

An Assessment of the Legal Procedure for the Registration of Trademarks in Nigeria

By
Dr. Ibrahim Abdulkarim *
and
Maryam Ibrahim Abdullahi**

Abstract

Intellectual property represents the human ideas and innovation which has been translated into information or technical know-how that are of commercial, scientific and proprietary value. The law recognizes these values and attaches some rights to the owners of such property. Due to the economic value of intellectual property, the law confers some rights to the owner of trade mark against unauthorized use by other people. These rights emanate from the registration status of the trademark. Registration of trademarks is the basic concept of trademark protection, it is a pre-condition for the institution of infringement action under the Trademarks Act. Taking into consideration that registration is not mandatory; the common law however, offers some forms of protection to a proprietor of an unregistered trademarks. Hence, where the marks or services have conferred on the owner considerable goodwill or reputation, the owner can enforce his right under the common law tort of passing off¹. Registration further confers on the proprietor of a trademark, exclusive rights to use the mark in relation to goods or classes of goods in respect of which it is registered. In conducting this research, the authors adopted doctrinal method of research using both primary and secondary sources of material. The paper amongst others revealed that the artificial dichotomy created between Part A and Part B of the Act relating to trademark registration is entirely unclear and in actual fact there appears to be little or no difference. Therefore, there is no logical basis for continuing with this dual system of registration which is largely ignored in practice. It is recommended amongst others that section 2(3), 6(2) and 14(2) of the Trademark Act, be amended to harmonize the registration in Part A and B which has been abandoned in almost all the developed countries.

Keywords: Trademark, Patent, Intellectual Property, Registrable and None-Registrable Trademark.

1.1 Introduction

Trade mark is a branch of Intellectual Property. The term “Intellectual Property” is property emanating from the human intellect, mind or through invention².

*(Reader) , Department of Private Law, Faculty of Law, ABU Zaria.

** Department of Private Law, Faculty of Law, ABU Zaria.

¹ Section 3 of the Trade Marks Acts, Cap. T13 Laws of the Federation of Nigeria, 2004

Intellectual property therefore represents the human ideas and innovation which has been translated into information or technical know-how that are of commercial, scientific and proprietary value. The law recognizes these values and attaches some rights to the owners of such property³. Due to the economic value of intellectual property, the law confers some rights to the owner of trade mark against unauthorized use by other people. These rights emanates from the registration status of the trademark.⁴

Registration of trademarks is the basic concept of trademark protection. It is a pre-condition for the institution of infringement action under the Trademarks Act⁵. Taking into consideration that registration is not mandatory; the common law however, offers some forms of protection to a proprietor of an unregistered trademarks. Hence, where the marks or services have conferred on the owner considerable goodwill or reputation, the owner can enforce his right under the common law tort of passing off.⁶Registration further confers on the proprietor of a trademark, exclusive rights to use the mark in relation to goods or classes of goods in respect of which it is registered. For registration purposes, the Act divided the trademarks register into registrable and non registrable. For a proposed mark to be registrable, it must either have passed the test to be inherently distinctive,⁷where it is required that the proposed mark have the capability to distinguish even if it is not presently distinctive. The Trademarks Act⁸ provides a guide as to which marks may pass this test. which include: The name of a company, individual or firm (represented in a special manner); The signature of the applicant; invented words ;non descriptive words; any other distinctive marks .This dual routes for the protection of marks in Nigeria lead to a division of the trademarks register into Part A and part B⁹ with the effect that marks that are inherently distinctive under Section 9 are registered in part A while marks that can only acquire distinctiveness through use under section 10 are registered under part B .The intention of this dichotomy was to give a superior rights to marks registered under part A, this intention cannot however be seen in practice which added to the challenges faced by the registry. The dichotomy between Part A and B registration has long been abolished in many jurisdictions because it does not add value to trade mark protection.

² Kur. J.J(2015) *Intellectual Property Law and Entrepreneurship in Nigeria Principles and Practice*. Aboki Publishers Benue p.28

³ Ibid.

⁴ Ibid.

⁵ Op. cit.

⁶ Section 3 Ibid

⁷ Olatunji.O.A (2016)“ Fundamentals of the Nigerian Trademark Act”, *Journal of international Property Law and Practice*, .Vol. 11 No.2 p.134

⁸ Section 9 (1) (a)-(e) of the Act

⁹ Section 2(3) of the Act

Registered marks whether in part A or B are recorded at the Trademark Registry. The Idea is to keep records of the registered marks handy such that new registration applications will not be approved if they matched already registered marks. The global trend today is to convert the registration to online form which allows for easy search. The Trademarks, Patent and Designs Registry has also found this trend effective from 2013¹⁰. However, it is still advisable that prior to commencing a registration process an availability search is conducted at the Trade Mark Registry to determine availability of the trademark. The preliminary search process does not seem to be as straightforward and convenient as is obtainable in other jurisdictions. In the United States of America, for instance, those who want to register a trademark can conduct a search on the Trademark Electronic Search System database that contains trademarks and prior pending applications. The results of a preliminary search done using the Trademark Electronic Search System are available immediately after submitting the search query.

