

ASSIGNMENT OF INTELLECTUAL PROPERTY RIGHTS – ESSENTIAL CONSIDERATIONS

1.0. INTRODUCTION

Adequate knowledge of the subject of intellectual property, the objectives underlying its protection and available mechanisms for adequate balancing of private rights of owners and the public interests of users have become critical.¹ This is because globally, intellectual property is recognised as a vital asset in business, which is currently estimated to be even more valuable than physical assets.² Its protection or lack thereof, as the case may be, also has a fundamental impact on vital aspects of life such as education, health, entertainment, culture, employment, food security and general societal growth and development.³ Just as with buying and selling physical property, transferring the ownership of intellectual property is an important part of doing business⁴.

¹Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)2.

²Ibid.

³ Ibid.

⁴ Intellectual Property assignment : What it is and how to make one

<https://www.legalzoom.com/articles/intellectual-property-assignment-how-to-guide#:~:text=IP%20ownership%20rights.->

,What%20is%20an%20intellectual%20property%20assignment%3F,part%20of%20a%20larger%20transaction accessed on 18 February 2024.

2.0. Definition of Terms

2.1. **Intellectual Property rights:** This refers to legal rights which result from intellectual activity in the industrial, scientific, literary and artistic fields.⁵

2.2. **Assignment:** An Assignment is a transfer or setting over a property or of some right or interest therein from one person to another.⁶

2.3. **Assignor:** An assignor is a person, company or entity who transfers rights they hold to the assignee.⁷

2.4. **Assignee:** An assignee is a person, company, or entity to which a transfer of property, rights or interest is made.⁸

2.5. **Licence:** Licensing of intellectual property, is the grant of a right to use IP without transferring ownership⁹ In other words, the original holder of the IP right remains the owner but allows a third party limited access to the right.¹⁰

3.0. Assignment and Licence – Distinction.

There is a fundamental distinction between an assignment of an intellectual property right and a licence of it.¹¹ The former involves a complete transfer of the right, so that the assignee stands in the shoes of the assignor.¹² A licence by contrast, is merely a permission to do an act which would, but for the licence, be

⁵ WIPO, *Intellectual Property Handbook*, (2nd Ed. WIPO Publication No 489 (E) Geneva, 2004).

⁶ G.S. & L. Ltd v. AMCON (2023) 15 NWLR (Pt. 1907) 382.

⁷ G.S. & L. Ltd v. AMCON (2023) 15 NWLR (Pt. 1907) 382.

⁸ Ibid.

⁹ Assignment vs Licensing: A comprehensive guide with 6 key benefits and lawyer-drafted templates, <https://docue.com/en-gb/legal-hub/assignment-vs-licensing#:~:text=Assignment%20involves%20a%20transfer%20of,IP%20to%20a%20new%20owner>, accessed on 18 February 2024.

¹⁰ Marcus Smith QC and Nico Leslie, *The Law of Assignment* (2nd edn, Oxford University Press 2013) 156.

¹¹ Ibid.

¹² Ibid.

prohibited.¹³ Put differently, licence is the grant of a right to use IP without transferring ownership.¹⁴

4.0. Assignment of Intellectual Property Rights: This refers to the transfer of the ownership rights in the intellectual property (copyright, patent, industrial design, trademark) from the assignor to the assignee.

4.1. Types of Intellectual Property Rights

Intellectual Property rights are broadly categorised into two parts: copyright and industrial property rights.¹⁵ While copyright refers to the exclusive rights for creative works of authorship, such as literary, artistic and musical works, as well as the entrepreneurial rights relating to the exploitation of these works.¹⁶ Industrial property rights refers to the legal protection of a wide range of industrial and commercially valuable information including those arising from the creation of new and useful inventions, outwardly appealing designs, trademarks, service marks, geographical indications, trade secret/confidential information all fall within the scope of the law of industrial property.¹⁷

The following are the various types of Intellectual Property rights:

- i. Copyright
- ii. Patent

¹³Marcus Smith QC and Nico Leslie, *The Law of Assignment*(2ndedn, Oxford University Press 2013) 156.

¹⁴ Assignment vs Licensing: A comprehensive guide with 6 key benefits and lawyer-drafted templates, <https://docue.com/en-gb/legal-hub/assignment-vs-licensing#:~:text=Assignment%20involves%20a%20transfer%20of,IP%20to%20a%20new%20owner>, accessed on 18 February 2024.

¹⁵ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)3.

¹⁶ Ibid 4.

¹⁷Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015) 3.

