

ELEMENTS OF TRADEMARKS AND DESIGNS UNDER INTELLECTUAL PROPERTY LAW IN NIGERIA*

Abstract

Generally, intellectual property refers to the creative works of the mind. The realization that intellectual property work is akin to industrialization has long been recognised by the western world as a means of growth and development of trade and international commerce. It deals with trade marks (including the service marks), which means, except in relation to a certification trademarks, 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 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 trademark, a mark registered or deemed to have been registered under Section 43 of the Trademark Act, Cap 436 Laws of the Federation 1990. A trade mark is a distinctive sign which is used to distinguished the products or services of different business, while designs right protect the form of appearance eg, Spare parts, Furniture or textiles. Intellectual property consists of Patents, Design, Trade mark, Trade Secrets or confidential information and copyrights of all these elements, although copy right is regarded by many people including scholars and practitioners as the only representation or household name of intellectual property. The reasons for this view is not far-fetched because as the name implies, copy right seems to be synonymous with, to the extent that even, when there is infringement on patent, industrial designs, trademarks or trade secrets right, practitioners tend to regard such encroachment as being copyrighted. The distinctiveness between these elements of intellectual property is so as to create awareness to public especially the media on the need to protect all forms of Intellectual Property Rights (I.R.P).

Keywords: Distinctiveness, Intellectual Property, Trademark, Design, Nigeria.

1. Introduction

The development and growth of intellectual property law has assumed a universal dimension to the extent that its impart has become a subject of discourse and deliberation among countries, as regards to the protection of individuals and group intellectual activities. Intellectual property reflects a subject matter which is the product of the mind or the intellect. It is an umbrella term for various legal entitlements which attract to certain names, written and recorded media and inventions. The holders of these legal entitlements are generally entitled to exercise various exclusive rights in relation to the subject matter of the intellectual property. The laws are designed to protect different forms of subject matters, although in some cases there is a degree of overlap.¹

2. Definition of Terms

Intellectual: This is ability to understand things and to think intelligently is to say that someone is an intellect. A person can also conceive an idea, but if he is not intelligent may not know what use that idea can be put. This is why most creative works are not protected because those who conceived them did not understand how their ideas could be cultivated to productive ventures.

Property: Property is derived from a Latin word *Proprius*². 'It is the thing or things that someone owns'. This ownership can be a piece of land, a building or an article of precise definition. Property here refers to the produce of the mind. The right enjoyed here is that of the produce of mind rather than the produce itself.

Intellectual Property: This has two meanings: colloquial and legal. 'In the colloquial sense, it means or comprises all those things which emanates from the exercise of the human brain such as ideas, intentions, poems, designs, microcomputers and Micky mouse. In the legal sense, it is the rights which are enjoyed in the produce of the mind rather than upon the produce itself'³.

*By Hilary Chimezie OKOLOMA, LL.M, B.L, LL.B, B.Th, Dip.Th, Lecturer, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University Awka, Anambra State, Nigeria. Tel: +2348035091482. Email: hilmeziem4law@gmail.com, hc.okoloma@unizik.edu.ng; and

* Eyiuiche Stella AHANWA, Lecturer, LL.M, LL.B, B.L, Department of International Law and Jurisprudence Department, Faculty of Law, Nnamdi Azikiwe University, Awka, Anambra. Email: eyiuiche.stella@gmail.com. Tel: +2348032790674

¹ Oshisanya Lai Oshitokunbo: *An Almanac of Contemporary Judicial Restatements with Commentaries*. 2012 Pg 503

² Summers D. *Longman Dictionary of Contemporary English* (New Edn) (1995)

³ Jeremy P. & Allison F., *An Introduction to Intellectual Property Law*. (London: Butterworth's, second Edition. (1990) pp 3-4

Element: This is a constituent part of a claim that must be proved, a discretely claimed component of a patent claim⁴.

Distinctiveness: The quality of a trademarked word, symbol or device that identifies the goods of a particular merchant and distinguishes them from the goods of others⁵.

Trademarks: This means, except in relation to a certification trademark, 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 or use the mark, whether with or without any indication of the identity of the person. Trademark also means any sign capable of being represented graphically, which is capable of distinguishing goods and services of one undertaking from those of other undertaking⁶. It is also a type of intellectual property consisting of a recognizable sign, design, or expression that identifies products or services from a particular source and distinguishes them from others. In modern times, markets serve as points of display, exchange and sell of products of competing brands. These products that compete against each other are only distinguished by their trade mark features. Trade mark plays very important role in positioning a product. Even in ancient history or the middle Ages, Merchants recognised use of signs, symbols and engraved marks as important features to distinguishing one product from that of another. Trademark is also referred to a recognisable insignia, phrase word or symbol that denotes a specific product and legally differentiates it from all other products of its kind. It exclusively identifies a product as belonging to a specific company and recognises the specific company's ownership of the brand⁷

