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Table of Content

1)	Universalism, Cultural Relativism or Minimalism? – Quest for the Appropriate Model for Enforcing Women's Reproductive Rights – <i>F. A. R. Adeleke</i>	01
2)	Changing Faces of Terrorism in International Law: Exploring Negotiation as an Option in Nigeria. – <i>Gbadebo Anthony Olagunju</i>	23
3)	Responses of International Law to Human Disasters: The Humanitarian Law Perspective – <i>O.S. Oyelade.</i>	45
4)	Statute of Limitation in Environment-Related Harm and Injuries: Time for Reform? – <i>Tolulope Ogboru & Panmak Lere</i>	75
5)	Limitations of Plea Bargaining in Prosecuting Cybercrime in Nigeria – <i>Ifeoma E. Nwafor</i>	95
6)	Alternative Framework for Oil and Gas Financing in Nigeria: Issues, Challenges and Prospects – <i>Lanre Aladeitan & Obehioye Vera Okonofua</i>	119
7)	An Analysis of Statutory Provisions and Case Law on Trade Marks Registration Under the Nigerian Trade Marks Act – <i>Fagbemi, Sunday Akinlolu</i>	139
8)	Appropriateness of Sanctions Under the Nigerian Customs and Excise Management Act (CEMA) – <i>Musa Omale</i>	161
9)	Double Jeopardy Rule; A Clog in the Wheel of Nigeria Criminal Justice Administration. – <i>Mabel Osato Oniha</i>	183
10)	An Overview of the Disciplinary Mechanisms for Sanctioning of Judicial Officers in Nigeria – <i>Musa Adamu Aliyu</i>	199
11)	Reconceptualizing International Copyright Laws to Protect African Creative Industries – <i>Samuel 'samiai' Andrews</i>	217

12)	Plagiarism and Its Unique Problems: A Study of the Nigerian Legal Response – <i>Christian Sopuruchi Godsfriend</i>	243
13)	The Impacts of Nigerian Constitutions on National Coherence and Governance – <i>Mary-Ann O. Ajayi,</i>	261
14)	The Tragedy of the Nigerian Socio-Economic Crisis and Juvenile Delinquency – <i>Folake Bejide</i>	285
15)	Weakness of Capital Markets' Corporate Governance Instruments in Tackling Business Capture of State and Cronyism in Nigeria – <i>Okubor Cecil Nwachukwu.</i>	303
16)	Attorney General's Consent in Garnishee Proceedings versus Constitutionalism: Appraising the Status of the Central Bank of Nigeria – <i>Ekojoka F. Aghedo,</i>	331
17)	Appraisal of Legal Status of Patient's Right to Object to Medical and Surgical Treatments in Nigeria – <i>Kareem Adedokun</i>	353
<hr/>		
Case Review		
18)	<i>Haastrup v Eti-Osa Local Government: Do Local Government Councils Really Have Power to Conduct a Statutory Marriage in Nigeria?</i> – <i>Abubakri Yekini & M.A. Lateef</i>	377
<hr/>		
Statute Review		
19)	A Review of the Hague Conventions 1899 and 1907 – <i>Adedokun Olatokunbo Ogunfolu & Oluwadamilola Adebola Adejumo</i>	387

**AN ANALYSIS OF STATUTORY PROVISIONS AND
CASE LAW ON TRADE MARKS REGISTRATION UNDER THE
NIGERIAN TRADE MARKS ACT**

Fagbemi Sunday Akinlolu*

Abstract

The legal implication of trade mark registration is to have exclusive right to use the mark, and if need be, assign the mark to another person for use. The objective of trademarks registration is to enhance the economic efficiency of the market place by making the products and producers easier to identify by consumers. The aim of this paper is to analyze the statutory provisions and case law on trade mark registration in Nigeria. In doing this, the pertinent questions which this paper seeks to interrogate among others are: What can be or cannot be registered as trade mark? What is the rationale for trade mark registration? What are the procedures for trade mark registration and the legal effect of registration of trade mark? To answer these questions, this paper explains the meaning and registration of trademark, the paper highlights the advantages of trademarks registration. To understand these advantages, the article itemizes the benefits attached to the registered proprietor on the one hand and the consumers on the other hands. For the purpose of exposition of the intricacies involved in trademark registration, this paper relies heavily on case law on trademark disputes, which illustrates the points being addressed. In conclusion, the paper lists the shortcoming of the extant law on trademark registration in Nigeria with suggestions that the relevant authorities saddled with trademark administration should take steps for the review of extant trademark law in Nigeria.

Key Words: Statutory provisions, Case Law, Trademark, Registration.

*LL. B (Hons) (Ife), LL.M (Ife), Ph.D. (Ibadan), B.L., Senior Lecturer, Department of Public Law, Faculty of Law, University of Ibadan, Ibadan, Nigeria, E-mail. sakinfagbemilaw@gmail.com, Tel: 08034709340; 08101800280.

1.0 Introduction

Trademark is a branch of Intellectual Property. The term “Intellectual Property” as its name suggests is property emanating from the human intellect, mind or through human ingenuity and invention. Intellectual property therefore represents the human ideas and innovations which has been translated into information or technical know-how and are of commercial, scientific and proprietary values. The law recognises these values and attaches some rights to the owners of such property. According to McCarthy,¹ a trademark identifies a seller's goods and distinguishes them from others, associates the goods with the providers, serves as a representation of a certain level of quality and is a strong instrument in advertising. Conventionally, when consumers are able to associate a known mark with goods or services from a particular source, there is reliance on the mark and this would serve as a signal of the quality of such goods and services.²

Intellectual property right covers several fields of human endeavours namely: copyright, patents, industrial designs, trademarks, know-how, trade secret, service marks, indigenous knowledge and internet generated domain name.³ These fields have been adopted and recognised by the World Intellectual Property Organization (WIPO).⁴ The protection of intellectual property in

¹ McCarthy, J. T, *McCarthy on Trademarks and unfair Competition*, 4th ed., (Thomas Reuters, 2004) 26: 1-4, 29: 1-7; see also Olugbemi, A. (2015) 'Trademark Protection: An Appraisal' available at seahipai.org/journal-cy-dec-2015-IJBLR-D-7-2015.pdf, accessed on 18th August, 2018 and Byron, I. P. (July 2017) 'The Importance of Trademarks Protection in Nigeria' *Akungba Law Journal* Vol. 5. No. 1: 216-230:216-217.

