belonging to both local and foreign authors, were seized during the anti-piracy raid following a tip off by rights owners.¹⁶⁴ Earlier in 2013, NAFDAC seized and impounded from Aba market expired cartons of SMA infant formula, 6x 900 grams, fake Milo drinks and other products worth ₦3 million. SMA baby formula is not made in Nigeria and must have passed through the ports. It is not to say that the NSC is sitting with folded arms while all these counterfeit products find their way onto the market: year in year out a large number of seizures are made by the NCS. The problem is the larger number that get to the market either undetected or because a custom officer has looked the other way.

7.3.5 Enforcement Agencies

7.3.5.1 Nigerian Copyright Commission

The Nigerian Copyright Commission has been in the fore front of the fight against piracy and is doing a good job. The Nigeria Copyright Commission (NCC) then Nigerian Copyright Council, was established by the Copyright Decree No. 47 of 1988. The principal mandate of the NCC is the administration, protection and enforcement of all matters on copyright in Nigeria.¹⁶⁵ The NCC takes its mandate seriously and has initiated several programmes with regard to the administration and the enforcement of copyright. Some of the programmes comprise a copyright notification scheme, video rental scheme, optical disc plant and a

¹⁶³ Oladunjoye Phillip Nigeria: U.S. Trains Nigeria Customs On Intellectual Property Enforcement Daily Independent Friday 3 July 2009.

¹⁶⁴ ₦125 Million Suspected Pirated Literary Works Seized by NCC Operatives available at <http://www.copyright.gov.ng/index.php/news-and-events/245-n125-million-suspected-pirated-literary-works-seized-by-ncc-operatives> accessed 10 November 2013.

¹⁶⁵ Section 34 CA 1988 Cap C28 LFN 2004.

collection management organisation, which are to enable the smooth running of the NCC. Other programmes include STRAP and CLAMP for a better and more efficacious enforcement of copyrights and in particular, to curb piracy.

The NCC in 2012 alone seize a total of ₦ 4.3billion worth of infringing materials ranging from books, musical and movie works, broadcast signals and software products.¹⁶⁶ Despite NCC's aggressive anti-piracy actions and an obvious zero tolerance for piracy, in 2013 there were several mind boggling seizures. In Abuja, over 3,750 units of pirated broadcast decoders worth over ₦780 million used for broadcast signal hacking were impounded during one raid. These signal hacking devices were imported into Nigeria that means they must have passed the border by land, sea or air. According to NCC, the 'multipurpose broadcast signal-hacking device has the capacity to decode copyright-protected, encrypted signals; receive such signals from any part of the world and transmit such to as many television sets that are connected to it'.¹⁶⁷ This type of decoding is popularly known as STRONG. The Alaba International market notorious for piracy in optical disc,¹⁶⁸ was raided in July 2013 and broadcast materials, goods and equipment used for Digital Satellite Receiver Decoder worth ₦1.5bn (\$100 million) were seized.¹⁶⁹

Recently, a forty foot container which contained 600 cartons, each carton containing 1,020 copies (612,000 copies in all), of cinematographic DVDs and 45,900 units of empty jackets was intercepted on the verge of leaving the port.¹⁷⁰ On March 6, 2013 the truck carrying the

¹⁶⁶ Emmanuel Elebeke NCC impounds N4.38bn pirated goods ... Secures 29 convictions *Punch* Tuesday 29 January 2103 available at <http://www.vanguardngr.com/2013/01/ncc-impounds-n4-38bn-pirated-goods-secures-29-convictions/#sthash.Zax5BXbn.dpuf> accessed 13 November 2013.

¹⁶⁷ Copyright Commission Arrests Broadcast Pirate, Impounds N780 million Broadcast Signal-Hacking Devices available at <http://www.copyright.gov.ng/index.php/news-and-events/223-copyright-commission-arrests-broadcast-pirate-impounds-n780-million-broadcast-signal-hacking-devices> accessed 12 November, 2013.

¹⁶⁸ Where a set of Prison Break or Desperate Housewives, House Friends name it can be bought for just \$4 for a whole season.

¹⁶⁹ NCC raids Alaba, arrest pirates of broadcast equipment *Punch* Newspaper Wednesday 24 July 2013 <http://www.punchng.com/feature/midweek-revue/ncc-raids-alaba-arrest-pirates-of-broadcast-equipment/> accessed 12 November, 2013.

¹⁷⁰ This again proves that there is a conspiracy among the importers and the NSC officers, before a container attempts to leave the port an inspection of the goods must have been carried out and all fees paid.

container was turned back at the gate following a tip off by NCC officials. The goods were said to be worth over ₦300 million.¹⁷¹

In addition, at Ojuelegba in Lagos, famous for selling books, over 80,000 copies of pirated works were seized worth ₦40 million. These were works from local publishers such as Macmillan Nigeria Limited, University Press Plc, Evans Brothers Limited, HEBN Plc, Literamed Publications Ltd, Spectrum Books Ltd Rasmed Publications Ltd, among others.¹⁷²

One thing is clear, for all the raids conducted the stakeholders are worried about the spate of piracy and are investigating and calling upon the NCC to assist them. In turn the NCC enlists the services of security operative to carry out the raids and seizures.

The NCC have not only clamped down on pirates, they have also been engaged in prosecuting them, as well as ensuring a speedy trial and sentencing. In 2011 and 2012 a number of cases were instituted and convictions reached: the NCC prosecuted cases which began in 2012 and able to secure convictions the same year, with record fines of up to ₦250000.¹⁷³ In one case a conviction with no option of a fine,¹⁷⁴ in another case the Judge sentenced the offender to both a fine and imprisonment¹⁷⁵ for copyright infringement.

There are many other areas in which the NCC needs to put in more effort, for instance, in the area of public awareness, making the public know that the protection of intellectual property is for their benefit as right holders and users as well. The NCC needs to work with stakeholders to put certain measures in place to fight piracy, for instance, there should be proper ledger keeping between the NCC, book publishers and book sellers which would

¹⁷¹ BREAKING NEWS! BREAKING NEWS!!! Container of N300 Million Suspected Pirated DVDs Seized by Copyright Commission, Customs available at <http://www.copyright.gov.ng/index.php/news-and-events/175-container-of-n300-million-suspected-pirated-dvdds-seized-by-copyright-commission-customs> accessed 12 November 2013.

¹⁷² N40 Million Suspected Pirated Literary Works Seized by NCC Operatives available at <http://www.copyright.gov.ng/index.php/news-and-events/248-n40-million-suspected-pirated-literary-works-seized-by-ncc-operatives> accessed 10 November 2013.

¹⁷³ *NCC v Sunday Ayodele* FHC/KD/8C/2012.

¹⁷⁴ *NCC v Ebenezer Ogundele* FHC/L/459C/2011; *NCC v Ndidì Agwu* FHC/B/61C/12: Cinematograph films piracy; *NCC v Anoke Celestine* FHC/B/59C/12; sound recording and cinematograph films piracy Sound recording and cinematograph films piracy; *NCC v Godwin Kadiri* FHC/B/43C/2010 Infringement of Broadcast rights.

¹⁷⁵ *NCC v Nwore Anayo* FHC/ABJ/CR/10/2012.

prevent the book sellers from obtaining pirated books. Regular checks should be arranged between the publisher and the NCC on the book sellers and not merely infrequent raids which give the pirates and seller a breathing space. The right holders should start going after the pirates themselves in civil actions as well.

There is a disconnect between the NCC and the stakeholders. The NCC recently signed a Memorandum of Understanding (MOU) with the African University of Science and Technology Abuja for IP development. If the NCC is looking to develop IP, most of the stake holders are in Lagos and locating in the Nollywood Conference and Film market in Abuja is of little purpose.

7.3.5.2 National Agency for Food and Drug Administration and Control

Another enforcement agency that takes its mandate seriously and rigorously pursues counterfeit products is the National Agency for Food and Drug Administration and Control (NAFDAC). NAFDAC was established by Decree 15 of 1993¹⁷⁶ to regulate, to undertake inspection, to compile standard specifications and guidelines, provide quality certification and undertake the registration and control the manufacture, importation, exportation, distribution, advertisement, sale and use of certain regulated products, such as food, drugs, cosmetics, chemicals, medical devices and packaged water.¹⁷⁷

The Commission is also responsible for enforcement through investigation, interrogation and prohibition of the production, import, manufacture, distribution, display for the purpose of sale of any counterfeit, adulterated, banned, fake, substandard or expired drug or unwholesome processed food.¹⁷⁸ NAFDAC has initiated a number of programmes to enforce its mandate and make sure that drugs, food and chemicals meet the expected standard. Because a large number of fake and substandard products still find their way into the community, NAFDAC engages in frequent mop up exercises and surveillance to check the

¹⁷⁶ National Agency for Food and Drug Administration and Control (NAFDAC), Decree 15 of 1993 as amended by Decree 19 of 1999 and now Act Cap N1 Laws of the Federation of Nigeria (LFN) 2004.

