

**BILLS SUPPLEMENT**

*to the Uganda Gazette No. 29 Volume CII dated 19th June, 2009.*

Printed by UPPC, Entebbe by Order of the Government.

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**Bill No. 5** *Industrial Property Bill*

**THE INDUSTRIAL PROPERTY BILL, 2009.**

**MEMORANDUM.**

1. The object of this Bill is to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, technovations and industrial designs, to provide for the designation of registrar, the powers and functions of the registrar, and the establishment of a register of industrial property rights and for incidental and connected purposes.
2. This Bill is part of the programme of reform of commercial laws of Uganda to support private sector development, commercial justice reform and to encourage private investment.
3. Traditionally, industrial property has been known to include patents, utility models, industrial designs, technovations and trademarks. The law of trademarks is being dealt with separately.
4. Over time, some aspects of the law on industrial property have become outdated, especially in light of the present day policies, international obligations, globalization and technological developments.
5. In April 1994, Uganda signed the agreement establishing the World Trade Organisation (WTO) and ratified the Agreement in October 1994. By 31st December, 1994 Uganda had fulfilled all the

conditions necessary to become a founder member of the WTO. There is a great need to bring the current legislation in line with the international commitments to which Uganda is bound.

6. All WTO agreements are essential and of immediate concern to Uganda although the degree varies from one agreement to another. The different agreements give varied time frames within which member countries are expected to implement them. Uganda being a least developed country, benefits from the special and differential clauses that give a longer period for the application of particular agreements and of being required to implement certain provisions of the agreement because of the additional form of resource requirements needed to implement these agreements, and possible effect of the infant and non-competitive industries.

7. The Patents Cooperation Treaty (PCT) to which Uganda acceded on 19th February, 1995 provides for international patent applications. Therefore any applicant from a member country can designate Uganda for patent protection and similarly Ugandan patent applicants can designate PCT member countries in their applications.

8. Uganda enacted an amendment to the Patents (Amendment) Act, 2002 (Act No.7 of 2002), making the procedure on international applications for patents operational, and Uganda a designated country.

### Provisions of the Bill

#### Part I of the Bill—Preliminary

9. Part I provides for commencement and interpretation. Clause 2 which deals with interpretation of words and expressions used in the Bill defines “industrial property rights” as follows—

“industrial property rights” means rights under patents, certificates of utility models and technovations and registration of industrial designs issued under the Bill.

Clause 2 also defines *inter alia*, patent, industrial design, and utility model.

#### Part II—Administration

10. Part II of the Bill provides for the administration of the Bill by a registrar who is designated as registrar under Part V of the Uganda Registration Services Bureau Act, Cap.210 (clause 3).

11. Clause 4 of the Bill deals with the functions of the registrar. These include grant of applications for industrial property rights and registration of technology transfer agreements and licences.

12. Clause 5 of the Bill requires the registrar to maintain two registers one of which shall contain all industrial property applications and the other shall contain all industrial property and other rights granted under the Act which shall be recorded and numbered in the order of grant in respect of each patent where appropriate, its lapse for non-payment of annual fees and all transactions to be recorded by virtue of the new Act.

Under clause 5 the register may be inspected by the public upon the payment of the prescribed fee and the register shall be prima facie evidence of any matter required or authorized under the Act to be registered.

13. Clause 6 protects the registrar from personal responsibility in respect of acts done in good faith in performance of his or her duties. On the other hand clause 7 requires the registrar to pay compensation to a member of the public for any damage caused by him or her in the performance of his or her duties.

#### Part III—Patentability

14. Under this Part the registrar grants patents in respect of inventions. Clause 8 defines the term “invention” for the purposes of that Part to mean a solution to a specific problem in the field of technology.

15. Under clause 8(2) an invention may relate to a product or a process. Under clause 8(3), certain inventions are to be excluded from patent protection under the Bill. These include—

- (f) pharmaceutical products but here their protection would expire on 1st January, 2016 on which date, the protection would fall in the public domain and cease to exist.
16. Clause 9 defines a patentable invention as one which is new, involves an inventive step and is industrially applicable.
17. According to clause 10, an invention is new if it is not anticipated by prior art. Clauses 10(2) and (3) describe what a prior art is.
18. Clause 11 defines an inventive step and clause 12 explains an industrial application for purposes of patentability under clause 9.
19. Clause 13 states the following as patents which are not patentable—
- (a) plant varieties as provided for in the law providing for protection of plant varieties;
  - (b) inventions contrary to public order, public health and safety, principles of humanity and environmental conservation.
20. Clause 14 gives the Minister and the registrar power to prohibit the publication of any information in a patent application prejudicial to the security of Uganda.
21. Clause 15 imposes certain restrictions on the filing outside by Ugandans resident outside Uganda of applications for patents without the written authority of the registrar.
22. Clause 16 limits the extent to which certain inventions relating to micro-biological processes or products can be said to be disclosed for the purpose of patentability under the Act.

**Part IV of Bill—Right to Inventions and Naming of Inventor**

23. This Part deals with the right to a patent.

Clause 17 *inter alia*, provides that the right to a patent belongs to the inventor. Where two or more persons have jointly made an invention the right to the patent belongs to them jointly. According to clause 17(4) the right to a patent may be assigned or may be transferred by succession.

Clause 20 requires the inventor to be named as the inventor in the patent application unless he or she declares in writing to the registrar that he or she does not wish to be named. Under the clause where two or more persons have made the same invention independently of each other the person whose application has the earlier filing date or if priority is claimed the earlier validity claimed priority date, shall have the right to the certificate as long as the application is not withdrawn abandoned or rejected.

**Part V of the Bill—Application, Grant and Refusal of Grant of Patent.**

24. This Part deals with the process of application and grant of patents.

Clause 21 details the contents of an application for a patent including a description of the invention. It requires the application to be filed with the registrar. Under clause 21(2) where the ordinary residence or principal office of the applicant is outside Uganda he or she shall be represented by an advocate.

Clause 22 requires that the application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. But under clause 23 the applicant may divide the application into “divisional applications” but each divisional application is not to go beyond the disclosure made in the initial application.

Clause 24 provides the circumstances where an application may claim priority.

Under clause 25 the registrar may request information on foreign applications made by the applicant.

#### Fees

Under clause 26 prescribed fees are to be paid in respect of the application.

Under clause 28 the registrar is required to accord a filing date to the application. Under clause 29 the registrar is required to 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. "Priority date" for the purpose of claiming priority is defined by clause 2 as the date of the first application that serves as the basis for claiming the right of priority provided for in the Paris Convention.

Clause 30 authorises the registrar to direct an international type search in respect of any application found in order as to form. The registrar may also under clause 31 by notice in the Gazette direct that applications for patents relating to a specified field or a technical field to be subject to examination as to substance.

Clause 33 – Appeals. This clause gives an applicant a right of appeal against particular decisions of the registrar.

#### **Part VI—International Applications**

25. This Part deals with international applications i.e. applications for registration of patents under the Patent Cooperation Treaty which permits a person to make an application in one country which is recognised as an application also in another cooperating country.

#### **Part VII—Rights and Obligations of the Applicant or the Owner of the Invention**

26. Clause 38 spells out the rights of a invention owner. Under it the owner of the invention has *inter alia*, the following rights—

(a) to be granted the patent;

(b) to make, use, exercise and sell the invention and preclude others from exploiting the invention without his or her authorization.

The owner of the patent may assign or transfer by succession the application for or the patent.

Under clause 38(4) the applicant or owner of the patent may conclude licence contracts as provided in Part X of the Bill and be subject to the obligations referred to in section 39.

27. Clause 39 deals with obligations of the owner of the invention. They include the following—

(a) to disclose the invention in a clear and complete manner;

(b) to pay prescribed fees;

(c) to give information covering corresponding foreign applications and grants;

(d) to work patented invention in the country within the time limit prescribed;

(e) to refrain from making undesirable provisions in his or her licence contracts.

28. Clause 40 prescribes the remedies of a patent owner whose rights have been infringed. They involve obtaining information and claiming damages and compensation from court. But the patent owner is not entitled to exercise these rights unless the infringer has actual knowledge that the invention is subject to a published application received written notice that the invention he or she is using was subject to a matter of a published application and the application is identified in that notice by its serial number.

29. Clause 41 – Under this clause a patent is not effective as against a person who claims as a prior user. Clause 42 defines the scope of the patent protection. Clause 43 deals with limitation of rights. For example according to clause 43 the rights under the patent extend only to acts done for industrial or commercial purposes but do not extend to acts done for scientific research.

30. Clause 44 lists certain circumstances which are exempted from the requirement that the patent may not be used by others without the authority of the patent owner e.g. making use of patent invention for teaching purposes.

