

## CHAPTER 216

### THE PATENTS ACT.

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## CHAPTER 216

### THE PATENTS ACT.

*Commencement:* 15 October, 1993.

#### **An Act to provide for the grant, registration and protection of patents and for other purposes incidental thereto.**

##### PART I—INTERPRETATION.

#### **1. Interpretation.**

In this Act, unless the context otherwise requires—

- (a) “ARIPO Office” means the secretariat managing the African Regional Industrial Property Organisation (ARIPO), formerly known as the Industrial Property Organisation, for English-speaking Africa (ESARIPO) established by the Lusaka Agreement of December 9th, 1976, as amended;
- (b) “ARIPO Protocol” means the Protocol on Patents and Industrial Designs within the Framework of the African Regional Industrial Property Organisation (ARIPO), concluded on December 10th, 1982, at Harare;
- (c) “foreign application” means an application for a patent which has been filed in a national patent office of a country other than Uganda, or in a regional industrial property office acting on behalf of that country;
- (d) “Minister” means the Minister responsible for the supervision of the patents registry;
- (e) “Paris Convention” means the Paris Convention for the Protection of Industrial Property signed on 3rd March, 1883, as last revised;
- (f) “register” means the register of patents maintained under section 4;
- (g) “registrar” means the registrar of patents appointed under section 2;
- (h) “registry” means the patents registry referred to in section 3.

PART II—THE PATENTS REGISTRY.

**2. Officers.**

The Minister may appoint—

- (a) the registrar of patents who shall supervise the performance of the duties and functions of a registry under this Act;
- (b) assistant or deputy registrars who shall, subject to the direction of the registrar, have all the powers conferred by this Act on the registrar; and
- (c) examiners or other officers as may be necessary for carrying out the provisions of this Act.

**3. Patents registry.**

There shall be an office known as the patents registry with all functions relating to the procedure for the grant of patents and, in addition, shall—

- (a) register licence contracts, contracts assigning the right to a patent and contracts assigning patents, and patent applications;
- (b) provide patent information services to the public and maintain links with users and potential users of patent information;
- (c) act as the industrial property office of Uganda for the purposes of applications filed under the ARIPO Protocol; and
- (d) perform any other functions that the Minister may by regulations prescribe.

**4. Register of patents.**

(1) The registrar shall maintain a register of patents in which shall be recorded all patents granted, numbered in the order of grant, and, in respect of each patent, where appropriate, its lapse for nonpayment of annual fees, and all transactions to be recorded by virtue of this Act or regulations made under it.

(2) The Minister may make regulations prescribing the form of register to be maintained under this section.

(3) The register shall be prima facie evidence of all matters contained in it as required by law, and any person, upon payment of the prescribed fee, may search the register or obtain extracts from it.

(4) Notwithstanding the repeal of the Patents Act, Cap. 82 of the 1964 Revision, a register kept in pursuance of that Act shall be deemed to be part of the register kept in pursuance of this Act.

## **5. Administrative instructions.**

The registrar may, in conformity with the provisions of this Act, issue administrative instructions relating to the procedure for the grant of patents and the administration of granted patents as well as other functions of the registry.

## **6. Restrictions concerning patent officials.**

(1) A registrar, assistant or deputy registrar of patents or any other official of the registry shall not file an application for a patent, or be granted a patent or hold any rights relating to a patent.

(2) With respect to information which has come to his or her knowledge in the course of his or her duties, an official of the patents registry shall not, even after the termination of his or her employment, make use of, communicate or divulge to any person, otherwise than in the performance of his or her duties under this Act, the contents of any document, communication or information which by its nature is a professional secret.

(3) A person who contravenes subsection (2) commits an offence and is liable on conviction to imprisonment for a term not exceeding seven years.

### PART III—PATENTABILITY.

## **7. Definition of invention.**

(1) For the purposes of this Act, “invention” means a solution to a specific technological problem and may be or may relate to a product or process.