¹⁷⁷ Section 5 National Agency for Food and Drug Administration and Control (NAFDAC) Act Cap N1 Laws of the Federation of Nigeria (LFN) 2004.

¹⁷⁸ Section 5 National Agency for Food and Drug Administration and Control (NAFDAC) Act

quality and safety of medicines administered to the public by paying unannounced visits to medicine outlets and market place including hospitals.¹⁷⁹ In May 2013 alone a ware house was raided and different kinds of counterfeit drugs shipped in from China were discovered. The market price of the goods was over ₦106 million.¹⁸⁰

The real and eminent danger of counterfeit drugs is seen in the My Pikin case in 2008. Within a few days scores of children had died from ingesting a teething syrup known as My Pikin which was tainted with diethylene glycol, an industrial solvent and an ingredient used for antifreeze in brake fluid. This was not the first such incident, 109 children died in Nigeria in 1990 after taking medicine tainted with a similar compound.¹⁸¹ The My Pikin's case has been tried and two of the suspects were sentenced to 7 years imprisonment.¹⁸²

Recently, in October 2013, fake Dano Tetanus vaccines were intercepted by NAFDAC officers at the Enugu airport. The boxes of fake vaccines were imported on board an Ethiopian airline plane unaccompanied. None of the boxes contained a temperature card and no permission was sought from NAFDAC for the importation.¹⁸³

According to Orhii,¹⁸⁴ ₦627 million worth of drugs were destroyed in 2011 compared to ₦1.6 billion worth of drugs in 2010.¹⁸⁵ Although the clamp-down has been rigorous, counterfeiters are still finding ways to sell their products. He explained that despite the use of

¹⁷⁹ NAFDAC seizes substandard, expired drugs from drug outlets in Gboko Daily Trust Tuesday, 23 April 2013. available at <http://www.dailytrust.com.ng/daily/old/index.php/health/52783-nafdac-seizes-substandard-expired-drugs-from-drug-outlets-in-gboko> accessed 16 November 2013.

¹⁸⁰ Chioma Obinna Fake drugs: NAFDAC records big haul *Vanguard* Wednesday May 22, 2013 available at <http://www.vanguardngr.com/2013/05/fake-drugs-nafdac-records-big-haul/> accessed 16 November 2013.

¹⁸¹ Lynda Polygreen The New York Times February 6, 2009 available at http://www.nytimes.com/2009/02/07/world/africa/07nigeria.html?_r=2&scp=2&sq=nigeria&st=cse& accessed 16 November 2013.

¹⁸² My Pikin': Court Sentence Accused To 7 years Imprisonment Leadership May 17, 2013 available at <http://leadership.ng/news/170513/my-pikin-court-sentence-accused-7-years-imprisonment> accessed 16 November 2013.

¹⁸³ NAFDAC seizes N2.5m tetanus vaccines in Enugu The Citizen 8 November 2013 available at <http://thecitizenng.com/other-news/nafdac-seizes-n2-5m-tetanus-vaccines-in-enugu/> accessed 17 November 2013.

¹⁸⁴ The Director- General of NAFDAC

¹⁸⁵ NAFDAC records reduction in fake drug seizure available at <http://www.punchng.com/news/nafdac-records-reduction-in-fake-drug-seizure/> accessed 16 November 2013.

cutting edge technology to detect counterfeits that counterfeiters have not relented in their nefarious activities.¹⁸⁶

NAFDAC has used technology¹⁸⁷ to combat the counterfeiting problem through the use of a Mobile Authentication Service (MAS),¹⁸⁸ Radio Frequency Identification (RFID), Truscan technology,¹⁸⁹ and Minilabs: The Global Pharma Health Fund (GPHF).¹⁹⁰ Recently, NAFDAC adopted the World Health Organisation's (WHO) Rapid Alert System (RAS)¹⁹¹ for the surveillance and monitoring of substandard, spurious, falsely labelled and falsified counterfeit (SSFFC) medicinal products in Nigeria.¹⁹²

The use of these technologies has helped in speeding up the detection of fake and substandard medicines at the point of entry: this is evident in the drastic drop registered by the Quality of Antimalarial Medicines in Sub-Saharan Africa (QAMSA), from 64% in 2008¹⁹³ to 20% in 2011.¹⁹⁴ NAFDAC still needs to do more to clean up drugs sold by persons

¹⁸⁶ Sufuyan Ojeif NAFDAC, NGOs and fight against fake drugs Weekly Trust Saturday, 22 June 2013 available at <http://weeklytrust.com.ng/index.php/opinion/12968-nafdac-ngos-and-fight-against-fake-drugs> accessed 16 November 2013.

¹⁸⁷ Ignatius Chukwu Fake drugs drag MDGs back in Nigeria – NAFDAC *Businessday* October 25, 2013 available at <http://businessdayonline.com/2013/10/fake-drugs-drag-mdgs-back-in-nigeria-nafdac/> 16 November 2013.

¹⁸⁸ Mobile Authentication Service (MAS) is a text based service in which customer send text to a particular designated number to verify the authenticity of a drug before it is purchased.

¹⁸⁹ This is a Thermo Scientific TruScan analyser, it is a handheld, lightweight system for rapid raw material verification. It is easy to use, has non-destructive point-and-shoot operation enables verification through sealed packaging to minimize risk of exposure and contamination. Its embedded analysis software delivers a PASS/FAIL decision verifying the identity of a sample typically within 30 seconds if the contents are chemically authentic.

¹⁹⁰ Mini laboratories designed by the Global Pharma Health Fund (GPHF) to boost the capacity for testing medicines and the detection of false and substandard medicines in developing countries. Currently Nigeria has 54 minilabs. See generally http://www.gphf.org/images/downloads/minilab_weltkarte.pdf accessed 18 November 2013.

¹⁹¹ RAS is a web-based communications network involving focal persons and representatives of countries and areas in the Western Pacific Region, WHO and partner agencies devised to alert member countries, areas and relevant partner organizations, through their focal points and representatives in the network, about cases of counterfeit medicine. See general WHO Rapid Alert System for combating counterfeit medicine Fact sheet2 May 2005 available at http://www.wpro.who.int/mediacentre/factsheets/fs_20050503/en/index.html accessed 18 November 2013.

¹⁹² Chioma Obinna Fake drugs: NAFDAC adopts WHO Rapid Alert system Vanguard July 05 2013 available at <http://www.vanguardngr.com/2013/07/fake-drugs-nafdac-adopts-who-rapid-alert-system/> accessed 18 November 2013.

¹⁹³ WHO Survey of the quality of selected anti malaria medicines circulating in six countries of sub-Saharan Africa Quality Assurance and Safety: Medicines Essential Medicines and Pharmaceutical Policies

who are not pharmacist and the large drug market on Lagos Island run by illiterate traders has to be cleared. Manufacturers and importers of drugs have to find a way of distribute their drugs and not leave it to the marketers, who are largely uneducated.

7.3.5.3 Nigerian Police

The general duties of the Nigerian Police are spelt out in section 4 of the Police Act,¹⁹⁵ which provides:

The police shall be employed for the prevention and detection of crime, the apprehension of offenders, the preservation of law and order, the protection of life and property and the due enforcement of all laws and regulations with which they are directly charged, and shall perform such military duties within or outside Nigeria as may be required of them by, or under the authority of this or any other Act.

The provision empowers the police to apprehend offenders which include counterfeiters and pirates of intellectual property works. Even though the Police have not taken the lead in apprehending these offenders, they have been used by agencies, such as NCC and NAFDAC, to arrest offenders since they have the training and the background to deal with them.

The Nigerian police are under-trained and lack the ability and capability to deal with issues of counterfeiting. They are currently overwhelmed with day to day policing duties. The police force currently does not have a department dedicated to combatting counterfeiting and piracy, which is essential considering the rapid influx of fake and substandard products. If the Police had a monitoring unit the fake and substandard good which have been missed by Customs can be seized by the monitoring unit.

7.4 Flexibilities under the TRIPS Agreement

As is the case with all other aspect of intellectual property rights under the TRIPS Agreement, enforcement provisions have their flexibilities which mainly relate to the mode of enforcement and the venue for the enforcement of the right. Section 41 of the TRIPS

WHO/EMP/QSM/2011.1 p. 54 http://www.who.int/medicines/publications/WHO_QAMSA_report.pdf accessed 12 November, 2013.

¹⁹⁴ The Sun, NAFDAC boss and the challenge of fake drugs 21 October 2013 available at <http://sunnewsonline.com/new/opinion/nafdac-boss-challenge-fake-drugs/> accessed 18 November 2013.

