

**IN THE COURT OF APPEAL OF NIGERIA
HOLDEN AT ENUGU
ON THURSDAY, THE 26TH DAY OF NOVEMBER 1998
BEFORE THEIR LORDSHIPS**

ISA AYO SALAMI

JUSTICE COURT OF APPEAL

NIKI TOBI

JUSTICE COURT OF APPEAL

EUGENE CHUKWUEMEKA UBAEZONU JUSTICE COURT OF APPEAL

CA/E/225M/94

BETWEEN:

DENSY INDUSTRIES (NIG) LTD..... APPELLANT

V.

**SUNDAY UZOKWE..... RESPONDENT
(Trading under the name and style of Sunday Innocent & Co.)**

JUDGMENT

(Delivered by NIKI TOBI, JCA)

ISSUES:

- 1. Whether Exhibit 13 (Design No. 4464) was new at the time it was registered, in compliance with the requirements of section 13(1)(a) of the Patents and Designs Act, Cap. 344 of the Laws of the Federation of Nigeria. 1990.**
- 2. Whether the findings of the trial court that the appellants had failed to prove that registered design No. 4464 was not new at the time it was registered can stand in view of the probative and overwhelming evidence adduced before the trial court.**

FACTS:

This matter relates to design No. 4464. The appellant, as plaintiff, sought declarations by the trial court that the respondent has not acquired any exclusive privileges or rights in Nigeria in the design, and that the design is invalid being neither new nor original and rectification of the Register of Designs.

After hearing evidence from the parties, the trial court held that the appellant did not prove its case, having failed to tender the industrial design claimed to be in existence before that of the respondent and that the appellant therefore failed to prove that respondent's registered design No. 4464 is not new. In consequence, the trial court dismissed the case of the appellant with costs to the respondent.

Being dissatisfied with the decision of the trial court, the appellant appealed to the Court of Appeal which, in determining the appeal, considered the provisions of section 13(1)(a) and (b) (2), (3), (4) and (5) of the Patents and Designs Act, Cap. 344, Laws of the Federation of Nigeria, 1990 which read as follows: " 3(1) Subject to this section, an industrial design is registerable if -

(a) it is new; and

(b) it is not contrary to public order or morality.

(2) Where application is made for the registration of an industrial design, the design shall be presumed to be new at the time of the application except in so far as the following provisions of this section provide otherwise.

(3) An industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the Registrar that the creator of the design could not have known that it had been made so available.

(4) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that within the period of six months preceding the filing of the application for registration the creator has exhibited it in an official or officially recognized exhibition.

(5) An industrial design is not new merely because it differs in minor or inessential ways from an earlier design concerns a type of product other than the type with which an earlier design is concerned.

Held (Unanimously dismissing the appeal):

1. On Prerequisite for registration of an industrial design -

By virtue of section 13(1) of the Patents and Designs Act, an industrial design is registerable if:-

- (a) it is new; and**
- (b) it is not contrary to public order or morality.**

In the instant case, only section 13(1)(a) is relevant to the determination of whether or not design No. 4464 is new.

2. On Presumption of newness of industrial design and how rebuttance -

By virtue of section 13(2) of the Patents and Designs Act, where an application is made for the registration of an industrial design, the design will be presumed to be new at the time of the application except in so far as otherwise provided by section 13(3), (4) and (5). This presumption is rebuttable by evidence on the part of the party alleging that the design was not new at the time of the application. Once the evidence vindicates any of section 13(3), (4) and (5) of the Act, a court of law is bound to hold that the design was not new at the time of the application.

3. On Presumption of newness of industrial design and how rebuttance -

A party who alleges the earlier existence of a design must certainly prove such existence and the most fundamental way of proof is the tendering of the design in court. It is only when the court physically sees and examines the earlier design along with the other one that a judicious conclusion based on the judge's wisdom or sagacity will be drawn. It is not enough to tender the product and present same as a legal substitute for the design in question. The physical inspection of the design is crucial. In the instant case, failure by the appellant to tender before the trial court the design it alleged existed prior to that of the respondent was fatal to its case. Thus, the findings of the trial court that Exhibits 3A and 3B were similar to Exhibit 3 in shape, size and substance do not detract from the sanctity and aura surrounding an industrial design.

