

**DISTINCTIVENESS AND REGISTRATION OF TRADE MARKS UNDER THE TRADE MARKS ACT\***

**Abstract**

*At the centre of trade mark registration and protection is the issue of distinctiveness. Though the quality of being 'distinctive', or being capable of becoming 'distinctive in use' is stipulated as a major condition for registrability of a trade mark, the scope of this term and its impact on registration under the two parts of the trade marks register continues remains a major source of worry to proprietors of trade marks. Using the doctrinal methodology, this paper examined the import and scope of distinctiveness vis-à-vis registration of trade marks under Part A and B of the trade marks register. To be effective, this work considered the legal principles on registration of trade marks and critically analyzed the concept of distinctiveness as an important factor in registration of trade marks under Nigerian law. This paper advocated that proprietors of trade marks seeking registration of such marks should pay serious attention to this all-important factor as a pre-requisite for the success of such applications for registration.*

**Keywords:** Trade mark, Trade Marks Act, registration of trade marks, distinctiveness.

**1. Introduction**

A successful trade mark is a valuable asset that can boost the reputation of a brand and affect the preferences of its consumers. A trade mark is a symbol or a sign which differentiates the goods and services of one business from another one.<sup>1</sup> A trade mark may in particular consist of words, designs, letters, numerals or the shape of their packaging.<sup>2</sup> A trade mark provides protection to the owner of a mark by ensuring exclusive right to use it to identify goods or services, or to authorize another to use it in return for payment.<sup>3</sup> We opt for trademarks when we form a new, distinct meaning to the current word. Besides, we can also use it when we coin a new term to prevent customer confusion on the market and also to distinguish the origin of the products and services. A trade mark must be registered before the proprietor of the mark can benefit from the protection granted under the law. The registration of a Nigerian trade mark is under the control of the Registrar of Trade Marks who is responsible for the registration of trade marks and other related activities pertaining to the exploitation of a registered mark.<sup>4</sup> He also acts under the general direction of the Minister in charge of commerce, trade and industry.<sup>5</sup> The Registrar of Trade Marks is also the custodian of the trade mark register which is the record in which all registered trade marks with the names and addresses of their proprietors, the dates on which applications were made for the registration, notification of assignments and transmissions, the names and addresses of all registered users and such other matters relating to trade marks as may be prescribed are entered.<sup>6</sup> The Minister also play a major role in the registration of trade marks by making regulations for diverse purposes including the classifying of goods for the purpose of registration and for prescribing the fees to be paid in respect of applications, registrations and other matters under the Trade Marks Act.<sup>7</sup>

---

\* **By M.V.C. OZIOKO, PhD**, Reader and Formerly Head, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, P.M.B. 5025, Awka, Anambra State, Nigeria. Email: mvcozioko@gmail.com; mv.ozioke@unizik.edu.ng. Phone Number: +2348039464374;

\* **Chinedu A. ONAH, LL.M**, Lecturer, Department of Commercial and Property Law, Faculty of Law, Nnamdi Azikiwe University, P.M.B. 5025, Awka, Anambra State, Nigeria. Email: ac.onah@unizik.edu.ng; chineduonah@nigerianbar.ng. Phone Number: +2348064794333; and

\* **Chukwubuike J.S. AZORO, LL.B, LL.M, BL**, Ph.D Candidate, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, Awka, Nigeria and Associate at IUC Global Chambers, Awka, Nigeria; Phone Number: +234(0)8061116935; Email: cjsazoro@yahoo.com; cjsazoro@nigerianbar.ng.

<sup>1</sup> How to register a Trademark or Patent in Nigeria available at <<http://www.legalnaija.com/2013/09/how-to-register-trademark-or-patent-in.html>> accessed on 22<sup>nd</sup> April, 2022. A mark includes a device, brand, heading, label, ticket, names, signatures, words, letter, numeral or any combination thereof. See *Onayemi v. Bouari* (1954)14 WACA 597. Under s. 67 of the Trade Marks Act, Cap T13 *Laws of the Federation of Nigeria* 2004, a trade mark means 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 the person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under Section 43 of this Act".

