

**FOSTERING INNOVATION: A CRITICAL EXPLORATION OF PATENT RIGHTS ON THE
INDUSTRIAL SECTOR OF UGANDA**

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DECLARATION

I Kemigisa Beyoncé Hellen do hereby declare that this dissertation is original and has not been submitted for a degree or any other qualification in any University.

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APPROVAL

This dissertation has been submitted for examination with my approval as the university supervisor.

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DEDICATION

This research is dedicated to my parents Eng. Tushabe Aus. Ali the pillar of my education. My mother Mrs. Tushabe Betty Kamuli for the love, care and support. My brothers and sisters. Musimenta Gloria, Arinda Cynthia, Kasemire Marion, Alexander Muramira and Kobusingye Gift for the endless support and love. My babies Prince Peter, Ankunda Mikayla, Arinda Ivanka, Aruho Lindsey Briella and Ahebwa Dylan Adrian you are so much loved and appreciated.

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LIST OF ABBREVIATIONS AND ACRONYMS

ARIPO	African Regional Intellectual Property Organization
EAC	East African Community
IP	Intellectual Property
IPA	Industrial Property Act
IPRs	Intellectual Property Rights
IPRS	Intellectual Property Rights System
OAPI	African Intellectual Property Organization
PCT	Patent Cooperation Treaty
PSFU	Private Sector Foundation Uganda
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
UIRI	Uganda Industrial Research Institute
UK	United Kingdom
ULRC	Uganda Law Reform Commission
ULS	Uganda Law Society
URSB	Uganda Registration Services Bureau
WIPO	World Intellectual Property Rights Organization
WTO	World Trade Organization

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CHAPTER ONE: FOSTERING INNOVATION, A CRITICAL EXPLORATION OF PATENT RIGHTS ON THE INDUSTRIAL SECTOR OF UGANDA.

1.1 INTRODUCTION

Intellectual property law is the branch of law which concerns legal rights associated with creative efforts commercial reputation, and goodwill¹. Intellectual property establishes the protection of ideas and designs in art and technology in industry and trade. These are divided into copyright which is the protection of literary and artistic creations on one hand and industrial property which concerns the protection of distinctive signs and inventions on the other hand². It is from the industrial property that industrial creations such as inventions are granted intellectual property rights as Patent protection.

A patent is a government grant of exclusive rights to the invention for a limited period to prevent others from making or 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 created as mechanisms for improving the technological development in a given area, to help the innovators raise enough funding to make the products from their ideas. Patent law is also a mechanism used by societies to improve the rate of technological development and ensure that important techniques are disclosed so that they can be incorporated into the public knowledge

¹ David. I. Bainbridge, "Intellectual property", Chapter 1, Introduction to intellectual property rights, page 3

² Salazar. Consultant, Central American Economic Interrogation Secretariat (San Jose, Costa Rica). Article on Intellectual property and the right to health

base. The patent system does not come for free that is, it carries many costs for the society such as economic inefficiencies and inaccessibility to new technological devices for large parts of the population.

The study, therefore, seeks to examine the extent to which patent laws have been hazardous to technological and economic development and also the degree to which the positive effects of patents outweigh the negatives in Uganda. The study also discusses the effectiveness of the provisions of the Industrial Property Act 2014 in the industrial sector of Uganda and its comparison with the repealed Patent Act.

1.2 BACKGROUND.

Patents originated from the Venetian decree of 1474 which is considered the world's first true patent law as well as the British statute of monopolies of 1623. The Venetian decree laid out that any person in the city of Venice who made a new or ingenious device and registered it in the office of the provedore de comun (municipal registrar) secured a privilege that consisted in all, other persons being prohibited from making any other device identical or similar to it for a period for ten years. The statute of monopolies on the other hand represents the culmination of the privileges granted by the British Crown, and by eliminating all monopolies except those relating to top licenses for exploitation or making of new products, exalts the principle of novelty and practically establishes that only those monopolies that protect a novel activity are lawful. The exception written in the statute allowed letter patent for 14 years for the exclusive exploitation, for the benefit of the true and first inventor of any type of new manufacture within the realm³.

³ Salazar. Consultant, Central American Economic Interrogation Secretariat (San Jose, Costa Rica). Article on Intellectual property and the right to health.

In Uganda, the law of patents was introduced through the reception of English law which was given by the Uganda Order-In-Council 1902 under the auspice that Uganda was a protectorate of the United Kingdom of Great Britain and Northern Ireland from 1894. Through the Order-In-Council, Uganda received the English Patents Act Cap 82 which was revised in 1964, and other intellectual property law statutes from the United Kingdom. After independence, Uganda embarked on reformation of the patent laws that is to say, the first reformation was the revision of the Patents Act Cap 82 in 1964. In 1991, patent statute No. 10 of 1991 was enacted under which the patent statute regulations of 1993 were passed which then repealed the provisions of the Patents Act cap 82. The Patent Statute Regulations SI No. 70 of 1993 made under the 1991 Statute was later replaced in the same year by the Patent Statute Regulations SI No. 83 of 1993. The 1991 Statute was renamed during the compilation of the Laws of Uganda in 2000 as the Patents Act Cap 216 of October 1993. In April 1994 a year after enacting the Patents Act of 1993, Uganda signed the Agreement Establishing the World Trade Organization (WTO) and ratified the same in October 1994⁴. By December 31st 1994, Uganda had fulfilled all the conditions necessary to become a founder member of the WTO and consequentially a party to the TRIPS Agreement⁵. The Parliament of the Republic of Uganda 2002 passed the Patents (Amendment) Act 2002 which amended the Patents Statute, 1991 by providing for international applications and connected matters by giving effect in Uganda to the provisions of the Patents Co-operation Treaty signed at Washington on the 19th June 1970⁶.

⁴ World Trade Organization, (Uganda and the WTO), https://www.wto.org/english/thewto_e/uganda_e.html.

⁵ The TRIPS Agreement is Annex 1C of the Marrakesh Agreement Establishing the WTO, 1994.

⁶ The Patents (amendment) act, 2002.

In 2009, the government undertook further steps to reform the law on industrial property by tabling the Industrial Property Bill, 2009. The 2013 Report by the Sectorial Committee on Legal and Parliamentary Affairs on the Industrial Property Bill 2009 noted that Uganda as a member state of the WIPO, ARIPO, a signatory to the Paris Convention, Patent Cooperation Treaty, TRIPS Agreement and a recognized user of the Nice Agreement on Classification of Goods and Services, is obligated to enact laws to give effect to its international obligations⁷. To this effect, the committee through its study tours observed that the efficient laws would give confidence to the foreign investors to register their inventions and innovations without fear which would develop the industrial sector of Uganda. In addition to that Justice Aldous, in the case of *Chiron Cooperation V Organon Teknika Ltd*⁸, observed that the grant of monopoly rights in an invention through a patent system stimulates technical progress by encouraging research and invention, inducing inventors to disclose their discoveries, offering commercially practical rewards for the expense of developing inventions, and inducing investment of capital in new lines of production. Subject to the suggestions made by the sectorial committee on legal and parliamentary Affairs on the Industrial Property Bill 2009, the parliament in January 2014 passed the Industrial Property Act 2014 repealing the Patents Act Cap 216 and the United Kingdom Designs (Protection) Act Cap 218.