"The learned trial Judge raised the following fundamental point in the course of his evaluation of evidence at page 86 of the record:

'In deciding whether the design is new the design must be compared with another design alleged to have been published or used before the registration of the 1st defendant's design. It is after the comparison that the crucial determination of the question of prior publication or prior use can be made. The design of the plaintiff for the kitchen containers is not before me in this suit. The design of the 1st defendant is however before me. It is contained in the document annexed to Exhibit 13.'

The point made by the learned trial Judge is not only good logic but also good sense. There is so much in it and so much to admire. A party who alleges the earlier existence of a design must certainly prove such existence. And the most fundamental way of proof is the tendering of the design in court. It is only when the court physically sees and examines the earlier design along with the other one that a judicious conclusion based on the Judge's wisdom or sagacity will be drawn. Otherwise, the exercise is an impossible one, the Judge being a human being and not God, who is omniscience. A Judge's power of inquiry has human limitations, and such is the predicament of the learned trial Judge in the circumstances of the non-tendering of the so claimed earlier design, of the appellant." "With the greatest respect, I know of no law which says that where a product is tendered in a court of law, that makes the tendering of the design otiose or superfluous. In other words, it is the submission of learned counsel that a product is a legal substitute for a design in a matter which is determined on the basis of section 13 of the Patents and Designs Act. That cannot be the law. I do not know of one and learned counsel did not assist the court by citing any to us. In a matter concerning novelty in the way of designs, which permeates to the element of newness provided for in section 13 of the Act, the physical inspection of the design in question is a desideratum. There is no halfway to it. The findings of the learned trial Judge that Exhibits 3 A and 3B were similar to Exhibit 3 in shape, size and substance do not detract from the sanctity and aura surrounding an industrial design within the meaning of section 32 of the Act vis-a-vis the allodial rights of the design owner under the Act."

4. On Meaning of "new" in relation to industrial design -

The adjective "new" etymologically means lately made or produced, fresh, not much used. It also means having lately happened, recent and modern. Thus, nothing will be counted new or original unless it differs from what has gone before by something more than ordinary trade variants, or features res common in the trade.

5. On Criteria for determining the newness of an industrial design for purposes of registration of the design -

Under section 13(3) of the Patents and Designs Act, an industrial design is not new, if before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the registrar that the creator of the design could not have known that it had been so made available. In the instant case, while the appellant could invoke the first arm of this subsection which is enabling or peremptory, the respondent could invoke the second arm as a defence.

6. On Criteria for determining the newness of an industrial design for purposes of registration of the design -

Under section 13(5) of the Patents and Designs Act, an industrial design is not new merely because it differs in minor or inessential ways from an earlier design or concerns a type of product other than the type with which an earlier design is concerned. By this subsection, in order to qualify as new, the design must be materially or substantially different from an earlier design. A mere trade or business variation without more is a mere garb which is incapable of wearing the nomenclature "new". Thus, a design which is cosmetically different from an earlier one may amount to a trade, gimmick which is designed essentially or materially to overreach the business society and equity will not make available its sympathetic hands to such a design.

7. On When an industrial design is deemed known to the public in determining its newness for the purpose of registration of the design -

By virtue of section 13(4) of the Patents and Designs Act, an industrial design will not be deemed to have been made available to the public solely by reason of the fact that within the period of six months preceding the filing of the application for registration the creator had exhibited it in an official or officially recognized exhibition.

8. On Proof of documents -

By virtue of section 93 of the Evidence Act, the contents of a document may be proved either by primary or secondary evidence. Under section 94(1) of the Act, primary evidence means the document itself produced for the inspection of the court. Thus, unless there is evidence that there exists a document on an issue before the court, the best evidence is the production of the document, unless it has been destroyed or stolen or can only be procured by incurring heavy and substantial expenses. The production could either be by way of primary or secondary evidence. Failure to do so in the absence of a tenable explanation, will be fatal to the case of the party. In the instant case, in the light of the claim of the appellant in evidence that it procured a design, there was need to tender the design in court as required by the Evidence Act. Failure to do so clearly attracts the inference under section 149(d) of the Act that the appellant withheld the evidence because it was unfavorable to it. [Bello v. Kassim (1969) 1NMLR 148; Arum v. The State (1974) 4 ECSLR 368; Onah v. State (1985) 3 NWLR (Pt. 12) 236; Enahoro v. Queen (1965) 1 All NLR 125; Opolo v. State (1977) 11-12 SC.; Awosile v. Sotunbo (1986) 3 NWLR Pt 29) 471 referred to.]