<sup>2</sup> OA Oyewunmi, *Nigerian Law of Intellectual Property* (Yaba: University of Lagos Press, 2015) p. 236.

<sup>3</sup> How to register a Trademark or Patent in Nigeria available at <<http://www.legalnaija.com/2013/09/how-to-register-trademark-or-patent-in.html>> accessed on 22<sup>nd</sup> April, 2022.

<sup>4</sup> OA Oyewunmi, *op. cit*, p. 237.

<sup>5</sup> Trade Marks Act, s. 1.

<sup>6</sup> *Ibid*, s. 2(1) & (2).

<sup>7</sup> *Ibid*, ss. 42 & 45.

Registration of trade marks is the basic concept of trade mark protection. It is a pre-condition for the institution of infringement action under the Trade Marks Act.<sup>8</sup> Taking into consideration that registration is not mandatory; it still establishes one's right in a mark as there can be no infringement of an unregistered mark. For registration purposes, the Trade Marks Act divides the trade marks register into two parts: Part A and Part B.<sup>9</sup> Under both parts, registration of trade marks is in respect of particular goods or classes of goods as specified by the applicant. The Registrar of Trade Marks is vested with the power to tackle any question regarding the class of goods within which any goods fall and his decision is final.<sup>10</sup> However, unlike the Part A mark which must be distinctive on registration, the Part B mark does not have to be distinctive when registered. All that is required is that it should be capable of distinguishing, or better put, capable of becoming distinctive, in use.<sup>11</sup> In the circumstances, it becomes imperative to critically examine the concept of distinctiveness and its import cum implication on trade mark registration in Nigeria.

## **2. Registration of Trade Marks**

A person proposing to apply for the registration of a trade mark in Part A or Part B of the register may, if he so desires, apply to the Registrar in the prescribed manner for advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish (i.e. for a proposed registration under Part A), or capable of distinguishing (i.e. for a proposed registration under Part B), as the case may be; and the Registrar shall have power to give the advice asked for in the application.<sup>12</sup> The essence of this provision is to avoid a situation where an applicant wastes time and funds trying to procure the registration of a trade mark only for the application to be eventually refused. This is why the Act makes provision that if an application for registration is made on the strength of an affirmative advice from the Registrar within 3 months of the said advice and eventually the application is refused on grounds that the trade mark is not adapted to distinguish or is not capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.<sup>13</sup> Whether with or without first applying for advice from the Registrar, any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.<sup>14</sup> After due consideration of such application, the Registrar may refuse it, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.<sup>15</sup> In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.<sup>16</sup>

In the case of a refusal or conditional acceptance of an application for registration, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision shall be subject to appeal to the Court.<sup>17</sup> When any such appeal is brought, the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.<sup>18</sup> When an

---

<sup>8</sup> OA Oyewunmi, *op. cit.*, p. 241.

<sup>9</sup> Trade Marks Act, s. 2(3).

<sup>10</sup> *Ibid.*, s. 4.

<sup>11</sup> *Ibid.*, ss. 10 & 11.

<sup>12</sup> Trade Marks Act, s. 17(1).

<sup>13</sup> *Ibid.*, s. 17(2).

<sup>14</sup> *Ibid.*, s. 18(1).

<sup>15</sup> *Ibid.*, s. 18(2).

<sup>16</sup> *Ibid.*, s. 18(3). Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks. See *ibid.*, s. 24(1). Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, generally speaking, have all the incidents of an independent trade mark. See *ibid.*, s. 24(2). Where a trade mark and any part or parts thereof are registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as associated trade marks. See *Ibid.*, s. 24(3). Furthermore, where a person claiming to be the proprietor of several trade marks in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of – (a) statements of the goods in relation to which they are respectively used or proposed to be used; or (b) statements of number, price, quality or names of places; or (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or (d) colour; seeks to register those trade marks, they may be registered as a series in one registration. See *ibid.*, s. 25(1). All trade marks that are registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks. See *ibid.*, s. 25(2).

