

REGISTRATION OF TRADEMARKS IN NIGERIA.

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ABSTRACT

A trademark is a symbol or a sign which differentiates the goods and services of one business from another one.¹ A trademark may in particular consist of words, designs, letters, numerals or the shape of their packaging². A trademark provides protection to the owner of a mark by ensuring exclusive right to use it to identify goods or services, or to authorize another to use it in return for payment³. The registration of a Nigerian Trademark is under the control of the Registrar of Trademarks who is responsible for the registration of trademarks and other related activities pertaining to the exploitation of a registered mark⁴. He also acts under the general direction of the Minister in charge of commerce, trade and industry⁵. The Registrar of Trademarks is also the custodian of the trademark register which is the record in which all registered trademarks with the names and addresses of their proprietors, the dates on which applications were made for the registration, notification of assignments and transmissions, the names and addresses of all registered users and such other matters relating to trademarks as may be prescribed are entered⁶. The Minister also plays a major role in the registration of trademarks by making regulations for diverse purposes including the classifying of goods for the purpose of registration and for prescribing the fees to be paid in respect of applications, registrations and other matters under the Trademarks Act CAP T13 LFN 2004⁷.

1.0 INTRODUCTION

Registration of trademarks is the basic concept of trademark protection. It is a pre-condition for the institution of infringement action under the Trademarks Act⁸. Taking into consideration that registration is not mandatory; it still establishes ones right in a mark as there can be no infringement of an unregistered mark. For registration purposes, the Trademarks Act CAP T13 LFN 2004 divides the trademarks register into two parts: Part A and Part B⁹. Under both parts, registration of trademarks is in respect of particular goods or classes of goods as specified by the applicant¹⁰.

Registration of trademarks is usually in respect of specific goods such as medicines and cosmetics or classes of goods and reference would be made to the designated class as contained in the

¹ How to register a Trademark or Patent in Nigeria available at <<http://www.legalnaija.com/2013/09/how-to-register-trademark-or-patent-in.html>> accessed on 7th July 2017

² Oyewunmi A. O, *Nigerian Law of Intellectual Property* (University of Lagos Press 2015) pg. 236

³ How to register a Trademark or Patent in Nigeria available at <<http://www.legalnaija.com/2013/09/how-to-register-trademark-or-patent-in.html>> accessed on 7th July 2017

⁴ Ibid n (2) pg 237

⁵ Section 1 Trademarks Act CAP T13 LFN 2004

⁶ Section 2 (1) - (2) Trademarks Act CAP T13 LFN 2004

⁷ Section 42 and 45 Trademarks Act CAP T13 LFN 2004, Ibid n (1) pg. 238

⁸ Ibid n (2) pg 241

⁹ Ibid n (7)

¹⁰ Section 4 Trademarks Act CAP T13 LFN 2004

appropriate schedule of the Trademarks Act¹¹. The Registrar of Trademarks is vested with the power to tackle any question regarding the class of goods within which any goods fall and his decision is final.

This article intends to enlighten the reader on how trademarks are being registered in Nigeria and on all the facts one needs to know about registration of trademarks in Nigeria..

2.0 REGISTRATION OF TRADEMARKS IN NIGERIA

2.1 REGISTRATION UNDER PART A OF THE REGISTER.

To register a trademark, an application for registration needs to be made firstly¹². Majority of applications for registration of trademarks fall under Part A of the register¹³. Section 9 of the act states that for a mark to be eligible for registration under Part A, it must contain or consist of the following essential particulars:

- a. A name of a company, individual or firm represented in a special or particular manner.
- b. The signature of the applicant for registration or some predecessor in his business.
- c. An invented word.
- d. A word having no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or a surname.
- e. Any other distinctive mark such as colours

2.2.0 REGISTRATION UNDER PART B OF THE REGISTER.

A mark can be registered under Part B of the register where it is not sufficiently distinctive to qualify it for registration under Part A of the register¹⁴. To qualify for registration under Part B of the register, the mark has to be capable of being distinctive and it must distinguish the products in respect of which it is sought to be registered¹⁵.

It should be noted that even if a mark is not distinctive, it can be registrable under this Part provided it is capable of being distinctive in future with prolonged use¹⁶.