(2) The following shall not be regarded as inventions within the meaning of subsection (1)—

- (a) discoveries and scientific and mathematical theories;
- (b) plant or animal varieties or essentially biological processes for the production of plants or animals, other than biological processes and the products of those processes;

- (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
- (d) methods for treatment of the human or animal body by surgery or therapy as well as diagnostic methods, but the restriction under this paragraph shall not apply to products for use in any of these methods; and
- (e) mere presentation of information.

## **8. Patentable invention.**

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

## **9. Novelty.**

(1) An invention is new if it is not anticipated by prior art.

(2) Everything made available to the public anywhere in the world by means of written disclosure, including drawings and other illustrations, or by oral disclosure, use, exhibition or other nonwritten means shall be considered prior art if the making available is one which has occurred before the date of filing of the application or, if priority is claimed, before the priority date validly claimed in respect of it.

(3) The disclosure to the public of the invention shall not be taken into consideration if it occurred within twelve months preceding the date on which the application was filed and if it was by reason or in consequence of—

- (a) acts committed by the applicant or his or her predecessor in title;  
or
- (b) an abuse committed in relation to the applicant or his or her predecessor in title.

## **10. Inventive step.**

An invention is considered as involving an inventive step if, having regard to the prior art within the meaning of section 9, it would not have been obvious to a person skilled in the art, on the date of the filing of the application or, if priority is claimed, on the priority date validly claimed in respect of it.

### **11. Industrial application.**

An invention is considered industrially applicable if, according to its nature, it can technologically be made or used in any kind of industry.

### **12. Temporary exclusion from patentability.**

The Minister may, in the public interest, by statutory instrument, exclude from patentability, inventions concerning certain kinds of products or processes for the manufacture of those products, for a period not exceeding two years.

## **PART IV—APPLICATION, GRANT, REFUSAL OF GRANT.**

### **13. Application.**

(1) An application for the grant of a patent shall be made to the registrar, but where the applicant ordinarily resides or has his or her place of business outside Uganda, he or she shall be represented by an agent admitted to practise before the patents registry.

(2) The application shall be accompanied by the following—

- (a) a description disclosing the invention in a manner sufficiently clear and complete for the invention to be evaluated and to be carried out by a person skilled in the art and shall, in particular, indicate the best mode known to the applicant for carrying out the invention;
- (b) a clear and concise claim or claims defining the matter for which protection is sought and fully supported by the description;
- (c) any drawing which may be essential for understanding the invention;
- (d) an abstract serving the purpose of technical information but which shall not be taken into account for the purpose of interpreting the scope of the protection sought; and
- (e) the prescribed fee.

(3) The application shall state the name of any other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention.

(4) Where the applicant is not the inventor, the application shall be

accompanied by a statement justifying the applicant's right to the patent.

(5) The appointment of an agent under subsection (1) shall be indicated by designation of the agent in the application or by furnishing of a power of attorney signed by the applicant.

#### **14. Unity of invention.**

The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

#### **15. Amendment and division of application.**

(1) The applicant may amend the application, but the amendment shall not go beyond the disclosure in the initial application.

(2) The applicant may divide the application into two or more applications ("divisional application"), but each such divisional application shall not go beyond the disclosure in the initial application.

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

#### **16. Right of priority.**

(1) The application may contain a declaration claiming priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his or her predecessor in title, in or for any member State of the Paris Convention.

(2) Where priority is claimed in accordance with subsection (1), the applicant shall accompany the declaration with a copy of the earlier application, certified as correct by the office with which it was filed.

(3) The effect of the declaration made under subsection (1) shall be as provided in the Paris Convention.

(4) Where the requirements under this section and any regulations relating to them have not been complied with, the declaration referred to in subsection (1) shall be disregarded.

## **17. Information on corresponding foreign applications and grants.**

(1) The registrar may, within one year after the date of filing the application, request the applicant to furnish him or her with details of any foreign application for a patent or another title of protection filed by the applicant with a national industrial property office of another country, or with a regional industrial property office, relating to the same invention as that claimed in the application filed with the registrar.

