



INTRODUCTION

Design creates a nexus between functionality and form and is one of the key factors that attract customers to a product or to prefer one product over another.

In a legal sense, an industrial design constitutes the ornamental aspect of an article/object. It may consist of three-dimensional features, such as the shape of an article or it may include two dimensional features, such as patterns, lines or colour.¹

It is important to draw a distinction between industrial designs and patents which aim to protect an improvement in the functionality of an article.

Thus, if the aim is to protect the improvement in functionality of an innovation, filing a patent application should be considered so long as all the requirements for patentability are met. This is because industrial designs strictly protect the look and aesthetics of an article. Likewise, industrial designs do not protect intangible goods that are not visible to the eye.

Industrial designs are relevant to a wide variety of products, ranging from fashion, crafts to technical and medical instruments as well as jewelry and other luxury items. Industrial designs may consist of any of the following:

- a. Three dimensional features such as the shape of a product, for example, the Coca-Cola contour bottle,² Piaggio Vespa scooter, iPhone/iPad/iPod,³ and the iMac);
- b. Two-dimensional features, such as ornamentation, patterns, lines or color of a product e.g, Deola Sagoe Aso Oke designs⁴ or
- c. A combination of one or more such features.

Industrial design rights

Industrial design right is a form of intellectual property protection available for innovators in Nigeria and other jurisdictions across the world.

It is primarily focused on protecting the visual features of an article, i.e its design, shape, pattern or ornament. As such, a change in the functionality of the article or the materials used to manufacture the article will not be eligible for industrial design protection.

Industrial Designs in Businesses

Innovators often devote a significant amount of time and resources to enhance the design appeal of their products. New and original designs are often created in order to:

- a. Tailor a product to appeal to specific target markets e.g., modifications may be made to eye wear to make them suitable for different age groups.
- b. Create a niche market e.g., luxury cars, computers, phones etc.
- c. To enhance the distinctiveness of a brand e.g., Coca Cola.

Why is it necessary to protect Industrial Designs?

Industrial designs add a lot of value to a product, they make the product distinctive and appealing to customers and may even be its unique selling point. It is therefore important that designers or manufacturers as part of their business strategy include protecting valuable designs.

Registration of an industrial design at the Registry of Trademarks, Patents and Industrial Designs not only protects the design, it grants the owner the exclusive right to prevent its unauthorized copying or imitation by others. This improves the competitiveness of a business and often brings in additional revenue.⁵

Advantages of Registering Industrial Designs

- a. Helps to prevent the design from being copied by competitors.
- b. Helps to obtain fair economic returns on the creative effort put into creating the product.
- c. Industrial designs are business assets that may increase a company's commercial value.
- d. A protected design may also be licensed to others for a fee. This is particularly helpful in entering foreign markets the company may not be able to serve on its own and
- e. It encourages fair competition and honest trade practices which helps promote the creation of diverse aesthetically pleasing products.

Protecting Industrial Designs

In Nigeria, an industrial design must be registered in order to be protected under the relevant industrial design law. To do this, an application must be filed at the Registry of Trademarks, Patents and Designs.

Registrable Designs

For a design to be registrable under the Patent and Designs Act ("the Act"),⁶ such a design must be new and not contrary to public order or morality. An industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the registrar that the creator of the design could not have known that it had been made so available.⁷

In addition, the design must be original, a design is considered original if it has been independently created by the designer and is not a copy or an imitation of existing designs. Lastly, the design must have individual character.

Unregistrable Designs

The following Designs are generally barred from registration:

- a. Designs that do not meet the requirements of novelty, originality and/or individual character;
- b. Designs that are considered to be dictated exclusively by the technical function of a product; such technical or functional design features may be protected, depending on the facts of each case, by other IP rights (e.g., patents or trade secrets);
- c. Designs incorporating protected official symbols or emblems (such as the national flag);
- d. Designs which are considered to be contrary to public order or morality e.g., a design in the shape of genitals or other immoral form.⁸

Who may register an Industrial Design?

The right to registration of an industrial design is vested in the statutory creator of the design i.e. the person who, whether or not he is the true creator is the first to file an application to register, or validly claim a foreign priority for an application for registration of the design.⁹

However, the Act provides that the true creator of a design shall be entitled to be named as such in the register, and the entitlement in question shall not be modifiable by contract.¹⁰

Note that where an industrial design is created in the course of employment or in the execution of a contract for the performance of specified work, the ownership of the design is vested in the employer or, as the case may be, in the person who commissioned the work provided that, where the creator is an employee, then, if his contract of employment does not require him to exercise any creative activity but he has in creating the design used data or means that his employment has put at his disposal-(a) he shall be entitled to fair remuneration taking into account his salary and the importance of the design which he has created; and (b) the entitlement in question is not modifiable by contract and may be enforced by civil proceedings.¹¹

Application for registration¹²

For a successful application for registration of industrial designs at the Trademarks, Patents and Industrial Designs Registry, the application made to the Registrar shall contain the following:

- a. a request for registration of the design;
- b. the applicant's full name and address and, if that address is outside Nigeria, an address for service in Nigeria;
- c. a specimen of the design or a photographic or graphic representation of the design with any printing block or other means of reproduction from which the representation was derived;
- d. an indication of the kind of product (or, where a classification has been prescribed, the class of product) for which the design will be used; and
- e. such other matter as may be prescribed accompanied by the prescribed fee.¹²

The term of protection for a registered industrial design lasts for two consecutive periods of 5 years each on application.