31. Clause 45 provides that a patent in respect of which Uganda is a designated state granted by ARIPO by virtue of the ARIPO Protocol has the same effect in Uganda as a patent granted under the Act except where the registrar communicates to ARIPO in respect of the application of the patent 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**

32. According to clause 46 a patent shall expire at the end of 20 years from the filing date of application. Annual fees are to be paid to keep, maintain the application or the patent.

#### **Part IX—Change in the Ownership and Joint Ownership of Application and Patent**

33. Clause 48 – According to this clause a contract assigning a patent or application for a patent shall be in writing signed by the party making the assignment. A prescribed fee is to be paid in respect of the change.

Clause 49 states what joint owners of a patent or application may do

#### **Part X of the Bill—Contractual Licences**

34. Clause 50 states the rights of licencees from owners of patents.

Clause 51 – Under this clause unless otherwise provided in a licence contract the Minister may any grant permission to any person to do or may himself or herself do of the acts which constitute exercise of the rights of ownership.

Clause 52 prescribes the effect of a patent not being granted or revoked or being invalidated. In any such circumstances the court may make an order it considers appropriate for the payment of the royalties or the retention of any consideration paid or given relating to the application or patent.

Clause 54 – A licence contract is required to be submitted to the registrar for registration. The application is by petition.

Clause 55 prescribes certain terms which are not allowed to be put in a licence contract as being unjustified restrictions on the licence with the consequence that the contract taken as a whole is harmful to a economic interests of Uganda.

Clause 56 provides for the registration of contracts and issue of a certificate of registration to the petitioner. Clause 57 provides for appeals by petitioner against the decision of the registrar. The grounds are limited to the grounds specified in clause 57(2).

Clause 58 provides for the compulsory licensing to exploit a patented invention on grounds that the market for the patented invention is not being supplied or is not being supplied on reasonable terms in Uganda.

The following provisions of Part X deals with the following—

Clause 59 - Compulsory licences based on interdependence of patents.

Clause 60 - Preconditions for grant of compulsory licences.

Clause 61 - Grant and terms of compulsory licence.

Clause 62 – Transfer of compulsory licence, Clause 63 deals with cancellation of compulsory licence and Clause 64-deals with registration of grant cancellation or variation of compulsory licence.

Clause 65 – Licence as of right. Under this clause an owner of a patent may request the registrar to make an entry in the register to the effect that a licence under the patent is to be available as of right.

**Part XI of the Bill—Exploitation of Patented Inventions by the Government or by Third Persons Authorised by Government.**

35. This Part deals with circumstances in which the Minister may order the exploitation of an invention by Government or an agency of government in the public interest subject to the payment of adequate compensation.

Clause 67 deals with transfer of patent in connection with illegally accessed genetic resources. The Minister is entitled to claim proprietary interest in any patent filed or granted to which the clause applies.

**Part XII—Utility Models**

36. This Part applies certain provisions of the Act to utility models certificate. It also provides for the issue of utility model certificates.

Clause 70 contains provisions for the conversion of patent applications to applications for utility model certificates.

**Part XIII—Industrial Designs**

37. Part XIII deals with rights in industrial designs including registration of industrial designs. Clause 71 defines an “industrial design” to mean that aspect of a useful article which is ornamental or aesthetic that may consist of three dimensional features like a shape, or surface of an asset or a three dimensional feature such as patterns, lines or colours.

Under clause 75 the duration of registration of an industrial design shall be up to the end of the fifth year following the date of registration

**Part XIV—Technovations**

38. This Part deals with technovations. Clause 81 defines a technovation as follows—

“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 proposal, has not been used or actively considered for use by that enterprise”.

This Part (clause 86) enables a technovator (employee) to be issued a technovation certificate by an enterprise. This would entitle the technovator to payment of remuneration for use by an enterprise of the technovation.

Clause 88 deals with settlement of disputes under that Part XIV.

**Part XV—Surrender, Revocation and Invalidation**

39. Clause 89(1) provides that a patent, utility model or industrial design registration certificate may be surrendered by its owner to the registrar.

Clause 89(2) provides that 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.

According to clause 89(4) the surrender shall be effective only after it has been published.

Clause 90 also provides for application by an interested party to the court to revoke or invalidate a patent, utility model or industrial design registration.

According to clause 91 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 from the date of the grant of the patent or certificate or registration for the utility model or the industrial design to have ceased to have effect.

#### Part XVI—Infringement

40. This Part deals with infringement of rights under the Act and the manner of challenging and relief to be granted in respect of infringement including criminal proceedings.

Clause 99 enables a rights owner whose rights are being infringed to get the customs authorities to suspend from circulation any particular goods affected by the infringement.

#### Part XVII—Special Provisions on Enforcement of Patent Rights

41. This Part (clause 102) deals with special provisions that facilitate the enforcement of patent rights. It empowers the court on the request of the owner of the patent or of an exclusive licensee or of compulsory licensee or of a non exclusive licensee to grant an injunction to prevent infringement or an imminent infringement and the court may even award damages in appropriate circumstances.

#### Part XVIII—Miscellaneous Provisions

42. This Part deals with miscellaneous matters such as public notices, regulations and the power of the Minister to amend the Schedule. It also seeks to repeal the existing Patents Act, Cap.216 and the existing United Kingdom Designs Protection Act, Cap.218.

Clause 110 provides detailed transitional and savings provisions.

HON. FREDRICK RUHINDI, MP  
Deputy Attorney General and  
Minister of Justice and Constitutional Affairs.

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SCHEDULE

Currency point.

A Bill for an Act

ENTITLED

**THE INDUSTRIAL PROPERTY ACT, 2009.**

**An Act to provide for the promotion of inventive and innovative activities, to facilitate the acquisition of technology through the grant and regulation of patents, utility models, industrial designs and technovations and to provide for the designation of a registrar, to provide for the functions of the registrar, and the establishment of a register of industrial property rights and for related matters.**

BE IT ENACTED by Parliament as follows:

PART I—PRELIMINARY

**1. Commencement.**

This Act shall come into force on a date that the Minister may, by statutory instrument appoint; and the Minister may appoint different dates for different provisions.

**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) registration of an industrial design; or
- (iv) a certificate of technovation;

“ARIPO” means the African Regional Intellectual Property Organisation;

“ARIPO Office” means the Secretariat managing the African Regional Intellectual 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;

“Bureau” means the Uganda Registration Services Bureau established by the Uganda Registration Services Bureau Act;

“compulsory licence” means an authorization given by the competent authority to a person, firm or a private or state-owned or state-controlled entity, to exploit a patent, a utility model, a layout-design or an industrial design in Uganda without the approval of the rights owner;

“concerned Minister” means the Minister to whose ministry the information in an application relates;

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

“cross-licence” means a licence to enable a person to use his or her own patent together with an earlier patent without which his or her own patent cannot be worked without infringing rights derived from the earlier patent;

“currency point” has the meaning given to it in the Schedule;

“designated office” means an office designated under section 34;

“divisional application” has the meaning given to it by section 23;

“elected office” means an office designated under section 34;

“examiner” means an examiner of patents designated as examiner of patents under the Uganda Registration Services Bureau Act;

“exclusive licence” means a licence contract that confers on the licensee and, where it is established expressly in it, on the persons authorised by the licensee, the right to exploit the licensed industrial property right to the exclusion of all other persons, including the rights owner;

“foreign application” has the meaning given to it by section 25;

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

“industrial design” has the meaning given to it in section 71;

“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 taken as deserving specified intellectual property rights;

“international bureau” means the International Bureau of the World Intellectual Property Organisation;

“international classification” means the classification of patent for invention, inventors certificates, utility models and utility certificates known as the international patent classification” as established by the Strasbourg Agreement concerning the international patent classification of March 24th, 1971 as amended on September 28, 1979;

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

“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 a new and useful improvement of it which is not obvious, capable of being used or applied in trade or industry; and includes an alleged invention;

“inventor” means the person who actually devises the invention as defined in section 8; and includes the legal representative of the inventor;

“licence contract” means a contract or an 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 person licensed under a contract which is registered or taken to be registered under this Act;

“licensor” means a party to a licence contract who grants the permission under a contract registered or taken to be registered under this Act;

“Minister” means the Minister responsible for justice;

“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 revised;

“patent” means the title granted to protect an invention;

“Patent Cooperation Treaty” means the Patent Cooperation Treaty signed on June, 1970 the Regulations made made under the administrative instructions under that Treaty as revised, amended and modified;

“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;

“priority user” has the meaning given to it in section 41;

“receiving office” means an office designated under section 34;

“register” means the register of industrial property rights under section 5;

“registrar” means the officer designated as registrar of industrial property under the Uganda Registration Services Bureau Act and includes the deputies and assistants of that officer;

“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;

“surcharge” means a fee prescribed under this Act in respect of delayed payment;

“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 it 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 previously available in Uganda; and includes microorganisms or other self-replicable material, products of genetic resources and herbal as well as nutritional formulations which give new effects;

“World Trade Organisation” means the World Trade organisation, established in 1995 by the Uruguay Round of multilateral trade negotiations under the auspices of GATT (General Agreement on Tariffs and Trade, based on a 1947 agreement).