1.3 STATEMENT OF THE PROBLEM

The Patents Act Cap 216 which was repealed by the Industrial Property Act 2014, contained provisions that were not complying with the obligations of the national, regional and international intellectual property organizations. Uganda being a

⁷ See <http://www.wipo.int/classifications/nice/en/preface.html> last accessed 28th February 2024.

⁸ [1995] FSR 325

member of ARIPO, WIPO at the regional sphere and a member state of the World Trade Organization (WTO) at the international level, is under obligation to ensure that the protection of patents is not only governed by domestic legislation but also by the obligations developed by the regional and international organizations⁹. The enactment of the Industrial Property Act 2014 has aimed to bridge the gap between the national legislation and the obligations developed by the regional, and international organizations.

The major question of this research is, whether the enactment of the Industrial Property Act 2014 of Uganda concerning the protection of patents is efficient enough to fulfil the international and regional obligations laid out under Articles 1(3) and 3(1) of the TRIPS agreement¹⁰. To this effect, where the enactment does not bridge the gap between the obligations developed by the regional and international organizations, the Industrial Property Act 2014 shall be considered frivolous.

1.4 GENERAL OBJECTIVE

The general objective of this study is to analyse the impact of the patent systems laws in the development of the industrial sector of Uganda concerning the national, regional and international developments.

⁹ The WTO was established by the Agreement Establishing the World Trade Organization, signed in Marrakesh Morocco on 15th April 1994. And Uganda became a member in April 1994, see: http://www.wto.org/english/thewto_e/uganda_e.htm last accessed 28th April 2024.

¹⁰ Article 1(3) of the TRIPS agreement provides in that part that “members shall accord the treatment provided for in this Agreement to the nationals of other members”. Article 3(1) of the TRIPS agreement requires that each member state accords to nationals of the other member states the same treatment it gives to its own nationals with the regard to protection of intellectual property rights.

1.4.1 SPECIFIC OBJECTIVES

- a) To assess the effectiveness of the Industrial Property Act 2014 in the protection of patent rights in Uganda.
- b) To find out the challenges of the enforcement of Patents that arose from the repealed Patents Act Cap 216 in the industrial sector of Uganda.
- c) To identify the solutions to the challenges of the enforcement of the Patents arising from the newly enacted Industrial Property Act 2014 in the industrial sector of Uganda.
- d) To examine the extent to which the domestic legislation on the protection of patent rights complies with the regional and international intellectual property laws.

1.5 RESEARCH QUESTIONS

- a. Whether the positive effects of the Industrial Property Act 2014 outweigh the negative effects of the repealed Patents Act 216.
- b. Whether Uganda have a functional patent enforcement mechanism and institutions?
- c. Whether the legal framework of Uganda comply with the protection of patents granted in the National, regional and international developments?

1.6 SCOPE OF THE RESEARCH

This research focuses on the efficiency of Uganda's patent System in the industrial sector. The research also highlights the national and international legislations and

how they regulate the protection of patent rights in the industrial sector which form the national Intellectual Property System of Uganda.

The main emphasis and focus are drawn towards the intellectual property legal, policy and institutional framework of the country as far as the protection of patent rights is concerned, as well as relating Uganda's patent system with regional and international developments. The holistic approach of the study is based on the interdependence of Uganda on the national, regional and international legislation of the protection of patents in the industrial sector of Uganda.

1.7 JUSTIFICATION

The purpose of this research is to show the multiplicity of developments in intellectual property law regulating the protection of patent rights on the international scene such as the treaties to which Uganda is a signatory and show how they call for reform of the industrial property law in Uganda. Uganda is a party to the Paris Convention for the protection of industrial property and yet the laws on patents in Uganda are not compliant with the convention.

The research here shows the effect of the amendment to the Patents Act Cap 216¹¹, which was recently passed into law (the Industrial Property Act 2014) to accommodate the international obligations that Uganda engaged in as a result of becoming a member state of the WIPO, ARIPO, a signatory to the Paris Convention, Patent Cooperation Treaty, TRIPS Agreement and a recognized user of the Nice Agreement on Classification of Goods and Services.

¹¹ In January 2014 the industrial property Act 2014 was passed repealing the patents Act Cap 216 and the United Kingdom Designs (protection) Act cap 218.

1.8 SIGNIFICANCE

The research is made to act as a platform to guide investors, development partners and policymakers in investing-related decisions and policies by considering the national, regional and international developments to which Uganda shall be obligated.

The research shall encourage inventors to acquire patent rights that shall not only protect their work but also lead to economic and technological development. While obtaining a patent, the inventor is required to make a technical disclosure that would allow other persons who are skilled in the same area of technology to make and use the invention. This disclosure ensures that at the end of the term, anyone with the relevant technical skills will be able to use the invention and may also make the knowledge available to others. This is important to economic development since long-term economic growth is largely due to technological change¹².

The research shall strengthen the confidence of investors in Uganda's economy by establishing an analysis of the uniformity of the Industrial Property Act of 2014 with the development of the TRIPS agreement.

CHAPTER TWO: LITERATURE REVIEW.

According to David Bainbridge, patents effectively give the inventor or more commonly his employer a monopoly to work the invention to the exclusion of others for a while. However, the monopoly is not absolute and there are several checks and balances to curb its abuse¹³. This means that benefits do not come for free, as they

¹² Mansfield, Edwin, "intellectual property Rights, Technological Change, and Economic Growth," Walker, Charls E., and Bloomfield, MarkA, eds., Intellectual Property Rights and Capital Formation in the Next Decade 5-6.

¹³ Bainbridge. I. D, Intellectual Property, (9th edition Published in 2012) Chapter 11, Patent law-background Basic Principles and Practical aspects, Introduction, page 389.

carry many costs for society, mainly in terms of economic inefficiencies and inaccessibility to new technological devices for large parts of the population¹⁴.

According to Anthony C.K. Kakooza, local investors are weary of their intellectual property rights both locally and across borders, with immediate neighbours concerned amid increasing counterfeiting and smuggling of goods across borders. The instant research looks forward to solving the writer's perspective of the demanding improvement in legislation as it establishes the effectiveness of the provisions of the patent system laws in Uganda towards harmonizing laws with the other member states to avoid infringement¹⁵.

Uganda's rectification of the agreement establishing the WTO in October influenced its embankment on the modification of its intellectual property laws in line with the requirements of the TRIPS agreement (Anthony C.K Kakooza). Such modifications have expanded the focus of Uganda's horizon from the traditional confinements, that is trademarks, patents, and copyrights to areas such as geographical indications, technovations, trade secrets, plant variety protection, traditional medication practice and establishment of an industrial property office¹⁶. The writer to this extent ignores that the patent system in Uganda disregards certain inventions from intellectual property protection and also the fact that most traditional confinement has not been subject to intellectual property enforcement, for example, the traditional medication practices. This research lays down the

¹⁴ Uganda Law Reform Commission, "A Study Report on Industrial Property Law", (LAW COM PUB. NO. 12 of 2004).

¹⁵ Kakooza C.K. Anthony, The Civil, Administration and Criminal Law Standards in Intellectual Property Enforcement in Uganda: The Good, the Bad and the Hoped-for, <http://ssrn.com/abstract=1658658>

¹⁶ Atwine Jeffery, "A Review of Uganda's current situation with regard to intellectual property policy issues; opportunities and Challenges" (Dec.2003) Vol. 1 No.2, The Uganda Living Law Journal, page 192 to 215.

effectiveness of the modification of patent system laws that have resulted in the harmonization of national and international legislation¹⁷.

