UNIVERSITY OF LAGOS

UNILAG-Patent Management Protocol

Forward

The University of Lagos is entering a new era in which it will be engaging more with its immediate community in providing solutions to societal needs. Our research and innovation activities moving forward would be focused on addressing the specific needs of our communities and societies at large with the cascading effect on enhancing the quality of life and creating wealth. Such solutions are products of innovations and research findings that are often eligible for intellectual property protection.

This new era of pragmatic interface with our communities in addressing their specific needs requires the emplacement of necessary governance structure and workflow process for the filing of appropriate intellectual property rights to support the inventive efforts of members of the university community. It is in this sense that the University of Lagos Patent Management Protocol has been developed to provide a framework for the filing and processing of patent applications.

The protocol provides an institutional framework for all activities relating to the filing of a patent application for an invention. It gives members of the university community, at their fingertips, the opportunity to quickly determine what qualifies as inventive work or otherwise without engaging in any desktop research. Indeed, it encapsulates what needed to be known about the process of patenting and what comes afterward in terms of the time frame, fee regimes, custodian of IP rights, post-patenting activities such as prototyping, and product development and commercialisation.

It is my desire to see the University of Lagos ranked not only as the university with the most commercialized patents but with the highest returns on royalty in the foreseeable future. This concise protocol for patent management is meant to provide the framework for achieving that aspiration.

Prof. Oluwatoyin Temitayo Ogundipe, *FAS*
Vice Chancellor

UNILAG-Patent Management Protocol

1.0 Background Introduction

The UNILAG Patent Management Protocol (hereinafter referred to as UNILAG-PMP) provides procedural framework for the routing, coordination and management of activities leading to the filing of application for patents as well as post-patent activities for inventions or innovation of members of the University community arising from individual's or University sponsored research. The Protocol equally provides delineation for varieties of works that qualify for patent or other intellectual property (IP) rights. The Protocol is in four levels; the first level defines what can be classified as creative works for IP rights as well as list of exceptions to patentability; the second level provides a checklist for identifying patentable inventions or innovations; while the third level provides the detailed flow sequence of activities for the filing of patent. This is further broken down into responsibilities expected of both the inventor, and the Innovation Unit in interfacing with the Patent Registry. It also provides information on timelines for the filing of a successful patent application, the associated filing fees, and the custodian for the patent. The fourth level is the post patent activity which involves further development of Proof of Concept and validation followed by product development and commercialization, in conjunction with the Entrepreneurship and Skill Development Centre (ESDC). A list of glossary of terms is equally provided in the Protocol.

2.0 Creative Works for IP Rights

Creative and inventive works are generally categorised as intellectual property. The World Intellectual Property Organisation (WIPO), the United Nation's agency responsible for IP issues recognises two broad categories of intellectual property and these are industrial property and copyright.

2.1. Industrial Property: this comprises patent for inventions, trademarks, industrial designs, trade secrets and geographical indications.

2.2. Copyright and Related Rights: creative works such as literary works (novels, poems, reference works, plays, newspaper advertisement), films, music, artistic works, and audio-visual works, computer programs, broadcasts and databases are covered under copyright. Related Rights on the other hand include such works as artistic performances by actors and musicians, production of phonograms and radio and television programmes. Related Rights is at times equally known as Neighbouring Rights which include performances and folklore.

The validity periods for the various classes of IP Rights are presented in Table 1.

3.0. Checklist for Patentable Invention and Exceptions to Patentability

Not all inventions and innovations qualify for a grant of patent. There are basic checklists for patentable inventions as well as exceptions to patentability.

3.1. Identifying Patentable Inventions/Innovations

Inventions and innovations must meet the following criteria to be eligible for patent:

- Utility: must serve a practical purpose particularly industrial application.

- Novelty: must exhibit some characteristics not present or part of the existing body of knowledge (prior art) in the particular field.
- Non-Obviousness: exhibit at least an inventive step that could not be deduced by someone with average knowledge of the technical field.
- Legal coverage: must be acceptable under the law as eligible for IP Rights.
- Disclosure sufficiency in filing application: the invention must be disclosed in sufficient detail to permit reproduction of the claimed invention.
- Morality: must not be contrary to morality.