In Nigeria, the search still has to be conducted manually at the Trademarks, Patent and Designs Registry in Abuja due to the fact that the online platform still does not support online searches for existing trademarks that were registered before the advent of the online platform. The search report from the manual search can take about 3 days to be ready.

The aim of this paper therefore is to appraise the legal regime on registration of trademarks in Nigeria with the view to finding out whether the dichotomy of the registration of marks into part A and B still has a place in the 21st century and the efficiency of the commission as a repository of registered marks.

In achieving this aim, the paper discusses the Trademark Search as the first step for the process of registration in Nigeria., The paper equally examines the eligibility for Registration of Trademarks in Nigeria more so, The paper discusses Registration of Trademarks in Nigeria under part A of the Register and followed by the Part B Registration, Furthermore, The paper discusses Registrable Marks ,and ,non-Registrable marks and lastly, the paper concludes by making some findings and recommendations.

1.2 Trademark Search

The trademark search is the first step for registering a trademark in Nigeria. In practice, a preliminary availability search is carried out to confirm that the trademark is not identical to, or similar to an existing registered mark¹¹. This is 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

¹⁰Dalley G.R.F (2019) *Registration of Trademarks and Challenges of the Trademark Office in Nigeria*.<http://grfdalleyandpartners.com/2019/04/04/registration-trademarks-challenges-trademark-office-nigeria>. accessed on 25/11/19

¹¹ Oyewunmi.A.O (2015) *Nigerian Law of Intellectual Property* University of Lagos Press and Bookshop Ltd, Akoka,Lagos. P.233

similar mark is on the register in respect of the class of goods concerned, this may be a pointer to, though non-conclusive of, availability of the mark. Where the outcome of the search is successful, a duly filed application form will be submitted, accompanied by clear and distinct representations of the mark and prescribed fees. Other documents to accompany the application include the power of attorney/Authorization of Agent; the full name(s), nationality and physical address of the applicant; a list of all goods and services covered or proposed to be covered by the trademark and translation of non-English words in the trademark, if any.¹²

Upon receipt of a complete application, the Registrar issues an official acknowledgement reflecting the official number and filing date of the application. The filing date thus issued may be of critical importance in determining priority in the event of competing applications and uses¹³. The registry thereafter undertakes an examination of the trademark to ascertain its registrability based on considerations of distinctiveness, public policy and other basis for disqualification in line with the provisions of the Act.¹⁴ Following the examination, the Registrar may refuse or accept the mark either absolutely or subject to such amendments or conditions as he deems appropriate.¹⁵ If it is found that the mark is disqualified on the basis of contrariness to the law, the Registrar has a duty to refuse. However, if the applicant is willing, the registrar has discretion to treat a Part A application as a Part B one (where the mark falls short of the requirements of registrability under Part A). Where an application is refused, the grounds for the decision shall be put in writing. An applicant who is dissatisfied with the refusal may appeal to the court which shall, after listening to both parties (if required) make an appropriate order.¹⁶

On the other hand, if the Registrar is satisfied with the examination, written notice of acceptance is issued. Following acceptance, the trademark is advertised in the Trademarks journal, whereupon any interested person may give written notice of opposition within two months of the publication, stating the grounds for the opposition. Where such notice of opposition is received by the registrar, 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 relies for his application.¹⁷ The Registrar may, if the circumstances so require, hear the parties, consider the evidence and decide whether and subject to what conditions, the registration is to be permitted.¹⁸ In an opposed application, an appeal from the Registrar's decision shall be made to the court.¹⁹ Where there is no opposition, or the opposition has been

¹² Ibid

¹³ Ibid

¹⁴ Sections 11-13 of the Act

¹⁵ Section 18(2) *ibid*

¹⁶ Section 18(4)-18(7) *ibid*

¹⁷ Section 20(3) *Ibid*

¹⁸ Section 20 *Ibid*

¹⁹ Section 21 *Ibid*

decided in favor of the applicant, the Registrar shall, unless the application has been accepted in error, register the trademark in Part A or Part B (as the case may be) and issue the applicant with a certificate of registration.²⁰ The registration of a mark in Part A or B of the register, shall, if valid, confer on the registered proprietor the exclusive right to the use of the Trademark in relation to the particular goods in respect of which it is registered. The certificate is valid at the first instance, for seven years, after which it is renewable every fourteen years.²¹ In conclusion, trademark search is important before registration because it ensures that the proposed trademark does not conflict with an existing trademark.

1.3 Eligibility for Registration of Trademarks

Registration of a Trademark is a prerequisite of trademark protection against infringement action under the Act.²² For purposes of Registration, the Trademark Register is divided into two parts:²³ Part A and Part B. In either case, registration is in respect of particular goods or classes of goods as specified by the applicant.²⁴ Where there is any question regarding the class of goods within which any goods fall, the matter shall be determined by the Registrar, whose decision is final.²⁵ It is pertinent to note that the division of the trademark register into two parts has not served any purpose. , instead, it has created problems for marks owners or prospective mark owners. The power vested upon the Registrar of Trademarks is open to abuse or arbitrariness.

