



UGANDA LAW REFORM COMMISSION

**A STUDY REPORT ON INDUSTRIAL
PROPERTY LAW
(Patents, Industrial Designs
Technovations and Utility Models)**

KAMPALA, UGANDA

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A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

FOREWORD

The Government of Uganda, basing on the findings of the Commercial Justice Reform Programme baseline study and in consultation with stakeholders developed a four year detailed strategy for the reform of the commercial justice system. The strategy focused on five essential areas; the commercial courts, the commercial registries, the legal profession, the commercial regulatory environment and commercial laws.

In furtherance of the programme, the Uganda Law Reform Commission with the support of the Justice, Law and Order Sector proposed to reform key selected commercial laws that affect the basic operating environment of businesses to promote private sector business operations.

It should be noted that the commercial justice system in Uganda has fared badly because commercial life has been encumbered for several decades. This has caused inadequacy in Government delivery and led to the slow development of the private sector.

The commission, having appreciated the fact that law cannot be adequately reformed without appreciating the political, cultural and socio-economic context in which it operates and as a measure towards operationalising the people's constitutional right to participate in the law making process carried out wide consultations with the relevant stakeholders and individuals with a wide range of expertise on policy and business issues. As a result of these involving endeavours, many proposed Bills have been drafted.

The commission is grateful to the Justice Law and Order Sector for funding the completion of the laws under the commercial law project. It is also grateful to the consultants, Mr. Michael Hathaway of Nathan Associates and Mrs. Judy Goans for guiding the progress of the project to the end.

The commission also thanks various government departments and bodies, civic and educational institutions and all individuals who have contributed greatly to this process by participating in the consultations carried out by the commission and the consultants contracted for this project.

The commission acknowledges the input of previous consultants on the reform of business laws including, the Reid and Priest consultants and Ms. Claire Manuel and all other individuals and organisations that in one way or another participated in these reforms, particularly members of the business associations' taskforce.

The commission is indeed confident that the recommendations contained in this report and the proposed draft Bill will, due to the fact that the public have had an input, be easily enforceable in our society.

Professor Joseph M.N. Kakooza,
Chairman, Uganda Law Reform Commission.

TABLE OF CONTENTS

Foreword	iii
Table of contents	iv
List of Acts and Conventions	v
Acronmys/Abbreviations	vi
Preface	vii
EXECUTIVE SUMMARY	xv
1. Background	xv
2. Justification for reform of industrial property law	xv
3. Objectives of the study	xvii
4. Methodology	xviii
5. Summary of recommendations	xx
CHAPTER ONE	
INTELLECTUAL PROPERTY	1
1.1 Historical Background	1
1.2 Intellectual property and national economic development	3
1.3 International aspects	5
1.4 Cautionary note	8
CHAPTER TWO	
INDUSTRIAL PROPERTY	11
2.1 Patent Law	13
2.2 Industrial Designs	13
2.3 Unity Models	15
2.4 Trade Marks	16
2.5 The Law Applicable to Industrial Property in Uganda	16
CHAPTER THREE	
ANALYSIS OF REFORM ISSUES	26
ANNEX 1 The Industrial Property Bill	49
ANNEX 2	
PUBLICATIONS OF THE UGANDA LAW	
REFORM COMMISSION	137

LIST OF FACTS AND CONVENTIONS.

ACTS, UGANDA.

1. Constitution of Uganda.
2. Patent Act, Cap. 216.
3. Trademarks Act, Cap. 217.
4. United Kingdom Designs (Protection) Act, Cap 218.
5. National Drug Policy and Authority Act, Cap, 206.
6. Uganda National Council for Science and Technology Act.,Cap. 209.

LEGISLATION - OTHER COUNTRIES.

1. South Africa Medicines and Related Substances Control Act No. 101 of 1965 (as amended by the Medicines and Related Substances Control Amendment Act, 1997).
2. Malaysia: Patents Act 1983, as amended by Patents (Amendment) Act, 2000.

LIST OF CASES.

1. Diamond V Chakrabarty 447 U.S. 303, 309 - 10 (1980).

CONVENTIONS.

1. African Regional Industrial Property Organisation Protocol.
2. General Agreement on Trade in Services. (GATS).
3. Paris Convention for Protection of Industrial Property, 1883.
4. Agreement on Trade Related Aspects of Intellectual Property. (TRIPs).
5. World Trade Organisation Agreement (WTO)1994.
6. The Patent Cooperation Treaty (PCT).
7. EC's Community Patents Agreement 1989.

ACRONMYS/ABBREVIATIONS.

AIDS	Acquired Immune Defecency Syndrome.
ARIPO	African Regional Industrial Property.
GATS	General Agreement on Trade in Services.
GATT	General Agreement on Tariffs and Trade.
GMO	Genetically Modified Organisms.
IPR	Intellectual Property Rights.
LDCs	Least Developed Countries.
NDA	National Drug Authority.
PCT	Patents Cooperation Treaty.
PEAP	Poverty Eradication Action Plan.
PMA	Plan for Modernisation of Agriculture.
SPEED	Support for Private Enterprise Expansion and Development.
TRIPS	Trade Related Aspects of Intellectual Property Rights.
ULRC	Uganda Law Reform Commission.
UDR	Unregistered Design Right.
UPOV	Union Internationale pour Protection des Obstentions Vegetales.
USAID	United States Agency for International Development.
USPTO	United States Patent and Trademark Office.
WIPO	World Intellectual Property Organisation.
WTO	World Trade Organisation.

PREFACE

Establishment of the Uganda Law Reform Commission.

The Uganda Law Reform Commission was established in 1990 by the Uganda Law Reform Commission Act, Cap. 25. Prior to this enactment, law reform was the responsibility of the department of law reform and law revision of the Ministry of Justice, which had been set up in 1975. In 1995, with the promulgation of the Constitution, the commission became a constitutional commission by virtue of article 248 of the Constitution.

Composition of the commission.

Under section 3 of the Uganda Law Reform Commission Act, Cap. 25, the commission consists of a chairman and six other commissioners, all of whom are appointed by the President on the advice of the Attorney General.

The chairperson and four of the commissioners are lawyers who are retired or sitting judges of the Court of Appeal or High Court of Uganda; or are lawyers qualified to be appointed as judges of the Court of Appeal or High Court of Uganda; or are senior practising lawyers or senior teachers of law at a university or similar institution of law in Uganda. The remaining two commissioners, as set out by section 4(2), are non-lawyers but persons who have distinguished themselves in disciplines relevant to the functions of the commission.

Additionally, section 12 empowers the Attorney General, on the advice of the commission, to appoint experts or consultants in any specific aspect of law reform undertaken by the commission.

The commission is serviced by a secretariat composed of an executive secretary and other staff. The commission has three departments which are: the law reform department, the law revision department and the department of finance and administration. The staff of the commission consists of lawyers and non-lawyers appointed by the Attorney General from among persons who are either public or non-public officers.

Functions of the commission.

The main function of the commission as set out under section 10 of the Uganda Law Reform Commission Act, Cap. 25 is to study and keep under constant review the Acts and other laws of Uganda with the view to the making of recommendations for their systematic improvement, development, modernisation and reform with particular emphasis on-

- (a) the elimination of anomalies in the law, the repeal of obsolete and unnecessary laws and the simplification and translation of the law;
- (b) the reflection in the laws of Uganda of the customs, values and norms of society in Uganda as well as concepts consistent with the United Nations Charter for Human Rights and the Charter of Human and Peoples' Rights of the African Union;
- (c) the development of new areas in the law by making the laws responsive to the changing needs of the society in Uganda;
- (d) the adoption of new or more effective methods or both for the administration of the law and dispensation of justice; and
- (e) the integration and unification of the laws of Uganda.

Powers of the commission.

In the performance of its functions, the commission may-

- (a) receive, review and consider any proposals for the reform of the law which may be referred to it by any person or authority;
- (b) prepare and submit to the Attorney General, from time to time, for approval, programmes for the study and examination of any branch of the law with a view to making recommendations for its improvement, modernisation and reform; and those programmes shall include an estimate of the finances and other resources that will be required to carry out any such studies and the period of time that would be required for the completion of the studies;
- (c) undertake, pursuant to any such recommendations approved by the Attorney General, the formulation of draft bills or other instruments for consideration by the Government and Parliament;
- (d) initiate and carry out, or, with the approval of the Attorney General, direct initiation and research necessary for the improvement and modernisation of the law;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (e) provide, at the instance of the Government, to Government ministries and departments and other authorities concerned, advice, information and proposals for reform or amendment of any branch of the law;
- (f) encourage and promote public participation in the process of lawmaking and educate and sensitise the public on lawmaking through seminars, publications and the mass media; and
- (g) appoint or empanel committees, in consultation with the Attorney General, from among members of the commission, or from among persons outside the commission, to study and make recommendations to the commission on any aspect of the law referred to the committees by the commission.

Profile of the commission.

Vision.

The vision of the commission is to promote, in Uganda, a legal system with just and up-to-date laws, easily accessible to all.

Mission statement.

To contribute to sustainable development, an equitable and just legal system through revision, harmonisation, development and reform of the law.

Values of the commission.

The commission-

- (a) seeks to be impartial at all times in all dealings with clients,
- (b) endeavours to operate with integrity and in a professional way,
- (c) is committed to equity and pragmatic diversity in the workplace,
- (d) respects and values the contribution of the people, and
- (e) endeavours to communicate consistently and effectively with its stakeholders in all its projects.

Slogan.

“Law reform for good governance and sustainable development”.

Justification for legal reform.

The Ugandan society, like all societies, is in a constant state of change caused by political, social and economic factors yet there have been few changes in the law since the inception of English law in Uganda in 1902. In addition, there are emerging cultural patterns and gender relations, new Government policies such as decentralisation, privatisation, economic liberalisation, poverty eradication, private sector development and the modernisation of agriculture. However, there have been few changes in the law yet the law, at any given time, has to effectively respond to social changes and to the aspirations of the people. There is need for extensive research including the need for wide consultations with stakeholders when proposing reforms in any area of the law.

Current members of the Uganda Law Reform Commission.

1. Professor Joseph Moll Nnume Kakooza.

Professor Kakooza is a holder of the degrees of B.C.L. and LL.B. of the National University of Ireland, Dublin; LL.M. (Harvard); M.Litt. and a Postgraduate Diploma in Anthropology of the University of Oxford; Certificate in International Relations, of the University of Oslo; Barrister-at-Law, of the Inner Temple, London and Advocate of the High Court, Uganda.

Professor Kakooza served as a lecturer at the Faculty of Law, University College, Dar-es-Salaam, as a senior lecturer and founding head (later twice dean) and finally Professor of Law at Makerere University. He has been a visiting scholar at Harvard Law School; guest lecturer at the college of criminal justice, Northeastern University Boston and visiting professor, College of Law, University of Florida. He is currently teaching law at Kampala International University and medical jurisprudence in the Faculty of Medicine, Makerere University, part-time. He is widely published, particularly in criminal justice and family law and he is a member of many professional organisations. He is listed in the international publication of *WHO IS WHO in Education* and was given the award of *MAN OF THE YEAR, 2003*, by the American Biographical Institute, Inc.

Professor Kakooza has, among other spells of public service, served as Ag. Judge of the High Court of Uganda, Ag. Solicitor General, President of Uganda

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

Industrial Court; and commissioner of law reform. He was acting chairman of the commission from 2000 to 2002 when he became the chairman.

He has been in charge of the Domestic Relations Law Project and Labour Laws Project. He is currently in charge of the Intellectual Property Law Project, the Reform of the Accountants Act Project, the Living Law Journal Project and the Sentencing Legislation Reform Project.

2. Ms. Percy Night Tuhaise.

Ms. Percy Night Tuhaise is a holder of the degrees of LL.B and LL.M of Makerere University, Kampala; a Postgraduate Diploma in Legal Practice of the Law Development Centre, Kampala. She also holds various certificates in human rights teaching and research (Ottawa Canada 1991), (Strasbourg, France, 1995). She is the deputy director and a principal lecturer of the Law Development Centre, Kampala. She is also an advocate of the High Court of Uganda. Ms Tuhaise was appointed a part-time commissioner in 1995. She assisted commissioner Kibuka in the Rape and Defilement Project. She has been in charge of the Business Associations cluster of the Commercial Law Project and Succession Law Project, and is currently in charge of the Codification of the Contracts Law Project under the Commercial Law Project II and Simplification of the Penal Code Act Project. She is also a member of the editorial board for law revision.

3. Mr John Mary Mugisha.

Mr. Mugisha holds the degree of LL.B of Makerere University and a Postgraduate Diploma in legal practice, LDC. He was appointed a part-time commissioner in 1999. He is a principal lecturer at the Law Development Centre, Kampala and an advocate of the High Court of Uganda. Mr. Mugisha is a former President of Uganda Law Society; Vice President of the East African Law Society; lead counsel for the Constitutional Review Commission; and deputy secretary general in charge of Eastern Africa, International Bar Association (IBA). He is also a member of the Law Council representing the Uganda Law Society. Mr. Mugisha has been the commissioner in charge of Secured Transactions and Fair Trade Clusters of the Commercial Law Reform Project. He is currently in charge of subsidies and countervailing measures,

UGANDA LAW REFORM COMMISSION

under the Commercial Law Reform Project II and Trial Procedures Reform Project under the Criminal Law Reform Project I.

4. Dr. Lillian Tibatemwa-Ekirikubinza.

Dr. Tibatemwa-Ekirikubinza is a holder of a PhD in law from the University of Copenhagen, Denmark; an LLM in Commercial Law from the University of Bristol, UK; an LL.B (Hons) degree from Makerere University and a Postgraduate Diploma in Legal Practice from the Law Development Centre, Kampala. She was the deputy dean of the Faculty of Law, Makerere University and is currently the Deputy Vice Chancellor in charge of academic affairs at Makerere University and a part time commissioner of the commission since 1999.

Dr. Tibatemwa-Ekirikubinza is widely published in areas of women's law; children's rights and constitutionalism. Her publications include "*Women's Violent Crime in Uganda: More Sinned Against Than Sinning*" (1999). Her latest publication is entitled "*Gender and Human Rights: A Case Study of Polygamy Among the Basoga of Uganda*" (2003).

Apart from being a commissioner of the Uganda Law Reform Commission where she has been in charge of various projects namely: the Insolvency Cluster of the Commercial Law Reform Project I, the Domestic Violence Project, the E-Commerce, Computer Crime and E-Evidence Project under the Commercial Law Reform Project II. Dr Tibatemwa-Ekirikubinza has also held other positions of responsibility among which are: board member of the Uganda National Bureau of Standards, member of the academic board of Makerere University Business School, Nakawa and a complimentary member of the British Institute of International and Comparative Law.

Former members of the Uganda Law Reform Commission.

1. Justice Sir Harold G. Platt.

Justice Sir Harold Platt is a holder of MA of Oxford University after his first degree in India. He retired but was actively involved in various aspects of the legal field. He served in various capacities in East Africa including: Chairman

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

Uganda Law Reform Commission 1994 -2000, where he was in charge of the Commercial Law Project among others; judge of the Supreme Court of Uganda 1989-1994, judge of the High Court and Court of Appeal Kenya 1968-1989; Government service, provincial magistrate Tanzania 1962-1972, colonial legal service Tanganyika 1954 -1962 and in legal practice 1951-1954. Justice Sir Harold Platt was called to the Bar in 1952 after serving in the royal air force from 1942-1947.

2. Professor Eric Paul Kibuka.

Professor Kibuka holds a B.A and PhD of Makerere University. He was a director of the United Nations African Institute for the Prevention of Crime and Treatment of Offenders, Kampala. He was appointed a part-time commissioner in 1995. He is a retired lecturer of sociology at Makerere University. Professor Kibuka was in charge of the Rape and Defilement Law Project. He was also in charge of the Decriminalisation of Petty Offences Project as well as the Contracts Law Project.

3. Ms. Hilda A. Tanga.

Ms. Tanga is a holder of a B.A degree in education and a postgraduate diploma in Human Resources Management. She has been a graduate teacher at Kololo S.S.S; lecturer in business communication at the National College of Business Studies; Ag. registrar and deputy academic registrar at the Uganda Polytechnic Kyambogo. Ms. Tanga has also been an adhoc consultant with Management Training and Advisory Centre (MTAC) on management and training of trainers. She is currently an examiner with the Uganda National Examinations Board (UNEB) and National Business Examinations Council (Nakawa).

4. Ms. Filda Mary Lanyero Ojok.

Ms. Mary Lanyero was a senior lecturer and dean of the Faculty of Arts, Institute of Teacher Education, Kyambogo. She is also involved with various non-governmental organisations in various capacities. Ms. Lanyero holds certificates from the American Studies Winter Institute, USA. She holds a masters degree in international relations, Carleton University Ottawa, Canada

UGANDA LAW REFORM COMMISSION

and a B.A of Makerere University majoring in history and literature in English. Ms. Lanyero was a teaching assistant, University of Carleton, Ottawa Canada.

5. Mr. Francis Butagira.

Mr. Butagira was appointed commissioner on 22nd January 1996. He holds the degrees of LL.B Makerere University and LL.M (Harvard). He is an advocate of the High Court of Uganda and former principal lecturer at the Law Development Centre.

6. Mr. Richard Aboku Eryenyu.

The late Richard Aboku Eryenyu served as commissioner from 19th January 1996 until his death on 7th April 1999. He was an LL.B graduate of Makerere University and a chief magistrate.

EXECUTIVE SUMMARY.

1. Background.

The law applicable to industrial property in Uganda, is the Constitution of Uganda; the United Kingdom Designs (Protection) Act, Cap.218; the Uganda National Council for Science and Technology Act, Cap. 209; the National Drug Policy and Authority Act, Cap. 206; the Trademarks Act, Cap. 217 and the Patents Act, Cap.216 which provides for the grant, registration and protection of patents. This law came into force on the 15th October 1993, by virtue of the Patents Act (Commencement) Instrument 1993, SI No.70.

An effective, investment-oriented intellectual property system depends on comprehensive substantive laws in addition to having adequate judicial and administrative components. Substantive laws include the legal tools of copyright, patents, trademarks, trade secrets and a few other special forms of intellectual property protection.

A national intellectual property regime which works well serves public welfare by upgrading the technical base of the country, preparing the ground for creation and exchange of advancing technology, and fostering greater human resource development in technical fields. In short, the stimulus to expanding a country's stock of technical knowledge is materially increased and the stimulus to investment in useful development of that knowledge is, likewise, increased. The existing intellectual property laws fall far short of sustaining a working intellectual property regime.

2. Justification for reform of industrial property law.

The need to repeal and replace the Patents Act, with a new industrial property law arises from the failure of the existing law to stimulate the upgrading of the technical base of the country, prepare the ground for creation and exchange of advancing technology and foster greater human resource development in technical fields.

UGANDA LAW REFORM COMMISSION

A multiplicity of developments in intellectual property law on the international scene including a number of treaties to which Uganda is a party also call for reform of the industrial property law. Uganda is a party to the Paris Convention for the protection of industrial property, yet the current law on industrial designs in Uganda is not compliant with this Convention. A number of provisions of the Patents Act relating to the expiry of patents, proceedings for the forfeiture of patents or their revocation, and application and grant of compulsory licenses are inconsistent with this convention.

Further regarding industrial designs, Uganda does not have specific legislation providing for a procedure to process granted designs or a way through which the registry can process an application for a design or register an industrial design in Uganda. The United Kingdoms Designs (Protection) Act, Cap. 84 provides for the protection of industrial designs granted in the United Kingdom. There is no registration done in the patents registry of an industrial design.

The Patents Cooperation Treaty (PCT) provides for international patent applications. Uganda acceded to it on the 9th of February 1995. Therefore any applicant from a member country can designate Uganda and Ugandan investors can designate PCT member countries in their own applications under the PCT.

Uganda has drafted an amendment to the Patents Act, which was recently passed into law. This means that the procedure on international applications for patents is operational and Uganda is a designated country.

As a member of the World Trade Organisation, Uganda is required to amend her intellectual property legislation to conform to the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement). Article XVI.4 of the Agreement establishing the World Trade Organisation provides that each member state shall ensure that its laws and regulations are brought into conformity with its obligations under the agreements.

Specifically regarding industrial property, the relevant parts of the TRIPS Agreement are Part II - 2 on trade marks, 3 on geographical indications, 4 on Industrial Designs, 5 on Patents.

Under the TRIPS regime, the reform of intellectual property has to strike a balance between protecting and respecting the rights of industrial property holders particularly holders of patents, and public interest concerns particularly those on access to essential drugs for a least developed nation like Uganda which is affected by diseases like malaria and HIV/AIDS. The issues of food security also have to be addressed in the reforms. The exceptions built in the law therefore have to address the above-mentioned concerns in an equitable manner.

There have been new developments in the multilateral trading system arising out of the recently concluded ministerial conference in Qatar-Doha. The public health declaration particularly has an impact on the reforms of patent law in Uganda, as it addresses issues of access to essential drugs, compulsory licensing and specifically patenting of pharmaceuticals in least developed nations like Uganda.

The reforms required to be effected on the Patents Act are quite extensive, warranting a total repeal of the law and its replacement with a new law on industrial property.

3. Objectives of the study.

The objectives of the study were to-

- (a) examine the efficacy of the existing industrial property in stimulating the upgrading of the technical base of the country, its capacity to stimulate creation and exchange of advancing technology and foster greater human resource development in technical fields;
- (b) propose amendments and where necessary new legislation e.g. trade secrets, geographical indications, to update Uganda's law to conform

to her development needs and international obligations, under among others, the TRIPS Agreement;

- (c) carry out a comparative analysis with foreign jurisdictions in their experience in updating domestic legislation to conform to development needs and international obligations;
- (d) examine the need to strengthen the enforcement of Uganda's intellectual property rights in order to encourage investment and invention; and
- (e) to create awareness of intellectual property rights.

4. Methodology.

The project was to be carried out with the help of a consultant. Mr. Michael Hathaway of Nathan Associates (the consultancy) from the United States was contracted by the USAID. Unfortunately because of his heavy schedule, the work could not progress as fast as it was planned, and it stalled until August 2001, when another consultant, Mrs. Judy Goans, was contracted to carry on the project.