¹⁹⁵ Cap. P19 Laws Federation of Nigeria 2004.

Agreement makes it clear that members are not obliged to put in place a judicial system for the enforcement of intellectual property rights (IPRs) distinct from that for the enforcement of law in general and are not required to prioritise the enforcement of intellectual property rights above the enforcement of law in general. This requirement actually makes the enforcement of intellectual property rights easier for most countries as they do not have to set up special court for the enforcement of IPRs. Criminal procedure and penalties are not required, except in case of wilful trade mark counterfeiting or copyright piracy on a commercial scale.¹⁹⁶ These punishments, however, may be extended to other cases of infringement of intellectual property rights, particularly if they are committed wilfully and on a commercial scale.

7.5 Sections B: Challenges to intellectual Property Rights

7.5.1 Challenges facing Intellectual Property Law in Nigeria.

The foremost challenge to intellectual property rights in Nigeria relates to the disregard of these set of rights by the government. All other challenges, in one way or the other are tied to the government's indifference to intellectual property rights.

7.5.2 Law and Policy

First, intellectual property is not constitutionally protected¹⁹⁷ as a right.¹⁹⁸ Although, there are intellectual property laws, there are no intellectual property policies. These are imperative as they predefine the roles and responsibilities of intellectual property administrators by blending together the policy issues which are unique to Nigeria, as well as create a step-by-step directive on how to achieve intellectual property protection and encouragement. Policies provide a laid-down pattern that administrators should follow. For instance, in most intellectual property administrative offices in Nigeria, because there are no polices, each director pursues his own plan and once he is out of office both the good and bad policies are thrown into the bin and everything starts from scratch. The essence of a policy is to create continuity and foster a common goal. Policy should establish provisions to promote the

¹⁹⁶ Article 61 TRIPS Agreement.

¹⁹⁷ See general Article 43 and 44 Constitution of the Federal Republic of Nigeria.

¹⁹⁸ Constitution of the United States (Article I, Section 8, Clause 8).

progress of science, arts, research and development in universities and research institutes on patents, copyrights and other intellectual property areas.

The lack of revision or amendments that pervades the Nigerian legal framework is no longer acceptable. Some of the laws have shortcomings in respect of appropriate requirements and regulatory gaps as identified by this study. Laws should be regularly reviewed in Nigeria as part of a long-term policy development process to review its legal and institutional frameworks to ensure that the laws, generally, are compatible with current trends. For instance, digital protection of copyright is absent from the present Copyright Act.

A final crucial feature of the legal framework that touches on protection and enforcement of intellectual property is a specific law on counterfeiting and piracy. Counterfeiting and piracy have become a most challenging problem associated with intellectual property. The importance of an anti-counterfeiting law, especially in relation to Nigeria, is that there would be criminalisation of any sort of infringement of intellectual property which will drive home the point that unauthorised US\$650 billion a year.¹⁹⁹ The piracy rate for licensed software in Nigeria in 2011 was 82% with a commercial value of US\$251 million.

The demand for these products plays a role in this menace, the reason is not far to seek. Poverty is a major contributor to the demand for such goods. In a country of over 160 million people and 20 per cent²⁰⁰ the people living on less than a dollar a day, it is logical that such people cannot afford the more expensive version of the products they buy. Some have never even seen or used the original products.²⁰¹ As Harms argues that, many people living in developing countries live in isolated communities ‘cut off by a lack of infrastructure and education’, how then can they benefit from intellectual property or understand the merits of its protection²⁰² if they neither benefit nor see the advantages of its protection. As simple as

¹⁹⁹ Unreal Campaign brochure http://www.inta.org/Advocacy/Documents/unreal_pamphlet_FINAL.pdf

²⁰⁰ Abimbola Akosile Poverty Threshold in Nigeria: Myth or Reality? *ThisDay* 16 May 2013 available at <http://www.thisdaylive.com/articles/poverty-threshold-in-nigeria-myth-or-reality-/147595/> accessed 25 March 2014.

²⁰¹ See generally Poku Adusei *Patenting of Pharmaceuticals and Development in Sub-Saharan Africa: Laws, Institutions, Practices, and Politics* Springer New York 2013 p.281.

²⁰² L.T.C. Harms Offering Cake to the South, 22(10) *European Intellectual Property Review* 451 October 2000 p.451

it sounds it is a reality. The unfortunate part is that most of these products are consumables that are dangerous to life and property.

7.5.3 Education and Research

Education is key to the development of any nation. Knowledge of intellectual property rights and protection are first encountered by students at university level and only in the faculty of law. But not all faculties of law in Nigeria teach intellectual property. Sciences are taught in all secondary schools, but most students are not given the opportunity to learn to research on their own which can lead to invention. Even at university level, most science students do not have an opportunity to be innovative, since they do not have access to the required scientific information, laboratory equipment and chemical reagents to carry out experiments.

As Harms remarks, '[i]nformation is not knowledge. A library is of no use if one cannot read.'²⁰³ As noted in this study, Nigeria alone is home to over 10.5 million out-of-school children, which translates to over 17% of the world's out-of-school population.²⁰⁴ Accordingly, if the requisite knowledge is not imparted to a child, that knowledge cannot translate into innovation and development *per se*.

A lack of awareness of intellectual property permeates various professional sectors and at different levels of government: the executive, the legislators and even the judiciary²⁰⁵ as well as the educational sectors. Educating the public on the importance of intellectual property, firstly requires educating the government, the legislators and the judiciary on the economic and developmental gains to the country that are linked with suitable and effective protection of intellectual property. Without this key group of people knowing the essence of intellectual property protection and encouraging such, the status quo will remain.

Even lawyers know little about intellectual property law. A classic case of lack of education relating to intellectual property protection is the case of a well-known trade mark in Nigeria,

²⁰³ L.T.C. Harms p.451-453.

²⁰⁴ Out-of-School Children: New Data Reveal Persistent Challenges, UNESCO Institute for Statistics, November 2012, available at <http://www.uis.unesco.org/Education/Documents/fs-18-OOSC-2.pdf> 21 March 2013

²⁰⁵ See the erroneous judgement in *Microsoft Corporation v Franike Associates Ltd.*, Suit No. FHC/L/CS/610/05 and Suit No: CA/L/573/2008.

called ‘Gala’. Gala is a household snack name and it’s a product of United African Company of Nigeria Plc (UAC). Despite the fact that UAC has a legal department that should be aware that the use of a trade mark as an adjective can make it become generic, UAC does not realise: it advertises on its website that Gala ‘is the market leader in the sausage roll market and has become a generic name.’²⁰⁶ This statement, coming from one of the leading conglomerates in Nigeria, is alarming. How can a company say its mark has become generic? It is evident that even big companies that are supposed to know the significance of a trade mark do not. What can be expected from the small medium enterprises (SME’s) and petite traders? If UAC, that has a portfolio of over 100 trade marks with several in-house lawyers, say that their mark is generic, it means that trade marks owner still do not see a trade mark as more than a name.

The legal professional needs to engage in continuing education, in some jurisdiction it is mandatory to maintain their license to practice law. Continuing legal education (CLE) or continuing professional development is compulsory in a lot of countries.²⁰⁷ It should be in Nigeria as well. Continuing education should include training of personnel in the patent and trade marks registry, copyright commission, and research institute, the Standards Organization of Nigeria (SON), the National Agencies for food and drugs Administration and Control (NAFDAC), the Consumers Protection Council (CPC), the Nigerian Custom Services (NCS), Nigerian Police Force (NPF) alike.

For these reasons and several others, the government, through its agencies, should engage in a massive awareness campaign to educate the public, formally and informally, on the advantages of creating, inventing, licensing and the use of intellectual property rights, which would assist in reducing counterfeiting and piracy.

The government should encourage research, to promote innovation and technological advancement in various sectors to enable the transfer and dissemination of technology, as well as to promote foreign direct investment. It is suggested that government should allow

²⁰⁶ uac brands uac food brands available at <http://www.uacnplc.com/brands/foods.htm> accessed 28 February 2014.

²⁰⁷ Australia, Canada, United Kingdom and United States.

duty-free importation of books, journals, laboratory equipment, teaching and other research materials for tertiary institutions.

7.5.4 Development

It is trite that development has to come from within. As the Report of the Commission on Intellectual Property Rights²⁰⁸ remarks, the key determinant for economic growth and poverty reduction is the ‘development of indigenous technological capacity’. It highlighted the fact that many studies²⁰⁹ point to ‘early emergence of an indigenous technological capacity’ as the ‘most distinctive single factor determining the success of technology transfer’.