² McCarthy, J. T *ibid*, 1-7. See also Ogbuabor. C. A & Anya, S. N. (2013) “Jurisdiction in Actions for Infringement of Trade Marks and Passing-Off” *The Nigerian Juridical Review* Vol 11: 87.

³ It should be noted that there are no statutory provisions on the registration of service mark and domain name in Nigeria. The implication of this is that an aggrieved party to a wrongful use of registered domain name can only claim his right to the use of domain name in an action for passing off. See generally Araromi, M. A. (October 2011) 'Trademark Right in Domain Name System: A Jurisprudential Analysis' *University of Ibadan Law Journal*, Vol. 1, No. 1: 125-146: 138; Oriola, A. (July 1999), 'Anton Pillar Order as a Remedy for Copyright Infringement: A Marital Law in Disguise' *Modern Practice Journal of Finance and Investment*, Vol. 3, p. 6; David I. Bainbridge, *Intellectual Property* 4th edn, (England: Financial Times Pitman Publishing, 1999), 3.

⁴ WIPO is an important agency of the United Nations overseeing Intellectual Property matter. The Organisation came into being in 1967 and was saddled with the responsibilities to promote innovation, creativity and protection of Intellectual Property rights globally, Nigeria became member of WIPO 1995 and has acceded to many of its treaties and protocols

Nigeria can be traced back to the colonial era when the English Trademark Ordinance was introduced to the colonies even before the amalgamation of the then Northern and Southern Protectorates of Nigeria in 1914.⁵ Presently, intellectual property is administered in Nigeria under various species named above. For instance, the Trademarks, Patents and Designs are administered by the Federal Ministry of Trade and Investment while Copyright is administered by the Nigeria Copyright Commission (NCC).⁶ The Nigerian Trade Marks law and practice is governed by the Nigerian Trade Marks Act (TMA) 1988 as amended⁷ and the Merchandise Marks Act.⁸

The questions which this paper seeks to interrogate among others include: What can be or cannot be registered as trademark? What is the rationale for trademark registration? What are the procedures for trademark registration and the legal effect of registration of trademark? To answer these questions, this paper is divided into the following eight sections.

Following this introduction, section two of the paper discusses the meaning and registration of trademarks. In sections three and four, the paper highlights registrable and non-registrable trademarks. Section five explains the rationale for trademarks registration. Section six deals with the procedures for registration of trademarks while section seven is devoted to the legal effects of registration of trademarks. The concluding section highlights the inadequacies of the extant law on trademarks registration in Nigeria with recommendation for amendment.

⁵ Mahwel, J. B. (Sept. 2016) 'Intellectual Property Rights in Nigeria, Are there Adequate Remedies for Damages?' A Comparative Analysis of United Kingdom and Nigeria' *Journal of Public Law & Constitutional Practice* Vol. 9: 319-342: 319-320

⁶ *Ibid*

⁷ Now Cap. T13 Laws of the Federation of Nigeria (LFN) 2004. The first law in Nigeria on trademark was the Trade Marks Ordinance of 1914 and followed by the Trade Marks Act of 1965, which was succeeded by the present Act. Trade Marks law in Nigeria is a replica of the United Kingdom Trade Mark Act of 1938 although differs only in terms of section numbering and the omission of certain administrative sections, which are not applicable in Nigeria. See Shyllon, F. *Intellectual Property Law in Nigeria*. Vol. 21 (Munich: Max Planck Institute for Intellectual Property, Competition and Tax Law, 2003) 211; Ajani, O. O. (2016), 'Fundamental of the Nigerian Trade Marks Acts and Implication for Foreign Trade Marks Owners' *Journal of Intellectual Property Law and Practice* Vol. II, Issue 1: 130-137

⁸ Cap. M10 Laws of the Federation of Nigeria (LFN) 2004.

2.0 Meaning and Registration of Trade Marks

Trademark is defined under the Trade Marks⁹ as:

Except in relation to a Certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that persons, and means, in relation to a Certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act.

The Trade Marks Act¹⁰ similarly describes 'mark' to include 'a device, b heading, label, ticket, name, signature, word, letter, numeral or any combin thereof'. Trademark could then be described as the sign which distinguishes particular goods or services of one undertaking from the goods or services of other undertakings. A trademark is invariably a badge or sign, which indicates the source or origin of the goods in respect of which it is used. The primary function of trademarks is to indicate origin, however, mark also performs other functions and these include 'quality assurance'. To explain a little further; the quality function of a trademark is that the trademark offers a guarantee to the consumer that the goods or services is of the same quality as the one the consumer has become accustomed to. Trademark also performs "investment and advertising" functions. In this connection, it relates to the "cachet" or "aura" which the consumer associates with the mark usually as a result of the way the proprietor has used and promoted the mark and its goods or services.¹¹

Furthermore, there is 'descriptive functions', for examples, some of the most powerful trademarks are those which indicate origin

⁹ See section 67 of the Trade Marks Act, Cap T 13, Laws of Federation of Nigeria, 2004.