Table 1: Validity periods of the classes of IP Right (Adapted from http://www.wipo.int/about-ip/en/)

Categories of IP	Classes of IP Right	Validity (Years)	Renewal	Term Limit
Industrial Property	Patent	20 years	Not renewable afterwards	20 Years
	Utility Model*	10 years in the first instance	renewable for 2 consecutive terms of 5 years each	
	Trademarks	7 years in the first instance	Renewable thereafter at intervals of 14 years	No time limit. Remains valid as long as it is renewed
	Industrial designs	5 years in the first instance	renewal for 2 further consecutive terms of 5 years each	15 years
	Geographical indications*†	Throughout lifetime.		For as long as it is not secret
	Appellation of Origin			
	Trade Secret	As long as it can be kept secret.		
Copyright	Copyright	50-70 years post-creator's death or post-publication (depending on the category of work)	Not applicable	Time barred
	Related Right	Maximum of 50 years		
	Neighbouring Right	Indefinite duration for Folklore		

*These are not available under Nigerian Law but regional and international frameworks do exist.
†May only be granted through creative use of the certification trademarks.

3.2. Exceptions to Patentability

The WIPO has identified the following as not being eligible for patentability:

i. Discoveries and/or mathematical theories.

ii. Aesthetic creations (but are protectable as industrial designs or copyright).
iii. Playing games, methods of doing business (software/computer programmes are protectable under copyright in Nigeria if requirements are met).
iv. Diagnostic, surgical and therapeutic methods.
v. Inventions contrary to morality.
vi. Plant or animal varieties (permitted for protection under "Sui generis systems" as per international requirement particularly but they are still excluded from patentability in Nigeria).

4.0 Filing a Patent Application

Filing an appropriate IP Right application is a flow sequence from the inventor/innovator, through the Innovation Unit of the Research & Innovation Office to the Trademarks, Patents and Design Registry of the Ministry of Trade, Investment and Commerce. The Trademarks, Patent and Design Registry is the national office responsible for the administration and coordination of all industrial property issues while fall within the mandate of the Nigerian Copyright Commission. Each individual in the flow sequence plays specific roles in the application process.

The roles of the Inventor, the Innovation Unit and the Patent Registry in the application process are represented graphically in Figure 1.