<sup>17</sup> *Ibid.*, s. 18(4). Note that by virtue of s. 251(1)(f) of the Constitution of the Federal Republic of Nigeria (as amended) and s. 7 of the Federal High Court Act, Cap F12 *Laws of the Federation of Nigeria* 2004, the Federal High Court enjoys exclusive original jurisdiction over any such matter. See *Omnia Nigeria Limited v. Dyke Trade Limited* (2007)15 NWLR (pt. 1058) 576.

<sup>18</sup> Trade Marks Act, s. 18(5). Such appeals shall be heard on the basis of the materials stated by the Registrar in pursuance of s. 18(4), and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar,

application for registration has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause notice of the application as accepted to be published in the Journal; and the notice shall set out all conditions and limitations subject to which the application has been accepted.<sup>19</sup> However, the Registrar may cause notice of an application for registration of a trade mark to be published in the Journal before the application is accepted in the case of an application for registration of a distinctive mark as a trade mark under section 9(1)(e) of the Act, or in any other case where it appears to the Registrar that it is expedient by reason of any exceptional circumstances to do so.<sup>20</sup>

Any person may within two months from the date of publication of a notice of application for registration, whether the said application has been accepted or not prior to the said publication, give notice to the Registrar of his opposition to the said registration.<sup>21</sup> The notice shall be given in writing and shall include a statement of the grounds of opposition.<sup>22</sup> The Registrar shall send a copy of every such notice to the applicant; and within one month after the date on which the copy is received by the applicant the applicant shall send to the Registrar a counter-statement of the grounds on which he relies for his application. An applicant who fails to send such counter-statement within the prescribed period shall be treated as having abandoned his application.<sup>23</sup> If the applicant sends such a counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.<sup>24</sup> The decision of the Registrar shall however be subject to appeal to the Court.<sup>25</sup> On such appeal, the Court, shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.<sup>26</sup> The court may also permit the trade mark proposed to be registered to be modified in any manner not substantially affecting its identity, but in any such case the trade mark as so modified shall be advertised in the Journal in the prescribed manner before being registered.<sup>27</sup>

When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either the application has not been opposed and the time for notice of opposition has expired; or the application has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be.<sup>28</sup> Generally, a trade mark, when registered, is registered as of the date of the application for registration, and that date is deemed to be the date of registration.<sup>29</sup> On the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration in the prescribed form sealed with the seal of the Registrar.<sup>30</sup>

---

other than those so stated by him, except by leave of the Court; and if any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving such notice as may be prescribed. See *ibid*, s. 18(6). The Registrar or the Court may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the Court, as the case may be, thinks fit. See *ibid*, s. 18(7).

<sup>19</sup> *Ibid*, s. 19(1). Note that 'Journal' here refers to the Trade Marks Journal established under s. 63 of the Act.

<sup>20</sup> *Ibid*, s. 19(2). Where notice of such an application has been published in the Journal before acceptance, the Registrar may, if he thinks fit, cause notice of the application to be published in the Journal again when it has been accepted, but shall not be bound to do so. See *ibid*, s. 19(3).

<sup>21</sup> *Ibid*, s. 20(1).

<sup>22</sup> *Ibid*, s. 20(2).

<sup>23</sup> *Ibid*, s. 20(3). The Registrar may request a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice to give security for costs of the proceedings before him relating to the opposition, and in default of such security being duly given may treat the opposition or application, as the case may be, as abandoned. See *ibid*, s. 20(5).

<sup>24</sup> *Ibid*, s. 20(4).