### 3. Registrar.

(1) For the avoidance of doubt the person to be the registrar for the purposes of registration of industrial property shall be an officer designated as such under Part V of the Uganda Registration Services Bureau Act.

(2) The registrar shall have a seal of a device approved by the Minister, but until the seal has been obtained a stamp in a form Minister may approved by the Minister shall be issued instead of the seal.

(3) The mpression of the seal or stamp shall be judicially noticed and admitted in evidence.

(4) Any act or thing directed to be done by or to the registrar may be done by or to any officer authorized by the Minister.

### 4. Functions of the registrar.

(1) The functions of the registrar are—

- (a) to receive, consider and grant applications for industrial property rights;
- (b) to receive, and register technology transfer agreements and licences;
- (c) to 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) to promote inventiveness and innovativeness in Uganda; and
- (e) to perform any other functions for the better carrying out of this Act.

(2) In the carrying out of his or her functions, the registrar shall liaise with relevant institutions.

**5. Register of industrial property.**

(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 to any regulations made under this section, obtain extracts from them.

(3) The form of the registers shall be as prescribed by regulations.

(4) The register of patents shall be *prima facie* evidence of any matter required or authorised by or under this Act to be entered in the registers.

**6. Protection from personal liability.**

No matter or thing done by any member, officer, employee or agent of the registrar shall, if the matter or thing is done bona fide for executing the functions of his or her 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.

**7. Liability of the registrar for damages.**

Section 6 shall not relieve the registrar of the liability to pay compensation or damages to any person for injury to him or her, his or her property or any of his or her interests caused by the performance of the functions conferred on the registry by this Act or by any other written law or by the failure, whether wholly or partially, of any works.

## PART III—PATENTABILITY.

**8. 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 1st January 2016.

**9. Patentable invention.**

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

**10. 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 where the disclosure occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect of the application.

(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 within 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.

### 11. 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 relates on the date of the filing of the application or, if priority is claimed on the date validly claimed in respect of the invention.

### 12. 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.

### 13. Non-patentable inventions.

The following are not 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.

### 14. Information prejudicial to security 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 concerned Minister as being information the publication of which might be prejudicial to the security 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) Where it appears to the registrar that any application filed as described in subsection (1) contains information the publication of which might be prejudicial to the interest of the public, the registrar may give directions 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 29.

(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 to it shall not be communicated and no patent shall be granted in response to 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.

(4) Where the registrar gives instructions under this section in respect of an application, the registrar shall give notice of the application and of the directions to the concerned Minister and the following provisions shall have effect—

- (a) 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) where 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, and the registrar shall continue his or her directions under subsection (2) until they are revoked under paragraph (e);
- (c) where 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) where on the consideration of an application at any time it appears to 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 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 conditions that the registrar may consider 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 concerned Minister may, in determining a question under subsection (4)(c)—

- (a) at any time after, or, with the consent of the applicant, before the expiry of the period prescribed for the purposes of section 29, consider the application and any documents submitted in relation to the application; or
- (b) where the application contains information relating to the production or use of atomic energy or research into matters connected with the production or use, of atomic energy, authorise the National Council for Science and Technology to study the application and any documents sent to the registrar in connection with the application 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 to the application expires, and while the directions are still in force, an application is brought for the grant of a patent—

- (a) if while the directions are in force, the invention is used by or with the written authorisation of or on the orders of a Government Ministry, department or agency, section 66 shall apply as if—
  - (i) the use was made under 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 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) Where 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 response to 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 a direction under this section commits an offence and is on conviction, liable to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

#### 15. Restriction on applications abroad by residents of Uganda.

(1) Subject to this section, a person resident in Uganda shall not without written authority granted by the registrar, file or cause to be filed outside Uganda, an application for a patent, 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) no directions have been given under section 14 in relation to the application in Uganda or any such directions given have been revoked.

(2) Subsection (1) does 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 commits an offence and is liable on conviction, to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

(4) In this section—

(a) a reference to an application for a patent includes a reference to an application for other protection for an invention; and

(b) a 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.

#### 16. Patents relating to micro-biological processes or products.

(1) Where an invention concerns a micro-biological process or the product of that process 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 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 subsection (1)(b) may be submitted within 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) Where 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 taken to have occurred if a new deposit of the micro-organism originally deposited is made within three months from the date on which the person who deposited it is 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 registry 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 person making the deposit indicating that the newly deposited micro-organism is the same as that originally deposited.

(6) In this section “depository institution” means a place where biological organisms are stored.

#### PART IV—RIGHT TO INVENTIONS AND NAMING OF INVENTOR.

##### 17. Right to a patent.

(1) Subject to this section, the right to a patent belongs to the inventor.

(2) Where two or more persons have jointly made an invention the right to the patent belongs to them jointly.

(3) Where 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, has the right to the patent.

(4) The right to a patent may be assigned or may be transferred by succession.

(5) Sections 51 to 65 apply, with the necessary modifications, to contracts assigning the right to a patent.

##### 18. Unauthorised application based on an invention of another person.

Where an 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, assign to that person the application or, where the patent has already been granted, the patent.

##### 19. Inventions made in execution of commission or by employee.

(1) Notwithstanding section 18 and in the absence of a contract to the contrary, the right to a patent for an invention made in execution of a commission or of a contract of employment, belongs to the person having commissioned the work or to the employer.

(2) Where the invention referred to in subsection (1) is of exceptional importance the employee has a right to equitable remuneration taking into consideration his or her salary and the benefit derived by the employer from the invention.

(3) Subsection (1) applies where a contract of employment 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.

(4) In the circumstances referred to in subsection (3), the employee has 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.

(5) In the absence of an agreement between the parties, the court shall fix the remuneration.

(6) An invention made without any relation to an employment or contract of service and without the use of the employer's resources, data, means, materials, installations or equipment belongs solely to the employee or the person commissioned.

(7) This section, where relevant, applies directly or indirectly to government department or an agency of government or a similar organisation.

## 20. Naming of inventor.

(1) The inventor shall be named as inventor 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.

(2) A promise or an undertaking by the inventor made to any person to the effect that he or she will make the declaration referred to in subsection (1) has no legal effect.

(3) Where 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 shall have the right to the certificate, as long as the application is not withdrawn, abandoned or rejected.

(4) In order to establish the right of preference the registrar shall take into account the matter claimed in the applications.

(5) Where an invention is made in execution of an employment contract the purpose of which is to invent, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer.

(6) Where the economic gains extracted by the employer are disproportionately high as compared to the employee's salary and the reasonable expectations of gain that the employer had from his or her employee's inventive output at the time he or she hired him or her, the employee is entitled to an equitable remuneration.

(7) Where an invention is made by an employee not in execution of an employment contract, and where for making that invention the employee used materials, data know-how of the employer, the right to the patent shall belong, in the absence of contractual provisions to the contrary, to the employer.

(8) The employee is entitled to a remuneration that is at least equivalent to one third of the net direct and indirect gains obtained by the employer from exploiting the invention.

(9) Where the employer neglects to file a patent application within one year from the date on which the employee communicates to him or her the invention, the employee shall have the right to the patent, including the right to assign that right to an interested party and to license or transfer the patent, if granted.

(10) An invention claimed in a patent application filed by the employee within one year after the expiry of the employment contract which falls within the scope of the former employer's main business, shall be presumed to have been made under the expired contract, unless the employer produces evidence to the contrary.

(11) An anticipated promise or undertaking which is made by the inventor to his or her employer to the effect that he or she will waive any remuneration he or she is entitled to under this section shall be without legal effect.

(12) The inventor shall be named as such in the patent, unless in a special written declaration signed by him or her and addressed to the registrar he or she indicates that he or she wishes not to be named.

(13) A promise or an undertaking by the inventor made to a person to the effect that he or she will make such a declaration under subsection (12) has no legal effect.

(14) This section shall apply to all employees whether or not they are employed in the public service.

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

**21. 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 of the invention;
- (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 of Uganda.

(2) Where the applicant's ordinary residence or principal place of business is outside Uganda, the applicant shall be represented by an advocate of the High Court of Uganda.

(3) The request shall state the name 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—

- (a) disclose the invention and at least one mode of carrying out the invention, in full, clear, concise and exact terms as to enable a person who has ordinary skills in the art to make use of and to evaluate the invention; and
- (b) 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) Disclosure of the claimed invention shall be considered sufficiently clear and complete if it provides information which is sufficient to allow that invention to be made and used by a person skilled in the art on the filing date, without undue experimentation.

