

ANTON PILLAR ORDER AS A WEAPON OF PROTECTION
OF
INTELLECTUAL PROPERTY RIGHTS

INTRODUCTION

“The scope of intellectual property rights is very wide. The field encompasses such legal concept as trade marks, patents, designs as well as copyright. All these legal concepts deal in one way or the other with the protection of the fruits of man’s creative efforts. The man who thinks up a distinctive and original name, device or get-up to market his goods in order to make the goods easily recognizable or even more attractive to the average purchaser, and had over a period of time procured through the quality of his goods substantial goodwill for the name, device or get up, deserves some protection for such name, device or get-up, and he is indeed protected by the law of trade marks. The man who spends money, energy, ingenuity and time in conducting research and inventing a new machine, discover a new device or process is protected by the law of patents. The man who designs a new shape for a motor car or settee or designs a new patterns for textiles is also creative. He is protected by the law of designs. The man who writes a new song, or story, or the architect who designs a unique building are all creative. They on their part are protected by the law of copyright”

The above is an attempt to present in a nutshell what intellectual property is about. However, apart from Patents, Designs, Trade Mark and Copyright there are other legal concepts which are often treated as species of intellectual property. These include trade secretes, confidential information and breach of trust.

The various aspects of intellectual property rights differs in purpose and detailed rules. Each can be studied as a special legal subject. However, they all share one fundamental common feature, and that is that the rights protected by them are negative in nature, they are rights to stop others from doing certain things – rights in other words, to stop piracies, counterfeiters, imitators or even in some cases third parties who have independently reached the same ideas, from exploiting without the licence of the rightowner.²

Intellectual property protects applications of ideas and information that are of commercial value. The subject is growing in importance, especially in the advanced industrial countries, as the fund of exploitable ideas becomes more sophisticated and as the hopes for successful economic future comes to depend increasingly upon superior corpus of new knowledge and fashionable concepts. There has recently been a great deal of political and legal activities designed to assert and strengthen the various types of protection for ideas.

The above statement is equally applicable to Nigeria as an integral part of the world intellectual property community to the extent that our future economic fortune depends to a large extent on the volume of new knowledge and exploitable idea at our disposal. However, whilst the developed countries and some developing countries especially in Asia continue to engage in a flurry of activities, legal and political, targeted at strengthening

the protection afforded to intellectual properties, the same cannot be said about Nigeria. There seems to be an insufficient appreciation of the key position of intellectual property in the developmental process of a nation and of the fact that the level of development of a state is a reflection of the knowledge and ideas at its disposal and the use it is able to make of them.

Information technology is fast changing the face of the world with its unending vistas of possibilities and the great challenges it poses to intellectual property law. Nigeria as most countries in Africa is clearly lagging behind.

The only way to encourage the growth of new ideas and search for productive knowledge is for the inventors, the creators and researchers to have full confidence that whatever they come up with will be adequately protected by effective legal machinery so as to justify the resources, financial and otherwise, expended in their efforts.

By law, there are diverse remedies, which are tailored at addressing the infringement of different species of intellectual property rights. These include damages, accounts of profit and injunction. There are also reliefs under the criminal law.

However, the most effective and therefore the most frequently sought remedy is the injunction³. Even, then, one specie of injunction, that is, Anton pillar order, stands out as an invaluable weapon in the armoury of an intellectual property lawyer and rightowner. This is a product of its flexibility (as an equitable remedy) as well as the stage of its intervention.

o international

In this paper, an attempt will be made to consider briefly some of the principal branches of intellectual property rights and their infringement.

Other traditional remedies and their shortcomings, injunctions generally, the Anton pillar order, its historical and procedural context, its relation to other aspects of law like constitutional law and the law of evidence and needs for safeguard. The paper will conclude by highlighting some attendant problems and suggested solutions.

SOME HEADS OF INTELLECTUAL PROPERTY RIGHTS.

1. COPYRIGHT

Principally, the law regulating copyright in Nigeria today is the Copyright Act Cap 68 Laws of the Federation of Nigeria 1990. Before the Act, there had been the Copyright Act 1911⁴ and the Copyright Act 1970.

4. In Nigeria, as in most commonwealth jurisdictions, Copyright law is largely statutory. There is also a general body of case law amplifying the statutory provisions. Apart from municipal laws, there are als For a further consideration of these conventions see (a) Shahid Atiku: International Dimension of Copyright Protection – the Global Perspective at page 15 of Copyright law and administration in Nigeria edited by Prof. E.E. Uvieghara (b) Judesola Akande: International Dimension of Nigeria Copyright Law at page 55 of Copyright Law and administration in Nigeria Ed. – Prof. Uvieghara.
5. Black's law Dictionary, 5th Edition page 304.
6. Lahore: Intellectual property in Australia: copyright [Sidney Butterworks] 1977 page 80. See also S 1(2)(a) of the Copyright Act LFN 1990.

conventions, which impact upon the administration of Copyright law. The two major international treaties on copyright are the Bern Convention of 1888 as well as the Universal Copyright Convention 1952⁵.

Black's Law Dictionary defines copyright as:

“the right of literary property as recognised and sanctioned by positive law. An intangible incorporeal right granted by statute to the author or originator of certain literary or artistic production, whereby he is invested for a limited period, with the sole and exclusive privilege of multiplying copies of the same and publishing and selling them”.⁶

The subject matter of copyright in Nigeria can be found in Section 1 of the copyright Act. By that section, works that are eligible for copyright are literary works, musical works, artistic works, cinematographic films, sound recordings and broadcasts.

However, for copyright to subsist in any of the works listed above, some other conditions must be satisfied.

In the first instance, the work must be “original”. Originality is a fundamental principle of copyright. It is in fact regarded as the basis of the protection given by the law of copyright to particular forms of expression.⁷

4

7. Lahore: **Op. Cit**, page 81

8. Holmes Vs. Hurst 174 U.S. 82, 19 SC 606 (1899)

9. (1916) 2 Ch.d. 601 at 608; see page 3 Intellectual Property Case Books (Copyright) edited by Professor W.R. Cornish.

Originality in this regard, however, does not connote originality of ideas, concepts, facts or opinions. Copyright exists only in the form in which these are expressed such as written words, musical notation, drawings and so on⁸. As stated by Mr. Justice Brown of the U.S. Supreme Court :

“The right thus secured by copyright Act is not a right to the use of certain words, because they are the common property of the human race, and are as little susceptible of private appropriation as air or sunlight; nor is it the right to ideas alone, since in the absence of means of communicating them they are of value to no one but the author. But the right is to that arrangement of words, which the author has selected to express his idea... The subject or property is the order of words in the author’s composition, not the words themselves, they being analogous to the element of matter, which are not appropriated unless combined, nor the ideas expressed by those words, they existing in the minds alone which is not capable of appropriation”⁹

However, originality does not require that the idea expressed in the work be necessarily novel or new, it being sufficient that the author contribute something more than a mere trivial variation, something recognizably his own. In the words of Peterson J. in University of London Press Ltd. V. University Tutorial Press Ltd.:¹⁰

“The word original does not in this connection mean that the work must be the expression of original or innovative thought. Copyright Acts are not

5

11. Copinger and Skone James on Copyright – 1st Edition para 116 at pg. 44.
12. Ibid.
13. Lahore Op. Cit. Page 38
14. 8 Fed. Cas. 615; Story U.S. Rep. 8/768 (1848)
15. (1923) 40 T.L.R. 186

concerned with the originality of idea, but with the expression of thought and in case of “literary work” with the expression of thought, in print or writing. The originality, which is required, relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work – that it should originate from the author.”

Where the author makes use of pre-existing material, it becomes necessary to determine whether he has employed sufficient independent skill and labour to justify copyright for his result.¹¹ According to Copinger and Skone James, in determining whether a work is original and entitled to copyright, the work must be looked at as a whole and if notwithstanding that the author has used existing material he has expressed sufficient independent skill and labour, he will be entitled to copyright protection for his work¹². Also, if an author “by using pre-existing material, produces a work such as an anthology, abridgement, directory, map or translation, his labour, skill and judgement must be such as to produce a work which has some quality which distinguishes it from the raw materials used, and it is this labour, skill and judgement which must not be appropriated by another¹³.

In this regard, the statement of Justice Storey of United State in Emerson Vs Davies¹⁴ adopted by Lord Atkinson in Macmillan & Co. Ltd. V. K. J. Cooper¹⁵ is instructive. According to Justice Storey:

6

“The work of the Plaintiff is in my judgement, new and original, in the sense in which these words are to be understood in the cases of copyright. The question is

not whether the materials which are used are entirely new and have never been used before or even that they have never been used before for the same purpose. The true question is, whether the same plan, arrangement and combination of materials have been used before for the same purpose or for any other purpose. If they have not, then the Plaintiff is entitled to a copyright, although he may have gathered hints for his plan and arrangements, from existing and known sources. He may have borrowed much of his materials from others, but if they are combined in a different manner from what was in use before..., he is entitled to a copyright In truth, in literature, in science and in art, there are and can be, few, if any, things which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow and use much which was well known and used before. No man, creates a new language for himself, at least if he be a wise man, in writing a book. He contents himself with the use of language already known and used and understood by others. No man writes exclusively from his own thoughts, unaided and uninstructed by the thought of others. The thoughts of everyman are more or less a combination of what other men have thought and expressed, although they may be modified, exalted, or improved by his own genius or reflection. If no book could be the subject of copyright which was not new and original in the element of which it is composed there could be no ground for any copyright in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence It is a great mistake to suppose, because all the materials of the work or some parts of its plan and arrangements and modes of illustration may be found

7

16. *Supra*

17. Per Peterson J. at pg. 609 of the report.

18. See Section 126 Copyright Act.

separately, or in a different form or in a different arrangement in other distinct works, that therefore, if the plan or arrangement or combination of these materials in another work is new, or for the first time made, the author or compiler, or framer of it (call him what you please) is not entitled to copyright”.

In considering the originality of a work, the brevity of the time used in producing it is immaterial. In the *University of London Press Ltd. Vs. University Tutorial Press Ltd.*¹⁶ It was suggested that the time spent in producing the work amongst other things should be a test for subsistence of copyright. Dismissing this view, Peterson J. said:

“If time expended is to be the test; the rapidity of an author like Lord Byron in producing a short poem might be an impediment in the way of acquiring copyright; and, the complete his mastery of his subject; the smaller would be the prospect of the author’s success in maintaining his claim to copyright”¹⁷

In addition to a work being original, the copyright Act also requires that it be fixed in any definite medium of expression from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of any machine or device¹⁸. As can be gathered from the above. Copyright does not subsist in ideas or thought. For a work to attract copyright protection, it must have been reduced to one form of concrete expression or the other.

Furthermore, for a work to qualify for copyright, it must have been produced by a qualified person under S. 2(1) or it must have originated in Nigeria in

8

19. Schedule 1 Copyright Act and S. 2(2)(3)(4)

20. *Ibid.*

21. See S. 10(3) Copyright Act.

accordance with Section 3 or must have been made by or under the direction or control of Government or a state authority in line with Section 4 of the Copyright Act.