In the Business Guide to the Uruguay Round, it is accurately stated that “industries and trading organizations were complaining that because of differing national standards for the protection of intellectual property rights such as patents, trade in counterfeit goods was on the increase”¹⁸. Thus, the effects of increased trade in counterfeit goods are that legitimate business is discouraged and investor’s interest wanes. The differing national and international standards of patent protection have created a loophole in the enforcement of patents; this has been ignored by the initial writers. This research seeks to expose the differing national and international standards of patent protection to encourage lawmakers to identify these loopholes and establish patent system laws that are consistent and not frivolous.

Adam Jaffe (2007) argues that the economic function of patent protection is to provide a measure of predictability and protection of the expensive process of product and process development. As such it lies in the heart of the technological process, which in turn is the primary engine of economic growth¹⁹. Adam (2007) asserts that the patent system is strongest and that incentives for innovation are the greatest when the system only protects those patents that are truly inventive. Therefore, in light of Adam, beyond dispute that might be led by patent systems, it promotes innovation. Adam Jaffe however ignores the fact that for the patents to protect and promote innovations the enforcement of patent system laws must not

¹⁷ Ibid

¹⁸ Business guide to the Uruguay Round published by the International Trade Centre UNCTAD/WTO and the Common Wealth Secretariat, 1996. At page 15.

¹⁹ Adam Jaffe, (*expert opinion to the house of Representatives*), American innovation at risk: The case for patent Reform, house of representatives, subcommittee on courts, the internet and intellectual property, committee on the judiciary, Washington DC.

be frivolous and must be consistent with the national, regional and international standards of intellectual property. The instant research is different from the initial writing (including Adam Jaffe) because it highlights the effects of the patent system laws and how they have maintained proper enforcement of patents to encourage innovation. The instant research shall also examine whether Uganda's legal and policy management framework is well equipped to avail protection of patent rights²⁰.

According to the Uganda Law Reform Commission on the study of industrial property, the holder of a patent or collection of related patents can be hazardous in a way that blocks the development of whole the branches of a given technology or imposes licensing schemes which force manufacturers to sell their products at prices not suitable for large sectors of the society. Despite the negative impact of the patent systems on the development of economies and technologies, some authors have suggested solutions to the existing shortcomings in the protection of the patent rights of inventors²¹.

Mulligan & Lee argue that a functioning Patent System should ensure low discovery costs to make it economically feasible to obtain information that persons and firms need to comply with the law. This shall ensure that those who intend to infringe the patent laws are informed about the existence of patent rights on certain inventions and knowledge. In addition, the instant research shall expose the demerits of the

²⁰ Adam Jaffe, (*expert opinion to the house of Representatives*), American innovation at risk: The case for patent Reform, house of representatives, subcommittee on courts, the internet and intellectual property, committee on the judiciary, Washington DC.

²¹ Uganda Law Reform Commission, "A Study Report on Industrial Property Law", (LAW COM PUB. NO. 12 of 2004).

patent system laws to enable the legislation drafters to devise mechanisms to modify better enforcement of patents in Uganda²².

2.1 METHODOLOGY

Research is a process of enquiry and investigation, it is systematic, methodical and ethical, research can help solve practical problems and increase knowledge.

The Oxford Dictionary defines 'method' as defined in the Oxford English Dictionary, is a special form of procedure or characteristic set of procedures employed (more or less systematically) in an intellectual discipline or field of study as a mode of investigation and inquiry or teaching and exposition²³. A research method refers only to the various specific tools or ways data can be collected and analysed for example a questionnaire, interview checklist, and data analysis software.

The different types of research include (i) explanatory(which involves explaining the law for instance by diverging historical backgrounds), (ii) empirical research (which involves the identification of the valid law, determining the best legal means for researching a certain goal), (iii) Hermeneutic (interpretation, argumentation), (iv)exploring(which involves looking for new, possibly fruitful paths in legal research, (v) logical research (coherence, structuring concepts, rules, principles), (vi) instrumental (concept-building) and (vii) evaluative research (which involves testing whether rules work in practice or whether they are following desirable moral, political, economic aims or in comparative law)²⁴.

²² Mulligan Christina & Timothy B. Lee, Scaling the Patent System, NYU Annual Survey of American Law, Vol. 68, (2012) PDF Available at: <http://ssrn.com/abstract=2016968>

²³ H.L.A. Hart, The Concept of Law, 2nd edition (Oxford University Press, Oxford 1997), 88-91. See also Scott J. Shapiro, "What is the Internal Point of View?" (2006) 75 Fordham Law Review 1157-70.

²⁴ Mark Van Hocke, Which Kind of method for What Kind of Discipline? (2011) See; Preface.

Methodology is defined as the study of the direction and implications of empirical research or the sustainability of the techniques employed in it or (more generally) a method or body of methods used in a particular field of study²⁵. It also refers to the study and critical analysis of data production techniques; it is the strategy plan of action, process or design that informs one's choice of research methods. The purpose of this section is to guide the research in deciding what types of data are required for a study and which data collection tools will be most appropriate for the study.

2.1.1 Research Approach (es)

Research approaches can be (i) Quantitative or Qualitative, (ii) Applied or Basic, and (iii) Deductive or inductive²⁶.

Qualitative research is more subjective than Quantitative and involves examining and reflecting on the tangible aspects of a research subject such as values, attitudes, and perceptions. The disadvantage of this kind of research is that, although it can be easier to start, it can often be difficult to interpret and present the findings. The findings can also be challenged easily.

Quantitative emphasizes collecting and analysing numerical data, it concentrates on measuring the scale, range, and frequency of phenomena. A disadvantage of this research is that although it is harder to design initially, is usually highly detailed and structured and results can be easily collated and presented statistically²⁷.

The researcher will use a qualitative approach and this will be done through viewing documents, article analysis, and legal analysis of the different laws and policies,

²⁵ Dawn Watkins and Mandy Burton, "Research Methods in Law", 1st edition (2013), page 2.

²⁶ Colin Neville, "Handbook on Introduction to Research and Research Methods", Published at Brantford University School of Management, page 3. (last updated July 2007).

²⁷ *ibid*

among others. The general characteristic of qualitative research is that it is appropriate for small samples as it is not measurable, unlike quantitative research. The advantage of using this research is that it offers a complete description and analysis of the research topic without limiting the scope of the research and the nature of the participants' responses (Collins and Hussey 2003). A qualitative approach will be chosen to enable an in-depth analysis of the various issues in this study. This is because the technique is flexible and appropriate in terms of the data collected the methods of collecting the data and the timing of the research²⁸.

Research Design

The study will adopt a descriptive research design where qualitative data will be employed. Research design is an analytical descriptive design where lots of information about the problem will be red. As highlighted by Creswell (2013) research design is the “science (and art) of planning procedures for conducting studies to get the most valid findings”. A proper research design gives a detailed plan that a researcher will use to guide and focus on the research.

Sources for the research

The researcher shall use both primary and secondary sources of data that is desktop, library and internet research. Use of published textbooks and journals shall also be a source of information and articles from newspapers of wide circulation shall be used. This method is chosen because it is convenient for a student, it is time-saving and it does not require many resources.

²⁸ ibid

It shall also involve legislative analysis and an analysis of actual enforcement/ adherence to protection of patent rights which in turn affects the industrial sector of Uganda.