- iii. Industrial Designs
- iv. Trademarks
- v. Confidential Information/Trade Secrets

4.1. **Copyright**

Copyright is regulated by the Copyright Act, 2022 (The Act). The Act does not define Copyright. However, the Act provides that literary works, musical works, artistic works, audiovisual works, sound recordings and broadcasts are eligible for copyright.¹⁸ The Act explicitly states that literary, musical or artistic work can only be eligible for copyright if some effort has been expended on making the work, to give it an original character and the work has been fixed in any medium of expression known or later to be developed, from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of any machine or device.¹⁹ The Act by virtue of section 30 provides for Assignment of Copyright. Section 30 provides:

“(1) For the purpose of Chapter 4 of the Constitution of the Federal Republic of Nigeria 1999, copyright shall be deemed to be movable property and shall be transferable by way of assignment, testamentary disposition or operation of law. First ownership of copyright. Ownership of copyright in collective works. Assignment and licence. Cap. C23, LFN, 2004. A 198 2023 No. 8 Copyright Act, 2022.

¹⁸ Copyright Act 2022, s. 2(1) (a-f).

¹⁹ Copyright Act 2022, s. 2(2) (a-b).

(2) An assignment or testamentary disposition of copyright may be limited to only some of the acts, which the owner of the copyright has the exclusive right to control or to a part only of the period of the copyright, or to a specified country or other geographical area.

(3) An assignment of copyright or an exclusive licence to do an act, the doing of which is controlled by copyright, shall have no effect unless it is in writing.

(4) A non-exclusive licence to do an act, the doing of which is controlled by copyright, may be written, oral, or inferred from conduct of the owner of copyright.

(5) An assignment or licence granted by one copyright owner, shall have effect as if granted by his co-owner and subject to any agreement between them, any fee received shall be divided equitably among the co-owners.

(6) For the purposes of this section, persons shall be deemed to be co-owners, if they — (a) share joint interest in the whole or any part of a copyright; or (b) have interests in the copyright in various works comprised in a production of two or more works.

(7) Ownership of a material in which a work is embodied shall not confer ownership of copyright in the work.

(8) Except as may otherwise be provided for in an agreement, an owner of copyright who transfers the ownership of the material in which the work is embodied, shall not be deemed to have

transferred his copyright or to have granted a licence for the exploitation of the work.

(9) Except as may otherwise be provided for in an agreement, an owner of copyright who transfers his copyright or grants a licence for the exploitation of a work shall not be deemed to have transferred the ownership of the material in which the work is embodied.

(10) An assignment, licence or testamentary disposition, may be granted or made in respect of a future work or an existing work in which copyright does not subsist, provided that it shall not be permitted to transfer the rights in all future works of an author.

(11) A testamentary disposition of a material on which a work is first written or recorded shall, in the absence of any indication to the contrary, be presumed to include any copyright or prospective copyright in the work, which is vested in the deceased.”²⁰

A combined reading of section 2 and 30 of the Act reveals that copyright in literary works, musical works, artistic works, audiovisual works, sound recordings and broadcasts can be transferred by way of assignment, testamentary disposition or operation of law. A copyright owner may choose to assign some of the acts to which he has exclusive right to control, a part of the period of the copyright, or to a specified country or other geographical area.²¹ It is pertinent to state that assignment of copyright shall have no effect unless it is

²⁰ Copyright Act 2022, s. 30.

²¹ Copyright Act 2022, s.30(2).

in writing.²² It is noteworthy that while non-exclusivelicence can be oral, assignment and exclusive licence must be in writing.²³

4.2. **Patent**

Patent is defined as legal rights that confer on inventors of new and useful products and processes the right to exclude others from the commercial exploitation of the invention.²⁴ Patent is regulated by the Patent and Designs Act.²⁵By virtue of the Act, an invention is patentable if it is new, results from inventive activity and is capable of industrial application;²⁶ or if it constitutes an improvement upon a patented invention and also is new, results from inventive activity and is capable of industrial application.²⁷ The Act further provides that an invention is new if it does not form part of the state of the art²⁸ and an invention results from inventive activity if it does not obviously follow from the state of the art, either as to the method, the application, the combination of methods, or the product which it concerns, or as to the industrial results it produce.²⁹ The Act by virtue of section 24 provides for Assignment of Patent. Section 24 provides:

“(1) Subject to this section, a person's rights in a patent application, in an application for the registration of a design, in a patent or in a

²²Copyright Act 2022, s. 30(3).

²³ Ibid s.30(4).