The rights afforded by Copyright is subject to temporal limitation. For this purpose, copyright works are broadly categorized into two by the Act. The first category has literary, musical or Artistic works. Here, copyright runs for the life of the author plus seventy years from the end of the calendar year in which he dies. In case of government or corporate bodies, Seventy years after the end of the Calendar year in which the work was first published.¹⁹ The second category has cinematograph films, photographs, sound recordings and Broadcasts. Here copyright runs for fifty years from the end of the calendar year in which the work was first published, recorded or broadcast.²⁰

Subject to the exceptions stated therein, initial ownership of copyright is vested by Section 9 of the Act in the author of the work. S 10 of the Act makes provisions for transfer of copyright either by transmission, testamentary disposition or by operation of law as a movable property. However, no assignment of copyright and no exclusive licence to do an act the doing of which is controlled by copyright shall have effect unless it is in writing²¹ though no specific form is prescribed.

22. Ss. 5, 6 & 7 of the Copyright Act Cap. 68 LFN 1990

23. See Generally also 16, 17, 18, 19, 22 of the Act for various Civil and Criminal remedies.

The nature of the right afforded by copyright under the Act is stated in Sections 5, 6 and 7 of the copyright Act. Basically, it is an exclusive right to control the doing or to authorize the doing of certain things in Nigerian in relation to the copyright work. These include the reproduction, publication, performance, exhibition for sale or otherwise of the copyright work among others.²²

However, certain exceptions are created in derogation from the rights afforded by the above provisions in the 2nd and 3rd Schedules to the Act. Notable among these exceptions is fair dealing for purposes of research, private use, criticism and review or the reporting of current event. In other words, the right to copyright afforded by the Act is not absolute.

S. 14 of the Act set out elaborately what constitute an infringement of copyright whilst S. 15 provides that an infringement of copyright shall be actionable at the suit of the owner, assignee or an exclusive licensee of the copyright, as the case may be, in the Federal High Court exercising jurisdiction in the place where the infringement occurred and in an action for such an infringement, all such relief by way of damages, injunction, accounts or otherwise shall be available to the Plaintiff as is available in any corresponding proceedings in respect of infringement of other proprietary rights.²³

24. See W.R. Cornish Op. Cit para 14 – 08 pg. 487
25. Section 1(1)(A) & (B) Patents and Design Act.
26. See Section 4 & 5 Patents & Design Act Cap 344 LFR 1990
27. Section 7

2. PATENTS & DESIGNS

The primary source of the laws on patents and Designs in Nigeria is the Patent and Designs Act Cap 344 laws of the Federation of Nigeria 1990. Under the Act, Sections 1 to 11 are devoted exclusively to Patent whilst Sections 12 –22 are devoted exclusively to Designs. The rest of the Act deals with matters common to the two concepts.

Patents and Designs are distinct concepts, but they share many common features. It is this affinity between the two concepts and the rights afforded and protected by them that is conceivably responsible for their joint administration in many commonwealth jurisdictions. For instance, as far back as 1875, the administration of Patens and Designs have been the responsibility of the Patent office in England.²⁴

Basically, Patents are granted in respect of inventions, that is technological improvements (great and small) which contains some Scintilla of inventiveness over what is previously known. In Nigeria, an invention must be capable of industrial application before it can qualify for patent protection.²⁵

Unlike copyright, which automatically attaches to any qualified work, a Patent is granted by a State authority – Registrar of Patent - after a substantial examination as to its validity²⁶. It is also granted for a maximum period of 20 years from date of filing of the relevant Patent application²⁷ and requires that the innovation be publicly described in the Patent Specification.

28. W.R. Cornish Op Cit para 1 – 05 pg 6 see also S.6 Patent & Design Act.

29. Section 2 Patents & Designs Act.

30. See Section 9 of Patent & Design Act.

The right afforded by a Patent is to prevent all others - not just imitators-but even independent devisers of the same ideas – from using the invention for the duration of the Patent ²⁸

However, under the Act, right to patent is vested in the person who is first to apply for patent whether or not he is the true inventor, though there are safeguards against fraudulent applications²⁹

Any interested party may apply to Court for the nullification of any patent on the ground that the invention is not patentable or the description of the invention fails to conform with Section 3(2) of the Act³⁰

With respect to registered Designs on the other hand, the Act provides that any “combination of lines or columns 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 tested result ³¹

The origin of designs registration dated back to the earliest period of industrialisation in some part of textile industry in England. The real impetus towards the modern system came in 1830s. The poor quality of British industrial design particularly when compared with the achievement

31. Section 12 Patent & Design Act.

32. W.R. Cornish Op. Cit. Para 14.08 pg 486

33. S. 15, 16 & 17 Patents & Designs Act.

of the French incited the middle class radicals to press for a system of training designers and manufacturers to demand for more substantial legal monopoly, the result was a form of head-start protection³²

Here as in patent one of the basic requirement is that the design must be capable of industrial application. This requirement is understandable in view of the fact that these concepts represent monopolies granted in a market economy for the limited purpose of motivating industrial advancement.

Like Patent but unlike copyright, an industrial design requires registration with a state authority after satisfaction of certain conditions by the applicant.³³ Foremost among these conditions are novelty and compatibility with public order and morality³⁴

Registration of an industrial design confers upon the registered owner the right to preclude any other person from reproducing the design in the manufacture of a product, importing, selling or utilizing for commercial purpose a product reproducing the design or holding such a product for the purpose of selling it or of utilising it for commercial purposes.³⁵

34. S. 13 Patents & Designs Act.

35. S. 19 Patents & Designs Act.

36. S. 20

37. S. 21

By virtue of S. 14, right to registration is vested in the person who is first to apply for registration called the Statutory Creator regardless of whether or not he is the true creator.

A registered design can only subsist for a maximum period of 15 years from the date of application for registration. The initial period is five years renewable for two consecutive periods of five years each³⁶. Right conferred by registration may be renounced by the owner at any time before its expiration³⁷. Furthermore, any interested party may apply to court for nullification of the registration under S. 22 of the Act.

S. 27 of the Act allows a Nigerian applicant for registered Patent or Design to rely on a prior date in respect of corresponding application in any commonwealth country³⁸

Both Patent and registered design may be licenced.³⁹ Rights in any application for registration of Patents and Designs as well as right to registered Patent and Design can be transferred by assignment or transmission⁴⁰

Licence, assignment and transmission by succession must be registered.

38. For list of Countries qualified as Convention Country presently see Patent and Design (Convention Countries) Order made pursuant to Section 27 of the Patents & Designs Act. Laws of Federation 1990. Though the list is not close as the minister has the Power to extend the list as circumstances demands. See Generally S. 22.

39. S. 123

40. S. 24

3. TRADE MARK & TRADE NAMES.¹⁴

The Law of Trade Marks and associated rights focuses attention on rights long associated with intellectual property, which nevertheless are concerned with methods of promoting and selling goods and services. The purpose of legal intervention here is to give protection to information but trade marks, names and such other symbols have less finite character than the information protected by patent, designs and copyrights. In an economy where most goods and services come from competing enterprises, trade mark owners typically use their marks to distinguish their products and services from others on offer. Their hope is that this will create an association in consumers' minds between origin and good value. Trade marks and names are accordingly quite as significant in economic terms as patent and copyright and their impact across industry is far wider⁴¹.

In the English case law, demands for legal protection against the imitation of marks and names were being made and acceded to from the early years of industrialisation. The courts of equity took the lead because Plaintiffs wanted injunctions. They intervened when one trader represented to the public that he was selling the goods or carrying on the business of another⁴². Soon afterwards, similar actions for damages at Common Law are found, the action on the case for deceit being held to lie at the instance of a competitor.⁴³

Nevertheless, English traders kept up pressure to have the protection of trade marks made more secure. In 1875, the campaign for a registration system succeeded so far as marks for goods were concerned, but it was not immediately clear whether the registrable types of marks could be protected only after registration.

However, the judges were sympathetic to the view that goodwill acquired through actual trading should have the first call on legal protection. Common Law and equity were held

41. W. R. Cornish para 15-01 pg 515

42. *Blanchard vs Hill* (1742) 2A+K 485 per Lord Hardwick L. C.

43. *Sykes vs Sykes* (1824) 3 B & C 541.

still to give relief against passing off, even if it was effected through imitating a mark that might have been registered.

From the initial adoption of a registration system in 1875, the British approach has been to treat Common Law protection and registration cumulatively, the common law giving root protection wherever trading reputation justified it and registration providing surer, more straightforward, protection when an official grant had been secured⁴⁴.

As in other area of intellectual property law, Nigerian law of trade marks is heavily derived from the English experience. Apart from the Common Law torts of passing off and injurious falsehood which form part of Nigerian law by virtue of Section 24 of the Interpretation Act 1964 and similar enactments, the Trade Mark Act 1967 which form the primary enactment in this area of law was based upon the English Trade Mark Act 1938. The 1967 Act has now been reproduced as Cap 436 in the 1990 reprint of the Laws of the Federation. Under the Act, the Common Law protection by passing off or similar tools and registration are treated cumulatively. By Section 3 of the Act, no person shall be entitled to institute any proceedings to prevent or to recover damages for, the infringement of an unregistered trade mark, but nothing in the Act shall be taken to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

Furthermore, section 7 provides that nothing in the Act shall entitle the proprietor of a trade mark to interfere with or restrain the use by any person of a trade mark, identical with or nearly resembling it in relation to goods in relation to which that person has continuously used that trade mark prior to the use or registration of the proprietor and neither can the proprietor object to the registration of the prior user notwithstanding S13(2) which precludes registration of identical marks.

44. W. R. Cornish Par. 17-01 pg 569

It is apparent therefore, that registration under the Act does not confer an absolute right as Common Law right continue to enjoy recognition under the Act.

For the purpose of registration, the register of trade mark is divided into part A and Part B. For a mark to qualify for registration in Part A, it must satisfy the requirement of distinctiveness as set out in Section 9 of the Act whilst a mark for registration in Part B must meet the test of capacity to distinguish prescribed in Section 10 of the Act. The Registrar of trade marks is given power to classify goods into various classes and to decide into which class an application falls. His decision in this regard is final.⁴⁵ A mark must be registered in respect of specific goods or class of goods. Section 11 to 13 of the act define the limitation on the categories of marks that are registrable under the Act. Any of the grounds contained in these sections may be made the ground of opposition to registration under Section 20 or rectification proceedings under Section 38 of the Act.

By Section 18 of the Act, any person claiming to be the owner of a trade mark used or proposed to be used by him and who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration in Part A or Part B and Registrar has the discretion to register though his decision in this regard is subject to appeal to the Federal High Court.

There is also provision for pre- as well as post-acceptance of publication in the trade mark Journal under Section 19. Section 20 and 21 prescribe the operative procedure before the Registrar as well as appeal to the Court. When registered, a trade mark is deemed registered from the date of application for registration⁴⁶ and enures for an original period of 7 years, which is renewable from time to time for consecutive periods of 14 years. For the purpose of priority, Section 44 provides that any person who has applied for protection for any mark in a convention country shall be entitled to

45. S. 4 of the Act

46. S. 4-22 of the Act.

registration of mark under this Act in priority to other applications and the registration shall have the same date as the date of the application in the convention country in so far as the application under this Act is made within six months of the application in the convention country. A convention country is defined in subsection (5) of Section 44 of the Act.

A registered trade mark may be assigned or otherwise transmitted⁴⁷ and such assignment or transmission is to be registered, the consequence of non registration being that no document relating to such assignment or transmission shall be admissible in evidence in proof of title to a registered mark unless the court otherwise directs.