¹⁰ *Ibid.*

¹¹ See David Kitchin *et al.* *Kerly's Law of Trade Marks and Trade Name*, 14th edn, (London: Sweet & Maxwell, 2005), 10; Idris, K. (2003) *Intellectual Property: A Power Tool for Economic Growth* (WIPO, Geneva, February 12, 2003 Press Release PR/2003/337) available at www.wipo.int_pr_2003_337 accessed on 12th August, 2018.

and also contain an allusion to some characteristic of the goods or services. The economic function of trademark in the modern economy is dictated by the sheer size of the market. This has become indispensable in a market dominated by mass production and the proliferation of comparable or competing products. Thus, in an economy, where most goods and services come from competing enterprises, trademark owners typically use their marks to distinguish their products and services from other on offer. Their hope is that this will trigger off an association in consumers' minds between origin and good value.¹²

In the United Kingdom, the Trade Mark (Amendment) Act¹³ recognises 'service marks'. This was also reflected in the 1994 Act.¹⁴ The provisions in these Acts are *impari materia* with Article 4 of the European Community Trade Marks Regulation. It should be noted that apart from recognizing services marks, the United Kingdom Act also permits shapes of goods to be registrable. All these are not so in Nigeria under the present statutory dispensation, thus, leading to confusing registration of trademark with service mark, which are not the same.¹⁵ For instance, while trademark is used to tell purchasers of goods that those goods are connected with and come from a particular manufacturer, the primary function of service mark is to identify the provider of certain services and distinguishing such service from the service provided by others in the industry. More importantly, a service mark is a brand that is used in sales and advertising to identify services of a party, and to distinguish them from the services of others. A service mark is accorded legal protection as a designation of source of services.

¹² Beebe, B. (1995), 'Trade Semiotic Analysis of Trademark Law' *UCLA Law Review*, Vol. 51 621:623; W. R. Cornish, *Intellectual Property*, 3rd edn. (London: Sweet and Maxwell, 1996), 515; Klieger, R. N. (1997) 'Trade Dilution: The Whittling Away of the Rational Basis for Trademark Protection' *Pittsburgh Law Review*, Vol. 58 789: 790; Fagbemi, S. A. (2009) 'Intellectual Property: The Legal Remedies for Infringement of Trade Mark and Common Law Tort of Passing Off' *International Journal of Law and Contemporary Studies* Vol. 4, Nos. 1 & 2: 31-54 and Cela, M. (2015) 'The Importance of Trademarks and a Review of Empirical Studies, *European Journal of Sustainable Development*, Volume 3-4: 125 -134.

¹³ Of 1914

¹⁴ See Section 1 of the United Kingdom Trade Marks Act, 1994.

¹⁵ See the case of *Coca-Cola Trade Mark*. (1986) RPC 421 (HL). Where the English court refused to register shape of goods as trademark

Example: Xerox_credit services, available from Xerox Credit Corporation.¹⁶ Typically, providers of services use service marks to protect their services from unauthorised use. However, since the extant law on trademarks in Nigeria did not provide for the registration of service mark, service providers are left without adequate protection under Nigerian law.

Other major innovation in the area of Intellectual property worth mentioning, but not subject of any statutory provision in Nigeria is the advent of and registration of domain name. The domain name has been developed as far back as 1980s in North American.¹⁷ The emergence of domain name to promote business is attributable to the availability of internet access, advances in internet technology and increases in online commercial activity, hence, domain names have gradually transformed the business society and our daily lives. Domain names function as interpreters between users and computers, devices, and content on the Internet. Typically, a person may choose to register a domain name by a combination of letters or figures. For instance, corporate bodies or organisations engaged in business register domain names that are their companies' names or the names of the brands of products they make, or their trademarks. Domain name operate in the same way as street addresses and point wanderers on the Internet to locations of their quests.¹⁸

The Domain Name System (DNS) facilitate the ability of users to navigate the World Wide Web (www), with the aid of two components: the domain name and its corresponding Internet Protocol (IP) number.¹⁹

There is no natural property interest in the domain name spaces, but that a synthetic proprietary interest has been engineered by the trademark holders through the help of the World Intellectual Property Organisation (WIPO) and is

¹⁶ Steven J. Hultquist, "Trademarks and Service Marks" available at www.hultquistip.com/files/tm_and-sm.pdf accessed on 24 September, 2018 at 10.46am.

¹⁷ Chih-Hong (Henry) Tsai (2013) "The Trademark/Domain Name Protection War: A Comparative Study of the U.S., UDRP and Taiwanese Law" *The John Marshall Review of Intellectual Property Law* 353.

¹⁸ Araromi, M. A *op cit* 125.

¹⁹ *Ibid*

being enforced by the Internet Corporation for Assigned Names and Number (ICANN) through its uniform Dispute Resolution Procedure (UDRP).²⁰ Registration of domain names for use in Nigeria is normally done outside the shores of the country since there is absence of ICANN accredited registrar for the domain names within the country. This clearly removes available registrars outside the jurisdiction of Nigerian courts for purposes of any injunctive relief, for deactivation, forfeiture or cancellation of names.²¹ It is, therefore, difficult to obtain remedy for wrongful use of domain name if one business is within Nigeria and the other business using a common name or a common trademark is outside Nigeria. Conversely, it is not compulsory to register a trade mark before it is used. For instance, the common law offers some forms of protection to a proprietor of an unregistered trademarks. Hence, where the marks have conferred on the owner considerable goodwill or reputation, the owner can enforce his right under the common law tort of passing off.²² Before a trade mark enjoys legal protection under the Trade Marks Act, it must be registered. It is the registration of trademark that confers on the owner/proprietor an exclusive right to use the mark and he can sue for its infringement by unauthorized user. However, the mark must actually be registered at the date of commencement of the action as it is not enough that registration has been applied for but not yet granted. Thus, where a defendant proves that he had been using his mark continuously for some period before the registration of the trade mark by the proprietor, his right to use the mark may override that of later registered proprietor. This was the position of the Nigerian Supreme Court in the case of *American Cynamid Co. v. Vitality Pharmacy Ltd.*²³ in that case, Honourable Justice Karibi-Whyte JSC (as he then