1.3.1 Registration of Trademarks Under Part A of the Act

Majority of the application for registration of Trademarks fall under this category. Section 9 of the Act provides that to be registrable in Part A of the register, a mark must contain or consist of at least one of the following essential particulars:

The name of the company, individual or firm represented in a special or particular manner: A name is a means of identity and the Act rightly reflect this by providing for the registration of the name of a natural or artificial person as the identity of products emanating from such person. Examples of brand names that are the names of founder include: Dangote for cement, sugar, flour e.t.c. Kellogs for breakfast cereals. Where the name that is sought to be registered is not that of the applicant, the Registrar has a discretion to refuse to register the name if such registration tends to suggest that the goods on which it is used emanates from the owner of the name.²⁶ The name to be registered must also be a True name and not an imaginary

²⁰ Section 22 Ibid.

²¹ Section 23 Ibid

²² Section 2 of the Act

²³ Section 2(4) ibid

²⁴ Section 4 Ibid

²⁵ Ibid

²⁶ The name may also be dismissed as being deceptive under section 11 of the Act

name. Furthermore, the name is required to be represented in a special or particular manner. In other words, it should not be written in ordinary print. This is to make it distinctive and to prevent a name from being so taken as a trade name or mark that anyone in business might unintentionally infringe it by an honest use of his own name.²⁷

- a. The signature of the Applicant for registration in his business: Unlike the previous provision which is non-specific, section 9(1) (b) of the Act requires that a signature must be that of the applicant or a predecessor in his business. A signature is commonly used to authenticate documents emanating from a person and it is therefore reasonable that it should also be used on goods for the same purpose. It is however not commonly used as a trademark because it is difficult to describe and recollect. One of the disadvantages of a signature mark is that it can easily be imitated by another trader who claims to have the same or similar signature.²⁸
- b. An invented word or Words: An invented word is a word that is “new and freshly coined”.²⁹ It occupies the highest level of the ladder of distinctiveness in the hierarchy of registrable Marks.³⁰ This is reasonable because having originated from the applicant; such a word is not likely to deprive anyone of the usage of the available vocabulary.

A word or words 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; This heading permits registration of any word as a trademark, provided it is not directly descriptive of the goods or services.³¹ Words that suggest that the goods are produced in a particular locality are not registrable. In the case of *Magnolia Metal Co* the court explained that a word does not become a geographical name simply because some place upon the earth’s surface has been called by it. Rather, such words must be interpreted in accordance with the general and popular meaning of the words. Accordingly, the mere fact that a name is a geographical name does not necessarily disqualify a word, in as much as it does not readily suggest that the goods are derived from that source. The onus lies on the applicant for registration to prove that the word is not a geographical name in its ordinary signification.

²⁷ Blanco. W.T and Jacob .R.(1986) *Kerlys Law of Trademarks and Trade Name* (12th Ed.)London, Sweet and Maxwell In: Oyewunmi. A.O (2015) *Nigerian Law of Intellectual Property* Op. Cit. p.234

²⁸ Ibid

²⁹ *Eastman Photographic Materials Co.Ltd v. Comptroller General of Designs Patent and Trademarks* (1898) AC 571

³⁰ Section 32 of the Act

³¹ Oyewunmi.A.O (2015) *Nigerian Law of Intellectual Property* Op.cit P.244

- c. Any other distinctive mark: This is a broad head which accommodates marks not falling within the other heads, provided the mark passes the test of distinctiveness. Distinctive according to the Trademarks Act ³² means “adapted to distinguish”. Section 9(3) of the Act provides that a tribunal faced with the question of whether or not a trademark is adapted to distinguish is empowered to have regard to the extent to which the Trademark is inherently adapted to distinguish, or by reason of the use of the trademark or of any other circumstances the trademark is in fact adapted to distinguish. In other words, no other meaning is conveyed by the mark except in relation to the applicants goods or services.

In determining the distinctiveness or otherwise of a mark, the tribunal may have regard to the issue of whether or not the registration of the mark is limited, in whole or in part, to one or more specified colors.³³ Accordingly, applicant for registration are at liberty to register specified colors as part of their trademark and this is taken into account by the Registrar in determining the qualification of the mark as a distinctive mark fit for registration. Where the mark is registered without limitation as to color, it shall be taken to be registered for all colors.³⁴ With regards to the question of infringement, where a color is not registered as part of a mark, the proprietor will not be entitled to exclusive use of such colour. In the case of *International Tobacco (Nig) Ltd. & Ors v. British American Tobacco (Nig) Ltd & Anor*,³⁵ the court of Appeal held that the gold colour was part of the registered mark of the plaintiffs/respondents. Here, the plaintiffs/respondents, who were owners of the registered trademark *Benson & Hedges* trademark. This was on the basis that the defendants were selling, distributing and importing a certain brand of *Traditional* cigarettes in packs confusingly similar to Thiers, particularly with regard to the gold colour of the packs. The question was whether the distinctive gold pack of the plaintiffs/respondents ‘brand was part of the registered feature of the mark, thereby entitling them to exclusive rights to use the mark. The court upheld the decision of the trial court. The respondents were found to have registered, beyond the name mark, the gold colouring pack of its cigarettes, which was further reinforced by the registration of the slogan ‘Turn to Gold’. Accordingly, the Appellants were held liable for Trademark infringement.