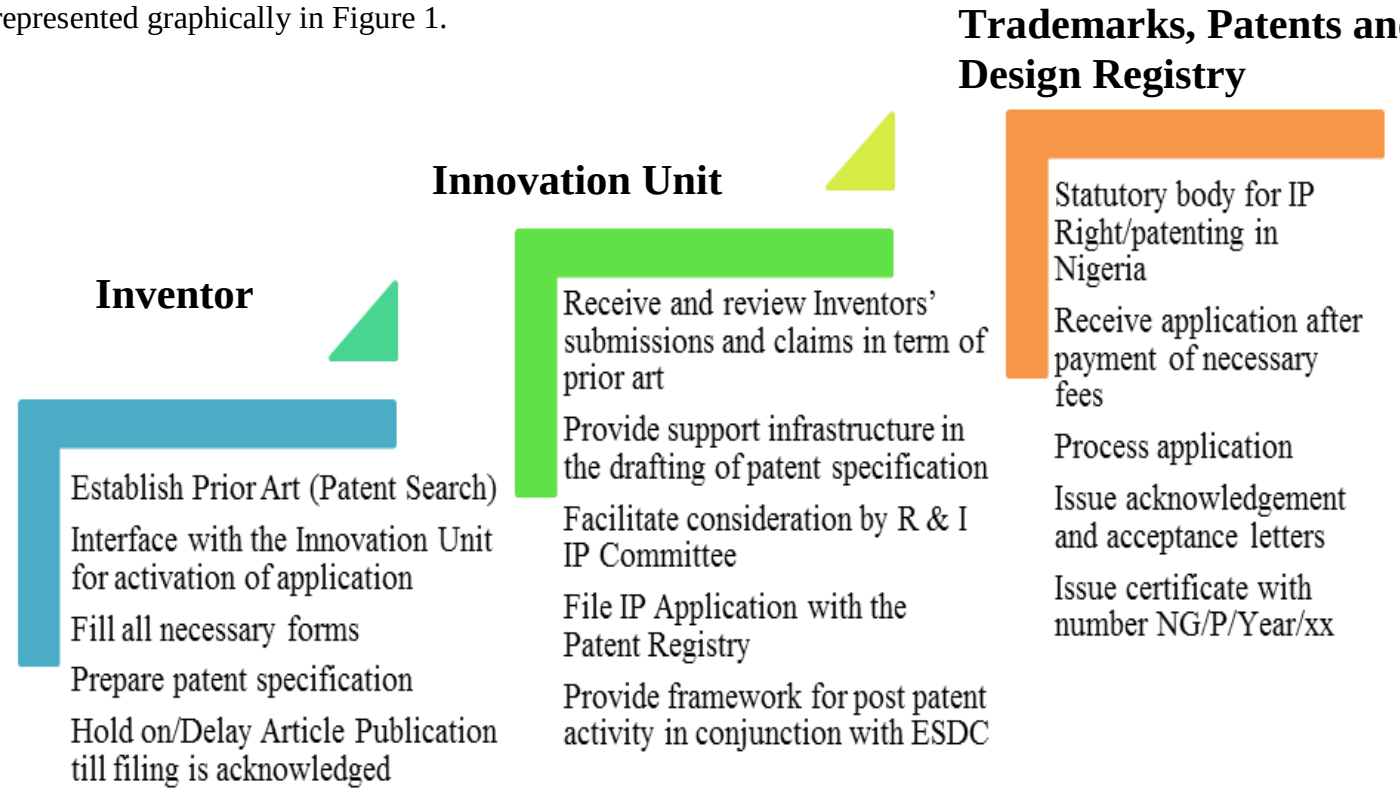

Figure1: Illustration of the roles of principal actors in the filing of patents

Patents have jurisdictional/territorial control or regulation; and as such filing could be at the national, regional, continental and global level. Filing at the national and regional level are straight forward but becomes complex at the continental and global level. Global filing is best routed through WIPO though multiple individual jurisdictional filing is equally possible but the route is tedious and costlier. The flow sequences with timelines for both national and international filings are presented in Figure 2 and Figure 3, respectively.

