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REVIEWING PETER E. VENTURES (NIG.) LTD v. GAZASONNER IND. LTD & ANOR (1998) 6 NWLR (PT. 555) 619 PRIOR PUBLICATION NOVELTY REQUIREMENT OF INDUSTRIAL DESIGN PROTECTION IN NIGERIA

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ABSTRACT: This paper provides a comprehensive analysis of the landmark Nigerian Court of Appeal decision in *Peter E. Ventures (Nig.) Ltd v. Gazasonner Ind. Ltd & Anor* (1998) 6 NWLR (Pt. 555) 619. The case represents a seminal authority on industrial design protection under the Nigerian Patents and Designs Act, particularly concerning the legal effect of prior public disclosure or commercial exploitation by a design proprietor before registration. The Appellant, having acquired technology from a Hong Kong company and commercially exploited "275 lamp burner" designs from 1987, subsequently registered the designs in 1994 and sought an interlocutory injunction against alleged infringement. The Court of Appeal unanimously refused the injunction, holding that the Appellant's prior commercial activities deprived it of the legal right of exclusiveness conferred by registration. This paper examines the statutory framework under the Patents and Designs

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Act, critiques the court's application of the *American Cyanamid* principles for interlocutory injunctions, and analyzes the decision's implications for intellectual property strategy in Nigeria. The paper argues that while the decision correctly interprets statutory novelty requirements, it creates significant practical challenges for design proprietors regarding the timing of registration relative to commercial exploitation. Comparative analysis with subsequent cases, including *Densy Industries (Nig) Ltd v. Uzokwe* (1999) and *West African Cotton Company Limited v. Hozelock Exel* (2020), demonstrates the enduring relevance of this decision. The paper concludes with recommendations for legal reform and practical guidance for intellectual property practitioners in Nigeria, but particularly, clients should be properly guided on conducting novelty searches, drafting pleadings carefully, consider invalidity counterclaims, and seek security for costs.

Keywords: *Industrial Design Protection, Prior Publication, Novelty, Case Review, Intellectual Property.*

1.0 INTRODUCTION

1.1 Background to the Study

Intellectual property law in Nigeria has evolved significantly since the enactment of the Patents and Designs Act of 1970. Among the various forms of intellectual property protection available in Nigeria, industrial designs occupy a unique position, protecting the ornamental or aesthetic aspects of useful articles rather than their functional features. The protection of industrial designs serves crucial economic functions, incentivizing creativity in product design, promoting industrial innovation, and preventing unfair competition through slavish imitation.

However, the effectiveness of industrial design protection depends critically on the proper interpretation and application of the statutory requirements for registrability and the scope of rights conferred upon registration. The Nigerian Court of Appeal's decision in *Peter E. Ventures (Nig.) Ltd v. Gazasonner Ind. Ltd & Anor* addresses fundamental questions at the intersection of design registration, novelty requirements, and interim relief in infringement proceedings.

1.2 Statement of the Problem

The central legal dilemma presented in this case concerns the relationship between prior commercial exploitation of a design and the subsequent acquisition of exclusive rights through registration. Section 19(1) of the Patents and Designs Act grants the registered proprietor of an industrial design '*the exclusive right to use the design in relation to the product for which it is registered and to prevent any other person from using it without his consent.*' However, Sections 13(3) and 19(2) (b) create exceptions where the design has been made available to the public prior to the registration date.

This creates a significant tension: does an entrepreneur who commercially tests a product before seeking registration forfeit the exclusivity that registration would otherwise confer? The problem is particularly acute where, as in the instant case, the proprietor itself was responsible for the prior public disclosure through its own importation and sale activities. The case also raises important questions about the standards for granting interlocutory injunctions in intellectual property disputes, particularly the application of the balance of convenience test where the plaintiff's claim to exclusivity is contested.

1.3 Objectives of this work

The work aims to:

a. Analyze the statutory framework for industrial design protection under Nigerian law;

b. Critically examine the Court of Appeal's interpretation of Sections 13(3) and 19(2)(b) of the Patents and Designs Act;

c. Evaluate the court's application of the principles governing interlocutory injunctions in intellectual property cases;

d. Assess the practical implications of the decision for design proprietors and intellectual property practitioners; and

e. Propose recommendations for legal reform and best practices.

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1.4 Methodology

This paper adopts a doctrinal legal research methodology, analyzing primary sources including the Patents and Designs Act, the Court of Appeal's judgment in **Peter E. Ventures**, and relevant case law from Nigerian courts and other common law jurisdictions. Secondary sources including academic texts, journal articles, and commentaries on Nigerian intellectual property law are also examined. Comparative analysis is employed where appropriate to illuminate the Nigerian position relative to other jurisdictions.