¹¹ Ibid n (7)

¹² Ibid n (7)

¹³ Trademarks Act CAP T13 LFN 2004

¹⁴ Ibid n (2) pg 246

¹⁵ Ibid n (13)

¹⁶ Ibid n (2) pg247

2.2.1 NON REGISTRABLE TRADEMARKS.

Certain marks are not permitted to be registered under the Trademarks Act for public policy considerations, consumer protection reasons and to safeguard the interest of businesses. Examples of such marks are marks that are deceptive and scandalous, marks that falsely imply official patronage, marks that seek to appropriate commonly known or generic designation and marks that are capable of causing confusion among consumers¹⁷.

a. Deceptive and Scandalous Trademarks

A mark would be tamed deceptive and therefore not protected under the law if it is capable of misleading or misinforming the consuming public by an untrue description of the character or quality of the goods in question or if it wrongly suggests a connection with another trader's product elsewhere¹⁸.

In *Orlwoola Trademark*¹⁹, Orlwoola was held to be deceptive if used as a trademark for clothing not made of wool and descriptive if used on clothes made of wool.

In *Ombrella Trademark*²⁰, Ombrella was rejected for shower curtains as it was descriptive of the applicant's umbrella shaped goods but descriptive for shower curtains of other shapes.

A mark would be scandalous if it is capable of causing disaffection or adversely affecting the mores of society²¹. For instance, marks with religious connotations, profane or vulgar marks and those that involve ethnic, gender or religious disparagement may be refused registration.

In the case of *Re Halleluyah Trademark*²², the mark Halleluyah was rejected in respect of women's personal clothing and underclothing on the basis that the use of such a religious term in that context would offend the senses of reasonably decent members of the society including the Christian faith. Thus its use in that manner would have constituted both gender and religious disparagement.

3.0. PROCEDURE FOR REGISTRATION OF TRADEMARKS IN NIGERIA.

Registration of trademark in Nigeria is effected at the Trademark, Patents and Designs Registry, Commercial Law Department, Ministry of Trade and Investment, Block D, Old secretariat, Area 1, Garki, Abuja²³. Application for trademarks registration is to be made by the proprietor or his representative²⁴. The usual practice is to instruct a local Attorney/Agent in Nigeria, who would file and process applications at the Nigerian Registry of Trade Marks, Patents, Designs and Copyright. A

¹⁷ Ibid n (2) pg 247

¹⁸ Section 11 Trademarks Act CAP T13 LFN 2004

¹⁹ [1910] 1 Ch. 130

²⁰ [1974] R.P.C. 371

²¹ Ibid n (2) pg 248

²² [1976] R.P.C. 605

²³ Trademarks, Patent and Design Registry, Commercial Law Department website <<http://www.iponigeria.com/#/Contact>> accessed on 20th July 2017.

²⁴ Ibid n (2) pg 253

Power of Attorney/Authorization of Agent Form would be completed in favor of such local Agent, as the enabling instruction to act for the principal/ Applicant. Thereafter, all official documents and forms would be submitted by the local Agent/Attorney. Until replaced or substituted by another local Agent, the local Agent remains responsible for processing registrations of the marks, defending oppositions (if any), provides address for local service of documents, and maintains renewals of the marks²⁵.

A trademark may be registered either plainly (black and white) or in colour. However, where a trademark is registered in colours, the protection afforded the Mark is limited to the colour(s) registered. On the other hand, a plain (black and white) registration affords protection to all colours of presentation of the trade mark²⁶.

Occasionally, the Registrar may request that for distinctiveness and acceptability for registration, word marks that are Common English words be registered in combination with devices or logos²⁷. Unless a trademark is registered in Nigeria, its Owner shall not be entitled to institute any proceeding to prevent, or to recover damages for its infringement²⁸. Under the law, any person who claims to be the proprietor of a trademark used or proposed to be used by him and is desirous of registering it must make an application in writing to the Registrar of Trademarks either under Part A or Part B of the register as described above²⁹. This application may be followed by a preliminary advice on the distinctiveness of the trademark³⁰. After advice has been given and for some reasons the Registrar objects to the registration of the mark on the basis of its lack of distinctiveness, the applicant will be reimbursed any fee paid by him on the filing of the application³¹.