In light of this fact, it is submitted that for intellectual property to foster economic growth and development the government must provide an enabling environment by improving its overall investment climate to encourage foreign direct investments and invest in the required technology for health, education, manufacturing and industrial infrastructure.²¹⁰

The importance of intellectual property to development should be reiterated. Currently the entertainment industry in Nigeria is the second largest employer of labour the Nollywood movie industry grosses revenue of US\$500 million per annum despite the lack of government support.²¹¹ Between 2005 and 2011 Nigeria released on average, 966 films per year although the production of most of these is artisan and semi-professional/informal.²¹²

²⁰⁸ Integrating Intellectual Property Rights and Development Policy Report of the Commission on Intellectual Property Rights London September 2002 Commission on Intellectual Property Rights available at http://www.iprcommission.org/papers/pdfs/final_report/ciprfullfinal.pdf accessed 1 march 2014.

²⁰⁹ Radovesic, S. (1999) *International Technology Transfer and Catch-up in Economic Development*, Elgar, Cheltenham, p.242. Also Saggi, K. (2000) ‘Trade, Foreign Direct Investment and International Technology Transfer: A Survey’, World Bank, Washington DC Source: http://www1.worldbank.org/wbiiep/trade/papers_2000/saggiTT-fin.pdf, and Rosenberg, N. (1982) *Inside the Black Box; Technology and Economics*, Cambridge University Press, Cambridge.

²¹⁰ See Carsten Fink and Keith E. Maskus (eds) *Intellectual Property And Development: Lessons from Recent Economic Research* World Bank and Oxford University Press New York, 2004 p.7.

²¹¹ Nigeria's Nollywood eclipsing Hollywood in Africa. *The New York Times* Saturday 15 May 2010 available at <http://www.independent.co.uk/arts-entertainment/films/nigerias-nollywood-eclipsing-hollywood-in-africa-1974087.html> accessed 20 November 2013; See also Nigeria's film industry Nollywood dreams, *The Economist* July 27th 2006 available at <http://www.economist.com/node/7226009> accessed 20 November 2013; Economic Note The Nigerian Media and Entertainment Industry: More than fun, there is good money to be made available at

The major challenge in the industry remains unlike most other countries, that the Nigerian film industry receives no national film support,²¹³ the UNESCO Institute for Statistics (UIS) affirmed that many countries' national film industry directly or indirectly benefits from public subsidy policies and mechanisms:²¹⁴ these include 12 of the top 15 countries with the highest production and market share.²¹⁵ The lack of funds contributes to the poor quality of production, making them unfit for commercial exhibition. Although, a semblance of funding was announced in 2010 by the Federal Government promising to invest of US\$200 million (R30 billion) in the development of the entertainment industry, till now the funds have not been accessible to the beneficiaries.

The movie and the music industries have been left to grow like weeds, there are no regulations for producers, marketers, actors and actress, singers songwriters and all other people involved in film and music production. It is even more disheartening to see despite being the third largest film producers in the world, that the UNESCO²¹⁶ excluded Nigeria from its rating of 'world production of feature films for theatrical release' on the basis that Nigerian films are not professional made with commercial exhibition as the main objective.²¹⁷

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- <http://research.bglgroupng.com/Documents/EconomicNote/ECONOMIC%20NOTE%20-The%20Nigerian%20Entertainment%20Industry.pdf> accessed 1 March 2014.
- ²¹² UNESCO Institute for Statistics, UNESCO Institute for Statistics, Emerging Markets and the Digitalization of the Film Industry an analysis of the 2012 UIS International Survey of Feature Film Statistics UIS INFORMATION PAPER NO. 14 AUGUST 2013 available at <http://www.uis.unesco.org/culture/Documents/IP14-2013-cinema-survey-analysis-en.pdf> accessed 1 March 2014.
- ²¹³ Jade Miller Global Nollywood: The Nigerian movie industry and alternative global networks in production and distribution available at <http://gmc.sagepub.com/content/8/2/117.full.pdf+html> accessed 20 November 2013.
- ²¹⁴ UNESCO Institute for Statistics, Emerging Markets and the Digitalization of the Film Industry an analysis of the 2012 UIS International Survey of Feature Film Statistics UIS INFORMATION PAPER NO. 14 AUGUST 2013 available at <http://www.uis.unesco.org/culture/Documents/IP14-2013-cinema-survey-analysis-en.pdf> accessed 1 March 2014.
- ²¹⁵ China, Russian Federation, France, United Kingdom, Germany, Spain, Republic of Korea, Italy, Argentina, Mexico, Brazil, Bangladesh. The in USA the cinema sector receives tax exemptions, deferred payments or accelerated amortization.
- ²¹⁶ UNESCO Institute for Statistics, Emerging Markets and the Digitalization of the Film Industry an analysis of the 2012 UIS International Survey of Feature Film Statistics UIS INFORMATION PAPER NO. 14 AUGUST 2013 available at <http://www.uis.unesco.org/culture/Documents/IP14-2013-cinema-survey-analysis-en.pdf> accessed 1 March 2014.
- ²¹⁷ Professional feature films made with commercial exhibition are digital movies exhibited in multiplexes for cinema purposes. Most Nigeria films are mainly in home video format.

Innovative development can only be achieved in an enabling environment. It must be emphasised that ‘intellectual property is not an end in itself but rather is a tool that could power countries’ growth and development’²¹⁸ bearing in mind that the ‘one size fits all’ approach is unlikely to work in Nigeria.²¹⁹

7.6 Conclusion

The cost of piracy and counterfeiting in terms of loss of human life and property is overwhelming. As Blakeney notes, the cost of piracy and counterfeiting goes a long way in its effect on business, trade, tax revenues, investment, competition, employment, consumer protection and public order.²²⁰

Enforcement is an important part of intellectual property rights protection, and it is a major problem facing developing countries, Nigeria in particular. It is easy to attribute the enforcement of IP to mean giving right holder more rights, but this is really not the case. Where IP enforcement is not adequate, there is a proliferation of fake and substandard drugs, food, clothes, bags, car parts and electrical material. These not only are dangerous and injurious to life and property but also take away the source of livelihood when companies close down as a result of not being able to compete with substandard products from China which are very attractive due to their low prices.

There are enforcement laws in Nigeria. However, a major issue relates to the inadequacy of the penalties. Penalties are expected to serve as a deterrent to prospective infringers, however, because the penalties are too weak, most infringers get away with very slight punishment which does not deter them, or others. There is an urgent need for a review of the penalties which include fines, the term of imprisonment, and the seizure policy. Although, the courts, recently, have woken up to the fact that infringers need to feel the punishment in

²¹⁸ Intellectual Property for Development available at <http://www.wipo.int/ip-development/en/> accessed 1 March 2014.

²¹⁹ Tana Pistorius ‘The Impact of Intellectual Property Law and Policy on Sustainable Development’ 32 (2007) South African Yearbook of International Law 376-395 p. 395.

²²⁰ Micheal Blakeney Proposals for International Criminal Enforcement in Christoph Antons (ed) *The Enforcement of Intellectual Property Rights: Comparative Perspectives from the Asia-Pacific Region* Volume 15 of Max Planck Series on Asian Intellectual Property Law, Kluwer Law International, 2011 23-46.

order to deter them and others from engaging in such crimes, such punishment are still a far cry from the gravity of the offences committed. The slow pace at which the court adjudicates is another issue which affects the enforcement of intellectual property rights.

Similarly, the patent and trade mark enforcement provisions need to be reviewed to create specific provision on cause of action and the remedies which will be applied if they are infringed. Also, criminal sanctions for wilful trade mark counterfeiting have to be included in the Trade Marks Act.

It is hoped that with the current sanitation of the drug industry Nigerian pharmaceuticals companies will be able to pass WHO prequalification of the diagnostics stage, a prerequisite for UN procurement, which would encourage local production of medicines as well as reduce the current importation of drugs and, thereby, reduce the influx of fake and substandard drugs.

Another way to battle fake products is to amend the Consumer Protection Act to include provisions that enable an effective refund and return policy. This condition is necessary as most Nigerians who buy in open markets do not think it is possible to return goods already bought, whether or not they suit their purpose or even turn out to be defective. This policy should be pasted up in all markets and the provision should be on receipts in order encourage returns. If a buyer can return whatever is bought that is sub-standard and the shop owner can, in turn, also return it to the distributor who bears the cost of importing the fake or sub-standard product there will be a rethink about bringing in substandard products.

In addition, NCC should find better ways of disposing of infringing material other than burning, which constitutes a health hazard. It is my suggestion that pirated books which are mostly educational can be marked as NOT FOR SALE and distributed in the rural area where text books are lacking, instead of burning them. The NCC, as the most visible authority on IP in Nigeria, needs to have a resource group that will act as a think-tank for initiatives on IP issues that will enhance development.