1.5 Scope and Limitations

The paper focuses specifically on industrial design protection under Nigerian law as illuminated by the **Peter E. Ventures** decision. While references are made to patent law where relevant, a comprehensive examination of patent protection falls outside the scope of this paper. The analysis is limited to Nigerian jurisprudence, though comparative references to English and other Commonwealth authorities are included where they have influenced Nigerian courts.

2.0 FACTUAL BACKGROUND AND PROCEDURAL HISTORY

2.1 The Parties and Their Claims

The Appellant Peter E. Ventures (Nig.) Ltd, was a Nigerian company that had acquired technology, including a mould and franchise, from a Hong Kong company for the manufacture of "275 lamp burners" used in hurricane lanterns. The Appellant claimed to be the first local manufacturer of this specific lamp burner design in Nigeria. After conducting test runs and commencing production around 1987, the Appellant eventually registered the industrial design in 1994, obtaining Certificates Nos. **5603 and 5604**.

The Respondents, Gazasonner Ind. Ltd and Chief Gaius Eze, were alleged to be producing and selling products that were identical or substantially similar to the Appellant's registered design. The Appellant instituted an action at the Federal High Court claiming infringement of its registered industrial design rights.

2.2 The Application for Interlocutory Injunction

As part of its substantive claim, the Appellant sought an interlocutory injunction to restrain the Respondents from further acts of infringement pending the final determination of the

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suit. Interlocutory injunctions are a crucial remedy in intellectual property cases, serving to preserve the status quo and prevent irreparable harm to the right holder during the pendency of litigation. However, the trial court refused the application, holding that the balance of convenience did not favour the grant of the injunction.

2.3 The Appeal to the Court of Appeal

Dissatisfied with the trial court's decision, the Appellant appealed to the Court of Appeal, Enugu Division. The appeal was heard on 14 May 1997, with the lead judgment delivered by Eugene Chukwuemeka Ubaezonu, J.C.A., and concurring judgments by Isa Ayo Salami, J.C.A. (as he then was, later President of the Court of Appeal and Acting Chief Justice of Nigeria) and Niki Tobi, J.C.A. (later Justice of the Supreme Court). The unanimous decision of the Court of Appeal was to dismiss the appeal and affirm the trial court's refusal of the interlocutory injunction.

3.0 STATUTORY FRAMEWORK FOR INDUSTRIAL DESIGN PROTECTION IN NIGERIA

3.1 Definition and Nature of Industrial Designs

Section 12 of the Patents and Designs Act defines an industrial design as "*any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result*". This definition encompasses two categories of designs: two-dimensional designs (combinations of lines or colours) and three-dimensional designs (forms), provided they are intended for industrial multiplication.

The requirement that the design not be "intended solely to obtain a technical result" creates an important distinction between industrial designs and patents. While patents protect functional inventions, industrial designs protect aesthetic or ornamental features. Where a design's features are dictated exclusively by functional considerations, protection must be sought, if at all, through patent law rather than design registration.

3.2 Requirements for Registrability

Section 13(1) of the Act provides that an industrial design is registrable if it is new. Subsection (2) establishes a presumption of novelty at the time of application for

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registration, stating: "A design shall be considered to be new if, at the date of the application for registration, it has not been made available to the public anywhere and by any means whatsoever".

Crucially, Section 13(3) provides that the presumption of novelty may be rebutted by evidence showing that, prior to the date of application, "*the design had been made available to the public anywhere and by any means*" unless it is shown to the satisfaction of the registrar that the creator could not have known that it had been made available. This provision is of central importance to the Peter E. Ventures decision.

3.3 Rights Conferred by Registration

Section 19(1) of the Act grants the registered proprietor '*the exclusive right to use the design in relation to the product for which it is registered and to prevent any other person from using it without his consent*'. "Use" is defined expansively to include "the making, importing, selling, hiring, offering for sale or hire, or otherwise disposing of any product to which the design has been applied."

However, Section 19(2) (b) creates an important exception: the rights conferred by registration do not extend to "acts in respect of a product which has been lawfully sold or otherwise lawfully made available to the public by or with the consent of the proprietor." This provision, read together with Section 13(3), formed the statutory basis for the Court of Appeal's decision.

3.4 Duration and Renewal

Under Section 20 of the Act, the initial term of registration for industrial design is five years from the date of application, renewable for two further periods of five years each, for a maximum total protection period of fifteen years. This limited duration reflects the policy balance between incentivizing design innovation and ensuring that designs eventually enter the public domain.

3.5 Grounds for Invalidation

Section 22 of the Act provides that a registered design may be invalidated if it does not comply with Sections 13(1) (a) (novelty), 13(1) (b) (not contrary to public order or

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morality), or 14 (right to registration). The procedure for invalidation may be by application to the registrar or by counterclaim in infringement proceedings before the Federal High Court.