²⁴ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)141.

²⁵ Patents and Designs Act, CAP P2 LFN 2004.

²⁶ Ibid, s. 1 (1) (a).

²⁷ Ibid, s. 1 (1) (b).

²⁸ Ibid, s.2 (a).

²⁹ Ibid, s. 2 (b).

registered design may be assigned, transferred by succession or held in joint ownership.

(2) An assignment under subsection (1) of this section shall be in writing and signed by the parties.

(3) An assignment or transfer by succession under subsection (1) of this section shall have no effect against third parties unless it has been registered and the prescribed fee paid.

(4) In the absence of any provision to the contrary among themselves, joint owners of a patent or registered design may separately transfer their shares, exploit the patented invention, utilise the registered design or exercise the rights conferred by section 6 or 9 of this Act, as the case may be; but a licence under this Act may not be granted by joint owners otherwise than jointly.

(5) Any reference (however expressed) in this Act to an applicant for a patent, an applicant for the registration of a design, a patentee or a design owner includes, unless the context otherwise requires, a reference to any predecessors or successors in title and, where appropriate, to joint applicants, joint patentees or joint owners, as the case may be.”

It can be deduced from section 24 that a person’s right to patent may be assigned or transferred by succession.³⁰ A patentee may assign or sell off the invention, in which case he totally divests himself of ownership of the whole

³⁰Patents and Designs Act, CAP P2 LFN 2004, s.24(1).

subject matter or specific rights in the invention.³¹ This is because as provided in section 6, patents confer a bundle of rights on the patentee and this may be jointly or severally exploited.³² Thus, the right to import in different countries may be assigned or licensed to different parties, while the right to manufacture may also be separately negotiated.³³ Where however, the contract is silent on this and merely provides for the assignment of the patent, a total divestment is contemplated.³⁴ For all practical purposes, the assignee steps into the shoes of the patentee/assignor.³⁵ By virtue of section 24 of the Patent and Designs Act, an assignment shall be in writing and signed by the parties.³⁶ The Act also provides that the assignment or transfer of patent shall be registered so as to constitute notice to third parties.³⁷ In *Arewa Textile Plc & 3 Ors v Fintex Limited*,³⁸ the respondent instituted an action at the Federal High Court against the appellants for the infringement of its registered patent, RP 12024 in respect of the “method and apparatus” of producing textile material. The process was invented and developed by one Kong Sang Wong. The said process was later assigned to Boaty Company Ltd, who further assigned the right to apply for a patent in Nigeria to the respondent. The respondent contended that it was the only manufacturer producing by its process and that the 1st appellant used its process and thereby flooded the market with the resulting goods. The trial court found in favour of the respondent. However, on appeal, it was held that there

³¹Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)181.

³² Ibid.

³³ Ibid.

³⁴Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)181.

³⁵Ibid.

³⁶Ibid, 182.

³⁷ Patents and Designs Act, CAP P2 LFN 2004, s.24(3).

³⁸ (2003) 7 NWLR (Pt. 819)322.

was no evidence to show that the respondent indeed applied for a patent in its own name, nor had it registered the purported assignment by Boaty Company Ltd. Having failed to do this, the respondent could not validly claim under a patent issued to another person. Thus, since there was no evidence of such registration and payment by the respondent, its cause of action against the appellants was held to be inchoate and the said assignment had no effect on the appellants.³⁹

4.3. ***Industrial Designs***

The Patent and Designs Act defines the nature of industrial design as any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, is an industrial design, if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result.⁴⁰

From the definition above, a design will qualify as an industrial design if it has the following characteristics. Firstly, it must be a combination of lines and colours or both. A design may also consist of a three-dimensional form, that is, the shape of an article.⁴¹ Here the design (shape) is applied to the article by incorporation into it. For example, the shape of a flower vase, cup or shoe sole is registrable as an industrial design.⁴² Further the design must be intended by the

³⁹ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)182.

⁴⁰ Patent and Designs Act CAP P2 LFN 2004, s.12

⁴¹ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)206.