1.3.2 Registration of Trademarks Under Part B of the Register

Where a mark is not sufficiently distinctive to qualify for registration in Part A of the Register it may be registrable under part B. To qualify under this head, the mark has to be capable of being distinctive, In other words, it has to, in relation to the goods in respect of which it is registered or proposed to be registered ,have the capability of

³² Section 9(2) of the Act

³³ Section 16(1) of the Act

³⁴ Section 16(2) Ibid

³⁵ (2009) 6NWLR (Pt.1138)577

distinguishing goods with which the proprietor of the Trademark is, or may be connected in the course of trade from goods in which no such connection subsist.³⁶ Registrability under part B lies on the capability of the mark to distinguish the products in respect of which it is sought to be registered. In this regard, consideration is given to the inherent capability of distinguishing the goods, as well as its factual capability, by reason of use or any other circumstance. A mark can be registrable under part B even where a mark is not inherently distinctive, provided it is capable of becoming distinctive in future with prolong use.³⁷

1.4 Protection of Trademarks

The protection of trademarks has become a top priority, as the identification of goods and services is important to ensure consumer protection and prevent unfair competition³⁸. Once a mark is registered, no other entity can use such mark or attempt to register a separate independent business name using the same or similar mark.

1.4.1 Inherent Distinctiveness

When a new company tries to acquire new mark for a business or product line, it is important to avoid using marks that are very close to existing marks. However, it is equally important to look at the uniqueness inherent in the original brand. The characteristics of the mark can be assessed based on its inherent nature or characteristics, or based on whether it has been practiced to the extent that it has been deemed to indicate the source of the applicant's goods or services³⁹. Essentially distinctive signs are those that communicate with consumers when they are first used, that is, the mark identifies the product, rather than the product identifying the mark⁴⁰. An inherently distinctive sign is a sign that can be registered, without evidence of uniqueness⁴¹. In *International Tobacco Company Ltd & Ors vs. British American Tobacco (Nigeria) Ltd & Anor*⁴² the court held that "...certain marks are inherently distinctive while others only acquire distinctiveness over time. A

³⁶ Section 10(1) of the Act

³⁷ Section 10(2) Ibid

³⁸ Bainbridge. D. I (2009) Intellectual Property 7th edn Pearson Education Ltd p. 627

³⁹ Michael, H. (2014). A Critical Assessment of Trade Mark Distinctiveness and Descriptiveness under Australian Law. *Paper Presented at the 28th Annual IPSANZ Conference, Queenstown, New Zealand*, September. p. 19-21.

⁴⁰ USLegal.com. Inherent Distinctiveness Law and Legal Definition. Retrieved from <https://definitions.uslegal.com/i/inherent-distinctiveness> accessed on 8/7/2019

⁴¹ (Anonymous) What are inherently distinctive v. Merely Descriptive Trademarks? <http://www.patenttrademarkblog.com/inherently-distinctive-vs-merely-descriptive-trademarks> accessed on 8/7/2019

⁴² (2009)6 NWLR part 1138 at 584

distinctive mark may lose its distinctiveness over time and become ‘generic’⁴³. Inherently distinctive marks may be suggestive, fanciful, arbitrary or generic⁴⁴. This means that it does not relate to the product or service for which it is to be used but consists of a word or design which invokes a particular ideas different from the product or service, or consisting of a completely new word or design not invoking any particular idea. For example, in *Lever Bros. Ltd v. Suni white Products Ltd*⁴⁵, the court held that in deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like.

Further examples are: In *International Tobacco Company Ltd & Ors vs. British American Tobacco (Nigeria) Ltd & Anor*⁴⁶ the court held that in determining whether two trademarks are identical or of close resemblance, two senses of the human being are employed. These are senses of ear and the eyes to arrive at a conclusion on the average memory arising from the general recollection. That in the exercise of comparison, not only the visible inspection is important, the sound is equally important. It went on to hold that distinctiveness is proved by reputation/goodwill, that it is not enough to show that there is resemblance of goods, the plaintiff has to further prove a reputation or goodwill attached to the goods under the trademark/name sufficient for members of the public to be misled by the defendant’s conduct into thinking that they are securing the goods of the plaintiff. It will have to demonstrate the volume of its sales and supplement that by evidence from traders and public of the meaning that they attach to the distinguishing features of the plaintiff’s goods saying for instance that they have long understood the trademark to denote the mark of the plaintiff⁴⁷. In the exercise of comparison, it is wrong to take the two trademarks side by side to determine whether they are identical or some close resemblance exists. The issue is whether the person who sees or has seen the proposed trademark will confuse it with the existing trademark, as to create confusion and be deceived common name. It relates to or is characteristic of a whole group or class. It is general as opposed to specific. It further means as “a generic term is one which is commonly used as name or description of a kind of goods and it is generally accepted that a generic term is incapable of achieving trade name protection”.

⁴³ The word ‘generic’ as held in *Smithkline Beecham Plc vs. Farmex Ltd* (2010)1 NWLR part 1175 at 285 In:Ameh.I (2014) Analysis of the Legal and Institutional frameworks for the Protection of Intellectual Property Rights in Nigeria Op.cit p.207

⁴⁴ (Anonymous)OverviewofTrademarkLaw.Retrieved <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm> accessed on 8/7/2019

⁴⁵ (1949)66 RPC 84.