4.0 LEGAL ISSUES FOR DETERMINATION

The Court of Appeal was called upon to determine the following principal issues:

4.1 Interpretation of Section 19(2)(b) and Section 13(3) of the Patents and Designs Act

The primary issue was whether the Appellant's prior commercial activities importing and selling lamps incorporating the 275 lamp burner design from 1987 until registration in 1994 constituted making the design "available to the public" within the meaning of sections 13(3) and 19(2)(b). If so, this would deprive the Appellant of the exclusive rights that registration would otherwise confer.

4.2 The Effect of Prior Commercial Exploitation by the Proprietor

A related issue was whether it mattered that the prior disclosure was effected by the Appellant itself rather than by a third party. The question was whether a design proprietor could ‘shoot itself in the foot’ by commercially exploiting a design before seeking registration, or whether the statutory exceptions applied equally regardless of the identity of the person who made the design available.

4.3 Principles for Granting Interlocutory Injunctions in Design Infringement Cases

The third issue concerned the proper application of the principles governing interlocutory injunctions, as established in *American Cyanamid Co. v. Ethicon Ltd* [1975] AC 396 and adopted in Nigerian jurisprudence. Specifically, the court had to consider whether the Appellant had established a serious question to be tried, whether damages would be an adequate remedy, and where the balance of convenience lay.

4.4 The Relationship between Registration and Enforceability

Finally, the case raised the broader question of whether registration automatically entitles the proprietor to enforcement remedies, or whether the court must examine the underlying validity of the registration when considering interim relief.

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5.0 ANALYSIS OF THE COURT OF APPEAL'S DECISION

5.1 The Lead Judgment: Ubaezonu, J.C.A

Justice Ubaezonu, delivering the lead judgment, conducted a careful analysis of the Appellant's pleadings and affidavit evidence. The court found that the Appellant had explicitly averred that from 1987 it had been importing and selling to the public lamps incorporating the 275 lamp burner design, the very design it subsequently registered in 1994.

The critical passage from the judgment states:

"It is clear from the averments in the aforementioned paragraphs of the reply that from 1987 the appellants had been importing and selling to the public, lamps with 275 lamp burner designs, which design it subsequently registered in 1994 ...the appellant is deprived of the legal right of exclusiveness to the 275 lamp burners design..."

The court reasoned that the combined effect of sections 19(2) (b) and 13(3) was to take away the monopoly rights that would otherwise flow from registration. Since the design had been made available to the public through the Appellant's own commercial activities before the registration date, the Appellant could not claim the exclusive rights that registration ostensibly conferred.

This interpretation gives effect to the statutory policy that industrial design protection is intended to reward the introduction of 'new' designs into the marketplace, not designs that have already been commercially exploited. The novelty requirement is thus not merely a formality but a substantive condition for protection.

5.2 The Concurring Judgment: Niki Tobi, J.C.A.

Justice Niki Tobi (as he then was) delivered a concurring judgment that elaborated on the policy rationale behind the statutory provisions. His lordship emphasized that intellectual property rights represent a bargain between the inventor and the public: the inventor receives a limited monopoly in exchange for disclosing a new and useful design to the public. Where the design has already been made available to the public before registration, the consideration for the monopoly fails.

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Justice Tobi also addressed the Appellant's argument that registration created a presumption of validity that the court should respect at the interlocutory stage. While acknowledging the presumption under Section 13(2), his Lordship held that the presumption was rebuttable and that the Appellant's own averments provided sufficient rebuttal evidence. The court was not required to ignore clear evidence of prior disclosure simply because the design had been registered.

5.3 The Concurring Judgment: Salami, J.C.A

Justice Isa Ayo Salami (as then was) concurred with the lead judgment, adding brief observations on the discretionary nature of injunctive relief. His lordship noted that even if the Appellant had established a serious question to be tried, the balance of convenience would still not favour granting the injunction given the strength of the Respondents' defence based on prior disclosure.

5.4 Application of the American Cyanamid Principles

The court's approach to the interlocutory injunction application merits detailed analysis. The principles governing interlocutory injunctions in Nigeria, as in England, derive from *American Cyanamid Co. v. Ethicon* Ltd, which established a three-stage test as follows:

a. The applicant must demonstrate that there is a serious question to be tried, that the claim is not frivolous or vexatious. The applicant need not establish a *prima facie* case in the sense of showing that success is more likely than not, but must show that the claim has sufficient substance to proceed to trial.

b. The court must consider whether damages would be an adequate remedy for the applicant if the injunction were refused and the applicant ultimately succeeded at trial. Conversely, if the injunction were granted and the respondent ultimately succeeded, would damages be an adequate remedy for the respondent?

c. If the adequacy of damages is unclear, the court must consider where the balance of convenience lies, which party would suffer greater irreparable harm from the court's decision, whichever way it goes.