In legal practice, a **preliminary availability search** is carried out to confirm that the trademark is not identical to or similar to an existing registered trademark. This is usually done by **filling in a search form** specifying the name, specimen and class which is sought to be searched and payment of the appropriate search fee. Where the search reveals that no similar mark is on the register in respect of the class of goods concerned, this may be a pointer to availability of the mark. Where the outcome of the search is successful, a dully filled application form will be submitted along with the prescribed fees. Other documents to accompany the application form are:

- a. Power of Attorney/Authorization of Agent
- b. Full names, nationality and address of the applicant
- c. A list of all goods and services proposed to be covered by the trademark

²⁵ How to register a Trademark or Patent in Nigeria available at <<http://www.legalnaija.com/2013/09/how-to-register-trademark-or-patent-in.html>> accessed on 7th July 2017

²⁶ Ibid n (25)

²⁷ Ibid n (25)

²⁸ Ibid n (23)

²⁹ Section 18 (1) Trademarks Act CAP T13 LFN 2004

³⁰ Section 17 (1) Trademarks Act CAP T13 LFN 2004

³¹ Section 17 (2) Trademarks Act CAP T13 LFN 2004

- d. Translation of non-English words in the trademark (if any).
- e. If the applicants seeks foreign priority, the date of the earlier foreign applications and names of the Countries where the applications were made must be stated.

Copies of trademark certificates and other form of verification of the applications in respect of which priority is claimed must also be provided by the applicant. It must however be emphasized that the earlier application must be within six months of application in Nigeria to enjoy priority.

When the Registrar of Trademarks receives the complete application, he then issues an acknowledgement reflecting the official number and filling date of the application. After this is done, the Registry undertakes an examination of the trademark to ascertain its registrability based on consideration of distinctiveness, public policy and other basis for disqualification in line with the provisions of the Trademarks Act. After the examination has been carried out, the Registrar of Trademarks may refuse or accept the mark. Refusal could be on the ground that the mark is disqualified on the basis of contrariness to the law. However if the applicant is willing, the Registrar of trademarks has a discretion to treat a Part A application as a Part B one.

In practice, where an application is refused, the grounds for the refusal is usually put down in writing by the registrar and an applicant who is dissatisfied with the refusal may appeal to the Federal High Court which shall after listening to both parties make an appropriate order whether the application is to be accepted³². If the registrar is satisfied with the examination on the other hand, a written notice of acceptance would be issued to the applicant and the trademark would be advertised in the Trademarks Journal³³. Once this is done, any opposing party has two months to give a written notice of opposition why the trademark should not be accepted³⁴. Where such notice of opposition is received by the Registrar of trademarks, he shall notify the applicant who shall within one month of the receipt of such notice send a counter-statement of the grounds on which he relied for his application³⁵. The registrar may listen to both parties, consider the evidence and decide whether and subject to what conditions the registration is to be permitted. If either of the parties is not satisfied with the decision of the Registrar, an appeal can be logged at the Federal High Court who has jurisdiction over such disputes³⁶.

In the absence of no opposition, the Registrar of Trademarks shall register the trademark in Part A or Part B of the register and issue the applicant a certificate of registration³⁷; and the registration of a trademark under Part A or Part B of the register shall confer on the registered proprietor the exclusive right to the use of the trademark in relation to the particular goods or classes of goods in respect of which it is registered.

³² Section 18 (4) - (7) Trademarks Act CAP T13 LFN 2004

³³ Ibid n (2) pg 255

³⁴ Ibid n (27)

³⁵ Ibid n (27)

³⁶ Section 21 Trademarks Act CAP T13 LFN 2004

³⁷ Section 22 Trademarks Act CAP T13 LFN 2004

4.0 DISTINCTIVENESS OF TRADEMARKS.

Firstly distinctiveness means the quality of being easily distinguishable. For a mark to qualify as a distinctive mark, one needs to look at the quality of the product. For instance Apple for computers and not for fruits. The following are degrees of distinctiveness of trademarks³⁸:-

- a. Fanciful
- b. Arbitrary
- c. Suggestive
- d. Descriptive
- e. Generic

a. **Arbitrary and Fanciful terms**:- A trademark that falls under either of these categories is automatically recognized as inherently distinctive. There is no requirement for the trademarked term to have a secondary meaning other than its literal meaning. A fanciful mark has no other meaning. It is created to represent the business e.g. Bing, Google, Exxon etc³⁹.

An arbitrary mark is a familiar term, logo, etc but it is used in an uncommon or unfamiliar manner to represent the business. There is no obvious connection between the trademark and product or services e.g. Apple for computers⁴⁰.

b. **Suggestive terms**:- The suggestive marks suggests the underlying product or service represented by the mark. It does not describe the product, but something about the mark somehow related to the product or services. It generally requires a certain level of cognition, creativity or imagination in how the product is perceived e.g. Citibank,inc and Playboy,inc⁴¹.

