

**UNDERSTANDING TRADEMARKS AND  
IT'S IMPORTANCE TO BUSINESSES  
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## TRADEMARKS AUTHORITY

- ▶ The relevant Trademarks Authority in Nigeria is the Trademarks Registry, FMITI at Abuja



## TRADEMARKS LEGISLATION IN NIGERIA

- ▶ Trademarks Act, CAP T13 LFN 2004
- ▶ Trademarks Regulation 1967
- ▶ The merchandise malpractices offences Acts, CAP T12 LFN 2004
- ▶ The Counterfeit/Fake Drugs(Miscellaneous Provision Act, C34 LFN 2004

# What is a trademark?

- ▶ A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights.
- ▶ Section 67. (1) of the Trademarks Act, described "mark" to includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;
- ▶ Trademarks serve a dual purpose: first, they distinguish a company's offerings from those of competitors, helping consumers recognize and trust a particular brand. Second, trademarks protect a company's intellectual property by granting exclusive rights to use that mark in connection with specific goods or services. These protections are vital for maintaining brand integrity and reputation in the marketplace.

# IMPORTANCE OF REGISTERING TRADEMARKS TO BUSINESSES

- ▶ 1. Acquire Intellectual Property Rights
- ▶ Trademark registration enables individuals and businesses to establish their ownership over a unique and distinctive mark that they intend to use for their goods or services. By successfully registering their trademark, they obtain valuable intellectual property rights, granting them legal protection and exclusivity in the use of that mark.
- ▶ 2. Exercise Exclusive Control over the Use of Trademark
- ▶ Upon obtaining a trademark registration, the proprietor secures exclusive rights to use the registered mark in connection with the specific goods or services covered by the registration. This exclusivity ensures that no other entity can use an identical or confusingly similar mark for similar products or services in the marketplace. It empowers the trademark owner to take legal action against any unauthorized use, thereby safeguarding their brand reputation and market position.
- ▶ 3. Get Legal Protection against Infringement
- ▶ Trademark registration offers strong legal protection against infringement. With a registered mark, the proprietor has a clear advantage in enforcing their rights in case of any unauthorized use or attempts to pass off a similar mark. This legal provision enables the trademark owner to initiate legal proceedings and seek appropriate remedies, such as injunctions and damages, against infringing parties, thus ensuring the mark's integrity and distinctiveness.
- ▶ 5. Get Legal Recognition for the Trademark
- ▶ Trademark registration establishes a legal record of ownership, which holds significant weight in legal proceedings. the fact that a person is the registered proprietor serves as prima facie evidence of the mark's validity. This recognition simplifies the process of enforcing trademark rights, as the burden of proof is reduced, making it easier for the proprietor to defend their mark against infringement or counterfeiting.

- ▶ 6. Own Your Trademark as an Asset
- ▶ Trademark registration confers exclusive ownership rights to the proprietor. This transformation of the mark into a valuable intangible asset enhances the brand's overall value and marketability. The proprietor can leverage their registered trademark for licensing, franchising, or other commercial purposes, thereby generating additional revenue streams and strengthening the brand's position in the market.
- ▶ 7. Establish the True Origin of Your Products
- ▶ By registering a trademark and using it as an indicator of the product's origin, the proprietor establishes a strong association between the mark and the goods or services it represents. This eliminates any doubt about the source of the products in the minds of consumers, thereby enhancing brand recognition, consumer trust, and loyalty.
- ▶ 8. Retain Trademark Rights During Business Expansion
- ▶ Trademark registration provides a strong foundation for businesses planning to expand their operations or enter new markets in Nigeria. With the protection granted by registration, businesses can confidently invest in their brand and marketing efforts without fear of infringing on other trademarks. Moreover, it establishes a clear path for future growth, licensing, and franchising opportunities, as potential partners or investors recognize the value and legal standing of the registered mark.

# Steps in trademarks registration in Nigeria are:

1. Availability search in the relevant class/classes.
2. Filling of the trademark application either through the online system or IPAS (manual) system.
3. Substantive examination of the trademark application based on the requirement of the Trademarks Act.
4. Issuance of either an acceptance letter or notification of refusal with reasons stated therein.
5. Publication of accepted trademarks in the trademarks journal with window period of two months to allow for the filing of opposition/objections (if any)
6. Quasi- judicial proceeding from notices of opposition filed as a result of journal publication which will determine rights of parties.
7. Payment and application for issuance of the Certificate of registration in absences of any opposition or upon a ruling delivered in favour of the applicant.
8. Certificate of Trademark registration is renewable at the first instance for seven (7) years and for each fourteen (14) years subsequently.