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In **Peter E. Venture's** case, the court effectively held that the Appellant failed at the first stage. Given the clear statutory exception in section 19(2) (b) as applied to the facts, there was no serious question to be tried. The Appellant's claim was not merely weak but was fundamentally defeated by its own pleadings. This represents a relatively rare case where a court determines the legal merits sufficiently at the interlocutory stage to refuse relief entirely, rather than preserving the status quo for trial.

6.0 EVALUATION AND REVIEW OF THE DECISION

6.1 Correctness of the Statutory Interpretation

With respect, the Court of Appeal's interpretation of Sections 13(3) and 19(2) (b) appears correct as a matter of statutory construction. The language of the provisions is clear and unambiguous: prior public availability, by any means and anywhere, defeats novelty. There is no exception for prior disclosure by the applicant itself. Indeed, to read such an exception into the statute would undermine the novelty requirement entirely, as applicants could simply register designs after commercial testing and still claim exclusivity.

This interpretation aligns with the position in other common law jurisdictions. Under English law, prior use by the applicant before the priority date destroys novelty for registered design purposes, subject only to limited grace periods for certain disclosures. Similarly, under the Community Design Regulation, a design is invalid if it has been made available to the public before the filing date, with limited exceptions.

However, the practical implications are severe. The decision effectively penalizes entrepreneurs who wish to test market response before committing to the costs of formal registration. This may discourage innovation or lead to strategic behavior where applications are filed prematurely before the design is fully refined.

6.2 The Problem of the Non-Examination System

A more critical perspective might question whether the court gave sufficient weight to the fact that Nigeria operates a registration system without substantive examination. The Registrar of Patents and Designs does not examine applications for novelty; registration is essentially automatic upon compliance with formal requirements. The presumption of

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novelty under Section 13(2) is therefore a legal fiction that may frequently be rebutted, as occurred in this case.

This creates a ‘trap for the unwary’: applicants may reasonably assume that registration confers enforceable rights, only to discover in litigation that their registration is effectively worthless due to prior commercial activities that they themselves undertook. The court might have considered whether the Appellant should have been estopped from asserting invalidity based on its own prior acts, or whether the Respondents had standing to raise the invalidity defence when they were not the original source of the prior disclosure. However, the court did not address these equitable arguments.

6.3 The Concurring Judgment of Niki Tobi, J.C.A: A Deeper Dive

Justice Niki Tobi's concurring judgment deserves special attention for its elaboration of the policy rationale behind the novelty requirement. His lordship emphasized that intellectual property rights are not natural rights but statutory creations, and the terms of the statute define their scope. The ‘bargain theory’ of IP that exclusivity is the *quid pro quo* for public disclosure of new designs was central to his reasoning.

Justice Tobi also addressed a subtle but important point: the distinction between challenging the validity of a registration and raising a statutory defence to infringement. The Appellant argued that the Respondents should have proceeded by way of invalidation proceedings under section 22 of the PDA rather than raising the issue as a defence. His lordship rejected this argument, holding that section 19(2)(b) operates as a direct limitation on the rights conferred by registration. It is not that the registration is invalid; rather, the rights conferred do not extend to acts in respect of products already made available to the public. This distinction is significant because it means that a registration may remain on the register but provide no practical exclusivity against products that were already in the public domain before registration.

6.4 Implications for Interlocutory Injunction Practice

The decision has significant implications for the grant of interlocutory injunctions in intellectual property cases. It establishes that where the defendant raises a defence based on prior public availability, and the plaintiff's own pleadings or evidence demonstrate that

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defence, the court may refuse interlocutory relief even if registration certificates have been issued. This is consistent with the principle that interlocutory relief is discretionary and will not be granted where the plaintiff's claim is demonstrably weak.

However, this approach may be contrasted with cases where the invalidity defence is less clear-cut. In *Bedding Holdings Ltd v. INEC & Ors*, the High Court granted an ex-parte injunction based on patent registration certificates, despite the defendants' argument that the patents were invalid. The court held that at the interlocutory stage, registration certificates constitute prima facie evidence of validity. The *Peter E. Ventures* decision distinguishes itself on the ground that the plaintiff's own pleadings provided the rebuttal evidence, rather than requiring extrinsic evidence from the defendant.

6.5 Practical Impact on Design Proprietors

From a practical perspective, the decision creates strong incentives for design proprietors to register their designs 'before' any commercial disclosure, including test marketing, importation, or sale. The safe harbor is registration before public disclosure. Where this is not possible due to financial constraints or the need to test market response, proprietors should at least document the confidential nature of disclosures and use non-disclosure agreements where feasible.

The decision also highlights the importance of careful pleading. The Appellant's downfall was its own detailed averments about its pre-registration commercial activities. A more carefully drafted statement of claim might have characterized these activities as internal testing or limited distribution rather than "selling to the public." However, any attempt to conceal or minimize prior disclosure would risk allegations of bad faith and potential invalidation on other grounds.