If copyright inspectors have the same powers as police officers, it would seem like a duplication of the duty of the police. It would be preferable if police officers are trained to identify pirated and counterfeit products and then seconded to the NCC to act as copyright inspectors. They could receive further training by the NCC on issues of copyright infringement, making them copyright inspectors backed up by the force of the law, which would prevent them from being harassed by copyright infringers.

Nigeria needs to take steps in building awareness of the importance of intellectual property protection and enforcement. The Government needs to promote anti- counterfeiting and piracy campaign by putting out posters in markets, airports, malls, colleges, universities and places where there is large gathering of people. The Nigerian entertainment industry is badly affected by optical disc piracy: most of their songs are copied and it is difficult for them to reap the rewards of their investment. They should be enlisted as ambassadors to fight piracy.

From the foregoing, the intellectual property provision on enforcement in Nigeria reasonably complies with the provisions of the TRIPS Agreement despite its weak enforcement mechanism. Enforcement should be one of the strategies to be adopted by Nigeria which can lead to economic development.²²¹

The advancement of the law without the improvements in education and research leaves a big gap in the system. Laws and policies need to be developed alongside other variables to bring about positive growth and development.

²²¹ Michael Blakeney Guidebook On Enforcement Of Intellectual Property Rights available at http://trade.ec.europa.eu/doclib/docs/2005/april/tradoc_122641.pdf accessed 7Novemehr 2013.

CHAPTER 8

Conclusions and Recommendations

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8.1 Introduction

The current legal framework in Nigeria can be utilised to protect intellectual property rights by means of a progressive interpretation which is consistent with international standards and obligations. The benefit of a reformed legal framework to Nigeria cannot be overstated: it is evident from developments in the entertainment and music industries in the last twenty years.

The issue of intellectual property rights and protection is a matter of national importance that cannot be addressed only by laws. The intellectual property laws have been in existence for over a century which points to the argument that intellectual property requires more than laws to translate into the development of Nigeria's economy, through in innovation, research and development.

That said, the thesis investigates the impact of certain provision of the TRIPS Agreement on the Nigerian intellectual property laws and the compliance of the laws to the TRIPS Agreement. The thesis has tried to note some of the issues that have raised serious concerns and suggestions have been proffered respectively.

The thesis demonstrates that where there is no specific provision as required by the TRIPS Agreement. Nigeria's legal framework has other resources that can be used to rationalise protection of those rights.¹

Stemming from the above, the research question in the thesis is to examine the impact of the TRIPS Agreement on Nigerian intellectual property legislation and, so doing, to examine the positive as well as negative aspects on Nigerian intellectual legislations. Some of the deep-rooted concerns about the TRIPS Agreement which relate to its effect on developing countries as well as the correlation that improved IP protection helps in creating socio-economic growth, technology transfer and foreign investment, are discussed. In a bid to determine the effect of the TRIPS Agreement on the Nigerian legislations *vis-à-vis* compliance, the three main areas of intellectual property laws, which are copyrights, trade marks and patent laws, of Nigeria were examined.

To some extent the foremost conclusion of the research is that the Nigerian laws do not have numerous inadequacies with regard to the protection of right holders and they comply relatively well with the TRIPS Agreement. But, there is a need for certain reforms to be carried out with regards to the current legislations and the laws are far from perfect. Also, areas of the law where it is imperative that reforms be addressed for the effective working of the law and judicial enforcement have been noted and a summary of the reforms necessary for compliance with the TRIPS Agreement, as well as general reforms to the law, are highlighted below.

8.2 Copyrights

Copyright is the most advanced form of intellectual property right in Nigeria. The creation of works, such as dramas, stem from traditional storytelling and dramatisations which took place in most Nigeria villages. These were developed into stage plays and, with the advent of projectors the entertainment industry grew to become the third largest film producer in the

¹ National Agency For Food and Drug Administration and Control Act 1993 (as Amended) Spirit Drinks Regulations 2005; Drugs and Related Products (Registration etc) Act 1999 (as amended) Pre-Packaged Food (Labelling) Regulations 2005; National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Wine Regulations 2005 and National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Spirit Regulations 2005.

world.² Copyright law in Nigeria, unlike other aspects of intellectual property law has been amended to make the laws more relevant and at par with international provisions on copyright.³

At present, the Copyright Act provides protection for most of the required works, especially as provided for by the TRIPS Agreement in Articles 9 to 14, though Nigeria has not reviewed its law after the inception of the TRIPS Agreement. In the area of copyright, Nigeria has enabling laws which require updating in view of the fact that the expression of creative works in music, acting, singing or dancing has reached a level of economic significance. Movie-making is one of the largest employers of labour in Nigeria, second only to agriculture, and grosses about US\$600 million annually.⁴ Similarly, the Nigeria music industry is enjoying high growth generating over US\$200 million from satellite broadcasts, US\$150 million from ringtone for mobile operators, \$105 million from overseas and US\$100 million from CD sales.⁵ Recently, Nollywood's contribution to the economic growth in Nigeria accounts for 1.4 per cent of GDP,⁶ still a far cry from the potential value of the industry if IP laws and enforcement mechanisms are enhanced.

Chapter 4 investigates the legal framework for copyrights. The chapter apprised all the laws and regulations pertaining to copyrights and related rights; primarily, presenting an overview

² Nigeria's Nollywood eclipsing Hollywood in Africa. *The New York Times* Saturday 15 May 2010 available at <http://www.independent.co.uk/arts-entertainment/films/nigerias-nollywood-eclipsing-hollywood-in-africa-1974087.html> accessed 20 November 2013; See also Nigeria's film industry Nollywood dreams, *The Economist* July 27th 2006 available at <http://www.economist.com/node/7226009> accessed 20 November 2013. See also *The Economist*, (18-3 1 December 2010). Nollywood: Lights, camera, Africa, pp. 85-88; Nigeria: Growth & Competitiveness, World Bank Country Economic Memorandum, 2006.

³ 1992 and 1999 copyright Amendments

⁴ Witney Schneidman, 'Nollywood, Intellectual Property and Nigeria's New GDP@' available at <http://www.covafrica.com/2014/04/nollywood-intellectual-property-and-nigerias-new-gdp/> Nigeria's Nollywood eclipsing Hollywood in Africa accessed 02 June 2014; *The New York Times* Saturday 15 May 2010 available at <http://www.independent.co.uk/arts-entertainment/films/nigerias-nollywood-eclipsing-hollywood-in-africa-1974087.html> accessed 20 November 2013; See also Nigeria's film industry Nollywood dreams, *The Economist* July 27th 2006 available at <http://www.economist.com/node/7226009> accessed 20 November 2013.

⁵ African Business Review, Nigeria's booming economy is music to the ears available at http://www.africanbusinessreview.co.za/business_leaders/nigerias-booming-economy-is-music-to-the-ears accessed 20 November 2013.

⁶ *The Guardian* Date Blog Monday 7 April 2014 available at <http://www.theguardian.com/global-development/datablog/2014/apr/07/nigeria-becomes-africa-largest-economy-get-data> accessed 02 June 2014.

of the legal framework of the law covering the requirement for copyright protection and works eligible for protection in Nigeria.

When analysing the TRIPS Agreement provisions on copyright against the Nigeria provisions on copyright in the comparative review, it became clear that Nigeria is not negligent of what is expected in compliance with the TRIPS Agreement. The chapter shows that the law makes adequate provision for protectable subject matter as provided for in the TRIPS Agreement, including computer programmes and the compilation of data. Furthermore, the subtle difference between the TRIPS Agreement and the Copyright Act relates to rental rights which need to be streamlined generally. Also, a provision for resale right needs to be included in the Copyright Act.

8.2.1 Issues Identified and Probable Solution

As discussed in chapter four, the legal framework on copyright is in need of reform if it is adequately to protect the rights of holders and users as well. Some of the issues identified include amendments to the following areas:

- The Copyright Act requires better structuring and modelling for easy use by illiterate copyright owners which is key in boosting copyright awareness and protection. The numerous regulations on copyright need to be incorporated into the Copyright Act as one.⁷
- The subject matter of protection of copyright is a very important aspect of copyrights as it forms the boundaries within which copyright operates. Proper delimitation is essential to meet the requirements and provide guidelines for protection.
- A legal instrument cannot function without a proper interpretation section; the Copyright Act does not have a comprehensive section on explanation of terms. For

⁷ Currently there are six different copyright related regulations Copyright: (Security Devices) Regulations 1999; Copyright (Video Rental) Regulations 1999; Copyright (Optical Discs Plants) Regulations, 2006; Copyright (CMOs) Regulations 2007; Copyright (Reciprocal Extension) Order 1972; Copyright (Levy On Materials) Order, 2012

instance, ‘copyright’ was not defined while ‘adaptation’ and ‘broadcast’ are defined generally and not in relation to particular works. An array of words and phrases are used in the Act which are not defined these include ‘infringing copy’, ‘performance’, ‘producer’, ‘publication’, ‘educational institution’, ‘private use’, ‘archives’, ‘fair dealing’, ‘judicial proceedings’ amongst others. The definition section of an Act makes the law easily understandable by lawyers and non-lawyers: the major holders of copyright in works in Nigeria.