9. On Onus of proof on plaintiff -

The person who makes allegations in a pleading is, by the ordinary rules of pleadings, bound to produce evidence to substantiate them as parts of his case. This onus is generally, though not invariably, on the plaintiff in any given case. Thus, where a plaintiff fails to prove a fact or facts essential to his case, a court of law is competent to dismiss the case. In the instant case, since the appellant did not discharge the burden of proof either on the basis of preponderance of evidence or on probability,

the trial court was correct in dismissing its claim. [Akinfosile v. Ijose (1960) SCNLR447; Abiodun v. Adehin (1962) 2 SCNLR 305; Elias v. Disu (1962) 1 SCNLR 361; George v. U.B.A. (1972) 8-9 SC. 264; The Nigerian Safety Insurance Co. Ltd v. Zaria Co-operative Credit Marketing Union Ltd (1978) 1 NLAR 1; Edieazu v. Awka Community Council (1980) 7 C.A. (Pt. 1) 103 referred to.]

NOTABLE PRONOUNCEMENT:

10. On Duty on counsel to exercise sound professional judgment in exploring a party's right of appeal -

"In an effort to win, and a fairly desperate one for that matter, learned counsel for the appellant tried to distinguish the facts of this case from those of the sister case which was decided by this division on Tuesday 7th July 1998. It is the case of Densy Industries Limited v. Sunday Uzokwe (1998) 9 NWLR (Pt.567) 569. I have read that case, and I do not see any substantial or functional difference to make a difference in this judgment. Both cases have to do with the newness or otherwise of design No.4464. While design No.4464 was Exhibit 1 in the above case, it is Exhibit 13 in this appeal. Does that really make any difference' I think not. In judicial proceedings, the number given to an exhibit is not material. What is material is the substance or content of the exhibit tendered and admitted. I can say this much on the correctness of the decision. After all, I was not in the panel and so the issue of passing judgment on a case earlier done by me does not arise. I do hope I have the jurisdiction to agree with the judgment of my learned brothers.

In the light of the above decision of this division, I expected counsel to withdraw this appeal. Unfortunately, he thought differently and that raises a problem which has bothered me over the years, and it is the right of appeal. It is elementary law that appeal is both a constitutional and a statutory right which an aggrieved party is free to exercise. Although the decision is presumed to have been taken by the party himself, there are many known cases where counsel plays the role of a mace bearer. In most cases, he plays the role well. In some cases, he does not. With respect, in this case, counsel ought to have advised his client against appeal in the light of our 7th July 1998 decision. It is one thing for counsel to try a matter on appeal where the authorities are either slippery or not sacrosanct on an issue. It is quite another for counsel to appeal as a gamble. It is yet quite another for counsel to show some recalcitrance in the appeal decision. In the last case, counsel is not fair to his client, for he is the person who incurs the expenses. It is rather sad that the appellant was pushed into this appeal in the clear face of our 7th July 1998 decision. I can guess the next journey of this case. And so I ask the question: to what extent will counsel be involved in the appeal decision' There is not much the law can do, but there is so much that counsel, as ministers in the temple of justice can do. There should be some self-searching exercise. That is one way to reduce the financial burden of litigants who mostly rely on the professional advice of counsel just like the way the baby relies on the mother.

I have a very great temptation to award costs personally against counsel, but I am struggling to overcome the temptation, and for only one reason. All that I have said above is largely conjectural as what happens in counsel's chambers, is not a matter of public property. I am not even sure that I have the jurisdiction to be so conjectural. May he, in a matter such as this not affecting the merits of the matter, "yes". Even then, let me hold my brakes. It is possible I am wrong in my thinking that counsel urged the appeal decision on his client. In order to play safe therefore, I will award the cost in the usual tradition and that is against the appellant who has lost the appeal. And this I assess at N4, 000.00. After all, he should accept the professional performance of his counsel cum onere."