7.0 COMPARATIVE ANALYSIS WITH OTHER CASES

7.1 Densy Industries (Nig) Ltd v. Uzokwe

The Court of Appeal's decision in *Densy Industries (Nig) Ltd v. Uzokwe* (supra), decided shortly after *Peter E. Ventures*, applied similar principles. The case involved registered designs for mosquito repellent coils. The defendant argued that the designs were not new because identical or similar products had been available in the Nigerian market before the

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registration date. The Court of Appeal held that "once the evidence vindicates any of section 13(3), (4) and (5) of the Act, a court of law is bound to hold that the design was not new at the time of the application for registration".

The case of the Appellant from his pleadings and evidence at the court of trial is that he is the registered owner of Design No. 4464 in respect of kitchen plastic container, that the design was registered on 5th March, 1991 in the name of "Sunday Innocent and Co.", that at the time of registration, the design was new and that he is the author. It was his case that he started producing the plastic containers shortly after registration of the design and within two months of registration he discovered that his right in the design had been infringed.

At the trial, the appellant as plaintiff tendered Exhibit "1" which contains the plans and drawings of the registered design. He tendered as Exhibit "2", the finished product from the registered design. It was part of his case that he started mass production of Exhibit "2" since 1991 and that at that time, there was no similar design or product in the market. Exhibit "5", the similar product produced and distributed by the defendants was tendered by the plaintiff.

It was the case of the 1st Respondent as defendant that the design was not new, that the Appellant as the plaintiff was not the creator and that the product was common, available in the market and had been produced even before the registration of the plaintiff's design. In his amended statement of defence, the 2nd Respondent as 2nd defendant denied the newness of the said design and stated that the product had been in the market long before the registration of the design by the Appellant as the plaintiff. It was the evidence of D.W.1 that the Respondents as defendants had been producing plastic kitchen containers since 1987.

The Issues before the Supreme Court:

1. Whether the burden of producing the designs and drawings from which Exhibit "5" which is the infringing product still lies with the plaintiff who has produced and tendered in court Exhibit "1", the plans and drawings from which Exhibit "2" was produced.

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2. Whether the burden of proving the novelty of Exhibit "2" has not been discharged by appellant as provided by the Patents and Designs Law.

3. Did the Court of Appeal, Enugu properly apply the decision in F. O. Ajibowo & Co. Ltd. v. Western Textile Mills Ltd. (1996) (sic) (1976) 7 SC 97 in the appeal before it?

4. Whether the findings made by the trial court were perverse that the Court of Appeal has to interfere with the said findings."

The defendants in their brief identified the following two issues for determination in the appeal: -

1. Whether the burden lies on the appellant herein to prove the novelty of the design in dispute in this suit?

2. If so, whether the appellant discharged the said burden to entitle him to the registration of the said design and the reliefs claimed.

The decision of the Supreme Court on the above issues:

The appellant appealed to the Supreme Court, which in its determination of the appeal referred to and construed the provisions of Sections 1, 12 and 13 of the Patents and Designs Act, Cap. 344, Laws of the Federation of Nigeria. Those provisions state respectively as follows:

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

a) if it is new, results from inventive activity and is capable of industrial application; or

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

"12. Any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, is an industrial design if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result."

"13(1) Subject to this section, an industrial design is registrable if -

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a. it is new; and

b) (b).........

"(2) Where an application is made for the registration of an industrial design, the design shall be presumed to be new at the time of the application except in so far as the following provisions of this section provide otherwise.

(3) 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 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.

(5) An industrial design is not new merely because it differs in minor or inessential ways from an earlier design or concerns a type of product other than the type with which an earlier design is concerned.

On what constitutes a registrable industrial design -

To be registrable, an industrial design must come within the meaning of the expression "design" in section 12 of the Patents and Designs Act, Cap 344, Laws of the Federation of Nigeria, 1990. An industrial design is any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours. What actually constitutes the design is that particular combination and arrangement of lines which give such features. [Ajibowo & Co. Ltd. v. Western Textile Mills Ltd. (1976) 7 SC 97 referred to.] (Pp. 542, paras. E-F, 545, para. B; 546, para. C)

On Proof of infringement of industrial design -

It is important in a case where the newness of a design is in dispute, as in this case, that the design claimed to be infringed and the infringing design should be put side by side to enable the court to compare and determine whether they are basically the same or whether there are fundamental differences in the shape and pattern of the lines. It is important to put them side by side to enable the court compare having regard to section 13(5) of the Patents and Designs Act Cap. 344, Laws of the Federation of Nigeria, 1990 which states that an industrial design is not new "merely because it differs in minor or inessential ways from an

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earlier design" In this case, the trial court was in error in arriving at the conclusion that the two products are similar and are produced from one design by a mere "cursory perusal of the external appearances of exhibit "2" and exhibit "5". [Ajibowo & Co. Ltd. v. Western Textile Mills Ltd. (1976) 7 SC. 97 referred to and applied.] (Pp. 542- 543, paras. F-A; 545, paras. C-D, 546, paras. C-E)