⁴² Ibid.

creator to be used as a model or pattern to be multiplied by industrial process.⁴³ In other words, the design must not be a 'stand-alone' work of art or design such as sculpture, drawing, carving or other purely artistic design not intended to be reproduced industrially.⁴⁴ A design qualifies protection as an industrial design if it is reproduceable by industrial means, including mechanical processes such as printing, embroidery, sewing etc., as well through manual application to industrial products through painting, engraving and other processes⁴⁵. What is important is that the design must be intended for use in industry, in respect of articles of manufacture produced on a large scale. To qualify as an industrial design within the meaning of Section 12, a design should not be intended solely to obtain a technical result.⁴⁶ In other words, it must not be a functional feature or shape which is applied for its usefulness or add utility to the article to which it is applied and without which the article cannot perform its function.⁴⁷ Thus, protection here is not extended to patterns, shape or other features which are assumed for technical reasons rather than aesthetics.⁴⁸

The Patent and Designs Act provides that a person's right in application for registration of a design and in a registered design may be assigned.⁴⁹ An assignment of a person's right in application for registration of a design and in a registered design shall be in writing and signed by the parties.⁵⁰ The Act explicitly

⁴³Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)206.

⁴⁴ Ibid.

⁴⁵ Ibid

⁴⁶ Ibid.

⁴⁷ Ibid.

⁴⁸ ibid

⁴⁹Patent and Designs Act CAP P2 LFN 2004, s.24(1)

⁵⁰Patent and Designs Act CAP P2 LFN 2004, s.24(2)

provides that an assignment of the aforementioned rights shall have no effect against third parties unless it has been registered and the prescribed fee paid.⁵¹

4.4. **Trademarks**

Trademark is defined under section 67 of the Trademarks Act as a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person.

From the definition of Trademark under the Act, it can be deduced that trademark must consist of a mark which has been defined as including a device, brand, heading, label, ticket, name, signature, letter, numeral, or any combination thereof.⁵² It is noteworthy that unlike patents and designs, prior use or publication of the mark by the applicant is not a barrier to trademark registration.⁵³ Thus, trademark registration may be based on prior use or it may be futuristic in which case an intent to use will suffice as a basis for the application.⁵⁴ The Act by virtue of section 26 provides for Assignment of Trademark. Section 26 provides:

“(1) Notwithstanding any rule of law or equity to the contrary, a registered trademark shall after the commencement of this Act be assignable and transmissible either in connection with the goodwill of a business or not.

⁵¹ Patent and Designs Act CAP P2 LFN 2004, s.24(3)

⁵² Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.67.

⁵³ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)236.

⁵⁴ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.18(1).

(2) A registered trademark shall after the commencement of this Act be assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) Subsections (1) and (2) of this section, shall apply in regard to an unregistered trademark used in relation to any goods as they apply in regard to a registered trademark registered in respect of any goods, if - (a) at the time of the transmission of the unregistered trademark it is used in the same business as a registered trade mark;

and (b) it is assigned or transmitted at the same time and to the same person as that registered trademark; and (c) it is so assigned or transmitted in respect of goods all of which are goods – (i) in relation to which the unregistered trademark is used in that business; and (ii) in respect of which the registered trademark is assigned or transmitted.

(4) Where after the commencement of this Act, a trade mark is assigned in respect of any goods and at the time of the assignment the trade mark is used in a business in those goods, then, if the assignment is made otherwise than in connection with the goodwill of that business, the assignee shall not acquire any rights under the assignment until the following requirements have been satisfied, that is to say the assignee - (a) must within six months from the date of the assignment or within such extended period, if any, as the Registrar may allow, apply to the Registrar for directions with respect to the

advertisement of the assignment; and (b) must advertise the assignment in such form and manner and within such period as the Registrar may direct.

(5) Where the Registrar gives directions under subsection (4) of this section, for the advertisement of an assignment, he shall also cause notice of the assignment to be published in the Journal.”⁵⁵

It can be deduced from section 26 of the Trademarks Act that registered trademarks are assignable. Further, the Act provides that the registered proprietor of a trademark has power to assign the trademark, and to give effectual receipts for any consideration for such an assignment.⁵⁶ An assignee that becomes entitled by assignment or transmission to a registered trademark is required to apply to the Registrar to register his title.⁵⁷ The Registrar, on his part, shall, register such assignee as the proprietor of the trademark in relation to goods in respect of which the assignment has effect and shall cause such particulars of the assignment to be entered on the Register.⁵⁸ Where the particulars of the assignment is not entered in the register, it shall not be admitted in evidence in any court in proof of the title to a registered trade mark unless he court otherwise directs.⁵⁹

4.5. ***Confidential Information/Trade Secrets***

Protection of trade secrets and other forms of confidential information, although not falling within intellectual property statutory protection in Nigeria,

⁵⁵ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990.

⁵⁶ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.29.

⁵⁷ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.30(1).

⁵⁸ Ibid.