(7) For the purposes of assessing sufficiency of disclosure, the disclosure contained in the description, claims and drawings, as established on the date in which the sufficiency of disclosure was examined, shall be taken into account.

(8) The description shall contain a clear identification of the origin of genetic or biological resources collected in the territory of Uganda and that were directly or indirectly used in the making of the claimed invention as well as of any element of traditional knowledge associated or not with those resources and that was directly or indirectly used in the making of the claimed invention without the prior informed consent of its individual or collective creators.

(9) For the purposes of this section, a person shall be taken as having ordinary skill in the art if that person is a citizen of Uganda who has studied and carries out his or her profession in Uganda, and has acquired an average expertise and experience in the technical field of the claimed invention.

(10) The registrar may, before granting the patent, require the description in a foreign patent application to be adapted to the ordinary skill in the art of the citizens of Uganda so as to ensure technology dissemination.

(11) The abstract, which must be concise and precise, shall only serve the purpose of technical information; and shall not be taken into account when interpreting the scope of the protection.

(12) The abstract shall only serve the purpose of providing technical information; and it shall not be taken into account when interpreting the scope of the protection sought.

(13) The applicant may, at any time before the grant of the patent, withdraw the application.

(14) Where the application has been withdrawn without having been opened to public inspection, and—

(a) no priority rights have been claimed by virtue of that application; and

(b) no rights are outstanding in Uganda in connection with the application,

a subsequent application may be filed in Uganda in respect of the same invention.

(15) The subsequent application shall be regarded as the first application in Uganda in respect of that invention.

(16) Priority rights shall not be claimed on the withdrawn application after the lodging of the subsequent application.

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

## 22. 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.

## 23. Amendment and division of application.

(1) The applicant may amend the application, but 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, in this Act referred to in this Act as “divisional applications” but each divisional application shall not go beyond the disclosure made in the initial application.

(3) Each divisional application is entitled to a filing date and where appropriate, the priority date of the initial application.

## 24. 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 or regional applications filed by the applicant or his or her predecessor in title in or for any State party to that Convention and any Member of the World Trade Organization.

(2) Where the application is filed in Uganda before the expiration of the periods referred to in subsection (1), the application shall not be invalidated by reason of an act accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, and those acts shall not give rise to any third-party right or any right of personal possession.

(3) The period of priority under subsection (1) is twelve months and shall be counted according to the provisions of article 4 of the Paris Convention.

(4) Where the application contains a declaration under subsection (1), the registrar may request that the applicant furnish, within the prescribed time, a copy of the earlier application certified as correct by the Industrial Property Office with which it was filed.

(5) The registrar shall accept the form and the content of the certification mentioned in subsection (4) as determined by the certifying authority.

(6) Where the registrar finds that the requirements under this section and the regulations relating to those requirements have not been complied with, the declaration shall be considered not to have been made.

## 25. 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 for 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 within sixty days—

- (a) copies of any communication received by the applicant concerning the results of a search or examination carried out in respect of the foreign application;
- (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 to 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 only 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 has the right to submit comments on the documents furnished under this section.

(7) The details of the requirements under this section shall be as prescribed by regulations

## 26. Payment of fees.

(1) The application shall be subject to payment of the prescribed fees.

(2) The registrar may waive the whole or part of the fees in such manner and under such circumstances as may be prescribed.

## 27. 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 paid by him or her.

## 28. Filing date and examination of application as to form.

(1) The registrar shall accord as the filing date the date of receipt of the application, if, at the time of receipt, the application contains—

- (a) an express or implicit indication that the granting of a patent is sought;
- (b) indications allowing the identity of the applicant to be established;

- (c) a part which, on the face of it, appears to be a description of an invention; and
- (d) one or more claims identifying the characteristic elements of the invention.

(2) Where the registrar finds that the application does not, at the time of receipt, fulfill the requirements referred to in subsection (1), he or she shall invite the applicant to file the required correction and shall accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

(3) Where the application refers to drawings which are not included in the application, the registrar shall invite the applicant to furnish the missing drawings.

(4) If the applicant complies with the invitation under subsection (3), the registrar shall accord as the filing date the date of receipt of the missing drawings.

(5) The registrar shall accord as the filing date the date of receipt of the application and shall treat any reference to the drawings as non-existent.

(6) After allocating a filing date, and having the invention classified according to the international classification, the registrar shall examine whether the application complies with the requirements of sections 21 (1) and (2), and the other requirements of this Act and regulations made under it and whether information requested under section 25, has been provided.

(7) Within ninety days after the publication of the notice mentioned in section 29, any interested party may file with the registrar a notice of opposition.

(8) The notice of opposition shall identify the opposed patent application, as well as the grounds that the opponent considers relevant to bar the grant as well as all relevant evidence.

(9) The failure to meet the formal or substantive conditions of patentability in sections 9, 13 and 21 may be alleged by the opponent.

(10) The registrar shall give notice of the opposition in the *Gazette*.

(11) The applicant may within sixty days from the publication of the notice of opposition file a counter-statement.

(12) The registrar may, if he or she considers fit, grant a hearing at which the patent applicant and the opponent may argue and counter-argue their case and submit additional evidence, if available, including oral evidence.

(13) Subsection (1) shall apply to the inventions mentioned in section 8(2)(f) immediately after the coming into force of this Act.

(14) The remaining subsections of this section as well as section 32 shall apply to the inventions mentioned in subsection (13) only after January 1, 2016; and the examination of those inventions shall apply the conditions of patentability referred to in subsection (4) as if those conditions were being applied on the date of filing in Uganda, as established under subsection (1), or where priority was claimed, the priority date of the applications.

## 29. 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 period 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 date.

(3) The publication of the patent application shall be effected by publishing the particulars set out in the regulations, in the *Gazette* and a newspaper of wide circulation.

**30. International type search.**

(1) The registrar may direct that an application which is 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 request the applicant to pay the prescribed fee; and if the applicant does not comply with the request, the application shall be rejected.

(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 registrar shall reject the application.

(4) Where 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) Where 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 claim 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;
- (b) the application does not comply, in whole or in part, with the requirements of unity of invention prescribed by section 22 and the rules pertaining to it; 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 regulations.

**31. Examination as to substance.**

(1) The registrar may, by notice in the *Gazette*—

- (a) direct that an application for a patent which relates to a specified field or specified technical fields shall be subject to an examination as to substance; or
- (b) amend any direction issued under paragraph (a).

(2) Where an application for a patent satisfies the requirements specified in section 28(1) and the subject matter of the application does not fall within a technical field specified under subsection (1), the registrar shall notify the applicant and the applicant shall, within three years from the filing date of the application, submit a request in the prescribed form for the examination of the application under subsection (4).

(3) Where no request is made under subsection (2) within the prescribed period, the application shall be taken to be abandoned.

(4) 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 section 22(5) and (6).

(5) For the purposes of the examination under subsection (4), 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 examinations to the registrar and the registrar shall submit a copy of it to the applicant.

(6) Except where an application is subject to an international-type search under section 30, 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 22 and the rules pertaining to it.

(7) Where the registrar is of the opinion that the requirements of unity of invention have not been complied with, the registrar shall request the applicant to restrict or divide the application.

(8) Where, taking due account of the conclusions of a report referred to in subsection (6), 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 request him or her to submit his or her observations and, where applicable, to amend his or her application.

(9) Where, in spite of 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 to grant a patent and notify the applicant accordingly.

(10) The details of the requirements and the procedure to be followed under this section shall be prescribed by regulations.

### **32. Grant, registration and publication of a patent.**

(1) Unless an application has been rejected or a patent has been refused under section 31, a patent shall be granted and issued to the applicant in the prescribed form.

(2) A 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 31.

(4) The registrar shall, upon the request of the owner of the patent, make any change in the text of 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.

### **33. Appeals under Part V.**

An applicant who is aggrieved by a decision of the registrar may appeal within two months to the court against a decision by which the registrar—

- (a) records a filing date;
- (b) rejects the application;
- (c) treats the application as if it had not been filed;
- (d) considers any of the claims to be withdrawn; or
- (e) refuses to grant a patent.

### **PART VI—INTERNATIONAL APPLICATIONS.**

#### **34. Further functions of the registry.**

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

(2) The registry 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 registry under this Part shall be performed in accordance with the Patent Cooperation Treaty, the regulations made under it and the administrative instructions issued under the regulations of the Patent Cooperation Treaty and with the provisions of this Act and the regulations made under the Act relating to them.

(4) In case of conflict, the provisions of the Patent Cooperation Treaty, the regulations and the administrative instructions issued under it shall apply.



**35. Unsearched or unexamined international applications.**

(1) Where an international search report is not established or relates to only one or some of the claims of an international application, the registrar shall reject the international application or consider withdrawn the claim or claims which are 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 which relates to 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 23(2) the parts concerned or satisfies the registrar that the request to pay the additional fees was not justified.