A claim for an infringement of rights in design cannot be sustained merely because the infringing product is similar to that of the alleged infringed product. Similarity in design has nothing to do with its novelty or distinctiveness. More is required from the plaintiff bearing in mind the provisions of section 1 of the Patents and Designs Act, Cap. 344, Laws of the Federation of Nigeria, 1990. In this case, to succeed in his claim that his copyright in the design, exhibit "1" had been infringed, the appellant had the onus of showing that the finished products comprised in exhibits "2" and "5" were made from the same design and not that the products are merely similar and to do this he should tender the designs of both products (exhibits "2" and "5") for comparison. Thus, whilst the earlier observation by the trial court that owing to the absence of the design for exhibit "5" (the respondent's product), it could not compare exhibits "2" (the appellant's product) and "5" is sound, it derailed when it proceeded to compare the finished products as against the designs from which they were produced. [Metropolitan Industries (Nig.) Ltd. v. Industrial Applications (Nig.) Ltd (1973) 1 NMLR 274 referred to and applied.] (Pp. 543, paras. A-C, 544, paras. D-E)

Per OGWUEGBU, J.S.C. at page 545, paras. A-D:

"I have no doubt in my mind that the court below properly applied the decision of this court in Ajibowo & Co. Ltd. v. Western Textiles Mills Ltd. (supra) where Fatayi-Williams, J.S.C. (as he then was) held as follows:

> ...What actually constitutes the design is that particular combination of and arrangement of lines, which give such features. Thus, like the disputed design in the case in hand, a design for a pattern may consist of a mere arrangement of straight lines or stripes. This is why it is important that in a case where the newness of such a design is disputed, the design claimed to be new and the old design should be put side by side to enable the court to compare and see whether they are basically the

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> same or there are fundamental differences...' The above conclusion did not suggest that a comparison of both products be embarked upon as was done by the learned trial Judge in the case before us.

Per WALI, J.S.C at page 545, paras. A-H:

"The learned trial Judge after making a correct finding on the evidence before him that: -

> In the present case the plans & drawings of the plaintiff's design are contained in the document annexed to Exhibit "1". The shape & size of the container including the shape & size of the bottom of the container and cover are claimed (sic). This design was used in the productions of Exhibit "2". The design used by the 1st defendant in the production of Exh. "5" is not before me in this case. A comparison of the designs therefore cannot be made.

He went back on the finding (supra) and compared the two products to wit: Exhibits "2" & "5" and concluded: -

'A cursory perusal of the external appearances of Exhibits "2 and 5" reveals the two are similar to each other. It seems Exhibits "2" & "5" are produced from the same design and by the application of the same process.'

This the law says the learned trial Judge cannot do without comparing the two designs from which Exhibits 2 & 5 were respectively made. In the case of Ajibowo & Co. Ltd. v. Western Textiles Mills Ltd. (1976) 7SC 97; Fatayi - Williams JSC (as he then was) stated the law as follows: -

> ...What actually constitutes the design is that particular combination and arrangement of lines which give such features... This is why it is important that in a case where the newness of such a design is disputed, the design claimed to be new and the old design should be put side by side to enable the court to compare and see whether they are basically the same or there are fundamental differences...

The mere comparison of the two products and conclusion on that basis that they are similar and produced from the same is not enough.

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The Supreme Court in that regard affirmed this decision in *Uzokwe v. Densy Industries (Nig) Ltd*, adding an important refinement: comparing the finished products themselves is not sufficient to establish lack of novelty; rather, the designs from which the products emanated must be compared. This reinforces that the focus is on the design as registered (the lines, colours, or three-dimensional form) rather than the functional product incorporating the design.

7.2 West African Cotton Company Limited v. Hozelock Exel

The most recent significant decision on this issue is the Federal High Court's judgment in *West African Cotton Company Limited v. Hozelock Exel*. The court invalidated two registered designs on grounds of lack of novelty, relying on shipping documents and physical evidence showing that identical products had been imported and sold before the registration date.

This decision demonstrates that the principles established in *Peter E. Ventures* remain good law and continue to be applied by Nigerian courts. The court specifically cited *Densy Industries* and reaffirmed that prior commercial availability, even by importation from foreign sources, destroys novelty for Nigerian design registrations. The case also highlighted the practical difficulties faced by defendants in proving prior publication in a jurisdiction with limited discovery mechanisms and without a pre-registration examination system.

7.3 Falomo v. Banigbe - Interlocutory Injunction Principles

While not an intellectual property case, *Falomo v. Banigbe* provides the Supreme Court's authoritative restatement of the principles for granting interlocutory injunctions. Justice Iguh, delivering the lead judgment, affirmed the American Cyanamid test and emphasized that the grant or refusal of an interlocutory injunction is in the absolute discretion of the court, to be exercised judiciously considering all the circumstances.