The data will be analysed through a comparative study of the research materials to seek to show the role of international and national legislation in the development of patent systems in Uganda and how the protection of patent rights has affected the industrial sector in Uganda

2.2 CHAPTER SYNOPSIS

This study will be organized into four chapters. Chapter One, the chapter gives the general introduction, background of the study, statement of the problem, objectives of the study, research questions, justification of the study, significance of the study, the review of the literature and methodology part.

Chapter two deals with the non-legal aspects of the patent systems such as the contextualization of patents and their actual enforcement, the merits and demerits that arise from the enforcement of patent protection in the industrial sector of Uganda, the general problem and proposed solutions by various writers to the problem.

Chapter three will be an overview and assessment of the effectiveness of the provisions of the Industrial Property Act 2014 concerning the regional and international instruments towards the enforcement of patent protection in the development of the industrial sector of Uganda.

Chapter four concludes this research making a summation of the findings and recommendations thereto.

CHAPTER THREE: NON-LEGAL ASPECTS OF PATENT SYSTEMS IN THE INDUSTRIAL SECTOR OF UGANDA

3.1 INTRODUCTION

The chapter discusses the general composition of patents to fulfil the protection of inventions, the non-legal aspects of patent systems such as their relevancy in the intellectual property, their merits and demerits, and also the general problem and proposed solutions by various writers to the problem. Patent systems in many jurisdictions including Uganda have had insufficient enforcement mechanisms compared to other intellectual property rights, therefore the chapter is crowned with a detailed analysis of the extent to which the patent protection system of Uganda is equipped to guarantee the enjoyment and protection of patents towards the development of the industrial sector in Uganda.

3.2 CONTEXT OF PATENTS

A patent is an exclusive right granted for an invention which is a product or a process that provides in general a new way of doing something or offers a new technical solution to the problem. Patent law concerns new, industrial-applicable inventions. A patent is a reward or inducement that the state grants the inventor for his contribution to the solution of a problem in technology or industry. It is an arrangement between the state and the inventor whereby the latter decides to disclose and publicize his invention to society, in exchange for which the state assures him that no one thereafter will be able to copy it without his consent²⁹.

²⁹ Salazar. Consultant, Central American Economic Interrogation Secretariat (San Jose, Costa Rica). Article on Intellectual property and the right to health.

For an invention to qualify for patentability it must meet certain requirements however before looking at the basic requirements; an application for patents will be refused if the specifications do not disclose the invention in a manner which is clear enough and complete for the invention. The requirements for patentability, include; (i) novelty (new), (ii) involving an inventive step (non-obvious) and (iii) industrially applicable (useful)³⁰.

3.3 RELEVANCY OF PATENT PROTECTION.

The economic functioned patent protection is to provide a measure of predictability and protection of the expensive process of product and process development. As such it lies in the heart of the technological process, which in turn is the primary engine of economic growth. For this reason, the capitalists will usually require the certainty of patent protection as a precondition to investment. The patent system is the strongest and incentives for innovation are the greatest when the system only protects those patents that are truly inventive. When functioning properly, the patent system should encourage and enable the inventor to push the boundaries of knowledge and the possibility³¹.

In addition, patent systems intend to provide incentives to innovate by allowing innovators to restrict the use of the knowledge they produce, by allowing the imposition of charges on the use of that knowledge, thereby obtaining a return on their investment³². In the absence of protection of such knowledge, “free riders”, could easily use technical knowledge embedded in inventions without any

³⁰ Abinyo S., Enforcing Intellectual Property Rights in Uganda page 8.

³¹ Adam Jaffe, (*expert opinion to the house of Representatives*), American innovation at risk: The case for patent Reform, house of representatives, subcommittee on courts, the internet and intellectual property, committee on the judiciary, Washington DC.

³² Stieglitz E. Joseph, Economic Foundations of the intellectual Property Rights, Duke Law Journal Vol. 57, pg. 1693 (2008).

recognition of the creativity of the inventor or contribution to the investments made by the inventor. To this effect, patent systems are a prize system which entails giving a prize to whoever comes up with an innovation or at least those innovations that meet the announced objective³³.

3.4 SHORT COMES ARISING FROM PATENT PROTECTION.

There are mainly two short comes, firstly, the requirements for patentability (novelty, inventive step and industrial application) are hard to place within the context of Uganda's socio-economic environment. Secondly, by ruling out acts done for scientific research, in good faith and those done for government exploration from infringing acts, the Patents system laws in Uganda have had weak civil remedies for the infringement of the patent rights of the proprietor³⁴.

Once the infringement is established, the remedies available include injunction damages and any other civil remedy depending on the nature of the claim. The enforcement of patent infringement is entirely reserved to civil enforcement which exposes the enforcement of poor penal provisions of patent rights unlike the other intellectual property rights such as copyrights and trademarks which contributes to the inefficiency of patent systems in the development of the industrial sector of Uganda³⁵.

³³ See; why are patents useful? https://www.wipo.int/patents/en/faq_patents.html#basics

³⁴ Bakibinga D. J, intellectual Property Rights in Uganda: Reform & Institutional Management Policy Formulation, (December 2006) Paper delivered at the Network of Academies of Sciences in Organization of Islamic Countries (NASIC), International Seminar on "Intellectual Property and Innovation: Value Creation in the Knowledge Economy".

³⁵ Kakooza C.K. Anthony, The Civil, Administration and Criminal Law Standards in Intellectual Property Enforcement in Uganda: The Good, the Bad and the Hoped-for, <http://ssrn.com/abstract=1658658>

Lastly, from the interviews that I have conducted with Mr Kagwa John a patent examiner at the National Office URSB and a sample of individuals engaged in small-scale industry business, Small and medium-sized enterprises (SMEs) which manufacture and sell manufactured goods, they reveal that very few people have the knowledge and a substantial understanding of the law concerning patent rights which has gradually contributed to the low number of patent applications in Uganda. This has caused an imbalance of efficiency of the patent systems in the industrial sector of Uganda³⁶.

3.5 REGISTRATION OF PATENTS IN UGANDA.

A patent unlike a utility model is an exclusive right granted by the government for an invention. The term for protection is 20 years. An invention that is novel, inventive and industrially applicable may be granted a patent upon registration. The registration procedure goes as follows;

- 1) Submit a filed patent application form. Attached to it, is a patent document having a title abstract, description, claims and drawings, and also a proof of payments.
- 2) The Uganda Registration Service Bureau receives the document and accords it with a filing date and a patent application number.
- 3) An application found to be in order is subjected to substantive examination to determine if the claimed invention fulfils all requirements for patentability.

³⁶ An informational interview was conducted on 20th May 2021 at the National offices of Uganda Registration Service Bureau in Kampala and also along the streets of Katwe.

- 4) The applicant is notified of the grant/refusal of a patent. The applicant is then requested to pay the grant fees and thereafter issued a certificate of Grant of a Patent³⁷.

3.6 RATING UGANDA'S PATENT SYSTEM.

The efficiency of Uganda's Patent system is dependent on the national legislation and the enforcement mechanisms that are put in place. Statistically, the Patent offices in Uganda barely receive applications compared to the other similar offices in other jurisdictions. The National Intellectual Property Office receives and registers thousands of trademarks, several copyright applications and very few patent applications. Statistics for two financial years show that of the few patent applications received, very minimal applications qualified for the grant of a patent. Over the financial year 2012/2013 and financial year 2013/2014, only 24 patent applications were registered which is less than 1% of the received applications. Copyright applications constituted 2% and trademarks constituted 98 %. These statistics expose the limited engagement of the public in registering for patent protection which negatively affects Uganda's appreciation and enforcement of patent systems³⁸.