The commission, in consultation with the consultant and the Private Sector Trade Policy Capacity Building Project ("the project coordinators"), identified specific stakeholders with a range of expertise and with access to relevant networks of other experts to constitute the taskforce on intellectual property laws.

The task force was composed of-

- (a) Ministry of Tourism, Trade and Industry;
- (b) Ministry of Justice- Attorney General;
- (c) Ministry of Foreign Affairs;
- (d) Ministry of Agriculture, Animal Industry and Fisheries;
- (e) Uganda Revenue Authority;
- (f) Uganda Law Reform Commission;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (g) Uganda National Council for Science and Technology;
- (h) Uganda Law Society;
- (i) Uganda Investment Authority;
- (j) Faculty of Law - Makerere University, Kampala;
- (k) Judiciary – Commercial Court;
- (l) Law Development Centre;
- (m) Registrar General’s department;
- (n) Private Sector Foundation;
- (o) Support for Private Expansion, Enterprise and Development (SPEED);
- (p) Uganda Broadcaster’s Association;
- (q) Non Governmental Organisations’ representative;
- (r) Inter-University Council of East Africa;
- (s) Coalition for Health and Social Development;
- (t) Uganda Manufacturer’s Association;
- (u) Uganda Musician’s Union; and
- (v) Uganda Performing Artists Society.

The commission developed terms of reference for the task force and the taskforce would meet to consider the work presented by the consultants which was debated and agreed upon. In addition, members of the taskforce were invited by the commission to consult the various stakeholders they represented to come up with a widely accepted law.

From the consultations, ideas were collected from which the commission together with the consultant came up with draft background papers from which issues were developed and reviewed by the task force. The comments were incorporated in the final background papers. A consultative workshop with stakeholders was organised to review the recommendations and the resulting draft bills produced as a result of the work of the consultant and task force.

4.1 Scope of work.

The scope of work covered the following-

- (a) consulting stakeholders on Uganda's intellectual property laws;
- (b) reviewing and recommending for amendment or repeal of the existing legislation, or the introduction of new legislation by way of draft bills; and
- (c) preparing a detailed memorandum explaining the clauses in the draft bills.

Much as some significant work was done by the consultants, it was the considered view of the commission that further consultations with the different stakeholders were necessary so as to determine the policy to be followed in order to come up with background papers to the draft bill.

5. Summary of recommendations.

- (a) Non-patentable inventions. Non-patentable inventions should be provided for in the law in light of Article 27(2) and (3) of the TRIPS agreement.
- (b) Co-ownership of patents. The law should also provide for co-ownership of the patents in situations where parties have jointly made an invention or where inventions have been made independently of each other.
- (c) Term of patent. The term of a patent be extended to 20 years in light of Article 33 of the TRIPS Agreement.
- (d) Exemption of pharmaceuticals. Pharmaceuticals be exempted from being patented until January 2016.
- (e) Protection of living matter. In addition the new law should provide for patents relating to living matter, where an invention concerns a micro-biological process or product thereof and involves the use of micro-organisms not available to the public.
- (f) Unauthorised applications. The law should also cover situations of unauthorised applications based on the invention of another person, and inventions made in execution of a commission or by an employee.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (g) Grant of licences. Provisions should be made to the effect that in the absence of any provision to the contrary a licensor may grant further licenses to use the invention unless the licence granted is exclusive.
- (h) Publication of applications in Uganda.
There should be provision for the publication of the application for a patent in the Gazette or a proposed Industrial Property Journal.
- (i) International search. Applications should be subjected to an international type search where the application is found in order to form, or ascertain whether or not the subject of the application or any claim or claims is an invention.
- (j) Exploitation by Government. Provision for the exploitation of patented inventions by the Government or a third party authorised by the government be revised to conform to the terms of the TRIPS Agreement.
- (k) Parallel imports. Parallel importing be allowed for in the law as a good option for Uganda. It may well be the best way to improve access to essential drugs because of limited local capacity to produce and undertake drug manufacturing.
- (l) Regulation of Industrial designs. Provision be made for regulation of Industrial designs.
- (m) Regulation of Technovations. The new industrial property law should introduce regulations on technovations. Issues to be considered are the right to a technovation certificate, use of the technovation, and the remuneration of the person who came up with the technovation.
- (n) Examination. Provision should be made for examination to be done by the industrial property office and the National Council for Science and Technology.
- (o) Liability of officers. Officers of the industrial property office be protected from personal liability in the performance of their duty, bonafide. However, this should not relieve the registrar of liability.

CHAPTER ONE

INTELLECTUAL PROPERTY

Intellectual property is a branch of law that protects property interests in intangible things. The protection of intellectual property is based on two basic principles -

- (a) that it is beneficial to society to encourage the disclosure of new developments, and
- (b) that it is beneficial to society to ensure honest dealing.

Intellectual property offers a means for promoting progress by protecting rights in new creations of the mind. It also contributes to the strength of the market by prohibiting dishonest practices among merchants. Intellectual property protects both economic and non-economic rights in creative works.

1.1 Historical background.

The role of intellectual property as a means for promoting development has been recognised since ancient times. Near the end of the third century B.C., the Greek historian Phylarchos wrote that the rulers of the Greek City Sybaris issued patents for new foods.¹ The patent was a refinement on the more common incentive of awarding a prize. The ancient Greeks held contests to recognise and reward a wide range of achievements. The Olympic games represented one such contest, but the Greeks also held contests to reward the writing of tragedies and comedies, painting, poetry, sculpting and pottery-making; the production of superior agricultural products; and skills in the field of medicine and surgery.²

¹ Lipscomb's Walker on Patents 7 (1984) (hereinafter Lipscomb).

² Skoyles, John R., Leviathan, ch. 2, <http://www.skoyles.greatxscape.net/lv2.html>

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

Trademark law has even more ancient origins. Businesses have used signs to identify their services, and artisans have used marks to identify their goods, for thousands of years. Drawings in Egyptian tombs show workers branding cattle, and quarry marks have been found on Egyptian structures dating from 4000 B.C.³ In ancient Greece, potters signed their works, initially with the mark of their clans and later with their own names.⁴ Laws regulating business practices also have ancient origins. The book of Deuteronomy, written around 700 B.C.⁵, contains the injunction, “You shall not have in your bag two kinds of weights, large and small. You shall not have in your house two kinds of measures, large and small. You shall have only a true and honest weight; you shall have only a true and honest measure. . . .”⁶

Intellectual property continued to develop as governments, regardless of political ideology, offered inducements to authors and inventors either to create something new or to bring some desirable knowledge into the realm. The transfer of technology was promoted by offering “patents of introduction” to encourage artisans to bring a new skill into the region. In Europe, artisans banded into guilds, which enforced standards to be met by their members, and guild marks became recognised as indications of quality.

By the Nineteenth Century, the intellectual property system in Europe had largely developed into the form in which we know it today. The two major treaties in the field of intellectual property were adopted during that period, namely, the Paris Convention for the Protection of Industrial Property, adopted on 20 March, 1883 and the Berne Convention for the Protection of Literary and Artistic Works, adopted on 9 September 1886.

³ McCarthy on Trademarks and Unfair Competition 3d §5.01.

⁴ Skoyles, op.cit.

⁵ Bradshaw, Robert I., Deuteronomy, <http://www.robibrad.demon.co.uk/deut.htm> (1998). Other authors dopt dates ranging from approximately 1450-950 B.C.

⁶ Holy Bible, Deuteronomy 25:13-15.

Over the next century, improvements in trade and communications prompted calls for the nations of the world to harmonise their intellectual property laws and develop international norms to which they would jointly agree. Regional industrial property offices, such as the African Regional Industrial Property Office promoted cooperation in securing protection for intellectual property. Other regional agreements established a common set of principles to which members agreed. Such arrangements were undertaken by Andean nations under the Cartagena Protocol, by the European Union, and by Mexico, Canada, and the United States under the North American Free Trade Agreement. Efforts to harmonise intellectual property laws also took place under the auspices of the World Intellectual Property Organisation (WIPO), while the development of international norms was taken up in the Uruguay Round of the GATT. The most comprehensive of such provisions are embodied in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), an annex to the Agreement Establishing the World Trade Organisation.

1.2 Intellectual property and national economic development.

Intellectual property has historically been used to promote economic development. At the microeconomic level, patents, copyright, and similar forms of intellectual property provide a means by which innovators and investors can recover the investment of time and money needed to bring a new product to the market. Such incentives are offered to encourage disclosure.

To obtain a patent, an inventor is required to make a technical disclosure that would allow other persons who are skilled in the relevant area of technology to make and use the invention. That disclosure ensures that, at the end of the patent term, anyone with the relevant technical skills will be able to use the invention. It also makes that knowledge available to others who would build on it. This is important to economic development, because economists who have studied the subject have found that long-term economic

growth is largely due to technological change.⁷ In one such study, the Economics Nobel Laureate Professor Robert Solow of the Massachusetts Institute of Technology looked at economic output in the United States and concluded that the bulk of the increase was the result of technological advances.⁸

The other major theme of intellectual property is ensuring honest dealings. Honest dealings between merchants, and honest dealings between a merchant and the consumer. The Paris Convention refers to this aspect of intellectual property as “the repression of unfair competition.” Preventing dishonest and deceptive practices, and offering an effective remedy when such practices occur, is essential to promote economic growth. The lack of such protection slows sales, as consumers are much more cautious about their purchases when they lack confidence in merchants and know that they have no assurance of a remedy if goods are not as promised. Assuring such protection also makes it less difficult to establish new businesses, particularly in regard to some of the most profitable merchandise, since distrustful consumers are reluctant to take a chance on an unknown vendor. Finally, it is difficult for merchants to establish a reputation for honesty and quality if the market permits such acts of unfair competition as trademark infringement, palming off goods as those of another or falsely disparaging a competitor. This can be seen most clearly in cases of trademark counterfeiting. In some cases, the manufacturer of a quality product may learn of the existence of counterfeit products from the complaints of disappointed consumers, who have purchased a counterfeit item in the belief that it was genuine.

⁷ Mansfield, Edwin, “Intellectual Property Rights, Technological Change, and Economic Growth,” Walker, Charles E., and Bloomfield, Mark A, eds., *Intellectual Property Rights and Capital Formation in the Next Decade* 5-6, American Council for Capital Formation Center for Policy Research (University Press, Lanham, MD, 1988).

⁸ Prof. Solow studied the nonfarm economy during the period 1909-1949 and concluded that the bulk of the increase, other than that due to increasing population and consequent increasing work force. Walker and Bloomfield, *op. cit.* at 100.

At a macroeconomic level, intellectual property promotes economic development by encouraging domestic innovation and foreign direct investment. Foreign direct investment represents a major source of technology transfer and the intellectual property system creates a framework in which developing countries can participate jointly in the economic activities of the developed world.

The relationship of strong intellectual property protection and economic development was shown in a study for the World Bank by the eminent economist Dr. Edwin Mansfield. He surveyed 100 major U.S. firms in six manufacturing industries to determine the importance of intellectual property protection in influencing whether or not the firm would make various types of direct foreign investments. The high percentage of these firms indicates that intellectual property protection has a major effect on their foreign direct investment decisions.

1.3 International aspects.

In April 1994, Uganda signed the agreement establishing the World Trade Organisation (WTO) and ratified the same in October 1994. By 31st December 1994 Uganda had fulfilled all the conditions necessary to become a founder member of the WTO. Given Uganda's obligations under the WTO, there is a great need to bring the current legislation in line with the international commitments to which Uganda is bound.

All WTO Agreements are essential and of immediate concern to Uganda, even though the degree varies from one agreement to the other. The different agreements give varied time frames within which member countries are expected to implement them. However, Uganda, belonging to the group of least developing countries, benefits from the special and differential clauses that give longer periods for the application of particular agreements or not being required to implement certain provisions of the agreement because of the additional burden, in form of resource requirements needed to implement these agreements, and the possible effect on the infant and non-competitive industries.

Given Uganda's obligations under the WTO, there is a great need to bring the current legislation in line with the international commitments to which Uganda is bound. As clearly stated in the Business Guide to The Uruguay Round,⁹

“The multilateral legal instruments resulting from the Uruguay Round are treated as a single undertaking. All WTO member countries are required to adopt national legislation and regulations to implement the rules prescribed by GATT 1994 and its associate agreements, GATS (General Agreement on Trade in services) and the agreement on TRIPS (Trade Related Aspects of Intellectual Property Rights)”

and it goes on to state that

“...The single undertaking rule has automatically made all WTO members, including developing countries and transitional economies, parties to the associate agreements and other multilateral agreements.”

The situation as it stands is that by virtue of being a signatory to the WTO, Uganda is bound to fulfil specific obligations, which have a bearing on its domestic legislation. Thus the legal regime with regards to commercial laws is affected, and in particular legislation related to trade related aspects of intellectual property rights.

Article XVI.4 of the Agreement establishing the WTO provides that each member state shall ensure that its laws and regulations are brought to conform to its obligations, under the Agreements. Some of the obligations, rights and benefits can only be accessed and taken advantage of only with the correct legal framework in place. Given the complexity and number of legislation involved and the need for a comprehensive review of the listed legislation; the commission is desirous of contracting one consultant, being a lawyer with specialised training in intellectual property rights, with special emphasis on the TRIPS Agreement.

Under the obligations as set out in the WTO agreements, longer transitional periods were provided for developing countries to implement the obligations under the TRIPS agreement.

⁹ Business Guide to the Uruguay Round published by the International Trade Centre UNCTAD/WTO and the Common Wealth Secretariat, 1996. At page 15

It is important to note that the WTO conference in Seattle, USA at the end of 1999 presented developing economies their last hope of obtaining further extensions on the grace periods in implementing the TRIPS Agreement. That meeting was however frustrated for many reasons, the end result being that no substantive talks were carried out and the binding positions remained. Thus the greater need to amend the legislation related to TRIPS and develop new legislation to ensure that Uganda's legal regime conforms to her international obligations.

The need for the amendment and development of the TRIPS - related laws in Uganda cannot be overstated. The need for strong and globally uniform laws directly affects investor confidence in a country's economy. In the business guide to The Uruguay Round,¹⁰ it is accurately stated that "...Industries and trading organisations were complaining that because of differing national standards for the protection of intellectual property rights, such as patents and trademarks... trade in counterfeit goods was on the increase." The effect of increased trade in counterfeit goods is that legitimate business is discouraged and investor interest wanes. This fact in the wording of the WTO is stated thus; "The absence of adequate protection was also considered a deterrent to foreign investment in the production of patented goods and a reason for the reluctance of industries in developed countries to sell or license technology to industries in developing countries."¹¹

At present by virtue of being signatory to the WTO, Uganda is bound to fulfil specific obligations, which have a bearing on its domestic legislation. Thus the legal regime with regards to commercial laws is affected, and in particular legislation related to Trade Related Aspects of Intellectual Property Rights (TRIPS). There is, thus, great need to amend the legislation related to TRIPS and to develop new legislation to ensure that Uganda's legal regime conforms to her international obligations.

¹⁰ Ibid, at Page 3.

¹¹ Op Cit.

1.4 Cautionary note.

It must be noted that the above outlined support for promotion of compliance with the TRIPS Agreement must be accompanied by measures that address public interest challenges such as health, nutrition and environmental conservation in a least developed country like Uganda. To address these issues requires policy and institutional innovations in the developed and developing countries. While some of the measures can be addressed through multilateral forums, many of them should be addressed through domestic laws and policies, which should be designed to foster innovation and expand international trade.

In this context, it must be noted that the agreement recognizes the role of technology in social and economic welfare and sets out its objectives in Article 7 as-

“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.”

While, as argued above, “public disclosure leads to fewer patent applications and fewer innovations, and only for a given number of innovations will it raise the probability that new technologies will reach the product market and thereby enhance consumers’ surplus and possibly total welfare as well¹², for developing countries the concerns go beyond harmonization and are largely about access to technology.¹³

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- 12 Aoki, R. and Spiegel, Y. 1999. Public Disclosure of Patent Applications, R&D, and Welfare. Working Paper No. 30-99. The Foerder Institute for Economic Research, Tel-Aviv University, Israel.
- 13 These issues are part of a larger developing country multilateral trade agenda. For a review of the issues, see The South Centre 1998. The WTO Multilateral Trade Agenda. The South Centre, Geneva; The South Centre 1999. Issues Regarding the Review of the WTO Dispute Settlement Mechanism. The South Centre, Geneva.

UGANDA LAW REFORM COMMISSION

Nations that generate technology have always sought to protect it while those that import it have pursued avenues that maximize access to the available technology.¹⁴ Nations seeking to develop technologically have often imitated and learned from those already possessing the knowledge. For example, when “the United States was still a relatively young and developing country, it refused to respect international intellectual property rights on the grounds that it was freely entitled to foreign works to further its social and economic development.”¹⁵ The history of intellectual property protection in pharmaceutical products demonstrates this point. Many of the industrialised countries introduced patent legislation in this field after they had reached a certain level of technological competence and international competitiveness.¹⁶ More recently, technological learning has provided the policy basis for rapid industrialisation among developing countries.¹⁷ These countries have favoured policies and laws that promote the local working of patents, parallel imports, compulsory licensing and exclusion from patentability for certain classes of technologies. The new law must therefore not affect Uganda’s ability to use technological knowledge to promote public interest goals such as health, education, nutrition and environmental conservation.

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- 14 For a review of the negotiating history, see Yusuf, A.A. 1998. “TRIPs: Background, Principles and General Provisions,” in Correa, C.M. and Yusuf, A.A., Intellectual Property and International Trade: The TRIPs Agreement. Kluwer Law International, London.
 - 15 Office of Technology Assessment 1986. Intellectual Property Rights in an Age of Electronics Information. US Government Printing Office, Washington, DC, p. 228.
 - 16 France and Germany introduced pharmaceutical patent laws in 1960 and 1968 respectively while Japan and Switzerland acted in 1976 and 1977 respectively with Italy and Sweden joining them in 1978.
 - 17 Kim, L. 1997. Imitation to Innovation: The Dynamics of Korea’s Technological Learning. Harvard Business School Press, Cambridge, USA.

CHAPTER 2

INDUSTRIAL PROPERTY.

Traditionally, industrial property has been known to include patents, utility models, industrial designs and trademarks. Of late technovations have been included within the scope of industrial property.

A patent is a Government grant of exclusive rights in the invention for a limited period of time to prevent others from making, using, selling his or her invention. At the end of the patent term, any person is free to use the invention. The disclosure required by the patent system enables the public to learn how to exploit the invention, which can be done freely after the end of the patent term.

Patents are usually promoted as mechanisms for improving the technological development in a given area, and to help innovators to raise enough funding to make products from their ideas. Patent law is not some kind of natural law, but a mechanism used by societies to improve the rate of technological development, and to ensure that important techniques are disclosed so that they can be incorporated to the public knowledge base.

However, those benefits do not come for free: they have many costs for the society, mainly in terms of economic inefficiencies, and of inaccessibility to new technologic devices for large parts of the population. These costs come from the fact of granting some individual or company the monopoly on the commercial use of the patented technique.

The effect of monopolies, however 'limited', in economy is well studied by economists, and their impact on both technological and economical development can be really hazardous. The holder of a patent or collection of related patents can block the development of whole branches of a given technology, or impose licensing schemes which forces manufacturers to sell their products at prices not suitable for large sectors of the society.

Despite those negative effects, in certain sectors the positive effects of patents can outweigh them, being the overall effect positive for the society. Therefore, the problem always to be decided is whether in each specific claim for a patent, this balance is positive or negative. Society should be interested in having patents only in the case that their benefits are clearly shown, and when measured, they are of enough importance to make a positive result. Only in that case should society consider the possibility of forbidding individuals and companies to use freely the techniques they want the way they want, i.e. by forcing them to license patents.

Patent law must therefore encourage public disclosure of inventions that result from research and development. In exchange for the limited monopoly, the inventor must effectively disclose how to make and use the invention to the public, which facilitates further technological advances.

Industrial designs are another form of protection for inventions that are related to the concept of patents. An industrial design is the ornamental or aesthetic aspect of an article that gives a special appearance to the article. An industrial design is any composition of lines or colours that serves as a pattern for a product of industry or handicraft. It may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or colour. In some countries, industrial design registration may be used to protect trade “dress.” An industrial design is generally protected if it is new or original and not dictated solely by technical or functional features.

Utility models protect industrial innovations of less importance than those that are a subject of a patent. Novelty is generally a requirement for a utility model registration, but no inventive step is required.

Technovation, on the other hand, refers to a solution to a specific problem in the field of technology, proposed by an employee of an enterprise for use by that enterprise and which relates to the activities of the enterprise but which has not been used by the enterprise in question.

Exclusion of trademarks. It should however be noted that Uganda proposes to exclude trademarks from the proposed industrial property law framework, and have only patents, industrial designs, utility models and technovations to be consolidated into one industrial property law. Trademarks will be handled in a separate law because there is already a law in Uganda, which is being implemented and only requires modest reforms. Further, trademarks is a broad and quite complex area of intellectual property. Consolidating it with the rest of the other industrial property laws would not only create confusion, but it would be too bulky and complicated to follow and implement.

2.1 Patent law.

Until 1991, Uganda's Patent Law provided for registration of UK patents in Uganda. This Act was repealed in 1991 by the Patent's Act, Cap. 216. The Patents Act recognizes patents granted under the Harare Protocol, which is administered by the African Regional Industrial Property Organisation (ARIPO). It permits the registration of ARIPO patents and patents issued by other member countries with minimal examination.

2.2 Industrial designs.

The United Kingdom (Protection) Ordinance of 1937, as amended in 1962 provides that UK design registration automatically extends to Uganda. There is no local registration requirement, and there is no provision in Uganda for independent design registration. Uganda law does not provide any design registration mechanism, or any protection for unregistered designs.

Industrial designs are applied to a wide variety of products of industry and handicraft: from technical and medical instruments to watches, jewellery, and other luxury items; from house wares and electrical appliances to vehicles and architectural structures; from textile designs to leisure goods.

To be protected under most national laws, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied.

(1) Why protect industrial designs.