²⁰ *Ibid*

²¹ Mena Ajakpovi (2001) "Domain Names and Trademarks in Nigeria" *Modern Practice Journal of Finance and International Law*, Vol. 5, No. 2, p. 205

²² See section 3 of the Trade Marks Act, Cap T 13, LFN. 2004, which expressly forbid institution of action for the infringement of an unregistered trademarks. The legal implication of the tort of passing off is that the trader who originally owns an identity by which he has been known is put at a disadvantage if another person employs such an identity to promote himself or his own business. See Kodinliye, G. *The Nigerian Law of Torts 5th ed.* (Ibadan: Spectrum Law Publishing Nig. 1997), 215; Araromi, M. A. *op cit*, 126 and Fagbemi, S. A. (2011) 'A Critical Examination of Legal Remedies for the Tort of Passing Off and Unfair Competition under Nigeria Law' *University of Ibadan Journal of Private and Business Law* Vol. 6: 68-95. See also the case of *Ferodo Ltd. v Ibeto Ind. Ltd* (2004) NWLR (Pt. 866) 317 at 347 Paras. D-G.

²³ 34 NIPJD (1991) SC/ (1991) 2 SCNJ 42. See section 7 of the Trade Marks Act.

was) while explaining the import of section 7 of the Trade Marks Act said as follows:

The words of the above provision seem to me clear and unambiguous. The section protects trademarks, which are identical with, or nearly resembling that of a proprietor, or a registered user of a registered trade mark, where such trade mark has been in continuous use by another or his predecessor-in-title, previous to the date of the registration of the new trade mark. The protection covers both prior use of the trade mark or the registration of the trade mark in the name of the proprietor or predecessor-in-title.

It is important to note that there is a difference between registration of trademark and use of trademark. The difference between the two relates to the burden and standard of proof in the event of action for infringement. For instance, while anybody may bring an application to oppose registration of trade mark, the use of trademark does not depend on the validity of its registration but on the evidence of continuous and extensive use of the mark. Again, the effect of registration of trademark is to give it statutory protection, meanwhile, the right of the User of unregistered trademark lies only under the common law tort of passing-off.

Premised on the above, it is submitted that one may be a user of trademark and not the proprietor of the same trademark. It is equally clear that common law confers vary rights on the proprietor or user of unregistered trademark. However, the advantages to be derived from registration of trademark far outweigh that of unregistered users. Some of these advantages include the following among others:

- (a). Prevention of infringement of a trademark is easier, less time consuming and less costly in cases where a trademark is registered;²⁴
- (b). In the event of infringement, damages may be claimed from the infringer.

In the case of *CPL Industries Limited v. Morrison Industries Plc.*²⁵ it was

²⁴ *American Cyanamid Coy. v. Vitality Pharmaceutical Ltd (supra)*.

²⁵ Unreported Case Suit No FHC (2006-12-20).

held that *mere proof of infringement entitles the plaintiff to damages.* ;

- (c). Acquisition of right through registration is generally much quicker than building up the required common law repute, and goodwill, through use;
- (d). Registration allows for the effective appointment and control of licenses and franchises;
- (e). Registered trademarks are relatively easy to assign to third parties;²⁶
- (f). Registered trademarks can serve as security for loan in that they may be bonded; and
- (g). Trademarks registration can be of assistance in having the mark registered in another countries.²⁷

3.0 Registrable Marks

Premised on the meaning of trademarks in section 67 of Trade Marks Act, the salient question to ask is what can be registered as a trademark? In line with description of 'mark' in section 67 of the Act, it is certain that 'any mark, word(s), design, device, label, numerals or combinations of these which are distinctive or have acquired distinctiveness as used in relation to goods for the purpose of indicating a connection in the course of trade between such goods and some person having the right either as proprietor or as registered user to use the mark are capable of being registered.

For the purpose of registration of trademarks, the Trade Marks Act has created two Parts in the Trade Mark Register, hence, a 'mark' can be registered either under Part A or Part B of the Trade Marks Register. While registrations under Part A relate to marks which are inherently distinctive, registrations under Part B are available for marks which are capable of being distinctive. Under the current version of the Trade Marks Act, protectable trademarks are limited to goods only. However, in 2007, the supervising Minister in exercise of powers under sections 42 and 45 of the Trade Marks Act incorporated new schedules covering service

²⁶ Section 35 of the Act.

²⁷ Bowman Gilfillan Inc Trade Marks- Frequently asked Questions, 1999.

marks.²⁸ In the case of registration under part A of the register, the mark must contain or consist of at least one of the following essential particulars:

- (i) The name of a company, individual or firm represented in a special or particular manner;
- (ii) The Signature of the applicant or some predecessor in his business;
- (iii) An invented word or words;
- (iv) 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; see the case of *Ligget and Myers Tobacco Coy. v. Registrar of Trade marks*,²⁹ in that case, the bone of contention is whether the trade mark "CHESTERFIELD" is not a geographical name in its ordinary signification? The court in granting the application held thus:

The phrase 'geographical name' in the absence of special circumstances must be interpreted in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it.³⁰