3.7 CONCLUSION

The above chapter establishes the non-legal aspects of patents, that is to say, what constitutes a patent and its registration, the efficiency of patent systems both positive and negative in the development of economies and technologies about the national, regional and international developments of intellectual property laws. The

³⁷ Uganda Registration Service Bureau, "Utility models and Patents", <https://ursb.go.ug/utility-models-and-patents/>

³⁸ Abinyo S., "Enforcing Intellectual Property Rights in Uganda", (Statistics), page 14.

chapter gives the statistics on the enforcement of Patent Systems in Uganda in comparison with the enforcement of other intellectual property rights.

CHAPTER FOUR: THE LEGAL REGIME GOVERNING PATENT PROTECTION IN UGANDA.

4.1 INTRODUCTION

The chapter discusses the law governing patent protection in Uganda, that is to say, the institutional and policy framework that governs the enforcement of patents in Uganda as well as their issues and challenges. The patent system laws in Uganda have over time been modified to match the standards of international and regional organizations, for example, the Patents Act cap 216 was repealed to establish the Industrial Property Act 2014. The chapter seeks to identify the regional and international obligations that have been incorporated in the Industrial Property Act 2014 and how they have improved the enforcement of patents in the industrial sector of Uganda. The incorporation of international and regional obligations in domestic legislation is aimed at incorporating intangible objects at the same time in an unlimited number of copies at different locations anywhere in the world³⁹. For instance, states adopted the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement), the agreement is aimed at reducing distortions and impediments to international trade by promoting effective and adequate protection of intellectual property rights whilst ensuring that the adopted measures and procedures of enforcing these rights do not become a barrier to legitimate trade⁴⁰.

³⁹ Industrial Bureau of the WIPO, Elements of Industrial Property (1996), page 8.

⁴⁰ Agreement on Trade-Related Aspects of Intellectual Property Rights, (1994), Preamble of the TRIPS Agreement.

4.2 THE LEGAL FRAMEWORK OF PATENTS IN UGANDA.

The protection of patents in Uganda is primarily governed by the Industrial Property Act 2014 and the Industrial Property Regulations 2017 No. 2. The IPA 2014 generally provides for the promotion of inventive and innovative activities by facilitating the acquisition and development of technology through the grant of patents, utility models, industrial designs and technovations through registration with the designated registrar of industrial property rights. The act provides for the Registrar General as the Registrar of Industrial Property⁴¹. The registrar shall receive, consider and grant applications of industrial rights, receive and register technology transfer agreements, provide to the public industrial property information for technological and economic development maintain links with users of industrial property technological information and also promote inventiveness and innovations in Uganda⁴².

It is trite law that patent rights as a form of intellectual property are secured by the successful completion of formal application and registration procedures⁴³. A patent is a title granted to protect an invention⁴⁴. A patent is only granted upon the application for one. An application for a patent shall contain a request, a description of the invention, one or more claims and drawings where necessary, an abstract and any such other details as may be prescribed by the law⁴⁵.

The statutory definition of patents clearly states that patents are granted for inventions. The interpretation section defines an invention to mean, a new and

⁴¹ Section 3 (1) of the industrial Property Act 2014.

⁴² Section 4 of the industrial Property Act 2014.

⁴³ Bainbridge. I. D, Intellectual Property, (8th edition Published in 2010) page 4.

⁴⁴ Section 2 of the industrial property act 2014.

⁴⁵ Section 21 of the industrial property act 2014.

useful art whether producing a physical effect or not, a process, a machine, manufacture or composition of matter which is not obvious, or a new and useful improvement of it which is not obvious, capable of being used or applied in trade or industry and includes and alleged invention. An invention is also identified as a solution to a specific problem in the field of technology⁴⁶. A patent is therefore meant to protect the process and product of the inventor as it suffers the risk of being exploited by unauthorized users. Buckley LJ in *Hickton's Patent Syndicate V Patents & Machine Improvements Co. Ltd.*, succinctly summarized the nature of patent protection to be either a new way of making something which is the process or the making of a new article altogether which is a product⁴⁷.

For an invention of a process or product to be patentable, it must be new, involve an inventive step and must be industrially applicable⁴⁸. An invention is new if it is not anticipated by prior art where a person who is skilled in a relevant area could not derive the invention from a combination of a prior disclosed art⁴⁹. 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 the person skilled in the art to which the invention relates on the date of applying or if the priority is claimed on the date validly claimed in respect of the invention⁵⁰. In discovering if an invention involves an inventive step, the court of appeal in the case of *Windsurfing International Inc. V Tabur Marine (Great Britain) Ltd.*, set down four tests to determine the inventive step, (i) identifying the inventive concept, (ii) imputing to a normally skilled but imaginative addressee what was common general

⁴⁶ Section 8 (1) of the Industrial Property Act 2014

⁴⁷ (1909) 26 RPC 339 at 348

⁴⁸ Section 9 of the Industrial Property Act 2014.

⁴⁹ Section 10 of the Industrial Property Act 2014.

⁵⁰ Section 11 of the Industrial Property Act 2014.

knowledge in the art at priority Date,(iii)identifying the differences if any between the matter cited and the alleged invention,(iv) deciding if those differences viewed without any knowledge would have constituted steps which would have been obvious to the skilled addressee or whether an inventive step was necessary⁵¹. An invention shall be considered industrially applicable if according to its nature, it can be made or used in any kind of industry, including culture medicine, fishery and other services⁵².

An invention may be granted a patent upon registration. Registration is done in the following steps;

- i. The inventor shall file the patent application with the registrar following section 21 (1) of the IPA 2014, together with an application fee (Shs. 180,000)
- ii. Formal and substantive examination of the application is carried out by the patent office upon payment of the prescribed fees. A formal examination is done by the registrar of patents and then forwarded to the African Regional Industrial Property Organization (ARIPO) for substantive examination. The application is published in the gazette. (Sections 28, 29, 30 & 31 of the IPA 2014)
- iii. A certificate of grant and a copy of the granted patent are issued by the intellectual property office upon a finding that the application has patentable subject matter, payment of the prescribed fees has been made and that there

⁵¹ [1985] R.P.C 59

⁵² Section 12 of the Industrial Property Act 2014.

is of opposition application or such opposition application has been unsuccessful. (Grant fee, Shs. 300,000).

- iv. Then publication of the patent in the Uganda gazette. (section 32 of the IPA 2014)⁵³.