Industrial designs are what make an article attractive and appealing. Hence, they add to the commercial value of a product and increase its marketability. In turn, this contributes to the expansion of commercial activities and the export of national products.

When an industrial design is protected, the owner – the person or entity that has registered the design – is assured of an exclusive right against unauthorised copying or imitation of the design by third parties. This helps ensure a fair return on investment. An effective system of protection also benefits consumers and the public at large, by promoting fair competition and honest trade practices, encouraging creativity, and promoting more aesthetically attractive products.

Protecting industrial designs helps economic development, by encouraging creativity in the industrial and manufacturing sectors, as well as in traditional arts and crafts. Industrial designs can be relatively simple and inexpensive to develop and protect. They are reasonably accessible to small and medium sized enterprises as well as to individual artists and craftsmen, in both industrialised and developing countries.

(2) Protection of industrial designs.

In most countries, an industrial design must be registered in order to be protected under industrial design law. As a general rule, to be registrable, the design must be “new” or “original”. Different countries have varying definitions of such terms, as well as variations in the registration process itself. Generally, “new” means that no identical or very similar design is

known to have existed before. Once a design is registered, a registration certificate is issued. Following that, the term of protection is generally five years, with the possibility of further periods of renewal up to, in most cases, 15 years.

Depending on the particular national law and the kind of design, an industrial design may also be protected as a work of art under copyright law. In some countries, industrial design and copyright protection can exist concurrently. In other countries, they are mutually exclusive: once the owner chooses one kind of protection, he or she can no longer invoke the other.

Under certain circumstances an industrial design may also be protectable under unfair competition law, although the conditions of protection and the rights and remedies can be significantly different.

(3) How extensive is industrial design protection.

Generally, industrial design protection is limited to the country in which the protection is granted. Under the Hague Agreement concerning the International Deposit of Industrial Designs (a treaty administered by the World Intellectual Property Organisation - 'WIPO') a procedure for an international registration is established. An applicant can file a single international deposit either with WIPO or the national office of a country which is a party to the treaty. The design will then be protected in as many member countries of the treaty as the applicant wishes.

2.3 Utility models.

The Patents Act, Cap. 82 which was repealed by Act No. 10 of 1991 did not provide for utility models. The Patents Act however provides for grant of a certificate for utility models. An eligible invention for grant of a utility model is that which is new and industrially applicable. There is no requirement for an inventive step. The other procedures are similar to those for patent applications under the Act a utility model is protected for a seven-year period and is not renewable.

2.4 Trademarks.

The Trademarks Act, Cap. 217 provides for the registration of trade marks in Uganda. However a number of proposals have been made to enable the Act promote trade and investment and comply with the international standards commitments. (see Uganda Law Reform Commission Trademarks report publication No. 15 of 2004.)

2.5 The law applicable to industrial property in Uganda.

(1) The Constitution of Uganda 1995.

Objective number XI (ii) of the Constitution provides that the state shall stimulate agricultural, industrial, technological and scientific development by adopting appropriate policies and the enactment of enabling legislation.

Furthermore, objective number IX provides that in order to facilitate rapid and equitable development, the State shall encourage private initiative and self-reliance.

(2) Patents Act, Cap. 216.

The Patents Act provides for the grant, registration and protection of patents. This law came into force on the 15th October 1993, by virtue of the Patents Act (Commencement) Instrument 1993, Statutory Instrument No.70. This law recognises patents granted to a person under the Harare Protocol administered by ARIPO and in respect of which Uganda is a designated state.

This law also governs the grant of utility model certificates.

(3) United Kingdom Designs (Protection) Act, Cap. 218.

This Act provides for the protection in Uganda of designs registered in the United Kingdom. Under the Act, an innocent infringer of a registered design

is not liable for damages. Under the Act, there is no local registration requirement, and there is no provision in Uganda for independent design registration. The law does not provide any design registration mechanism, or any protection for unregistered designs.

(4) Uganda National Council for Science and Technology Act, Cap. 209.

This Act establishes the National Council for Science and Technology. The functions of the council include protecting intellectual property through appropriate patent laws and operating a national patent office. Further functions of the council include assisting in the promotion and development of indigenous science and technology through carrying out of scientific and technological research and development, technology transfer and adaptation, establishment of research and experimental development institutions, scientific and technological documentation and information services and encouragement of local innovations by providing more rapid and less costly incentives and programming integrated and co-ordinated science and technology activities.

The National Council for Science and Technology is therefore a key institution in the promotion of inventive and innovative activities and facilitating the acquisition of technology. It is meant to share responsibility with the Ministry of Justice and Constitutional Affairs by examining applications for industrial property rights for compliance with technology requirements. However, this goal of shared responsibility is yet to be met.

(5) National Drug Policy and Authority Act, Cap. 206.

This Act establishes a National Drug Policy and a National Drug Authority (NDA or “the Authority”) to ensure the availability at all times of essential, efficacious and cost effective drugs to the entire population of Uganda as a means of providing satisfactory health care and safeguarding the appropriate use of drugs.

Approval must be sought from the NDA in order to import pharmaceuticals into Uganda. Importers must apply to the NDA for registration and certification under the Act. The NDA has to ensure that drugs of quality, and which provide satisfactory health care to Ugandans, are supplied. The importation or sale of a patented drug domestically must comply with the requirements of the Act, particularly the objectives of the National Drug Policy, which are implemented by the NDA. Under the Act, the NDA must ensure that drugs which are unwholesome or adulterated or which do not conform to the prescription under which they are supplied are not supplied. Adulteration of drugs generally questions the patentability of the drug. If it is a proprietary drug, and NDA may help to detect an infringement of an existing patent holder's rights. The NDA may prohibit the sale of a drug if it is not satisfied with the information furnished or finds the drugs to be a danger to the health of a user, or if the description of the drug differs from the drug.

The NDA is empowered to scientifically examine any drug for purposes of ascertaining its efficacy, safety and quality. NDA is further empowered to register a product or the process for the making of a product if it is satisfied that the drug or preparation in respect of which the application is made has not previously been registered and that the use of the drug or preparation is likely to prove beneficial.

Although the National Drug Policy and Authority Act has valuable provisions covering the determination of essential drugs, and the regulation of importation and production of drugs, the provisions covering patented products are weak. For instance, there is a requirement on the part of the NDA to certify that the products or processes are not pirated and have never been registered; yet there is no linkage between the NDA and the patents office. The NDA is not empowered to undertake investigations where it suspects that a product has been produced as a result of a pirated process.

(6) Literature review.

The main works on the subject of industrial property in Uganda are not published. However a more recent but unpublished report by an American

Firm M/s Reid and Priest, contains proposals for reform of the Patents Act and the United Kingdom Designs (Protection) Act. The World Intellectual Property Office (WIPO) has also made proposals for the enactment of an Industrial Designs law for Uganda. These proposals are summarised next.

(a) M/s Reid and Priest proposals.

This report discusses five types of protection of intellectual property: patent inventions, unregistered designs, industrial designs registration, utility models and plant patents. It recommends the following:

(i) Enact implementing legislation to comply with ARIPO.

- (A) Reid and Priest recommended the enactment of implementing legislation to comply with ARIPO. Reid and Priest recommended that Uganda must enact implementing legislation before ARIPO patents will be available in Uganda. They further recommended that such legislation should include providing patent protection for industrial designs.
- (B) Reid and Priest recommended adopting a patent registration system to register patents issued by other countries as well as ARIPO patents. They further recommended that it is preferable for Uganda to register ARIPO patents and patents issued by other countries with minimal examination, rather than to establish a full substantive patent application examination system.
- (C) With respect to the registration of ARIPO patents, this is already provided for in Uganda.¹⁸
- (D) Establish a patent registration system for ARIPO patents and patents issue by other countries.
- (E) Reid and Priest recommended revising the Act to establish a system for registering ARIPO patents and patents from all convention countries. Uganda should provide a system for registering patents issued in any of the countries that are members of the Patent Cooperation Treaty (PCT). This would cover patents issued in all major European, North and South American and Asian Countries.

UGANDA LAW REFORM COMMISSION

- (F) Reid and Priest recommended that the Ministry of Justice and the Technology Council share responsibilities for the examination patent applications, whereby the Ministry of Justice would examine applications for compliance with procedural and legal requirements, and the Technology council would examine applications for compliance with technology requirements.
- (G) Reid and Priest recommended that non-citizens should be represented by an agent authorized to practice before ARIPO. They further recommended that as the number of applications for registration increases, this may be changed to require non-citizens to be represented by a local Ugandan agent.
- (H) Reid and Priest recommended provision for both unregistered designs and registered industrial designs. They recommended that it is important to provide an unregistered design right (UDR) similar to that provided under UK law, to provide protection for unregistered indigenous designs. They recommended drafting a new Bill for an unregistered Design Right Act that parallels the provisions governing UDRs set forth in the UK Copyright, Designs and Patents Act 1988.
- (I) For the Bill, they recommended any design, including a computer-generated design, and protection should exist immediately upon creation of the design in a tangible form. They further recommended that the design right in a work created by an employee within the scope of his or her employment should vest in the employer. The owner of a UDR should be allowed to licence or transfer the UDR.
- (J) All remedies available under Ugandan law for copyright infringement should be available for infringement of an unregistered design, including injunctions, damages, search and seizure, and court-ordered forfeiture of infringing goods.

The commission's comments regarding the proposals above are that-

- (a) a draft Bill or provisions on Unregistered Design Rights is acceptable,

¹⁸ See Patents Act 10/91.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (b) protection should also be extended to citizens of any country offering reciprocal protection to Ugandan citizens, and
- (c) the concept of “future design right” should be clearly defined.

(ii) Registered industrial design right.

Reid and Priest recommended that-

- (a) it is necessary to amend Uganda’s patent law to include industrial designs as patentable subject matter in order to implement ARIPO. The protection is offered in most of major European, North and South America and Asian countries and provides an important source of protection for products in many industries;
- (b) registration of ARIPO industrial design registrations be allowed, as well as design registrations issued by any PCT convention country, rather than establishing a full substantive examination system for design registrations;
- (c) patentability standards for industrial designs should be set forth in the patents law;
- (d) once the amendments to the Act are finalised, the patents regulations should be amended to implement the Act provisions relating to registration of industrial designs.

(iii) Amendment of the part of the Act providing for utility models.

Reid and Priest recommended amending the Patent Act and increasing the term of a utility model from seven to ten years. The commission agrees with the proposal.

(iv) Plant patents and protection of indigenous medicinal plants.

- (a) Because agricultural products form an important part of Uganda’s economy, Reid and Priest recommended that it is important to provide plant patent protection under the Act similar to that offered under US

law. Reid and Priest therefore recommend defining the protection available for plant and animal varieties and recommend allowing registration of plant patents issued by ARIPO or any PCT or UPOV convention country.

- (b) On the protection of indigenous medicinal plants, Reid and Priest noted that plant and utility patents do not offer the Government of Uganda significant protection against the exploitation of indigenous medicinal plants. Most plant-derived medicines are made by altering medicinal plants to create new compounds. Utility patents are typically available for such compounds and any novel processes used to make them. Because a plant is normally significantly altered to create the drug, a plant patent covering the plant is not likely to offer adequate protection against development and commercialisation of a drug derived from the patented plant. Reid and Priest add that even if a plant patent was construed to cover a drug derived from the plant, it is likely that the inventor of the drug would be able to obtain a separate utility patent covering the drug, and the parties would end up in a compulsory cross-licensing situation. Reid and Priest conclude that it is difficult to fit the concept of protecting use of Uganda's indigenous plants by non-citizen investors into traditional plant and utility patent categories, and non-citizen pharmaceutical firms are likely to be adverse to any attempt to do so.
- (c) In order to require non-citizen investors to compensate Uganda for use of such plants in the creation of therapeutic drugs, Reid and Priest recommended that it is preferable to protect plants as natural resources under Uganda's real property laws rather than to try to protect such plants under intellectual property laws.
- (d) With respect to plant patents and protection of indigenous medicinal plants, the section 7(2) (b) of Cap. 216 has a major error in the text. The text reads "...other than biological processes and the products..." Where it should have read "...other than non-biological and micro-biological processes and the products..." clearly a major change in emphasis.

(v) Amend licensing provisions to delete requirement of registering licenses.

- (a) Reid and Priest recommended that the provisions of the Act, which require the patent owner to submit any license agreements to the registrar for registration, should be deleted or revised to require registration only of technological aspects of licence agreements. They argued that the provisions of such agreements are typically confidential, and therefore it is likely that foreign investors would be unwilling to register their licence agreements with the registrar, particularly where the registrar records are available to the public.
- (b) In the alternative, they recommended that the National Council for Science and Technology, whose functions include registration of any technology transfer agreements, should register only the technical aspects of the agreements, rather than registration of confidential business provisions such as royalty agreements. Reid and Priest further note that there is duplication in registration with the Patents office and the council requiring registration of license agreements.
- (c) They further recommended that the requirements for registrability of license agreements should be amended to state that the requirements are guidelines for courts in resolving a dispute between parties to a licence agreement if it is disputed in court.

(vi) Other recommendations.

Additional recommendations by Reid and Priest include-

- (a) section 4 (1) of the Act should be amended to provide for the registration of title documents other than assignments, such as certificates of merger and certificates of change of name;
- (b) the Act should under section 8, set forth a positive recitation of what constitutes patentable subject matter;

UGANDA LAW REFORM COMMISSION

- (c) The new law should provide guidelines as to what kinds of products or processes are appropriate from exclusion from patentability so that foreign investors can more easily predict whether the provision may apply to technology they are planning to develop;
- (d) The new law should provide guidelines and requirements for persons admitted to practice before the patents office;
- (e) section 29 (1) where the Minister in consultation with the registrar directs that a patented invention be exploited by a Government agent or other person designated by the Minister, should be made clear as to whether the patentee will continue to have the right to practice the invention concurrently with the Government; and
- (f) the term of a patent should be increased to 20 years.

The commission agrees with Reid and Priest regarding the above mentioned additional recommendations. However the commission notes that the consultants made no reference to TRIPS in their draft comments.

(b) World intellectual property office proposals.

The international bureau of WIPO has also prepared a draft industrial designs Act for Uganda and submitted a commentary on the same. In the main, the work covers the following-

- (i) the definition of industrial designs, which they propose must be understood in a broad sense to include everything which gives rise to an esthetic impression in the appearance of a product;
- (ii) registrable industrial design, which must satisfy the requirement of originality; that is, it must be new and must be novel;
- (iii) the “first to file” system to determine who has the right to the registration of an industrial design. The creator’s moral right to be named as such in

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

the registration of the industrial design to ensure that recognition is given to the creator is also established;

- (iv) the requirements of an application for registration of an industrial design, which should be supplemented by regulations are also provided for;
- (v) formal, but not substantive, examination of industrial design applications is considered appropriate for Uganda. It is considered that substantive examinations would require a large collection of industrial designs, which are registered world wide and in any case cannot be exhaustive;
- (vi) the effect of the registration of an industrial design is also recommended to be covered under the proposed law. The effect is that the industrial design may not be exploited anywhere other than by the registered owner, unless consent of the owner is sought;
- (vii) that it is essential in any law on industrial designs to provide for the possibility of invalidating a registration not satisfying the fundamental requirements of law and public policy. A judicial procedure for invalidating a registration is therefore proposed;
- (viii) that local attorneys should represent applicants outside the jurisdiction or agents admitted to represent clients before the Registrar-General's department. This is in conformity with the usual provisions found in industrial property laws and the normal practice of industrial property offices; and
- (ix) that international treaties relating to industrial property to which Uganda is a party should apply and in the case of conflict, the law in Uganda shall prevail.

CHAPTER 3
ANALYSIS OF REFORM ISSUES.

1. Liability of officers.

The Patents Act does not provide officers of the industrial property office with protection from personal liability from acts done *bona fide* during the course of their duty. This is likely to deter the officers from effectively performing their duty and fully exercising their powers.

Recommendation 1.

In order for officers to take decisions without being deterred by fear of liability, officers of the industrial property office should be protected from personal liability resulting from acts or omissions done bonafide in the performance of their duty. This provision should not relieve the Uganda Registration Services Bureau of liability for damages for injury to property or any interests caused by the Uganda Registration Services Bureau in exercise of powers conferred under the Act.

2. Patentable subject matter.

The current law has a limited scope of patentable subject matter. Section 7(2)(b) of the Patents Act provides –

For the purposes of this Act, ‘intervention’ means a solution to a specific technological problem and may be or may relate to a product or process.

(2) The following shall not be regarded as inventions within the meaning of subsection (1)-

- (a) discoveries and scientific and mathematical theories;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than biological processes and the products of those processes;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (d) methods for treatment of the human or animal body by surgery or therapy as well as diagnostic methods, but restriction under this paragraph shall not apply to products for use in any of these methods; and
- (e) mere presentation of information.

The law does not provide for patenting life forms. Section 7(2)(b) excludes plant and animal varieties from inventions. However it takes an inventor of a biological product equally the same effort as other non- biological products. In addition these products can easily be replicated like any other products.

Uganda is party to the WTO Agreement, the Patents Cooperation Treaty, and the ARIPO Protocol, which provide a wider scope of patentable subject matter.

Article 27(3) of the TRIPS Agreement provides that-

“Members may also exclude from patentability;

- (a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
- (b) 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, members shall provide for the protection of plant Varieties either by patents or by an effective *sui generis* system or by any combination thereof. The provisions of this subparagraph shall be reviewed four years after the date of entry into force of the WTO Agreement.”

The TRIPS agreement gives member countries an option to either protect plant varieties under the patents law or under a *sui generis* system. Uganda has opted to protect plant varieties under the *sui generis* law based on the UPOV model law. (See ULRC study report on Plant Variety protection law, publication No. 18 of 2004).

In light of a multiplicity of developments in intellectual property law on the international scene, the current position does not tally with the international developments. Previously, in International law, genetic resources were viewed as a 'common heritage of mankind' and thus to be made freely available to all.¹⁹ The scientific norm was to collect germplasm freely in any nation and use it in breeding.²⁰

This notion has changed and countries are increasingly granting proprietary right for living organisms. In *Diamond v Chakrabarty*²¹ the American Supreme Court ruled that genetically engineered bacteria were subject matter, capable of being patented. Court authorised the award of patent rights to a bacteria strain transformed by Chakrabarty to make the bacterium capable of cleaning oil spills. It further held that 'the relevant distinction was not between products of nature whether living or not, and man-made inventions'.

In 1987, the United States Patent and Trademark Office (USPTO) issued a policy statement that it considered non-natural occurring, non-human multi-cellular living organisms including animals to be patentable subject matter.

Furthermore in 1988 a patent was granted to Harvard University for a genetically engineered mouse, which was to be used to test cancer drugs. In order to encourage innovation and invention, it is desirable for the law to provide patent protection for biological products, where an invention concerns a microbiological process or product thereof and involves the use of micro-organisms not available to the public.

Whilst the need to encourage innovation and invention is not in question, some doubts have been raised about the ethical values of patenting life forms and creating a monopoly over naturally occurring products. However it should be noted that the law is intended to protect living matter, where an invention concerns a microbiological process or product thereof not available to the public. The organisms must be new, non obvious and industrially applicable.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

In addition some doubts have been raised about the safety of Genetically Modified Organisms (GMOs), an innovation which the Industrial Property Law would encourage.

In February 2003, a committee set up to advise the President of Uganda on GMOs chaired by the late Attorney General Hon. Francis Ayume presented a report in which the committee made the following observations and recommendations, *inter alia*;

- (a) that there were enormous benefits and potential risks associated with biotechnology and therefore called for a balance to be maintained between biotechnology promotion and regulation.
- (b) that all biotechnology applications that are based on or inspired by knowledge, innovations or practices of communities or individuals in Uganda are subject to national legislation.

Uganda has been engaged in the development of national policies on biotechnology and biosafety regulations. Similar processes are going on in Kenya and Tanzania under the UNEP/GEF enabling activities. The Uganda Law Reform Commission was a member of the task force that developed the Uganda Biotechnology and Biosafety policy and regulations coordinated by the Uganda National Council for Science and Technology. These regulations are intended to regulate biotechnology and provide a liability and redress system for injury caused by Biotechnology.

Recommendation 2.

- (a) The commission recommends that a provision be put in place making clearer and widening the scope of the term “invention” in light of Article 27 (3) (b) TRIPS Agreement and the new international developments in intellectual property rights.

¹⁹. John Mugabi, Charles Vector Border, Gudrun Hame, Lyle Glowka and Antonio la Vina Access to Genetic Resources, Strategies for Sharing Benefits, Published in Kenya 1997 Pg 245

²⁰ Intellectual Property Rights in Agricultural Biotechnology, edited by F. H. Erbisch and K. M. Maredia Pg. 19

²¹ 447 U.S 303, 309-10 (1980).

- (b) The new law should provide for patents relating to living matter, where an invention concerns a microbiological process or product thereof and involves the use of micro-organisms not available to the public.

3. Exclusion of pharmaceutical products from patentability.

During the negotiations leading to the Doha Declaration on the TRIPS Agreement and Public health, Least Developed Countries (LDC) were keen to have access to drug and other pharmaceutical products. These countries needed to ensure that they could be able to meet public health needs by promoting access to drugs policies. As result the Doha declaration provided *inter alia* that until 2016 LDCs could opt not to provide patent protection for pharmaceutical products.

Recommendation 3.

The commission recommends that pharmaceutical products be exempted from patentability until January 2016.

4. Publication of patent applications .

The Patent Act is silent about publication of a patent application. This creates a leeway for fraudulent applications, which discourages persons from inventing. In such intention an application can be made and granted without the return to the owner of an invention being aware. Much as the law provides for a search to be carried out. This in itsself does not prove novelty. Substantial information can be recovered from the public if the application is publicised.

In addition the mode and medium of publication should be a medium that is widely circulated. It is not enough to publish, in a medium that is not read or accessed by a big section of the public. In the alternative, a specialised medium for intellectual property matters can be used. The Uganda National Registration Services Bureau should have a journal in which among others the public can be notified of applications made to the registrar.

Recommendation 4.

There should be provision in the law requiring the publication of an application made to the registrar in the Gazette or the proposed intellectual property journal.