- (v). Any other distinctive mark.³¹

²⁸ Onyido, J. C & Okojie, Y, both of S. P.A. Ajibade & Co, (2017) *The International Comparative Legal Guide to: Trade Marks 2017* 6th ed. (London: Global Legal Group Ltd), Chapter 24, p.192 available at www.ICLG.com accessed on 11th August, 2018. Although a service mark is essentially the same as a trademark, however it applies to services rather than products. Service is used by a party to identify and distinguish the service of that party from the services of others and to indicate the source of the service (even if the source is unknown). In plain English, a service mark is a word, phrase, symbol or logo that is used to brand, identify, and distinguish a service. While a trademark is a word, phrase, symbol or logo that is used to brand, identify and distinguish a product. See Trademark vs Service Mark: What's the Difference? Available at <https://secureyourtrademark.com>, accessed 10th August, 2018. The implication of Minister action is that application for registration of service mark may be rejected by Registrar of Trademark since there is no express provision in the extant Trademarks Act for its registration in Nigeria.

²⁹ (1969) ALLNLR 540.

³⁰ Article 22 of TRIPS Agreement defines geographical indications as 'indications which identify a good as originating in the territory of a member, or a region or locality in that territory. Where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin'.

³¹ Section 9(1) Of the Act.

Conversely, for a trade mark to be registrable in part B of the register, it must have distinguishing feature in relation to the goods in which it is proposed to be registered *vis-à-vis* any subsisting mark.

4.0 Non-Registrable Trade Marks

The inclusion of identification features in the very definition of a trademark is significant to its historic basis that the law's purpose is to protect marks as, in a broad sense, indicators of origin. In Britain and under the Trade Mark Act of 1938, which is *impairi material* with the Nigerian Trade Marks Act, there was certain niggardliness over what could be a trademark in relation, for instance, to slogans, get-up and colouration.³² In *Coca-cola Trade Marks Application*,³³ the House of Lord refused to treat the shape of the "Coca-cola" bottle as a trade mark for non-alcoholic beverages in Class 32. However, great liberation is now to be expected, but still subject to the governing consideration of distinctiveness. Thus, *In Smith Kline v. French Trade Mark's Application*,³⁴ the House of Lords allowed the registration of a colour combination added to a drug capsule as trade identification.

In view of the foregoing, a mark proposed to be registered must satisfies the consideration of distinctiveness.³⁵ As a general rule, deceptive marks which are likely to mislead and/or misinform the buying public, or scandalous marks which are contrary to law and morality, vulgar and disparaging marks,³⁶ names of

³² Cornish W.R. *op cit*, p 582.

³³ [1986]ARC 421

³⁴ [1976]ARC 511.

³⁵ See the case of *Boots Company Limited v. United Niger Imports (Chemicals and Industry) Ltd (supra)*; *Ferodo Ltd. v. Ibeto Industries Ltd. (supra)*; Michael Blakeney, *Trade Related Aspect of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement*, (London: Sweet & Maxwell, 1996), 53. See also Article 15.1 of the TRIPS Agreement, Article 6, Section B, 2 of the Paris Convention

³⁶ A scandalous trade mark according to Regan Smith is one which "its use would be shocking to the sense of propriety, would give offense to the conscience or moral feelings, or would call out condemnation". Over the years, some marks which have been held to be similar as to confuse the Nigerian public are: (i). The word "Censrina" and "Castoria", "Peacock and peak" and "Three Castles and Old Castle" and (ii). Two marks where the prominent features in each was the "land", although there are other differences. see Regan, S. (Summer 2007) 'Trade Marks Law and Free Speech Protection for Scandalous and Disparaging Marks' *Harvard Civil Rights-Civil Liberties Law Review* Vol. 42, No 2: 459; See Kodilinye, G., *op cit*, 221; Ese Malemi, *Law of Tort* (Ikeja: Princeton Publishing Company), 493-494; *United Kingdom Tobacco Co., v. Carreras Ltd*, (1936) 16NLR 1 and *Gottshark v. Spruce* (1936) 1 FSC 42.

chemical substances³⁷ and identical or resembling trademarks which are likely to deceive or cause confusion,³⁸ and the use of the Nigerian Coat of Arms or other Emblem or Insignia of governmental authority.³⁹

5.0 Rationale for Trade Marks Registration

The foundation upon which the law relating to trademarks registration evolved is to prevent the deception of the public by offering goods as possessing some connection with a particular trade, which in fact it does not. It is therefore a fundamental principle of law that an Applicant, who wants to register his trademark must show that it is clearly distinguishable from other marks in the market. The rationale for this is to avoid public deception and to avoid the mark from being mistakenly taken as the marks of rival traders.⁴⁰

According to Griffiths,⁴¹ the rationale behind the protection of trademarks is that the owner has spent time and money in presenting a service or product to the consumer; and the owner should be able to protect this investment by being

³⁷ See section 12 of the Trademarks Act, the provision of section 12 (1) of the Act is therefore qualified by sections 14 and 38 of the Act. For instance, section 14 deals with conclusive validity of trade mark after seven years of its registration unless the registration is obtained by fraud. Section 38 on the other hand, confers on any person who alleges that there had been wrong entry of trade marks in the register, to apply either to the court or to the Registrar of the trade mark for the rectification or expunging of the marks from the register.

³⁸ For instance, section 13 of the Act forbids the registration as trademark identical or resembling marks belonging to different proprietors and already in the register in respect of the same goods or description of goods. 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. See *Ferodo v. Ibeto (supra)* at Pages 124-125; see also *Montres Buler Societe Anonyme v. Bulova Watch Company Limited LLC*, 03/17/2011.