When facilitating patent applications, there is a rebuttable presumption that the person making the applications is entitled to grant the patent. A proprietor or a person named as an inventor in a patent application according to section 20 of the IPA 2014 is entitled to exclusive rights and obligations⁵⁴. An applicant or owner of an invention has the right to fulfil the relevant requirements under the Act to be granted the patent, to make, use, exercise and sell the invention exclusively and may preclude any person from exploiting the patented invention without his or her authorization⁵⁵. The owner may also assign and transfer by succession the application for the patent or the patent⁵⁶. In addition, according to section 38(4) of the IPA 2014, an applicant or owner of a patent may conclude license contracts and shall be subjected to obligations. These obligations include, (i) to disclose the invention clearly and completely and in particular to indicate the best mode for carrying out the invention following the requirements and subject to the sanction applicable under this act. (ii) to give information concerning corresponding foreign applications and grants including denials, revocations, invalidations suspensions or

⁵³ Abinyo S. Enforcing Intellectual Property Rights in Uganda, a presentation in the WIPO Training of Trainers Program on Effective Intellectual Property Asset Management by Small and Medium- Sized Enterprises (SME) in Kampala, Uganda November 7th, 2014, Organized by the WIPO in conjunction with the URSB. p.8; PDF Available at https://www.google.com/url?sa=t&rct=j&q=&esrc=s&source=web&cd=5&cad=rja&uact=8&ved=0CDgQFjAE&url=http%3A%2F%2Fwww.wipo.int%2Fedocs%2Fmdocs%2Fsme%2Fen%2Fwipo_smes_kla_14%2Fwipo_smes_kla_14_inf_1_prov.pdf&ei=e1sgVejYBYXbap7tgVg&usg=AFQjCNGFeD3nR6YTscQY6nei0B9Fmi93VQ&sig2=OvSLozWnAxewafJKaXi2RA&bvm=bv.89947451,d.d2s last accessed 28th April 2024.

⁵⁴ Part VII of the IPA 2014.

⁵⁵ Section 38(1) of the IPA 2014.

⁵⁶ Section 38(2) of the IPA 2014.

lapses, (iii) to pay a fee to the registrar as prescribed by law, (iv) to work the patent invention in the country within the prescribed time limit and, (v) in connection with license contracts and contracts assigning patents or patent applications, to refrain from making undesirable provisions referred in section 55 of the IPA 2014⁵⁷.

4.3 ENFORCEMENT OF PATENT PROTECTION IN UGANDA.

The strength of the enforcement of rights granted by the patent system laws is such that infringement of patents and the defences to infringement have to be carefully drawn out⁵⁸. *Monsata Canada Inc. V Schmeiser*, infringement was defined to mean any act that interferes with the enjoyment of the monopoly granted to a patentee⁵⁹. Under the Industrial Property Act 2014, an infringement of a patent under Section 92 occurs when a person other than the owner of the patent exercises any of the exclusive rights granted to the patent proprietor under Section 38 of the Act without the owner's authorization.

The exclusive rights protected under the provision were summarized in the American case of *Curtiss Aeroplane & Motor Corporation v United Aircraft Engineering Corporation*, as the rights to make, use and sell the patented product or a product made from a patented process infringes the rights of the patent proprietor⁶⁰. The rights of the owner of a patent include the right to fulfil the relevant requirements under the act to be granted a patent, the right to make use, exercise and sell the invention exclusively and may preclude any person from exploiting the patented invention without his or her authorization⁶¹. To this effect, upon the request of the

⁵⁷ Section 39 of the IPA 2014.

⁵⁸ Bainbridge. I. D, *Intellectual Property*, (8th edition Published in 2010) page 492

⁵⁹ [2004] 1 S.C.R 904

⁶⁰ (1920), 266 Fed. 70 (2nd Cir.) (USA), cited with approval by Rudd J in *Beecham Group Ltd v International Products Ltd & Anor* [1968] EA 396 at 402 (HCK)

⁶¹ Section 38 of the Industrial Property Act 2014.

owner of the patent, the court shall grant, (i) an injunction to prevent infringement where infringement is imminent or to prohibit the continuation of the infringement once it is started, (ii) damages and (iii) any other remedy provided for in law⁶². Where a person is threatened with infringement proceedings and who can prove the acts performed do not constitute an infringement, he or she may request the court to grant an injunction to prohibit the threat and to award damages for financial loss resulting from the threat⁶³.

According to section 96 of the IPA 2014 concerning infringement, 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 that alleged infringer if the product is new or a substantial likelihood exists that the identical product was made by the and the owner of the patent is unable through reasonable effort to determine the process used.

Although the enforcement of patents in regards to the infringement in courts is silent in Uganda, there are forms of infringement of patents in Uganda, this is to say; the importation and sale of the patented products without authorization and permission of the proprietor amounts to infringement⁶⁴. For instance, the report by the WTO on the East African Community Trade Policy Review revealed that Uganda's economy and markets are flooded with imported manufactured products from all over the world⁶⁵. The other form of patent infringement in Uganda is infringement by repair

⁶² Section 93 of the IPA 2014.

⁶³ Section 95(1) of the IPA 2014.

⁶⁴ Societe Anonyme des Manufactures de Glaces v Tilghman's patent Sand Blast Co. Ltd (1883) 25 Ch. D 1.

⁶⁵ World Trade Organization (WTO), East African Community Trade Policy Review-Uganda, WT/TPR/171/UGA, p. A3-211, Document available at https://www.wto.org/english/tratop_e/tp_r_e/s171-03_e.doc

or modification. This is rampant in Katwe a suburb of Kampala which is notoriously famous for repairing and modifying imported electronics, automobiles, televisions, refrigerators, and all kinds of appliances. Whereas the Industrial Property Act 2014 is silent on the exhaustion of patent rights upon the sale of the product by the patentee, the question of patent exhaustion in infringement cases involving the repair or modification of a product is inevitable in Uganda. To this extent where the purchaser has an implied license to repair and modify the product, changes that amount to remarking the product infringe the patent and the purchaser cannot rely on the implied license as a defence⁶⁶.

In *Dunlop Pneumatic Tyre v Neal*, Dunlop had a patent for pneumatic tyres for bicycles which claimed “a rubber or elastic tyre having the form of a saddle or arch in section lined in canvas, in combination with two wires or sufficiently inelastic cores for securing the same to the rims or tyres substantially...” The defendant Neal had repaired a worn-down tyre originally made by the plaintiff by repairing a broken wire and constructing a new canvas cover and rubber cover. The defendant argued that the patent covered a combination and that since part of the combination (the wires) had been licensed by Dunlop by sale, there was no infringement. The learned judge North J in rejecting the defence and holding the defendant liable for infringement, held that; “... the only license or authority given by the sale made by the plaintiffs was the tyre, including the wires, might be used till it should be worn out. Any simple repairs might be done by any person without a license from the manufacturer. [But] when a person takes the whole thing and makes and sells that which is a new tyre having merely the old wires in it, there is no license from the

⁶⁶ Christopher Stothers, *Patent Exhaustion: the UK Perspective*, (2008), page 8.

plaintiffs to use the old wires to put them into a new article making up precisely the combination which is the subject of the patent”⁶⁷.

This kind of infringement in the case of Dunlop, is rampant in Katwe where electronic appliances, automobiles and other products are substantially repaired and modified in such a manner that would constitute the making of new products using the parts of patented products. However, these activities have gone unabated⁶⁸.

Lastly, where an action is brought for infringement of a patent, a defendant may be in a position to file defences which may include;

- i. Prior use and commencement, a patent has no effect against any person who in good faith for his or her enterprises or business before the filing date or where the 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, is using the invention or making effective and serious preparations for that use⁶⁹.
- ii. Invalidity of the patent, in proceedings for infringement, it is proper for the alleged infringer to counterclaim and contend that the patent for which the owner claims is infringed is invalid for the want of satisfaction of the essential requisites of a patent⁷⁰.
- iii. Exception to exclusive rights, as a defence it is not an infringement of a patent to use the patented invention without authorization of the patent

⁶⁷ [1899] 1 Ch 809, (1899) 16 RPC 247.

⁶⁸ Kakooza C.K. Anthony, The Civil, Administration and Criminal Law Standards in Intellectual Property Enforcement in Uganda: The Good, the Bad and the Hoped-for <http://ssrn.com/abstract=1658658>

⁶⁹ Section 41(1) of the IPA 2014.