(2) The applicant shall, at the request of the registrar, furnish him or her with the following particulars concerning any of the foreign applications referred to in subsection (1)—

- (a) copies of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (b) a copy, if any, of the patent or other title of protection granted on the foreign application;
- (c) a copy, if any, of the final decision rejecting the foreign application or refusing the grant requested; and
- (d) a copy, if any, of a decision invalidating the patent or other title of protection granted to the applicant on the basis of the foreign application.

(3) The particulars furnished under this section shall merely serve the purpose of facilitating the evaluation of novelty and inventive step with respect to the invention claimed in the application filed with the registrar or in the patent granted on the basis of that application.

## **18. Withdrawal of application.**

The applicant may, at any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent, withdraw the application, but he or she shall, if he or she does so, forfeit the filing fee.

## **19. Filing date and formal examination.**

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

- (a) an express or implicit indication that the granting of a patent is sought;
- (b) information establishing the identity of the applicant; and

(c) a part which, on the face of it, appears to be a description of an invention.

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

(3) Where the application refers to drawings which in fact are not included in the application, the registrar shall invite the applicant to furnish the missing drawings; and if the applicant complies with the invitation, the registrar shall accord as the filing date the date of receipt of the missing drawings; otherwise the registrar shall accord as the filing date the date of receipt of the application and shall treat any reference to the missing drawings as nonexistent.

(4) After according a filing date, the registrar shall examine whether the application complies with the requirements of section 13 and the regulations pertaining to them and those requirements of this Act and the regulations which are designated as formal requirements for the purposes of this Act.

## **20. Search and substantive examination.**

(1) The Minister may, by statutory instrument—

- (a) direct that applications for patents relating to a specified technical field or fields or that all applications relating to any technical field shall be the subject of an examination as to substance; or
- (b) add further technical fields to those covered by a direction under paragraph (a) of this subsection or remove any technical field from the scope of the direction.

(2) If, in the registrar's opinion, the subject matter of an invention for which a patent is sought falls within a technical field covered by the terms of a direction made under subsection (1), he or she shall cause an examination to be carried out as to patentability under Part III of this Act.

(3) For the purposes of the examination under subsection (2), the registrar may transmit the application, with all accompanying documents, to the ARIPO Office or some other examining authority designated in the

statutory instrument for a preliminary examination as to the patentability of the invention claimed, and the examining authority shall furnish a report on the conclusions of its examination and shall transmit it to the registrar and to the applicant.

(4) Where, taking due account of the conclusions of any report referred to in subsection (3), the registrar is of the opinion that any of the conditions as to patentability have not been fulfilled, he or she shall notify the applicant accordingly and invite him or her to amend his or her application.

(5) Where the applicant fails to amend his or her application, within the specified period of time, to the satisfaction of the registrar, the latter shall refuse the grant of a patent and notify the applicant accordingly.

## **21. Grant, registration and publication of patent.**

(1) Unless the application has been rejected or refused under section 20, a patent shall be granted and issued to the applicant in the specified form.

(2) A patent granted under subsection (1) shall be recorded in the register, and the prescribed particulars of the patent shall be promptly published by the registrar in the Gazette.

(3) The registrar shall, whenever possible, reach a final decision on the application not later than two years after the commencement of the examination referred to in section 20.

(4) The registrar shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by it, where the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

## **22. Appeals.**

An applicant may appeal to the High Court against a decision by the registrar—

- (a) according a filing date to an application;
- (b) rejecting an application; or
- (c) treating an application as if it had not been filed.

### **23. ARIPO patents.**

A patent granted to an applicant by the ARIPO Office in accordance with the ARIPO Protocol and in respect of which Uganda is a designated State shall, with the necessary modifications, have the same effect and enjoy the same protection in Uganda as a patent granted under this Act; but a patent so granted shall not have legal effect or protection in Uganda where the registrar has made a written communication to the ARIPO Office, in accordance with the ARIPO Protocol, that the patent shall have no effect in Uganda.