A licensee of trade marks may also be registered under sections 33 and 34 of the Act. Also a registered user and such a licensee may sue to protect the mark in his own name if the owner refuses or neglects to do so within two month of his being called upon to do so.⁴⁸

Section 43 of the Act also provides for the registration of certification marks in respect of marks adapted in relation to any goods to distinguish, in the course of trade, goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristics from goods not so certified. Such registration is restricted to Part A of the register.

In exercising his discretionary powers under the Act, the Registrar is enjoined to observe the rule of fair hearing⁴⁹ and most of his decisions are appealable to the Federal High Court⁵⁰.

47. Section 26 of the Act

48. 33 (4) of the Act

49. S. 46 of the Act.

50. See power of FHC in dealing with Court of Appeal S. 55 of the Act.

Certificate of registration is a **prima facie** evidence of validity not only of the original registration but also of all subsequent assignments and transmissions of such mark.

REMEDIES FOR INFRINGEMENT OF INTELLECTUAL PROPERTY RIGHTS.

The precise value of a right must be measured in terms of the remedies that lie for its infringement. The range of reliefs provided by law for the protection of property is wide and that is one of the most significant consequences of characterising patents, copyrights, trade marks and the like as properties⁵¹.

We shall here deal with the forms of reliefs available to the owner of intellectual property rights and with a variety of procedural factors affecting their enforcement. Although there are distinctions between the specific fields, there is enough common ground to justify treating them together.

By section 15 (1) of the copyright Act, infringement of copyright shall be actionable at the suit of the owner, assignee or an exclusive licensee in the Federal High Court and in any action for such an infringement, all such reliefs by way of damages, injunction, accounts or otherwise shall be available to the Plaintiff as is available in any corresponding proceedings in respect of infringement of other proprietary rights. There is a corresponding provision in Section 25(2) of the Patent and Designs Act.

However, nowhere in the Trade Marks Act is there express provision similar to those in section 15 of the Copyright Act and section 25 (2) Patent and Design Act. It may well be that this omission is deliberate. Equity and Common Law have long treated trade marks as “Property” and have protected them as such in terms of reliefs provided against infringement. In other words, trade marks and names have crystallised into “Property”

19

51. W. R. Cornish **Op. Cit** para 2-27 pg 54.

with the torts of passing off and injurious falsehood as weapons of protection long before the concept of registration of trade marks emerged⁵².

On the other hand, copyright, patent and designs are relatively recent concepts and the need to expressly make provision as to their proprietary status may be justified.

Generally, remedies against infringement of intellectual property rights can be categorised into two, to wit: Civil and Criminal.

As regard criminal remedies, the law on each of these rights creates a variety of offences directed against infringement of the relevant right. For instance sections 18, 19 and 20 of the Copyright Act create certain offences directed against different mode of infringement of copyright and prescribe penalties for those offence. Section 12 provides that Criminal and Civil proceedings may be pursued simultaneously. This was meant to be an exception to the rule in Smith vs Selwyn⁵³ in relation to priority of Criminal proceedings.

Similar provisions are contained in Sections 60 and 61 of the Trade Marks Act. However, a Criminal proceeding being a contest between the state and the accused is of limited practical value to the intellectual property right owner.

CIVIL REMEDIES

DAMAGES

One of the more common remedy for infringement of intellectual property right is a claim for damages in a Civil action either solely on in conjunction with other remedies. By an action in damages, the right owner seeks to recover the money he has lost by the infringer's act. The measure of damages is thus the depreciation caused by the infringement to the value of the right in question in terms of what the owner has suffered

52. W. R. Cornish Op. Cit para 15-05 pg 517

53. (1914) 3 K.B 98

by reason of diminution of the sales or the loss of profit which he might otherwise have made.

The basis for calculation of damages, however, is not hard and fast. For instance, damages for infringement of copyright had been held to be at large as far back as 1914 in *Fenning Film Service Vs Wolverhampton Cinemas*⁵⁴ In the case of *Plateau Publishing Co Vs Chief Chucks Adopy*^{54b}, another copyright case, an award of damages which had no direct relevance to any ascertainable economic indices was made by the High Court and though considered to be on the high side by the supreme Court was left undisturbed.

The basic aim of an award of damages is to compensate the Plaintiff for the harm caused by the legal injury complained of and not from some other cause.⁵⁵ There must be a direct causal connection between the injury and the damages.

In the case of breach of contract, damages generally seek to put the Plaintiff in the position that he would have occupied had the contract been performed and he may recover damages for profits anticipated by him for the contract.⁵⁶ Damages in tort aim to put the victim back to his position before the tort.⁵⁷ If a tortious act is also a breach of contract, the law allows the claim to be put on either basis but not on the two together.

As a general rule, exemplary damages may not be awarded to punish the defendant for wrongful conduct however aggressively or insultingly deliberate. But there is an exception where the defendant's conduct has been calculated by him to make profit for himself which may well exceed the compensation payable by him to the Plaintiff for "it is necessary for the law to show that it cannot be broken with impunity".^{57(b)}

54. (1914) 3 K.B. 1171

54(b) (1986) 4 NWLR pt 36 pg 265

55. *United Horse Shoe vs Stewart* (1888) R.P.C. 260 at 267

56. See *Chity on contract* (27th ed. 1994) vol. 1 par 1551 etseq.; *McCreyor on Damages* (15th edition 1988) 24-47, pg 175-207.

57. *Clerk and Landsell on Torts* (17th edition 1995) para 27-04

57(b) *Rookes vs Bernard* (1964) A.C. 1129 at 1221-1231 per Lord Diplock

S 15(4) of the copyright Act provides that where, having regard to the flagrancy of the infringement and the benefit shown to have accrued to the defendant by virtue of the infringement and the measure of damages that can be conventionally awarded is regarded as inadequate, the Court has a discretion to award any amount as additional damages it might deem adequate in the circumstances of the case. S (17)(3) of the English Act which is **impari materia** with our S 15(4) was applied in the case of Williams Vs Settle⁵⁸ to award additional damages in favour of a Plaintiff against a Photographer defendant on the ground that the photographer's infringement of the Plaintiff's copyright was most flagrant and a demonstration of lack of feeling and sense of family dignity and pride.

There is no such express, provisions in respect of other intellectual property rights, though recourse may be had to the common law in an appropriate case to award additional damages.⁵⁹

Ordinarily, rights that rank as common law property are enforceable even against those unwittingly interfering with them⁶⁰. However, by virtue of Section 15(3) copyright Act an exemption is made from liability to pay damages is granted in favour of an infringer who was not aware and had no reasonable grounds for suspecting that copyright subsisted in the work to which the action relates⁶¹. The burden of proving innocence here lies on the Defendant. It is an extremely heavy burden as copyright subsists without registration formalities. It will be difficult to prove that the work was reasonably thought to be out of copyright⁶².

58. (1960) 1 WLR 1072

59. Rooks V. Bernard (Supra) Cassell V. Broome (1972) A.C. 1027 H.L Morton Norwich V. Intercom (No. 2) [1981] FSR 337.

60. W.R. Cornish **op cit** para 2-41 p. 62.

61. See Plateau Publishing V. Adoph for the application of this provision.

62. Roibini, Callender, Smith, press law: Sweet & Maxwell 1978 pg. 266.

ACCOUNT OF PROFIT

This is an equitable remedy. The Defendant is ordered to account to the plaintiff for profits made from wrongdoing such as the infringement of an intellectual property right⁶³. This is not a notional computation as with damages but an investigation of actual accounts and thus a personal remedy against unjust enrichment⁶⁴. The right owner here will be claiming the amount of profit made by the infringer. Of all the practical remedies, this is the most useful in monetary terms because the right owner is entitled to infringer's profit even though the infringer was unaware that the right existed. The principles upon which such an account is granted in relation to copyright were stated by Wigram V-C in *Colburn V. Simms*⁶⁵ thus:

“It is true that the Court does not, by account, accurately measure the damage sustained by the proprietor of an expensive work from the invasion on his copyright by the publication of the cheaper one. The Court, by account, as the nearest approximation which it can make to justice, takes from the wrongdoer all the profit he has made by his piracy and gives them to the party who has been wronged. In doing this the Court may often give the injured party more, in fact, than he is entitled to, for non-constant that a single additional copy of the more expensive book would have been sold, if the injury by the sale of the cheaper book had not been committed. The court of equity, however does not give anything beyond the account”.

Nonetheless, account is a labourious and expensive procedure and is infrequently resorted to. Though attractive, it is highly susceptible to the problem of proof.

63. This was treated as accepted by Lord Eldon L.C in *Higg V. Kirby* (1803) 8 Ves. Jun 215 at 223

64. *A.G.V. Observer* (1990) 1 A.C 109 at 262, 265 – 267, 293 – 294

65. (1843) 12 L.J.Ch 388.

DELIVERY UP

This is also an equitable remedy. In order to ensure that injunctions are properly effective, courts of equity and their successors maintain a discretion to order delivery up of infringing articles or documents for destruction, or else to require their destruction under oath by the defendant, or some equivalent step such as erasure of a trade mark.”⁶⁶

Section 16 of the copyright Act provides that the owner of the copyright shall be regarded as if he were the owner of the infringing copies as well as materials and equipment used for the infringement. In other words he is regarded as if he is the owner of the infringing article. Therefore, he can exercise the option under the statute to ask for delivery up as well as claim for consequential damages for conversion.

It is not, however, extremely clear whether the delivery up is an alternative or commulative remedy with a claim for damages in conversion. It appears from the use of the word “or” in the Section that the remedies are alternative. It is submitted however, that in the interest of efficacy and to properly compensate the right owner, the remedies should be treated as cumulative. In any event, the use of the word “or” is not conclusive as there have been cases where it has been construed conjunctively.⁶⁷ Furthermore, the tort of conversion is committed once there is a willful interference without lawful justification with any chattel in a manner inconsistent with the right of the owner, whereby that owner is deprived of the use and possession of it”⁶⁸. Therefore, recovery of possession of the goods should not preclude the right owner from claiming damages in respect of the act of deprivation and for whatever period it may have lasted.

66. W.R Caransh Op cit para. 2 – 37 pg 60

67. Eze V King

68. Salmond and Henston on the law of Torts (19th Edition) S. 30 pg 108

INJUNCTION

Another remedy and perhaps the most important in the field of intellectual property law is the order of injunction. This is an order of Court directing a party to litigation to do or refrain from doing an act.⁶⁹ Willfully to disobey is contempt of court punishable by fine, imprisonment or sequestration of assets.⁷⁰ Sequestration is the form of punishment most appropriate to contempt by a company⁷¹.

An Injunction may be interlocutory or final. It may be in a mandatory form commanding the doing of a positive act or restrictive or negative or prohibitive commanding the party enjoined to refrain from doing certain things. The order may restrain a company by its directors, employees or solicitors from doing the prohibited act, the latter and any others who deliberately engage in the conduct will be liable in contempt⁷². Any other person may be enjoined either by himself, his agent, servants and/or privies etc. This is to guarantee the efficacy of the order and forestall a circumvention of the order⁷³.

