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International **Comparative** Legal Guides



Patents **2021**

A practical cross-border insight into patent law

11th Edition

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Zambia

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Joseph A. Jalasi



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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

Section 79 (1) of the Patents Act provides that:

"A patentee or exclusive licensee shall have the right to commence court proceedings against a person who is alleged to have infringed or is performing any act likely to cause an infringement of a patentee's right in a patent."

There is no choice between the tribunals, all patent infringement matters are commenced in the High Court.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

Parties are not required to undertake mediation before commencing court proceedings. The parties will have to voluntarily agree to mediation. Mediation and arbitration are commonly used methods of alternative dispute resolution (ADR) in Zambia. Order 19 Rule 3 of the High Court Rules provides that the judge may refer parties to mediation or to arbitration after commencement of court proceedings. Where a matter has been referred to mediation and is not settled within 45 days, it shall be referred back to the judge; within 14 days the judge must summon the parties and give directions.

1.3 Who is permitted to represent parties to a patent dispute in court?

Parties can either represent themselves, or engage legal practitioners to represent them.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

To commence proceedings, parties will have to file a writ of summons and statement of claim in court. Order 6 Rule 1 of the High Court Rules provides that every action must be commenced by a writ of summons unless an act or statute indicates which mode of commencement is to be used. The Patents Act does not have any provision stating the mode of commencement.

Order 19 of the High Court Rules provides the procedure for what happens after the statement of claim has been served and the defence has been settled. The judge shall summon the parties to a scheduling conference so that the court can issue orders and directions.

If a party does not respond, the judge will follow up, and if the parties respond the court will address the issue of inspection, admission, interrogatories and the mode and place of trial. The court will give directions as to when parties must conduct discovery and inspection. Normally, this is within 14 days from the date of the order. Inspection follows maybe 14 days thereafter. So, it will approximately take about a month or so to get to trial.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Yes. A party can be compelled to disclose relevant documents after commencing court proceedings by way of discovery and inspection. According to Order 24 Rule 7 of the Rules of the Supreme Court (White Book), after discovery and inspection a party can file an order of discovery to compel the other party to produce relevant documents. However, a party can be compelled to disclose the relevant documents before trial should they wish for a more advanced list of documents.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

The court or the judge shall, not later than 21 days after the appearance and defence have been filed, summon parties to a scheduling conference and issue directions with respect to setting for filing court documents.

Yes, technical evidence which we refer to as "Expert Evidence" may be produced. Parties seeking to adduce expert evidence from the court must apply for leave from the court in accordance with the provisions of Order 38 Rule 36 of the Rules of the Supreme Court (White Book) 1999 Edition.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

Yes, an amendment of pleadings is allowed before and/or at trial. The parties can file their written skeleton arguments before the trial with the Commercial Court. In the General List, there is no such requirement as there are no opening arguments; arguments are filed at the conclusion of the trial.

With respect to evidence, in the General List there are oral arguments and in the Commercial Court the parties will file witness statements.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The time frame varies from case to case, but on average in the Commercial Court the trial can take six to 12 months.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

Yes, parties can utilise the WIPO Arbitration and Mediation Center, which is a neutral, international and non-profit dispute resolution provider. Unlike a trial, these ADR methods are less formal and perhaps more time- and cost-efficient. The procedures are open to any person or entity, regardless of nationality or domicile. They may be held anywhere in the world, in any language and under any law chosen by the parties.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are public documents and so are all other proceedings on a court record.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

Decisions made in the Supreme Court are binding on all lower courts as the courts apply the principal of *stare decisis*. Judgments from other jurisdictions are only of a persuasive nature, but they are not binding, especially those from the commonwealth and common law jurisdictions.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

There is a commercial division of the High Court; however, there is no specialised Court for Intellectual Property.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

Section 79 (1) of the Patent Act sets out the *locus standi* for bringing an intellectual property infringement, revocation and declaratory proceedings and states that a patentee or exclusive licensee shall have the right to commence court proceedings against a person who is alleged to have infringed or is performing any act likely to cause an infringement of a patentee's right in a patent.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