5. International search.

The search carried out by the patent registry is not adequate and does not conform to the international standards. Article 15 of the Patent Cooperation Treaty provides for an international search.

Article 15(5)(b) provides-

- (a) “if the national law of the contracting state so permits, the national office of or acting for such state may subject any national application filed with it to an international type search”.
- (b) “Article 15 also states that the object of the international search is to discover relevant prior art”.

International searches are carried out by an international searching authority, which may be either a national office or an intergovernmental organisation, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.

In the past researchers got prior art from third world countries and patented them in their countries as inventions of their own which is contrary to the patents principle of novelty. The requirement of an international search will help in averting such scenarios.

Recommendation 5.

It is proposed to subject applications to an international type search where the application is found in order as to form, to ascertain whether or not the subject of the application or any claim or claims is an invention.

6. The term of the patent rights.

The current law provides for a term of fifteen years with an extension of up to five years on application made a month before the expiration of the fifteen years.

Section 31 of the Patent Act provides-

- (1) Subject to subsection (2) a patent shall expire at the end of the fifteenth year after the date of the grant of the application.
- (2) the registrar may grant the extension for a further period of five years; but the request under this subsection shall be made not less than one month before the expiration of the patent.

Article 33 of the TRIPS agreement provides -

“The term of protection available shall not end before the expiration of a period of twenty years counted from the filling date”.

The period of 15 years is short and does not encourage innovation and technology transfer. Much as the law provides for an extension of five years on application to the registrar, it is conditional and is an unnecessary burden. The law should provide for protection of 20 consecutive years.

Recommendation 6.

The commission is of the view that the term of a patent be extended to 20 years.

7. Contractual licences.

The current law is silent on the various issues with regard to contractual licences. For example on whether the patent holder can still use the invention even when a licence has been granted to another party.

In addition the law is silent on the effect of a contractual licence when a patent is revoked or invalidated.

Recommendation 7.

- (a) It is proposed that provisions should be made to the effect that in the absence of any provision to the contrary a licensor may grant further licences for the use of the invention unless the licence granted is exclusive.
- (b) Provision be made to provide for repayment of royalties or return of consideration paid under the contract where a patent is not granted; is revoked or is invalidated.

8. Compulsory licencing.

A compulsory licence is given to one or more companies by a national Government to use a patent, copyright, or other form of intellectual property within the country, without the authorisation of the patent holder but in return for some compensation to the patent holder, usually 1-10% of sales.

Many compulsory licences are issued in the US for instance, in public interest or to promote more competition in business. The US government has issued compulsory licences to the army on satellite technology and night-vision glasses; to various companies on technologies to reduce air pollution; on nuclear technology; and in the biotech industry to other biotech and pharmaceutical companies. In cases involving anti-competitive practices, courts award compulsory licences, without any compensation to the IPR holder.

Compulsory licensing is meant to deal with situations of balance between profits for owners of patent rights against the needs of affected people. The compulsory licensing provisions currently in the Act are not comprehensive. There is no provision, for example, for compulsory licensing for non- working patents, nor compulsory licensing based upon the interdependence of patents. Further, the law does not provide any pre-conditions for the grant of compulsory licences, the grant and terms of a compulsory license, nor the transfer of compulsory licences.

Legislation in many countries provides that where the patented product is not available or is available at exorbitant prices, the Government may, on grounds of public interest, authorise an interested manufacturer to use the patent, requiring him or her to pay the patent owner a royalty that the Government considers reasonable.

The TRIPS Agreement lays down strict conditions for such licensing to ensure that compulsory licences are issued only in exceptional situations and on an objective basis. The circumstances are –

- (a) when an interested manufacturer has failed in his or her efforts to obtain the authorisation on reasonable terms and conditions;
- (b) in case of national emergency.

The TRIPS agreement, which introduced pharmaceutical patents into international trade agreements for the first time, allows compulsory licensing (under Article 31) if it is necessary to protect a nation's health.

Case study 1 - USA and Thailand. Several industrial governments are fighting compulsory licensing because of the impact on their economies. The US government and the US pharmaceutical industry are fighting hard to prevent the compulsory licensing of essential drugs, particularly AIDS drugs in developing countries. For instance, after the Asian financial crisis, Thailand was in no position to afford AIDS drugs sold at US prices. Local health groups accordingly lobbied the Thai and US governments to licence local companies to manufacture anti-HIV drugs and drugs to treat opportunistic AIDS infections. They pointed out that many lives would be saved and that the patent holder, instead of receiving virtually nothing from the Thai market, would benefit from a steady unspectacular stream of compensatory payments. In response, the US government persuaded the Thai government not only to drop its plans for compulsory licensing of the drugs, but also to change its patent and trade laws to outlaw compulsory licensing altogether. It threatened

to reduce Thailand's access to the US market for its jewellery exports, one of Thailand's major sources of foreign exchange, while at the same time offering to cut tariffs on Thai jewellery and wood products entering the US market. This was in spite of the fact that the US government does not even have patent rights on the drugs in question in Thailand.

Case Study 2 – USA and South Africa. The US government is using the same tactics in South Africa – pressured by pharmaceutical lobby. More than three million people – 16% of the population are HIV positive in South Africa, including one-quarter of the pregnant women in the poorest provinces. The price of the anti-HIV drug treatment as set by companies such as Bristol-Myers Squibb would amount to almost 40% of an average worker's salary. In 1997, South Africa amended its national legislation to allow compulsory licensing of patented AIDS drugs so that local companies could make and sell cheaper generic versions.

Implementation of the legislation however has been suspended until a challenge lodged by some 40-drug companies with the South African courts is resolved. In the meantime, the US has put a wide range of trade sanctions on South Africa, including denying it tariff relief on certain exports. The lowering of prices in South Africa would not be a serious threat to either the profits or the research and development funding of the large Northern pharmaceutical companies, given that it could only increase sales income from the south and that the bulk of income of drugs trans-nationals will continue to come from the north.

The TRIPS Agreement does leave WTO member countries with a certain amount of freedom. Countries are allowed under certain conditions to issue compulsory licences against the will of the patent holder. For example, for a country with the HIV seroprevalence, the Government could decide that it is in the public interest to ensure that appropriate drugs are manufactured locally or made available at a cheaper price.

Following the Doha Declaration, such compulsory licences in LDCs are issued for predominantly regional markets. This declaration is very significant because LDCs which have a shortage of resources may avoid duplication of resources by benefiting from cheap products from neighbour countries that have issued a compulsory licence.

Recommendation 8.

- (a) Provision for the exploitation of patented inventions by the Government or a third party authorised by the Government be revised to conform to the terms of the TRIPS Agreement in particular Article 31 of the Agreement.
- (b) Uganda's legislation should have provisions for compulsory licensing, allowing the person granted a compulsory licence to produce predominantly for the regional market.

9. Parallel importing.

A patent confers not only the exclusive right to manufacture and work the patent in the country where it is granted, but also the exclusive right to import the patented product into the country.

However, these rights of the patent holder are qualified by the principle of exhaustion of rights. This principle of exhaustion states that once patent holders or other authorized parties have sold a patented product, they cannot prohibit the subsequent re-sale of that product since their rights in respect of that market are exhausted by the act of selling it. The patent holder's rights over a patented product are therefore, exhausted.

Thus, from the moment the product is marketed, the patent holder can no longer control its subsequent circulation. The patent holder however, still holds exclusive right to manufacture the product and to put it on the market, but from that moment, he or she has no further right over the product on the market. On the basis of the exhaustion principle, it would be possible for another party (apart from the patent holder or its authorised agents) to import the patented product from another market where the product is sold.

Parallel importing involves bringing products in from another country. It consists of purchasing proprietary products from a third party in another country, rather than directly from another manufacturer and taking advantage of the fact that pharmaceuticals companies sometimes charge significantly lower prices in one country than in another. For instance, in Britain, where parallel importing is common, the least price for Glaxo Wellcome's Retovir is 125 pounds, but consumers can purchase the same proprietary drug imported from other European countries for as little as 54 pounds.

Parallel importing can be an important tool enabling access to affordable medicines because there are substantial price differences for pharmaceutical products in different markets. The price differences may be due to local market conditions, based on factors such as differences in intellectual property rules, or prevailing income levels, as well as the degree of competition among producers. Where there is little competition among producers, or where the producer has a monopoly within a particular market, a very high price may be charged for a medicine, regardless of the income levels.

Article 6 of the TRIPS Agreement provides that the issue of exhaustion of rights shall not be a matter of dispute settlement. Hence, TRIPS leaves it to members to decide how the principle should be applied within their national territory.

Case study 3 – drug prices. Price for the same product can vary widely among countries because of many factors, such as differences in intellectual property rules, differences in local incomes, and the degree of competition among producers. For example, a 1998 study by the Consumer Project on technology found prices for Smithkline Beechmans's version of Amoxil was \$8 in Pakistan, \$14 in Canada, \$16 in Italy, \$22 in New Zealand, \$29 in the Philippines, \$36 in Malaysia, \$40 in Indonesia, and \$60 in Germany.¹

By permitting some form of parallel importing, countries can shop around and get better prices, using market forces to lower national expenditure on a range of goods, including pharmaceuticals. In the European Union (EU), parallel importing of patented products is widely used and is seen as very effective at equalising prices.

Since the creation of the WTO, the US government has been extremely aggressive in attacking parallel imports by other countries. Nevertheless, parallel imports of a range of goods routinely flow into the United States itself. Parallel imports are admitted in many developed and developing countries. Examples of the countries include-

(a) **Argentina: Patent Law No. 24.481 of 1995.**

Article 36.c provides that the rights conferred by a patent shall have no effect against-

“any person who imports or in anyway deals in the product patented or obtained by the patented process once the said product has been lawfully placed on the market in any country; placing on the market shall be considered lawful if it conforms to Section 4 of Part III of the TRIPS Agreement.”

(b) **South Africa: Medicines and Related Substances Control Act No. 101 of 1965 (as amended by the Medicines and Related Substances Control Amendment Act 1997).**

Section 15C inserted by the 1997 amendment Act provides that-

“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 No. 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

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

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)”.

(c) **Malaysia: Patents Act 1983, as amended by Patents (Amendment) Act 2000.**

Section 58A-Acts deemed to be non-infringement.

- “(1) It shall not be an act of infringement to import, offer to sale, sell or use-
- (a) any patented product; or
 - (b) any product obtained directly by means of the patented process or to which the patented process has been applied, which is produced by or with the consent, conditional or otherwise, of the owner of the patent or his licensee.
- (2) For the purposes of this section, “patent” includes a patent granted in any country outside Malaysia in respect of the same or essentially the same invention as that for which a patent is granted under this Act.”

Recommendation 9.

- (a) Parallel importing is a good option for Uganda. It may well be the best way to improve access to essential drugs because of limited local capacity to produce raw materials and undertake drug manufacturing.

- (b) The rights under patents should not extend to acts in respect of articles, which have been put on the market in Uganda or in any other country or imported into Uganda by the owner of the patent or with his or her express consent.

10. Exceptions to exclusive rights.

The provision will provide for the different circumstances in which exclusive rights conferred by patent are restricted, in order to allow a third party to make work with the invention. The provision allows any person to make use of a patent in the manner specified in the provision. During the lifetime of a patent any such use is not subject to compensation.

It is proposed to have the following exceptions-

- (a) an exception for experimental use of an invention, which allows the use of a patent in experimentation for both scientific as well as commercial purposes, without the consent of the patent holder;
- (b) an exception for teaching purposes, so that patented inventions can be used in the course of teaching and for educational purposes;
- (c) the early working or the “Bolar” exception, which permits the use of an invention for the purpose of obtaining approval of a generic product before the expiry of the patent. This procedure is intended to enable the marketing of a generic version promptly after the patent protection of the patented product expires. The exception is available with respect to pharmaceutical patents and may also apply to agrochemical and other products requiring administrative approval prior to commercialisation. The use of this exception was the subject of a WTO dispute between the EC and Canada, in which the Canadian legislation that permitted generic manufacturers to carry out experiments and tests required

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

to obtain marketing approval before the expiry of the patent was determined to be TRIPS- consistent;

- (d) an exception for individual prescriptions, which allows the use of patented pharmaceutical products in the preparation of individual prescriptions; and
- (e) an exception for the production and export of a patented product, which would allow production of medicines for export to a third country, in order to meet a health need in that third country. This exception has been proposed (by developing countries in the WTO) as a solution to the problem of countries with limited manufacturing capacity to effectively use the compulsory licensing provisions in the TRIPS Agreement. WTO Members are expected to discuss the proposal to interpret Article 30 as explicitly allowing this exception, but the status is not conclusively resolved yet.

Exceptions to the exclusive rights granted by patents are justified on the grounds that in certain circumstances, limited use of the patented inventions is required to achieve public policy purposes of encouraging innovation, promoting education and protecting other public interests.

Article 30 of the TRIPS allows limited exceptions to exclusive patent rights; provided that the exceptions satisfy the three fold test of-

- (a) not unreasonably conflicting with the normal exploitation of the patent;
- (b) not unreasonably prejudicing the legitimate interests of the patent owner; and
- (c) taking into consideration the legitimate interests of third parties.

UGANDA LAW REFORM COMMISSION

All national patent laws have provisions relating to exceptions to the exclusive rights granted by a patent, although the scope and content of these provisions vary from country to country.

In many national patent laws, there are exceptions to patent rights for cases of experimental use or use for research purposes. In Europe, for instance, case law has admitted the legality of experimental use for commercial purposes.

It is also no longer disputed that Article 30 of TRIPS allows for exceptions to exclusive patent rights in the case of early working (the “Bolar”-type exception). The first early working provision was introduced in the Drug Price Competition and Patent Term Restoration Act (1984) of the US, under which a generic producer was allowed to import, manufacture and test a patented product before the expiry of its patent. This ability to do this prior to the expiry of the patent will enable the generic producer to have its product ready for marketing as soon as the patent protection for the original branded product ends.

The compliance of this exception with the TRIPS Agreement was confirmed by a panel decision in 2000, in the case brought by the EC against Canada under WTO’s dispute settlement mechanism, questioning the legality of the Canadian law which not only allowed tests, but also production and stockpiling of the generic product for immediate release after patent expiry. The panel confirmed that an early working exception is consistent with the TRIPS Agreement, although production and stockpiling was not.

The UK commission on IPRs in its report has recommended that developing countries should include an appropriate exception for early working to patent rights in their national laws, to “accelerate the introduction of generic substitutes on patent expiry”. This exception has important implications for developing countries, especially if they are currently or potentially producers of generic medicines. Even where they are not likely to be producers of medicines, it would still be prudent for developing countries to include a Bolar-type exception within their national law, in order to enable the products of a foreign company to gain regulatory approval and to market entry soon after the patent has expired.

Another exception that has been generally accepted is the exception for individual prescriptions; that is, medicines for individual needs prepared by a pharmacist on the basis of a medical prescription. This exception is embodied in the EC's Community Patents Agreement 1989.

It is worth noting that the exceptions to patent rights under Article 30 operate automatically; i.e there is no need for consent by the patent holder, nor is there a requirement to obtain authorisation from a court or other authority to use the patent. Any party can therefore, benefit from an exception at any time during the lifetime of a patent. Another advantage is that use of exceptions under Article 30 does not require payment of compensation to the patent holder.

Recommendation 10.

- (1) Provision should be made to provide for the different circumstances in which exclusive rights conferred by patent are restricted.

These exceptions to exclusive rights should include to-

- (a) carry out any acts related to experimental use on the patented invention, whether for scientific or commercial purposes;
- (b) make use of a patented invention for teaching purposes;
- (c) carry out acts, including testing, using, making or selling a patented invention solely for the purposes reasonably related to the development and submission of information required under any law of the country or of a third country which regulates the manufacture, construction, use, sale of any product;

- (d) make use of the patented invention in relation to the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription; and
- (e) to manufacture and export to a third country a patented healthcare invention where the export of the invention addresses a health need identified by the third country, provided that the product is either
 - (i) not patented in the third country; or
 - (ii) that Government has authorised use of the patent without consent of the patent owner and that the production of or export of the invention is intended only for the market of the third country.

(11) Term for utility models.

The current law provides for a term of seven years for utility models, which period is not extendable. This period is small and does not encourage invention and technology transfer. Uganda as a country is pushing for value adding to the products of export in order to fetch more revenue. However this may not be possible unless innovation and technology transfer are encouraged.

Recommendation 11.

The term on utility models should be increased from seven years to ten years.

(12) Industrial designs.

An industrial design is the ornamental or aesthetic aspect of an article that gives a special appearance to the article. An industrial design is any composition of lines or colours that serves as a pattern for a product of industry or handicraft. It may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as

patterns, lines or colour. In some countries, industrial design registration may be used to protect trade “dress.” An industrial design is generally protected if it is new or original and not dictated solely by technical or functional features.

Industrial designs in Uganda are protected by the United Kingdom Designs (Protection) Act, Cap. 218. This Act provides for the protection in Uganda of designs registered in the United Kingdom. Under the Act, an innocent infringer of a registered design is not liable for damages. Under the Act, there is no local registration requirement, and there is no provision in Uganda for independent design registration. The law does not provide any design registration mechanism, or any protection for unregistered designs.

Uganda is party to the WTO/TRIPs Agreement, the Patents Cooperation Treaty, the ARIPO protocol etc, which provide for industrial designs.

Article 25 of the TRIPs agreement provides-

“Members shall provide for the protection of independently created industrial design that are new or original”.

From the above it is clear that Uganda, as a WTO member state is required to provide protection for industrial designs.

Industrial designers are becoming a significant aspect in industries today and should be protected to encourage investment and trade in Uganda.

Recommendation 12.

A new provision should be made for regulation of industrial designs as per the TRIPs Agreement in particular Article 25 and the ARIPO protocol.

(13) Technovations.

The current law does not provide for technovations. A technovation is a solution to a specific problem in the field of technology proposed by an employee of an enterprise in Uganda for use by that enterprise, which on the date of the proposal, has not been used or actively considered for the use by that enterprise.

At common law, in absence of a contract to the contrary, such technovations belongs to the employer. This is because the innovation is presumed to have come as a result of the employment during the hours of employment and using facilities for the employer.

Recommendation 13.

The new industrial property law should introduce regulation on technovations. Issues to be considered are the right to a technovation certificate, use of the technovation, and the remuneration of the technovator.

(14) Infringement and enforcement of industrial property.

The provisions on infringement and enforcement of rights in the current patents law are neither clear nor adequate. One feature of the TRIPS Agreement that distinguishes it from the WIPO convention is the emphasis it lays on enforcement by its member countries of its standards and rules. The Agreement prescribes the institutional mechanisms, procedures and remedies that countries must adopt. The Agreement states that national courts shall be able ‘to order prompt and effective provisional measures’ to preserve evidence in regard to alleged infringement of intellectual property rights, and to prevent an infringement from occurring by, *inter alia*, preventing the entry of imported goods into the channels of commerce in their jurisdiction.

Where infringement of patent rights has been established, legislation should empower the courts to have authority to order the infringer to pay to the rights holder damages to compensate for the injury. To create an effective deterrent, the courts are authorised to order the destruction of the infringing goods so that they do not enter commercial channels. Destruction should be at the expense of the infringer under the supervision of the court. In Uganda for example the Uganda revenue authority is finding it a burden to bare the costs of destruction of counterfeit goods.

Member countries are required to adopt procedures under which holders of intellectual property who have ground to suspect that counterfeit goods infringing on their patents are likely to be imported would request customs authorities not to release the goods. Countries have the option to prescribe procedures for the suspension of release from customs of products that infringe on products. The Agreement also calls on all countries to see that where there is wilful breach of patent rights on a commercial scale, the infringer is prosecuted under criminal law and punished with imprisonment or fines sufficient to provide a deterrent.

Recommendation 14.

- (a) The provisions on infringement should be streamlined in order to conform to the technological developments as well as the international obligations incurred by Uganda.
- (b) It is also proposed that an industrial property tribunal with a chairman at the level of the High Court judge and with members with experience in industrial, scientific and technology fields be established.

(15) Examination of patent applications.

The current law provides for examination of patent applications by the registry. However the patent registry does not have the technology and human resource to carry out effective examination. Owing to this, examinations for applications are done in Harare, Zimbabwe, which is time consuming and may be discouraging for inventor.

Recommendation 15.

Provision should be made for examination to be done by the bureau and the National Council for Science and Technology. The bureau may carry out procedural examinations while the National Council for Science and Technology carries out the technical examination.

ANNEX 1

THE INDUSTRIAL PROPERTY BILL, 2004.

Arrangement of clauses.

PART I - PRELIMINARY.

Clauses.

1. Commencement.
2. Interpretation.

PART II - ADMINISTRATION.

3. Establishment of an industrial property department.
4. Functions and powers of the industrial property department.
5. Appointment of officers.
6. Register of the industrial property department.
7. Protection from personal liability.
8. Liability of industrial property department.

PART III -PATENTS: PATENTABILITY.

9. Meaning of “invention”.
10. Patentable invention.
11. Novelty.
12. Inventive step.
13. Industrial application.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

14. Non-patentable inventions.
15. Information prejudicial to defence of Uganda or safety of the public.
16. Restrictions on applications abroad by residents of Uganda.
17. Patents relating to living matter.

PART IV - RIGHT TO INVENTIONS AND NAMING OF INVENTOR.

18. Right to a patent.
19. Unauthorised application based on an invention of another person.
20. Inventions made in execution of commission or by employee.
21. Naming of inventor.

PART V - APPLICATION, GRANT AND REFUSAL OF PATENT.