(3) Where an international preliminary examination report with respect to an international application has been communicated to the registrar, the following provisions 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 preliminary examination shall be considered withdrawn unless the applicant divides the application into disual appplication in accordance with as provided for in section 23(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 the invention which is 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.

**36. 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 international publication is effected in English.

(2) If the international publication is effected in a language other than English, subsection (1) shall apply where the applicant has 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 the transaction.

**37. 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 under section 29.

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

**38. Rights of the owner.**

- (1) The applicant or the owner of an invention has the right—
- (a) on fulfilling 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 authorization by any of the following acts—

- (i) where 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) where the patent has been granted in respect of a process or doing any of the acts referred to in paragraph (a) in respect of a product obtained by means of that process;

(c) where the patent has been granted in respect of a new use, of putting the patented product or process into a new use without the prior authorisation of the owner of the patent.

(2) After the grant of the patent, and within the terms of this section, the owner of the patent has the right to preclude any person from exploiting the patented invention in the manner referred to in subsection (1).

(3) The owner of a patent may assign or transfer by succession the application for patent or the patent.

(4) The applicant or the owner of a patent may conclude licence contracts as provided for in Part X of this Act and be subject to the obligations referred to in section 39.

### 39. Obligations of the owner.

The applicant or the owner of an 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 under this Act;
- (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 55.

### 40. Remedies.

(1) The owner of a patent has the right—

- (a) to obtain an injunction to restrain the performance or the likely performance, by any person without his or her authorization, of any of the acts referred to in section 39;
- (b) to claim damages from any person who, having knowledge of the patent, performs any of the acts referred to in section 38, without the owner's authorization;
- (c) to claim compensation from any person who, without his or her authorisation, performs any of the inventions claimed in the published application, as if a patent had been granted for that invention.

(2) The right under subsection (1) is only exercisable where the person referred to in that subsection has at the time of the performance of the act—

- (a) actual knowledge that the invention that he or she is using is the subject matter of a published application; or
- (b) received written notice that the invention that he or she is using is the subject matter of a published application, and the application is identified in that notice by its serial number.

**41. Right of a prior user.**

(1) Notwithstanding section 38, a patent has no effect against any person, in this Act 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, is using the invention or is making effective and serious preparations for that use.

(2) A person referred to in subsection (1) has the right, for the purposes of his or her enterprise or business, to continue the use or to use the invention as envisaged in the preparations referred to subsection (1).

(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 is or are made.

**42. Scope of protection.**

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

**43. Limitation of rights.**

(1) The rights under the patent extend only to acts which are done for industrial or commercial purposes but do not extend to acts which are done for scientific research.

(2) The rights under the patent do 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 consent.

(3) The rights under the patent do 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 a 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, is using the invention or is making effective and serious preparations for use, to the extent that those acts do not differ in nature or purpose from the actual or envisaged prior use.

(5) 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.

(6) The rights under the patent shall be limited by the terms of the patent.

(7) 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.

(8) The rights of the patent do 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 those mutants or variants are deserving of separate patents.

**44. Exception to exclusive rights.**

It is not an infringement of a patent to use the patented invention without the authorization 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 another country which regulates the manufacture, construction, use or 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 another country a patented healthcare invention where the export of the invention addresses a health need identified by the other country, where—
  - (i) the product is either not patented in the third country; or
  - (ii) the government of another country has authorised use of the patent without the consent of the patent owner and the production for export of the invention is intended only for the market of the third country.

#### 45. ARIPO Protocol on patents.

A patent, in respect of which Uganda is a designated state, granted by ARIPO by virtue of the ARIPO Protocol has the same effect in Uganda as a patent granted under this Act except where the registrar communicates to ARIPO, in respect of the application of the patent, 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.

#### 46. Term of patent.

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

#### 47. 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 registrar.

(2) The fee shall be due at the end of the day immediately before each anniversary of the date of filing of the application.

(3) A grace period of six months shall be granted for the payment of the annual fee upon payment of the prescribed surcharge.

(4) If an annual fee is not paid in accordance with this section, the application shall be taken to have been withdrawn or the patent shall lapse and the relevant invention shall cease to be protected.

(5) The registrar shall immediately publish the lapse of any patent under subsection (4).

(6) Within six months from the expiration of the grace period referred to in subsection (3), an interested person may, upon payment of the prescribed fee, request the registrar to restore the application that is taken to have been withdrawn, or a patent that has lapsed, by virtue of subsection (4).

(7) Upon a request under subsection (6), the registrar shall, if satisfied that the failure to pay the annual fee is not intended, subject to the payment of the annual fee, make an order restoring the application or the patent as the case may be.

(8) Where a patent is restored, no proceedings shall be brought in respect of the patent—

- (a) in relation to any acts performed after the lapse of the patent and before the date of the order for restoration; or
- (b) in relation 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 APPLICATION AND PATENT.

#### 48. Change in ownership of application.

(1) A contract assigning a patent or application for a patent shall be in writing and shall be signed by the party making the assignment.

(2) A change in the ownership of a patent or an application for a patent shall, upon payment of the prescribed fee, be recorded in the patent register;

(3) Until the change has been recorded, a document evidencing the change in ownership shall not be admitted in any proceedings as evidence of the title of a person to an application or a patent, unless the court otherwise directs.

#### 49. Joint ownership of application and patent.

(1) 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;

(2) The joint owners may only jointly grant permission to any third person to do any of the acts referred to in section 38.

#### PART X—CONTRACTUAL LICENCES.

#### 50. Rights of licensee.

(1) In the absence of any provision to the contrary in a licence contract, the licensee is entitled to do any of the acts referred to in section 38 in respect of the invention, without limitation as to time, in Uganda and in any field of use of the invention, utility model or industrial design.

(2) Subject to subsection (1) the licensee may not grant permission to a third person to do any of the acts referred to in section 38.

#### 51. 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 person to do, or may himself or herself do, any of the acts, which constitute exercising the rights of ownership.

(2) Where the licence contract provides that the permission granted by the licence contract is exclusive, the licensor may neither grant permission to a third person to do any of the acts referred to in section 38 and covered by the licence contract, nor himself or herself do any of those acts, and the licensee shall be considered an exclusive licensee for the purposes of this Act.

#### 52. Effect 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 licence contract—

- (a) the application is withdrawn;
- (b) the application is rejected; or
- (c) that patent is revoked or declared invalid,

the court may on the application of the aggrieved party, make any order it considers reasonable under the circumstances for the repayment of the royalties or the return of any consideration paid or given under the licence contract and directly relating to the application or patent.

#### 53. Form of licence contracts.

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

#### 54. Petition for registration.

(1) All licence contracts, including modifications of them, shall be submitted to the registrar 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 the documents and the prescribed fees.

(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.

(4) Where 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.

(5) Where—

- (a) section 52 or subsections (2) to (4) and the rules relating to the licence contract, have not been complied with; or
- (b) the licence contract cannot be registered under section 55, the Registrar shall refuse to register the licence contract and shall state the reasons for the refusal.

(6) 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 have a defect precluding registration, within forty-five days from the date of the notification.

(7) A licence contract is void if the registration is refused by the registrar in accordance with this Act.

#### 55. Prohibited terms in a licence contract.

(1) The registrar may refuse to register a licence contract if the registrar is of the opinion that any clause in the 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.

(2) Without prejudice to subsection (1) the following terms in a licence contract shall be taken to have the effect described in that subsection to—

- (a) require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the licence contract relates;
- (b) require the licensee to acquire any materials from the licensor 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;
- (c) 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) 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) require the licensee to sell products produced by him or her under the contract exclusively or principally to persons designated by the licensor;
- (f) limit the volume of the products produced by the licensee with the help of the technology to which the licence contract relates;
- (g) oblige the licensee to employ persons designated by the licensor and not needed for the efficient transfer of the technology to which the contract relates except that where the contract provides for the employment of persons who are needed for the transfer of technology to which the contract relates, the contract shall provide for the training of persons to replace them within a reasonable period;