Protecting Industrial Designs in the International Space

Industrial design protection is territorial, which means it is generally limited to the country or region where the design has been registered. Thus, if protection is sought in foreign markets, it may be necessary to apply for protection in the specific foreign countries.

It is important to note that a creator has six months from the date on which he applied for protection in the first country to claim the right of priority when applying for design protection in other countries. Once this period has lapsed, he will be unable to apply for design protection in foreign countries, as the design will no longer be considered new.

Industrial designs may be protected abroad in three ways: Nationally, Regionally and Internationally.

a. National:

A creator/company may seek protection by applying separately to the national IP offices of each country in which they intend to obtain protection. The process may however be cumbersome and expensive as translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees.

b. Regional

Where protection is sought among a group of countries that are members of regional agreements which enable the registration of designs in more than one country, a single application at the regional IP office concerned may be filed.

For example, the African Regional Industrial Property Office (ARIPO) for industrial design protection in English-speaking African countries; the Benelux Designs Office (BDO) for protection in Belgium, the Netherlands and Luxembourg; the Office for Harmonization in the Internal Market (OHIM) for Community designs in the 15 countries of the European Union; the Organisation Africaine de la Propriété Intellectuelle (OAPI) for protection in French speaking African countries e.t.c.

c. International

Companies that wish to register their designs internationally in several countries may also use the procedures offered by the Hague Agreement Concerning the International Deposit of Industrial Designs, a WIPO-administered treaty.

An applicant from a Member country to the Hague Agreement can file a single international application with WIPO; the design will then be protected in as many Member countries of the treaty (currently 36) as the applicant wishes. Note however, that Nigeria is not signatory to any of the above treaties.¹³

Enforcing Industrial design rights

Whenever there has been an infringement of design rights, the creator may as a first step send a 'cease and desist' letter informing the infringer of a possible conflict between his design and his exclusive design rights. The assistance of a lawyer in drafting such a letter is advised.

If the infringement persists, it may be necessary to take legal action against the infringer. An Anton Piller order may be sought from the court to enter the premises where the infringing designs are being held and seize them without prior notice to the infringer.

A creator may also seek damages for any injury done to his reputation or goodwill as a result of the infringement.

Conclusion

The protection of intellectual property in worldwide or in foreign markets has been a great concern for many creators and corporations for years, more so in this age of digital and technological advancement. Intellectual property rights enable owners of ideas, inventions, and creative expression to exclude others from access to or use of their property without permission first having been requested and granted.

As intellectual property is critical to fostering innovation, it is important to ensure that they are adequately protected as without protection of ideas, businesses and individuals would not reap the full benefits of their inventions.

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ENDNOTES

- 1 Retrieved from <https://www.wipo.int/designs/en/> on March 29, 2021.
- 2 Instantly recognisable, the Coca-Cola contour bottle is a masterpiece in industrial design that dates back to 1915 when the Coca-Cola Company asked its bottle suppliers to design a new bottle that would be distinctive and instantly recognisable - even in the dark. Designer Earl R. Dean took up the challenge, and following instructions issued by his boss, aimed to come up with a design based on the ingredients of the drink. Unable to find any reference images for either the coca leaf, or the Kola nut, Dean instead used an image of a cocoa pod from his encyclopedia as inspiration, leading to the iconic ribbed bottle shape we know and love today.
- 3 Three indisputably game-changing product lines by arguably the world's most iconic and celebrated industrial designer, Sir Jonathan Ive - all of which could easily have made the list on their own. It all started back in 2001 with the original iPod; the first iPhone was released in 2007; the iPad followed three years later; and finally, the iPad Mini in 2012.
- 4 Section 12 of the Patents and Designs Act.
- 5 Retrieved from https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/looking_good_nig.pdf on March 30, 2021.
- 6 Cap P2 LFN 2004.
- 7 Section 13 of the Patents and Designs Act.
- 8 Retrieved from https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/looking_good_nig.pdf on March 30, 2021.
- 9 Section 14(1) of the Patents and Designs Act.
- 10 Section 14(2) of the Patents and Designs Act.
- 11 Section 14(3) of the Patents and Designs Act.
- 12 Section 15 of the Patents and Designs Act.
- 13 Retrieved from https://www.wipo.int/export/sites/www/sme/en/documents/guides/customization/looking_good_nig.pdf on March 30, 2021.

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