⁴⁶ (2009)6 NWLR pt. 1138 at 577

⁴⁷ *Alban Pharmacy Ltd. vs. Sterling Products International Incorporated* (1968) All NLR 300

1.4.2 Acquisition of Distinctiveness through Use

When a trademark is deemed unique, it can thus be registered as a trademark⁴⁸. Trademarks may be acquired for active advertising. Trademarks that are only descriptive but unique may be protected by law. Descriptive marks can be accelerated to achieve unique meaning through the use of the trademark owner⁴⁹. Trademarks that have achieved acquired distinctiveness can be successfully protected by law⁵⁰. Determining whether a trademark is eligible for registration depends on its unique capabilities. One way in which a mark is protected is through use. In principle, the mark must be certified in the application that it is currently in use and have acquired the uniqueness associated with the same goods and/or services specified in the application⁵¹.

For trademarks to be deemed distinctive, the trademark must be known to the majority of the public. Most of the public must be able to identify trademarks related to the goods or services involved. The purpose of the evidence is to prove that the trademark has been in use and is actually identified in the public mind with the goods or services of a particular merchant before applying for registration⁵². In the case *Ferodo Ltd vs. Ibeto Industries Ltd*⁵³. The appellants in this case instituted an action against the respondent on allegation of continued infringement of their trademark by use of graphic representation of its products which markedly becomes almost indistinguishable from the appellant trademark duly registered and not merely the name of the product, 'Ferodo', contained in the packet. On the strength of this, the appellants sought among other reliefs, an injunction restraining the respondent from infringing the registered trademark. The Court held in that case thus: The element of distinctiveness is consonant to or predicated on some age by way of long extensive user. What constitutes long or extensive user is a question of fact to be determined in the light of the circumstances of the case. It is certainly not the age of Methuselah. Once the Trademark by frequent use, has acquired notoriety in the trade to the common knowledge and easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness⁵⁴. In the instant case⁵⁵ he went further

⁴⁸ USLegal.com. Acquired Distinctiveness (Trademark) Law and Legal Definition. Retrieved from <https://definitions.uslegal.com/a/acquired-distinctiveness-trademark> accessed on 8/7/2019

⁴⁹ What Is Acquired Distinctiveness & Secondary Meaning? On <https://www.ny-trademark-lawyer.com/what-is-acquired-distinctiveness-secondary-meaning.html> accessed on 8/7/2019

⁵⁰ <https://www.briffa.com/blog/establishing-acquired-distinctiveness> accessed on 8/7/2019

⁵¹ Daniel .Z (2011). Court decides on acquisition of distinctiveness. Retrieved from <https://www.internationallawoffice.com/Newsletters/Intellectual-Property/Argentina/Obligado-Cia/Court-decides-on-acquisition-of-distinctiveness> accessed 10/7/2019

⁵² Pelin .B (2014). Trademark's Acquired Distinctiveness through Use. Retrieved from <http://www.mondaq.com/turkey/x/315326/Trademark/Trademarks+Acquired+Distinctiveness+Through+Use> accessed on 10/7/2019

⁵³ (2004)5 NWLR pt. 866 at 317 and *Smithkline Beechman Plc vs. Farmex Ltd* (2010)1 NWLR part 1175 at 285

⁵⁴ Per Niki Tobi, JSC in the case of *Ferodo Ltd & Anor. vs. Ibeto Industries Ltd* op cit.

⁵⁵ ibid

to hold that: It is not enough for the appellants to claim that the components or chequered device formed part of the Trademark but they have the onus to prove further that the components or chequered device were in fact registered. I do not see any such evidence, and here I do not find Exhibit D useful to the appellants. I have carefully examined D and I am clearly of the opinion that what was registered as a Trademark is 'Ferodo' and all other elements are mere beautifications..... Finally the court held that it has been shown that long or extensive use of the Gold colour Pack since 1973 for about 33 years is more than enough time for it to acquire distinctiveness "...it can be seen that there is more than sufficient evidence of *Acquired Distinctiveness*, resulting from sales and heavy advertising throughout Nigeria from 1973 going by exhibit". Therefore, for a mark to acquire distinctiveness through use, it must have been used as a trademark, must be promoted as a trademark, must prove that the trademark operates as a trademark and the relevant public has come to rely on the trademark as a recognized commodity in the market.

1.4.3 Loss of Distinctiveness

Although trademarks are available when they are proven to be unique, they may also be lost. It is important to remember that the protection of trademark maintenance is completely under the control of the owner. The owner of the trademark only needs a high level of organization and a strong defence strategy to maintain the protection of a mark⁵⁶. The uniqueness of a trademark may be lost for different reasons.

One way in which a trademark loses its distinctiveness is when the owner fails to update and manage the trademark. In most cases, when a trademark is registered, it is valid for ten years. However, it is important that companies do not check the protection of their trademarks after ten years. Obviously, many changes may occur in a decade: new business pop-ups, new products are born, and new applications are submitted⁵⁷. Therefore, companies should ensure that they check their trademarks from time to time to ensure that the trademark does not lose its distinctiveness.