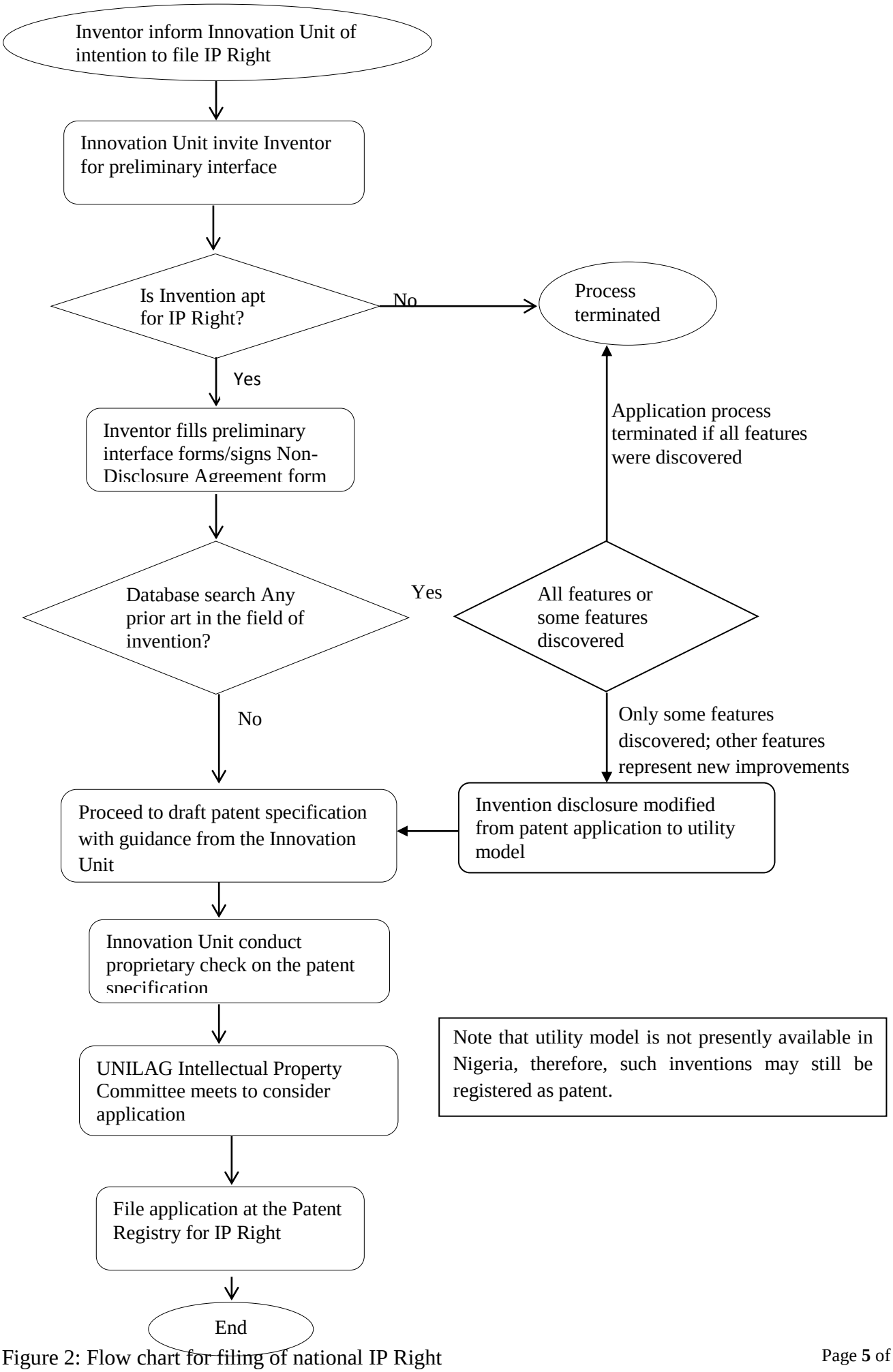

Figure 2: Flow chart for filing of national IP Right

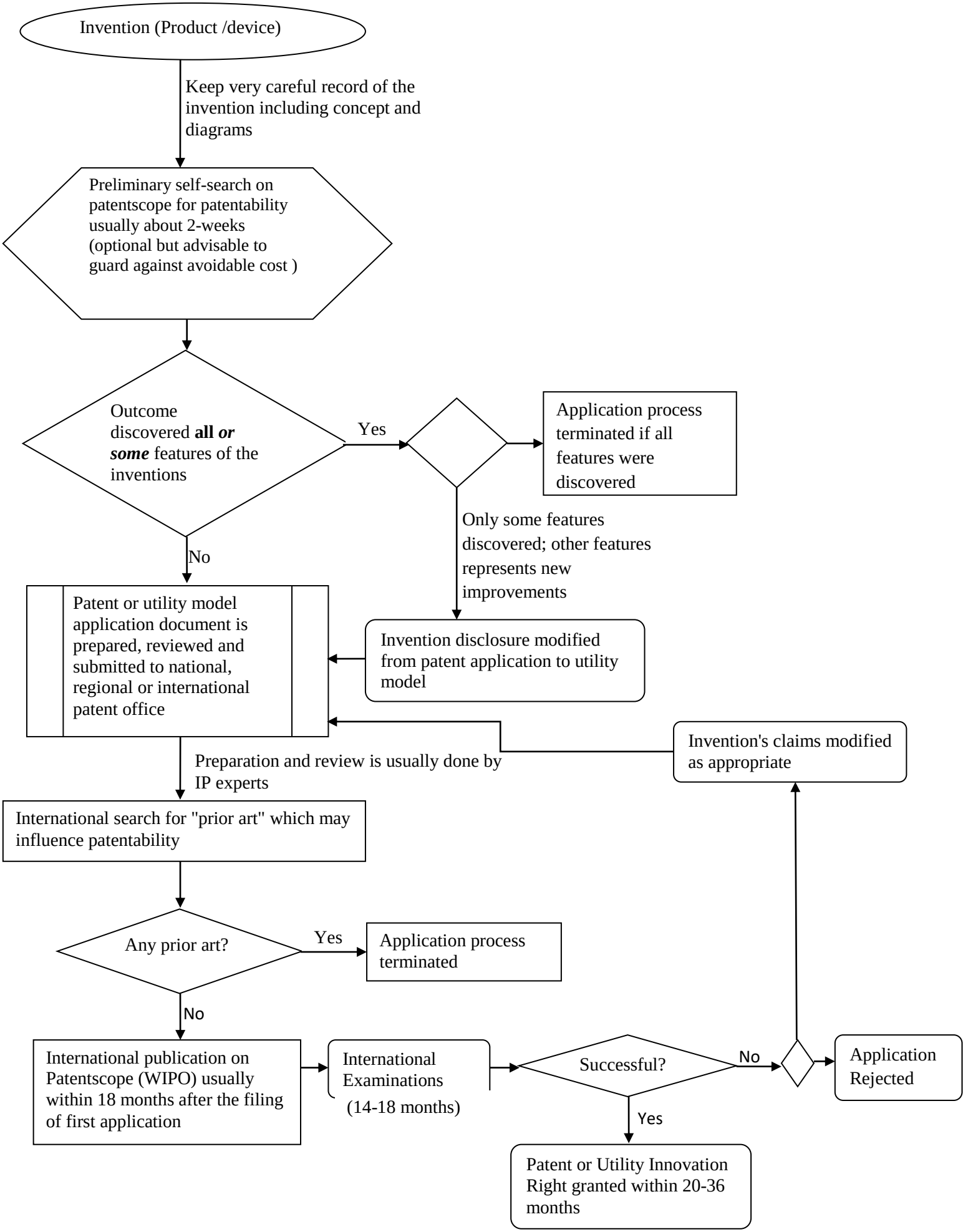

Figure 3: Filing sequence for international IP Right through PCT route

4.1. IP Application Timelines

The timelines from the intention to file IP Right to the eventual granting of the right for either national or international (PCT-WIPO) application are provided in Table 2. These timelines are exclusive of the post-patenting activities.