A final or perpetual order of injunction is one that is granted after the establishment of the relative right of the parties at the conclusion of litigation. It is often said to be subject to two considerations: viz: “It lies in the discretion of the court and it is available at the instance of a private litigant only if he has some proprietary right or interest to protect”.⁷⁴ On the other hand, an injunction granted before trial can either be interim or interlocutory. The distinction between these two forms of injunction was drawn by the Supreme Court in the case of *Kotaye Vs Central Bank of Nigeria (C..B.N)*⁷⁵ According to *Nnamareka Agu JSC* ⁷⁶.

69. W.R. Cornish para. 2 – 31 pg 55

70. *Director General of Fair Trading v. Smith’s Concrete* [1991] 4 All ER 150 C.A.

71. *Hospital for Sick Children v Walt disney* (1968) ch. 752 C.A.

72. *A.G. V. Newspapers Publishing* (1987) 3 All ER 276 C A *Chelsea Man v. Chelsea Girl* (No. 2) [1988] F.S.R. 217

73. The draft Order in the judgement of Templeman J. in **EMI LTD. V. Pandit (1975) 1. ALL ER Pg 418 at 424 para f.**

74. W.R. Cornish Op. Cit para. 2 – 26 pg 59

75. *Kotoye V. CBN.* [1989] NWLR Pt. 98 pg. 419.

76. *Infratum* pg 440 and 441 of the report.

“I think it is correct to say that “ex parte” in relation to injunction is properly used in contradistinction to “on notice” and both expressions, which are mutually exclusive, more strictly rather refer to the manner in which the application is brought and the order procured. An Applicant for a non-permanent injunction may bring the application **ex-parte**, that is without notice to the other side or with notice to the other side, as is appropriate. By their very nature, injunction granted on ex-parte application can only be properly interim in nature. They are made without notice to the other side, to keep matter in **status quo** to a named date, usually not more than a few days, or until the respondent can be put on notice. The rationale for an order made on such an application is that delay to be caused by proceedings in the ordinary way by putting the other side on notice would or might cause such an irretrievable or serious mischief. Such injunctions are for cases of real urgency. The emphasis is on ‘real’.

And at page 441 his Lordship continues: “on the other hand, even though the word interlocutory comes from two Latin words “inter” (meaning between or among) and “locutus” (meaning spoken) and strictly means an injunction granted after due contest inter parties, yet when used in contradistinction to interim in relation to injunctions, it means an injunction not only ordered after a full contest between the parties but also ordered to last until the determination of the main suit. Applications for interlocutory injunction are properly made on notice to the other side to keep matters in status quo until the determination of the suit.”

Further, in the case of **7^{UP} Bottling Company Ltd. & Ors Vs Abiola & Sons Ltd.**⁷⁷, the full court of the Supreme Court had this to say about the two types of **pre trial** injunctions:

77. [1995] 3 NWLR Pt. 383 pg. 257.

“There was a real misconception and some confusion on the part of the appellants. The appellants, somehow, did not distinguish between an interim injunction and an interlocutory injunction and for that reasons did not recognise the difference between the purpose for which an interim injunction is granted and the purpose for which an interlocutory injunction is granted. The result was that, in the appellant’s brief, authorities relating to an application for an order of interlocutory injunction were being cited freely in support of contention being made in relation to an order of interim injunction as if an interim injunction was the same thing as an interlocutory injunction. That should not be so. It was the aforesaid misconception on the part of the appellants that led to the erroneous submission in their brief that in the present case it was not necessary to make any distinction between an interim injunction and an interlocutory injunction. An order of interlocutory injunction is one made pending the determination of a pending suit. Obeya Memorial Hospital V A.G. Federation (1987) 3 NWLR (Pt. 60) 325, Ojukwu Vs. Governor of Lagos State (1986) 3 NWLR (Pt 26) 39 and Kotoye Vs. Central Bank of Nigeria (1989) 1 NWLR (Pt 98) 419. An interlocutory injunction cannot generally be granted without giving prior notice of the application to a respondent and the order cannot be made behind the respondent in view of the fact that the court has to decide many things before it can properly come to a conclusion on the question of whether to grant or refuse it. Further and this is very important, a grant of an application for an interlocutory injunction without notice to the respondent or behind the respondent is void by virtue of the provision of section 33(1) of the Constitution.

An order of interim injunction is one granted to preserve the status quo and to last until a named date or definite date or until further order or pending the hearing and determination of a motion on notice. It is for a situation of a real emergency to preserve and protect the rights of the parties before the court from destruction by either of the

parties Kotoye's case, supra. It merely leaves matters in status quo and the court does not, at that stage, have to decide any contentious issues before granting it."

By virtue of the statutes governing the different courts in Nigeria, these Court especially the High Courts (States and Federal) as well as the Court of Appeal and the Supreme Court have the power to grant an injunction in addition to or in substitution for any other remedy as the circumstance may require.⁷⁸

The most important civil remedy available to the victim of intellectual property right infringement is an injunction restraining the infringer from ever repeating the infringement. However, it has been found in practice that the valuable injunctive remedies available are those used in interlocutory proceedings before the trial. Such orders include orders for interim injunction, detention of infringing articles, the Mareva injunction detaining the property of the infringer within jurisdiction to ensure that it is available to satisfy award of damages when eventually made and mandatory order of **Anton Pillar** compelling the infringer to allow ingress into his premises for the purpose of the Plaintiff securing concrete evidence of his infringement in order to aid the court in arriving at a just award of damages. Of all those injunctive remedies, the Anton Piller has proved to be the most efficacious, and has indeed become an indispensable tool of the intellectual property rights lawyer in the pursuit of his client's remedies"⁷⁹

It is the Anton Pillar Order which is the primary subject of this paper and to it, we now turn.

78. See for instance – High Court law of Lagos State, Federal High Court Act, Court of Appeal Act, Supreme Court Act.

79. Obatosin Ogunkeye **op cit** pg 109

ANTON PILLAR ORDER

The Anton Pillar order is an order by the Court requesting the Defendant to permit the Plaintiff and his solicitors together with any other person specified in the order to enter the defendant's premises and search for any evidence of infringement to be found therein. The order may also ask the defendant to permit the infringing articles or any evidence to be seized or copies thereof to be made in case of documents.

This order is most often made in patent, copyright and passing off actions. This power can be invoked on an ex parte application in those rare instances where a Plaintiff can show an extremely strong prima facie case that the damage, potential or actual, is very serious for the applicant, that the defendant has in his possession incriminating document and things and that there is a real possibility that he may destroy such material before an application inter partes can be made. When such an application is made, the court sits in camera since it is of the essence of the relief sought that the defendant should not have advance knowledge of the application or Court Order and so have an opportunity of destroying the relevant material.^{80(a)}

The overwhelming majority of cases on Anton Pillar injunction are intellectual property cases. This state of affairs, however, is produced more by necessity than by coincidence. "The remarkable advancement in information storage and copying technology... have made piracy and counterfeiting a major and highly unscrupulous trade in many parts of the world, as well as inducing unauthorised reproduction on a very considerable scale in enterprises, organizations and the home. The challenges to intellectual property rights at so many levels has prompted the courts to expand their repertoire of civil procedures, increasing the range and severity of criminal law in this field. To give one Plaintiff a more effective method of proceeding is to give it to all who can claim to be in comparable case".^{80(b)}

80(a) The Supreme Court Practice (the White Book) 1993 Vol. 1 para 29/2 –3/6 at page 531
80(b) W.R. Cornish Op Cit. Para 2 – 20 at page 41.

The evolution of Anton Pillar injunction can be regarded as the product of the effort of English judges to meet the challenges confronting the modern intellectual property law.

Unlike the various remedies we have considered so far, an Anton Piller Order belongs to a class of its own. It is more than a remedy especially in view of the state and the manner of its intervention. It is a secrete weapon which attacks an infringer before he knows it, preventing him from destroying or otherwise dispose of evidence and compelling him to disclose his source of supplies as well as the channels of his own distribution.

Anton Pillar order is relatively recent in the firmament of injunctions. The first reported decision on it was that of Templeman J in EMI V Pandit^{80(c)} where the learned trial judge attempted to consider the various ramifications of the new effort of English judges at applying existing law to new circumstances.

EMI's was a case where the Plaintiffs, who owned the copyright in certain sound recordings of Indian music brought an action against the defendant claiming injunctions restraining the defendant from infringing their copyright and from passing off, an order for delivery up of infringing material, an order requiring the defendant to give discovery of suppliers and customers of infringing material, an order for production of documents and finally damages for infringement of copyright, passing off and conversion.

Before trial, the Plaintiffs applied ex parte for an order that such persons as might be duly authorised by the Plaintiff be at liberty to enter the defendants' premises between specified hours for the following purposes: inspecting and photographing prerecorded tapes and other infringing materials, invoices, bills and other documents and correspondence which were relevant to the action; removing infringing articles, and inspecting, photographing and testing typewriters, since the plaintiffs suspected that the

80(c) Supra

typewriter which had been used to carry out the alleged forgery was one belonging to the defendant which might still be on the premises. The Plaintiffs were apprehensive that if they served notice on the defendant of the application as required under the rules, he would destroy, or remove from the premises all relevant documents and articles and that the Plaintiff would be effectively debarred from obtaining further relief in the action.

After a brief survey of the applicable rules of court as well as judicial authorities Templeman J said at page 432 of the report: “From the terms of RSC Ord 29 and from the authorities which I have quoted, it seems to me that I have jurisdiction to make an order which will give these Plaintiffs substantially the relief which they seek I think it is right to stress that in my judgement, the kind of order, which is sought now, can only be justified by a very strong case on the evidence and can only be justified where the circumstances are exceptional to this extent, that it plainly appears that justice requires the intervention of the Court in the manner which is sought without notice, otherwise, the plaintiffs may be substantially deprived of a remedy. The order will only be granted on terms which safeguards the defendant, as far as possible, and which narrows the relief so far as might otherwise cause harm to the defendant In essence, the Plaintiffs are seeking discovery, but this form of discovery will only be granted where it is vital either to the success of the Plaintiffs in the action or vital to the Plaintiffs in proving damages. In other words, it must be shown that irreparable harm will occur, or there is a high probability that irreparable harm may occur to the Plaintiffs, unless the particular form of relief now sought is granted to them.”

As for the framing of the order, his Lordship said “ I shall then order” that the defendant whether by himself, his servants, agents or any of them or otherwise howsoever shall permit such persons not exceeding three as may be duly authorised by the Plaintiff and members or employees not exceeding two of the Plaintiffs’ solicitors to enter forthwith the premises known as (and then the address is given ...) or such parts

which is granted by this order. Then, the order continues by specifying purposes and the only purposes for which the Plaintiffs are to be allowed to enter the premises”

The Anton Pillar Order takes its name from the case *Anton Pillar K.G. v. Manufacturer Process Ltd.*⁸¹; the first reported case in which its use was sanctioned by the English Court of Appeal.

In the Anton Pillar case, the Plaintiffs were foreign manufacturers who owned the copyrights in the design of a high frequency converter used to supply computers. They learnt that the defendants, their English agent were to supply rival manufacturers with information belonging to the Plaintiffs which would enable their rivals to produce a similar product. The Plaintiffs wished to restrain the defendants from infringing the copyright using confidential information or making copies of their machines but they were afraid that the defendants, if notified would take steps to destroy the documents or would send them out of the jurisdiction so that there would be none in existence by the time the action reached the stage of discovery of documents. The Plaintiff accordingly made an ex parte application for an order requiring the Defendant to permit the Plaintiffs to enter the defendant’s premises in order to inspect, remove or make copies of documents belonging to the Plaintiffs. Brightman J. at the first instance refused to make the ex parte order. Granting the application on appeal, Lord Denning M.R. said at page 782 of the report:

“Let me say at once that no court in this land has any power to issue a search warrant to enter a man’s premises so as to see if there are papers or documents there which are of an incriminating nature whether libels or infringements of copyright or anything else of the kind. No constable or bailiff can knock at the door and demand entry so as to inspect papers or documents. The householder can shut the door in his face and say “get out”.