³⁹ Section 62 of the Act expressly prohibits the use 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. 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. The appropriate authority here is the President of Nigeria or Governor of a State in the case of Arms of Nigeria and Arms of any State respectively. See section 62 (3) of the Act; See also the case of *Alban Pharmacy Ltd. v Sterling Products International Ltd.* (1968) 1 All NLR 300; Alatumji, A. O & Olapade, O. S. (2014-2015) 'The Trademarks Act of Nigeria and the United Kingdom: A Comparative Examination' *NIALS Journal of Intellectual Property (NJIP)*, 83

⁴⁰ Mena Ajakpovi (July/October 2005), 'Intellectual Property Rights in an Electronic Environment: Nigerian Perspective' *Modern Practice Journal of Finance and Investment Law* Vol. 9, Nos. 2-3-4, 641.

⁴¹ Griffiths, A. *An Economic Perspective of Trade Mark Law*. New Horizons in Intellectual Property (United Kingdom: Edward Elgar Publishers, 2011), 29

allowed to prevent others from using the trademark and profiting from the owner's investment. Trademark protection therefore, reduces significantly consumer search costs since consumer do not have to spend time investigating the attributes of a particular brand because the trademark is a shorthand way of signifying the consistency or quality.⁴²

Premised on the foregoing, one essential criteria qualifying a trademarks registration is that it should be 'distinctive'.⁴³ Hence, the proper test to determine when a mark has become *public juris* is whether its use has ceased to deceive the public as to the maker of the article. Another factor qualifying a trademark for registration is that, it must be 'original'. The 'origin theory' is aptly captured in the definition given to marks in section 67 (1) of the Nigerian Trade Marks Act. However, the theory admits exceptions under the English Law. For instance, where the goods in question, emanates from several legitimate producers, who are producing goods with different tastes, composition or qualities for sale under the mark in different territories, the theory will not apply. This is called under the English law an "exhaustion theory".⁴⁴ Exhaustion theory is the parallel sale of differing goods under one mark.⁴⁵

Under the English law and by virtue of exhaustion doctrine, the rights of an intellectual property owner terminate after an exercise of the rights by the owner. The exhaustion doctrine states that after the intellectual property owner has made a first sale of a commodity that embodies the owner's intellectual property, the owner no longer has the right to prohibit sales of that particular commodity.⁴⁶

⁴² IOWA State University, Trademark Licensing Office, Trademark Legal Basics, available at www.trademark.iowastate.edu/basic accessed on 9th August, 2018

⁴³ See the case of *Singer Manufacturing Co., Ltd. v. Loog* [1880] 18 Ch. D. 395 at 412.¹

⁴⁴ The theory has no place under the Nigerian Trademarks Act, thus, a proprietor of a trademark enjoys exclusive right over his mark even after he has transferred his title to a buyer. This is a clear derogation from the free market operation in commercial transaction

⁴⁵ Sneha Jain, (January 2009) "Parallel Imports and Trademark Law, *Journal of Intellectual Property Rights* Vol 14, 14-27. See also the case of *Champagne Heldsieul et Gemopolo S.A v. Buxton* (1930) 1 Ch. 33

⁴⁶ Shubba Ghosh, (November 2013), "The Implementation of Exhaustion Policies: Lessons from National Experiences", Issue Paper 40, *International Centre for Trade and Sustainable Development*, 3; Phillip Jeremy, *Trademark Law: A Practical Anatomy* (London: Oxford University Press, 2003) 273-275. See the cases of *Kistaeng v. John Wiley & Sons, Inc.*, 568 U.S. (2013); *Champion Spark Plug Co. v. Sanders*, 331 U.S. 125 (1947) and *Quantav. L.G. Electronics*, 53 U.S. 617 (2008).

Thus, once the marked goods are once purchased legitimately, the intellectual property owner or any one deriving title from him cannot prevent sale of such goods, as the exclusive right to sell goods bearing the mark is 'exhausted' by the first sale; then the exclusive right to sell goods bearing the mark cannot be exercised twice in respect of the same goods.⁴⁷

6.0 Procedures for Registration of Trade Marks

After ascertaining that the mark is registerable, a search should be conducted at the Trademarks Registry to confirm the availability of the mark. An application may still be made without conducting a search, but this stands the risk of being refused if it is discovered to be in conflict with an existing mark. Secondly, the following information: the name of the mark or specimen of the mark (in the case of a logo or device); full name and address of the Applicant; indication of the product class(es); and a power of attorney duly executed by the proprietor of the mark, authorising a registered agent to register the trade mark are then forwarded under a cover letter addressed to the Registrar of Trade Marks, with an indication whether registration is sought under Part A or Part B of the register.

The applicant may request an opinion on distinctiveness from the registry. An Acknowledgment is issued immediately the application is filed. An Acceptance Letter will normally follow within three to four months after filing the application, and after an initial examination possible conflicts as being conducted by the registry. For the purpose of registration of trade mark in Nigeria, a Registrar of Trade Mark is appointed with an office in the Federal Capital Territory, Abuja.⁴⁸ The Registrar of trade mark generally acts under the direction of the Honourable Minister of Trade and Investment. The Registrar also has an official seal, which are officially and judicially noticed.⁴⁹

The duties of a Registrar of trademark among others include maintenance of trademark register and to examine application for the registration of trademark.⁵⁰

⁴⁷ Bansal Ashwini Kr. *Law of Trademarks in India* 2nd edn. (Centre for Law, Intellectual Property and Trade, 206) Chapter 18, 429 and 430.

⁴⁸ Section 1 of the Act.

⁴⁹ Section 1 (2) and (4) of the Act. See also section 122 of Evidence Act, 2011

⁵⁰ Section 2 of the Act.