⁵⁹ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s. 30(3).

subsists at common law and is therefore part of the body of Nigerian Laws.⁶⁰ The law in this area protects information of confidential character which is not already in the public domain, from misappropriation by a person to whom the information has been confided.⁶¹ For an information to qualify as a trade secret, the information must be commercially valuable, be known only to a limited group of persons and be subject to reasonable steps taken by the rightful holder of the information to keep it secret, including the use of confidentiality agreements for business partners and employees.⁶² Trade secrets can be assigned to other persons.

5.0. ESSENTIAL CONSIDERATIONS IN THE ASSIGNMENT OF IP RIGHTS

5.1. *Identification of the specific IP right to be assigned:*

In the assignment of IP rights, parties (assignor and assignee) must be certain as to the specific IP rights to be assigned. In determining the specific IP right, it is pertinent to be certain as to whether the assignor intends to assign its copyright, patent, industrial design, trademark or trade secret. The assignee must be clear as to whether it is the legal or the equitable right that the assignor intends to assign. This is important because in the case of infringement of copyright, the Act expressly provides that it shall be actionable at the instance of the owner, assignee or an exclusive licensee of the copyright.⁶³ In *M.C.S. (Nig.)*

⁶⁰ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015) 311.

⁶¹ Ibid.

⁶² World Intellectual Property Organisation, <[Trade Secrets – Everything you need to know \(wipo.int\)](https://www.wipo.int)> accessed on 14 February 2024. Agreement on Trade-Related Aspects of Intellectual Property rights (TRIPS Agreement), Article 39.

⁶³ Copyright Act 2022, s.37(1).

Ltd./Gte v Adeokin Records,⁶⁴the court stated that for a person to be a legal owner of copyright for the purposes of vesting requisite locus, such must fall under any of the following categories, namely, the author of the work himself, the assignee and the exclusive licensee. From the foregoing, it can be deduced that the obvious person to bring proceedings for infringement of one of the statutory types of intellectual property is the owner at law, the assignee and the exclusive licensee.⁶⁵ A person with a purely equitable title (under a trust or a specifically enforceable contract) is permitted to bring a motion for interlocutory relief, but he may not proceed further without joining the legal owner.⁶⁶Similarly, under the Patent and Design Act, an infringement of the rights of a patentee or design owner shall be actionable at the suit of the patentee or design owner in question.

5.2. ***Understand the specific statutory requirements for assigning the IP right:***

Parties (assignor and assignee) should ensure to understand the specific statutory requirements for assigning the IP right sought to be assigned. In this case, parties should be certain as to whether the assignment of such an IP right requires to be in writing, oral or can be determined by the conduct of the parties or whether the assignment of such rights requires registration or advertisement. It is pertinent that the assignor is certain as to whether the assignment of the IP right is to be in writing or orally. As it pertains to copyright, the Act provides that an assignment of copyright shall have no effect unless it is

⁶⁴(2007) 13 NWLR (Pt. 1052) 616, 628.

⁶⁵W.R. Cornish, *Intellectual Property* (3rdedn, Sweet and Maxwell 1996) cited in *M.C.S. (Nig.) Ltd./Gte v AdeokinRecords*(2007) 13 NWLR (Pt. 1052) 616, 628.

⁶⁶*Ibid.*

in writing.⁶⁷ Further, the Patent and Designs Act provides that assignment of a person's rights in a patent application, in an application for the registration of a design, in a patent or in a registered design shall be in writing and signed by the parties.⁶⁸ The Trademarks Act does not provide that the assignment should be in writing. However, the Act provides that if the assignment is otherwise than in connection with the goodwill of the business, the assignee shall not acquire any rights under the assignment until the assignment is advertised within six (6) months in such form and manner and within such period as the Registrar may direct.⁶⁹ The Registrar is also required to cause notice of the assignment to be published in the Journal.⁷⁰ Compliance with the statutory requirements for the transfer of IP rights help parties determine when the right or interest in IP is said to have been assigned.

5.3. ***Define or identify the scope of the right being assigned:***

Here, parties (assignor and assignee) determine the scope of the IP right that is to be assigned. The key consideration is whether the assignor intends to assign apart or the entirety of the IP right. An assignor may in the case of assignment of copyright decide to assign only some of the acts, which the owner of the copyright has the exclusive right to control or to a part only of the period of the copyright, or to a specified country or other geographical area. As it pertains to Patent, a patent may be assigned in respect of a product (the act of making, importing, selling or using the product, or stocking it for the purpose of sale or use) or assigned in respect of a process (the act of applying the process or doing, in respect of a product obtained directly by means of the process).