Nigerian Cases Referred to in the Judgment:

Abiodun v. Adehin (1962) 2 SCNLR 305
Adejumo v. Ayanlegbe (1989) 3 NWLR (Pt. 1 10) 417
Akinfosile v. Ijose (1960) SCNLR 447
American Cyanamid v. Vitality Pharmaceuticals Ltd. (1991) 2 NWLR (Pt.171) 15
Arum v. The State (1974) 4 ECSLR 368
Awosile v. Sotunbo (1986) 3 NWLR Pt. 29) 471
Bello v. Eweka (1981) 1 SC 101
Bello v. Kassim (1969) 1 NMLR 148
Daisy (Nig.) Ltd. v. Uzokwe (1998) 9 NWLR (Pt.567) 569
Echeazu v. Awka Community Council (1980) 7 C.A. (Pt. 1) 103
Elias v. Disu (1962) 1 SCNLR 361
Enahoro v. Queen (1965) 1 All NLR 125
George v. U.B.A. (1972) 8-9 SC. 264
Onah v. State (1985) 3 NWLR (Pt. 12) 236
Opolo v. State (1977) 11-12 SC. 1
The Nigerian Safety Insurance Co. Ltd v. Zaria Co-operative Credit Marketing Union Ltd (1978) 1 NLAR 1

Foreign Cases Referred to in the Judgment:

British Thompson Houston v. Grompton Partinsion (1935) 52 R.P.C 409
In Re Trainers Application (195 I) 68 P.R.C. 255
Legatti v. Woods (1949) 66 R.P.C. 293
Minnesota Mining and Manufacturing Applications (1969) R.P.C. 95
Phillips v. Harbro Rubber Co. (1920) 37 R.P.C. 233.
Thermo/Syndicates Applications (1961) R.P.C.

Nigerian Statutes Referred to in the Judgment:

Evidence Act. Cap. 1 12. Laws of the Federation of Nigeria, 1990, Ss. 9.7, 94(1) & 149(d)

Patents and Designs Act,Cap. 344 Law s of the Federation of Nigeria, 1990, Ss. 13(1)(a), (2), (3), (4) & (5).

Books Referred to in the Judgment:

Documentary Evidence: The Law, Practice and Procedure, by Yargata B. Nimir and Sunday S. Obende, 1998, Pp. 10-32.

Appeal:

This was an appeal against the decision of the trial court dismissing the case of the appellant for want of evidence. The Court of Appeal, in a unanimous decision, dismissed the appeal.

TOBI, J.C.A. (Delivering the Leading Judgment): This matter has to do with a design. It bears registration No.4464. The appellant, as plaintiff, asked for two declarations in the lower court: (1) That the 1st defendant (now respondent) has not acquired any exclusive privileges or rights in Nigeria in the design. (2) That the design is invalid being neither new nor original and rectification of the register of designs by the 2nd defendant.

After hearing evidence from the parties, the learned trial Judge dismissed the case of the appellant. He said in the last paragraph of the judgment:

"After a careful consideration of the evidence adduced, the submissions of the learned counsel for both sides and the case law I have come to the conclusion that the failure of the plaintiff to tender the industrial design applied in the production of Exhibits 3A and 3B is fatal to its case. The plaintiff has therefore not proved that the 1st defendant's registered design No.4464 is not new. Consequently, the suit is hereby dismissed with N500.00 costs to each of the defendants"

Dissatisfied, the appellant filed an appeal. As usual, briefs were duly filed and exchanged. The appellant formulated issues for determination. In the course of arguing the brief, learned counsel for the appellant, Mr. O. Oyewole. Sought leave of court to withdraw issues (b) and (c). This court struck out the two issues accordingly. The two issues left for determination in this appeal are:

"(a) Whether Exhibit 13 (design No.4464) was new at the time it was registered, in compliance with the requirements of section 13(1)(a) of the Patents and Designs Act Cap. 344 of the Law's of the Federation of 1990 ("the Act") ...

(d) Whether the findings of the trial Judge that the appellants had failed to prove that registered design No.4464 was not new at the time it was registered can stand in view of the probative and overwhelming evidence adduced before the lower court."

On the other hand, the respondent formulated the following four issues for determination.

"(i) Whether or not Exhibit 13 (registered design No.4464) was new at the time it was registered.

(ii) Whether the rights conferred on the registered owner of an industrial design by section 19(1) of the Patents and Designs Act are rights which can be enjoyed by the respondent in his business name.

(iii) Whether the respondent is the registered owner of Exhibit 13.