When a trademark becomes generic, it loses its distinctiveness too⁵⁸. For example, aspirin, escalators and trampolines have become generic, thus making the mark owners to lose the protection of their marks. Aspirin, escalators and trampolines were once officially owned trademarks, and now they are everyday items. Sometimes marks become so popular that they live their own lives. Once a trademark reaches its generic status, the loss of uniqueness means a loss of trademark protection⁵⁹. In Nigeria, for example, some trademarks are almost at the stage of losing their distinctiveness. An example is Maclean's Toothpaste. Most customers sometimes

⁵⁶ Nick. P (2017) Frustrating Ways to Lose Your Trademark Rights. Retrieved from <https://www.trademarknow.com/blog/six-frustrating-ways-lose-trademark-rights> accessed on 13/7/2019

⁵⁷ Foundation of Law. Loss of Trademark Right Section. Retrieved from <https://lawshelf.com/courseware/entry/loss-of-trademark-rights-section-10643> accessed on 10/7/2019

⁵⁸Ibid n

⁵⁹ Nick. P (2017). Op.cit

want to buy another brand of toothpaste, but still call it Maclean's. The other is Indomie. A large number of customers in Nigeria call all types of noodles Indomie. Other examples include Omo for detergents and Maggi for seasoning. If these marks are not careful enough, their marks may become generic and hence lose their distinctiveness.

The purpose of a trademark is to identify or distinguish goods or services of a particular source from those of others. Non-unique or descriptive marks cannot be protected as trademarks because they do not distinguish between specific goods or services of traders and similar goods or services from other sources⁶⁰. Another way in which a trademark loses its distinctiveness is when a trademark becomes similar to someone else's trademark⁶¹. This may end in court and the ruling may take any form. Another way a mark may lose its distinctiveness is non-use of the mark by the owner⁶². In most cases, the owner's failure to use the trademark for three years may result in the trademark losing its uniqueness and thus losing the trademark. Although, abandonment of mark is not necessarily permanent; trademark owners can revive trademarks. Similarly, a new user can appear and get the right to use the mark abandoned by the original user, thereby excluding the original owner from its use⁶³.

Trademark owners must do their best to protect their marks. Trademark owners should extend their symbol to all media to carry their company logo. Marks can be prominently displayed on packaging, labels, websites, advertisements, press releases, trade shows, business documents, and more. Mark owners often make a common mistake that is, failing to comply with trademark requirements after trademark registration⁶⁴. To their dismay, they lose the rights to their own trademarks. Another way in which a trademark loses its distinctiveness is through false statements and fraud. If the trademark owner commits fraudulent or distorted facts when obtaining a trademark registration, the undisputed trademark may also be lost. Owners who lie to the date of first use of the trademark, or the owner of their ownership interest in the trademark, will be considered fraudulent and may lose their trademark⁶⁵.

1.5 Non-Registrable Trade Mark

Marks that are not distinctive enough from other marks and which cannot be registered as a trademark are called non-registrable marks⁶⁶. This may be on the

⁶⁰Darron .S & Suzy R (2017). Dodging Death by "Genericide". Retrieved from <https://dcc.com/services/trade-marks/dodging-death-by-genericide> accessed on 13/7/2019

⁶¹Ibid

⁶² Foundation of Law. Loss of Trademark Right Section. Retrieved from <https://lawshelf.com/courseware/entry/loss-of-trademark-rights-section-10643> accessed on 10/7/2019

⁶³ Ibid

⁶⁴ How To Lose Your Trademark: 4 Common Mistakes. Retrieved from <https://www.lawinc.com/how-to-lose-my-trademark-common-mistakes> accessed on 13/7/2019

⁶⁵ Ibid

⁶⁶(Anonymous) Registrable vs Non-Registrable Trademarks. Retrieved from <https://www.indiafilings.com/learn/registrable-trademarks> accessed on 13/7/2019

ground of safeguarding the interest of businesses consumer protection or other public policy considerations. Examples of marks that cannot be registered include marks that contradict public order or counter standards of moral, marks that have common terms or words that have broad meaning, marks that have names, symbols of states, nation, international organization, marks without acquired distinctiveness, marks that serve mainly as geographical locations, marks that may potentially cause deceit to consumers⁶⁷. Other examples of non-registrable marks include marks that cannot be accepted under the Trademark Act⁶⁸, marks that consist of subject matter that hurt the religious senses of any class or sections of the society and marks that contain improper or vulgar subject matter⁶⁹. Other types of marks that are qualified to be non-registrable marks include deceptive or scandalous marks, identical and resembling trademarks, names of chemical substance, marks that have immoral bearings or negates public policies and marks similar to coat of arms.