(i) Yes, declarations can address non-infringement. According to Section 84 of the Patents Act:

- (1) A person who is interested in a protected patent may apply to the High Court for a declaration, by the Court, of the performance of a specific act, by the applicant, as not constituting an infringement of the patentee's right in the protected patent.
- (2) The patentee, an assignee or licensee shall have the right to be joined as defendants in the proceedings referred to in subsection (1).
- (3) The High Court shall not make the declaration, referred to in subsection (1), if: (a) the act to which the application relates is already a subject of infringement proceedings; or (b) the person making the application fails to satisfy the court that the person had previously written to the patentee, requesting for a written acknowledgment of whether such act is infringing or non-infringing, and the patentee has failed or neglected to respond to such request within a reasonable period.

(ii) In accordance with the WIPO, declarations can be made over a technical standard or hypothetical activity.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

No, a party cannot be liable for infringement as a secondary infringer.

And in response to the second question, Section 72 (1) (c) of the Patents Act provides that a party can infringe by supplying part of the infringing product or process.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

No, patents are territorial rights. The exclusive rights are only applicable in the country or region in which a patent has been filed and granted, in accordance with the law of that country or region.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

No, protection does not extend to non-literal equivalents in Zambia.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

Yes, a defence of patent invalidity can be raised and the defence will be pleaded in the defendants' defence if the opposition is in the High Court. If the opposition is before the Registrar at Patents and Companies Registration Agency (PACRA), Section 57(2) of the Patents Act provides that where an applicant for a grant of a patent wishes to contest a notice opposing the grant of a patent, the applicant shall, within the prescribed period, or

any such further period as the Registrar may allow, file, with the Registrar, a counterstatement setting out particulars of the grounds on which the notice is contested.

There are no restrictions on such defence. The defence will be made in response to the pending opposition as the issues of invalidity and infringement will be heard in the same proceedings both before the Registrar and proceedings before the High Court.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “Formstein defence”)?

See question 1.17 above. Infringement by equivalence is not applicable in Zambia.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

The patent has to be capable of industrial application. If the patent does not have this trait, then there is a ground to consider it as invalid.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

As a general rule applicable to all litigation, a party can apply to stay other proceedings on grounds such as it being in the interest of orderly resolution that one matter be stayed to properly resolve the other matter. This is designed to avoid multiplicity in the administration of justice.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

Section 83 of the Patents Act provides for innocent infringement, where the defendant was not aware and had no reasonable grounds for supposing that the patent existed.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

Yes, preliminary injunctions are available on an *ex parte* basis if a party highlights that a particular infringement ought to be stopped immediately. *Inter partes* are also available once the court grants an *ex parte*. However, once the court decides that there is no urgency, the court will hear it *inter partes*. This also applies where the court expresses doubt or would like to seek clarity on whether the patent infringement requires an immediate stop or otherwise.

There is no requirement for a bond, but the party taking out an injunction must have an understanding of the potential damages.

The basis on which injunctions are granted is that the application must adhere to the following principles:

- (i) there must be a serious question to be tried;
- (ii) damages will not be sufficient (the plaintiff will not be adequately compensated by an award of damages at the trial);
- (iii) balance of convenience; and
- (iv) preserving the *status quo*.

In accordance with Section 99 of the Patents Act, a public interest defence is available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device. See question 3.2 below.

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive damages available?

The principal in Zambian Courts on assessment will follow the common law position, which is that damages for infringement/validity will be assessed separately. This is pursuant to the English Extent Act Chapter 10 and 11 of the Laws of Zambia.