The Supreme Court also endorsed the flexible approach articulated by Lord Denning in *Hubbard v. Vosper*, which counsels against making the remedy of interlocutory injunction "the subject of strict rules." This flexibility is particularly important in IP cases, where the balance between protecting rights and preventing anti-competitive behavior can be difficult to strike.

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7.4 Comparative Perspectives from Other Jurisdictions

English law, under the Registered Designs Act 1949 (as amended), takes a similar approach to novelty. Section 1B (2) provides that a design is not new if it is the same as a design that has been made available to the public before the relevant date. The ‘grace period’ provisions under section 1B (5) allow disclosure by the designer within 12 months before the filing date without destroying novelty. Nigeria has no equivalent grace period, making the position even stricter for Nigerian applicants.

Under the EU Community Design Regulation (6/2002), a design is invalid if it does not meet the novelty and individual character requirements. However, the "grace period" of 12 months for disclosures by the designer or a successor in title provides a safety net. The Nigerian legislature might consider adopting similar provisions to balance the interests of designers who need to test market response before incurring registration costs.

Australian law, under the Designs Act 2003 (Cth), also includes a 12-month grace period for certain disclosures by the designer. The rationale is that designers should not be penalized for limited public disclosures that do not compromise the design's novelty in a meaningful sense. The absence of such a provision in Nigerian law represents a gap that the *Peter E. Ventures* decision highlights.

8.0 CONCEPTUAL AND THEORETICAL FRAMEWORK

8.1 The Economic Rationale for Industrial Design Protection

Industrial design protection rests on economic justifications similar to other IP rights but with distinctive features. The primary justification is incentive-based: without protection, competitors can free-ride on the investments made by designers in developing attractive, marketable product appearances. This would lead to underinvestment in design innovation.

However, the protection of industrial designs also raises competition concerns. Unlike patents, which protect functional innovations that may have significant consumer welfare benefits, design protection primarily protects aesthetic features. The social loss from monopoly pricing may be less significant because consumers often have close substitutes, but the risk of creating ‘design patents’ that impede competition remains.

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8.2 The Novelty Requirement: Policy and Purpose

The novelty requirement serves several functions. First, it ensures that protection is not granted for designs already in the public domain, which would represent a windfall to the applicant and an unjustified restriction on public freedom. Second, it encourages prompt registration before public disclosure, which promotes the orderly operation of the registration system. Third, it establishes a clear priority rule that reduces uncertainty about the scope of rights.

The *Peter E. Ventures* decision faithfully applies these policies. By denying exclusivity to a proprietor who had already exploited the design commercially, the court ensured that the Appellant could not use registration to withdraw from the public domain what had already been given to the public. This aligns with the fundamental principle that IP rights do not create property in information that is already known, but rather reward the introduction of new information.

8.3 The Interplay between Registration and Infringement

A theoretical tension in the decision concerns the relationship between registration and infringement. If registration is merely ministerial and does not involve substantive examination, should it confer any presumption of enforceability at the interlocutory stage? One could argue that registration should at least shift the burden to the defendant to establish invalidity or the applicability of statutory exceptions.

The court's approach in *Peter E. Ventures* gave little weight to the registration certificates, relying instead on the Appellant's own pleadings. This suggests that registration alone is insufficient to establish a serious question to be tried where the plaintiff's own case demonstrates a statutory defence. However, where the defence relies on extrinsic evidence not apparent from the plaintiff's pleadings, the court might be more reluctant to refuse interlocutory relief without a fuller hearing.

8.4 Access to Justice and Intellectual Property Enforcement

The decision also raises access to justice concerns. Interlocutory injunctions are often the only effective remedy in intellectual property cases, particularly where the defendant is a small or medium enterprise that may not have assets to satisfy a damages award. By

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refusing the injunction, the court effectively told the Appellant that its only recourse was to proceed to a full trial, which might be expensive and time-consuming.

This creates a particular burden for Nigerian entrepreneurs who may lack the resources for protracted litigation. The *Peter E. Ventures* decision may have the unintended effect of discouraging design registration and enforcement, even where the designs are genuinely new. The solution, however, lies not in judicial reinterpretation but in legislative reform to introduce a grace period and substantive examination.

9.0 PRACTICAL IMPLICATIONS AND RECOMMENDATIONS

9.1 Implications for Design Proprietors

The primary lesson from *Peter E. Ventures* is clear: register before you disclose. Design proprietors should file applications for registration before any public disclosure, including importation, sale, or even offering for sale. Where this is not possible, proprietors should:

a. *Document all disclosures carefully:* Maintain records showing the date, nature, and extent of any disclosure, as well as any confidentiality agreements in place.

b. *Use non-disclosure agreements:* Where disclosure to potential licensees or manufacturers is necessary before registration, ensure that written confidentiality agreements are in place.

c. *Consider foreign filing strategies:* If the design has been disclosed abroad, consider whether a Nigerian registration would still be valid given the "anywhere" language in Section 13(3).

d. *Disclose prior use in the application:* While not required by the Act, voluntary disclosure of prior use might allow the registrar or the court to assess novelty more accurately.

e. *Seek legal advice before enforcement:* Before commencing infringement proceedings, assess whether the design's novelty might be challenged based on pre-registration disclosures.

