

## THE TEST OF NOVELTY OF INDUSTRIAL DESIGNS IS GLOBAL AND NOT TERRITORIAL - A REVIEW OF THE JUDICIAL DECISION IN SUIT NO. FHC/L/CP/1240/13 WEST AFRICAN COTTON LTD V HOZELOCK EXEL

A Brand Protection Unit Newsletter from Jackson, Etti & Edu.



Jackson, Etti and Edu's intellectual property litigation team recently obtained a decision in favour of West African Cotton Ltd at the Federal High Court, where the provisions of the Patent and Designs Act on novelty of the subject matter of registered industrial designs was reviewed and interpreted by Hon. Justice R.M. Aikawa. The Court held that the test of novelty to be applied in determining if an industrial design should be cancelled, is a global test and not a local one. Thus, where an industrial design is registered after complying with filing formalities, such design may be cancelled and expunged, if the subject matter of the design was not "new" globally.

### Facts of the Case

The main contention by West African Cotton Ltd in the referenced case was that, Hozelock Exel's industrial design registrations RPD/D/F/RD/2010/96 and RPD/D/F/RD/2010/96 for their CP-3 and CP-5 knapsack sprayers, were not new at the time of registration, as West African Cotton Ltd commenced importation of its WT-15, (which had similar designs) from China prior to the date the applications for the design registrations for CP-3 and CP-5 were filed and registered in Nigeria, in 2010. Hozelock Exel however argued that the test of novelty was a local test, and that since it was not shown that West African Cotton Ltd's WT-15 was available in Nigeria prior to the date the applications for the designs registrations were filed, then the CP-3 and CP-5 design registrations would not be liable for cancellation.

Jackson, Etti and Edu, nevertheless, contended on behalf of West African Cotton Ltd that, the test of novelty of the subject matter of an industrial design is a global test, such that a registered proprietor of an industrial design ought to be able to show that the industrial design was “new” globally. In the event the industrial design was unable to comply with the global test of newness at the time of registration, such registered industrial design would be liable to be cancelled and expunged from the register of industrial designs in Nigeria.

## Decision of the Court

In a well-considered decision, the Federal High Court per Hon. Justice Aikawa agreed with West African Cotton Ltd’s argument (as per Jackson, Etti and Edu’s submissions) and held that the test of novelty was a global test. The Court held that since West African Cotton Ltd had shown that WT-15 knapsack were available for importation in China and Germany prior to the date Hozelock Exel’s industrial designs were filed and registered in 2010, the said design registrations were liable to be cancelled and expunged. The Court upheld the provisions of Section 13(3) of the Patent and Designs Act, which provides that an “industrial design is not new if before the date of the application for registration, it has been made available to the public anywhere....” The Federal High Court held that the word “anywhere” clearly implies a global test and not a local test of novelty. The Judge summarily held that registered designs for CP-3 and CP-5 knapsacks be expunged from the Register of Industrial Designs, in line with Jackson, Etti and Edu’s arguments on behalf of West African Cotton Ltd.

## Implication of the Decision in Nigeria’s Industrial Designs Jurisprudence

The decision in West African Cotton Ltd v Hozelock Exel is a landmark decision for many reasons. One is that there is currently no reported judicial decision clarifying this fine point, to determine if test of newness/novelty in Nigerian patent and designs law is global one or a local one. The decision in West African Cotton Ltd v Hozelock Exel has now laid this issue to rest. The test is clearly a global test.

Another reason this decision is important is that, this case has shown that the registration of an industrial design can be set aside for want of novelty. There is sparse judicial authority on this subject, hence the need for judicial authorities to guide future actions, particularly where a proprietor of a doubtful industrial designs uses such registered design as a basis to threaten legal actions against another competitor. Registered proprietors have time and time again interfered in business of competitors, by obtaining the registration of doubtful designs in Nigeria. The implication of this judicial decision is that the registration of the subject matter of a design that is already in public domain is not a confirmation of the validity of such design. Rather such design may be considered worthless and the proprietor of such industrial design may be made liable for obtaining such registration in the first place, as it may be considered as an attempt to obtain a monopoly when no case for such has been justifiably established.

### Key Contacts:

**Obafemi Agaba**

Partner

obafemiagaba@jacksonettiandedu.com

**Toyosi Odunmbaku**

Senior Associate

toyosiodunmbaku@jacksonettiandedu.com

www.jacksonettiandedu.com