- Limitations and exceptions permitted by the law require more detail which is lacking in the present Copyright Act. Subject matters excluded from copyright protection, such as ideas, procedures, methods of operation or mathematical concepts, should be clearly stated. The Act mentions fair dealing without defining what it means, leaving it to the discretion of the courts or reliance on definitions from other jurisdictions where such issues arises in an infringement suit.
- Paragraph (s) of the second schedule, which relates to the visually impaired has to be redrafted totally and amended in accordance with the Marrakesh Treaty for the facilitation of access to published works by persons who are blind, visually impaired, or print disabled.⁸ It is expected that through this Treaty the Government will take note of this provision and improve access to knowledge and information by the blind, visually impaired, and print disabled by setting up publishing houses that will publish works in braille, large print text and audio books format.
- The Copyright Act needs to take cognizance of the digital explosion in the last two decades which has made copyright infringement easy and possible from anywhere in the world, and to protect digital works made in Nigeria either by including digital protection in the Copyright Act or creating a special Act for the protection of digital works.

⁸ Marrakesh Treaty to Facilitate Access to Published Works for Persons who are Blind, Visually Impaired, or Otherwise Print Disabled adopted by the Diplomatic Conference in Marrakesh, June 17 to 28, 2013 VIP/DC/8 REV.

- Access to knowledge mainly in the area of access to learning materials, is a major challenge in the area of copyright. It is due to a number of factors, such as price and unavailability of copyrighted materials. Accordingly, education and learning materials should be made free of import duty.
- Providing educational uses of content by the government is an area for further development, especially when it comes to importing educational content from more industrially advanced countries into Nigeria. Awareness needs to be created to promote and coordinate open-access publishing systems. Nigerian needs to start making use of compulsory license to improve the distribution of books.
- Paragraph (k)⁹ should be amended to give private libraries access to copyright materials to bridge the gap of access to knowledge and information currently in existence in Nigeria. Where the government has failed to provide access to knowledge and information, people should not be further deprived of the access through the private sector. Good libraries are important for educational services, which include digital learning environments. More access should be given to libraries to make copies of works that are not available and cannot be obtained commercially.
- The piracy of locally published books imported from South-East Asian countries has to be highlighted as this practice is stalling creativity, damaging the economy and reducing the income of right holders.

8.3 Trade marks

Trade marks are a unique product or business names that build value and reputation for a product and business based on quality which results in consumer satisfaction and, in turn, influences repeated purchases by the consumer.

Nigerian consumers, generally, do not behave like consumers in Japan, UK, US and other developed countries. The reason is that most consumers have low purchasing power and the

⁹ Para (k) Second Schedule CA 1988 Cap 28 LFN 2004.

quality of products that the majority of consumers have access to is of a low standard. Departmental store brands that sell cheap quality products to low income earners in developed countries in developing countries are few. Therefore, most consumers make their choices based on what is available. Consumers who are on an upper or middle level income, on the other hand, base their choices on known international brands because it is believed that they are of better quality. Trade marks evolve into brands that become important company assets and, therefore, require protection by the law.

Accordingly, chapter five of the thesis, on trade marks reviews the legal framework and explores whether the 49 year old Act complies with the 20 year old TRIPS Agreement, taking into consideration that trade mark protection has undergone consequential modifications at the international level, as well as domestically in Nigerian commerce and trade. It was observed that the legal confines required to deal with the evolving issues in trade mark protection are in place. Chapter five illustrates several flexibilities that can be incorporated into the Trade Marks Act to the benefit of the country. Nigeria has the technical expertise and infrastructural capacity to draft a trade mark law that will take advantage of these flexibilities.

A major part of the discussion in chapter five relates to geographical indications. Despite the nebulous provision in the Trade Marks Act, protection can still be derived for geographical indications through the use of passing off, protected appellations of origin, certification trade marks, administrative schemes and other legal frame work.¹⁰

The aspects of the Act which need amendments are noted and will be discussed below.

¹⁰ National Agency For Food and Drug Administration and Control Act 1993 (as Amended) Spirit Drinks Regulations 2005; Drugs and Related Products (Registration etc) Act 1999 (as amended) Pre-Packaged Food (Labelling) Regulations 2005; National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Wine Regulations 2005 and National Agency for Food and Drug Administration and Control Act 1993 (as Amended) Spirit Regulations 2005.

8.3.1 Issues Identified and Probable Solution

It is submitted that the issue which are raised concerning the need for an amendment to the Trade Marks Act and the inclusion of the necessary flexibilities as provided for the TRIPS Agreement can be addressed in a variety of ways The proposed approaches are as follows:

- The domestication of the Paris Convention for it to be made applicable in Nigeria requires a mere declaration by the Minister of Trade and Investment in a Federal Gazette listing the Convention Countries. Consequently, the declaration will make it possible for Nigerian trade mark owners to claim priority in convention countries, as well as opening the trade mark registry to applications from other convention Countries.
- Trade marks are still defined in the traditional form in the Act: meaning that topics such as packaging, shape, colour, sound or scent are excluded from the definition. In addition, it is imperative that the protectable subject matter of a trade mark be defined in terms of graphical representation and visual perceptibility as these form a critical foundation for evaluating and determining the appearance of a trade mark. The TRIPS Agreement however, does not make such definition mandatory.
- Of particular importance is the legal recognition of the protection of well-known marks. Nigeria has come of age and there are now a lot of local brand names that have become well-known, these include Gala, Ragolis, FanIce, Mr Biggs, Big Treat, Mama Cass, Chvita, and Dangote. It is on this basis that a review of the Trade marks Act is requested to give proper protection to well-known trade marks. It is suggested that protection of well-known marks should include marks used on the same or similar goods and services and on unrelated goods and services as well, as requested in the TRIPS Agreement.¹¹

¹¹ Article 16.3 TRIPS Agreement.

- The TRIPS Agreement provides that members may make registration dependent on use.¹² Currently, the Trade Marks Act¹³ allows marks that are in use and proposed to be used to be registered. The requirement is such that countries can make their own use requirement and at the same time not demand actual use. This is a flexibility which is an important criterion that should be exploited and put in place as part of the registration system of the trade mark's registry to avoid *mala fide* trade mark registration that is plaguing the Nigerian trade mark registry.
- The requirement that opposition to a trade mark application should be made within two months of the application should be amended to allow for extension where good cause is shown and the Registrar is satisfied that the circumstances justify an extension of the time.¹⁴ For years the Act has given the Minister the authority to make regulations for extending the time limit required in the Trade Marks Act for the performance of any act, whether generally or in particular cases and whether at the discretion of the Registrar or otherwise,¹⁵ provided such regulations are published in the Federal Gazette.¹⁶ In 49 years no Minister has passed a regulation in this regard. It is submitted that an extension of time provision should be included in the Trade Marks Act as a distinct provision and not left to the discretion of the Minister.
- As noted above the Trade Marks Act does not have a comprehensive interpretation section. Any amendment to the Act should include a thorough list of terminologies used in the Act such as 'applicant', 'confusing', 'country of origin', 'defensive trade mark', 'distinctive', 'filing date', 'month', 'priority date',¹⁷ 'proprietor', 'proposed mark', 'similar goods', 'use' and 'use of a trade mark'. In addition, previously defined terms require further and better explanation of the meaning, for example, 'person concerned', 'permitted uses', 'transmission' and 'tribunal'.

¹² Article 15.3 TRIPS Agreement.

¹³ Section 18 Trade Marks Act.

¹⁴ See section 47 Canadian Trade-marks Act R.S.C., 1985, c. T-13; US Trademark Act § 13(a), 15 U.S.C. § 1063(a).

¹⁵ Section 45 (1) (g) TMA 1965 T13 LFN 2004.

¹⁶ Section 45 (2) TMA 1965 T13 LFN 2004.

¹⁷ Section 44 TMA 1965 T13 LFN 2004; Although priority date was not expressly mention it can be implied from the provision.