⁶⁷ Copyright Act 2022, s.30(3).

⁶⁸ Patents and Designs Act, CAP P2 LFN 2004, s. 24(1) (2).

⁶⁹ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.26(4).

⁷⁰ Ibid, s. 26(5).

5.4. ***Identify the owner of the IP right:***

The assignee must ensure that the IP right vests in the assignor. This is applicable in the case of Employee/Contractor IP rights. The Copyright Act provides that except as otherwise provided in an agreement, copyright shall initially vest in the author.⁷¹ The Act further provides that where a person in the absence of an agreement to the contrary, creates a work under a contract for services, or in the course of employment by a government, a ministry, department or agency of a government or a prescribed international or inter-governmental organisation, the copyright in that work shall vest in that government, ministry, department, agency, prescribed international or inter-governmental organisation.⁷² Similarly, the Patent and Designs Act provides that where an invention is made or an industrial design is created in the course of employment or in the execution of a contract for the performance of specified work, the right to a patent in the invention is vested in the employer or person who commissioned the work.⁷³ However, where the inventor is an employee, if his contract of employment does not require him to exercise any inventive activity but he has in making the invention used data or means that his employment has put at his disposal or the invention is of exceptional importance, then the employee is entitled to a fair remuneration.⁷⁴

⁷¹Copyright Act 2022, s.28(1).

⁷²Copyright Act 2022, s. 28(2).

⁷³ Patents and Designs Act, CAP P2 LFN 2004, s. 2(4).

⁷⁴ Ibid, s. 14(4).

5.5. **Ensure that the IP rights are properly registered and protected:**

Parties (assignor and assignee) must ensure that the IP rights are properly registered and protected. Unlike Copyright that confers on every work that is eligible without registration,⁷⁵ Patent, Industrial Design and Trademark requires registration before such IP right can be recognised. The Patent and Designs Act provides that the right to a patent in respect of an invention is vested in the statutory inventor that is the first person to file whether or not he is the true inventor. Further, the Act requires that assignment of patent right shall have no effect against third parties unless it has been registered and the prescribed fee paid. In *Arewa Textile Plc & 3 Ors v Fintex Limited (Supra)*, there was no evidence that patent was registered by the respondent, hence, its cause of action against the appellants was held to be inchoate and the said assignment had no effect on the appellants.⁷⁶ The Trademarks Act provides that the registration of a person in Part A or B of the register as proprietor of a trademark in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of that trademark in relation to those goods.⁷⁷ From the foregoing, registration of IP right cannot be overemphasised as it is a prerequisite to the recognition of such right. It is noteworthy that registration of the assignment or transfer of IP right constitutes notice to third parties.

5.6. **Third – Party Agreement and Licenses:** Before the assignment of IP rights, it is essential for parties to review any existing third -party agreements and licenses

⁷⁵ Copyright Act 2022, s. 4, s. 5.

⁷⁶ Adejoke O. Oyewunmi, *Nigerian Law of Intellectual Property* (University of Lagos Press and Bookshop Ltd 2015)182.

⁷⁷ Trademark Act, Chapter 436 Laws of the Federation of Nigeria 1990, s.5 and s.6.

that may impact the assignment. These agreements may include non-disclosure agreements (NDAs), Licencing contracts, or joint venture agreements⁷⁸. Understanding how these agreements interact with the IP assignment process is crucial to avoid breaching any contractual obligations or inadvertently assigning rights that should remain with third parties⁷⁹. A tip here would be to conduct a thorough review of all existing agreements to ensure compliance.⁸⁰

6.0. CONCLUSION

This work has been able to give an overview of assignment of IP rights, define the terms associated with assignment of IP rights, examine each of the types of IP rights and finally examine the essential considerations in the assignment of IP rights.

It is our Opinion that parties (assignor and assignee) should ensure to conform with the essential considerations discussed above in the assignment of IP rights. This is because, as rightly stated above, these considerations make for clarity amongst parties as to; what IP right is being transferred, the scope of the IP right being transferred, whether the transfer of such IP right requires to be in writing or otherwise, proper identification of the owner of the IP right, proper registration and protection of the IP right sought to be assigned and disclosure of a third-party agreement if any.

⁷⁸ IP Assignment: Transferring Ownership of your Intellectual Property <<https://fastercapital.com/content/IP-Assignment--Transferring-Ownership-of-Your-Intellectual-Property.html>>accessed on 18 February 2024.

⁷⁹Ibid.

⁸⁰Ibid.