<sup>25</sup> *Ibid*, s. 21(1). The Court may require the appellant to give security for costs of the appeal, and in default of such security being duly given may direct the appeal to be treated as abandoned. See *ibid*, s. 21(6). On the hearing of such appeal, any party may, either in such manner as may be prescribed or by special leave of the Court, bring forward further material for the consideration of the Court. See *ibid*, s. 21(3). On an appeal under this section, no further ground of opposition to the registration of a trade mark shall be allowed to be taken by an opponent or the Registrar, other than those stated in the notice of opposition given to and considered by the Registrar by that or any other opponent, except by leave of the court; and if any further grounds of opposition are taken, the applicant shall be entitled, on giving such notice as may be prescribed, to withdraw his application without payment of the costs of the opponent or any of the opponents. See *ibid*, s. 21(4).

<sup>26</sup> *Ibid*, s. 21(2).

<sup>27</sup> *Ibid*, s. 21(5).

<sup>28</sup> *Ibid*, s. 22(1).

<sup>29</sup> *Ibid*, s. 22(2). Where registration of a trade mark is not completed within 12 months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice. See *ibid*, s. 22(4).

<sup>30</sup> *Ibid*, s. 22(3).

The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time. However, in relation to a trade mark registered before the commencement of the Act, the duration thereof shall be for a period of fourteen years but may be renewed from time to time.<sup>31</sup> The Registrar shall, on application made by the registered proprietor of a trade mark, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be.<sup>32</sup> Before the expiration of the last registration of a trade mark, the Registrar shall send notice to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.<sup>33</sup> Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade-mark that is already on the register. However, this rule does not apply where the court is satisfied that there has been no *bona fide* trade use of the trade mark that has been removed during the two years immediately preceding its removal, or that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.<sup>34</sup>

### **3. Concept of ‘Distinctiveness’ and Registration under Part A**

In order that a trade mark (other than a certification trade mark) may be registrable in Part A of the register, section 9(1) of the Trade Marks Act provides that it must contain or consist of the following essential particulars: (a) the name of a company, individual, or firm, represented in a special or particular manner;<sup>35</sup> (b) the signature of the applicant for registration or some predecessor in his business; (c) an invented word or invented words;<sup>36</sup> (d) 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;<sup>37</sup> (e) any other distinctive mark. However, a name, signature or word or words other than such as fall within paragraphs (a) to (d) above shall not be registrable under paragraph (e) except upon evidence of its distinctiveness.

It is clear by the provisions of section 9(1) of the Act that where an application for registration in Part A of the trade marks register satisfies one or all of the five conditions, the application should be granted. Accordingly, an

---

<sup>31</sup> *Ibid*, s. 23(1).

<sup>32</sup> *Ibid*, s. 23(2).

<sup>33</sup> *Ibid*, s. 23(3).

<sup>34</sup> *Ibid*, s. 23(4).

<sup>35</sup> See *AB Chami & Co. Ltd v. WJ Bush & Co. Ltd* (1996) FHCLR 784. The name must be a real name and written in a special manner, the intention being “to prevent a name from being so taken as a trade mark that any trader might unintentionally infringe it by an honest use of his own name.” See TA Blanco White and R Jacob, *Kerly’s Law of Trademarks and Trade Names* (10<sup>th</sup> edn, London: Sweet & Maxwell, 1972) 18. Nwabachili even opined that surname should come within the purview of the word ‘name’ in relation to an individual. See CC Nwabachili, *Intellectual Property Law and Practice in Nigeria* (Lagos: Malthouse Press Ltd, 2017) 101.

<sup>36</sup> See *Aristoc Ltd v. Rysta Ltd* (1945) AC 68. According to Nwabachili, ‘invent’ conjures the image of originality. An invented word should be a word coined or put together by the applicant. Citing the learned authors of Halsbury’s Laws of England, he further opined that the test of an invented word is that it must have been substantially new when first used by the applicant in relation to his trade. See CC Nwabachili, *op. cit.*, pp. 101 – 102; HS Giffard, *Halsbury’s Laws of England* (3<sup>rd</sup> edn, London: LexisNexis Butterworths, 1964) 192. A word may be an invented word although it conveys a meaning to the reader, and contains a covert and skilful allusion to the character of the goods. See *ibid*. Further see *Re: Eastman Photographic Materials Co. Ltd* (1898)15 RPC 476.