81. [1976] 1 All E.R. , 779.

That was established in the leading case of *Entick V Carrington*". None of us would wish to whittle down that principle in the slightest. But the order sought in this case is not a search warrant. It does not authorise the Plaintiffs' solicitors or anyone else to enter the defendants' premises against their will. It does not authorise the breaking down of any doors, nor the slipping in by a back door, nor getting in by an open door or window. It only authorises entry and inspection by the permission of the defendants. The Plaintiffs must get the defendants' permission. But it does this: It brings pressure on the defendants to give permission. It does more, it actually orders them to give permission with, I suppose, the result that if they do not give permission, they are guilty of contempt of court."

And at page 783 his Lordship continues: "One might think that with all these safeguards against abuse, it would be of little use to make such an order. But it can be effective in this way. It serves to tell the defendant that, on the evidence put before it, the Court is of the opinion that he ought to permit inspections – nay, it orders him to permit – and that he refuses at his peril. It put him in peril not only of proceedings for contempt, but also of adverse inference being drawn against him; so much so that his own solicitor may often advise him to comply. We are prepared therefore, to sanction its continuance, but only in an extreme case where there is grave danger of property being smuggled away or of vital evidence being destroyed"

As to the couching of the order, the court of Appeal approved the precedent as framed by Templeman J in *EMI V Pandit* case⁸².

Commenting on the nature of an Anton Pillar order, Brown Wilkistion J said in *Thermax Ltd. V. Schott Industrial Glass*⁸³ Ltd.:

82. (Supra) See page 784 para a-b of the report.

83. (1981) F.S.R. 259 at 291

“The procedure is vary obviously draconian in its results. It is quite rightly said that it is not a search warrant in the sense that if the defendant refuses to obey the order and allow the Plaintiff and his representatives to enter and search no force can be used against such defendant. But its effect is often very similar.

SOURCES OF JURISDICTION

The jurisdiction of the English Court to make this Order was founded upon S. 37 of the Supreme Court Act 1981⁸⁴ as well as Ord. 29 rules 1 & 2 of Rules of Supreme Court, England.^{84(a)}

S. 37 provides that “-(1) The High Court may by order (whether interlocutory or final) grant an injunction or appoint a receiver in all cases in which it appears to the Court to be just and convenient to do so.

- (2) Any such order may be made unconditionally or on such terms and conditions as the court thinks just.
- (3) The power of the High Court ... to grant an interlocutory injunction restraining a party to any proceedings from removing from the jurisdiction of the High Court, or otherwise dealing with assets located within that jurisdiction shall be exercisable in cases where that party is as well as in cases where he is not, domiciled, resident or present within that jurisdiction.”

“Order 29 provides:

1 – (1) An application for the grant of an injunction may be made by any party to a cause or matter, whether or not a claim for the injunction was included in that party’s writ, originating summon, counter claim or third party notice, as the case may be.

84. Replacing the Judicative Act 1925 S. 45

84(a) See the Survey of the authorities by Templeman J. in *Emi Vs. Pandit* (Supra).

- (2) Where the applicant is the Plaintiff and the case is one of urgency such application may be made **ex parte** on affidavit but, except as aforesaid, such application must be made by Motion or Summons.
- (3) The Plaintiff may not make such an application before the issue of writ or originating summons by which the cause or matter is to be begun, except where the case is one of urgency, and in that case the injunction applied for may be granted on terms providing for the issue of the writ of summons and such other terms, if any, as the Court thinks fit.”

In Nigeria, jurisdiction over intellectual property matters in the first instance is the exclusive preserve of the Federal High Court. By S. 251 of the Constitution of the Federal Republic of Nigeria, 1999 (the 1999 Constitution) “Notwithstanding anything to the Contrary contained in this constitution and in addition to such other jurisdiction as may be conferred upon it by an Act of the National Assembly, the Federal High Court shall have and exercise jurisdiction **to the exclusion of any other Court in Civil Causes and Matters-**

..... (f) any Federal enactment relating to Copyright, Patent, Designs, Trade Marks and Passing-off, Industrial Designs and Merchandise Marks, business name, Commercial and industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards” (underlining supplied). Incidentally, the various subject matter of intellectual property rights are contained in the exclusive legislative list of the 1999 Constitution.⁸⁵ Intellectual property matters are therefore subjects of Federal Legislations and thus within the exclusive jurisdiction of the Federal High Court at least with respect to civil actions!

85. See Item 13 and 43 in part 1 of the 2nd Schedule

The jurisdiction of the Federal High Court to make injunctive orders including ex parte Anton Piller orders can be found in S. 252 of the 1999 Constitution, S. 13 of the Federal High Court Act Cap 134 Laws of Federation of Nigeria 1990 (the Federal High Court Act”) as well as Order 34 rule 1 of the Federal High Court (Civil Procedure) Rules 2000 (Federal High Court Rules).

According to S. 252 (1) of the 1999 Constitution; “For the purpose of exercising any jurisdiction conferred upon it by this constitution or as may be conferred by an Act of the National Assembly, the Federal High court shall have all the powers of the High Court of a state.”

And by Section 13 of the Federal High Court Act “(1) the Court may grant an injunction or appoint a receiver by an interlocutory order in all cases in which it appears to the Court to be just or convenient so to do.

(2) Any such order may be made either unconditionally or on such terms and conditions as the Court may think just.”

Order 34 rule 1 of the 2000 Rules also states that: “(1) An application for the grant of an injunction may be made by a party to an action before or after the trial of the action, whether or not a claim for injunction was included in that party’s claim.

(2) Where the applicant is the Plaintiff and the Case is one of urgency, the application may be made ex parte on affidavit but except as aforesaid, the application shall be made by Motion on Notice or Summons.”

The High Court law of Lagos State contains similar provisions to those of the Federal High Court Act. Whilst commenting on the effect of the Lagos State High Court Law in relation to the grant of **Mareva Injunction**, a contemporary of Anton Piller Order Nnamaeka – Agu JSC said in **Sotiminu Vs. Ocean Steamship (Nig.) Ltd.**⁸⁶

‘Now Section 18 of the High Court Law of Lagos State provides as follows:

“(1) The High Court may grant ... an injunction ... by an interlocutory order in all cases in which it appears to the Court to be just or convenient so to do’

The type of injunctions over which the Court may exercise jurisdiction were not categorised or limited. Rather, the Court was in Section 10 conferred with the general jurisdiction, power, and authorities, which are vested in or capable of being exercised by the High Court of Justice in England. Also section 13 empowers the Court as follows:

“(13) subject to the express provisions of any enactment, in every Civil cause or matter commenced in the High Court, law and equity shall be administered by the High Court concurrently and in the same manner as they are administered by the High Court of Justice in England”

I am of the clear view that by the joint effect of sections 10, 13 and 18 of the High Court Law of Lagos States that, that court has jurisdiction and power to entertain and in appropriate cases, grant a Mareva injunction as was developed by the High Court of Justice in England in 1975. By section 16 of the Court of Appeal Act 1976, that court could in an appeal pending before it exercise that power.” **(Underlining supplied)**

Furthermore Section 13 and 18 of the High Court Law of Lagos State are **impari materia** with sections 10 and 13 respectively of the Federal High Court Act.

86. (1992) 5 NWLR pt 239 pg 1 at pg 226.

ANTOM PILLAR ORDER AND PRE-EXISTING LEGAL ORDER:

In view of the seeming novelty of the Antom Pillar Order of injunction, there is need to set its against the background of some well establish principles of our law particularly constitutional law as well as the law of evidence to see how compatible it is with those principles.

By virtue of Section 36 of the 1999 Constitution, in the determination of his Civil rights and obligations including any question or determination by or against any government or authority, a person shall be entitled to a fair hearing within a reasonable time by a Court or other tribunal established by law and constituted in such manner as to secure its independence and impartiality.

Section 37 of the same Constitution also provides that the “privacy of Citizens, their homes correspondences, telephone conversation and telegraphic communication is hereby guaranteed and protected”

The question is how compatible is an Antom Pillar Order which is necessarily **ex parte** and an invasion of privacy compatible with the above quoted constitutional provisions?

In justifying the grant of **ex parte** injunctions in **7-Up Bottling Co. Ltd. V. Abiola & Sons Ltd.**⁸⁷, the Supreme Court per Uwais JSC stated at page 280 of the report thus:

‘I wish to deal only with the constitutional issue raised by the appellants, Section 33 subsection (1) provides thus:

“33(1) In the determination of his Civil rights and obligations, including any question or determination by or against any government or authority, a person shall be entitled to a fair hearing within a reasonable time by a Court or other

87. *Supra*

tribunal established by law and constituted in such manner as to secure its independence and impartiality.”

..... there is no doubt that the right to fair hearing under the constitution is synonymous with the common law rules of natural justice

In both criminal and civil proceedings, there are certain steps to be taken which are incidental or preliminary to the substantive case. Such steps include motion for directions, interim or interlocutory injunctions. The time available for taking the steps may be too short or an emergency situation may have arisen. It, therefore, becomes necessary to take quick action in order to seek remedy for or arrest the situation. It is in respect of such cases that provision are made in the Court rules to enable the party affected or likely to be affected to make ex parte applications. The orders to be made by the Court, unlike final decisions, are temporary in nature, so that they do not determine the civil rights and obligations of the parties in the proceedings as envisaged by the constitution. If the Supreme Court can dispose of an application under section 213 subsection (4) of the 1979 Constitution without oral hearing of the application, then I see nothing wrong or unconstitutional for a trial Court to deal with an ex parte motion under its rules.’

In the same judgement, the Supreme Court per Wali J.S.C quoted with approval the statement of Achike J.C.A. while delivering the judgement of the Court of Appeal in the case when he said inter alia that “insistence on the observance of right of a fair hearing in relation to interim application made ex parte ought not to be pursued to the hilt. To my mind, since the status quo sought to be maintained inures to the interest of both parties and any damage to which the other party may be exposed consequent to the making of the interim ex parte order is fully guaranteed, and also mindful of the wide residuary inherent powers reserved to the Courts under Section 6 (6)(a) of the Constitution, it

seems to me that the powers of the Courts to grant interim **ex parte** orders thus confined within the safeguards of rules of Court and rules of practice ought not to be given a strict interpretation of being in conflict with the right to fair hearing. In my respectful opinion, that is a simplistic view of Section 33(1) of the Constitution. It is Counter-productive. Operating within safeguards against abuse, the court ought to sanction their continued powers to grant **ex parte** interim injunctions in deserving cases – only in extreme cases where there are imminent and grave dangers of the **res** being destroyed or disposed of in rather suspicious or unwholesome circumstances”

The Supreme Court had earlier confirmed the constitutionality of **ex parte** injunctions in the case of **Kotoye V. CBN**⁸⁸

It can therefore be said with some measure of confidence that Anton Pillar order which is a specie of **ex parte** injunctions is not incompatible with the fair hearing provision of the 1999 constitution.