(iv) Whether the trial Judge was not correct in holding that the appellants have failed to prove that the registered design No.4464 was not new at the time it was registered."

Before learned counsel for the appellant argued the brief, he urged this court to discountenance paragraphs 4.10 to 4.19 of the brief. These were accordingly struck out. Dealing with issue (a), learned counsel called the attention of the court to section 13 of the Patents and Designs Act, 1990 and contended that it is clear from the provisions of section 13(3) that the presumption of novelty or newness created under section 13(2) can be rebutted by credible evidence that the design has been made available to the public before the date of application for registration.

Referring to the evidence of PW1 and PW2, learned counsel submitted that since there was no contradiction thereof, they are admissible and acceptable in law. He relied on *American Cyanamid v. Vitality Pharmaceuticals Limited* (1991) 2 NWLR (Pt. 171) 15 at 28; *Bello v. Eweka* (1981) 1 SC. 101 and *Adejumo v. Ayantegbe* (1989) 3 NWLR (Pt. 110) 417.

Learned counsel submitted that it was not necessary for the appellant to tender the design by which Exhibits 3A and 3B were produced in view of the overwhelming evidence already before the court and the findings of the learned trial Judge that Exhibits 3, 3A and 3B were actually similar in shape, size and substance. He contended that section 13(3) of the Act shows clearly that it is not necessary to tender the design in evidence if before the date of application for registration, same "has been made available to the public anywhere and at any time by means of description, use or in any other way..."

Relying also on section 12 of the Act, learned counsel contended further that the section places emphasis on the application of designs in some industrial process. Since the application of design No.4464 resulted in Exhibit 3 and the trial Judge had found as a fact that Exhibits 3A and 3B were similar to Exhibit 3 in shape, size and substance, and that Exhibits 3A and 3B were already being produced by the appellants as far back as 1987, the trial Judge ought to have concluded that design No.4464 was not new and original at the time it was registered in 1991 learned counsel argued.

Counsel submitted that the conclusion of the trial Judge that the existence in Denmark of the design used by the appellant in producing the kitchen containers in Nigeria cannot validly be the basis for annulling the registration of a design in Nigeria, is flawed. This is because the appellant's case was that design No.4464 was neither new nor inventive as similar products were already in the market, counsel contended. He submitted that the aim of the Act is to afford protection to true inventors and not to encourage people to simply copy designs of products that are already freely obtainable in the market for registration, in order to claim undeserved advantage over others who have been manufacturing similar products before the design was registered.

Contending that the court could declare the registration of design No.4464 null and void under section 22(l) (b) of the Patents and Designs Act, counsel urged the court to allow the appeal.

Dealing with issue No. 1. learned counsel for the respondent. Mr. S. O. P. Okeke called the attention of the court to paragraph 9 of the further amended statement of defence. the evidence of the P.W.I PW.2 and the respondent and submitted that the only reasonable conclusion from the evidence of P.W.I. and P.W.2 is that the appellant "might be producing other plastic product by 1987 but definitely not the plastic kitchen container of the design No.4464. Exhibits 3. 3A C and 3B. He further submitted that the trial Judge was correct in holding that the appellant did not prove that the 1st defendant's registered design No.4464 is not new. It was the argument of learned counsel that in deciding whether the design is new or not. the design must be compared with another design alleged to have been published or used before the registration of the design No.4464. Since Exhibits 3-3B were said to be bought and not produced, there was no basis for comparison of the design of prior use, counsel argued.

Counsel contended that where prior use is relied upon, the particulars must not only state what was used and where and by whom and the first and last dates at which the use took place, but also in a case where apparatus alleged to have been used previously is still in existence, where it can be inspected by or on behalf of the plaintiff or the court. He relied on *British Thompson Houston v. Crompton Partinsion* (1935) 52 R.P.C. 409 at 414; *Legatti v. Hoods* (1949) 66 R.P.C. 293.

Counsel argued that the mere production of documents of importation of apparatus can never become a conclusive evidence of prior use of a design. There is always a substantial tradition of unwillingness on the part of jurists to decide questions of prior use in favour of an opponent, unless every detail is apparent on the fact of the document produced to establish prior use, counsel further argued. He relied on *Thermal Syndicates Applications* (1961) R.P.C. *Minnesota Mining and Manufacturing Applications* (1969) R.P.C. 95.