- (h) 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) 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) extend the coverage of the contract to technology not required for the use of the technology which is the main subject of the licence contract and to require consideration for that additional technology;
- (k) fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the licence contract relates;
- (l) prohibit or restrict the use by the licensee, after the expiration of the contract, of the technology acquired as a result of the licence contract, subject, to any right of the licensor under the patent;
- (m) establish the duration of the licence contract for a period which is unreasonably long in relation to the economic function of the licence contract; except 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) restrict the licensee from entering into sales, representation or manufacturing agreements relating to similar or competing technologies, when those restrictions are not needed for protecting the legitimate interests of the licensor; including, in particular, protecting the licensor's individual 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) prevent the licensee from adapting the technology to local conditions or introducing innovations in it or changing 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 marks or trade names, and except to the extent that the 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) impose acceptance of additional technology, future inventions and improvements, and goods or services not required by the licensee;
- (q) impose restrictions on territories, quantities, prices, customers or markets arising out of patent pool or cross-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 adverse effects on the licensee, except for those restrictions appropriate and ancillary to cooperative arrangements such as co-operative research arrangements;
- (r) impose restrictions which regulate advertising or publicity by the licensee except where restriction of the 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 marks, trade names or other identifying items;
- (s) 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) impose requirements for payments even under conditions of *force majeure*;
- (u) 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) impose quality control methods or standards not needed by the licensee, except to meet the requirement of a guarantee or when the product bears a trade mark, or trade name of the licensor;
- (w) allow the licensor to participate permanently in the management of the licensee's business as a condition for obtaining the technology;
- (x) restrict the licensee from taking measures that will enhance Ugandan technological capacity and which are not prejudicial to the licensor's industrial property rights;
- (y) restrict the use of Ugandan expertise in management and consultancy or in any other positions;
- (z) require payment of royalty for patents granted outside Uganda;
  - (aa) apply different conditions to similar transactions with other trading parties, and that placing the licensee at a competitive disadvantage; and
  - (ab) make the licence contract subject to acceptance of supplementary obligations which, by their nature or according to commercial usage, have no connection with the subject of the contracts.

**56. 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) Where the registrar fails to notify the petitioner—

- (a) of a defect in the petition or of terms or defects precluding registration of the licence contract within ninety days after the date of the petition; or
- (b) of his or her decision to refuse to register the licence contract within ninety days after the date of notification referred to in paragraph (a),

the licence contract shall be presumed 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 date of conclusion of the contract, on the date of the conclusion of the licence contract, and
- (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 54(6), the petition shall be taken to have been received on the date when the correction or amendment is made.

(5) The registration and 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 licence contract shall be confidential unless both parties to the licence contract agree to permit access to it by third parties and the access shall only be to the extent of the permission granted.

### 57. Appeal.

(1) A petitioner who is aggrieved by a decision of the registrar to register a licence contract may appeal against the decision of the registrar to the court within two months after the registrar's refusal to register the licence contract.

(2) The grounds of an appeal under this section shall be limited to the following—

- (a) that the decision of refusal contains no statement of the reasons for the refusal;
- (b) that none of the reasons specified in the decision is valid under this Act or that the 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.

### 58. Compulsory licences for non-working and similar reasons.

(1) After the expiration of four years from the filing date of an application or three years from the grant of a patent, whichever last expires, a 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.

### 59. 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 later patent may request the court 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 is entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent.

(3) The use authorized 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.

### 60. 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 requested the owner of the patent for a contract licence but has been unable to obtain the licence contract 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; except that the registrar shall notify the owner of the patent as soon as reasonably possible of the waiver.

**61. Grant and terms of compulsory licences.**

(1) When 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 after taking into account any terms agreed by the parties, proceed to fix the terms which shall be taken to constitute a valid contract between the parties and shall be governed by the provisions on contractual licences.

(2) When 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 authorized, 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 having regard to all the circumstances of the case, including the economic and social value of the licence.

(3) A representative of the registrar 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.

**62. 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 the transfer shall not be valid until the consent of the court is obtained.

**63. Cancellation of compulsory licence.**

(1) On the application of an interested party, the court may cancel a compulsory licence if—

- (a) the licensee fails to comply with the terms of the licence; or
- (b) the conditions which justify the grant of the licence have ceased to exist and are unlikely to recur;

but the legitimate interests of the licensee shall be 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 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 a contractual licence on more favourable terms.

**64. Registration of grant, cancellation or variation.**

Where the court grants, cancels or varies the term 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.

**65. Licence as of right.**

(1) The owner of the patent may request the registrar to make an entry in the register to the effect that a licence under the patent is to be available as of right.

(2) The request shall be notified by the registrar to the licensee under the patent.

(3) A 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, a 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 the subject of an entry under this section, that falls 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 by the owner 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 entry under this section.

(8) Section 63(3) shall apply, with the necessary modifications, where the terms of a licence granted under subsection (5) have been fixed by the court.

PART XI—EXPLOITATION OF PATENTED INVENTIONS BY THE GOVERNMENT OR BY THIRD PARTIES AUTHORISED BY THE GOVERNMENT

**66. Exploitation of patented inventions by the Government or by third parties 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 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 registrar and the owner of the patent, order that the protected invention shall be exploited by a Government ministry, a department, an 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) An order under subsection (2) shall remain in force until it is revoked by the Minister in writing, after giving six months prior notice of his or her intention to revoke to the party named or described in the order.

(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 interested.

(4) The Minister may, notwithstanding any of the measures set out in this section, by written order authorise the utilisation of any process for the manufacture, sale or supply of any molecule or substance, by any individual, corporation, society or other enterprise named or described in the order without notice to the patent holder or any other noticeable party.

(5) An order under subsection (4) and that order shall remain in force until revoked by the Minister in writing, after giving six months prior notice of intention to revoke to the party named or described in the order.

(6) An application shall not be made under subsection (1) unless the applicant has unsuccessfully sought a licence contract from the owner of the patent.

(7) Subsection (1) shall not apply in a case of national emergency or other extreme urgency and in that case the Minister shall cause the contents of the order to be communicated to the owner of the patent as soon as practicable.

(8) An order under this section shall be subject to conditions that the Minister considers necessary.

(9) Where an order under this section is made, the Minister shall determine the amount of compensation to be paid to the owner of the patent, and the compensation shall be equitable having regard to all the circumstances of the case and in particular, the economic and social value of the patent.

(10) 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 38.

(11) The Minister may, upon the request of the owner of the patent or the Government ministry, a department, an agency or other person designated by the Minister for the purpose 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 the variation.

(12) 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 (7).

(13) The authorisation of a person in an order under this section shall not be transferable except to a business or enterprise owned or operated by that person.

(14) The exploitation of the invention under an order made under this section shall be primarily for the supply of the regional market.

(15) An order which relates 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 or her licensee is not competitive and the Minister is satisfied that the issue of the order would remedy that practice.

(16) A person who is aggrieved by a decision of the Minister under this section may appeal to the court.

#### **67. Transfer of patent in connection with illegally accessed genetic resources.**

(1) The Minister is entitled to claim proprietary interests in any patent application filed or granted that does not comply with sections 21(6) and 21(7) as regards genetic resources.

(2) The Minister shall notify the registrar to assign to the ministry, or to any agency or entity designated by the competent authority, a share in the application or in the resulting patent, which shall not be less than twenty percent of the ownership of the claimed invention.

(3) Where the non compliance with violation with sections 21(6) and 21(7) as regards genetic resources generates strong public concern and is likely to give rise to breach of morality and public order, the competent authority, if vested with the total ownership of the application or the resulting patent, may withdraw the application or abandon the patent, so that the claimed invention falls into the public domain.

(4) This section shall apply without prejudice to the application of sections 102(9) and 102(10).

#### **PART XII—UTILITY MODELS**

#### **68. Applicability of provisions relating to patents.**

(1) Subject to this section, Parts III, IV, V, VII, VIII, IX, X, XI, XV and XVI shall apply, with the necessary modifications, to utility model certificates or applications for them, as the case may be.

(2) Where the right to a patent conflicts with the right to a utility model certificate in the case referred to in section 17 (3), that provision shall apply as if the word "patent" were replaced by the words "utility model certificate".

(3) A certificate of utility model is prima facie evidence that the holder is the registered owner of a utility model with the registrar.

#### **69. 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 9, 11, 30, 31 and 46 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 is not renewable.

#### **70. Conversion of patent applications to application 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, and the utility model certificate shall be accorded the filing date of the initial application.

(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 (2) more than once.

#### **71. Definition of an industrial design.**

(1) For the purposes of this Part, "an industrial design" means that aspect of a useful article which is ornamental or aesthetic that may consist of three dimensional features like a shape or surface of an article or a three dimensional feature such as patterns, line or colours.

(2) The protection of industrial design 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.

#### **72. Right to industrial design; naming of creator.**

(1) Subject to this Act and to the provisions of any other written law, the creator of an industrial design or his or her successor in title has 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 17, 19, and 20 apply with the necessary modifications, to the rights of the creator of an industrial design.

#### **73. Registrable industrial designs.**

(1) An industrial design is registrable if it is new.

(2) An industrial design shall be taken 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 any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Section 10(3) applies, with the necessary modifications, in respect of priority dates of an industrial design.

(4) An industrial design which is contrary to public order or morality shall not be registered.

**74. Application and examination**

(1) A person who wishes to register an industrial design shall submit to the registrar—

- (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.

(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 if 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 twelve 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 if at the time of receipt of the application, the prescribed 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 of the industrial design.