<sup>37</sup> See *Bubble-Up International Limited v. Seven-Up Company Ltd* (1971) UILR 154 HC where the court held that the clearest ground of objection was that the trade mark applied for had a direct reference to the character or quality of the goods in respect of which registration was sought. However, the mere fact of words having some reference to the goods does not render them incapable of registration. The inclusion of the term ‘direct’ in the statutory provision was intended to correct a tendency to find that some commendation or descriptive reference in any word may at the registration of a number of words really fit some character or quality of the goods or even form the name of the goods. Thus, whether a word or words suggest some object or quality of such a direct reference to the goods is largely a question of fact in each case. See HS Giffard, *op. cit.* Also see *Colgate & Co’s Application* (1913)30 RPC 26C where the word ‘ribbon’ as held to have some direct reference to the character of the goods, dentrifice of a flat ribbon shape. Similarly, in *Minnesota Mining & Manufacturing Co’s Application* (1948)65 RPC 22A, the word ‘Scotchlite’ was held to have a reference to the character or quality of the goods as made in Scotland. In *Edge’s Trademark* (1891)8 RPC 207, the word ‘Edge’s Filter Blue’ sought to be registered with respect to laundry blue were held to have reference to the character or quality of the goods. However, see *Liggett & Myres Tobacco Ltd. v. Registrar of Trade Marks* (1969) All NLR 540 where the Registrar had refused to register the word ‘Chesterfield’ on grounds that it was a geographical name and on appeal, it was held that a word does not become a geographical name simply because somewhere, however remote, bears that name such that once the applicant can show that the word has a dictionary meaning aside being the name of some geographical location and that the said word has no direct reference to some character or quality of the goods, he has discharged the onus on him.

important feature that runs through the above statutory prescription is that such a mark must be distinctive. On the meaning of 'distinctive' in this context, section 9(2) of the Trade Marks Act offers some guidance thus:

... 'distinctive' means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

It is further provided in Section 9(3) of the Act that:

In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which the trade mark is inherently adapted to distinguish as aforesaid and by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

The effect of the above statutory provision is that the Registrar in considering an application to register a trade mark, must consider both its inherent adaptability to distinguish and also the extent to which it is shown by evidence (if there is such evidence) to be distinctive.<sup>38</sup> In *Weldmesh Trademark*<sup>39</sup> the words 'adapted to distinguish' were held to mean 'adapted of itself, standing on its feet.' In *Casella & Co's Application*,<sup>40</sup> the Court explained thus:

A trader may take a word which from something in the words itself say the fact that no one had ever heard the word before [and] that it indicated the particular trader, but always from something found in the word itself as distinguished from the way in which it is used is such as to answer the description of being adapted to distinguish the goods.

As an example of a word which has been held to be adapted to distinguish, reference must be made to *Re: Avery (W & T) Ltd's Application*<sup>41</sup> where Younger, J. held as follows:

A body of evidence has been adduced from trade witnesses' customers and rival manufacturers from every part of the United Kingdom who testify in one form of words or another that the word 'Avery' applied to weighing apparatus unmistakably signifies the manufacture of the applicant company and other... I am completely satisfied that this word 'Avery' is distinctive of the company's goods in the statutory sense, that is to say, it is adapted to distinguish their goods from those of all other persons.

