



# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2015

**4th Edition**

A practical cross-border insight into trade mark work

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URL: www.glgroup.co.uk

**GLG Cover Design**

F&F Studio Design

**GLG Cover Image Source**

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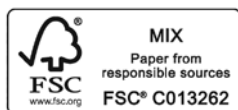
Information Press Ltd.  
May 2015

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ISBN 978-1-910083-43-7

ISSN 2049-3118

**Strategic Partners**



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EDITORIAL

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Welcome to the fourth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

One general chapter entitled “BRIC Economies: Another BRIC in the Wall of Global IP Standards?”.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 42 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord (UK) LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

*The International Comparative Legal Guide* series is also available online at [www.iclg.co.uk](http://www.iclg.co.uk).

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# Nigeria

Olufemi Adekeye



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant Nigerian trade mark authority?

The Commercial Law Department of the Federal Ministry of Industry, Trade and Investment.

### 1.2 What is the relevant Nigerian trade mark legislation?

The Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria 2004.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Device, brand, headings, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

### 2.2 What cannot be registered as a trade mark?

- Any matter the use of which would by reason of it being likely to deceive or cause confusion;
- any scandalous design;
- if it is identical and resembles a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods; and
- names of chemical substances.

### 2.3 What information is needed to register a trade mark?

The applicant's name, signature and address; a print of the proposed trade mark, or .jpeg illustration of the mark; any other distinctive mark; the class and specification of the goods or services for which the trade mark is to be registered; and the details of the agent.

### 2.4 What is the general procedure for trade mark registration?

The applicant should conduct a search at the Trade Mark Registry to determine whether the proposed trade mark is available for

registration. Although a search is not mandatory, it will help the applicant in determining whether the trade mark sought to be registered is available for registration.

The application is prepared on the relevant statutory form and filed upon payment of the prescribed fees. Thereafter, the Trade Mark Registry will issue the applicant with an Acknowledgment Form confirming receipt of the application by the Registry and a temporary number will be allocated to the trade mark, pending registration and the allocation of a permanent registration number.

An Acceptance Form will be issued if the Registrar is satisfied that the mark can be registered. After the issuance of the Acceptance Form, the mark will be published in the Trade Marks Journal to notify any interested party who may have an objection to the registration of same. If there is no opposition, an applicant can apply for the issuance of a certificate.

### 2.5 How can a trade mark be adequately graphically represented?

The Act does not provide how a trade mark can be adequately graphically represented, save that section 9 of the Act states that it must be distinctive.

### 2.6 How are goods and services described?

All goods and services in the trade mark registration are required to be adequately described in accordance with the Nice Agreement on International Classification of Goods and Services.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a Nigerian trade mark?

It is only effective within the Federal Republic of Nigeria.

### 2.8 Who can own a Nigerian trade mark?

Natural persons and corporate entities.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark may acquire distinctive character through use where the trade mark has been used in a manner that it is associated with a particular good.

**2.10 How long on average does registration take?**

Between 12 to 18 months from submission of the application to the issuance of a certificate.

**2.11 What is the average cost of obtaining a Nigerian trade mark?**

The total official cost of filing the application and the collection of the certificate is N28,000.00. This sum excludes agents' fees and other incidental expenses.

**2.12 Is there more than one route to obtaining a registration in Nigeria?**

No, there is not.

**2.13 Is a Power of Attorney needed?**

It is needed where the applicant engages the services of an agent. The Power of Attorney does not have to be notarised.

**2.14 How is priority claimed?**

Any person who has applied for protection for any trade mark in a Convention country shall be entitled to priority registration of his trade mark over other applicants, and the registration shall have the same date as the date of the application in the Convention country. It should, however, be noted that the application must be made in the same manner as an ordinary trade mark application.

**2.15 Does Nigeria recognise Collective or Certification marks?**

Certification marks are recognised, however the Act makes no mention of Collective marks.

**3 Absolute Grounds for Refusal****3.1 What are the absolute grounds for refusal of registration?**

Registration may be refused where the mark is:

- deceptive;
- lacking distinctiveness;
- scandalous; or
- identical to and/or resembles an existing mark.

**3.2 What are the ways to overcome an absolute grounds objection?**

By a written application to the Registrar stating the reason why the trade mark sought to be registered should not be objected to.