22. Application.
23. Unity of inventions.
24. Amendment and division of application.
25. Right of priority.
26. Information concerning corresponding foreign applications and grants.
27. Payment of fees.
28. Withdrawal of application.
29. Filing date and examination of application as to form, etc
30. Publication of application

UGANDA LAW REFORM COMMISSION

31. International type search
32. Examination as to substance
33. Grant, registration and publication of a patent
34. Appeals

PART VI - INTERNATIONAL APPLICATIONS

35. Interpretation of part
36. Further functions of the industrial property department
37. Unsearched or unexamined international applications, etc.
38. Provisional protection of published international applications
39. Publication of international applications

PART VII - RIGHTS AND OBLIGATIONS OF THE APPLICANT OR THE OWNER OF THE INVENTION

40. Rights of owner
41. Obligations of owner
42. Remedies
43. Right of a prior user
44. Scope of protection
45. Limitation of rights
46. Exception to exclusive rights
47. ARIPO Protocol on patents

PART VIII - TERM OF PATENT AND ANNUAL FEES

48. Term of patent
49. Annual fees

PART IX - CHANGE IN THE OWNERSHIP AND JOINT OWNERSHIP OF APPLICATIONS AND PATENTS

50. Change in ownership of applications, etc
51. Joint ownership of applications and patents

PART X - CONTRACTUAL LICENCES

52. Rights of licensee
53. Right of licensor to grant further licences and use of the invention
54. Effects of patent not being granted, revoked or being invalidated
55. Form of licence contracts
56. Petition for registration
57. Prohibited terms in licence contracts
58. Registration of the contract and issue of certificate
59. Appeal
60. Compulsory licenses for non-working and similar reasons
61. Compulsory licences based upon interdependence of patents
62. Preconditions for grant of compulsory licences
63. Grant and terms of compulsory licences
64. Transfer of compulsory licences.
65. Cancellation of compulsory licences.
66. Registration of grants, cancellation or variation.
67. Licences as of right.

PART XI - EXPLOITATION OF PATENTED INVENTIONS BY THE
GOVERNMENT OR BY THIRD PERSONS AUTHORISED BY THE
GOVERNMENT.

68. Exploitation of the patented inventions by the Government or by third persons authorized by the Government.

PART XII - UTILITY MODELS.

69. Applicability of provisions relating to patents.
70. Special provisions relating to utility model certificates.
71. Conversion of patent applications to applications for utility model certificates, and vice versa.

PART XIII - INDUSTRIAL DESIGNS.

72. Definition of an industrial design.
73. Right to industrial design; naming of creator.
74. Registrable industrial designs.
75. Application and examination.
76. Duration and renewal of registration of an industrial design.
77. Restoration of registration of industrial designs.
78. Graphic representations, specimens, etc.
79. Publication of reference to registration of industrial designs.
80. Rights conferred by registration of industrial designs, etc.
81. Transfer and assignment of industrial designs, licences.

PART XIV – TECHNOVATIONS

82. Definitions.
83. Right to technovation certificate.
84. Request.
85. Issuance or refusal of technovation certificate
86. Use of technovation.
87. Remuneration of the technovator.
88. Derogation by contract.
89. Disputes.

PART XV – COMMON PROVISIONS: SURRENDER,
REVOCATION AND INVALIDATION

90. Surrender.
91. Revocation or invalidation.
92. Effect of revocation or invalidation.

PART XVI – INFRINGEMENT

93. Acts constituting infringement.
94. Relief.
95. Declaration of non-infringement.
96. Threat of infringement proceedings.
97. Criminal proceedings.
98. Presumption of use of patented process.

UGANDA LAW REFORM COMMISSION

99. Legal proceedings by licensee.
100. Appeal from decisions of the registrar.
101. Suspension of release by customs authorities.
102. Assessors.

MISCELLANEOUS PROVISIONS.

103. Regulations.
104. Repeal of Cap. 216 and saving provisions.
105. Exemption from stamp duty.

SCHEDULE – Transitional and saving provisions.

THE INDUSTRIAL PROPERTY ACT, 2004

An Act of Parliament to provide for the promotion of inventive and innovative activities, facilitate the acquisition of technology through the grant and regulation of patents, utility models, technovations and industrial designs, provide for the establishment, powers and functions of the Industrial Property Department and for purposes incidental thereto and connected therewith.

PART I – PRELIMINARY

1. Commencement.

This Act shall come into operation on such date as the Minister may, by notice in the Gazette, appoint.

2. Interpretation.

In this Act, unless the context otherwise requires-

“application” means an application under this Act for the grant of-

- (i) a patent;
- (ii) a certificate of utility model;
- (iii) a certificate of technovation; or
- (iv) registration of an industrial design.

“ARIPO” means the African Regional Industrial Property Organisation;

“ARIPO Office” means the Secretariat managing the African Regional Industrial Property Organisation (ARIPO), formerly known as Industrial Property Organisation, for the English- speaking Africa (ESARIPO) established by the Lusaka Agreement of 9th December 1976 as amended;

“ARIPO Protocol” means the protocol on patents and industrial designs adopted at Harare on 10th December 1984;

UGANDA LAW REFORM COMMISSION

“Court” means the Commercial Division of the High Court of Uganda;

“Examiner” means an examiner of patents appointed under section 5;

“Former Office” means the Patents Office existing immediately before the commencement of this Act;

“Industrial design” has the meaning assigned to it in section 72;

“Industrial property department” means the Uganda Industrial Property Department of the Uganda National Registration Services Bureau established under section 3;

“Industrial Property Journal” means a journal published by the industrial property department mainly for the purpose of advertising industrial property applications and for publishing other matters required to be published under the Act;

“Industrial property rights” mean rights under patents, certificates of utility models and technovation and registration of industrial designs issued under this Act;

“Innovation” means utility models, technovation models, and industrial designs and any other non-patentable creations or improvements that may be deemed as deserving specified intellectual property rights;

“International bureau” means the International Bureau of the World Intellectual Property Organisation established by the convention signed at Stockholm on the 14 July 1967;

“International classification” as regards industrial designs, means classification in accordance with the Locarno Agreement of October, 1968, establishing an international classification for industrial designs;

“Invention” means a new and useful art (whether producing a physical effect or not), process, machine, manufacture or composition of matter which is not obvious, or any new and useful improvement thereof which is not obvious, capable of being used or applied in trade or industry and includes an alleged invention;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

“Inventor” means the person who actually devises the invention (as defined in section 9) and includes the legal representative of the inventor;

“Licence contract” means a contract or agreement by which a person grants permission to use his or her industrial property rights, know-how, or other technical information or technical services;

“Licensee” means a licensee under a contract registered or deemed to have been registered under this Act;

“Licensor” means a party to the licence contract who grants the permission under a contract registered or deemed to have been registered under this Act;

“Registrar” means the registrar of the industrial property department appointed under section 5;

“Minister” means the Minister for the time being responsible for matters related to industrial property;

“National Council for Science and Technology” means the Council established by section 1 of the Uganda National Council for Science and Technology Act;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property, of 20th March, 1883, as last revised;

“Patent Cooperation Treaty” means the treaty of that name signed at Washington on the 19th June, 1970;

“Priority date” means the date of the first application that serves as the basis for claiming the right of priority provided for in the Paris Convention;

“Self-replicable matter” means any matter possessing the genetic material necessary to direct its own replication by way of a host organism or in any other indirect way;

“Utility model” means any form, configuration or disposition of element of some appliance, utensil, tool, electrical and electronic circuitry, instrument,

handicraft mechanism or other object or any part of the same allowing a better or different functioning, use, or manufacture of the subject matter or that gives some utility, advantage, environmental benefit, saving or technical effect not available in Uganda before and includes microorganisms or other self-replicable material, products of genetic resources, herbal as well as nutritional formulations which give new effects.

PART II – ADMINISTRATION.

3. Establishment of an industrial property department.

There is established an industrial property department under the Uganda National Registration of Services Bureau.

4. Functions and powers of the industrial property department.

The functions of the industrial property department shall be to:

- (a) receive, consider and grant applications for industrial property rights;
 - (b) receive, and register technology transfer agreements and licences;
 - (c) provide to the public industrial property information for technological and economic development and maintain links with users and potential users of industrial property information;
 - (d) promote inventiveness and innovativeness in Uganda; and
 - (e) perform any other functions for the better carrying out of this Act.
- (2) In the carrying out of its functions, the department shall liaise with relevant institutions.

5. Appointment of officers.

The Minister shall, on the recommendation of the board of the Uganda National Registration of Services Bureau appoint:

- (a) a registrar of the industrial property department who shall exercise the powers and perform the duties and functions of the department under this Act; and
- (b) examiners and other officers as may be necessary for carrying out the provisions of this Act.

6. Register of the industrial property department.

- (1) The registrar shall maintain two registers one of which shall contain all industrial property applications received, and the other shall contain all industrial property and other rights granted under this Act, in which shall be recorded and numbered in the order of grant, and in respect of each patent, where appropriate, its lapse for non-payment of annual fees and all transactions to be recorded by virtue of this Act.
- (2) A person may, during working hours, inspect the registers maintained under subsection (1) and may, subject to the payment of the prescribed fee and any regulations made under this section, obtain extracts therefrom.
- (3) The details concerning the register shall be prescribed by the regulations.
- (4) The register of patents shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

7. Protection from personal liability.

No matter or thing done by any member, officer, employee or agent of the department shall, if the matter or thing is done bona fide for executing the functions, powers or duties of the office, render the member, officer, employee or agent or any person acting on his or her directions personally liable for any action, claim or demand whatsoever.

8. Liability of the industrial property department for damages.

The provisions of section 7 shall not relieve the department of the liability to pay compensation or damages to any person for any injury to him or her, his or her property or any of his or her interests caused by the exercise of the powers conferred on the department by this Act or by any other written law or by the failure, whether wholly or partially, of any works.

PART III – PATENTABILITY.

9. Meaning of “invention”.

- (1) For the purposes of this part, “invention” means a solution to a specific problem in the field of technology.
- (2) Subject to subsection (3), an invention may be, or may relate to, a product or a process.
- (3) The following shall not be regarded as inventions and shall be excluded from patent protection:
 - (a) discoveries, scientific theories and mathematical methods;
 - (b) schemes, rules or methods for doing business, performing purely mental acts or playing games;
 - (c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;

- (d) mere presentation of information;
- (e) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and micro-biological processes; and
- (f) pharmaceutical products until January 2016.

10. Patentable invention.

An invention is patentable if it is new, involves an inventive step, and is industrially applicable.

11. Novelty.

- (1) An invention is new if it is not anticipated by prior art.
- (2) For the purposes of this Act, everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) or by oral disclosure, use, exhibition or other non-written means shall be considered prior art. Provided that such disclosure occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect thereof.
- (3) For the purpose of the evaluation of novelty, an application for the grant of a patent or a utility model certificate in Uganda shall be considered to have been comprised in the prior art as from the filing date of the application, or if priority is claimed, as from the date of its validly claimed priority, to the extent to which its content is available, or is later made available, to the public in accordance with this Act or in accordance with the Patent Cooperation Treaty.

- (4) For the purposes of subsection (2), a disclosure of the invention shall not be taken into consideration if it occurred not earlier than twelve months before the filing date or, where applicable, the priority date of the application and if it was by reason or in consequence of:
- (a) acts committed by the applicant or his or her predecessor in title; or
 - (b) an evident abuse committed by a third party in relation to the applicant or his or her predecessor in title.

12. Inventive step.

An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the inventions, it would not have been obvious to a person skilled in the art to which the invention pertains on the date of the filing of the application or, if priority is claimed, on the priority date validly claimed in respect thereof.

13. Industrial application.

An invention shall be considered industrially applicable if, according to its nature, it can be made or used in any kind of industry, including agriculture, medicine, fishery and other services.

14. Non-patentable inventions.

The following shall not be patentable -

- (a) plant varieties as provided for in the law providing for the protection of plant varieties.
- (b) inventions contrary to public order, morality, public health and safety, principles of humanity and environmental conservation.

15. Information prejudicial to defence of Uganda or safety of the public.

- (1) Where an application for a patent is filed under this Act or under any international convention to which Uganda is a party, and it appears to the registrar that the application contains information of a description notified to the registrar by the Minister responsible for defence or the concerned Minister as being information the publication of which might be prejudicial to the defence of Uganda, the registrar may give directions prohibiting or restricting the publication of that information or its communication to any specified person or persons.
- (2) If it appears to the registrar that any application so filed contains information the publication of which might be prejudicial to the interest of the public, the registrar may give direction prohibiting or restricting the publication of that information or its communication to any specified person or persons until the end of a period not exceeding three months from the end of the period prescribed for the purposes of section 30.
- (3) Where directions under this section are in force with respect to any application-
 - (a) if the application is made under this Act, it may be processed to the stage where it is in order for the grant of a patent, but shall not be published and any information relating thereto shall not be communicated and no patent shall be granted in pursuance of the application;
 - (b) if it is an application for an ARIPO patent, it shall not be sent to the ARIPO office; and
 - (c) if it is an international application for a patent, a copy of the application shall not be sent to the International Bureau or to any international searching authority appointed under the Patent Cooperation Treaty.

UGANDA LAW REFORM COMMISSION

- (4) Where the registrar gives instructions under this section with respect to any application, the registrar shall give notice of the application and of the directions to the Minister responsible for defence or the concerned Minister and the following provisions shall then have effect-
- (a) the Minister responsible for defence or the concerned Minister shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of Uganda or the safety of the public;
 - (b) if the Minister responsible for defence or the concerned Minister determines that the publication of the application or the publication or communication of the information would be prejudicial to the safety of the public, the Minister shall notify the registrar, who shall continue his or her directions under subsection (2) until they are revoked under paragraph (e);
 - (c) if the Minister responsible for defence or the concerned Minister determines that the publication of the application, or the publication or communication of the information would be prejudicial to the defence of Uganda or the safety of the public, he or she shall (unless a notice under paragraph (d) has previously been given by the Minister responsible for defence or the concerned Minister to the registrar) reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;
 - (d) if on the consideration of an application at any time it appears to the Minister responsible for defence or the concerned Minister that the publication of the application, or the publication or communication of the information, contained in it would not, or would no longer, be prejudicial to the

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

defence of Uganda or the safety of the public, he or she shall give notice to the registrar to that effect; and

- (e) on receipt of a notice under paragraph (d), the registrar shall revoke the directions and may, subject to such conditions as the registrar may deem fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time had previously expired.
- (5) The Minister responsible for defence or the concerned Minister may, in determining a question under paragraph (c) of subsection (4)-
 - (a) at any time after, or, with the consent of the applicant, before the expiry of the period prescribed for the purposes of section 30, consider the application and any documents submitted in relation thereto; or
 - (b) where the application contains information relating to the production or use of atomic energy or research into matters connected with such production or use, authorise the National Council for Science and Technology to study the application and any documents sent to the registrar in connection therewith and report to the registrar as soon as reasonably practicable on the utility or otherwise of the patent applied for.
- (6) Where directions have been given under this section in respect of an application for a patent for an invention and the period prescribed in relation thereto expires, and while such directions are still in force, an application is brought for the grant of a patent, then-
 - (a) if while the directions are in force, the invention is used by or with the written authorisation of or on the order of a Government Ministry, department or agency, the provisions of section 67 shall apply as if:

UGANDA LAW REFORM COMMISSION

- (i) the use was made pursuant to the provisions of that section;
 - (ii) the application had been published at the end of that period; and
 - (iii) a patent had been granted for the invention at the time the application is brought for the grant of a patent (taking the terms of the patent to be those of the application as at the time it was so brought); and
- (b) if it appears to the Minister responsible for defence or the concerned Minister that the applicant for the patent has suffered hardship by reason of the continuation in force of the directions, the Minister may, with the consent of the Ministry responsible for finance, make such payment by way of compensation to the applicant, as appears to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.
- (7) If the applicant is dissatisfied with the amount of compensation paid to him or her under subsection (6), he or she may appeal to the court.
- (8) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions remain in force.
- (9) A person who fails to comply with any direction under this section shall be liable, on conviction, to imprisonment for a term not exceeding two years, or to a fine not exceeding forty eight currency points, or to both.

16. Restriction on applications abroad by Ugandan residents.

(1) Subject to the provisions of this section, no person resident in Uganda shall, without written authority granted by the registrar, file or cause to be filed outside Uganda, an application for a patent for invention, unless-

- (a) an application for a patent for the same invention has been filed with the registrar not less than six weeks before the filing of the application outside Uganda; and
- (b) either no directions have been given under section 15 in relation to the application in Uganda or any such directions have been revoked.

(2) Subsection (1) shall not apply to an application for a patent for an invention in respect of which an application for a patent has first been filed in a country outside Uganda by a person resident outside Uganda.

(3) A person who files or causes to be filed an application for the grant of a patent in contravention of this section shall be liable on conviction, to imprisonment for a term not exceeding two years, or to a fine not exceeding forty-eight currency points, or to both.

(4) In this section-

- (a) any reference to an application for a patent includes a reference to an application for other protection for an invention;
- (b) any reference to either kind of application is a reference to an application under this Act, under the law of any country other than Uganda or under any international treaty or convention to which Uganda is a party.

17. Patents relating to micro- biological processes or products.

- (1) If an invention concerns a micro-biological process or the product thereof and involves the use of a micro-organism which is not available to the public and which cannot be described in the patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed if-
 - (a) a culture of the micro-organism has been deposited with a depository institution not later than the date of filing of the application;
 - (b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and
 - (c) the depository institution and the file number of the culture deposit are stated in the application.
- (2) The information referred to in paragraph (b) of subsection (1) may be submitted within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date.
- (3) The deposited culture shall be made available upon request of any person having the right to inspect the files.
- (4) If a deposited micro-organism ceases to be available from the institution with which it was deposited because:
 - (a) the micro-organism is no longer viable; or
 - (b) for any other reason the depository institution is unable to supply samples, and if the micro-organism has not been transferred to another depository institution from which it continues to be available, an interruption in availability shall

not be deemed to have occurred if a new deposit of the micro-organism originally deposited is made within a period of three months from the date on which the depositor was notified of the interruption by the depository institution and a copy of the receipt of the deposit issued by the institution is forwarded to the Industrial Property Department within four months from the date of the new deposit stating the number of the application or of the patent.

(5) A new deposit shall be accompanied by a statement signed by the depositor indicating that the newly deposited micro-organism is the same as originally deposited.

PART IV – RIGHT TO INVENTIONS AND NAMING OF INVENTOR.

18. Right to a patent.

- (1) Subject to this section, the right to a patent shall belong to the inventor.
- (2) If two or more persons have jointly made an invention the right to the patent shall belong to them jointly.
- (3) If, and to the extent that, two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date, or if priority is claimed, the earliest validly claimed priority date that leads to the grant of a patent, shall have the right to the patent.
- (4) The right to a patent may be assigned or may be transferred by succession.
- (5) Sections 52 to 66 shall apply, with the necessary modifications, to contracts assigning the right to a patent.

19. Unauthorised application based on an invention of another person.

Where the applicant has obtained the essential elements of the invention which is the subject of his or her application from the invention of another person, he or she shall, unless authorised by the person who has the right to the patent or who owns the patent, be obliged to assign to such person the application or, where the patent has already been granted, the patent.

20. Inventions made in execution of commission or by employee.

- (1) Notwithstanding section 18 and in the absence of contractual provisions to the contrary, the right to a patent for an invention made in execution of a commission or of an employment contract shall belong to the person having commissioned the work or to the employer. Provided that where the invention is of exceptional importance the employee shall have a right to equitable remuneration taking into consideration his or her salary and the benefit derived by the employer from the said invention.
- (2) The provisions of subsection (1) shall apply where an employment contract does not require the employee to exercise any inventive activity but when the employee has made the invention by using data or means available to him or her during his or her employment.
- (3) In the circumstances provided for in subsection (2), the employee shall have a right to equitable remuneration taking into account his or her salary, the importance of the invention and any benefit derived from the invention by the employer.
- (4) In the absence of agreement between the parties, the court shall fix the remuneration.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (5) Inventions made without any relation to an employment or service contract and without the use of the employer's resources, data, means, materials, installations or equipment shall belong solely to the employee or the person commissioned.
- (6) This section shall, where relevant, apply directly or indirectly to Governmental and other organisations.

21. Naming of inventor.

The inventor shall be named as such in the patent application and in the patent unless in a special written declaration addressed to the registrar he or she indicates that he or she wishes not to be named and any promise or undertaking by the inventor made to any person to the effect that he or she will make such declaration shall be without legal effect.

PART V – APPLICATION, GRANT AND REFUSAL OF GRANT OF PATENT.

22. Application for a patent.

- (1) An application for a patent shall be filed with the registrar and shall contain-
 - (a) a request;
 - (b) a description;
 - (c) one or more claims;
 - (d) one or more drawings (where necessary);
 - (e) an abstract; and
 - (f) such other details as shall be prescribed by the regulations made under this Act.

UGANDA LAW REFORM COMMISSION

- (2) Where the applicant's ordinary residence or principal place of business is outside Uganda, he or she shall be represented by an agent who shall be a resident of Uganda and admitted to practice before the High Court of Uganda.
- (3) The request shall state the name of, and prescribed data concerning, the applicant, the inventor and the agent, if any, and the title of the invention and where the applicant is not the inventor the request shall be accompanied by a statement justifying the applicant's right to the patent.
- (4) The appointment of an agent shall be indicated by the designation of the agent in the request or by furnishing a power of attorney signed by the applicant and, where subsection (2) applies, the agent shall be designated in the request.
- (5) The description shall disclose the invention and at least one mode for carrying out the invention, in such full, clear, concise and exact terms as to enable any person having ordinary skills in the art to make use and to evaluate the invention and that description shall include any drawings and relevant deposits as in the case of micro-organisms and self-replicable material which are essential for the understanding of the invention.
- (6) The claim or claims shall define the matter for which protection is sought and shall be clear and concise and fully supported by the description.
- (7) The abstract shall merely serve the purpose of the technical information; in particular, it shall not be taken into account for the purpose of interpreting the scope of the protection sought.

- (8) The details of the requirements with which the application must comply shall be prescribed by regulations made under this Act.

23. Unity of inventions.

- (1) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
- (2) The regulations shall contain rules concerning compliance with the requirements of unity of invention under subsection (1).
- (3) The fact that a patent has been granted on an application that did not comply with the requirements of unity of invention shall not be a ground for the invalidation or revocation of the patent.

24. Amendment and division of application.

- (1) The applicant may amend the application, provided that the amendment shall not go beyond the substance of the disclosure made by the applicant in the initial application.
- (2) The applicant may divide the initial application into one or more applications (hereinafter referred to as “divisional applications”) provided that each divisional application shall not go beyond the disclosure made in the initial application.
- (3) Each divisional application shall be entitled to a filing date and where appropriate, the priority date of the initial application.