## **PART V—RIGHTS AND OBLIGATIONS.**

### **24. Obligations of owner.**

The owner of a patent shall have the following obligations—

- (a) to disclose the invention in a clear and complete manner and, in particular, to indicate the best mode for carrying out the invention in accordance with the requirements and subject to the sanctions applicable under this Act;
- (b) to work the patented invention in the country within the time limit prescribed; and
- (c) to pay the prescribed fees to the registry.

### **25. Rights of owner.**

(1) The owner of a patent has an exclusive right to make, use, exercise and vend the invention, and may preclude any person from exploiting the patented invention without his or her authorisation, by any of the following acts—

- (a) when the patent has been granted in respect of a product—
  - (i) making, importing, offering for sale, selling and using the product;
  - (ii) stocking the product for the purposes of offering for sale, selling or using the product;
- (b) when the patent has been granted in respect of a process—
  - (i) using the process;
  - (ii) doing any of the acts referred to in paragraph (a) of this subsection in respect of a product obtained directly by means of the process.

(2) After the grant of the patent, and within the limits defined in section 27, the owner of the patent has a right to preclude any person from exploiting the patented invention in the manner referred to in subsection (1).

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

## **26. Infringement.**

(1) Subject to sections 27, 28 and 37, where a person other than the owner of a patent or a licensee does any of the acts specified in section 25(1) in respect of the patented invention, that act shall constitute infringement of the patent.

(2) If the owner of a patent or the licensee is of the opinion that his or her patent has been or is about to be infringed, he or she may institute infringement proceedings in the High Court for the following relief—

- (a) damages;
- (b) an injunction to prevent infringement or continuing infringement of the patent; and
- (c) any other civil remedy.

(3) Where a defendant to infringement proceedings can prove that the acts done by him or her do not constitute an infringement, he or she may pray the court for a declaration that the patent in question has not been infringed.

(4) If a patent relates to a process for the manufacture of a product showing novel features, the product shall, in the absence of proof to the contrary, be presumed to have been manufactured by that process.

## **27. Scope of protection.**

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

## **28. Limitation.**

The rights of an owner of a patent shall extend only to the use of the patented invention for industrial or commercial purposes, but those rights shall not be deemed to be infringed by the following—

- (a) acts done in pursuance of scientific research;
- (b) acts in respect of articles which have been put on the market in Uganda by the owner of the patent or with his or her express consent;
- (c) the use of the patented article on foreign aircrafts, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Uganda;
- (d) acts performed by any person who in good faith, before the filing or, where priority is claimed, before the priority date of the application on which the patent is granted and in Uganda, was using the invention or was making effective and serious preparations for such use, to the extent that those acts do not differ in nature or purpose from the actual or envisaged prior use and provided that the right of the prior user referred to in this section may be transferred or devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been made.

**29. Exploitation by the Government or persons authorised by the Government.**

(1) Where the Minister is of the opinion that it is in the vital public interest to do so, he or she, in consultation with the registrar, and without the authority of the owner of a patent, may direct that a patented invention be exploited by a Government agent or other person designated by the Minister, on the following conditions—

- (a) that the owner of the patent and any licensee has been given an opportunity to be heard before the direction is made; and
- (b) that the Government provides for the payment of adequate remuneration, as fixed by the registrar, to the owner of the patent for the use of his or her invention.

(2) The owner of any patent affected by any direction of the Minister under this section may appeal to the High Court—

- (a) against the direction of the Minister;
- (b) against a decision of the registrar fixing the amount of remuneration under subsection (1),

but an appeal shall not suspend the effect of the direction of the Minister under subsection (1).

(3) For the purposes of this section, “vital public interest” includes matters of paramount importance pertaining to national security, public health, public order and morality and the national economy.

(4) For the purposes of forming an opinion under subsection (1), the Minister may consult with such technical experts in the particular field of the patented invention as may be necessary.