Table 2: Timelines for the filing of national or international IP Right

Filing Type	Contact Office	IP Activity	Duration (Month)	Flow Cycle
National	Innovator/Innovation Unit	Notification and interface with the Innovation Unit	Two weeks	6-12 Months
		Interface and signing of non-disclosure agreement form	Two weeks	
		Review of preliminary forms and resubmission	Six weeks	
		Patent specification drafting	Two weeks	
	Innovation Unit	Proprietary check on patent specification	Two weeks	
		Consideration by UNILAG IP committee	On notice after feedback on patent specification	
	Patent Registry	Filing of application at Patent Registry	6 months	
International	WIPO	International search for prior art (ISA)	4 Months	24-36 Months
		IP Filling through PCT		
		International publication on patentscope	18 Months after first application	
		International Examination	14 - 18 months	

4.2. Filing Fees for IP Right

The schedule of filing fees for patent either via the national or the WIPO-PCT route is provided in Table 3.

Table 3: Filing fees for national and international patent

Filing Type	Transmittal Fee	Int. Filing Fee	Fee per sheet over 30	Int. Search Agency(ISA)	Preliminary Examination Fee	Supp. Search Fees	Total
National	=N=25,000.00 per application				=N=25,000*X + Agency fee		
International		CHF1330		CHF150-2000	Optional		CHF1480-3500

X is number of invention for patent; CHF is Swiss Franc

4.3. Custodian of Patent

The University should ideally be the institutional owner of patents for so many reasons. One, the University bears the full cost implication of the filing process. Two, the inventor is a staff of the University and makes use of its infrastructure in the course of the invention. Further, the University has a wide leverage to handle residual issues emanating from the invention process including all post patent activities leading to the derivation of economic benefit from the invention. However, for inventions that emerge from sole funding by the inventor, the issue of ownership may need to be negotiated based on the level of involvement of the University.

5.0 Post Patent Activity

There are two post patent activities, and these are prototyping/validation and product development/commercialisation.

5.1. Development of Prototyping/Validation

Patented invention proceeds to full prototyping, testing and validation for improvement preparatory to large scale product development and commercialisation. This process involves conducting real time performance evaluation of the prototype of the invention for validation. It is envisaged that the University would fund this process through a dedicated fund in the form of an *Innovation Fund.*

5.2. Product Development and Commercialisation

After prototyping, the patented invention proceeds to product development and commercialisation under the control of the Entrepreneurship and Skill Development Centre (ESDC) in conjunction with the Innovation Unit. The ESDC will determine and recommend to the University the best model for commercialisation of the patented invention. The Centre may suggest the best of any of the following three models to the University towards deriving maximum benefit from the invention:

1. Setting-up a Special Purpose Vehicle (SPV) for product development and commercialisation
2. Entering into equity participation with interested investor(s) for joint venture partnership.
3. Out-right sale of the proprietary right on the invention.

4. Granting permission (license) to a third party to use the patent exclusive right on agreed terms.

5.3. Reward System for Patented Inventions

This is as provided in the University of Lagos policy documents on intellectual property management and Research and Innovation governance framework.

6.0 Glossary of Terms

6.1. Creative work: this applies more to copyright and designs than patent and it refers to the tangible manifestation of the conversion of an idea into physical form or process though the exercise of the human mind (mental activity). *A distinct feature of any creative work is that it is difficult for two people working independently to produce the same work via the same thought process*.

6.2. Invention: refers to a unique or novel product, process, method or combination of all these (arising from creative use of the human mind) which is eligible for proprietary protection.

6.3. Innovation: refers to the art of converting an idea or invention into tangible product or service that creates value.

6.4. Intellectual Property (IP): refers to creative, inventive and enterpreneurial works eligible for both moral and economic ownership in terms of privileges and benefits.

6.5. Intellectual Property Right: refers to secure legal instrument granting control to originators of creative works. The instrument grants the holder the right to benefit from his/her own creativity or investment in a creation.

6.6. Protocol: refers to specified procedural path for the routing and coordination of all activities relating to intellectual property and related matters.

6.7. Post Patent Activity: refers to series of activity on a particular invention after the granting to patent award leading to commercial launch or uptake of the invention.

6.8. Proof of Concept: a term used to describe documented evidence on a small scale (through experiment or pilot project) that a concept, idea or process is feasible with potential for real-world application.