As regards the right to privacy guaranteed by S 37 of the 1999 Constitution, it has always been stressed that Anton Pilla order does not authorise the Plaintiff to enter the premises of the defendant against the Defendant’s will. The Plaintiff can only enter if permitted by the Defendant. But the defendant runs the risk of being committed for contempt of Court if he refuses to permit entry.

Considering this aspect of an Anton Pillar order in the case of **EMI Vs Pandit**,^{88(a)} **Templem J** said at Page 421 and 424 of the report, that “whatever the justification and authority for such an order, I would be very slow to authorise what appears, at first blush, to be a trespass of property and invasion of privacy I am prepared, subject to authority and rules justifying this course and subject to suitable safeguards, to make an order on the defendant to allow the Plaintiffs to enter on premises in which he is in occupation for the

88. *Supra*
88(a) *Supra*

purpose specified by the Plaintiff, this order will not involve forcible entry but would make defendant liable for contempt proceedings if he disobeyed the order. An order in that form does not justify any unlawful entry. It imposes on the defendant a mandatory injunction ordering him to allow the Plaintiffs to enter. It limits the person who shall be allowed in to those whom counsel has satisfied me are necessary in the present case to inspect, identify and photograph infringing materials and other articles to which the Plaintiffs are entitled. It does not order an entry on premises unless they are in occupation or use by the defendant, so that the rights of other persons, who may be interested in the property are fully protected and, finally, it lays down reasonable hours for the exercise of the power which is granted by this order.”

In Anton Pillar K.G. Vs Manufacturing process⁸⁹, Lord Denning MR. Insisted that Anton Pillar order “only authorises entry and inspection by the permission of the defendants. The Plaintiffs must get the defendant’s permission”.

In view of the role played by the consent of the defendant in an Anton Pillar order, and the fact that a party has a perfect legal right to waive the right to privacy guaranteed in his favour by the Constitution, it can be said, technically at least, that Anton Pillar order does not derogate from and is compatible with the Constitutional right to privacy. The maxim here is volenti non fit injuria and a party who consented to the entry and inspection of his premises can hardly turn round to complain about such entry and inspection.

Tenuous as the consent argument is in relation to Anton Pillar order, it can still be justified on the ground of necessity.

There is an undoubted need for the court to sustain the order in the interest of efficacious administration of justice and this need is even more compelling in the field of intellectual property law where the efficacy of civil litigation depends on the ability of the Plaintiff to

89. (1976) 1 All E.R. 779

get hold of evidence before the defendant has the opportunity to secrete, destroy or otherwise dispose of such evidence to the everlasting prejudice of the Plaintiff.

The making of Anton Piller order in an appropriate case has also been held by the European Court of Human Right not to be in breach of Article 8 of the European convention on Human Rights which contains a guarantee of respect for private life and the home in the case of *Chappel Vs. United Kingdom*.⁹⁰

In certain cases, Anton Pillar order is made requiring the Respondent to disclose information as to sources of supply or customers, the names and addresses of persons he has had dealings with in pursuit of the illegal trade and also details of the trade. Since this information would in many cases furnish evidence of criminal conduct it had to run counter to the well established privilege against self incrimination.

Section 176 of the Evidence Act⁹¹ provides:

“No one is bound to answer any question if the answer thereto would, in the opinion of the Court have a tendency to expose the witness or the wife or husband of the witness to any criminal charge, or to any penalty or forfeiture which the judge regards as reasonably likely to be preferred or sued for ...”

An objection along this line to this aspect of Anton Pillar order was first upheld by the House of Lords in the case of *Rank Film Distributors Ltd. Vs. Video Information Centre*⁹² where the order applied for was refused by the Court. Also in *Tate Access Floors Inc. Vs. Bosswell*⁹³ *Sir Nicholas Brown– Wilkinson V-C* said:

90. (1989) F.S.R. 617

91. Cap 112 Laws of the Federation of Nigeria 1990.

92. (1980) A.C. 380; see also *Tate Access Floors Inc. Vs Bosswell* (1991) Ch 512 at 532.

93. (1991) Ch. 512 at 532.

“But if, as is likely to be too often the case, there is a real risk of a conspiracy charge, the judge will not be able to make an Anton Pillar Order at all and in consequence vital evidence will be destroyed”

Apparently, the privilege is available to those who run substantial privacy operations and so are likely to be charged with criminal offences.

In view of the fact that the effect of the privilege was to offer a haven to those apparently most culpable, parliament in England proved willing to intervene and this resulted in the enactment of S 72 of the Supreme court Act in 1981 which provides that:

“(1) In any proceedings to which this subsection applies a person shall not be excused, by reason that to do so would tend to expose that person, or his or her spouse to proceedings for a related offence for the recovery of a related penalty.

- (a) From answering any question put to that person in the first mentioned proceedings; or
From complying with any order made in those proceedings.
- (2) Subsection (1) applies to the following Civil proceedings in the High Court, namely –
 - (a) proceedings for infringement of rights pertaining to any intellectual property or for passing off;
 - (b) proceedings brought to obtain disclosure of information relating to an infringement of such rights or to any passing off;
 - (c) proceedings brought to prevent any apprehended infringement of such rights or any apprehended passing off ...

(5) In this Section “intellectual property” means any patent, trade mark, copyrights, registered design, technical or commercial information or other intellectual property”

The definitions of “related offence” and “related penalty” means that only the privilege against incrimination of “intellectual property” offences has been removed⁹⁴

There is no provision similar to the above in Nigeria and the Nigeria Courts cannot ordinarily compel a defendant suspected of infringing the Plaintiff’s right to disclose any information regarding the sources or outlets of infringing articles if to do so would violate S. 176 of the Evidence Act.

⁴³However, Nigeria courts can take a cue from the approach of Warner J. in the case of **IBM United Kingdom Ltd. Vs. Prima Data International Ltd.**⁹⁵ where his Lordship made an order and Sir Mervyn Davies refused to set aside the material part, in which a provision was included in the following terms:

“(“B”)efore any person enters (address) pursuant to this order, the supervising solicitors shall offer to explain to the second defendant the meaning and effect of this order in everyday language and shall also advise the second defendant of his right to obtain legal advice for permitting entry provided such advice is obtained at once (such advice to include an explanation that the second defendant may be entitled to avail himself of the privilege against self incrimination) and so that the provisions of paragraphs (1), (2), (3) and (4) of the order shall have effect only in so far as such privilege is not claimed by the second defendant”

Commenting on the above, Sir Mervyn Devies said “my conclusion from the foregoing is that an Anton Pillar order may properly be made in the terms of paragraph (1) with its

94. See *Universal City Studios Inc. vs Hubbard* (1984) Ch. 225

95. (1994) 1 WLR 719

provision. The order may be served but may not be executed until (a) the defendant is told of his privilege right and (b) the defendant then expressly declines to claim that right ... It seems to me that the form of the order adequately protects the defendant's privilege while at the same time allowing search if privilege is not claimed ... A supervising Solicitor must ensure that the defendant properly understands his rights as preserved by the order, i.e. that there will be no entry if the defendant claims privilege and the meaning of privilege must be explained".

Nevertheless, there is a compelling need for the Nigerian Law makers to amend the provisions of S 176 of the Evidence Act to modify the privilege against self-incriminating for the limited purpose of Anton Pillar Orders in intellectual property cases. This has been done in England as far back as 1981 and there is no reason why this should not be so in Nigeria, especially in view of the growing importance of intellectual property rights to national economic advancement.

BASIC REQUIREMENTS FOR THE GRANT OF ANTON PILLAR ORDER

In *Anton Pillar K.G V. Manufacturing Process*⁹⁶, Omrod LJ laid down three preconditions for the grant of Anton Pillar Orders in the following words "There are three essential preconditions for the making of such an order, in my judgement. First there must be an extremely strong prima facie case. Secondly, the damage, potential or actual must be very serious for the Plaintiff. Thirdly, there must be clear evidence that the defendants have in their possession incriminating documents or things and that there is real possibility that they may destroy such material before any application inter parties can be made"

96. *Supra* at page 784

97. (1987) Ch. 38

The increasing frequency with which the Anton Pillar Order was being resorted to in the 1980 gave rise to serious public as well as judicial concern. In the case of *Columbia Picture Industries Inc. Vs. Robinson*⁹⁷ Scott. J expressed a “very grave disquiet” at what he found “(a) procedure which on a regular and institutionalised basis, is depriving citizen of their privacy and closing down their businesses by orders made ex parte, on application of which they know nothing and of which they cannot be heard, by orders which they are forced, on pain of committal, to obey even if wrongly made”

Such judicial disquiet and judicial response to public concern led to the setting up in England of a committee under the Chairmanship of Staughton L.J. Its report suggested that there should be a forth precondition that the harm likely to be caused by the execution of the Anton Pillar Order to the respondent and his business affairs must not be excessive or out of proportion to the legitimate objects of the order especially when the effect of the order will be the seizure of trading stock or the perusal by the Plaintiff of the defendant’s confidential commercial documents”

Each of the above preconditions will be considered briefly:

(a) **AN EXTREMELY STRONG PRIMA FACIE CASE**

To secure an Anton Pillar order, an applicant would have to demonstrate by affidavit evidence an extremely strong prima facie case of infringement of his right.

It appears that the burden on the applicant here is heavier than in other cases of ordinary interim or interlocutory injunctions where the standard requirement as laid down in *American Cynamid V Ethicon*⁹⁸ is that there must be “a serious question to be tried”⁹⁹

98. (1975) 1 All E.R. 504

99. See page 510 para C-C per Diplock L. J. See also the Nigerian case of *Kotoye vs CBN* where the *Cyamind CASE* was approved as the position in Nigeria by the Supreme Court.

Therefore, an Anton Pillar order will not be made to enable a Plaintiff fish for evidence in order to justify mere suspicion. A wrongdoing, which will justify an Anton Pillar Order – e.g. pirating of copyright material – is likely to be the type, which is committed deliberately, repeatedly and surreptitiously. The Applicant’s case when he applies for an Anton Pillar Order may be based wholly or largely on circumstantial evidence, and the Plaintiff may be unaware of the scale of the defendant’s wrongdoing. To obtain, and preserve evidence when there is material from which the Court can infer a serious risk that the evidence might be concealed or destroyed by the defendant is a legitimate purpose of an Anton Pillar order.¹⁰⁰

b) **SERIOUS DAMAGE**

An applicant for Anton Pillar Order must also show by his affidavit evidence that the damage, actual or potential, to him as a result of the infringement is very serious. Even where the applicant is able to demonstrate a clear case of infringement, but the infringement is such that would not occasion any serious damage to the applicant, the Court will not grant him an Anton Pillar Order. This attitude is understandable in view of the draconian nature of an Anton Pillar Order.

c) **INCRIMINATING MATERIAL**

The applicant must additionally produce clear evidence that the defendant has in his possession incriminating documents or things and there is a real possibility that the defendant may destroy such material before any inter parties application can be made. In **Broker McConnell Plc. Vs. Plascow**¹⁰¹, the Court of Appeal stressed the difference between “a real possibility” and the “extravagant fears which seem to afflict all Plaintiffs who have complaints of breach of Confidence, breach of copyright or passing off”.

100. *Youssif va Salama* (1980) 1 WLR 1540.