- Section 7 of the Trade Marks Act, which deals with prior right in trade marks, shows that there are numerous uncertainties regarding the application of this provision. For instance, the provision seems to be referring to unregistered trade marks that have been in continuous use without expressly mentioning that factor. It is feared that there is a probability for a likelihood of confusion, since the trade marks would co-exist without delimitation. In this regard it is submitted that the earlier unregistered right should be limited to the specific geographical location of its business.
- Defences to trade mark infringement that are typically provided for in other jurisdictions¹⁸ need to be included in the Trade Marks Act, such as doctrine of laches estoppel, acquiescence, functionality, fair use and collateral use. Although there are no specific provisions relating to trade marks or IP generally in the Limitation Decree.¹⁹ It should however be noted that in certain situations, the provisions in the Decree may be invoked to prevent the institution of an action for infringement, such as in cases of malicious falsehood, defective products or in the tort of passing off.
- Nigeria has no provisions on the exhaustion of rights and parallel importation. Section 5 in conjunction with section 33 of the Trade Marks Act grants a trade mark owner the exclusive right to use the trade mark in relation to goods and the use by a person other than the owner of the trade mark or registered user is not regarded as a permitted use. It includes non-infringing use by other people who are legitimately buying, importing and selling. Consequently, if the goods are bought from a channel of trade for which the trade mark has become exhausted, such use, not by the owner or registered user, may be regarded as an infringement of the owner's right.²⁰ The provision limits the choice of the consumer and it is particularly worrisome in a county like Nigeria where no alternatives are provided by the government and a lot of

¹⁸ United States: §1115 (Section 33 of the Lanham Act);

¹⁹ Limitation Decree No. 88 of 1966 (this Act is not cited as one of the laws in the current Laws of the Federation of Nigeria 2004).

²⁰ See *Honda Place Limited, Honda Motor Company Limited of Japan v Globe Motors Holding Limited & others*.FHC/L/CS/1442/97; See also (2005) LPELR-SC.161/2001 and *Honda Company Ltd and Anor. v. Bright Motors and 4 Others*. Car importation constitute 8% of the total imports to Nigeria. See The Observatory of Economic Complexity at <http://atlas.media.mit.edu/country/nga/> accessed 15 February 2014.

livelihoods depend on trading. In summary, the absence of these principles gives the judges the discretion to interpret some section²¹ as providing exclusive rights for the trade mark owners to the detriment of the other importers and consumers.

- The absence of an important provision, such as licensing, like the other necessary reforms noted, can hinge on the fact that some of these issues were not as developed as they are now. However, this is no excuse as amendments could have been made and have been ignored by subsequent governments.

8.4 Patents

Patent protection has encouraged research and development in numerous countries, but not in Nigeria. Evidently the laws are insufficient; the government needs to create an environment in which research and development can be undertaken. Chapter six deals with the Patent and Design Act (PDA) as it relates to compliance with the TRIPS Agreement provisions on patents. The patents aspect of the TRIPS Agreement remains the most controversial, especially in relation to the patenting of life forms and uses without authorisation of the right holder. The chapter highlights the effect of the TRIPS Agreement on public health without the implementation of the Doha Declaration, its effect on foreign direct investment, innovation and research and development as well as on technology transfer. The purpose of the chapter is to analyse the challenges, if any relating to the implementation of the TRIPS Agreement and to suggest potential reformation to the law. Some of the issue observed include the following:

8.4.1 Issues Identified and Probable Solution

The Patent and Design Act is committed to a range of patent protection. It must however be conceded, however, that in some instances certain provisions require amendment and the incorporation of the TRIPS flexibilities to have a beneficial effect.

- The rules that govern what is patentable must be clear, concise and detailed enough to avoid confusion and assumptions. Section 1 of the PDA provides similar provisions

²¹ Section 5 TMA 1965 T13 LFN 2004.

as the TRIPS Agreement and most other countries.²² However, definition of key words such as ‘inventions’, and ‘patentable subject matter’ are absent.

- Exceptions excluded from the general rule of patentability: It should be noted that the exceptions which the TRIPS Agreement allows may be used to solve some of the controversial issues that have been raised. For instance a *sui generis* system of protection for plant varieties can be drafted in a way that is not contrary to the morality and public order of the country.²³ Other exceptions from protection which are absent in the PDA include the exemptions of diagnostic, therapeutic and surgical methods for the treatment of humans or animals.²⁴
- Inventions contrary to public order or morality require more elaboration. The Bolar exception needs to be included as part of the amendments to the PDA as it allows early regulatory approval for generic drugs and by so doing, ensures that patented drugs immediately become accessible at the expiration of the brand name drug companies’ patents. Universally accepted exceptions, such as private and non-commercial use, prior use, experimental use, research and teaching purposes, individual prescription (pharmacy), should be specifically provided for in the PDA.
- A situation in which an employer takes all in the PDA²⁵ is likely to discourage employees even in situations in which the invention falls within the scope of the employer’s work, but the employee is not employed to invent. The situation is made worse if the invention is made without using the employer’s time, resources, data or means that are at his disposal because of his employment and the invention does not relate to the employer’s business or originate from the employee’s work. The criteria for determining whether an invention made by an employee belongs to the employee or to the employer have to be enumerated and reformed, and a balance in determining ownership between the employee/employer has to be achieved.

²² Section 103 35 U.S. Code Patent; Section 3 UK Patent Act; section 7 Australian Patent Act 1990.

²³ Article 27.2 TRIPS Agreement.

²⁴ Article 27.3(a) TRIPS Agreement.

²⁵ Section 2 (4) PDA 1970 P2 LFN 2004.

- In over 100 years of the patent law existence, the patent registration system in Nigeria still cannot provide substantive examinations for patent applications. As observed in the study, patent examination can be outsourced prior to employing well trained examiners.
- A best mode requirement improves the quality of application presented as it ensures full disclosure of the most effective method of working the invention. This requirement also restrains the inventor from concealing the preferred embodiments of the inventions from the public.
- In reforming the PDA the legislature has to take the principle of national treatment into consideration as certain provisions, such as section 6(4) of the PDA,²⁶ conflict with the requirement in the TRIPS Agreement. This provision relates to foreign priority claims only.
- Section 6(4) creates further confusion by allowing concurrent rights for the same inventions to exist. It deprives the first inventor of the exclusive right by allowing persons, who have made serious preparation, to exist side by side with the first inventor. Also, allowing the grant of a patent²⁷ where there is evidence of manufacturing the product or applying the process conflicts with the requirements of what constitutes a patentable invention.²⁸

²⁶ Section 6 (4) PDA provides: “Where, at the date of the filing of a patent application in respect of a product or process or at the date of a foreign priority validly claimed in respect of the application, a person other than the applicant- (a) was conducting an undertaking in Nigeria; and (b) in good faith and for the purposes of the undertaking, was manufacturing the product or applying the process or had made serious preparations with a view to doing so, then, notwithstanding the grant of a patent, there shall exist a right (exercisable by the person for the time being conducting the undertaking, and not otherwise) to continue the manufacture or application, or to continue and complete the preparations and thereafter undertake the manufacture or application, as the case may be, and in respect of any resulting products to do any other act mentioned in subsection (1) of this section.”

²⁷ Although the PDA does not say whether there grants of the patent was in Nigeria or in a foreign country. Whatever the case may be a patent cannot be granted where the product has been manufactured or the process has been in use as a patent is only granted if the invention is new, results from inventive activity and is capable of industrial application; or if it constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.

²⁸ Section 1 of the PDA.

- As indicated in chapter 6 certain TRIPS flexibilities which mitigate the effect of the patent provisions are absent in the PDA. For example, exhaustion of rights and parallel imports. It is suggested that a system of international exhaustion should be adopted. The importance of these principles lies in the fact that they permit the importation of cheaper and good quality products.
- Nigeria has no anti-competition law and the PDA does not eliminate situations where patents can be used to create a monopoly. The advantages of such a provision will be that it fosters competition which results in lower prices, better quality products and more choice for consumers.
- Implementation of the ‘Paragraph 6 system’ is of utmost importance to the public health care system in Nigeria, in consideration of the fact that 90% of the People Living with HIV do not have access to antiretroviral treatment²⁹ and only 10% of the children born children born to women living with HIV receive early infant diagnosis. The need for a speedy implementation of this provision cannot be overstated as other diseases too, share a lack of access to medicines and medical devices. Nigeria currently suffers from an extreme case of insufficient capacity to provide medicines needed for a population of over 160 million.

8.5 Enforcement

The law will be mere rhetoric and high sounding words if the essence of the law, its enforcement, cannot be accomplished. The undesirable effect of the inability of the law to act as a deterrent and punish unscrupulous elements that see counterfeiting and piracy as a business results in untold hardship to both consumers and producers of intellectual property.

In chapter seven, section A the adequacy of enforcement procedures and mechanism of the legal framework on intellectual property in Nigeria was scrutinised to determine its compliance with the required standard expected under the TRIPS Agreement.

²⁹ UNAIDS, Global Report UNAIDS report on the global AIDS epidemic 2013 http://www.unaids.org/en/media/unaids/contentassets/documents/epidemiology/2013/gr2013/UNAIDS_Global_Report_2013_en.pdf p. 46.