## 2- Systems of filing

- Online
- IPAS(Industrial Property Automation System)

## WHAT CAN BE REGISTERED AS TRADEMARKS IN NIGERIA

- ▶ Any device, brand, heading, label, ticket, signature, word, letter color, mark, numeral, or any combination thereof may be registered as a trademark (S.67)
- ▶ Coca-cola, Fanta, Dangote, Nokia, Apple etc.

The Coca-Cola logo, featuring the brand name in its signature red script font.The Fanta logo, consisting of the word "Fanta" in a blue, rounded font with a green leaf-like shape above the letter 'a', all enclosed within an orange circle.The Dangote logo, featuring a blue eagle emblem above the word "DANGOTE" in a bold, blue, sans-serif font.The Nokia logo, with the word "NOKIA" in a bold, blue, sans-serif font, and the tagline "Connecting People" in a smaller, blue, sans-serif font below it.

# What are the Requirement for Trademark Registration in Nigeria

The Trademarks Act provides several requirements for the registration of trademarks, such requirement includes;

- (a) Trademarks must be distinct,
- (b) must not be identical or similar with an existing registered mark,
- (c) it must not be deceptive or scandalous mark
- (d) it must not be a word or words having direct reference to the character or quality of the goods in the class for registration and not being according to its ordinary signification a geographical names or a surname. See S. 9 of TM Act



# WHAT CANNOT BE REGISTERED AS A TRADEMARKS

- ▶ Non-Distinctive mark- (S.9(2)) “distinctive” means adapted, in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists”,
- ▶ Deceptive (S.10) or Scandalize marks or Design -( any scandalous design S.11(b))
- ▶ Names of chemical substance - (S.12)
- ▶ Geographical names - (S.9)
- ▶ Mark that connoted Nigeria Government Patronage- (S.62(1)(a) & (b))

See the case of Beecham Group Ltd Vs Essdee Foods Product Nig Ltd in (1977-1989) 2.I.P.L.R @ Pg 240 Para G- where the court held that “the criterion is that the mark to be registered must not, when compared with what is already registered, deceive the public or cause confusion. See Ademola CJN in Alban Pharmacy Limited Vs Sterling International Inc (1968)1 All NLR 300.

# WHO CAN APPLY FOR REGISTRATION

S.18:-

Any person claiming to be the proprietor of a trademark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration- S.18

For us to appreciate the meaning of proprietorship, it will be pertinent to look at the common law definition.

it has been settled by Nicholson & Sons' Application (1931) 48 RPC 227 and the judgement of Lawrence L.J at page 253 to which Morritt L.j has referred... *Proprietorship is determined by first use. it is not determined by deceptiveness which by itself begs the question of proprietorship*"

In the case of **Brown Shoe Application (1959) RPC 29** where the English Court refused a trademark application copied by the Applicant from an entity based in U.S.A. The Court per Wynn J held as follows:

*"It is incumbent on an applicant for registration of a trademark which has not yet been used in trade to assert that it is proposed to be used by him and that he claims to be the proprietor thereof. If there is an owner of a similar mark who has made an earlier assertion of proprietorship and who has not abandoned that claim, then the claim of the applicant is not well founded, and the application should not be allowed to go forward".*

## WHO CAN APPLY FOR REGISTRATION(CONTD)

The above English authorities have been endorsed in the recent decision of the Nigerian Federal High Court per Honourable Justice J.T. Tsoho, who in the case of Piaggio & C.S.P.A.V. Autobahn Techniques Ltd & Registrar of Trademark in Suit No. FHC/L/CS/1307/12 (Unreported) held as follows:

*“in line with the facts of the instant case, I find of great relevance these decisions Gynomin Trademark (1961) RPC 408; al bassam Trademark (1995) RPC 511; Brown Shoe Company Trademark (1959) 29; The European Blair Camera Company’s Trademark (1896) 13 RPC 600; Trademarks of J. Lesquendieu (1934) 51 R.P.C 273; Vitamins LD’s T.M. (1956) RPC. Where the court held that in AL BASSAM Trademark (Supra, per Ward L.J at page 527). “it is to the effect that in deciding questions of proprietorship of unregistered marks. it was necessary to start with common law principles, namely: the owner of a mark which had been used was the one who first used it:...””*