In view of the fact that issue No.2 of the respondent is the same as issue (b) of the appellants which was withdrawn and struck out. I shall not deal with that issue. So too issue No.3 of the respondent. It is realised that the respondent's brief did not argue

issue No.4 and so I will stop here, but not before saying that learned counsel urged the court to dismiss the appeal.

I think the fulcrum or prop of this appeal is whether Exhibit 13 was new at the time it was registered, within the meaning of section 13 of the Patents and Designs Act, 1990. This is the first and main issue of both the appellant and the respondent. And this is a matter of substantive law. Tied to this is the issue of proof which is a matter of adjectival or procedural law. This is the second issue of the appellant.

Section 13(1) of the Act provides that, subject to the section, an industrial design is registrable if (a) it is new; and (b) it is not contrary to public order or morality. As it is, only section 13(1)(a) is relevant for our purpose: section 13(1)(b) is not. By section 13(2), where application is made for the registration of an industrial design, the design will be presumed to be new at the time of the application except in so far as section 13(3), (4) and (5) provide otherwise. Again, as it is, the presumption in section 13(2) is rebuttable, and this will be by evidence on the part of the party alleging that the design was not new at the time of the application. Once the evidence vindicates any of section 13(3)(4) and (5) of the Act, a court of law is bound to hold that the design was not new at the time of the application.

I move to the three subsections. By subsection (3), an industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the registrar that the creator of the design could not have known that it had been made so available. By subsection (4) an industrial design will not be deemed to have been made available to the public solely by reason of the fact that within the period of six months preceding the filing of the application for registration the creator has exhibited it in an official or officially recognised exhibition.

Subsections (3) and (4) have some inter union as they are intertwined. And so, they have to be construed together in order to really know or appreciate the intention or intendment of the draftsman. Subsection (3) has two arms. The first which can be referred to as the enabling or peremptory arm clearly states the situation or instance when the design will not be regarded as new. And that situation or instance is when it is made available to the public. Now, the second arm. The arm which begins with the conjunction "unless", unlike the first arm, is neither enabling nor peremptory. On the contrary, it has the character of exception. In the context of this appeal, while the appellant could invoke the first arm of the subsection, the respondent could invoke the second arm as a defence.

There is a nexus between the two subsections. I had mentioned it. It is the element of "public" in them. While subsection (3) provides for a situation when or where the design in law is made available to the public, subsection (4) provides for the opposite situation, that is to say when or where the design, in law, is not made available to the public.

And finally, subsection (5) provides that an industrial design is not new merely because it differs in minor or inessential ways from an earlier design or concerns a type of product other than the type with which an earlier design is concerned. By the subsection, in order to qualify as new, the design must be materially or substantially different from an earlier design. A mere trade or business variation without more is a mere garb which is incapable of wearing the nomenclature "new" in the context of subsection (5). A design which is cosmetically different from an earlier one may amount to a trade gimmick which is designed essentially or materially to overreach the business society and equity will not make available its sympathetic hands to such a design. Certainly not.

The adjective "new" etymologically means lately made or produced, fresh, not much used. It also means having lately happened, recent and modern. In *Re Trailers Application* (1451) 68 P. R. C. 255, the court held that nothing will be counted new or original unless it differs from what has gone before by something more than ordinary trade variants or features common in the trade. See also *Phillips v. Harbro Rubber Co.* (1920) 37 R.P.C. 233.

It is the contention of the appellant that Exhibit 13 was not new at the time it was registered. To the appellant, his design had existed and so was first in time. The learned trial Judge raised the following fundamental point in the course of his evaluation of evidence at page 86 of the record: "In deciding whether the design is new the design must be compared with another design alleged to have been published or used before the registration of the 1st defendant's design. It is after the comparison that the crucial determination of the question of prior publication or prior use can be made. The design of the plaintiff for the kitchen containers is not before me in this suit. The design of the 1st defendant is however before me. It is contained in the document annexed to Exhibit 13."