25. Right of priority.

- (1) The application may contain a declaration claiming the priority as provided for in the Paris Convention of one or more earlier national, regional or international applications filed by the applicant or his or her predecessor in title in or of any State party to the Paris Convention.
- (2) The registrar may, at any time after the expiration of three months from the filing of an application containing the declaration, require that the applicant furnish a copy of the earlier application, certified as correct by the industrial property office with which it was filed or, where the earlier application is an international application filed under the Patent Cooperation Treaty, by the International Bureau.

26. Information concerning corresponding foreign applications and grants.

- (1) At the request of the registrar, an applicant shall furnish the registrar with the date and number of any application of a patent or other title of protection filed by the applicant with the office responsible for registration of industrial property of another country or with a regional industrial property office (in this Act referred to as a ‘foreign application’), relating to the same invention as that claimed in the application filed with the registrar.
- (2) The applicant shall, at the request of the registrar, furnish the registrar with the following documents relating to one of the foreign applications:
 - (a) copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (b) a copy of the patent or other title of protection granted on the foreign application; and
- (c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.
- (3) The applicant shall, at the request of the registrar, furnish the registrar with a copy of any decision revoking or invalidating the patent or any other title of protection granted by the applicant on the basis of the foreign application.
- (4) The applicant shall, at the request of the registrar, furnish the registrar with copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of any foreign application other than the one referred to in subsection (2).
- (5) The documents furnished under this section shall merely serve the purpose of facilitating the evaluation of novelty claimed in the application filed with the registrar or in the patent granted on the basis of that application.
- (6) The applicant shall have the right to submit comments on the documents furnished under this section.
- (7) The details of the requirements under this section shall be prescribed by regulations.

27. Payment of fees.

- (1) The application shall be subject to the payment of the prescribed fees.
- (2) The registrar may waive the whole or part of the fees in the manner and in the circumstances as may be prescribed.

28. Withdrawal of application.

The applicant may withdraw the application at any time before the grant of a patent or before the notification of rejection of the application or before the refusal to grant a patent but the applicant shall, if he or she does so, forfeit the prescribed fees.

29. Filing date and examination of application as to form, etc.

(1) The registrar shall record as the filing date, the date of receipt of the application, provided at the time of receipt the documents filed contain:

- (a) the name of applicant;
- (b) a part which on the face of it appears to be a description; and
- (c) a part which on the face of it appears to be a claim or claims.

(2) If the registrar finds that the application did not, at the time of receipt, fulfill the prescribed requirements, the registrar shall invite the applicant to file the required correction.

(3) If the applicant complies with the invitation referred to in subsection (2), the registrar shall record as the filing date the date of receipt of the required correction; otherwise the registrar shall treat the application as if it had not been filed.

(4) Where the application refers to drawings, which are not included in the application, the registrar shall invite the applicant to furnish the missing drawings and if the applicant complies with the invitation the registrar shall record as the filing date the date of receipt of the missing drawings.

(5) Where no invitation under subsections (2) and (4) was sent to the applicant and the applicant nevertheless files a correction pertaining to any of the requirements under

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

subsection (1) to his or her application, the registrar shall record as the filing date the date of receipt of the correction, provided that the correction was received within thirty days from the date of application.

- (6) If the applicant wishes to submit a correction to the application after thirty days from the date of submission of the application, the applicant shall seek leave from the registrar, and in such a case the registrar shall record as the filing date the date of receipt of the correction.
- (7) Where the request is accompanied by the statement on the right to the patent, the registrar shall send a copy of the statement to the inventor and the inventor shall have the right to inspect the application and to receive, at his or her own expense, a copy thereof.
- (8) The registrar shall cause an examination to be carried out as to whether there are any of the following defects with respect to the application:
 - (a) the request does not comply with the requirements of section 22(3) and the rules pertaining thereto;
 - (b) the description, the claims and, where applicable, the drawings do not comply with the physical requirements prescribed by the regulations;
 - (c) the application does not contain an abstract;
 - (d) the applicant has not complied with a request of the registrar under section 26; or
 - (e) the fees referred to in section 27 have not been paid as provided for in the regulations or the payment of such fees has been waived under that section.

- (9) If the registrar finds any of the defects referred to under subsection (7), the registrar shall invite the applicant to remedy such defects provided that any corrections made to the application shall not be such that they would require a change of the filing date; and if the applicant does not comply with the invitation, the application shall be rejected by the registrar.
- (10) The details of the requirements and the procedure under this section shall be prescribed by regulations.

30. Publication of application.

- (1) The registrar shall publish the application as soon as possible after the expiration of eighteen months from the filing date or, where priority is claimed, from the date of priority.
- (2) For the purposes of subsection (1), in the case of applications claiming priority, the term of eighteen months shall be construed from the original filing date and in the case of applications with two or more priority claims, the period shall be construed from the earliest priority dates.
- (3) The publication of the patent application shall be effected by publishing the particulars set out in the regulations, in the Gazette or a medium .

31. International type search.

- (1) The registrar may instruct that any application found in order as to form be the subject of an international-type search.
- (2) When a direction under subsection (1) is made, the registrar shall invite the applicant to pay the prescribed fee; and if the applicant does not comply with the invitation, the application shall be rejected.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (3) Upon receipt of the report on the international-type search, the registrar may request the applicant to furnish him or her with a copy of any document cited in the report, and if without lawful reason any copy is not furnished within the prescribed time limit, the application shall be rejected.
- (4) If it is apparent from the report on the international-type search or from the declaration on the non-establishment of the report, that the subject of the application or of any claim or claims is not an invention, the registrar shall reject the defective application or consider the defective claim or claims to be withdrawn, as the case may be, unless the applicant satisfies the registrar that the subject of the application or claims constitutes an invention.
- (5) If it is apparent from the report on the international-type search or from the declaration on the non-establishment of the report, that:
 - (a) the description, the claims or, where applicable, the drawings do not comply, in whole or in part, with the prescribed requirements to such an extent that no meaningful search could be carried out; or
 - (b) the application does not comply, in whole or in part, with the requirements of unity of invention prescribed by section 23 and the rules pertaining thereto; or
 - (c) the invention claimed in the application does not fulfill the requirements of novelty;

the registrar shall reject the application unless the applicant either satisfies him or her that the requirements have been fulfilled or amends or divides the application so as to comply with the requirements.

- (6) The details of the requirements and the procedures under this section shall be prescribed by the regulations.

32. Examination as to substance.

- (1) The registrar may, by notice in the Gazette-
 - (a) direct that applications for patents relating to a specified field or specified technical fields shall be the subject of an examination as to substance; or
 - (b) amend any direction issued pursuant to paragraph (a).
- (2) Where an application for a patent satisfies the requirements specified in subparagraph (7) of section 29 and the subject matter thereof does not fall within a technical field specified under subsection (1) of this section, the registrar shall so notify the applicant who shall, within three years from the filing date of the application, submit a request in the prescribed form for the examination of the application pursuant to the provisions of subsection (3). Provided that where no request is made within the prescribed period, the application shall be deemed to be abandoned.
- (3) Where a request is filed under subsection (2), the registrar shall cause an examination of the application to be made as to whether:
 - (a) the invention in respect of which the application is made is patentable within the meaning of this Act; and
 - (b) the application complies with the requirements of subsections (5) and (6) of section 22.
- (4) For the purposes of the examination under subsection (3), the registrar may submit the application together with the relevant documents to an examiner or other competent authority for examination as to the patentability of the claimed invention and the examiner or other competent authority shall submit a report of the findings of the examination to the registrar who shall submit a copy thereof to the applicant.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (5) Save where an application is subject to an international-type search under section 31, the registrar shall cause an examination to be carried out as to whether the application complies with the requirements of unity of invention prescribed under section 23 and the rules pertaining thereto.
- (6) If the registrar is of the opinion that the requirements of unity of invention have not been complied with, the registrar shall invite the applicant to restrict or divide the application.
- (7) Where, taking due account of the conclusions of any report referred to in subsection (5), the registrar is of the opinion that any of the conditions referred to in subsection (2) are not fulfilled, the registrar shall notify the applicant accordingly and invite him or her to submit his or her observations and, where applicable, to amend his or her application.
- (8) Where, despite any observation or amendment submitted by the applicant, the registrar finds that any of the conditions referred to in subsection (2) are not fulfilled, the registrar shall refuse the grant of a patent and notify the applicant accordingly.
- (9) The details of the requirements and the procedure to be followed under this section shall be prescribed by regulations.

33. Grant, registration and publication of a patent.

- (1) Unless an application has been rejected or a patent has been refused under section 32, a patent shall be granted and issued to the applicant in the prescribed form.
- (2) Every patent granted under subsection (1) shall be registered, and shall, as soon as reasonably practicable, be published by the registrar in the Gazette.

- (3) The registrar shall, whenever possible, reach a decision on the application not later than two years from the commencement of the examination referred to in section 32.
- (4) The registrar shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by it, where the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

34. Appeals.

The applicant may appeal within two months to the court against any decision by which the registrar records a filing date, rejects the application, treats the application as if it had not been filed, considers any of the claims to be withdrawn or refuses to grant a patent.

PART VI – INTERNATIONAL APPLICATIONS.

35. Interpretation of part VI.

For the purposes of this part-

- (a) “International Application” means an international application filed in accordance with the Patent Cooperation Treaty and the Regulations established thereunder;
- (b) “Receiving Office,” “Designated Office,” “Elected Office,”
- (c) “International publication,” “international search report,” “international preliminary examination report,” and the words “to designate” and “to elect” have the meanings respectively assigned to them in the Patent Cooperation Treaty.

36. Further functions of the industrial property department.

- (1) The industrial property department shall act as a receiving office where an international application is filed with it by a national or a resident of Uganda.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (2) The industrial property department shall act as a designated office or an elected office in the case of any international application in which Uganda is designated or elected for a national patent.
- (3) The functions of the industrial property department under this Part shall be performed in accordance with the provisions of the Patent Cooperation Treaty, the regulations made thereunder and the administrative instructions issued under the said regulations and with the provisions of this Act and the regulations pertaining thereto. Provided that in case of conflict, the provisions of the Patent Cooperation Treaty, the regulations and the administrative instructions issued thereunder shall apply.

37. Unsearched or unexamined international applications, etc

- (1) Where an international search report is not established or relates to only one or some of the claims of the international application, the registrar shall reject the international application or consider withdrawn the claim or claims not covered by the report, as the case may be, except to the extent that the applicant satisfies the registrar that the non-establishment of the report in whole or in part was not justified.
- (2) Where the international search report related to only one or some of the claims due to the applicant's refusal to pay additional fees, those parts of the international application which consequently have not been searched shall be considered withdrawn unless the applicant divides out from the application as provided for in section 24 (2) the parts concerned or satisfies the registrar that the invitation to pay the additional fees was not justified.

UGANDA LAW REFORM COMMISSION

- (3) Where an international preliminary examination report with respect to an international application has been communicated to the registrar the following paragraphs shall apply:
- (a) where, in the case of lack of compliance with the requirements of unity of invention, the international preliminary examination report indicates that the international preliminary examination was carried out on restricted claims, or was carried out on the main invention only, those parts of the international application indicated as not having been the subject of international preliminary examination shall be considered withdrawn unless the applicant divides out from the application as provided for in section 24(2) in parts concerned or satisfies the registrar that the invitation of the international preliminary examining authority was not justified; and
- (b) where the international preliminary examination report states, with respect to the entire international application or one or some of its claims only, the opinion that a defect under Article 34(4) (a) of the Patent Cooperation Treaty exists under the international application or the claim or claims, as the case may be, the application shall be considered withdrawn unless the applicant satisfies the registrar that the defects do not exist.
- (4) The registrar may refuse to grant a patent if it is apparent from an international search report or an international preliminary examination report that an invention claimed in an international application does not fulfill the requirements of novelty, unless the applicant either satisfies the registrar that the requirements have been fulfilled or amends the claims in such a way that fulfils the requirements.

38. Provisional protection of published international applications.

- (1) Relief against infringement may be sought in respect of acts committed before the grant of the patent but after the date of international publication under the Patent Cooperation Treaty, where the said international publication was effected in English.
- (2) If the international publication was effected in a language other than English, subsection (1) shall apply where applicant had transmitted an English translation of the international publication to the infringer and only in respect of acts committed by the latter after he or she had received such translation.

39. Publication of international applications.

An international application which is published under Article 21 of the Patent Cooperation Treaty and in which Uganda is designated for a national patent shall be treated as published in terms of the provisions of section 30.

**PART VII – RIGHTS AND OBLIGATIONS OF THE APPLICANT
OR THE OWNER OF THE INVENTION.**

40. Rights of the owner.

- (1) The applicant or the owner of an invention shall have the right:
 - (a) on fulfillment of the relevant requirements under this Act, to be granted the patent,
 - (b) to make, use, exercise and sell the invention exclusively, and may preclude any person from exploiting the patented invention without his or her authorisation by any of the following acts-

UGANDA LAW REFORM COMMISSION

- (i) when the patent has been granted in respect of a product, making, importing, offering for sale, selling and using the product or stocking the product for the purposes of offering for sale, selling or using the product;
 - (ii) when the patent has been granted in respect of a process or doing any of the acts referred to in paragraph (a) of this subsection in respect of a product obtained by means of the process.
- (c) When the patent has been granted in respect of a new use, putting the patented product or process into a new use without the prior authorisation of the owner of the patent.
- (d) After the grant of the patent, and within the terms of this section, the owner of the patent has a right to preclude any person from exploiting the patented invention in the manner referred to in subsection (1).
- (2) The owner of a patent may assign or transfer by succession the application for patent or the patent.
- (3) The applicant or owner of a patent may conclude license contracts as provided for in part X of this Act and be subject to the obligations referred to in section 42

41. Obligations of the owner.

The applicant or the owner of invention shall have the following obligations:

- (a) to disclose the invention in a clear and complete manner, and in particular to indicate at least one mode for carrying out the invention, in accordance with the requirements, and subject to the sanctions, applicable under this Act;
- (b) to give information concerning corresponding foreign applications and grants;

- (c) to pay fees to the registrar, as prescribed in this Act and the regulations, subject to the sanctions provided for therein;
- (d) to work the patented invention in the country within the time limit prescribed;
- (e) in connection with licence contracts and contracts assigning patents or patent applications, to refrain from making undesirable provisions referred to in section 56.

42. Remedies.

The owner of a patent shall have the right-

- (a) to obtain an injunction to restrain the performance or the likely performance, by any person without his or her authorisation, of any of the acts referred to in section 40;
- (b) to claim damages from any person who, having knowledge of the patent, performed any of the acts referred to in section 40, without the owner's authorisation.
- (c) to claim compensation from any person who, without his or her authorization, performed any of the inventions claimed in the published application, as if a patent had been granted for that invention: Provided that the said person, at the time of the performance of the act, had:
 - (i) actual knowledge that the invention that he or she was using was the subject matter of a published application; or
 - (ii) received written notice that the invention that he or she was using was the subject matter of a published application, such application being identified in the said notice by its serial number.

43. Right of a prior user.

- (1) Notwithstanding the provisions of section 40, a patent shall have no effect against any person (hereinafter referred to as “the prior user”) who, in good faith, for the purposes of his or her enterprise or business, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted, and within the territory where the patent produces its effect, was using the invention or was making effective and serious preparations for such use.
- (2) Any such person shall have the right, for the purposes of his or her enterprise or business, to continue such use or to use the invention as envisaged in such preparations.
- (3) The right of the prior user may only be transferred or may only devolve together with his or her enterprise or business, or with that part of his or her enterprise or business in which the use or preparations for use have been made.

44. Scope of protection.

The scope of the protection afforded to a patent shall be determined by the terms of the claims but where these are inadequate, the description and the drawings included in the patent may be used to interpret the claims.

45. Limitation of rights.

- (1) The rights under the patent shall extend only to acts done for industrial or commercial purposes but shall not extend to acts done for scientific research.
- (2) The rights under the patent shall not extend to acts in respect of articles which have been put on the market in Uganda or in any other country or imported into Uganda by the owner of the patent or with his or her express consent.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (3) The rights under the patent shall not extend to the use of articles on aircraft, land vehicles or vessels of other countries, which temporarily or accidentally enter the airspace, territory, or waters of Uganda.
- (4) The rights under the patent shall not affect the acts performed by any person who in good faith, before the filing or, where priority is claimed, before the priority date of the application on which the patent is granted and in Uganda, was using the invention or was making effective and serious preparations for such use, to the extent that those acts do not differ in nature or purpose from the actual or envisaged prior use and provided that the right of prior user referred to in this section may be transferred or devolve only together with the enterprise of business, or with that part of the enterprise or business, in which the use or preparations for use have been made.
- (5) The rights under the patent shall be limited by the provisions of the terms of the patent.
- (6) The rights under the patent shall be limited by the provisions on compulsory licences for reasons of public interest, the interdependence of patents, or the exploitation of patented inventions by the State.
- (7) The rights of the patent shall not extend to variants or mutants of living forms or replicable living matter that is distinctively different from the original for which patents were obtained where such mutants or variants are deserving of separate patents.

46. Exception to exclusive rights.

It shall not be an infringement of a patent to use the patented invention without the authorisation of the patent holder in any of the following circumstances-

- (a) to carry out any acts related to experimental use on the patented invention, whether for scientific or commercial purposes;
- (b) to make use of a patented invention for teaching purposes;
- (c) to carry out acts, including testing, using, making or selling a patented invention solely for the purposes reasonably related to the development and submission of information required under any law of Uganda or of a third country which regulates the manufacture, construction, use, sale of any product;
- (d) to make use of the patented invention in relation to the preparation for individual cases, in a pharmacy or by a medical doctor, of a medicine in accordance with a medical prescription; and
- (e) to manufacture and export to a third country a patented healthcare invention where the export of the invention addresses a health need identified by the third country, provided that the product is either -
 - (i) not patented in the third country; or
 - (ii) that Government has authorized use of the patent without consent of the patent owner and that the production of or export of the invention is intended only for the market of the third country.

47. ARIPO Protocol on Patents.

A patent, in respect of which Uganda is a designated state, granted by ARIPO by virtue of the ARIPO Protocol shall have the same effect in Uganda as a patent granted under this Act except where the registrar communicates to ARIPO, in respect of the application thereof, a decision in accordance with the provisions of the Protocol that if a patent is granted by ARIPO, that patent shall have no effect in Uganda.

PART VIII – TERM OF PATENT AND ANNUAL FEES.

48. Term of patent.

A patent shall expire at the end of twenty years from the filing date of the application.

49. Annual fees.

- (1) In order to maintain the application or the patent, an annual fee shall be paid in advance and in the manner prescribed to the industrial property department. The fee shall fall due on the eve of each anniversary of the date of filing of the application or the grant of the patent.
- (2) A grace period of six months shall be granted for the payment of the annual fee upon payment of such surcharge as may be prescribed from time to time.
- (3) If an annual fee is not paid in accordance with this section, the application shall be deemed to have been withdrawn or the patent shall lapse and respective invention shall cease to be protected.
- (4) The registrar shall forthwith publish the lapse of any patent under subsection (3).
- (5) Within six months from the expiration of the grace period referred to in subsection (2), any interested person may, upon payment of the prescribed fee, request the registrar to restore an application that is deemed to have been withdrawn, or a patent that has lapsed, by virtue of subsection (3).

- (6) Upon a request under subsection (5), the registrar shall, if satisfied that the failure to pay the annual fee was not intended, subject to the payment of the annual fee, make an order restoring the application or the patent as the case may be.
- (7) Where a patent is restored, no proceedings shall be brought in respect of the patent-
 - (a) with respect to any acts performed after the lapse of the patent and before the date of the order for restoration; or
 - (b) with respect to any acts performed after the date of the order of restoration in relation to articles imported into or manufactured in Uganda, after the lapse of the patent and before the date of the order for restoration.

PART IX – CHANGE IN THE OWNERSHIP AND JOINT OWNERSHIP OF APPLICATIONS AND PATENTS.

50. Change in ownership of applications, etc.

- (1) All contracts assigning patents or applications for patents shall be in writing and shall be signed by the party making the assignment.
- (2) Any change in the ownership of a patent or an application for a patent shall, on payment of a fee fixed by regulations, be recorded in the patent register, and until the change has been recorded, any document evidencing the change in ownership shall not be admitted in any proceedings as evidence of the title of any person to an application or a patent, unless the court otherwise directs.

51. Joint ownership of applications and patents.

In the absence of an agreement to the contrary between the parties, joint owners of a patent or an application for a patent may, separately:

- (a) transfer their shares in the patent or the application for the patent,
- (b) exploit the protected patent, and preclude any person from exploiting the patent,

- (c) may only jointly grant permission to any third person to do any of the acts referred to in section 42.

PART X – CONTRACTUAL LICENCES.

52. Rights of licensee.

- (1) In the absence of any provision to the contrary in the licence contract, the licensee shall be entitled to do any of the acts referred to in section 40 in respect of the invention, without limitation as to time, in the whole of Uganda and in any field of use of the invention, utility model or industrial design.
- (2) In the absence of any provision to the contrary in the licence contract, the licensee may not grant permission to any third person to do any of the acts referred to in section 40.

53. Right of licensor to grant further licences and use of the invention.

- (1) In the absence of any provision to the contrary in the licence contract, the licensor may grant permission to any third person to do, or may himself or herself do, any of the acts, which constitute exercising the rights of ownership.
- (2) If the licence contract provides that such contract or the permission granted by it is exclusive, the licensor may neither grant permission to any third person to do any of the acts referred to in section 40 and covered by the licence contract, nor him or herself do any of those acts, and the licensee shall be considered an exclusive licensee for the purposes of this Act.

54. Effects of patent not being granted, revoked or being invalidated.

Where, before the expiration of the licence contract any of the following events occurs with respect to any patent or application for a patent referred to in that contract-

- (a) the application is withdrawn;
 - (b) the application is finally rejected; or
 - (c) that patent is finally revoked or declared invalid,
- the court may make any order it deems reasonable under the circumstances for the repayment of the royalties or the return of any consideration paid or given under the contract and directly relating to any such application or patent.

55. Form of licence contracts.

All licence contracts shall be in writing and shall be signed by the parties thereto.