Zambia applies principles of common law where there is no decided case in Zambia. Similarly, the basis for damages or account of profits will be according to the loss of profits suffered by the patentee arising out of infringing activities or by reference to a reasonable royalty rate. Nothing stops the assessing court from combining the two methods.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

According to Section 80 of the Patents Act, the court may grant any of the following reliefs:

- (a) an injunction to prevent an infringement of the patentee's or exclusive licensee's right, where infringement is imminent, or to prohibit the continuation of an infringement;
- (b) an order that the infringing product or article be delivered up;
- (c) award of damages;
- (d) account of profits;
- (e) payment of royalties;
- (f) destruction or disposal of infringing products or articles, as the court considers appropriate, in accordance with laws relating to public health and the environment; or
- (g) any other remedy the court may consider appropriate.

Please note that an *Anton Piller* Order is available to facilitate the search of premises and seizure of evidence without prior warning. It prevents distraction of evidence in cases of trademark/copyright patent infringements.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

No. All available reliefs are referred to in our answer to question 1.25.

1.27 How common is settlement of infringement proceedings prior to trial?

Patent infringement cases are very rare in Zambia; therefore studying frequency is very difficult.

1.28 After what period is a claim for patent infringement time-barred?

Section 79 of the Patents Act provides that infringement proceedings shall not be heard by the court unless the proceedings are commenced within a period of five years from the date on which the facts giving rise to such proceedings became known to the patentee or an exclusive licensee, except that the court may, in its absolute discretion, allow proceedings to be commenced after five years.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Yes. The appeal has to be on a point of law or a mixed point of law and fact; however, it cannot be simply based on fact.

1.30 What are the typical costs of proceedings to a first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

The costs awarded in patent cases are not too different to those in ordinary cases. The rule followed is that the party will bear its own costs. The costs are those prescribed in the Legal Practitioners Cost Order of 2017.

1.31 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? Will your country host a local division of the UPC, or participate in a regional division? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

This is not applicable in Zambia.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

Yes, patents can be amended *ex parte* after they have been granted.

Section 47 of the Patents Act provides that:

- (1) The Registrar may, on request by an applicant, authorise the correction of a clerical error in a document filed with PACRA.
- (2) Where a request for the correction of an error, referred to in subsection (1) concerns the description, claim or drawings, the correction shall be obvious and immediately evident that nothing else is intended than what is offered as a correction.
- (3) A request for the correction of a clerical error (as specified in subsection (1)) shall be made by the applicant in a prescribed manner and on payment of a prescribed fee.
- (4) Where it is proposed by the Registrar that a correction be made, other than the request referred to in subsection (3), the Registrar shall give notice of the proposed correction to the applicant for the grant of a patent.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

It is possible for amendments to be made. Section 91 of the Patents Act provides that:

- (1) An application for revocation of a patent, made in accordance with this section, shall be served by the Registrar on a person appearing on the Register as a patentee or person having an interest in the patent.
- (2) The Registrar shall, before revoking the patent, give the patentee or any person having an interest in the patent an opportunity to be heard.
- (3) Where an application for the revocation of a patent applies only to some parts of the claim in the complete specification, the Registrar may only revoke those parts, except that where the grounds for revocation are established with respect to the first claim of the patent, the patent shall be invalidated.

Therefore, due to a full or part revocation, the patent will be amended accordingly in the event that there is a change in the specifications.

2.3 Are there any constraints upon the amendments that may be made?

As mentioned in question 2.1, Section 47 (1) (2) of the Patents Act provides that the Registrar may, on request by an applicant, authorise the correction of a clerical error in a document filed with PACRA. The amendments are constrained to clerical errors concerning description, claim or drawings.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

The terms of the licence shall not have unjustified restrictions or be prejudicial to the economic interest of the country.

Section 97 (1) of the Patents Act provides that the Registrar may refuse to register a licence contract which imposes unjustified restrictions on the licensee or is prejudicial to the economic interest of the country.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes, a patent can be the subject of a compulsory licence. Section 99 of the Patents Act provides that a person may, after three years from the date of the grant of a patent, apply to the Minister for the grant of a compulsory licence on any of the following grounds:

- (a) that without reasonable cause, the patentee does not work the patented process in Zambia;
- (b) that the patented product or article is not available to the public in Zambia in sufficient quantity or at an affordable price;
- (c) that the refusal by the patentee to grant a contract licence, on reasonable terms, is prejudicial to the country's establishment and development of industries or commercial activities;
- (d) that the applicant for a contract licence has failed to obtain the patentee's consent for the use of the patented invention, under reasonable terms and conditions;

- (e) that the interest of public health or nutrition demand the commercial working of the patented invention in Zambia;
- (f) that there is a need to remedy the abuse of intellectual property rights or anti-competitive practices; or
- (g) that there is a national emergency which requires the use of the patented invention.