The point made by the learned trial Judge is not only good logic but also good sense. There is so much in it and so much to admire. A party who alleges the earlier existence of a design must certainly prove such existence. And the most fundamental way of proof is the tendering of the design in court. It is only when the court physically sees and examines the earlier design along with the other one that a judicious conclusion based on the Judge's wisdom or sagacity will be drawn. Otherwise, the exercise is an impossible one, the Judge being a human being and not God, who is omniscience. A Judge's power of inquiry has human limitations, and such is the predicament of the learned trial Judge in the circumstances of the non-tendering of the so claimed earlier design, of the appellant. Reacting to the conclusions of the learned trial Judge on the non-tendering of the design, learned counsel for the appellant submitted thus:

"It is respectfully submitted that it was not necessary for the appellant to tender the design by which Exhibits 3A and 3B were produced in view of the overwhelming evidence already before the court and the findings of the learned trial Judge that Exhibits 3.3A and 3B were actually similar in shape, size and substance. Section 13(3) of the Act show clearly that it is not necessary to tender the design in evidence if

before the date of application for registration, same has been made available to the public anywhere and at any time by means of description, use or in any other way ...

By the above, learned counsel has made quite some loaded claims, apparently based on law and a bit on facts. The factual aspect is on what learned counsel referred to as "overwhelming evidence already before the court", an aspect I will deal with later. For now, let me deal with the law.

With the greatest respect, I know of no law which says that where a product is tendered in a court of law, that makes the tendering of the design otiose or superfluous. In other words, it is the submission of learned counsel that a product is a legal substitute for a design in a matter which is determined on the basis of section 13 of the Patents and Designs Act. That cannot be the law. I do not know of one and learned counsel did not assist the court by citing any to us. In a matter concerning novelty in the law of designs, which permeates to the element of newness provided for in section 13 of the Act, the physical inspection of the design in question is a desideratum. There is no halfway to it. The findings of the learned trial Judge that Exhibits 3A and 3B were similar to Exhibit 3 in shape, size and substance do not detract from the sanctity and aura surrounding an industrial design within the meaning of section 32 of the act vis-a-vis the allodial rights of the design owner under the Act. And I so hold. That is the first submission on law.

The second aspect of the submission on law is predicated on section 13(3).

Because of the strangeness of the submission. I must read it the second time:

"An industrial design is not new if, before the date of application for registration, it has been made available to the public anywhere and at any time by means of description, use or in any other way unless it is shown to the satisfaction of the registrar that the creator of the design could not have known that it had been made so available".

How does section 13(3) accommodate the submission of learned counsel? Why does learned counsel really think that section 13(3) is handy and helpful? Although section 13(3) deals both with substantive and adjectival law, it is my view that the adjectival aspect of the law has not the legal capacity to bear the burden suggested by learned counsel. It does not appear that I sound clear. Perhaps I could sound clearer by illustrating the two situations. While the adjectival aspect of section 13(3) anticipates giving of evidence by the creator that he had no knowledge that the design was made available to the public before the date of the publication, the burden learned counsel for the appellant gives to the subsection is that by it, a party, and specifically, his client, the appellant, is under no legal duty to tender the design.

Since section 13(3) does not so provide, this court is free to look at the law of evidence on the issue. And here, I can take most elementary first principles of law. By the Evidence Act, the contents of a document may be proved either by primary or secondary evidence. That is the language of section 93 of the Evidence Act. Primary evidence means the document itself produced for the inspection of the court. That is

the language of section 94(1) of the Evidence Act. See generally the recent book by Yargata Nimpar and Sunday S. Obende entitled: Documentary Evidence: The Law Practice and Procedure, Jos University Press Ltd. (1998). 10 to 32.

Where there is evidence that there exists a document on an issue before the court the best evidence is the production of the document unless it has been destroyed or stolen or can only be procured by incurring heavy and substantial expenses. The production could either be by way of primary or secondary evidence. Failure to do so in the absence of a tenable explanation, will be fatal to the case of the party.

In the light of the claim of the appellant in evidence that it procured a design, there was need to tender the design in court as required by the Evidence Act. Failure to do so clearly attracts the invocation of section 149(d) of the Act. See Bello v. Kassim (1969) NMLR 148; Arum v. The State (1974) 4 ECLSR 368; Onah v. The State (1985) 3 NWLR (Pt.12) 236; Enahoro v. The Queen (1965) 1 All NLR 125; Opolo v. The State (1977) 11-12 SC 1; Awosile v. Sotunho (1986) 3 NWLR (Pt.29) 471.