1.5.1 Deceptive or Scandalous Marks

Where the use of the mark is likely to deceive or cause confusion or otherwise not likely to be protected in the Court of justice, as in where it is scandalous, such mark(s) would be refused registration. In determining whether a mark is likely to deceive“ or is scandalous in nature“, the Nigerian Courts have always taken into account the intelligence and education of the consumers. Accordingly, Butler L.J in the case of *United Kingdom Tobacco Co., v. Carreras Ltd.*,⁷⁰ observed as follows:

It is a well established principle, not only in this country, that the likelihood of deception varies with the intelligence and education of the consumer and that a trade marks or get-up which might not confused a literate or educated person could quite easily confuse an illiterate or uneducated one, in the instant case, it was significant that the plaintiff’s „Band Master Cigarettes were popular amongst all classes in Nigeria, and were known among the illiterate class simply as “Oloyinbo”. There was therefore a strong likelihood that illiterate or uneducated persons might confuse, the defendant’s “Barrister” Cigarettes, which also carried a picture of a white man, albeit in a different garb with the plaintiff’s products

⁶⁷(Anonymous) What type of trademark is non-registrable? Retrieved from <https://trademark.marcaria.com/hc/en-us/articles/218320043-What-type-of-trademark-is-non-registrable-> accessed on 14/7/2019

⁶⁸ Ibid

⁶⁹ (Anonymous) Registrable vs Non-Registrable Trademarks. Op.cit

⁷⁰ (1936)16 NLR 1. See Kodilinye. G(1992) *Nigerian Law of Torts* Ibadan: Spectrum Law Publishing, p. 221

In the case of *Orwoola Trademark*,⁷¹ “Orwoola” was held to be deceptive if used as trademark for clothing not made of wool and descriptive if used on clothes made of wool.

A scandalous trade mark is capable of causing disaffection or adversely affecting the morals of society at the particular time. A scandalous mark would give offense to the conscience or moral feelings, or would call out condemnation”.⁷²The test whether a trade mark is scandalous involves a two-part examinations. Firstly, it is determined in the context of the market place and secondly, whether it relates only to the goods described in the application for registration. In other words, the basic rule as to whether a mark is scandalous is to weigh the public reaction to the mark. The onus is therefore on the Applicant to show that the mark has deceived, or is capable of misleading the public as to the source or origin of the goods offer for sale.

1.5.2 Name of Chemical Substances

Trademark that is made up of names of chemical substances is not allowed to be registered in Nigeria⁷³.Section 12(1) of the Act restrict registration of Marks relating to a chemical substance from being registered as a trademark in respect of a chemical substance or preparation.

Section 12 (1) of the Act, provide as follows:

...no word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation; and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 14 of this Act, be treated for the purposes of section 38 of this Act as being an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the case may requires.

Words like sulfur, magnesium etc. are not registrable as a trademark in respect of any chemical products, as such name may be generic, if it is the name of the chemical products, or deceptive if it is not.

However, such chemical name may be registrable where it is used in connection with another word to denote a brand or make of such an element or compound as made by the proprietor or registered user of the trademark .In the case of *Smithkline Beecham*

⁷¹ (1910) Ch.130

⁷² Smith.R (2007) “Trade Marks Law and Free Speech Protection for Scandalous and Disparaging Marks.” *Harvard Civil Rights-Civil Liberties Law Review*, Vol.42, No. 2p. 459

⁷³ Iclg.com. Nigeria: trade Marks 2019. Retrieved from <https://iclg.com/practice-areas/trade-marks-laws-and-regulations/nigeria> accessed on 15/7/2019

Plc v. Farmex Limited,⁷⁴The plaintiff, Smithkline Beecham Plc., was a manufacturing pharmaceutical company and was also a registered owner of the pharmaceutical company and was also a registered owner of the trademark ‘Milk of Magnesia’ which it acquired from Sterling Products Plc. The plaintiff along with its successor-in-title, used the trade name “Philips Milk of Magnesia” on the drugs sold by it, but this, being distinct from its registered trademark, was not registered. The defendant on its part was also a manufacturing pharmaceutical company and one of its pharmaceutical products was “Dr. Meyers Milk of Magnesia”. The plaintiff instituted action claiming among others, an injunction to restrain the defendant from infringing its registered trademark “Milk of Magnesia”, and from manufacturing and selling any pharmaceutical products bearing the trademark Milk of Magnesia. The plaintiff contended that the mark used by the defendant was similar to its own mark. The defendant on the other hand contended that it was the authorized user of the Trademark “Dr. Mayer’s” used on a variety of its pharmaceutical products and also that the name “Milk of Magnesia” was a generic name which the plaintiff erroneously register as a trademark and could not therefore claim exclusive ownership of the name “Milk of Magnesia” because it was a generic or scientific name used freely in the medicinal and scientific world. With regard to the issue whether milk of magnesia was registrable, the court held that at the time the plaintiffs trademark “Milk of Magnesia” was registered, the pharmaceutical world did not recognize it as a generic name and thus, an order removing the name from the register could not be ordered. It was however noted, that it was left to the relevant authority to consider registering the words “Milk of Magnesia” with the word “Philips” added to it, since the words had acquired the status of a generic name in both official and unofficial circles. The court therefore dismissed the plaintiffs’ case.