Regrettably, the meaning of 'distinctive' does not appear to have been analyzed in-depth in any decided Nigerian cases.<sup>42</sup> Decided English cases however provide a guide. In *Re James' Trademark*,<sup>43</sup> it was held that, 'to be this [distinctive], that it must be a mark or device of such a kind that in case of infringement it shall be clear that it is being infringed and that the mark is something different from all other marks used in the same class of goods.' Also, in *Re: Cadbury Brothers Ltd's Application*,<sup>44</sup> it was held that what is meant by 'distinctive' is that when you see the name your mind immediately refers to the person or company who sold or manufactured the article and to that one person or firm or company alone. In *Yorkshire Copper Works Application*<sup>45</sup> the point was fully and lucidly analyzed. In this case YCW Limited applied to register the word 'Yorkshire' (in Parts A and B of the register, being conceded that if registration in Part A was refused, registration in Part B must be refused also) for 'solid-drawn tubes and capillary fittings, all being made of copper or non-ferrous copper alloys'. The applicants contended, and it was accepted for the purposes of the decision of the Court that to everyone concerned with the trade in these goods, the word 'Yorkshire' had lost its primary geographical significance and become 100 percent distinctive of the applicants. The Registrar however refused the application and appeals against his decision were dismissed by Lloyd-Jacob, J. and the Court of Appeal. The applicants then appealed to the House of Lords. Their Lordships also dismissed the appeal. Though the applicants offered to show that the mark 'Yorkshire' meant their pipe fittings to 100 percent of those in the trade, their Lordships held that the other factor of inherent adaptability could not be disregarded. Lord Simonds said, *inter alia*:

I am led to suggest that it is perhaps easier to define 'inherent adaptability' in negative than in positive terms: in other words, I would say that to distinguish the goods of A when you can

<sup>38</sup>FO Babafemi, *Intellectual Property: The Law and Practice of Copyright, Trade Marks, Patents and Industrial Designs in Nigeria* (1<sup>st</sup> edn, Ibadan: Justinian Books, 2007) p. 182.

<sup>39</sup> (1966) RPC 220.

<sup>40</sup> (1910)2 Ch 240, (1910)27 RPC 45.

<sup>41</sup> (1919)36 RPC 89.

<sup>42</sup>According to Nwabachili, 'distinctive' as used in the Act should not mean proof beyond doubt or absolute linkage with a particular trader. A significant factor to be considered in each case is the market and locality to which both the trader and his trade mark pertain. See CC Nwabachili, *op. cit.*, p. 106.

<sup>43</sup> (1886)38 Ch 392.

<sup>44</sup> (1981)1 Ch 331 at 339.

<sup>45</sup> (1954)1 All ER 570.

predicate of it that it is such a name as it would never occur to B to use in respect of his similar goods. Of such names the classic examples are 'Monte Rosa' for cigarettes or 'Teneriffe' for boiler plates. There will probably be border-line cases, but there is in my opinion, no doubt on which side of the border lies Yorkshire, a county not only of broad acres but of great manufacturing cities.

It is therefore clear from the above case that where the inherent unsuitability is so strong that no degree of distinctiveness can counterbalance it, the mark will not be registered. However, in contrast, the Nigerian case of *Liggett & Myers Tobacco Ltd v. Registrar of Trade Marks*<sup>46</sup> is very instructive. In this case the applicants brought an application for an order that the Registrar should register their trade mark, 'Chesterfield' simpliciter, without any design. The applicants, however, were the owners and proprietors of 'Chesterfield' with a device registered on the register in class 45. The respondent refused to register the trade mark 'Chesterfield' without any design on the ground that the word is a geographical name in its ordinary signification. At the trial the counsel for the applicants submitted that the trade mark had been used by the applicants since 1930 and that it could, therefore, be accepted by the Registrar as being distinctive of the plaintiff's goods. He further submitted that the word 'Chesterfield' was one which bore no reference to the character and quality of the goods, tobacco and cigarettes in respect of which the mark was sought to be registered; that the place called 'Chesterfield' was not reputed for these goods and that since the dictionary meaning of the word is a kind of overcoat or a crouch, it was not primarily a geographical name. The Court, per Kassim J., held that although the phrase, 'geographical name' in the absence of special circumstances must be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the word, a word does not become a geographical name simply because some place on the earth's surface has been called by it. The Court further held that in the instant case, the onus was on the applicants to prove that the word 'Chesterfield' was not a geographical name in its ordinary signification; that in this case the applicants have discharged that onus, and accordingly the application should be accepted. In yet another decided Nigerian case, that of *Trebor Nigeria Ltd v. Associated Industries Ltd*<sup>47</sup> the Court held *inter alia* that the trade mark of the defendants, a black elephant, was very distinctive of the defendant's goods and did not infringe that of the plaintiffs.