56. Petition for registration.

- (1) All licence contracts, including modifications thereof, shall be submitted to the industrial property department for registration in the patent register.
- (2) A petition for registration under subsection (1) may be made by any party to the contract, and shall be accompanied by such documents and fees as may be prescribed.
- (3) The registrar shall issue to the applicant a receipt, which shall be proof of the fact of filing the petition and of the date on which it was filed and if no receipt is issued within fourteen days from the date of the petition, the petitioner may rely on other evidence to prove the fact and date.

- (4) Where-
 - (a) section 54 or subsections (2) to (4) and the rules relating thereto, have not been complied with; or
 - (b) the licence contract cannot be registered under section 57, the registrar shall refuse to register the licence contract and shall state the reasons for such refusal.

- (5) Before refusing to register the licence contract, the registrar shall notify the petitioner and allow the parties:
 - (a) to submit their observations, if any;
 - (b) to correct any defect in the petition; or
 - (c) to amend any term, or to correct any defect, in the licence contract that has been declared by the registrar to be a term of defect precluding registration, within forty-five days from the date of the notification.

- (6) A licence contract shall be void if the registration has been refused by the registrar in accordance with the provisions of this Act.

57. Prohibited terms in licence contracts.

The registrar may refuse to register a licence contract if the registrar is of the opinion that any clause in a licence contract imposes unjustified restrictions on the licensee with the consequence that the contract, taken as a whole, is harmful to the economic interests of Uganda, the effect of any such term contained in the contract being, for instance-

- (a) to require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the contract relates;
- (b) to require the licensee to acquire any materials from the licencor or from sources designated or approved by him or her, unless it is practically impossible to ensure the quality of the products to be produced;

UGANDA LAW REFORM COMMISSION

- (c) to prohibit the licensee from acquiring, or to restrict his or her acquisition of any materials from any source, unless it is practically impossible to ensure that quality of the products to be produced;
- (d) to prohibit the licensee from using, or to restrict his or her use of any materials which are not supplied by the licensor or by sources designated or approved by him or her, unless it is practically impossible to ensure the quality of the products to be produced;
- (e) to require the licensee to sell products produced by him or her under the contract exclusively or principally to persons designated by the licensor;
- (f) to limit the volume of the products produced by the licensee with the help of the technology to which the contract relates;
- (g) to oblige the licensee to employ persons designated by the transferor and not needed for the efficient transfer of the technology to which the contract relates, provided that, for persons so needed, the contract shall provide for training of the persons to replace them within a reasonable period;
- (h) to impose restrictions on research or technological development carried out by the licensee to absorb or adapt the technology in connection with new products, processes or equipment;
- (i) to prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates or not owned by the licensor;
- (j) to extend the coverage of the contract to technology not required for the use of the technology which is the main subject of the contract and to require consideration for such additional technology;
- (k) to fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the contract relates;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (l) to prohibit or restrict the use by the licensee, after the expiration of the contract, of the technology acquired as a result of the contract, subject, however, to any right of the licensor under the patent;
- (m) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, provided that any period which does not exceed the duration of the patent to which the contract relates shall not be regarded as unreasonably long;
- (n) to restrict the licensee from entering into sales, representation or manufacturing agreements relating to similar or competing technologies, when such restrictions are not needed for protecting the legitimate interests of the licensor; including, in particular, protecting the licensor's industrial or intellectual property rights or ensuring that the licensee exercises his or her best efforts in respect of any manufacturing, distribution or promotional obligations;
- (o) to prevent the licensee from adapting the technology to local conditions or introducing innovations in it or change to alternative inputs, or to require the licensee to introduce unnecessary designs or specification changes if the licensee makes adaptations on his or her own responsibility and without using the licensor's name, trade or service marks or trade names, and except to the extent that this adaptation unsuitably affects those products, to be supplied by the licensor, his or her designates, or his or her other licensees, or to be used as a component or spare part in a product to be supplied to his or her customer;
- (p) to impose acceptance of additional technology, future inventions and improvements, and goods or services not wanted by the licensee;
- (q) to impose restrictions on territories, quantities, prices, customers or markets arising out of patent pool or cross-

UGANDA LAW REFORM COMMISSION

licensing agreements or other international technology transfer interchange arrangements which unduly limit access to new technological developments or which would result in an abusing domination of an industry or market with adverse effects on the licensee, except for those restrictions appropriate and ancillary to co-operative arrangements such as co-operative research arrangements;

- (r) to impose restrictions which regulate advertising or publicity by the licensee except where restriction of such publicity may be required to prevent injury to the licensor's goodwill or reputation where the advertising or publicity makes reference to the licensor's name, trade or service marks, trade names or other identifying items;
- (s) to impose confidentiality after the expiry of the licence agreement or to impose unreasonably long periods for secrecy following the commissioning of manufacturing facilities using the licensed technology, or to impose measures which limit technological learning and mastery, except those which relate to industrial property rights;
- (t) to impose requirements for payments even under conditions of *force majeure*;
- (u) to impose restrictions which prevent or hinder export by means of territorial or quantitative limitations or prior approval for export or export prices of products or increased rates of payments for exportable products resulting from the technology licensed;
- (v) to impose quality control methods or standards not needed by licensee, except to meet the requirement of a guarantee or when the product bears a trade mark, service mark or trade name of the licensor;
- (w) to allow the licensor to participate permanently in the management of the licensee's business as a condition for obtaining the technology;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (x) to restrict the licensee from taking measures that will enhance local technological capability and which are not prejudicial to the licensor's industrial property rights;
- (y) to restrict the use of local expertise in management and consultancy or in any other positions;
- (z) to require payment of royalty for patents granted outside Uganda;
- (aa) to apply dissimilar conditions to equivalent transactions with other trading parties, thereby placing the licensee at a competitive disadvantage; or
- (bb) to make the contract subject to acceptance of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of such contracts.

58. Registration of the contract and issue of certificate.

- (1) Where the registrar finds that the licence contract may be registered, the registrar shall register the contract and issue a certificate of registration to the petitioner.
- (2) If the registrar fails to notify the petitioner-
 - (a) of defects in the petition or of terms or defects precluding registration of the licence contract within ninety days of the date of the petition; or
 - (b) of his or her decision to refuse to register the licence contract within ninety days of the date of notification, the licence contract shall be deemed to have been registered and the registrar shall issue a certificate of registration to the petitioner.
- (3) The registration shall take effect-
 - (a) if the petition was made within sixty days from the conclusion of the contract, on the date of the conclusion of the contract, and

UGANDA LAW REFORM COMMISSION

- (b) in all other cases, on the date of the petition.
- (4) When the petition is corrected or the licence contract is amended under section 56(5), the petition shall be deemed to have been received on the date when the correction or amendment was made.
- (5) The registration and the certificate shall state:
 - (a) the name of the parties to the contract and of the licensee if he or she is not a party;
 - (b) the date of the petition;
 - (c) the date of the registration; and
 - (d) the registration number,

all of which shall be published in the Gazette.

- (6) The contents of the contract shall be confidential unless both parties to the contract agree to permit access thereto by third parties and such access shall only be to the extent of the permission so granted.

59. Appeal.

An appeal against the decision of the registrar may be made to the court by the petitioner within two months of the registrar's refusal to register the licence provided that the grounds of such an appeal shall be limited to the following:

- (a) that the decision of refusal contains no statement of the reasons for refusal;
- (b) that none of the reasons specified in the decision is a valid reason under this Act or that such reason was wrongly applied to the petitioner or to the licence contract; or
- (c) that the procedure applied by the registrar was irregular and prejudicial to the rights of the petitioner.

60. Compulsory licences for non-working and similar reasons.

- (1) At any time after four years from the filing date of an application or three years from the grant of a patent, whichever period last expires, any person may apply to the court for a licence to exploit the patented invention on the grounds that the market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Uganda.
- (2) Notwithstanding subsection (1), a non-voluntary licence shall not be granted if the owner of the patent satisfies the court that circumstances exist which justify the fact that the market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Uganda.

61. Compulsory licences based upon interdependence of patents.

- (1) Where a patented invention cannot be worked without infringing the rights derived from an earlier patent, the owner of the latter patent may request the court at any time for the grant of a compulsory licence with respect to the earlier patent to the extent necessary for the working of his or her invention, if the invention constitutes an important technical advance of considerable economic significance in relation to the invention claimed in the earlier patent.
- (2) The owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent.
- (3) The use authorised in respect of the first patent shall be non-assignable except with the assignment of the second patent.

- (4) In this section, “earlier patent” or “first patent” means a patent granted on an earlier application or benefiting from an earlier validly claimed priority date, and “later patent” or “second patent” shall be construed accordingly.

62. Preconditions for grant of compulsory licences.

- (1) A compulsory licence shall not be granted unless the person requesting the licence:
- (a) satisfies the court that he or she has asked the owner of the patent for a contractual licence but has been unable to obtain the licence on reasonable commercial terms and within a reasonable time; and
 - (b) offers a guarantee satisfactory to the court to work the relevant invention sufficiently to remedy the deficiencies or to satisfy the requirements which gave rise to his or her request.
- (2) The requirement under subsection (1)(a) shall be waived in the case of a national emergency or other circumstances of extreme urgency or where the application is based on anti-competitive practices provided the owner of the patent shall be so notified as soon as is reasonably practicable.

63. Grant and terms of compulsory licences.

- (1) In considering a request for a compulsory licence, the court shall decide whether a compulsory licence may be granted and shall, if it decides in favour of the grant and taking into account any terms agreed by the parties, proceed to fix the terms which shall be deemed to constitute a valid contract between the parties and shall be governed by the provisions on contractual licences.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (2) In fixing the terms under subsection (1), the court shall ensure that the compulsory licence:
 - (a) is limited, in scope and duration, to the purpose for which it was authorised, and in the case of semi-conductor technology, shall only be for public non-commercial use or to remedy a practice determined after a judicial or administrative process to be anti-competitive;
 - (b) is limited predominantly for the supply of the regional market;
 - (c) does not entitle the licensee to grant further licences without the consent of the owner of the patent;
 - (d) is non-exclusive; and
 - (e) provides for the payment to the owner of the patent of remuneration which is equitable with due regard to all the circumstances of the case, including the economic and social value of the licence.

- (3) A representative of the industrial property department and the patent owner shall have the right to appear and be heard at the hearing before the court of an application for a compulsory licence.

64. Transfer of compulsory licence.

A compulsory licence may be transferred only with that part of the industrial undertaking or its goodwill, in which the relevant invention is used and no such transfer shall be valid until the consent of the court has been obtained.

65. Cancellation of compulsory licence.

- (1) On the application of any interested party, the court may cancel a compulsory licence if:
 - (a) the licensee fails to comply with the terms of the licence; or

UGANDA LAW REFORM COMMISSION

- (b) the conditions which justified the grant of the licence have ceased to exist and are unlikely to recur; provided that the legitimate interests of the licensee are adequately protected.
- (2) On the application of the Minister or on the application of the owner of the patent, the court may cancel the compulsory licence if, within two years from the grant of the licence, the licensee has not taken the necessary steps to work the relevant invention sufficiently so as to remedy the deficiencies or to satisfy the requirements which gave rise to his or her application for the said licence.
- (3) On the application of the owner of the patent or the licensee, the court may vary the terms of a compulsory licence if new facts on the owner's part justify the variation and in particular if the patent owner has granted contractual licence on more favourable terms

66. Registration of grants, cancellation or variation.

Where the court grants, cancels or varies the terms of a compulsory licence, the court shall instruct the registrar to record the grant, cancellation or variation in the register without payment of any fee.

67. Licences as of right.

- (1) The owner of a patent may request the registrar to make an entry in the register to the effect that licences under the patent are to be available as of right.
- (2) The request shall be notified by the registrar to the licensees under the patent.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (3) Any licensee may, within the prescribed time limit, object to the entry requested under subsection (1) on the ground that the owner of the patent is, by the relevant licence contract, precluded from granting further licences.
- (4) Where the registrar receives no objection under subsection (3) or considers all objections made to be unfounded, the registrar shall make the requested entry in the register and shall publish the entry.
- (5) Where a patent is the subject of an entry under this section, any person may require the owner of the patent to grant him or her a non-exclusive licence under the patent on terms which, in the absence of an agreement between the parties, shall be fixed by the court.
- (6) The amount of the annual fees with respect to a patent, which is subject of an entry under this section, falling due after the date of the entry, shall be reduced by half.
- (7) The owner of the patent may at any time request the registrar to cancel an entry under this section and the registrar shall cancel the entry after payment of the balance of all annual fees which would have been payable if no entry had been made and the registrar shall publish the cancellation of any entries under this section.
- (8) Section 65(3) shall apply, with the necessary modifications, where the terms of license granted under subsection (5) of this section have been fixed by the court.

PART XI – EXPLOITATION OF PATENTED INVENTIONS BY THE GOVERNMENT OR BY THIRD PERSONS AUTHORISED BY THE GOVERNMENT.

68. Exploitation of the patented inventions by the Government or by third persons authorised by the Government.

- (1) Subject to this section, where:
 - (a) the public interest, in particular, national security, nutrition, health, environmental conservation, national emergency or the development of other vital sectors of the national economy so requires; or
 - (b) the registrar determines that the manner of exploitation of an invention by the owner of the patent or his or her licensee is not competitive,

the Minister may, upon application to him or her in the prescribed form and after consultation with the industrial property department and the owner of the patent, order that the protected invention shall be exploited by a Government Ministry, department, agency or other person as the Minister may designate in the order subject to the payment of adequate compensation to the owner of the patent in accordance with this section.

- (2) Upon exercising the powers conferred upon the Minister under subsection (1), the Minister may, notwithstanding any of the measures set out under this section, authorise by written order the importation, manufacture or supply, or authorise the utilisation of any molecule or substance whatsoever by any individual, corporation, society, or other enterprise as named or described in the order without notice to the patent holder or any other notifiable party, and such order shall remain in force until revoked by the Minister in writing, after giving six months prior notice of his intention of such revocation to the party named or described in the order.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (3) An order made under subsection (2) shall not require the payment of compensation to the owner of the patent or licence holder or any other party so interested.
- (4) The Minister shall notwithstanding any of the measures set out in this section, authorise the utilisation of any process for the manufacture, sale or supply of any molecule or substance whatsoever, by any individual, corporation, society or other enterprise as named or described in the order and such order shall remain in force until revoked by the Minister in writing, giving six months prior notice of intention of such revocation to the party named or described in the order.
- (5) No application shall be made under subsection (1) unless the applicant has unsuccessfully sought a contractual licence from the owner of the patent: except that the provisions of this subsection shall not apply in cases of national emergency or other extreme urgency in which case the Minister shall cause the contents of the order to be communicated to the owner of the patent as soon as reasonably practicable.
- (6) An order under this section shall be subject to such conditions as the Minister may deem necessary.
- (7) Where an order under this section is made, the registrar shall fix the amount of the compensation to be paid to the owner of the patent, such compensation being equitable with due regard to all the circumstances of the case and in particular, the economic and social value of the patent.
- (8) An order under this section shall not preclude the owner of the patent from concluding a licence contract or from exercising the powers conferred by section 40 of this Act.

UGANDA LAW REFORM COMMISSION

- (9) The Minister may, upon the request of the owner of the patent or the Government Ministry, department, agency or other person designated by the Minister for the purposes of any order under this section and after hearing all interested parties, vary the terms of the order to the extent that changed circumstances justify such variation.
- (10) The Minister may, upon the request of the owner of a patent and after hearing all interested parties, revoke an order under this section-
- (a) if satisfied that the circumstances necessitating the order have ceased and are unlikely to recur; or
 - (b) where the Government Ministry, department, agency or other entity or person designated for the purposes of the order is in breach of any condition imposed under subsection (6).
- (11) The authorisation of any person in an order under this section shall not be transferable except to a business or enterprise owned or operated by that person.
- (12) The exploitation of the invention pursuant to an order under this section shall be primarily for the supply of the market in Uganda.
- (13) An order relating to the exploitation of an invention in the field of semi-conductor technology shall only be made where the court has determined that the manner of exploitation of the patented invention by the owner of the patent or his licensee is not competitive and the Minister is satisfied that the issuance of such order would remedy such practice.
- (14) A person aggrieved by any decision of the Minister under this section may appeal to the court.

PART XII – UTILITY MODELS.

69. Applicability of provisions relating to patents.

- (1) Subject to this section, the provisions of Parts III, IV, V, VII, VIII, IX, X, XI, XV and XVI shall apply, with the necessary modifications, to utility model certificates or applications, as the case may be.
- (2) Where the right to a patent conflict with the right to a utility model certificate in the case referred to in section 18(3), the said provision shall apply as if the word “patent” were replaced by the words “utility model certificate”.

70. Special provisions relating to utility model certificates.

- (1) An invention qualifies for a utility model certificate if it is new and industrially applicable.
- (2) Sections 10, 12, 31 32 and 47 shall not apply in the case of applications for utility model certificates.
- (3) A utility model certificate shall expire at the end of the tenth year after the date of the grant of a utility model and shall not be renewable.

71. Conversion of patent applications to applications for utility model certificates, and vice versa.

- (1) At any time before the grant or refusal of a patent an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.

UGANDA LAW REFORM COMMISSION

- (2) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert his or her application into a patent application, which shall be accorded the filing date of the initial application.
- (3) An application may not be converted under subsections (1) and subsection (2) more than once.

PART XII – INDUSTRIAL DESIGNS.

72. Definition of an industrial design.

- (1) For the purposes of this Part, “an industrial design” means any composition of lines or colours or any three dimensional form or any material, whether or not associated with lines or colours: Provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft and appeals to and is judged by the eye.
- (2) The protection under this Act shall not extend to anything in an industrial design which serves solely to obtain a technical result, and to the extent that it leaves no freedom as regards arbitrary features of appearance.

73. Right to industrial design; naming of creator.

- (1) Subject to the conditions of this Act and to the provisions of any other written law, the creator of an industrial design or his or her successors in title shall have the exclusive right to sell or cause to be sold for commercial or industrial purposes the goods in which the design is incorporated.

- (2) Sections 18, 20, and 21 shall apply, with the necessary modifications, to the rights of the creator of an industrial design.

74. Registrable industrial designs.

- (1) An industrial design is registrable if it is new.
- (2) An industrial design shall be deemed to be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or, in Uganda, by use or in other way, prior to the filing date or, where applicable, the priority date of the application for registration.
- (3) Section 11(3) shall apply, with the necessary modifications, in respect of priority dates of an industrial design.
- (4) Industrial designs that are contrary to public order or morality shall not be registrable.

75. Application and examination.

- (1) A person wishing to register an industrial design shall send to the industrial property department:
 - (a) an application in the prescribed form;
 - (b) a power of attorney, where the applicant is represented by an agent;
 - (c) drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used; and
 - (d) the prescribed application fee.

UGANDA LAW REFORM COMMISSION

- (2) The request may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional.
- (3) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.
- (4) Two or more industrial designs may be the subject of the same classification provided that they relate to the same class under International Classification or to the same set or composition of articles.
- (5) The application, at the time of filing, may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding 12 months from the date of filing or if priority is claimed from the date of priority of the application.
- (6) The applicant may at any time withdraw an application lodged under this section.
- (7) The registrar shall record as the filing date the date of receipt of the application: except that at the time of receipt of the application, the application fee is paid and the application contains the name of the applicant and a graphic representation of the article embodying the industrial design or a specimen thereof.
- (8) Sections 25 and 29(2) and (3) shall apply, with the necessary modifications, in respect of priority dates and the filing of corrections to the application.

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (9) The registrar shall, if satisfied that an application meets the requirements of this section and of sections 72 and 73, register the industrial design, publish a reference to the registration, and issue a certificate of registration to the applicant.
- (10)(a) Notwithstanding subsection (9), where a request has been made under subsection (5) of this section for deferment of publication, upon registration, of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection. The registrar shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner.
- (b) At the expiry of the period of deferment, the registrar shall publish the registered industrial design.
- (c) The institution of legal proceedings on the basis of a registered industrial design during the period of deferment of publication shall be subject to the condition that the information contained in the register and the file relating to the application has been communicated to the person against whom the action is brought.
- (11) Subject to subsection (8), the date of the registration shall be that of the application.

76. Duration and renewal of registration of an industrial design.

- (1) Subject to subsection (2), the duration of the registration of an industrial design shall expire at the end of the fifth year following the date of the registration.

- (2) The registration of a design may be renewed for two further consecutive periods of five years upon payment of a prescribed fee.
- (3) The fee for the renewal of registration of an industrial design shall be paid within twelve months preceding expiration of the period of registration but a grace period of six months shall be allowed for the late payment of the renewal fee on payment of the surcharge, as may be prescribed.

77. Restoration of registration of industrial designs.

- (1) Where the protection granted to an industrial design has not been renewed due to circumstances beyond the control of the owner of the design, the owner or any other persons entitled may apply for its restoration on the payment of the prescribed renewal fee, as well as of the surcharge, within a period of one year from the date upon which renewal fee was due.
- (2) An application for restoration of registration for an industrial design, together with documents proving payment of the fees and surcharge mentioned in subsection (1) shall be sent to the registrar and shall contain a statement of the grounds on which the owner or the persons making the application consider the restoration justified.
- (3) The registrar shall examine the grounds mentioned in the statement referred to in subsection (2) and shall either restore the registration for the design or reject the application if he or she does not consider the grounds valid.
- (4) Restoration of registration shall not entail prolongation of the maximum duration of the registration of the industrial design.

- (5) Restored designs shall be published by the registrar in the prescribed form.

78. Graphic representations, specimens, etc.

- (1) The application, including any drawings, photographs or other graphic representations and any specimen of the registered industrial design shall be kept by the industrial property department and after publication of the registration they shall be communicated upon request made in the prescribed manner.
- (2) Drawings, photographs or other graphic representations and specimens of industrial designs shall be kept by the Industrial Property Department for a period of eight years after the expiry of the registration and may be examined by any interested person on payment of the prescribed fee.
- (3) After publication, any person may, on payment of a prescribed fee, obtain an official copy of the application, representations or specimens from the industrial property department.
- (4) Subsections (1), (2) and (3) shall apply to official copies furnished by applicants seeking to avail themselves of the priority of an earlier registration and to the documents enabling certain applicants to claim the priority.
- (5) An applicant for registration of an industrial design seeking to avail himself or herself outside Uganda of the priority of his or her registration before registration of the industrial design may obtain an official copy of his or her application.