**3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

An applicant can approach the court directly for a review of the Registrar's refusal.

**3.4 What is the route of appeal?**

Appeal lies in the first instance to the Federal High Court and then to the Court of Appeal, and finally to the Supreme Court.

**4 Relative Grounds for Refusal****4.1 What are the relative grounds for refusal of registration?**

- There is an earlier application or registered mark;
- the mark is notorious or well known;
- the applicant of the trade mark is not the true proprietor thereof; or
- the application for the mark was made in bad faith.

**4.2 Are there ways to overcome a relative grounds objection?**

By an application to the Registrar containing convincing arguments as to why the trade mark should not be rejected.

**4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

The applicant can appeal directly to the Federal High Court.

**4.4 What is the route of appeal?**

Where an applicant has an option to appeal, he must approach the court directly if the action is pending. If, on the other hand, the appeal is made to the Registrar, the Registrar may at any stage of the proceedings refer the application to the court, or he may, after hearing the parties, determine the question between them subject to appeal to the court.

**5 Opposition****5.1 On what grounds can a trade mark be opposed?**

- Where the trade mark is identical or similar to a registered trade mark;
- where the trade mark contains deceptive or scandalous designs; or
- where the trade mark contains immoral words and/or symbols.

**5.2 Who can oppose the registration of a Nigerian trade mark?**

Any person with sufficient interest.

**5.3 What is the procedure for opposition?**

A party that intends to oppose a trade mark shall, within two months after the publication of the trade mark in the Journal, cause a Notice of Opposition to be filed with the Registrar stating the grounds of its opposition. The Registrar shall send a copy of the Notice to

the applicant and, within one month of receipt of the Notice by the applicant, the applicant shall send to the Registrar a counter statement showing the grounds for the application to register the trade mark in Nigeria. If the applicant fails to file the counter statement, the applicant will be deemed to have abandoned his application.

Where the applicant files a counter statement, a copy of the counter statement shall be sent to the person giving the Notice and the Registrar, after hearing both parties, decides whether registration is to be permitted and if it is subject to any conditions or limitations.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The applicant will be issued with a certificate upon payment of the necessary fees.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's rights (other than a certification trade mark) commence upon the registration of a trade mark.

### 6.3 What is the term of a trade mark?

An initial period of seven years at the first instance, which is renewable thereafter in accordance with the provisions of the Act.

### 6.4 How is a trade mark renewed?

An application for renewal is made by the registered proprietor of the trade mark to the Registrar by filing the prescribed form, within the prescribed period and paying the prescribed fees. The Registrar shall renew the registration of a trade mark for a period of 14 years from the date of expiration of the original registration or of the last renewal of registration.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

By virtue of section 30 of the Act, an individual can register the assignment of a trade mark by making an application to the Registrar.

### 7.2 Are there different types of assignment?

The Act does not provide any other mode of transferring title in a trade mark apart from the procedure stated in section 30 of the Act.

### 7.3 Can an individual register the licensing of a trade mark?

Under Nigerian law, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in which it is registered, either with or without conditions or restrictions, by filing the prescribed form and paying the prescribed fees.

### 7.4 Are there different types of licence?

Licences may take many forms, from restrictive, general and exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

A registered user may institute proceedings for infringement in his own name as if he were the proprietor.

### 7.6 Are quality control clauses necessary in a licence?

The Act is silent on this. However, the use of the trade mark by the user is subject to any conditions or restrictions as which apply to the proprietor, and the proprietor may lay down certain requirements for the use of the trade mark by the user, including quality control.

### 7.7 Can an individual register a security interest under a trade mark?

The Act does not make provision for the registration of a security interest.

### 7.8 Are there different types of security interest?

There is no provision under the Act relating to a security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

- Where the trade mark was registered without any *bona fide* intention by the applicant to use same and there has been no use of the trade mark for up to one month before the date of the application; or that up to one month before the date of the application, the registered trade mark has not been in use for a continuous period of at least five years;
- non-renewal of the registration of the trade mark; or
- where there is a breach of a condition or restriction that applies to the use of the trade mark.

### 8.2 What is the procedure for revocation of a trade mark?

A registered trade mark can be revoked on an application by the applicant or any person concerned either to the Registrar or the court.

### 8.3 Who can commence revocation proceedings?

Any interested person who has sufficient interest in the trade mark.