From the foregoing, it is safe to say that 'distinctiveness' refers to the quality of being easily distinguishable.<sup>48</sup> For a mark to qualify as a distinctive mark, one needs to look at the quality of the product, for instance, Apple for computers and not for fruits.<sup>49</sup> The following are degrees of distinctiveness of trademarks: (a) fanciful; (b) arbitrary; (c) suggestive; (d) descriptive; and (e) generic.<sup>50</sup>

- (a) **Arbitrary and Fanciful Terms:** A trademark that falls under either of these categories is automatically recognized as inherently distinctive. There is no requirement for the trademarked term to have a secondary meaning other than its literal meaning. A fanciful mark has no other meaning. It is created to represent the business e.g. Bing, Google, Exxon etc.<sup>51</sup> An arbitrary mark is a familiar term, logo, etc but it is used in an uncommon or unfamiliar manner to represent the business. There is no obvious connection between the trademark and product or services e.g. Apple for computers.<sup>52</sup>
- (b) **Suggestive Terms:** The suggestive marks suggests the underlying product or service represented by the mark. It does not describe the product, but something about the mark is somehow related to the product or services. It generally requires a certain level of cognition, creativity or imagination in how the product is perceived e.g. Citibank and Playboy.<sup>53</sup> The suggestive mark is also inherently distinctive without showing a secondary meaning of the word.
- (c) **Descriptive Terms:** Descriptive marks describe in some way the product or service represented. This can include information about or allude to the nature, characteristics, geography or quality of the product or service. To qualify as a mark, the owner must demonstrate that the work has achieved secondary meaning beyond the literal definition of the mark. This requirement ensures that there is no confusion between the literal meaning and the product or services  
e.g. Home Depot and Band-Aid.<sup>54</sup>
- (d) **Generic Terms:** Generic marks are not capable of protection. Generally, the mark is not distinctive because it represents a type of product or area of service e.g. Soda, french-fries and cars, etc. A valid mark may become generic if the mark begins to describe every product or service of that type. That is, it no longer makes the specific product or service distinctive e.g. Aspirin, Laudromat and Videogames etc. A business mark that is becoming generic will fight to restore its distinctiveness for that business product or service e.g. Google and Xerox.<sup>55</sup>

---

<sup>46</sup> (1969) All NLR 540. See also *In Magnolia Metal Coy's TSS* (1897)2 Ch 371

<sup>47</sup> (1971) All NLR 468. Also see *GB Ollivant & Co. Ltd. v. John Christian & Co.* (1925)6 NLR 102.

<sup>48</sup>FO Dawodu, 'Registration of Trademarks in Nigeria', <<https://countryhillattorneys.com.ng/wp-content/uploads/2017/08/REGISTRATION-OF-TRADEMARKS-IN-NIGERIA.pdf>> Last accessed on 22/4/2022.

<sup>49</sup> *Ibid.*

<sup>50</sup> *Ibid.*

<sup>51</sup>Trademark Distinctiveness requirement available at <<http://thebusinessprofessor.com/knowledge-base/trademark-distinctiveness-requirement/>> accessed on 22/4/2022.

<sup>52</sup> *Ibid.*

<sup>53</sup> *Ibid.*

<sup>54</sup> *Ibid.*

<sup>55</sup> *Ibid.*

#### **4. Concept of ‘Distinctiveness’ and Registration under Part B**

In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists.<sup>56</sup> Unlike the Part A mark, a Part B mark does not have to be distinctive when registered.<sup>57</sup> All that is required is that it should be capable of becoming distinctive in use. Thus, a mark can be registered under Part B of the register where it is not sufficiently distinctive to qualify it for registration under Part A of the register,<sup>58</sup> provided the mark is capable of becoming distinctive with prolonged use and distinguishes the products in respect of which it is sought to be registered.<sup>59</sup> As soon as it becomes distinctive the owner of the mark could make a fresh application to register it in Part A.<sup>60</sup> According to Nwabachili, the import of the above is that section 10(1) of the Act is a generalized provision for registration of trade marks.<sup>61</sup> Kerly’s view supports this assertion when he opined that a trade mark that is registrable under Part B of the register is one which in due course may become distinctive of the goods of the proprietor of the mark. Seargent, L.J puts it better in the case of *Davis v. Sussex Rubber Co.*<sup>62</sup> when he held thus:

But so far as this is concerned, the Registrar is directed to accept an application to register in Part B unless he is not satisfied that the mark is capable of distinguishing the goods of the applicant... it is not necessary for the applicant to prove that the mark has actually become distinctive; it is sufficient for him to satisfy the Registrar that it is capable of becoming distinctive, a much less strenuous task and one in which the onus lies rather on the opponent than on the applicant.

It follows therefore that the important phrase in section 10(1) of the Act is that a trade mark registrable in Part B of the register must be a trade mark capable of distinguishing the goods of the applicant from the goods of others of the same class. It is therefore necessary to understand the amplitude and plenitude of this phrase.<sup>63</sup> Kerly’s view is that the natural meaning of the words ‘capable of distinguishing’ should be:

That the mark concerned will, given the proper conditions in due course become actually distinctive: that is to say ‘capable of distinguishing’ would seem in the context of these sections to mean the same as ‘capable of becoming distinctive’.<sup>64</sup>

Kerly quotes, in support, the opinion of Lawrence, L.J in *Ustikon, Davies v. Sussex Rubber Co.*<sup>65</sup> where the learned law Lord held as follows:

The expression ‘capable of distinguishing’ seem to have a somewhat wider import than the expression ‘adapted to distinguish’ in that the former embraces marks which have not, at the date of the application, but which, if used long enough, may acquire the characteristic of distinctiveness of the goods of the proprietor of the trademark.

Generally, it is provided in the Act that a mark may be registered in Part B notwithstanding registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.<sup>66</sup>

#### **5. Conclusion**

A trade mark is registered by a proprietor so as to distinguish the proprietor’s product from those of other competitors. Thus, the proprietor thereafter markets his product under that trade mark with a view to making it a popular brand and the major choice of the purchasing consumers. The trade marks register is statutorily compartmentalized into Parts A and B. For a mark to qualify as a trade mark susceptible to registration under Part A, the said mark must be distinctive. On the other hand, for a mark to be registrable under Part B, it has to be capable of becoming distinctive with prolonged use provided it distinguishes the goods to which it relates from other goods in the same class. Distinctiveness is unarguably the distinction in registration under the two parts of the trade marks register since this is the criterion that qualifies or disqualifies a mark from registration in the trade marks register. Proprietors of trade marks are therefore enjoined to pay great attention to this all-important factor, since the success or otherwise of an application for registration of a trade mark thrives around it.

---

<sup>56</sup> FO Babafemi, *op. cit.*, p. 185.

<sup>57</sup>*Ibid.* See “*Jerry-Lynn*” Trade Mark (1999) FSR 491; *Bach Flower Remedies* (2000) RPC 513 CA where a mark that originally was capable of distinguishing had become incapable as a result of use in a generic sense for particular herbal remedies.

<sup>58</sup> OA Oyewunmi, *op. cit.*, p. 246.

<sup>59</sup> FO Dawodu, *op. cit.*

<sup>60</sup> FO Babafemi, *op. cit.*, p. 186.

<sup>61</sup> CC Nwabachili, *op. cit.*, p. 107.

<sup>62</sup> (1927)44 RPC 412.

<sup>63</sup> CC Nwabachili, *op. cit.*, p. 106.

<sup>64</sup> TA Blanco White and R Jacob, *op. cit.*, p. 154.

<sup>65</sup> (1927) 44 RPC 412.

<sup>66</sup> Trade Marks Act, s. 10(3).