By virtue of section 19 (1) of the Act, when an application for registration of a trademark has been accepted by the Registrar, he shall publish the notice in the Trade Mark Journal. Anybody who wishes to oppose the application shall within two months from the date of the publication do so. Once there is no opposition filed challenging the application for registration within the statutory period allowed for third party, or where the opposition had been resolved in favour of the Applicant, the Registrar shall register the mark and issue to the Applicant a certificate of registration thereof. Such certificate is *prima facie* evidence of registration and afforded the proprietor all the rights and privileges under the Act. These rights and privileges cannot be realized on just presentation of application for registration. Conversely, in the United States of America, once a mark has been searched and cleared, an application can be filed with the U.S. Patent and Trademark Office based either on use in commerce (commerce between two or more states or between a foreign country and the United States) or on the basis of intent-to-use (ITU) in the future.⁵¹ In the case of an ITU application, a registration will not issue until the mark is being used in commerce. The process of securing a registration takes approximately nine to 12 months to complete, depending upon the complexity of the issues encountered during examination. Once the trademark examiner has accepted the application for registration, it will be published in the Official Gazette of the U.S. Patent and Trademark Office for opposition purposes. During this 30-day period, the world is put on notice that anyone who believes he will be damaged by issuance of the registration may file an opposition to registration and make his case. If no opposition is filed, the registration will issue and the applicant can from that point onward use the logo “®” to indicate registration in its packaging and printed materials.⁵²

Registration of a trademark or service mark with the U.S. Patent and Trademark Office provides many advantages over relying solely on common-law rights, including the creation of certain presumptions under the law, such as the presumption that the registration and mark are valid, that the registrant has the

⁵¹ Susan B. Flohr, 'Company Names, Trademarks, and Protection Your Commercial Identity' available at <https://www.lankhome.com/siteFiles/publications/OD81B5ED2909E94651A32A4F84DB.pdf> accessed on 26 September, 2018 at 11.00am

⁵² *Ibid*

exclusive right to use the mark, and that the registrant is the rightful owner of the mark. Federal trademark rights are also nationwide. Once a registration issues, no one else can adopt the same or confusingly similar mark and claim he had no notice of the registration. By law, the registration constitutes constructive notice.

Under the extant Trademark registration regime in Nigeria, the Registrar of Trademark has a wide discretionary power to determine which part of the trademark's register should a mark be registered, he also has to determine any question arising therefrom.⁵³ For instance, the likelihood of the deception of two seemingly similar trademarks. The Registrar's judgment in these issues can hardly be questioned once they are exercised in the best interest of smooth administration of trademark regime. The implication of the above is that while the Registrar of Trademark's power to determine registration of trademarks in Nigeria is subjective, that of the U.S. Patent and Trademark Office is transparent and objective. Quite apart from this, the trademark regime in the United States confers on an Applicant or prospective user of trademark wide range of advantages than what obtain under the Nigerian Trade Marks Act. For instance, an application showing an intent-to-use (ITU) a mark in future is protected under the U.S. law.

7.0 The Legal Effects of Registration of Trade Marks

Registration of a trademark confers on the registered proprietor the exclusive right to use the mark in relation to his goods or services.⁵⁴ The status also confers on the registered proprietor the legal capacity to institute legal action for its infringement by an unauthorized user. Accordingly, section 3 of the Nigerian Trade Marks Act provides *inter alia* that: 'No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark....'.

The above provision is however subject to the right of an unregistered user to bring action for the tort of passing off with all its attendant conditionalities

⁵³ Section 4 of the Act.

⁵⁴ Mena Ajakpovi, (Jan/April 2004) 'The Internet Intellectual Property Rights and Legal Framework for E-Commerce in Nigeria' *Modern Journal of Finance and Investment Law* Vol. 8, Nos 1-2: 166

under the common law. For instance, the plaintiff in an action for the common law passing off must *prima facie* establish that:

- (a) he enjoys sufficient goodwill in relation to the goods in question from members of the public,
- (b) the defendant act in misrepresenting the goods or mark to the public is capable of misleading or is likely to mislead the public into believing that the goods or services are authorized by the plaintiff,
- (c) the defendant acts will lead to actual or likely damage to him.⁵⁵

The above requirements are not necessary in the case of registered trademark; what is essential is proof of registration of the mark by the proprietor of the trademark. Furthermore, registration of a trademark also confers a personal proprietary right on the proprietor than the right conferred by passing-off.⁵⁶

Under the Trade Marks Act, a proprietor of registered trade mark has the right to either use the trademarks personally or assigns it to another person. Similarly, a registered trade mark is capable of being transmitted to beneficiary on the demise of the proprietor.⁵⁷ Furthermore, the Trade Mark Act also confers right in varying degrees on the registered user to bring an action for any infringement of registered trade mark, provided he had called upon the proprietor to do so and he has defaulted after two months of such request.⁵⁸

The right of the proprietor takes effect from the date of the filing of the application for registration.⁵⁹ However, infringement proceeding cannot be commenced before the date on which the trademark is in fact registered.⁶⁰ Under the English law, only acts committed in the United Kingdom can amount to an infringement of the proprietor's exclusive right.⁶¹ Conversely, it seems that a proprietor of trademark in Nigeria can bring action for act of infringement

⁵⁵ See *Reckitt & Colman Product Ltd v. Borden Inc. & Ors.* (1990) RPC 341.

⁵⁶ *Seven-Up Company & Other v. Warri Bottling Company* (1984) F.H.C.L. R 13.

⁵⁷ Section 26 of the Act.

⁵⁸ Section 33 of the Act. *

⁵⁹ Section 22 (2) of the Act.