101. [1985] R.P.C. 425

The Anton Pillar case was about “incriminating documents or things”. It is clear, however, that an Anton Pillar Order can be made even after judgement, when liability is no longer in issue, in order to obtain documents essential to execution of a judgement if there is a serious risk that a defendant will remove or destroy them in order to frustrate enforcement of a judgement.¹⁰²

d) **HARM TO BE CAUSED MUST NOT BE EXCESSIVE.**

The harm likely to be caused by the execution of the Anton Pillar Order to the respondent and his business affairs must not be excessive or out of proportion to the legitimate object of the order. This, it is suggested, mean that if the three original Anton Pillar pre-conditions are satisfied and the Court would otherwise make an order in terms which it has decided are appropriate, it must first balance the harm likely to be caused by the execution of an order in those terms against the object which it has already decided to be legitimate. For example, if the order which would otherwise be made would permit the removal from business premises of documents for copying, followed by their swift return, but not the indefinite removal of the defendant’s stock in trade which is the subject of an alleged infringement of copyright or execution of an order at the defendant’s home, it is the harm likely to be caused by the execution of that order which is to be weighed.

Above all, it must be recognised that an order will not be made simply because the four pre-conditions are fulfilled, but is most unlikely to be made unless they are fulfilled; so far as is relevant. The grant of Anton Pillar order like any other specie of injunction is a matter for the discretion of the Court the exercise of which must always depend on the facts and circumstances of the particular case. It is in recognition of this fact, that Diplocks L.J after considering the factors for the grant of an interlocutory injunction in American Cyanamid’s case stated at page 511

102. Distribution Automatic Halia SPA v Holford General Trading Co. Ltd. [1985 1 WLR 1066

103. [1988] R.P.C. 618

paragraphs f – g thus “I would reiterate that, in addition to those to which I have referred, there may be many other special factors to be taken into consideration in the particular circumstances of individual cases. The instant appeal affords one example of these”.

SAFEGUARDS AGAINST ABUSE OF THE ORDER OR ITS EXECUTION.

In the words of Browne – Wilkinson J. in *Thermax Ltd. V. Schott Industrial Glass Ltd*¹⁰³, Anton Pillar “procedure is very obviously draconian in its results. It is quite rightly said that it is not a search warrant in the sense that if the defendant refuses to obey the order and allow the plaintiff and his representatives to enter and search no force can be used against such defendant. But its effect is often vary similar”.

Scott J. has also expressed a similar anxiety in the case of *Colombia Pictures Industries Inc. Vs. Robinson* about a “procedure which, on a regular and institutionalized basis is depriving citizens of their property and closing down their businesses by orders made ex parte, on applications of which they know nothing and of which they cannot be heard, by orders which they are forced, on pain of committal to obey, even if wrongly made”.

Undoubtedly, Anton Pillar order can become a vicious weapon if not properly managed. It is therefore imperative to confine the order as well as its execution within certain limit in order to avoid its misuse especially in the hands of vindictive or overzealous plaintiffs or their representatives.

In response to the above scenario, attempts have been made through judicial pronouncements or otherwise, to regulate different aspect of the order to safeguard its misuse and minimise its injurious effect on its victims.

In *Colombia Picture Industries Inc. V. Robinson*, the court set out certain safeguarding measure in obtaining and executing Anton Pillar Order, these include:

- (a) The order must be so drawn as to extend no further than the maximum extent necessary to achieve the preservation of documents or articles, which may otherwise be destroyed or concealed. Once the Plaintiff's solicitors have satisfied themselves what material exists and have had an opportunity to take copies thereof, the material ought to be returned to the owner. The material ought to be retained no more than a relatively short period of time for the purpose.
- (b) It is essential that a detailed record of the material taken should be made by the solicitors who execute the order before the material is removed.
- (c) No material should be taken unless it is clearly covered by the terms of the order.
- (d) It is inappropriate that seized material, the ownership of which is in dispute, should be retained by the Plaintiffs' solicitors pending trial if the material is to be kept from the defendants, it should be held by their solicitors on the usual undertaking.

Also, in *Manor Electronics Ltd. V. Dickson*¹⁰⁴. It was held that a form of Anton Pillar Order providing that the Plaintiff's representatives "be entitled to enter" instead of requiring the defendant to permit such entry is defective. An Anton Pillar Order can be

no more than an order **in persona** to a defendant to permit entry. The Plaintiff is not entitled to enter against the wishes of the defendant. The order must not suggest the contrary.

Apart from the above and like in any other case of interim or interlocutory injunction, the applicant must be prepared to give an undertaking in damages and should provide evidence about his means to satisfy any order that may be made against him. In this regard, the Plaintiff may be required to pay money into court or to his Solicitors to be held by the Solicitors as officers of the court pending further order, or to provide a bond by an insurance company or a bank guarantee.

Commenting on the importance of undertaking as to damages to interim and interlocutory injunctions, **Nnamaeka Agu J.S.C.** stated in **Kotoye V. C.B.N.**¹⁰⁵ thus:

“It is my view that a necessary corollary to the fact that an undertaking as to damages is the price that an applicant has to pay for the order of interlocutory injunction is that failure to give the undertaking leaves the order, without a **quid pro quo**, and so should be a ground for discharging the order. This ought to be more so in respect of **ex parte** orders in which the order is being made without the other side being heard... Above all, this court ought to take notice of the numerous cases of abuse of **ex parte** injunctions that have come up in recent times ... As the Courts cannot prevent such applicants from exercising their constitutional rights by stopping such applications, they can, and ought, at least, see that justice is done to the victims of such **ex parte** applications and orders by ensuring that the applicant fully undertake to pay any damage that may be occasioned by any such order which may turn out to be frivolous or improper at the end. It is, therefore, my view that, save in recognised exceptions, no order for an interlocutory or interim injunction should be made **ex parte** or notice, save upon their conditions that the applicant gives a satisfactory undertaking as to damages”

105. Supra at pg 450 para E to 451 para A.

Failure to give the requisite undertaking as to damages is sufficient ground for discharging the order on Appeal. “In my judgement, therefore, where a Court of first instance fails to extract an undertaking as to damages where it should, an appellate court ought normally to discharge the order of injunction on appeal”¹⁰⁶

Furthermore, as in all **ex parte** application, there is a duty on the applicant to make a full and frank disclosure of all material facts.¹⁰⁷ This is a duty owed to the Court and not to the defendant. The duty is to identify any possible defences or weak points and not merely to exhibit documents in which defences or weak points lurk and might be discovered.¹⁰⁸ The duty is not merely to disclose all material facts known to the Plaintiff but also to make such enquiries as are reasonable in the circumstances and to disclose material facts revealed by such enquires.¹⁰⁹

In **Columbia Picture Industries Inc. V. Robinson Scott J.**¹¹⁰ said that the affidavit evidence in support of the application for an Anton Pillar Order should err on the side of excessive disclosure and that if there are two or more Plaintiffs, the duty of disclosure is owed by each of them and breach of the duty by any of them prejudices all.¹¹¹

If material matter is omitted (even by error of judgement) the order must be discharged without investigating its merits.¹¹²

In effecting the service of the Anton Pillar Order the directions as to whom and how it is to be served must be scrupulously followed. The practice has evolved in England of directing the execution of the order to be effected by the Applicant’s Solicitors together

106. Ibid at pg 451 paragraph B.

107. R.V. Kessington Income Tax Commissioner ex parte Princess Edmond de Polignac [1917] K.B. 486

108. Siporex Trade S.A. Vs. Comdel Commodities Ltd. [1986] 2 Lloyd’s Rep. 428 [A Mareva Case]

109. Bank Mellat V Nikpour [1985] FSR 87

110. Supra

111. See also Ojukwu V Gov. of Lagos State; Onuzulike Vs. Nwokedi (1989) 2 NWLR Pt. 102 Page 229 for failure to disclose material facts.

112. Thermox V. Schoot [1986]3 NWLR Pt 26 page 39 -Industries Glass Ltd. [1981] FSR 289; Wardle Fabrics Ltd. V. Myristis (G) Ltd. [1984] F.S.R. 263

with independent solicitors from a different firm referred to as the supervising solicitors. In this regard, applicant must furnish evidence of the identity and experience of the proposed supervising solicitors and his or her familiarity with the operation of Anton Pillar Orders. If for any reason, the judge will be asked not to provide that the order be served by independent supervising solicitors there should be evidence to justify the request (which may not, of course, be granted). If the judge grants the request, his reason for doing so should be expressed in the order and the Counsel for the Plaintiff owes a duty to the Court to bring this to the judge's attention if he overlooks it.

In Nigeria, instead of requiring service by independent supervising solicitors, the order usually specify that execution be effected by the bailiff of the Court in the company of the Applicant's solicitors and a senior police officer together with any other person as the order may specify.

As stated in the case of A.B. VS. C.D.¹¹³ when a draconian order of this kind is made, it is essential to ensure that it is executed with meticulous care and that the "victim" should be informed of his rights and the evidence on which the **ex parte** order was made so that he can consider whether he should consent or immediately apply to court for discharge, variation or limitation of the order. The defendant must be informed of his right to consult a legal practitioner in addition to explaining to him the ramifications of the order in every day language.

The requirement in an Anton Pillar order that the defendant "forthwith" permit the Plaintiff's representatives to enter the premises to be searched does not mean that the defendant must allow such entry at once or immediately, but only after there has been a reasonable period of time for him to obtain legal advice.¹¹⁴

113. [1982] R.P.C. 509

114. Bhimiji V. Chitewani [1971] 1 All ER 705

Execution of an Anton Pillar Order by a lawyer related to the executive of the Plaintiff company (or the Plaintiff in the case of an individual) is undesirable.¹¹⁵

In this regard, a Solicitor who falls short of the strict requirements that officers of the Court executing Anton Pillar Orders have to observe the exact terms of the order and who, having undertaken to the Court to explain to the defendant the meaning and effect of the order, fails to discharge his duty to give true and accurate explanation by stating wrongly to the defendant that he is entitled to search for materials outside the scope of the order, may be held to be in contempt of court even if his conduct is negligent rather than contumacious.¹¹⁶

DISCHARGE OR VARIATION OF ANTON PILLAR ORDER.

By Order 9. Rules 11 and 12 of the Federal High Court (Civil Procedure) Rules, 2000, where an order is made on a motion **ex parte**, any party affected by it may within seven days after service of it, or within such further time as the court shall allow, apply to the court by motion to vary or discharge it, and the court may, on notice to the party obtaining the order, either refuse to vary or discharge it, or may vary or discharge it with or without imposing terms as to cost or security or otherwise as seems just.

No order made on a motion **ex-parte** shall last for more than 14 days after the party affected by the order has applied for the order to be varied or discharged or last for another 14 days after application to vary or discharge it had been concluded.

If a motion to vary or discharge an **ex-parte** order is not taken within 14 days of its being filed, the **ex parte** order shall automatically lapse.

115. Manor Electronics Ltd. V. Dickson [1988] R.P.C. 618

116. VDU Installations Ltd. Vs. Integerated Computer System & Cybernetics Ltd. reported in [The Times, August 13, 1988] .See also Columbia Picture Ltd. V. Robinson (Supra).