The suggestive mark is also inherently distinctive without showing a secondary meaning of the word.

c. **Descriptive terms**:- Descriptive marks describe in some way the product or service represented. This can include information about or allude to the nature, characteristics, geography or quality of the product or service. To qualify as a mark, the owner must demonstrate that the work has achieved secondary meaning beyond the literal definition of the mark. This requirement insures that

³⁸ Trademark Distinctiveness requirement available at <<http://thebusinessprofessor.com/knowledge-base/trademark-distinctiveness-requirement/>> accessed on 11th July 2017

³⁹ Ibid n (38)

⁴⁰ Ibid n (38)

⁴¹ Ibid n (38)

there is no confusion between the literal meaning and the product or services e.g. Home Depot and Band-Aid⁴².

d. **Generic Terms:-** Generic marks are not capable of protection. Generally, the mark is not distinctive because it represents a type of product or area of service e.g. Soda, french-fries and cars etc.

A valid mark may become generic if the mark begins to describe every product or service of that type. That is, it no longer makes the specific product or service distinctive e.g. Aspirin, Laudromat and Videogames etc.

A business mark that is becoming generic will fight to restore its distinctiveness for that business product or service e.g. Google and Xerox

5.0 RENEWAL AND DURATION OF REGISTRAION.

The certificate of registration is valid for the first seven years and subject to renewal every fourteen years⁴³. An application for renewal should be made not less than three (3) months from the due date⁴⁴. Renewal of a trademark is very paramount because where a mark which is for renewal has not been renewed, even after the Registrar of Trademarks has sent notice in the prescribed manner to the proprietor of the trademark, the trademark may be removed from the register⁴⁵. However the registrar seldom removes the mark.

In the case of A.B. Chami & Co -v- W.J. Bush & Co Ltd⁴⁶, the court held that a trademark which had not been renewed for thirty one years after registration was held to have been validly renewed since the trademark had not been removed from the register.

The law further states that even where a mark is removed, such mark will still be deemed to be on the register for the purpose of any application for the registration of a trademark during one year next after the date of removal unless there has been no *bonafide* trade use of the trademark that has been removed during the two years immediately preceding its removal; or no deception or confusion would be likely to arise⁴⁷.

⁴² Ibid n (38)

⁴³ Section 23 Trademarks Act CAP T13 LFN 2004

⁴⁴ Ibid n (25)

⁴⁵ Ibid n (2) pg 259

⁴⁶ [1996] FHCLR 784

⁴⁷ Section 23(4) Trademark Act CAP T13 LFN 2004

6.0 ASSIGNABILITY AND TRANSMISSIBILITY OF REGISTERED TRADEMARKS.

A registered trademark is assignable and transmissible either in connection with the goodwill of a business or not. A registered trade mark is assignable and transmissible in respect of either all the goods in respect of which it was registered or of some of those goods⁴⁸. An unregistered trade mark is assignable and transmissible if at the time of the transmission of the unregistered trade mark it is used in the same business as a registered trade mark; it is assigned or transmitted at the same time and to the same person as a registered trade mark; and in respect of goods to which the unregistered trade mark is used in that business⁴⁹. For an assignment of a trademark to be valid, the assignee of the trademark shall apply to the Registrar of Trademark for directions with respect to the advertisement of the assignment and advertise the assignment in such form and manner and within such period as the Registrar may direct⁵⁰. The notice of assignment shall be published in the Trademark Journal.

7.0. ELECTRONIC FILING IN NIGERIA.

Trademarks can now be filed in Nigeria electronically through Local intellectual Property (IP) Agents⁵¹. The Electronic filing was introduced to reduce the bottleneck that come with manual process of applications. The Electronic Filing Method is Convenient as you can file from the comfort of your location. Applicants will automatically get their Electronic acknowledgement notice on the same day of payment. Payments can now be made via Quickteller.com using Debit cards or at any Skye Bank Plc. in Nigeria⁵². Applicants however must obtain Pre-generated Invoices obtainable through a Platform created for Local Agents in Nigeria⁵³. One of the Benefits of Electronic filing is the Check Status module. You can track your applications online using your online application ID provided on your Acknowledgment letter. Electronic Filing is encouraged as it is in line with Best practices around the world.

8.0. CONCLUSION

In conclusion, to register trademark in Nigeria has the many benefits in that the registry protects your trademarks, discourages others from using similar marks without your license, notifies the general public about your ownership of the mark (thereby popularizing your trademark), and file a case at the Federal High Court against any company or individual in the event of infringement on the trademark.

Therefore, all Nigerians and inventors are advised in their best interests to register their trademarks because of the attendant benefits.

⁴⁸ Ibid n (23)

⁴⁹ Ibid n (23)

⁵⁰ Ibid n (23)

⁵¹ Ibid n (25)

⁵² Ibid n (25)

⁵³ Ibid n (25)