### 8.4 What grounds of defence can be raised to a revocation action?

When a revocation is based on grounds of non-use, a proprietor can contend that there has been *bona fide* use of the trade mark up to one month before the date of the application for revocation.

Where a revocation is based on grounds of non-renewal, evidence that the Registrar did not forward to the proprietor the statutory

notice of the date of expiration for the last registration of the trade mark is a good and arguable defence.

Also, a revocation on the grounds of a breach of any condition may be countered with evidence showing that there has been due compliance with the prescribed conditions set down by the Registrar.

#### 8.5 What is the route of appeal from a decision of revocation?

Appeal lies in the first instance to the Federal High Court, and subsequently to the Court of Appeal, and finally to the Supreme Court.

## 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

- Where the registration was obtained by fraud; or
- where the trade mark is of a scandalous design or is likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality.

#### 9.2 What is the procedure for invalidation of a trade mark?

A trade mark can be invalidated on an application by the applicant or an interested party either to the Registrar or to the court.

#### 9.3 Who can commence invalidation proceedings?

Any interested person who has demonstrated sufficient cause in the trade mark in question can commence an invalidation proceeding.

#### 9.4 What grounds of defence can be raised to an invalidation action?

Prior *bona fide* use and honest concurrent use are good and arguable defences that can be raised to an invalidation action.

#### 9.5 What is the route of appeal from a decision of invalidity?

An appeal against an invalidity decision by the Registrar lies in the first instance to the Federal High Court, and subsequently to the Court of Appeal, and finally to the Supreme Court.

## 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

By virtue of section 251 (1) of the 1999 Constitution of the Federal Republic of Nigeria, the Federal High Court has exclusive civil jurisdiction to adjudicate on all trade mark matters. The court's coercive powers can be enforced either through injunctive reliefs, damages and other reliefs that meet the ends of justice.

#### 10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

An action on infringement of a trade mark is commenced by a writ of summons served on the alleged infringer. Upon the settlement of pleadings by both parties, the matter is set down for trial by the court. From the commencement of action to trial is between four to six months, barring any unforeseen contingency.

#### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Preliminary and final injunctions are available. Preliminary injunctions are granted to preserve the *res* pending the final determination of the substantive suit, while final injunctions are granted at the conclusion of the substantive suit to perpetually prevent the continued infringement of the act complained of.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. The procedures are called interrogatories and discoveries. An *Anton Piller* order can also be obtained to access the premises of the infringer for the purpose of taking possession of documents and other items which might form evidence in the action against the alleged infringer.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence of parties is presented in writing under oath and filed together with the parties' pleadings. However, it should be noted that subpoenaed witnesses who are deemed by the rules of practice to be the Court's witness are exempted from filing written depositions on oath. After the adoption of the written depositions on oath by a witness, the witness is cross-examined by the opposing party's counsel and subsequently re-examined by his counsel where necessary only to clear any ambiguity arising out of cross-examination.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings can be stayed pending the resolution of validity of an infringement action pending before the Registrar.

However, in a situation where there are two separate actions pending before the court between the same parties on the same subject matter, the practice is not to stay proceedings. Rather, upon the application of any of the parties, the court may order a consolidation of both suits in order to avoid multiplicity of actions. Or, alternatively, the latter action could be struck-out based on the application of either party in order to prevent an abuse of court processes.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

There is no limitation period specified in the Act within which an action for trade mark infringement may be instituted. However, section 13 of the Merchandise Marks Act stipulates a time frame

for the institution of criminal proceedings in respect of an offence against the Act. The said section provides thus: “No prosecution for an offence against this Act shall be commenced after the expiration of three years after the commission of the offence, or one year after the first discovery thereof by the prosecutor, whichever expiration first happens”.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Sections 3 and 4 of The Merchandise Marks Act, Cap M10, Laws of the Federation of Nigeria 2004 provide for offences that can be committed in respect of trade marks and trade descriptions. Upon conviction of any offence under the Act by a High Court, an infringer can face imprisonment for a term of two years or a fine, or both. Where an infringer has been summarily convicted by a Magistrates' Court, he faces imprisonment for up to six months or a fine of ₦100.

#### 10.9 If so, who can pursue a criminal prosecution?

The Police in the Magistrate Court and the office of the Attorney General in the High Court.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The Act does not make any provisions for this.