This type of licence is not very common. No compulsory licences have been issued in Zambia for the past five years.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

Extension of patents is allowed. Section 67 of the Patents Act provides that a patentee or an exclusive licensee may, six months before the expiry of the term of a patent, apply to the Registrar for an extension of the term of a patent for a further term not exceeding two years on any of the following grounds:

- (a) where there are hostilities between Zambia or any Commonwealth country and any other country generally and the patentee has suffered loss or damage; or
- (b) where an act of God occurs and the patentee has not been able to work the patent.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

Section 16 of the Patents Act provides that the following inventions shall not be patentable:

- (a) discoveries, scientific theories or mathematical methods;
- (b) schemes, rules or methods for doing business, performing purely mental acts or playing games or doing business;
- (c) literary, dramatic, musical or artistic work or any other artistic creation;
- (d) presentation of information; and
- (e) computer programs.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

No, this is not applicable.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

Yes, Section 56 of the Patents Act provides that a person, including the State, may oppose the grant of a patent at any time, within a period of three months from the date an application for a grant of a patent is advertised, or within such further period as the Registrar may allow, and before the sealing of the patent.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Yes, the appeal is made to the High Court of Zambia.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

A priority date of an invention shall be the earliest priority date claimed in an application, until the contrary is proven.

Section 41 of the Patents Act provides that the priority date of an invention, to which an application for the grant of a patent relates, shall be the date on which the application was first filed in the convention country.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

Yes, there is a grace period. The grace period is three months from the date an application for a grant of a patent is advertised to the public.

5.7 What is the term of a patent?

Section 65 of the Patents Act provides that the duration of every patent granted shall be 20 years from the filing date of the application for the grant of a patent.

5.8 Is double patenting allowed?

Yes, Section 74 of the Patents Act provides that where a patent is granted to two or more patentees, the patentees shall, subject to any agreement in force, be considered as joint owners.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

In accordance with Section 80 of the Patents Act, there are mechanisms of preventing the importation of a patentee or an exclusive licensee. The court may grant various reliefs such as an injunction to prevent an infringement of the patentee's or exclusive licensee's right, where infringement is imminent, or to prohibit the continuation of an infringement and an order that the infringing product or article be delivered up.

Obtaining such a court order can be immediate if it is *ex parte*. But if not granted *ex parte*, the court will grant a hearing date within a week. Parties are at liberty to file a certificate of urgency, which allow parties to approach the court and abridge the urgency of the matter.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

No, Section 3 (3) (a) of the Competition and Consumer Protection Act No. 24 of 2010 provides that this Act shall not apply to an agreement or conduct insofar as it relates to intellectual property rights including the protection, licensing or assignment of rights under, or existing by virtue of, a law relating to copyright, design rights, patents or trademarks.

7.2 What limitations are put on patent licensing due to antitrust law?

As mentioned in question 7.1, antitrust law does not apply to patents in Zambia.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

There have been no cases in Zambia where a FRAND licence has been issued; however, the principles applied in Zambia to an injunction are those as set out in the famous American Cyanamid case. As to whether Zambian Courts can grant a global injunction remains to be seen.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

None, although in 2016 Zambia repealed the 1958 Patents Act, bringing in a new regime.

8.2 Are there any significant developments expected in the next year?

There may be an introduction of the registrability of utility models or petty patents in Zambia.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

One noticeable trend in Zambia is the increase of pharmaceutical companies coming to register their patents. There is also an increase of Chinese companies coming to register patents, especially with respect to renewable energy.



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