### **30. Compulsory licences.**

(1) At any time after four years from the filing date of an application or three years from the grant of a patent, whichever period last expires, any person may, in proceedings instituted by him or her against the owner of the patent or in proceedings instituted against him or her by the owner request the court for the grant of a compulsory licence on any of the following grounds—

- (a) that the patented invention, being capable of being worked in Uganda, has not been so worked;
- (b) that the existing degree of working of the patented invention in Uganda does not meet on reasonable terms the demand for the patented product on the domestic market or for the purposes of exploitation;
- (c) that the working of the patented invention in Uganda is being hindered or prevented by the importation of the patented product; and
- (d) that, by reason of the refusal of the owner of the patent to grant licences on reasonable terms, the establishment or development of industrial or commercial activities in Uganda, or the possibilities of exportation from Uganda, are unfairly and substantially prejudiced.

(2) A compulsory licence under this section shall be on such terms as to payment of remuneration by the licensee to the owner of the patent and otherwise as the court may consider just.

(3) Where the patented invention is a process, “patented product” in subsection (1) means a product obtained directly by means of the process.

### **31. Term of patent.**

- (1) Subject to subsection (2), a patent shall expire at the end of the

fifteenth year after the date of the grant of the application.

(2) Where the owner of a patent makes a request to the registrar for extension of a patent and—

(a) accompanies the request with the prescribed fee; and

(b) satisfies the registrar that—

(i) the invention which is the subject of the patent is being worked in Uganda at the date of the request; or

(ii) there is a legitimate reason for failing to so work the invention,

the registrar may grant the extension for a further period of five years; but the request under this subsection shall be made not less than one month before the expiration of the patent.

(3) For the purposes of this section, a patented invention is worked if the patented product is effectively used in Uganda on a scale which is reasonable in the circumstances, but importation does not constitute working.

### **32. Annual maintenance fees.**

(1) In order to maintain the application or the patent, an annual fee shall be paid in advance to the registrar starting with the first anniversary of the date of the filing of the application.

(2) The amount of the annual fee shall be fixed by the regulations so that it increases with the number of years.

(3) A period of grace of six months shall be granted for the payment of the annual fee upon payment of a surcharge whose amount shall be fixed by regulations.

(4) If an annual fee is not paid in accordance with this section, the application shall be deemed to have been withdrawn or the patent shall lapse, and the lapse of the patent shall promptly be published by the registrar.

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

(6) If the registrar is satisfied that the failure to pay the annual fee concerned was unintentional and all annual fees due have been paid, he or she shall make an order restoring the application or the patent, as the case may be.

(7) Any interested person may appeal to the court against the decision of the registrar granting or refusing to grant a request for restoration.

(8) Where a patent is restored under subsection (6), no proceedings may be brought by virtue of the patent—

- (a) with respect to any acts performed after the lapse of the patent and before the date of the order for restoration;
- (b) with respect to any acts performed after the date of the order for restoration in relation to articles imported into Uganda, or manufactured in it, after the lapse of the patent and before the date of the order for restoration.

### **33. Change in ownership.**

(1) A contract assigning an application or a patent shall be in writing and shall be signed by the parties to the contract.

(2) Any change in ownership of an application or a patent shall be recorded in the register in accordance with the regulations governing the register, and on payment of the prescribed fee.

(3) Until a change in ownership has been recorded in accordance with this section, any document tending to establish the fact of the change in ownership shall not be admissible as evidence of title of any person to an application or patent.

### **34. Joint ownership.**

In the absence of any agreement to the contrary between the parties, joint owners of an application or a patent may—

- (a) separately transfer their shares in the application or the patent;
- (b) separately exploit the patented invention and preclude any person not being a joint owner from exploiting the patented invention;  
or
- (c) jointly grant permission to any third person to do any of the acts referred to in section 25.

PART VI—SURRENDER, INVALIDATION AND REVOCATION OF PATENTS.