1.5.3 Identical and Resembling Trade Marks

Section 13 of the Act forbids the registration as trade mark identical or resembling marks belonging to different proprietors and already in the register in respect of the same goods or description of goods. Note however that section 13 (1) of the Trade Mark is applicable where the mark sought to be registered is identical with existing registered trade mark and not where application to register both marks are pending. For instance, where there are competing applications for the registration of marks, the first in time takes precedents. It should be noted that mere contemplation to use mark as oppose to an intention to use a mark is not sufficient for application to register. The proviso to the stipulation in section 13 can be found in subsections (2) and (3) in respect of honest concurrent use, or where an applicant claims special circumstance to the satisfaction of the court or Registrar as the case may be.⁷⁵

In infringement action, the question whether one mark is likely to cause confusion with another, is a matter for the judge alone to decide, however, he cannot abdicate

⁷⁴ (2003) 4 I.P.L.R 416

⁷⁵ *Ferodo v. Ibeto* (supra) at Pages 124-125; see also *Montres Buler Societe Anonyme v. Bulova Watch Company Limited LLC*, 03/17/2011.

the decision to witness before him. Furthermore, in doing so, the judge must be guided by the evidence placed before him and not merely on an inspection of the marks.

In determining similarity for the purpose of marks, account is taken for the purpose of sound, sight and meaning of the Mar. Peacock Milk⁷⁶ as well as Bubble up⁷⁷ have been held to be likely to cause confusion as a result of the similarity of the trademarks to the well-known Peak Milk and Seven –Up drink respectively. Similarly, In⁷⁸ the case of Alban Pharmacy sterling Products International, the court held that in arriving at its decision on whether or not the marks are similar and therefore likely to cause confusion, the court must consider the person with imperfect recollection, the incautious, the illiterate, as well as those who place orders by telephone.⁷⁹ Where, however, the difference between the two devices sought to be registered is such that it can readily be perceived by the average person, the court may hold that there is no basis for a finding that there is such degree of resemblance as is likely or calculated to deceive either an educated or illiterate person. Thus, in the case of *Kai it Battery Factory Ltd v. Registrar of Trademarks*,⁸⁰ the court held that the applicants trademark did not so closely resemble an existing trademark as to be calculated to deceive. Here, the mark sought to be registered consisted of a device featuring three tigers squatting side by side, while the mark on the register was that of a representation of three cats placed over a board. According to Caxton-Martins J., 'cats are animals of the same genus as tigers but to an educated man, there can be no doubt as to which is which. The average man in the street, to whom the goods bearing the two trademarks are exposed for sale in the market will have no difficulty in differentiating one from the other from the background upon which the two types of animals are arranged on the devices.' Therefore according to the court, registration and use of the mark was not calculated to deceive and the registrar was accordingly ordered to proceed with the applicants' registration.

1.5.4 Restraint of Use of Arms of Nigeria or of a State

Apart from the above non-registrable marks, section 62 of the Act, expressly prohibits the use of Coat of Arms of Nigeria or the Arms of a state, in connection with any trade, business or profession of any person without prior authorization of the appropriate authority that is President or Governor, as the case may be⁸¹. The use of such Arms of government is criminal and the offender shall, on summary conviction be liable to a fine not exceeding forty naira. This amount which has since been overtaken by inflation should be reviewed upwards. The appropriate authority

⁷⁶ Terminal v. Marketing & Shipping Enterprises Ltd (1971)2 N.C.L.R 81

⁷⁷ Bubble Up Int. Ltd v. Seven –Up Ltd (1971) 7 U.I.L.R 154

⁷⁸ (1968)All N.L.R 292

⁷⁹ Oyewunmi. A.O (2015) *Nigerian Law of Intellectual Property* Op. Cit. p251

⁸⁰ (1968) NCLR 1

⁸¹ Section 62 (1)(a) of the Act

here is the President of Nigeria or Governor of a State in the case of Arms of Nigeria and Arms of any State respectively.⁸²The use of words such as National, Governor, President as well as the use of emblems or devices which can lead to the belief that the user of the mark is employed by, or supplies goods to the president or governor in his official capacity as such.⁸³

1.6 Conclusion

The paper analyzed the registration of trademarks in Nigeria and which has revealed certain challenges especially in the Trademark Registry. The trademark registration process in Nigeria is still evolving and requires improvement. The process unfortunately is weighed down by bureaucracy and this affects the speed at which registrations are completed. There is an urgent need for the challenges faced by the Trademarks office in Nigeria to be addressed in order to bring the office to the standard expected of it.

The paper makes the following findings:

1. The paper has finds that the artificial dichotomy created between Part A and Part B of the Act relating to trademark registration is entirely unclear and in actual fact there appears to be little or no difference. Therefore, there is no logical basis for continuing with this dual system of registration which is largely ignored in practice.
2. It also finds that the lack of a legal framework which provides for digital database in Nigeria slows down the registration process because searches of registered marks are done manually which is time consuming and may not be accurate.

In view of the findings above, the paper make the following recommendations.

1. There is need to merge the two parts of the register, in line with developments elsewhere, It is recommended that section 2(3), 6(2) and 14(2) of the Trademark Act, be amended to harmonize the registration in Part A and B which has been abandoned in almost all the developed countries.
2. It also recommends that a legal framework be put in place to provide the trademark registry with a digital database to enable the registrar keep the record of all the marks that are registered. The Act should also make a provision relating to the database to enable the public have access to it.

⁸² Section 62(3) Ibid

⁸³ Section 62(1)(b) Ibid in: Oyewunmi.A.O (2015) *Nigerian Law of Intellectual Property* Op.cit p.249