### 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The ground of defence in this regard can be found in section 7 of the Act, which states nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods that person or a predecessor in title of his has continuously used with such trade mark from a date prior to the registration of the proprietor's trade mark.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

Fair use, honest concurrent use, abandonment and non-use of the trade mark.

### 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

Injunctions, damages, alteration or rectification of the Trade Mark Registry and accounts for profits. Criminal penalties are in the form of fines and/or imprisonment under the Merchandise Marks Act.

#### 12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Costs are generally recoverable. The amount of costs recoverable will depend on the plaintiff's claims and the evidence led in support of same. However, it should be noted that, in civil proceedings, the Supreme Court has held that costs should not be punitive.

### 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The right of appeal can either be strictly on law or a mixture of law and facts.

#### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be raised on appeal where there are special circumstances and same can only be with the leave of the court.

### 14 Border Control Measures

#### 14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

Where there are reasonable grounds to suspect the importation of infringing goods, a registered proprietor may utilise the services of relevant government agencies, especially the Nigerian Customs Service, by filing a petition to the Comptroller General. Customs has the power to search for, seize, detain and destroy any infringing goods upon entry into Nigeria. With regards to how quickly such measures are resolved, much will depend on the resources available to the relevant authority at that material point in time.

### 15 Other Related Rights

#### 15.1 To what extent are unregistered trade mark rights enforceable in Nigeria?

Unregistered trade marks may be protected by an action in passing-off. However, for a party to succeed in a passing-off action, the plaintiff must prove that he has goodwill and/or reputation attached to the goods or services in the mind of the public, that there has been a deliberate misrepresentation by the defendant which is likely to cause the general populace to believe that the goods and services are authorised by the plaintiff and lastly, that the plaintiff has suffered or is likely to suffer damages arising from such deliberate misrepresentation.

#### 15.2 To what extent does a company name offer protection from use by a third party?

The company's name must be registered at the Corporate Affairs Commission to be able to enjoy protection under Nigeria Law.



**15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?**

Other Nigerian legislation, such as the Copyright Act and the Patents and Designs Act, confer IP protection.

**16 Domain Names****16.1 Who can own a domain name?**

Any natural persons and legal entities.

**16.2 How is a domain name registered?**

Registration can only be initiated by conducting an availability search through the Nigerian Internet Registration Association Accredited Registrar's website, as the body does not handle registrations directly. After the availability search, applications are also completed and submitted via the Registrar's website.

**16.3 What protection does a domain name afford *per se*?**

Registration of a domain name affords protection against the unauthorised use of identical or sufficiently similar names by third parties.

**17 Current Developments****17.1 What have been the significant developments in relation to trade marks in the last year?**

The computerisation of the Trade Mark Registry, which has facilitated the entire process of trade mark registration.

**17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.**

- *Holdent International Ltd v. Petersville Nigeria Ltd* (2013) LPELR-21474(CA), which states that in comparing two conflicting trade marks, it is best to look at the proposed trade mark in the absence of the existing trade mark, as looking at both trade marks side-by-side will create possible confusion.
- *The Procter and Gamble Company v. Global Soap and Detergent Industries Ltd & Anor* (2012) LPELR-8014(CA), which states that, in order to make a finding of non-use of a trade mark, two conjunctive elements must exist at the time of registration, namely: the trade mark was registered without *bona fide* intention to use same; and that there has been no *bona fide* use of the mark in relation to those goods by a proprietor within a month before the application to remove the mark is made.
- *Virgin Enterprises Ltd v. Richday Beverages Nig. Ltd* (2009) LPELR-8187(CA), which made a clear distinction between passing-off and infringement of trade marks.

**17.3 Are there any significant developments expected in the next year?**

It is expected that the Trade Mark Registry will improve on the current electronic filing, with a view to bringing it in line with international best practice.

**17.4 Are there any general practice or enforcement trends that have become apparent in Nigeria over the last year or so?**

In a bid to enhance the scope of its anti-piracy and anti-counterfeiting operations, the Nigerian Copyright Commission has constantly cooperated with the Nigeria Police Force and the Nigeria Customs Service to carry out sporadic raids of infringing goods across the country.

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Our Partners and Associates are members of internationally recognised professional bodies such as the Nigerian Bar Association, the International Technology Law Association and the Chartered Institute of Arbitrators (UK).

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