⁷⁰ Section 90(1) of the IPA 2014.

holder if it falls within the circumstances laid out in section 44 of the IPA 2014.

- iv. Limitation of rights, it is a defence if a patent owner brings an action for the infringement of rights under a patent that extends to the limited rights such as (i)acts which are done for scientific research, (ii)acts in respect of articles which have been put on the market in Uganda or any country or imported in Uganda by the owner of the patent, (iii)the use of articles on aircraft, land vehicles, or vessels of other countries which temporarily or accidentally enter the air space territory or waters of Uganda, and (iv)those that 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 those mutants or variants are deserving of separate patents⁷¹.

4.4 THE INTERNATIONAL PATENT PROTECTION.

The international standards for protecting Intellectual Property Rights today either begin from the TRIPS Agreement backtracking to standards and enforcement procedures in earlier international instruments, or from the earlier treaties and agreements and climax with the standards in the TRIPS Agreement⁷². The TRIPS agreement provides for the minimum standards of protection for Intellectual Property Rights applicable to all WTO members⁷³. The members can implement more extensive protection than is required by the TRIPS Agreement provided that such

⁷¹ Section 43 of the IPA 2014.

⁷² World Trade Organization (WTO), Understanding the WTO: The Agreements, Intellectual Property: Protection and Enforcement, available at http://www.wto.org/english/thewto_e/whatis_e/tif_e/agrm7_e.html

⁷³ Tshimanga Kongolo, African Contributions in Shaping the Worldwide Intellectual Property System, MPG Books Group, UK (2013), page 2

protection does not contravene the provisions of the agreement⁷⁴. The international perspective on patent protection is informed by the regional mechanisms under regional arrangements such as the ARIPO and the international mechanisms under the Patent Cooperation Treaty⁷⁵.

The African Regional Intellectual Property Organization (ARIPO) is an inter-governmental organization that facilitates cooperation among its member states on intellectual Property matters established by the Lusaka Agreement on 9th December 1976. The Harare Protocol empowers the ARIPO office to receive and process patent and Industrial Design applications on behalf of the state's party to the Protocol. The current members of the AIRPO include Botswana, Eswatini, Gambia, Ghana, Kenya, Lesotho, Namibia, Rwanda, Zambia, Zimbabwe, Sao Tome, Somalia, Sierra Leone, Tanzania, Sudan and Uganda. ARIPO itself can be designated under the PCT; it is also a member of the Paris Convention for the Protection of Industrial Property. The Harare Protocol empowers ARIPO to grant patents and register industrial designs as well as Utility models on behalf of the contracting states⁷⁶.

The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in each of the large number of countries by filing an 'international' patent application. Such an application may be filed by anyone who is a national or resident of a PCT contracting state. It may generally be filed with the national patent office of the contracting state of which the applicant is a

⁷⁴ Article 1 (1) TRIPS Agreement

⁷⁵ *ibid*

⁷⁶ ARIPO Secretariat Harare, "ARIPO: Who we are & What we do", (February 2016 revision), see; https://www.aripo.org/wp-content/uploads/2018/12/ARIPO_Who_We_Are_What_We_Do_1-1.pdf

national or resident or at the applicant's option, with the international bureau of WIPO in Geneva⁷⁷.

A patent owner who registers his or her patent under an international application must specify the states in which he or she seeks protection⁷⁸. A state selected for protection under an international patent application is known as a designated state⁷⁹. The international patent applicant is also required to register the same with the domestic patent office of that state and upon payment of the prescribed fee a patent may be granted⁸⁰. Similarly, an applicant filing an international application with the ARIPO which is a regional body has to specify the designated states and pay a designation fee per member state designated. A patent granted by the ARIPO under the Harare Protocol on Patents, unless objected to by the Registrar has the same effect as that granted by the national office under a national patent application⁸¹. International patent applications filed with the United International Bureau for the Protection of Intellectual Property (BIRPI) are operationalized by Part VI of the Industrial Property Act 2014. Regional patent applications that are granted under the ARIPO in respect of which Uganda is a designated state are operational under and subject to section 45 of the Industrial Property Act 2014⁸².

⁷⁷ World Intellectual Property Organization, "Patent Cooperation Treaty", see; <https://www.wipo.int/treaties/en/registration/pct/>

⁷⁸ Article 4(1) (ii) of the PCT

⁷⁹ *ibid*

⁸⁰ Article 4(2) of the PCT and section 34(2) of the IPA 2014

⁸¹ Section 45 of the IPA 2014.

⁸² *ibid*

4.5 THE RELATIONSHIP BETWEEN THE INTERNATIONAL PERSPECTIVE AND DOMESTIC PERSPECTIVE OF PATENT SYSTEMS IN UGANDA.

Patents under the TRIPS Agreement are protected and enforced under Part II Section 5 (the part for the standards concerning the availability, scope and use of intellectual property rights.) of the agreement.

The Industrial Property Act 2014 sufficiently replicates the provisions of the TRIPS Agreement as shown in the subsequent discussion.

Article 27(1) of the TRIPS Agreement provides that patent protection is for new inventions of a product or process involving an inventive step and is capable of industrial application, which is also provided in section 9 of the IPA 2014.

A patentee has exclusive rights to make, use and sell the invention under Article 28(1) of the TRIPS agreement, as well as assign, transfer by succession and license these rights as provided in Article 28(2) of the agreement. These provisions are similarly laid out in section 38 of the IPA 2014

The exclusive rights granted to a patentee under Article 28 are subject to limited exceptions under Article 30 of the Agreement which stipulates that members may provide limited exceptions to exclusive rights, provided such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking into account of the legitimate interests of third parties. These exceptions to the exclusive rights are laid out in section 44 of the IPA 2014.

The TRIPS agreement and the Industrial Property Act both stipulate that the term for patent protection shall not end before the expiration of a period of twenty (20) years from the filing date⁸³.

The TRIPS Agreement and the Industrial Property Act 2014 both provide similar remedies that shall be availed to the owner in case of an infringement of an intellectual property right. Where a patent has been infringed, a patentee shall apply to court seeking an injunction, and the judicial authorities shall have the authority to order a party to desist from infringement and also to restrain performance or entry into the channel without the authorization of the owner. This is laid out in Article 44 of the TRIPS agreement and Section 40 (1) (a) of the IPA 2014. Similarly, both the TRIPS Agreement and the Industrial Property Act 2014 provide for the claim of damages adequate to compensation for the injury suffered by the owner in case of an infringement of a patented product or process⁸⁴.

Lastly, the TRIPS agreement bears a minimum standard of legal provisions on Patent registration procedures and requirements, the rights of a patentee, protection from infringement and accessible remedies in case of infringement that member states should adopt in their national system for smooth enforcement. All these minimum protection requirements are met by Uganda's Industrial Property Act 2014.

4.6 CONCLUSION.

Whereas Uganda is making progress in improving its intellectual property environment, there is much more desired in making its patent regulatory and enforcement mechanisms and institutions functional. Without functional

⁸³ Article 33 of the TRIPS Agreement and Section 46 of the Industrial Property Act 2014.

⁸⁴ Article 45 of the TRIPS Agreement and Section 40(1)(b) of the Industrial Property Act 2014.

enforcement institutions, much as the Industrial Property Act 2014 is a good law that repudiates the minimum standards of the TRIPS Agreement, it remains a fine but helpless statute book in the laws of the land.