(8) Sections 24, 28(2) and (3) apply, with the necessary modifications, in respect of priority dates and the filing of corrections to the application.

(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) Notwithstanding subsection (9), where a request has been made under subsection (5) 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.

(11) The registrar shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner.

(12) At the expiry of the period of deferment, the registrar shall publish the registered industrial design.

(13) 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 have been communicated to the person against whom the action is brought.

(14) Subject to subsection (8), the date of the registration shall be that of the application.

**75. Duration and renewal of registration of an industrial design.**

(1) Subject to subsection (2), 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 the prescribed renewal fee.

(3) The fee for the renewal of registration of an industrial design shall be paid within twelve months before the 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 prescribed surcharge.

#### **76. 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 person entitled to the industrial design 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 referred to 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 considers 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 extend 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.

#### **77. Graphic representations, specimens and related matters.**

(1) The application, including any drawings, photographs or other graphic representations and any specimen of the registered industrial design shall be kept by the registrar 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 registrar for 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, a person may, on payment of a prescribed fee, obtain an official copy of the application, representations or specimens from the registrar.

(4) Subsections (1), (2) and (3) 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.

#### **78. 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 registrar.

#### **79. Rights conferred by registration of industrial designs and related matters.**

(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 that 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 has, in addition to any other rights, remedies or actions available to him or her, the right to institute court proceedings against any 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 for infringement to occur.

(4) An industrial design registered by ARIPO by virtue of the ARIPO Protocol and in respect of which Uganda is a designated State has 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 of it, a decision in accordance with the ARIPO Protocol that if a registration is made by ARIPO that registration shall have no effect in Uganda.

#### 80. Transfer and assignment of industrial designs, licences.

(1) Rights subsisting in an industrial design may be transferred in whole or in part.

(2) Sections 48, 49, 50, 54 and 56 apply, with the necessary modifications, to this Part.

### PART XIV—TECHNOVATIONS

#### 81. Definitions.

For the purposes of this Part—

“date of the proposal” means the date on which an employee makes a request in accordance with section 83;

“employee” and “enterprise” mean the employee and the enterprise referred to in the definition of “technovation”, and where several enterprises are owned or operated by one person, all those enterprises shall be considered as one enterprise;

“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;

“technovation certificate” means the document issued by the enterprise in accordance with section 84;

“technovator” means an employee to whom the enterprise has issued a technovation certificate

#### 82. Right to technovation certificate.

(1) Subject to subsection (2), an employee of the enterprise on the date of the proposal is entitled to a technovation certificate provided for in this Part.

(2) Where the duties of an employee comprise the making and proposing of technovations, he or she is not entitled to a technovation certificate for any technovation which relates 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 those duties.



(3) Where employees severally request for a technovation certificate for the same technovation, the employee who is the first to make the request is entitled to the certificate.

(4) Where a request for a technovation certificate is made jointly by two or more employees, the certificate shall be issued in their joint names.

### 83. Request.

(1) A request for a technovation certificate signed by the employee shall be filed in writing with the enterprise.

(2) 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 is filed.

### 84. Issue 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 for the refusal within the period prescribed in subsection (1).

### 85. 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 use 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 one year from the date of the proposal.

(3) The technovator shall assist the enterprise, to the best of his or her ability in any testing, development or use of the technovation.

(4) The enterprise shall 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 start using it within six months from the issue of the technovation certificate or the expiration of the period referred to in subsection (2), the technovator is exempted from the obligations referred to in subsections (3) and (5).

(7) Notwithstanding subsection (6) the technovator has the right to communicate his or her technovation to others only to the extent that the communication does not involve the communication of any know-how or other knowledge that has been acquired as an employee.

### 86. Remuneration of the technovator.

Where the enterprise uses the technovation or communicates it to a third person, the technovator is 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.

### 87. Derogation by contract.

A contractual provision that is less favourable to employees or technovators than the provisions of this Part is void.

### 88. Disputes

(1) A dispute which concerns 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.

(2) The arbitration board shall hear interested parties and deliver its ruling.

(3) Where the parties fail to agree on the appointment of the chairperson, the chairperson shall be appointed by the Chief Magistrate's Court which has jurisdiction in the area where the enterprise is located on the application of any party.

#### PART XV—SURRENDER, REVOCATION AND INVALIDATION

##### 89. Surrender.

(1) The owner of a patent, utility model or an industrial design registration certificate may surrender it to the registrar.

(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 immediately be recorded in the register and published by the registrar.

(4) The surrender shall only be effective after it has been published.

(5) If a licence is 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 licence has expressly waived the right to consent in the licence contract.

##### 90. Revocation or invalidation.

(1) An 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 twelve months from the date of publication of the grant of a patent, utility model or an 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 sections 17, 18 or 19 to apply for the grant of a patent;
- (b) the owner of the patent has infringed 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;
- (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 is lodged at the registry;
- (h) the time the application for the grant of the patent is filed, the application form or any other documents filed under the application contained a material misrepresentation; or
- (i) the invention is not new in terms of section 10.

(4) An application for revocation or invalidation of a patent shall—

- (a) state the ground 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 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).

(5) If the owner of the patent wishes to contest the application for revocation of invalidation he or she shall, within the prescribed time 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 under 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.

(7) The particulars required under 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 under 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 prescribed manner 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 subsection (2) applies 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 and that person 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 that person is entitled to join in the proceedings.

#### 91. Effect of revocation or invalidation

(1) A revoked or an invalidated patent, a utility model or an industrial design or claim or part of a claim of a registered industrial design shall be regarded from the date of the grant of the patent or certificate of registration for the utility model or the industrial design to have ceased to have effect.

(2) Where the decision of the court is no longer subject to appeal, the court shall inform the registrar who shall immediately register it and publish it as soon as possible in the *Gazette*.

## PART XVI—INFRINGEMENT

**92. Acts constituting infringement.**

Subject to sections 44, 49, 59, 60 and 68 any act specified in section 38 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.

**93. Relief.**

Upon the request of the owner of the patent or the registered utility model or an industrial design, the court shall grant, any of the following reliefs—

- (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.

**94. Declaration of non-infringement.**

(1) Subject to subsection (2), any person who shows 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) A declaration shall not be made under subsection (1)—

- (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 the owner has refused that demand or has failed to reply within a reasonable time.

**95. Threat of infringement proceedings.**

(1) A person who is threatened with infringement proceedings and 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 an industrial design, may request the court to grant an injunction to prohibit the threat and to award damages for financial loss resulting from the threat.

(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.

**96. Criminal proceedings.**

(1) A person who intentionally infringes a patent or a registered utility model or an industrial design, commits an offence and is liable on conviction to a fine of not less than forty eight currency points but not exceeding one hundred and twenty currency points or imprisonment of not less than two years but not exceeding five years or both.

**97. Presumption of use of patented process.**

For the purposes 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 is unable, through reasonable efforts, to determine the process actually used.

#### 98. Powers of court on appeal.

(1) Where provision is made under this Act for appeal from a decision of the registrar, the appeal shall be made to the 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 consider fit.

#### 99. Suspension of release by customs authorities.

(1) A rights owner, who has reasonable grounds for suspecting that the importation of pirated goods may take place, may lodge an application in writing with the court for the suspension of the release into free circulation of those goods.

(2) A rights owner who initiates the procedure under subsection (1) shall be required to provide adequate evidence to satisfy the court that, there is *prima facie* infringement of the patent utility model or industrial design and supply a sufficiently detailed description of the goods to make them readily recognisable by the customs authorities.

(3) In this section “rights owner” is the owner of a patent, utility model or industrial design.

#### 100. Expert witnesses.

The court may, appoint any person with expert knowledge to assist the court in any case where it appears to the court that such knowledge is required for the proper determination of the case.

#### 101. Legal proceedings by licensee.

(1) Any exclusive licensee within the meaning of section 102(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 subsection (1) notify the registrar, and may after three months from the request or refusal, and after giving notice to the owner, institute the proceedings in his or her own name; and the owner may join in the proceedings.

(3) 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.

#### PART XVII—SPECIAL PROVISIONS ON ENFORCEMENT OF PATENT RIGHTS

#### 102. Special provisions on enforcement of patent rights.

(1) Subject to sections 38, 59, 60, and 68, the performance of any act referred to in section 38(2) in Uganda by a person other than the owner of the patent and without the agreement of the owner shall constitute an infringement of the patent.

(2) On the request of the owner of the patent, or of an exclusive licensee, or of a compulsory licensee, or of a non-exclusive licensee if he or she has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so within ninety days, the court may grant an injunction to prevent infringement or an imminent infringement and, where the infringer acted knowingly or with reasonable grounds to know, the court may award damages and grant any other remedy provided for in this Act.