Learned counsel for the appellant referred to the evidence of PW1 and PW2 which included Exhibits 3A and 3B as "overwhelming". I have thoroughly examined the evidence of the witnesses, including the two exhibits and I do not, with respect, agree with learned counsel that the evidence is overwhelming. As a matter of law, the evidence before the learned trial Judge did not come near the proof of the case of the appellant: not to talk of being overwhelming.

The person who makes allegations in a pleading is, by the ordinary rules of pleading, bound to produce evidence to substantiate them as part of his case. That person is generally the plaintiff though not invariably so. Where a plaintiff fails to prove a fact or facts essential to his case, a court of law is competent to dismiss the case. See generally Akinfosile v. Ijose (1960) 5 FSC 192 (1960) SCNLR 447; Abiodun v. Adehin (1962) 1 All NLR 550; (1962) 2 SCNLR 305; Elias v. Disu and others (1962) 1 All NLR 214; (1962) 1 SCNLR 361; George v. U.B.A. (1972) 8-9 SC 264; The Nigerian Safety Insurance Co. Ltd. v. Zaria Co-operative Credit Marketing Union Ltd. (1978) 1 NCAR I; Echeazu and others v. Awka Community Council and others (1980) 7 CA (Pt. 1) 103. Since the appellant did not discharge the burden of proof either on the basis of preponderance of evidence or on probability, the learned trial Judge, in my humble view, was correct in dismissing his claim.

In an effort to win, and a fairly desperate one for that matter, learned counsel for the appellant tried to distinguish the facts of this case from those of the sister case, which was decided by this division on Tuesday, 7th July, 1998. It is the case of Densy Industries Limited v. Sunday Uzokwa (1988) 9 NWLR (Pt.567) 569. I have read that case, and I do not see any substantial or functional difference to make a difference in this judgment. Both cases have to do with the newness or otherwise of design No.4464. While design No.4464 was Exhibit 1 in the above case, it is Exhibit 13 in this appeal. Does that really make any difference? I think not. In judicial proceedings, the number given to an exhibit is not material. What is material is the substance or content of the exhibit tendered and admitted. I can say this much on the correctness

of the decision. After all, I was not in the panel and so the issue of passing judgment on a case earlier done by me does not arise. I do hope I have the jurisdiction to agree with the judgment of my learned brothers.

In the light of the above decision of this division, I expected counsel to withdraw this appeal. Unfortunately, he thought differently and that raises a problem which has bothered me over the years, and it is the right of appeal. It is elementary law that appeal is both a constitutional and a statutory right which an aggrieved party is free to exercise. Although the decision is presumed to have been taken by the party himself, there are many known cases where counsel plays the role of a mace bearer. In most cases, he plays the role well. In some cases, he does not. With respect, in this case, counsel ought to have advised his client against appeal in the light of our 7th July 1998 decision. It is one thing for counsel to try a matter on appeal where the authorities are either slippery or not sacrosanct on an issue. It is quite another for counsel to appeal as a gamble. It is yet quite another for counsel to show some recalcitrance in the appeal decision. In the last case, counsel is not fair to his client, for he is the person who incurs the expenses. It is rather sad that the appellant was pushed into this appeal in the clear face of our 7th July 1998 decision. I can guess the next journey of this case. And so I ask the question: to what extent will counsel be involved in the appeal decision? There is not much the law can do, but there is so much that counsel, as ministers in the temple of justice can do. There should be some self-searching exercise. That is one way to reduce the financial burden of litigants who mostly rely on the professional advice of counsel just like the way the baby relies on the mother.

I have a very great temptation to award costs personally against counsel, but I am struggling to overcome the temptation, and for only one reason. All that I have said above is largely conjectural as what happens in counsel's chambers, is not a matter of public property. I am not even sure that I have the jurisdiction to be so conjectural. May be, in a matter such as this not affecting the merits of the matter, yes".

Even then, let me hold my brakes. It is possible I am wrong in my thinking that counsel urged the appeal decision on his client. In order to play safe, therefore. I will award the cost in the usual tradition and that is against the appellant who has lost the appeal. And this I assess at N4.000.00. After all, he should accept the professional performance of his counsel cum onere.

SALAMI, J.C.A.: I agree.

UBAEZONU, J.C.A.: I agree.

Appeal dismissed

Counsel:

O. Oyewole - for the Appellant

S.O.P. Okeke - for the Respondent.