CHAPTER FIVE: SUMMARY OF FINDINGS, CONCLUSIONS AND RECOMMENDATIONS.

5.1 INTRODUCTION

The objective of this research was to assess the efficiency of Uganda's Patent system under the national intellectual property legal, institutional and policy framework in guaranteeing the enjoyment and protection of patents granted under national, regional and international applications. This chapter of the research seeks to make general observations, summarize the findings of the research, point out challenges faced in the collection of data of the research and climaxes with recommendations from the research and a general conclusion of the research.

5.2 GENERAL OBSERVATIONS AND SUMMARY OF FINDINGS.

The findings of the research are entirely based on the analysis of the national and international legislation, analysis of the intensive literature reviewed and the data collected from the field through interviews.

- a) The intellectual property legal framework of Uganda under the Industrial Property Act 2014 complies with the patent minimum protection requirements under the TRIPS Agreement standards⁸⁵. The TRIPS Agreement provisions for the registration of patents, the rights of the patentees, the duration term of the patent protection, and the remedies for patent infringement are repudiated by the Industrial Property Act of 2014.
- b) The patent registration, regulation and enforcement institutions such as the Uganda Registration Service Bureau, the courts at large, and the Uganda National Council of Science and Technology (UNCST) are short of well-

⁸⁵ Article 1(1) & section 5 of the TRIPS Agreement.

established capacity-building facilities to uphold enforcement and protection of patent rights.

- c) The information obtained from Mr. Kagwa John a patent examiner at the National Office URSB and a sample of individuals engaged in Small and medium-sized enterprises (SMEs) reveals that very few people have knowledge and a substantial understanding of the law concerning patent rights which has gradually contributed to the low number of patent applications in Uganda.
- d) The National Intellectual Property Office receives and registers the least number of patent applications compared to other intellectual property rights. Statistics for two financial years show that of the few patent applications received, very minimal applications qualified for a grant of a patent. Over the financial year 2012/2013 and financial year 2013/2014, only 24 patent applications were registered which is less than 1% of the received applications.
- e) The low levels of public awareness of the importance of patent rights and the law governing their protection have facilitated the persistent infringement of these rights in Uganda. For instance, the substantial modifications and repairs of patented manufactured products in Katwe⁸⁶.
- f) The importation and sale of patented products without authorization and permission of the proprietor has contributed to increased infringement of patents in Uganda. For instance, the report by the WTO on the East African

⁸⁶ Ikwap Emma, Know Your Hood: Katwe, Famous for Its African Metallic Artistry, Daily Monitor (10th July 2013), Retrieved 9th April 2015, at <https://www.monitor.co.ug/Magazines/HomesandProperty/-Famous-for-its-African-metallic-artistry/-/689858/1909992/-/item/1/-/13mw0h4/-/index.html>.

Community Trade Policy Review revealed that Uganda's economy and markets are flooded with imported manufactured products from all over the world⁸⁷.

- g) The international perspective on patent protection is informed by the regional mechanisms under regional arrangements such as the African Regional Intellectual Property Organization. This organization as empowered by the Harare Protocol, grants patents and registers industrial designs as well as utility models on behalf of the contracting states⁸⁸.
- h) On the other hand, the international perspective on patent protection is also informed by international mechanisms such as the patent cooperation Treaty which enables the protection of an invention in several countries by international patent applications which may be filed by anyone who is a national or resident of a PCT contracting state⁸⁹.
- i) The grant of international Patents by the United International Bureau for the Protection of Intellectual Property unless objected to by the Registrar has the same effect as the patents that are granted by the National office under a national patent application. International patent applications filed with the (BIRPI) and those granted under the ARIPO are operationalized by Part VI of the Industrial Property Act 2014.

5.3 CHALLENGES OF THE RESEARCH

The interviews that were initially intended to be made in Katwe about the people's perspective on the registration of patents were highly incapable because of the

⁸⁷ World Trade Organization (WTO), East African Community Trade Policy Review-Uganda, WT/TPR/171/UGA, p. A3-211, Document available at https://www.wto.org/english/tratop_e/tpr_e/s171-03_e.doc.

⁸⁸ ARIPO Secretariat Harare, "ARIPO: Who we are & What we do", (February 2016 revision), see; https://www.aripo.org/wp-content/uploads/2018/12/ARIPO_Who_We_Are_What_We_Do_1-1.pdf

⁸⁹ *ibid*

limited knowledge and awareness of intellectual property rights such as patent protection of inventions. In addition, business individuals along the streets of Katwe were hesitant to contribute to the research due to the perception towards the likelihood of criminal investigation and the fear of being interrogated about their businesses in the repair and modification of products to which they are not registered owners.

Scarce and limited publications on patent protection and infringement in Uganda did not avail much comparison for this research to work with. Due to the limited number of registered patents and scarce cases of patent infringement, the research barely contains precedented Ugandan case law to lay down a comparison of the principles governing patent systems in Uganda with the research at hand.

5.4 CONCLUSION

Uganda's patent system is not yet at optimum. The country is not earning maximal benefits from its patent system under which the registered inventions would afford protection and the owner's exclusive rights. Statistics show that the national office handles minimal patent applications, registrations and renewals compared to the other intellectual property rights applications. This has some effect on Uganda's designation in regional and international applications thus affecting the amount of revenue collected from the registration and maintenance of international patents. Uganda therefore earns a lesser share of the royalties and fees that accrue to a designated state than her counterpart member states to the respective IP organizations and instruments which have a higher level of patent activity.

It's important to note that Uganda is a developing country the problems that arise from the enforcement of patents are inevitable even though the laws governing

patents meet the minimal standards of the TRIPS agreement, however if the basis of the research is put into effect in regards with bridging the gaps and resolving the loopholes within the legal and policy framework, the enforcement and institutional development, then in the long run the positive effects of patent systems shall overcome the negatives in the industrial sector of Uganda.

5.5 RECOMMENDATIONS

5.5.1 Recommendations to the Government

The government through well-established enforcement and policy institutions should devise mechanisms to uphold intensive sensitization of the public on the importance and relevance of protection of patent rights. This shall encourage functional participation and enforcement of patent systems through their legal frameworks and institutions in the industrial sector of Uganda.

There is a need for the government to establish functional institutions to handle the issues and affairs of the enforcement of intellectual property rights and implementation of intellectual property regulations in Uganda as it is in Kenya which has an established functional institute, the Kenya Industrial Property Institute responsible for handling affairs that concern intellectual property rights.

5.5.2 Recommendation to the Parliament

Lawmakers in Uganda should develop patent legislation that facilitates penal provisions, especially for the infringement of patent rights. Intellectual property rights such as copyrights and trademarks have adopted both a civil and criminal enforcement of their infringement, unlike the patents which have gradually contributed to the inefficiency of the enforcement of patent systems in Uganda. The

development of criminal remedies for infringement of patents shall cut down on the inevitable use, repair and modification of patented products and processes.

There is a need to undertake more research in this area of law and policy to address the issues facing the enforcement of patent rights in Uganda in depth. Such research can be a basis for improving the functionality of Uganda's patent regulatory and enforcement institutions.

5.5.3 Recommendation to the intellectual property institutions in Uganda.

Intellectual property institutions such as registration offices (URSB), should adapt ways to effectively sensitize the public on patent systems in Uganda and encourage innovation as well as publicly advertise patents that have been registered to cut down on the inevitable chances of infringement by the people especially those in Katwe.

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