Presently Nigeria does not have a specialised courts system for intellectual property right enforcement and really does not need one as intellectual property matters are determined in the Federal High Court, not separate from that used for the general laws. Courts of superior jurisdiction have appellate jurisdiction in intellectual property matters.

Enforcement of intellectual property rights presupposes an infringement of the right and the existence of a right. Intellectual property rights are generally exclusive right which are products of human intellect that belong to the author or creator unless they have been assigned or licenced in one form or the other. Where any of the exclusive rights are infringed the owner has the right to various forms of enforcement mechanism which include criminal, civil and border measures, and remedies such as damages, injunctions, seizures, and imprisonment are awarded where infringement has been determined. The following are issues noted in chapter 7:

8.5.1 Issues Identified and Probable Solution

- Inadequacy of the penalties constitutes a major lacuna in the enforcement mechanism in Nigeria generally. This issue is not limited to intellectual property alone, but cuts across other areas of law in Nigeria. The major reason for this grave inadequacy, as noted in chapter seven, rests mainly on the fact that the laws have been stagnant and some of the intellectual property laws have not been review for upward of 45 years. The penalties provided in the law are no longer sufficient due to inflation, making it economically unrealistic to have such provisions in the law and giving an undue advantage to the infringer to the detriment of the rightful owner. Furthermore, in relation to copyright, where an infringer is required to pay ₦1000 (\$6) in a case of direct infringement and ₦100 (\$0.60) in a case of indirect infringement for each infringing copy, the situation is ridiculous.³⁰ It is suggested that the amount the infringer pays per copy should be equivalent to the market price or value of each infringing copy so as to serve as a deterrent to other infringers.

³⁰ Section 20 CA 1988 Cap 28 LFN 2004.

- The PDA requires distinct provisions of what constitutes infringement and the remedies that will be available to the rightful owners, as is provided in other countries such as the UK.³¹ The provision should include criminal procedures and penalties for product counterfeiting.
- Similarly, the Trade Mark laws require criminal procedures and penalties for wilful trade mark counterfeiting. In addition, infringement proceeding, explicitly stating what usage of a trade mark constitutes an infringement and what is not infringement, is necessary. These provisions are an absolute necessity considering the magnitude of pirated and counterfeit products that pervade the market.
- Nigeria's borders are highly porous. It is unthinkable that there are Custom Officers manning these borders. The Standard Organisation of Nigeria has failed woefully: as even pirated and counterfeit products carry their stamp. The nature of Nigeria's borders and the failure of the SON do not explain the catastrophic salutation: one singular factor is responsible which is the endemic corruption that pervades every government parastatal and agency.

8.6 Final Remarks

This thesis has made the case that the Nigerian intellectual property legislation will be affected by total compliance with the minimum standard of the TRIPS Agreement, despite the fact that the study reveals that quite a number of the current laws already comply with the TRIPS Agreement. The parts of the legal framework of Nigeria that do not comply with the TRIPS Agreement are few but salient: for instance the provision on plant varieties, the TRIPS requires protection either by patents or by an effective *sui generis* system or by any combination thereof.

It is surprising that legislations on patent protection, which dates back to 1970, contains a term of protection of 20 years and gives protection to both products or processes patent in all

³¹ See sections 60-71 UK Patent Act 1977 as amended.

fields of technology,³² provided they are new, involve an inventive step and are capable of industrial application.

Theoretically speaking Nigeria has no reason to complain about the level of protection afforded in the TRIPS Agreement. Technically, the level of protection found in the PDA is excessive for the level of technological development of Nigeria and the reason this provision has remained in place till date is because of the absence to good quality research and development and innovation.³³ Practically, the impact of the TRIPS Agreement relates to the fact that the provisions are minimum standard, which implies that members are bound to that level of protection even when it does not serve their purpose. Conceptual concerns over the implication relates to the fear that members are not allowed to reduce the protection on intellectual property rights where their technological development or creative capacity cannot measure up to the minimum standard. Developed countries had the opportunity which is refused developing countries through internationally binding agreements.

The protection of intellectual property in the TRIPS Agreement places intellectual property rights in an internationally enforceable realm, which makes it possible for a member state to call for a particular situation to be addressed in another member state, failing which trade sanctions may be imposed if any of the provisions are not complied with.

However, the TRIPS Agreement should not be seen as a fetter on member countries. It is submitted that the flexibilities in the TRIPS Agreement provide options for reviewing an enabling legal framework that captures the issues that have been raised in this study. The flexibilities that are in the TRIPS Agreement should be a mandatory provision in formulating or amending laws and regulations. These measures are necessary in order to protect public health and nutrition and to promote the public interest in sectors of vital importance to socio-

³² Except areas specifically excluded in the PDA. See section 1 (4) and (5) PDA 1970 P2 LFN 2004.

³³ India removed product patent from its law in 1970. See Section 5 India Patent Act, 1970: 'In the cases of inventions - (a) claiming substances intended for use, or capable of being used, as food or as medicine or drug, or (b) relating to substances prepared or produced by chemical processes no patent shall be granted in respect of claims for the substances themselves, but claims for the methods or processes of manufacture shall be patentable.' The India provision allowed companies to copy the patented product by simply changing the manufacturing process. India did not do anything out of place as most developed countries did not provide for product patenting till recently.

economic and technological development. Development that will contribute to the promotion of technological innovation and to the transfer and dissemination of technology to the mutual advantage of producers and users of technological knowledge in a manner conducive to social and economic welfare, as well as to balance rights and obligations as specified in the TRIPS Agreement.³⁴

Finally, the challenge remains that having laws is not enough. Government, and all stakeholders, must come to the realisation that positive action needs to be taken to develop intellectual property in the country.

³⁴ Section 7 and 8 TRIPS Agreement.

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Works Protected under Copyrights

	Work protected	Context and meaning
1.	Literary works	<p>includes, irrespective of literary quality, any of the following works or works similar thereto-</p> <p>(a) novels, stories and poetic works;</p> <p>(b) plays, stage directions, film scenarios and broadcasting scripts;</p> <p>(c) choreographic works;</p> <p>(d) computer programmes;</p> <p>(e) text-books, treaties, histories, biographies, essays and articles;</p> <p>(f) encyclopaedias, dictionaries, directories and anthologies;</p> <p>(g) letters, reports, and memoranda;</p> <p>(h) lectures, addresses and sermons;</p> <p>(i) law reports, excluding decision of courts;</p> <p>(j) written tables or complaints.</p>
2.	Musical works	"musical work" means any musical work, irrespective of musical quality and includes works composed for musical accompaniment
3.	Artistic works	<p>includes, irrespective of artistic quality, any of the following works or works similar thereto</p> <p>(a) paintings, drawings, etchings, lithographs, woodcuts, engravings and prints;</p> <p>(b) maps, plans and diagrams;</p> <p>(c) works of sculpture;</p> <p>(d) photographs not comprised in a cinematographic film;</p> <p>(e) works of architecture in the form of buildings models; and</p>

		(f) works of artistic craftsmanship and also (subject to section 1 (3) of this Act) pictorial woven tissues and articles of applied handicraft and industrial art;
4.	Cinematographic films	includes the first fixation of a sequence of visual images capable of being the subject of reproduction, and includes the recording of a sound track associated with the cinematograph film;
5.	Sound recording	means the fixation of a sequence of sound capable of being perceived aurally and of being reproduced but does not include a sound track associated with a cinematograph film;
6.	Broadcasting	means sound or television broadcast by wireless telegraphy or wire or both, or by satellite or cable programmes and includes re-broadcast;

Term of Protection of Intellectual Property Works

Duration of Copyright

TYPE OF WORKS		DURATION
1.	Literary, musical or artistic works other than photographs	70 years after the end of the year in which the author dies; in the case of government or a corporate body, 70 years after the end of the year in which the work was first published.
2.	Cinematographic films and photographs	50 years after the end of the year in which the work was first published.
3.	Sound recording	50 years after the end of the year in which the recording was first made.
4.	Broadcasting	50 years after the end of the year in which the broadcast first took place.
5.	In the case of anonymous or pseudonymous literary, musical or artistic works. See section 2 (3)	70 years from the end of the year in which the work was first published provided that when the author becomes known the duration shall be calculated in accordance with the first schedule to the Act.
6.	In the case of Joint authorship	Author refers to the author who dies last. See section 2 (4)

Duration and renewal of registration of Trade Marks

	Trade Marks	Duration
1	Initial registration of a trade mark	Registered for 7 years
2	Renewal of a trade mark	Renewed from time to time a period of 14 years from the date of expiration of the original registration or of the last renewed registration, as the case may be .

Duration and renewal of registration of Patents

	Patent	Duration
	Patent Protection	A patent is protected for 20 years from the date of the filing of the relevant patent application.

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