**35. Surrender of patent.**

(1) The owner of a patent may surrender some or all of the claims in respect of a patent.

(2) The surrender shall be recorded in the register but shall become effective on publication by the registrar in the Gazette.

(3) Where a licence has been recorded in the register in respect of a patent, the surrender shall be accompanied by a declaration by the licensee consenting to the surrender, unless the licensee has expressly waived his or her right in the licence contract.

**36. Invalidation and revocation.**

(1) The court may, at the request of a party to proceedings under this Act, invalidate and revoke a patent on any of the following grounds—

- (a) that the invention claimed is not patentable within the meaning of sections 7 to 11;
- (b) that the invention claimed is excluded from patentability under section 12;
- (c) that the description and claims accompanying the application for grant of a patent did not comply with the requirements of section 13(2); or
- (d) that the person to whom the patent was granted had no right to it and the patent has since the grant not been assigned to the person who has the right to it.

(2) An invalidated patent, or claim or part of a claim, shall be regarded as null and void from the date of the grant of the patent.

PART VII—CONTRACTUAL LICENCES.

**37. Licence contracts.**

(1) The owner of a patent may, by written contract, grant permission to another person or persons to do any of the acts specified in section 25 in respect of an invention for which the patent was granted or an application is

pending.

(2) A licence contract shall be in writing, signed by the parties to the contract, and shall be submitted by them, by petition, to the registrar for registration in the register.

(3) For the purposes of this Part of the Act, “licensor” means the party to the licence contract who grants the permission; and “licensee” means the person to whom the permission is granted.

### **38. Rights of licensee.**

In the absence of provisions in the licence contract to the contrary, the licensee shall be entitled to do, in respect of the invention, any of the acts specified in section 25, but he or she may not grant permission to a third party to do any of those acts in respect of the patented invention.

### **39. Prohibited terms in licence contracts.**

(1) The registrar shall examine the contract to ascertain whether it contains terms which impose unjustified restrictions on the licensee and whether, as a consequence, the contract taken as a whole, is harmful to the economic interests of Uganda, and he or she may refuse to register the licence contract if after taking into consideration, in such examination, in particular, any term contained in the contract he or she is satisfied that the effect of that term would be—

- (a) to permit or require the importation of technology from abroad when substantially similar or equivalent technology may be obtained on the same or more favourable conditions without importation from abroad;
- (b) to require payment of a price, royalty or other consideration which is disproportionate to the value of the technology to which the contract relates;
- (c) to require the licensee to acquire any materials from the licensor or from the sources designated or approved by him or her, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (d) to prohibit the licensee from acquiring, or to restrict his or her acquisition of, any materials from any source, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;

- (e) to prohibit the licensee from using, or to restrict his or her use of, any materials which are not supplied by the licensor or by sources designated or approved by him or her, unless it is otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced;
- (f) to require the licensee to sell products produced by him or her under the contract exclusively or principally to persons designated by the licensor;
- (g) to require the licensee to make available to the licensor without appropriate consideration any improvements made by the licensee with respect to the technology to which the contract relates;
- (h) to limit the volume of the products produced by the licensee with the help of the technology to which the contract relates;
- (i) to prohibit or restrict the export of the products produced by the licensee;
- (j) to require the licensee to employ on a permanent basis persons designated by the licensor;
- (k) to impose restrictions on research or technological development carried out by the licensee;
- (l) to prohibit or restrict the use by the licensee of any technology other than the technology to which the contract relates;
- (m) to extend the coverage of the contract to technology not required for the use of the main subject of the contract and to require consideration for such additional technology;
- (n) to fix prices for the sale or resale of the products produced by the licensee with the help of the technology to which the contract relates;
- (o) to exempt the licensor from any liability consequent upon any defect inherent in the technology to which the contract relates or to restrict the liability;
- (p) to prohibit or restrict the use by the licensee, after the expiration of the contract, of technology acquired as a result of the contract, subject, however, to any right of the licensor under the patent;
- (q) to require that disputes arising from the interpretation or performance of the contract be governed by a law other than the laws applicable in Uganda or that those disputes be brought before courts outside the territory of Uganda;
- (r) to establish the duration of the contract for a period which is unreasonably long in relation to the economic function of the contract, so however that any period which does not exceed the

duration of the patent to which the contract relates shall not be regarded as unreasonably long.