9.2 Implications for Legal Practitioners

Intellectual property practitioners should advise clients based on the *Peter E. Ventures* principles:

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a. *Conduct novelty searches:* Although no formal search is conducted by the registry, practitioners should conduct informal searches of the Nigerian market and online sources to identify potential prior art.

b. *Draft pleadings carefully:* Avoid over-detailed averments about pre-registration activities that could undermine the claim to exclusivity.

c. *Consider invalidity counterclaims:* When defending infringement actions, consider whether the registered design can be challenged under Section 13(3) based on prior public availability.

d. *Seek security for costs:* Given that interlocutory injunctions may be refused, consider seeking security for costs to protect against the risk of an adverse damages award.

9.3 Policy Recommendations for Legal Reform

The Nigerian legislature should consider re-enactment, or worst still an amendment to the Patents and Designs Act to address the harshness of the current position, via:

a. *Introduce a grace period:* Adopt a 12-month grace period for disclosures by the designer or their successor in title, similar to the provisions in the EU Community Design Regulation and Australian Designs Act.

b. *Implement substantive examination:* The registry should develop capacity for substantive examination of design applications for novelty, reducing the risk of invalid registrations.

c. *Create a searchable database:* Establish an online, searchable database of registered designs to facilitate novelty searches and reduce uncertainty.

d. *Provide for preliminary injunctions:* Consider a separate category of 'preliminary injunction' with lower standards for urgent cases, balanced by requirements for security.

9.4 The Role of the Nigerian Intellectual Property Office

The Nigerian IP Office has a crucial role to play in implementing these reforms. Even without legislative change, the registry could:

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a. *Publish examination guidelines:* Clarify the standards for registrability and the types of evidence considered relevant to novelty determinations.

b. *Improve record-keeping:* Ensure that design registrations are properly indexed and searchable.

c. *Engage in public education:* Inform applicants about the importance of filing before disclosure and the consequences of prior public availability.

10.0 CONCLUSION

10.1 Summary of Findings

The Court of Appeal's decision in *Peter E. Ventures (Nig.) Ltd v. Gazasonner Ind. Ltd & Anor* represents a significant authority on industrial design protection in Nigeria. The court correctly interpreted Sections 13(3) and 19(2)(b) of the Patents and Designs Act to hold that prior commercial exploitation of a design by the proprietor before registration deprives the proprietor of the exclusive rights that registration would otherwise confer. The decision reflects the fundamental policy that industrial design protection rewards the introduction of new designs to the public, not the registration of designs already in the public domain.

The court also applied the **American Cyanamid** principles for interlocutory injunctions appropriately, refusing relief where the plaintiff's own pleadings demonstrated a complete defence to the claim. While the decision creates practical challenges for design proprietors, particularly those who need to test market response before committing to registration, the solution lies in legislative reform rather than judicial reinterpretation.

10.2 Contribution to Nigerian Intellectual Property Jurisprudence

Peter E. Ventures has contributed to Nigerian IP jurisprudence in several important ways. First, it established clearly that registration does not guarantee enforceability; the underlying novelty of the design remains a justiciable issue even after registration. Second, it demonstrated that statutory defences under Section 19(2) (b) may be raised directly in infringement proceedings without the need for separate invalidation proceedings under Section 22. Third, it reinforced the discretionary nature of interlocutory relief and the importance of the balance of convenience.

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The decision has been consistently followed in subsequent cases, including *Densy Industries v. Uzokwe* and *West African Cotton Company v. Hozelock Exel*. It represents a settled principle of Nigerian intellectual property law that prior public availability defeats novelty, regardless of whether the prior availability was affected by the proprietor or a third party.

10.3 Final Reflections

The tension between protecting intellectual property rights and ensuring that protection does not extend to designs already in the public domain is inherent in any intellectual property system. The Nigerian approach, as articulated in '*Peter E. Ventures*', prioritizes the public domain and the novelty requirement over the expectations of registered proprietors. While this may seem harsh to individual entrepreneurs, it serves the broader public interest in maintaining a robust public domain and preventing the privatization of what has already been given to the public.

The optimal solution is not to abandon this principle but to provide better guidance to design proprietors about the consequences of pre-registration disclosure. Legislative reform introducing a grace period would balance the interests of designers with the public interest in novelty. Pending such reform, design proprietors must be vigilant to register their designs before any public disclosure.

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