It appears that an application to vary or discharge under the above rules can only be made by way of motion on notice¹¹⁷. It has been held in Hallmark Cards Inc. Vs. Image Art Ltd that where an Order has been made ex parte it is wrong to suspend it on an ex parte application by the defendant. The position of the Court in Hallmark's case is at variance with the position of English Courts in relation to the ordinary types of injunction where it is accepted that an order obtained ex parte may be varied or discharged upon an ex parte application.¹¹⁸

A defendant against whom an Anton Pillar order is made ex parte, can refuse immediate compliance and make an urgent application to have the order set aside, but will do so at his peril, since if he fails, he may be liable to penalties for contempt of court and if he uses the interval to breach the order, for instance, by destroying records, the consequence will be extremely grave.¹¹⁹

In the alternative, a party affected by an Anton Pillar Order may have recourse to the provision of s. 241 of the 1999 Constitution which provides that an “appeal shall lie from decisions of the Federal High Court or a high Court to the Court of Appeal as of right in the following cases ...: where an injunctions or the appointment of a receiver is granted or refused ...”

“Decision” is interpreted by Section 318 of the same Constitution to mean, “in relation to a court, any determination of that court and includes judgement, decree, order, conviction, sentence or recommendation”

Whilst it is incontestably clear that a party has a right of appeal against an ex parte order of injunction against him, the practice of appealing without first utilising the provision of

117. 7 UP Bottling Company V. Abiola and son Ltd. Ib. [1977] FSB 150 (Supra) pg. 285

118. See London City Agency (JCD) LTD. V Lee [1970] Ch. D 597; [1969] 3 All ER 1376

119. See per Sir John Donaldson MR in WEA Records Ltd. V Vision, Channel 4 Ltd. [1983] 1 WLR 721; [1983]3 All ER 589 CA

the rules of Court, allowing application to discharge or vary before the Court that made the order has been deprecated by the Supreme Court.

For instance, in 7^{UP} Bottling Company Ltd. Vs. Abiola & Sons Ltd., Iguh J.S.C. stated at pg. 285 of the report: “In this regard, the Court of Appeal per Achike J.C.A. observed as follows: “rather than question the ex parte order in accordance with the lucid provisions of order 8 rule 11 by a simple motion on notice, the appellant choose to complain against the conduct of the learned trial judge in this regard by way of appeal. No doubt, the appellants have the constitutional right to appeal against the decision of a High Court under Section 219, 220, and 221 of the Constitution of 1979 – which may be as of right or by leave – to the Court of Appeal. And the word “decision” by virtue of S. 277 of the said Constitution includes orders made by the High Court. Nevertheless, questioning the order of the trial judge by way of appeal cannot at any rate in this country be said to be reasonably expeditious in the circumstances of this case ... This proceedings by way of appeal, in contrast to the powers of review embedded under rule 11 (of Order 8), is to call in aid an enormous legal hammer to crack a rather small nut”.

I agree entirely with the above observations of Achike J.C.A. and fully endorse them. A simple interlocutory order which should have taken the trial court a matter of days, or at the worst a few weeks to determine had the defendants exercised their rights under the provisions of Order 8 rule 11 of the High Court rules has now taken seven years to be concluded in this court on appeal. I do not conceive that it was in the best interest of the defendants to have elected to question the said order of the trial court made upon an ex parte application through the circuitous means of an appeal instead of taking advantage of the provisions of order 8 rule 11 of the High Court rules 1987 to correct whatever error that was complained of.

It appears that a defendant in England does not have much of a choice as a party dissatisfied with an order made ex parte must apply under Order 32 rule 6 to have it set aside by the Court making the order before he can appeal to the court of Appeal. Until he has exhausted this procedure, the order is provisional only and cannot be appealed against to the Court of Appeal.¹²⁰

Grounds upon which the defendant may apply for a variation or discharge include failure of the Plaintiff to give an undertaking as to damages¹²¹, failure to disclose material facts or misrepresentation of material facts¹²² among others.

PILING PILLER ON MAREVA

The development of the Anton Piller Order has coincided with another, more general evolution in interlocutory procedure. This is Mareva injunction which is directed not to the uncovering and preserving of “fragile” evidence, but to the retention of the assets belonging to the defendant which may be needed to satisfy judgement in the action, particularly if they may be removed from the jurisdiction or otherwise disposed of to the prejudice of the judgement creditor.

Orders are frequently made containing both Anton Piller and Mareva terms. This is often called Piling Piller on Mareva. The order may relate to bank accounts and other financial assets. Equally, there have been orders directed to the seizure of specified valuables, such as cars, in which according to evidence, the proceeds of infringement have been invested.

The Phrase “Piling Piller on Mareva” was first aired, obiter, in Bekhor Ltd. V. Bilton. However, the first authoritative case where Anton Piller was

120. WEA Records Ltd. Vs Vision Channels 4 Ltd. [1983] WLR 721, [1983] 2 All ER 589.
 121. Kotoye V CBN (Supra)
 122. Ojulawu V. Gov. of Lagos State (1986) NWLR (Pt. 26)

piled on Mareva was the copyright/piracy case of C.B.S. United Kingdom Ltd. V. Lambert 122(b).

The Mareva injunction extends to cases where there is a danger that the assets will be dissipated within the jurisdiction as well as removed out of the jurisdiction.¹²³

To be efficacious, the procedure has to be swift and secrete in the sense that, the injunction must always be granted **ex parte** without notice to the defendant. The following guidelines were suggested by Mustill J. as well as the Court of Appeal in the case of **Third Chandris Corp. V. Unimarine S.A.**^{123(a)}

- (1) The Plaintiff should make full and frank disclosure of all matter in his knowledge which are material for the judge to know.
- (2) The Plaintiff should give particulars of his claims against the defendant, stating the grounds of his claims and the amount thereof and fairly stating the points made against it by the defendant.
- (3) The Plaintiff should give some grounds for thinking that the defendant has assets within jurisdiction.
- (4) The Plaintiff should give some grounds for believing that there is a risk of the assets being removed before the judgement or award is satisfied.
- (5) The Plaintiff must give an undertaking in damages in case he fails in his claim or the injunction turns out to be unjustified. In a suitable case this should be supported by a bond or security.

122(a) [1981] 1 Q.B. 923 at 955

122(b) [1983] Ch. 37

123. Z Ltd. V A-Z and AA-LL [1982] Q.B. 55 Sub. Nom. Z Ltd. V. A. [1982]1 All ER 556 CA

123(a) [1979] QB 645; [1979] 2 ALL ER 972. See also the Nigeria Case of Sotuminu Vs. Ocean Steamship Ltd. [1992]1 N.W.L.R. Pt. 239, pg. 1

The above requirements have now been slightly modified. It is not now necessary to show that the assets may be removed from the jurisdiction; any dealings with them that may defeat the ends of justice is sufficient.¹²⁴

CONCLUSION.

Having recognized the fact that intellectual property is one of the prime keys to our National Development, the next step is to strengthen the machinery for its protection. As we have attempted to demonstrate in this paper, Anton Piller order is a capable weapon albeit a volatile one in the armoury of an intellectual property right owner and his lawyer. It is in recognition of its potentials that both the parliament as well as the judiciary in England have focused special attention to its administration. In 1992, following the concern expressed by Nichol V-C¹²⁵ over the effects of carrying out the order, the Lord chancellor's Department issued a consultation paper² and from that followed the practice direction 1994^{125(a)}. There was also the Practice Note (Court of Appeal: Anton Piller Orders)^{125(b)}. These set out in details additional rules and forms in relation to the Anton Piller procedure.

In similar vein, the legislature intervened in 1981 to remove the obstacle to the execution of the Anton Piller order constituted by the rule against self-incrimination by the enactment of S. 72 of the Supreme Court Act, which has now been removed by the operation of the principle in so far as Anton Pillar order in intellectual property cases is concerned.

Furthermore, it is suggested that the Chief Judge of the Federal High Court issue a practice direction or in the alternative make special provisions in the Federal High court,

124. For a fuller discussion see Supreme Court practice [1993] Vol. 1 page 520 para 29/1/20, 21, 22 and 23. Also S. Gee *Mareva Injunctions and Antom Piller Relief* [2nd Edition] 1990.

125. Obatosin Ogunkeye: Legal remedies for infringer of copyright in Essays on copyright and Administration Edited by Professor E.E. Uvieghara.

125(a) [1994] 4 ALL ER 52

125(b) [1982] 1 WLR 1420

Civil Procedure rules, setting out clearly, procedure regarding the application for, as well as the execution of the Anton Piller Order. As it has been shown elsewhere in this paper, this has already been done in England and it has been yielding results.

It is rather discouraging, that the operation of a weapon as valuable as an Anton Piller order has remained uncoordinated coordinated and haphazard in this country. Judicial attitude towards it has never been more than lukewarm whilst that of the legislature has been that of unconcern. It is no wonder therefore, that section 176 of the Evidence Act remains intact nineteen years after a similar principle has been modified in England to pave way for an effective execution of the Anton Pillar Order.

It is not the case that our need in this regard is less than that of England or any other country for that matter, it is just that we are yet to properly appreciate the need and take the necessary steps of meeting it.

In the light of the above, we sincerely believe that certain steps need be taken to reverse the current situation.

To being with, the time is overdue for section 176 of the Evidence Act to be amended so as to remove the privilege against self incrimination at least in so far as the execution of Anton Piller Orders in intellectual property cases are concerned. This is necessary to enhance the efficacy of the Order as a weapon of discovery and preservation of evidence in intellectual property cases. As it is now, it is easy for an intellectual property right owner to be stonewalled and prevented from getting at the real culprit of infringement by conveniently hiding behind the privilege against self-incrimination.

Pending the suggested amendment, our judges are advised to utilise the approach adopted by Warner J. and Sir Mervyn Davies in the case of IBM United Kingdom Ltd. Vs. Prima Data International Ltd. ¹²⁶

Furthermore, it is suggested that the Chief Judge of the Federal High Court issue a practice direction or in the alternative make special provisions in the Federal High court,

Civil Procedure rules, setting out clearly, procedure regarding the application for, as well as the execution of the Anton Piller Order. As it has been shown elsewhere in this paper, this has already been done in England and it has been yielding results.

Finally, since Anton Piller procedure is a function of the judicial process; some judicial reforms will go a long way in positively encouraging its effectiveness. The court concerned with intellectual property cases as, shown in this paper, is the Federal High Court. This is a Court that was established to ensure expeditious disposal of matters in relation to which it had been vested with jurisdiction. The extent to which this has been achieved is questionable. As a matter of fact, the Federal High Court especially the Lagos and the Port Harcourt Divisions which handle the bulk of Intellectual property cases are as congested as any of the state high Courts if not more. There is therefore the need to expand the infrastructure and appoint more judges.

Not only that, there is urgent need to promote efficiency by specialisation on the part of the judges handling intellectual property cases and therefore administering Anton Piller Orders.

In England, there are patent judges who are specialised in intellectual property cases and incidentally Anton Piller Order was evolved by them. They have continued to mold and remold it for the purpose of achieving maximum efficiency.

Those judges by their wealth of experience as well as their regular involvement in this area are best positioned to appreciate the problems facing intellectual property cases and how best to tackle them. It was in the process of this that Anton Pillar Order was evolved. There is no harm in developing a similar practice in Nigeria. Our intellectual property law will definitely be better for it.

Anton Piller procedure will be expeditiously and effectively dealt with thereby assuring the right owner of a ready and effective weapon and increasing the readiness to invest more in intellectual property both in terms of human as well as material resources.