(2) Where the registrar is of the opinion that the contract contains one or more terms which impose unjustified restrictions on the licensee and that, as a consequence, the contract, taken as a whole, is harmful to the economic interests of Uganda, he or she shall notify the petitioners accordingly and invite them to modify the contract so that it does not contain any such term.

#### **40. Registration and certificates.**

(1) If the registrar finds the licence contract in order, he or she shall register the contract and issue a certificate of registration to the petitioners.

(2) The certificate of registration shall state—

- (a) the names of the parties to the contract;
- (b) the date of the petition;
- (c) the date of registration; and
- (d) the registration number.

(3) All the particulars specified in subsection (2)(a), (b) and (c) shall be published by the registrar in the Gazette.

### PART VIII—UTILITY CERTIFICATES.

#### **41. Utility certificate.**

(1) The registrar may grant a utility certificate in respect of an invention under this Part.

(2) Except as otherwise expressly specified in this Act, Parts I to VII and Part IX of this Act shall apply with necessary modifications to utility certificates and applications for them.

#### **42. Special provisions relating to utility certificates.**

(1) An invention is eligible for a utility certificate if it is new and is industrially applicable.

(2) It is immaterial that the invention does not involve an inventive step within the meaning of section 10.

(3) The provisions in respect of patents relating to examinations as to substance under section 20 shall not apply to applications for utility certificates.

(4) Utility certificates shall be registered in a separate part of the register.

#### **43. Duration and expiry of utility certificates.**

A utility certificate shall expire, without any possibility of renewal, at the end of the seventh year after the date of grant of the application; but the court may, before the utility certificate expires, and in proceedings under section 36, invalidate and revoke a utility certificate on any of the grounds under that section.

#### **44. Conversion of patent application to application for a utility certificate or vice versa.**

(1) At any time before the grant of a patent or the notification of rejection of the application or of refusal to grant a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility certificate, which shall be accorded the filing date of the initial application.

(2) At any time before the grant of a utility certificate or of the notification of rejection of the application, an applicant for a utility certificate may, upon payment of the prescribed fee, convert his or her application into a patent application, which shall be accorded the filing date of the initial application.

(3) An application may not be converted under subsections (1) and (2) more than once.

(4) The Minister may make regulations prescribing the procedure and requirements for conversion of an application under this section.

PART IX—GENERAL PROVISIONS.

**45. Jurisdiction.**

(1) The High Court is vested with jurisdiction to decide disputes relating to the application of this Act and matters which under the Act are to be referred to the court.

(2) The court hearing the proceedings under this Act may sit with and be advised by two assessors having expert knowledge of the matters of a technological or economic nature.

**46. Regulations.**

The Minister may, by statutory instrument, make regulations prescribing anything which under this Act is to be prescribed by the regulations and generally, for better carrying out the objects and purposes of this Act, or to give force or effect to its provisions or for its better administration.

**47. Transitional and savings provisions.**

A patent registered in Uganda under the Patents Act, Cap. 82, 1964 Revision, which was in force immediately before the commencement of this Act, shall continue in force and confer the same rights and privileges as if granted and registered under this Act, until its natural life in law expires; and the remainder of its natural life shall continue to run as if this Act had not been enacted.

**History:** Statute 10/1991; S.I. 70/1993.

**Cross References**

Lusaka Agreement of 9 December, 1976.

Paris Convention for the Protection of Industrial Property.

Patents Act, 1964 Revision, Cap. 82.

Protocol on Patents and Industrial Designs within the Framework of the African Regional Industrial Property Organisation.

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