79. Publication of reference to registration of industrial designs.

- (1) The registrar shall publish a reference to the registration of all industrial designs, which shall contain, in addition to the prescribed details-

- (a) the number of the industrial design;
 - (b) the date of filing of the application;
 - (c) the mention of any validly claimed priority; and
 - (d) the drawings, photographs or other graphic representations of the industrial design and an indication whether a specimen has been deposited with the industrial property department
- (2) The industrial property department shall prescribe the conditions of publication of the representations of the industrial design.

80. Rights conferred by registration of industrial designs, etc.

- (1) Registration of an industrial design shall confer upon its registered owner the right to preclude third parties from performing any of the following acts in Uganda:
 - (a) reproducing the industrial design in the manufacture of a product;
 - (b) importing, offering for sale and selling a product reproducing the protected industrial design; or
 - (c) stocking of such a product for the purposes of offering it for sale or selling it.
- (2) The rights conferred by the registration of an industrial design shall extend only to acts done for industrial or commercial purposes and shall not extend to acts in respect of a product embodying the protected industrial design after the product has been lawfully imported or sold in Uganda.
- (3) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him or her, have the right to institute court proceedings against any

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

person who infringes the industrial design by performing, without his or her consent, any of the acts referred to in subsection (1) or who performs acts which make it likely that infringement will occur.

- (4) An industrial design registered by ARIPO by virtue of the ARIPO Protocol and in respect of which Uganda is a designated State shall have the same effect in Uganda as an industrial design registered under this Act unless the registrar has communicated to ARIPO, in respect of an application thereof, a decision in accordance with the provisions of the ARIPO Protocol that if a registration is made by ARIPO that registration shall have no effect in Uganda.

81. Transfer and assignment of industrial designs, licences.

- (1) Rights subsisting in an industrial design may be transferred in whole or in part.
- (2) The provisions of sections 49,50,51,55 and 57 shall apply, with the necessary modifications, to this Part.

PART XIV – TECHNOVATIONS.

82. Definitions.

For the purposes of this Part:

- (a) “Technovation” means a solution to a specific problem in the field of technology, proposed by an employee of an enterprise in Uganda for use by that enterprise, and which relates to the activities of the enterprise but which, on the date of the proposal, has not been used or actively considered for use by that enterprise;

(b) “Employee” and “Enterprise” mean the employee and the enterprise referred to in paragraph (a), and where several enterprises are owned or operated by one person, all such enterprises shall be considered as one enterprise;

(c) “Date of the proposal” means the date on which the employee makes a request in accordance with section 84;

(d) “Technovation certificate” means the document issued by the enterprise in accordance with section 84;

(e) “Technovator” means an employee to whom the enterprise has issued a technovation certificate.

83. Right to technovation certificate.

- (1) Subject to subsection (2), any employee of the enterprise on the date of the proposal shall be entitled to a technovation certificate as provided for in this Part.
- (2) Where the duties of an employee comprise the making and proposing of technovations, he or she shall not be entitled to a technovation certificate for any technovation which pertains to the field of activities for which he or she is employed, unless the degree of the creative contribution inherent in the technovation exceeds that which is normally required of an employee having the said duties.
- (3) Where employees severally request a technovation certificate for the same technovation, the employee who is the first to make the request shall be entitled to such certificate.
- (4) Where a request for technovation certificate is made jointly by two or more employees, the certificate shall be issued in their joint names.

84. Request.

A request for a technovation certificate signed by the employee shall be filed in writing with the enterprise and the enterprise shall assist the employee in filing the request and shall issue a receipt to him or her acknowledging that a request has been filed and indicating the date on which it has been filed.

85. Issuance or refusal of technovation certificate.

- (1) Where the requirements of this Part are satisfied, the enterprise shall, within a period of three months from the date of the proposal, issue a technovation certificate to the employee.
- (2) The enterprise may refuse to issue the certificate if it is of the opinion that the requirements of this Part have not been satisfied and shall notify the employee of the reasons therefore within the time limit prescribed in subsection (1).

86. Use of technovation.

- (1) Where the enterprise issues a technovation certificate, it shall, at the same time, notify the technovator, in writing whether or not it intends to use the technovation.
- (2) Where the decision to make use of the technovation depends on testing the technovation in practice, the enterprise shall inform the technovator accordingly and may postpone the notification of its intention to use or not to use the technovation by not more than one year from the date of the proposal.
- (3) The technovator shall be obliged to assist the enterprise, to the best of his or her ability, in any testing, development or use of the technovation.

- (4) The enterprise shall be obliged to give adequate opportunity to the technovator to furnish the assistance rendered in subsection (3).
- (5) Once the technovation certificate has been issued, the technovator shall not communicate his or her technovation to any person other than the enterprise and shall not use it except in collaboration with the enterprise.
- (6) Where the enterprise declares that it does not intend to use the technovation or where the enterprise, having declared its intention to use the technovation, does not in fact start using it within six months from the issuance of the technovation certificate or the expiration of the time limit referred to in subsection (2), the technovator shall be exempted from the obligations referred to in subsections (3) and (5): except that the technovator shall have the right to communicate his or her technovation to others only to the extent that such communication does not entail the communication of any know-how or other knowledge that has been acquired as an employee.

87. Remuneration of the technovator.

Where the enterprise uses the technovation or communicates it to a third person, the technovator shall be entitled to a remuneration the amount and method of payment of which shall, in the absence of an applicable collective bargaining agreement, be fixed by mutual agreement between the technovator and the enterprise.

88. Derogation by contract.

Any contractual provision that is less favourable to the employees or technovators than the provisions of this Part shall be null and void.

89. Disputes.

- (1) Any dispute concerning the application of this Part shall be submitted by any interested party to an arbitration board consisting of three members: one member appointed by the complainant, the second member appointed by the party complained against, and a chairperson appointed by the two members. The arbitration board shall hear interested parties and thereafter deliver its ruling.
- (2) Where the parties fail to agree on the appointment of the chairperson, the chairperson shall be appointed by the resident magistrate's court having jurisdiction in the place where the enterprise is located.

**PART XV – COMMON PROVISIONS: SURRENDER,
REVOCATION AND INVALIDATION.**

90. Surrender.

- (1) A patent, utility model or industrial design registration certificate may be surrendered by its owner to the industrial property department.
- (2) The surrender may be limited to one or more claims of the patent or utility model, or, in the case of industrial designs, one kind of product or class of products.
- (3) The surrender shall promptly be recorded in the register and published by the registrar and the surrender shall be effective only after it has been published.
- (4) If a licence has been recorded in the register, surrender shall only be registered upon the submission of a declaration by which the licensee consents to the surrender, unless the latter has expressly waived this right in the licence contract.

91. Revocation or invalidation.

- (1) Any interested person may in proceedings instituted by him or her against the owner of a patent, or a registered utility model or industrial design or in proceedings instituted against him or her by the owner, request the court to revoke or invalidate the patent, utility model or industrial design registration.
- (2) An interested person may, within a period of twelve months from the date of the publication of the grant of a patent, utility model or industrial design request the court to revoke or invalidate the patent, utility model or industrial design registration.
- (3) The court shall revoke or invalidate the registration of the patent or the utility model or industrial design on any of the following grounds that:
 - (a) the owner of the patent is not entitled under section 18, 19 or 20 of the Act to apply for the grant of a patent;
 - (b) the owner of the patent is in infringement of the rights of the person filing an application for revocation of the patent or of any persons under or through whom he or she claims;
 - (c) the invention does not relate to an art (whether producing a physical effect or not), process, use, machine, manufacture or composition of matter which is capable of being applied in trade or industry;
 - (d) the invention is obvious in that it involves no inventive step having regard to what was common knowledge in the art at the effective date of the application;
 - (e) the invention, in so far as it is claimed in any claim of the application, is not useful;
 - (f) the patent does not fully describe and ascertain the invention and the manner in which it is to be performed;

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

- (g) the patent does not disclose the best method of performing the invention known to the owner of the patent at the time when the specification was lodged at the industrial property department;
 - (h) at the time the application for the grant of the patent was filed, the application form or any other documents filed in pursuance of the application contained a material misrepresentation; or
 - (i) the invention is not new in terms of section 11.
- (4) An application for revocation or invalidation of a patent shall:
- (a) state the grounds on which the applicant intends to rely in his or her application for revocation or invalidation of the patent, and
 - (b) be accompanied by:
 - (i) a statement setting out particulars of the facts alleged in support of the said grounds; and
 - (ii) proof of service on the owner of the patent of notice of filing of the application under sub-section (1) or (2) and such statement shall be furnished to the court.
- (5) If the owner of the patent wishes to contest the application for revocation or invalidation he or she shall, within such time as is prescribed or such further time as the court may allow, lodge with the court a counter statement setting out particulars of the grounds upon which the application is to be contested.
- (6) A copy of any counter-statement in terms of subsection (5) lodged with the court shall be served by the owner of the patent concerned on the person making the application for revocation or invalidation of the patent.

UGANDA LAW REFORM COMMISSION

- (7) The particulars required in terms of this section may from time to time, with the leave of the court, be amended.
- (8) No evidence shall be admitted in proof of any ground on which particulars have not been delivered in terms of this section, except by leave of the court.
- (9) After receiving an application under subsection (1) and ascertaining compliance with the provisions of this section which are applicable, the court shall arrange for the matter to be heard in the manner prescribed and may make such order as it deems fit.
- (10) The court shall publish the application for revocation or invalidation of the patent in the Gazette.
- (11) An aggrieved party may appeal against the decision of the court.
- (12) Where the provisions of subsection (2) apply only to some of the claims or some parts of a claim, or some parts of a registered industrial design only those claims or parts may be revoked or invalidated by the court.
- (13) The court may require the owner of the patent, the utility model or the industrial design registration certificate to submit to it for the purposes of examination, the registration certificate, publications and other documents showing the prior art which has been referred to either in connection with an application for a title to the patent, the utility model or the industrial design filed, for the same or essentially the same invention or design by the owner with any other national or regional industrial property office, or in connection with any proceedings relating to the registration of the patent, utility model or the industrial design or other title or protection granted upon such application.
- (14) The notice of the application referred to in subsection (1) shall be served on any licensee under the patent, the utility model or the industrial design who is entitled to join in the proceedings in the absence of any provision to the contrary in the licence contract.

- (15) Where, before or during the proceedings, it is alleged or it appears to the court that the right to the patent, the utility model or the industrial design belongs to a person who is not a party to the proceedings, notice of the application referred to in subsection (1) shall be served on that person and such person who shall be entitled to join in the proceedings.

92. Effect of revocation or invalidation.

- (1) Any revoked or invalidated patent, utility model or industrial design or claim or part of a claim of a registered industrial design shall be regarded as null and void from the date of the grant of the patent or certificate of registration for the utility model or the industrial design.
- (2) As soon as the decision of the court is no longer subject to appeal, the court shall inform the registrar who shall register and publish it as soon as possible in the Gazette.

PART XVI – INFRINGEMENT.

93. Acts constituting infringement.

Subject to sections 45, 49, 60, 61 and 68 any act specified in section 40 or 79 and performed by a person other than the owner of the patent or of the registered utility model or industrial design without the owner's authorisation, in relation to a product or a process falling within the scope of a validly granted patent or certificate of registration shall constitute an infringement.

94. Relief.

On the request of the owner of the patent or the registered utility model or industrial design, the court shall grant the following relief –

- (a) an injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement once infringement has started;

- (b) damages; or
- (c) any other remedy provided for in law.

95. Declaration of non-infringement.

- (1) Subject to subsection (2), any person showing a legitimate interest may request the court to declare that the performance of any specific act does not infringe the patent or the registered utility model or industrial design and the owner and any licensee under the patent or the registered utility model or industrial design shall have the right to be a defendant in the proceedings.
 - (2) No declaration under subsection (1) shall be made:
 - (a) if the acts to which the request relates are already the subject of infringement proceedings; or
 - (b) if the person making the request is unable to prove that he or she has previously demanded from the owner a written acknowledgement of the lawfulness of the acts referred to and that the owner has refused such demand or has failed to reply within a reasonable time.

96. Threat of infringement proceedings.

- (1) A person threatened with infringement proceedings who can prove that the acts performed or to be performed by him or her do not constitute infringement of the patent or the registered utility model or industrial design may request the court to grant an injunction to prohibit such threats and to award damages for financial loss resulting from the threats.
- (2) The mere notification of the existence of the patent or the registered utility model or registered industrial design shall not constitute a threat of infringement.

97. Criminal proceedings.

- (1) Any intentional infringement of the patent or the registered utility model or industrial design shall constitute an offence under this Act.
- (2) Such an offence shall be punishable with a fine of not less than 48 currency points and not exceeding 120 currency points or imprisonment for a term of not less than 3 years, and not more than 5 years, or with both.

98. Presumption of use of patented process.

For the purpose of proceedings, other than criminal proceedings, in respect of the infringement of the rights of the owner of the patent, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that an identical product was not made by the patented process shall be on the alleged infringer, if either of the following conditions is fulfilled:-

- (a) the product is new; or
- (b) a substantial likelihood exists 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.

99. Legal proceedings by licensee.

- (1) Any exclusive licensee within the meaning of section 53(2) may request the owner of the patent or the registered utility model or industrial design to institute legal proceedings for a specific relief with respect to any infringement specified by the licensee.
- (2) The licensee may, if the owner refuses or fails to institute legal proceedings in terms of subsection (1) notify the industrial property department, and may after a period of three months from the request or refusal, after giving notice to the owner, institute such proceedings in his or her own name; and the owner may join in the proceedings.

- (3) Even before the end of the three-month period referred to in subsection (2), the court may, on the request of the licensee, grant an appropriate injunction to prevent infringement or to prohibit its continuation, where the licensee shows that immediate action is necessary to avoid substantial damage.

100. Appeal from decisions of the registrar.

- (1) Where under this Act provision is made for appeal from the decision of the registrar, such appeal shall be made to the commercial court.
- (2) Upon any appeal to the court under this Act, the court may:
 - (a) confirm, set aside or vary the order or decision in question; or
 - (b) exercise any of the powers which could have been exercised by the registrar in the proceedings in connection with which the appeal is brought; and
 - (c) make such orders as to costs as it may deem fit.

101. Suspension of release by customs authorities.

- (1) A rights holder, who has reasonable grounds for suspecting that some goods imported infringing on a right or that importation may take place, may lodge an application in writing with the competent court or customs Authority for the suspension of the release into free circulation of such goods.
- (2) Any rights holder initiating the procedures under subsection (1) shall be required to provide adequate evidence to satisfy the court or authority that, under the laws of this country, there is *prima facie* an infringement of the right holders and to supply a sufficiently detailed description of the goods to make them readily recognisable by the customs authorities. The court (competent authorities) shall inform the applicant within a reasonable period whether they have accepted the application and, where determined by the competent authorities, the period for which the customs authorities will take action.

102. Assessors.

The court may appoint any person with expert knowledge to act as an assessor in an advisory capacity in any case where it appears to the court that such knowledge is required for the proper determination of the case.

PART XVIII – MISCELLANEOUS PROVISIONS.

103. Regulations.

The Minister may make regulations prescribing anything which under this Act may be prescribed, and generally for the better carrying out of the objects and purposes of this Act.

104. Repeal of the Patent Act, Cap 216. and savings.

- (1) The Patents Act, Cap. 216 is hereby repealed.
- (2) The transitional and saving provisions set out in the Schedule shall have effect upon the repeal of the Patent's Act.

105. Exemption from stamp duty.

No duty shall be chargeable under the Stamp Duty Act in respect of any instrument executed by, or on behalf of, or in favour of the industrial property department which, but for this section, the industrial property department would be liable to pay.

FIRST SCHEDULE.

One currency point is equivalent to twenty thousand shillings.

SECOND SCHEDULE.

TRANSITIONAL AND SAVING PROVISIONS.

Patent Act, Cap. 216.

1. In this Schedule-
“former Office” means the patents office existing immediately before the commencement of this Act; and
“repealed Act” means the Patents Act repealed by section 104.
2. Where a patent was registered in Uganda under the repealed Act or where it was saved under section 48(1) of that Act and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act, then, subject to this Schedule:
 - (a) such a patent shall be treated in Uganda as if it had been granted under this Act;
 - (b) such a patent shall expire as regards Uganda when those privileges and rights could have expired if this Act had not been made;
 - (c) such a patent may be revoked or invalidated only where those privileges and rights could be declared as not having been acquired in Uganda if this Act had not been made;
 - (d) the certificate of registration, or a certified copy of such patent, shall be admissible as *prima facie* evidence of the date and the fact of registration; and
 - (e) an action for infringement of such patent shall lie under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in other cases may be

Industrial Property office and disposed of as if this Act had not been enacted.

3. So far as is necessary for the purposes of paragraph 2, the register of patents under the repealed Act shall continue to be maintained and shall be deemed to be part of the register under this Act.

The United Kingdom Designs (Protection) Act, Cap. 218.

4. Where the registered proprietor of a design registered in the United Kingdom under the Registered Designs Act, of the United Kingdom enjoyed the same privileges rights in Uganda in respect of such design under the provisions of the repealed United Kingdom Industrial Designs Act immediately before commencement of the repealed Act, such design shall be deemed to have been registered under the repealed Act.
5. Applications for the grant of patents or the registration of utility models or industrial designs filed in Uganda between the date of the commencement of the repealed Act and the date of the commencement of this Act, shall be processed in accordance with the provisions of this Act and shall retain or be accorded the filing date or validly claimed priority date which was or would have been accorded under the repealed Act.
6. Section 53 shall not apply to licence contracts and contracts assigning the right to a patent or assigning applications or patents, provided that the said contract were concluded before the commencement of this Act and are submitted for registration to the registrar within sixty days from the commencement of this Act.
7. All the funds, assets and other property, movable and immovable, which immediately before the coming into operation of this Act, were held by the Government on behalf of the former Office shall, by virtue of this paragraph and without further assurance, vest in the industrial property department of the Uganda National Registration of Services Bureau .

UGANDA LAW REFORM COMMISSION

8. Every public officer having the power or duty to effect or amend any entry in register relating to property, or to issue or amend any certificate or other document effecting or evidencing title to property, shall, without payment of any fee or other charge and upon request by or on behalf of the industrial property department of the Uganda National Registration of Services Bureau, of all such things as are by law necessary to give final effect to the transfer of any property mentioned in paragraph 7 to the industrial property department.
9. All rights, powers, liabilities and duties, whether arising under any written law or otherwise, which immediately before the coming into operation of this Act were vested in, imposed on or enforceable by or against the Government in respect of the former Office shall by virtue of this paragraph, be transferred to, vested in, imposed on, or be enforceable by or against the industrial property department.
10. On and after the coming into operation of this Act, all actions, suits or legal proceedings, by or against the government pending in respect of the former Office shall be carried on or prosecuted by or against the industrial property department of the Uganda National Registration of Services Bureau and no such suit, action or legal proceedings shall abate or be affected by the coming into operation of this Act.
12. A person who is an officer or employee of the former office immediately before coming into operation of this Act shall be deemed to be an officer or employee of the industrial property department; except that:
 - (a) any officer or employee of the former office who does not wish to become an officer or employee of the industrial property department shall exercise his option within a period of twelve months from the date of coming into operation of this Act;
 - (b) subject to paragraph (a), every officer or employee of the Patents Office shall enter into a written contract of service

A STUDY REPORT ON INDUSTRIAL PROPERTY LAW

with the Uganda National Registration of Services Bureau within a period of eighteen months from the date of coming into operation of this Act whereupon his or her service with the Government shall be deemed to have terminated without right to severance pay but without prejudice to all other remuneration and benefits payable upon the termination of his employment with the Government: except that the terms and conditions of the contract or service shall not be at the disadvantage of such officer and employee.

- (c) Any officer or employee of the former office who does not exercise his or her option under (a) shall be deemed to have been seconded to the Uganda National Registration of Services Bureau for a further period of twelve months, after which he or she shall comply with paragraphs (a) or (b) above.

UGANDA LAW REFORM COMMISSION

ANNEX 2

PUBLICATIONS OF THE UGANDA LAW REFORM COMMISSION

No.	Publication.
1.	A study report on rape, defilement and other sexual offences.
2.	A study report on the reform of the law of domestic relations.
3.	The sixth revised edition of the laws of Uganda, 2000.
4.	A field study report on voices of the people on trial procedures, sentencing and decriminalisation of petty offences.
5.	A study report on company law.
6.	A study report on competition law.
7.	A study report on contracts law.
8.	A study report on cooperatives law.
9.	A study report on copyright and neighbouring rights law.
10.	A study report on electronic transactions law.
11.	A study report on geographical indications law.
12.	A study report on industrial property law (patents, industrial designs technovations and utility models)
13.	A study report on insolvency law.
14.	A study report on intellectual property - traditional medicine practice.
15.	A study report on intellectual property rights - trademarks and service marks law.
16.	A study report on intellectual property rights -trade secrets law.
17.	A study report on law relating to trial procedure law.
18.	A study report on plant variety protection law.
19.	A study report on quadhi's courts law.
20.	A study report on reform of the laws relating to chattel securities.
21.	A study report on reform of the laws relating to hire purchase.
22.	A study report on reform of the laws relating to mortgage transactions.
23.	A study report on sentencing guidelines.
24.	A study report on the law for establishment of special economic zones.
25.	A study report on the proposals for the reform of the accountants act, Cap 266.
26.	A study report on the reform of business associations - partnerships law.
27.	A study report on the reform of selected trade laws - consumer protection law.
28.	A study report on the reform of selected trade laws - sale of goods and supply of services law.
29.	A study report on the reform of selected trade laws - trade licensing law.
30.	Handbook on making ordinances and byelaws in Uganda.
31.	How our laws are made.
32.	Report on the background study on the legal implementation of the world trade organisation agreements.
33.	Report on the law relating to publishing horrific pictures and pictures of the dead in the press and