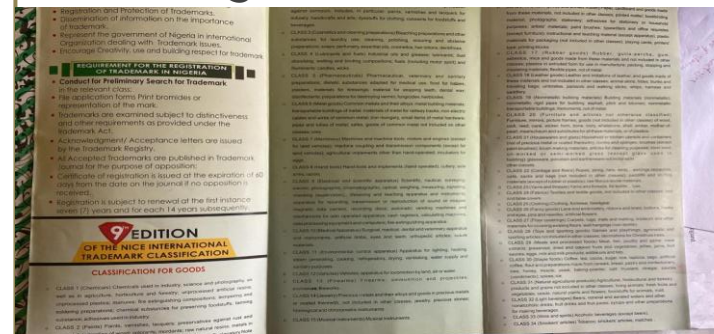
## SEARCH & APPLICATION



- ▶ The first action is to conduct search on the availability of the mark for registration. Therefore an application is submitted. - Regulation 33
- ▶ Trademark Search is optional
- ▶ It is advisable however to conduct a search
- ▶ If you are not sure seek advice of the registrar

## CLASSIFICATION OF GOODS

- ▶ Search is conducted according to the NICE international classification of goods - 9<sup>th</sup> Edition for Nigeria.



## EXAMINATION



Applications for registration are examined in accordance to the provisions of the Trademarks Act on the following grounds:

- ▶ Distinctiveness- (S.9)
- ▶ Contrary to law or morality
- ▶ Likelihood to deceive or cause confusion- (S.11)
- ▶ Names containing chemical substances- (S.12)
- ▶ Coat of arms & flags or state emblems
- ▶ Bad faith registration, fraudulent or confusingly similar
- ▶ Generic matter- (S.15,13,14)
- ▶ If no objection to the Registration by the examiner, Acceptance letter is issued.

## RIGHT OF APPEAL



- ▶ Refusal to Register can be appealed by showing evidence for example that it is not deceptive.
- ▶ Then appeal to court.

# SEPARATE & SERVICE MARKS

- ▶ A mark can be applied for in different classes also can be registered in series or as a defensive registration.
- ▶ Even companies with established reputation are advised to protect their marks in all classes.
- ▶ Do not allow social media or domain use of your Trademark.
- ▶ Sue infringers to protect your registered Trademarks

## PUBLICATION AND OPPOSITION

- ▶ Marks are published as accepted - S.19
- ▶ Marks are open to opposition within 60days from the date of publication - S.20
- ▶ If no opposition, marks proceed to certificate.



## PROCEDURE OF OPPOSITION

- ▶ S.20 (1-5)
- ▶ Regulations 48-57
- ▶ If opposition is successful, the application will be terminated.
- ▶ IF Opposition fail applicant proceeds to registration.
- ▶ In either case party has the right of appeals to the FHC.

## REGISTRATION



- ▶ A certificate of Registration is granted to the owner of the Trademark for a term of 7yrs, with the right to prevent third parties from using a similar or identical Trademark in the course of Trade or Commerce - S.23(1).
- ▶ Nigeria is not a member of ARIPO and Madrid Protocol.

## RENEWAL

- ▶ Registration is subject to renewals after the expiration of the first term of 7-years - S.23(2).





## **LICENSE/ASSIGNMENT**

- ▶ This right is recognized by law. The proprietor can grant a license to a user to use the mark - S.33

## **REVOCATION OF TRADEMARK**

- ▶ For non-use without bonafide intention to use the Trademark.
- ▶ 5 years

### CONVENTION PRIORITY IN TRADEMARKS REGISTRATION

- ▶ Under the Paris convention any person who files a Trademark application in a member country may claim priority of that filing date of an application is filed in any other member country within a specified period from the date of filing of the original application.
- ▶ Well known marks
  - Protected because the relevant public already knows the Trademarks

### SAME TRADEMARK BY DIFFERENT OWNERS

- ▶ Service Trademark Rights are generally geographic in scope. It is possible for some Trademark to be registered in different countries by different owners.
- ▶ It is therefore possible to have multiple owners in different classes.

# CONCLUSION

In conclusion, trademarks are not mere symbols; they are the embodiment of a company's identity, reputation, and intellectual property. They play an indispensable role in the modern business landscape, shaping consumer choices and facilitating trust in the marketplace. Understanding the significance and legal aspects of trademarks is fundamental for both businesses and consumers in today's commercial world.

**It is important to note that, it's now easier for any interested applicant to apply for trademark registration online anywhere, all you need to do is log on to [www.iponigeria.com](http://www.iponigeria.com) and follow the steps.**

**Thank you.**