⁶⁰ *Ibid.*

⁶¹ Section 9 (1) of the England Trade Mark Act, 1994.

committed in foreign country. The support for this view is captured in the wording of section 5 (2) of the Nigerian Trade Mark Act which provides thus

Without prejudice to the generality of the right to the use of a trade mark given by such registration as aforesaid, that right shall be deemed to be infringed by any person⁶² who, not being the proprietor of the trade mark or a registered user thereof, using it by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either:-

- (a). as being use as a trade mark, or
- (b). in a case in which the use is used upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

From the foregoing, the emphasis on “any person” in the above provision is to show that the provision of section 5 of the Act is binding on any person irrespective of their national identity, thus, if a non-Nigerian citizen infringes on a trademark registered under the Act, the Applicant can bring action in Nigeria for such infringement leaving in this regard, the problem of enforcement of such judgment in foreign country. The enforcement of such judgment may not however pose any problem, particularly, where the trademark in question enjoys protection under section 44 of the Act. This section gives right to a proprietor of trademarks to apply for protection of his mark in Convention Country.⁶³

⁶² Emphasis supplied.

⁶³ Nigeria is a party to the Paris Convention and therefore under an obligation to give protection of intellectual property rights to citizens of countries of the union so that citizens of the nations to this Convention will, as regards the protection of intellectual property, enjoy in all countries of the union the advantages that their respective laws grant to their citizens, and without prejudice to the rights especially provided for by the Convention. See Paris Convention for Protection of Industrial Property 1883 revised in Lisbon 1953.

In an action based on the statutory right conferred by registration of trademark, the plaintiff must prove his title either as proprietor or as a registered user. This status entitles him to sue and prove that the defendant has acted or threatened to act in such a way as to infringe the right conferred by registration as defined in section 67 of the Trade Marks Act. Procedurally, it is the proprietor of a trademark that can institute action for infringement of trademark and not the trademark itself. In the case of *Maersk Line & Anor. v. Addide & Anor.*⁶⁴ the Supreme Court said *inter alia* that 'a trademark cannot sue or be sued as it is not a juristic person, it is its proprietor that can sue or be sued'.

The major challenge hitherto existed in an action for the infringement of a trademark in Nigeria was the issue of court vested with the jurisdiction to entertain action for infringement of trademark in Nigeria.⁶⁵ Hence, whenever party seeks legal redress in the event of unauthorized use of his mark; he must as a threshold issue determine which proper *forum* to institute his action. This question has now been laid to rest under section 67 (1) of the Trade Marks Acts, which defines the court to which the Act apply to mean 'the Federal High Court'. This statutory provision has further received impetus under section 251 (1) of the Federal Republic of Nigeria Constitution, 1999 (as amended), which now conferred on the Federal High Court exclusive jurisdiction to entertain action for the infringement of trademark and other intellectual properties.⁶⁶

8.0 Conclusion

The law, practices and procedures for registration of trademark are provided for in the Nigerian Trade Marks Act. However, the provisions of the Act still remained as it was copied from the United Kingdom Trade Marks of 1938 without any substantial amendment to bring the provisions in tandem with international best practices. It is a fact that the world has transformed globally thus bringing unimaginable developments and advancement in virtually all

⁶⁴ (2002) 11 NWLR (Pt. 778) 317 at 360/ (2002) 4 SCNJ. 433.

⁶⁵ See in this connection the case of *Patkun Industries Ltd. v. Niger Shoes Manufacturing Co. Ltd (supra); IML, Chartering Nig. Ltd. v. IMNL International Messengers (Nig.) Ltd. (1977-1989) 2 IPLR 80 and Ayman Enterprises Limited v. Akuma Industries Limited & Others (2003-2007) 5 IPLR 1 at 25.*

⁶⁶ SA. Fagbemi, (2009) *op cit*, 48-49.

human endeavours. The advancement in commerce, information technology, mass communication and international politics to mention but just few have reduced the world into a global village. Granted the effect of globalization on every field of human pursuit including trademark practice, there is no doubt that the provisions of the Nigerian Trade Marks Act of 1965 has fell short of the modern trends and advancement in technology in relation to trademarks regime. It is a fact that the practice of trademark registration is on a daily basis expanding and several innovations are being introduced globally. These innovations amongst others include; registration of services mark, the introduction of exhaustion theory in America and Europe, and the emergence of registration of domain name orchestrated by the wide acceptability of internet practice highlighted in this paper. For instance, the United Kingdom Act made no provision for the registration of service marks, because of this and other inadequacies, the United Kingdom amended the 1938 Act in 1984 to accommodate the registration of service marks. This was further amended in 1994 to bring the United Kingdom at par with the European Union. Today service marks are registrable in the United Kingdom but Nigeria is still saddled with the 1938 Act which makes no provision for the registration of service marks save the directive of the Minister of Trade and Investment in the year 2012 without a formal incorporation of this directive by amendment to the Trade Marks Act.

Furthermore, Nigeria is signatory to Paris Convention of 1883, but there have been several other International Arrangements and Agreements in the field of intellectual Property relating to trade marks practices. It is sad to note that Nigeria has shown little or no interest in most of these new arrangements and innovations. A good example is the Madrid Protocol. At the level of case law, there are sizeable numbers of judicial authorities in the field of trademark registration due to the ignorance on the rules that govern trademarks and their use in the country. Also the absence of new innovations as obtained in advanced jurisdictions as greatly affected judicial activism in Nigeria. In view of the inadequacies of the extant statutory provisions on trademark practice in Nigeria, it is very imperative to increase seminar and talk shop on trademark to educate the public on the importance of trademark registration and its attendant legal

implications.

This paper had therefore highlighted various inadequacies in the extant Trade Marks Act. The hope is that this will challenge the relevant authorities to take concrete step to review or amend the present Trade Marks Act to meet the growing trends in international sphere. With this, it is expected that the practice of trademark will blossom to an acceptable international standard in Nigeria.

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