(3) The remedies provided to owners of patents in Uganda shall be also available, where appropriate, to the owners of foreign patents that have been the subject of a compulsory licence for the purposes of supplying the market in Uganda of pharmaceutical products, under the scheme established by the Decision of the World Trade Organisation General Council of August 30, 2003, in order to prevent or remedy the unauthorized importation as well as the re-exportation or deviation of the products in question.

(4) Where a foreign patent referred to in subsection (3) resulted from applications that were filed in the country where the compulsory licence was granted after the coming into force of this Act or that were entitled to claim priority in Uganda on that same date, only those applications that are filed in Uganda in accordance with section 8(7) shall benefit from the remedies provided for in this section as well as in the general law on enforcement.

(5) The customs authorities shall have the authority to take border measures for the purposes of this section.

(6) Where the customs authorities take action under subsection (5), they shall notify the rights owner of the suspension of release and the rights owner shall have ten days for providing adequate evidence that the retained products prima facie correspond to the claims of the patent in question.

(7) Without prejudice to the subsection (3), the same border measures that are available for the suspension by the customs authorities of the release into free circulation of counterfeit trademark and pirated copyright goods shall also apply to prevent the unauthorized importation or re-exportation of the products that have actually been imported into the territory of Uganda under the scheme referred to in subsection (3).

(8) This section shall not apply to re-exportation of pharmaceutical products to other Members of the Common Market of East and South Africa (COMESA).

(9) Provisional measures aimed at preserving relevant evidence shall also be available before the granting of the pending patent application, where the court deems necessary.

(10) The applicant shall initiate proceedings in court within twenty working days or thirty one calendar days, whichever is the longer, from the publication of the grant of the pending registration.

(11) For the purposes of subsection (9), the courts may refuse to grant provisional or definitive injunctions, without prejudice to the payment of damages, where—

- (a) after the expiration of four years from the date of filing of the patent application or three years from the date of the grant of the patent, the plaintiff or a person with his authorization is not, or has not taken serious preparations for, or has no serious intention to start, commercially exploiting the invention in a manner that meets the demands of the market as to quantity, or at any time if the invention is exploited in a manner that does not meet the demands of the market as to quality;
- (b) the injunction causes serious harm to the public interest;
- (c) the patented products or the products manufactured by a patented process are sold by the plaintiff or by a third party with the plaintiff's consent at prices that are deemed excessive taking into account the average purchasing power of consumers and the specific nature of the needs the products aim at meeting, and there is no competing product on the market;
- (d) the plaintiff has engaged in inequitable conduct, according to section 8(3);
- (e) the patent was obtained in contravention of sections 21(6) and 21(7).

(12) At any time after ensuring compliance with sections 21(6) and 21(7) of this Act, the patent holder may initiate proceedings on grounds of infringement, under this section.

(13) A remedy, shall not be available to the patent holder in respect of any acts done by third parties before the patent holder has ensured compliance with sections 21(6) and 21(7).

(14) Where the act of infringement is practised by the government or for the purposes of serving the government the court shall not issue an injunction other than for obtaining evidence in control of the infringer, if necessary, without prejudice to the accounting of damages.

(15) The rights accruing from patents for pharmaceutical processes shall not be enforceable until January 1, 2016, if alternative processes for making pharmaceutical products that are not subject to exclusive rights are not available and those patents, if enforced, indirectly give rise to market exclusivity of the pharmaceutical products in question.

(16) The court may order the infringer to pay damages relating to acts of infringement of patent rights practised—

- (a) after the date on which the patent application was opened for public inspection, in accordance with section 29; or
- (b) after the date on which the patent applicant gave notice to the alleged infringer of the contents of the application; or
- (c) after the date on which the alleged infringer acquired knowledge of the contents of the application by any means.

(17) The request for the court to order the payment of damages under subsection (2) may be filed only after the title of industrial property right in question is granted.

(18) Subsection (17) shall apply to those applications to which section 8(3)(f) refers only after January 1, 2016.

(19) For the purposes of civil proceedings in respect of the infringement of rights of the patent owner, if the subject matter of a patent is a process for obtaining a product, the court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.

(20) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process in the following circumstances—

- (a) if the product obtained by the patented process is new; or
- (b) if there is a substantial likelihood 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.

(21) In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taken into account by the court, which, among other measures, shall not facilitate those secrets to the plaintiff.

#### PART XVIII—MISCELLANEOUS

##### 103. Public notices.

Whenever any matter is required to be published under this Act, it shall be published in the *Gazette*, and also as soon as practicable, be published in a newspaper of wide circulation in the relevant area.

**104. Regulations.**

(1) The Minister may make regulations prescribing anything which under this Act is required or authorized to be prescribed, and generally for the better carrying out of the objects and purposes of this Act.

(2) Regulations made under subsection (1) may prescribe in respect of a contravention of any of the regulations a penalty of a fine not exceeding forty eight currency points or imprisonment not exceeding two years of both.

(3) The regulations may also prescribe additional penalties in respect of continuing offences and also a requirement that anything used in the contravention shall be forfeited to the state by the court.

**105. Corrections of errors and extension of time.**

(1) The registrar may, subject to any provision in the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the registry or in any recording effected under this Act or under the regulations.

(2) Substantive errors, may only be modified by the court, under due process.

(3) For the purposes of this section substantive errors are those that, if modified, will affect the rights conferred.

(4) Unless otherwise provided in this Act, if the registrar is satisfied that the circumstances justify it, he or she on receiving a written request, may extend the time for doing any act or taking any proceeding under this Act and the regulations, upon notice to the parties concerned and upon such terms as he or she may direct.

(5) The extension may be granted even where the time for doing the act or taking the proceeding has expired.

**106. Exercise of discretionary powers.**

The registrar shall give any party to a proceeding before an opportunity of being heard before exercising adversely to that party any discretionary power vested in him or her by this Act or the regulations.

**107. Power of Minister to amend Schedule.**

The Minister may with the approval of Cabinet by statutory instrument, amend the Schedule.

**108. Exemption from stamp duty.**

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

**109. Consequential amendment of Cap. 210.**

The Uganda Registration Services Bureau Act is amended in item 11 of the First Schedule, by substituting for the reference to the Patent Act the words "Industrial Property Act, 2009".

**110. Repeal of Cap. 216 and Cap. 218, transitional and savings provisions.**

(1) The Patents Act and the United Kingdom Designs Protection Act are repealed.

(2) Where a patent was registered in Uganda under the former patent Act or where it was saved under that Act and the privileges and rights conferred by the registration were effective immediately before the commencement of this Act, then, subject to this section-

(a) the patent shall be treated in Uganda as if it had been granted under this Act;

(b) the patent shall expire as regards Uganda when those privileges and rights could have expired if this Act had not been enacted;



- (c) the 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 enacted;
- (d) the certificate of registration, or a certified copy of the patent, shall be admissible as prima facie evidence of the date and the fact of registration; and
- (e) an action for infringement of the patent shall lie under this Act only if the alleged infringement occurred on or after the commencement of this Act, and in any other case may be referred to the Industrial Property office and disposed of as if this Act had not been enacted.

(3) So far as is necessary for the purposes of subsection (2), the register of patents under the former Patents Act shall continue to be maintained and shall be taken to be part of the register under this Act.

(4) Section 53 of this Act shall not apply to licence contracts and contracts assigning the right to patent or assigning applications or patents, if the contract is concluded before the commencement of this Act and is submitted for registration to the registrar within sixty days from the commencement of this Act.

(5) Where the registered proprietor of any design registered in the United Kingdom enjoyed privileges and rights in Uganda under the former United Kingdom Designs (Protection) Act immediately before the commencement of this Act, those privileges shall continue until they cease to exist under the United Kingdom Act subject to regulations made by the Minister under section 104 of this Act.

(6) All the funds, assets and other property, movable and immovable, which immediately before the commencement of this Act, were held by the Government on behalf of the former office shall, by virtue of this section and without further assurance, vest in the Government on behalf of the registrar.

(7) Every public officer having the power or duty to effect or amend any entry in the 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 registrar do all such things as are by law necessary to give final effect to the transfer of any property mentioned in subsection (6) to the registrar.

(8) 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 subsection, be transferred to, vested in, imposed on, or be enforceable by or against the registrar.

(9) On and after the commencement of this Act, all action, 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 registrar and no such suit, action or legal proceedings shall abate or be affected by the coming into operation of this Act.

(10) In this section—

“former Patents Act” means as the Patents Act (Cap. 216) repealed by this Act;

“former United Kingdom Designs (Protection) Act” means the United Kingdom Designs (Protection) Act (Cap. 218) repealed by this Act.

SCHEDULE

Currency point

One currency point is equivalent to twenty thousand shillings.

**Cross reference**

Stamps Act, Cap. 342.

The National Environment Act, Cap. 153.

Uganda Registration Services Bureau Act, Cap. 210.

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