3. Elements of Intellectual Property Law

Intellectual property consists of Patents, Trademarks, Designs, Secret or Confidential information and Copy rights. And of all these elements, Copy right is only regarded by many people including scholars and practitioners as the only representation or a household name of intellectual property⁸. The reason for this view is not far-fetched, as the name implies, copy right seems to be synonymous with, to the extent that even when there is infringement on Patent, Industrial Designs, Trademarks, every stakeholders tend to regard such encroachment as being Copyright. This write up will try to review the distinctiveness between some of these elements of intellectual property so as to create awareness to both practitioners and the general public especially the media, in this internet induced generation on the need to protect all forms of Intellectual Property Rights (I.P.R.).

Industrial Designs

These are technical attributes, which offer distinctive features in a product of a similar characteristics and appearance. Accordingly, Designs are elements of appearance in products. Cornish and Llewelyn opines that Designs appeal to the eye - a requirement of which the courts treated with notable generosity even though 'Appeal' suggests some feeling of aesthetic satisfaction, which is sparked by seeing. It is also a process of design applied to physical products that are to be manufactured by mass production. It is the creative act of determining and defining a product's form and features, which takes place in advance of the manufacture or production of the product. Furthermore, a design means the appearance, the features of a shape, pattern or of the whole or a part of a product resulting from the features of a shape in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation applied to an article to have a visual appeal.⁹

Trademarks

Trade mark does not only help to distinguish products within the legal and business systems – but just as significantly – with consumers. They are used to identify and protect words and design elements that identify the source, owner or developer of a product or service. They can be corporate logos, slogans, bands or the brand name of a product. Similar to a trade mark, a service mark identifies and distinguishes the source of a service rather than a product, and the term trade mark is often used to refer to both trade mark and service marks¹⁰. Trademark also means a mark that represents the goods or services provided by an entity or an individual. In India, trade mark registration is governed by the Trade Marks Acts of 1999, whereas the Designs Act 2000 governs the Design registration, both the trade mark and design registrations are not mandatory. However it is better to get a trade mark or design registered as registration provides protection against their unauthorised

⁴ Bryan A, Garner, *Black's Law Dictionary*, Seventh Edition. (West Group St Paul Minn 1999)

⁵ Ibid

⁶ Section 43 (Trade mark) Act CAP 436 LFN 1990.

⁷ Property Trade in Sections 372 – 380 Penal Code.

⁸ Carla Tardi. Investopedia.com, updated, March 23, 2022

⁹ Cornish W. & Llewelyn D. OP. Cit Pg 14

¹⁰ <https://eleartax.in/difference-between>. Accessed 3/7.2023

usage from third parties. Law governing trade mark in Nigeria is Trade Marks Act¹¹ and Trademark Regulation 1990. The grant of a statutory right of protection is subject to the fulfilment of the conditions and requirements of the law. An intellectual work will be accorded recognition if the creator fulfils the conditions set by the relevant law of the Country for its protection. Once the right is created, it becomes exclusive to the owner. The owner decides, directs and authorises the use or use any available legal means to protect his right against unauthorised use, violation or infringement. It is rights among the categories and class of law known as ‘Chosen-in-Action’¹².

Designs

Design means only the features of shape, configuration, pattern or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or both forms by any industrial process or means, whether manual, mechanical or chemical, separate or combined which in the finished article appeal to and are judged solely by the eye but does not include any mode or principle or construction or anything which is in substance a mere mechanical device and does not include any trade mark process or means, whether manual, mechanical or chemical, separate or combined which in the finished article appeal to and are judged solely by the eye but does not include any mode or principle or construction or anything which is in substance a mere mechanical device and does not include any trade mark¹³. Design in intellectual property is creations of the mind, this also includes designs, symbols, inventions, artistic and literary works and names and images that may be used in commerce.

Requirements for Design Patentability:

The following are the requirements for the patentability of any Design: Article of Manufacture, Originality, Novelty, Non-Obviousness and Ornamentality¹⁴

Registration and Protection of Design

Industrial design is registrable when it is any combination of lines and colours or both, and any three dimensional form. Whether or not associated with colours that is an industrial design under section 12 of Patent and Designs Act, where newness of a design is in dispute, infringed and allegedly infringing designs should be put side by side to enable court compare and determine whether they are basically the same or whether there are fundamental differences in the shape and pattern of the lines. Similarly, in industrial design it has nothing to do with its novelty or distinctiveness: infringement is determined not by the finished products without comparing the design itself¹⁸.

Registration and Title

Under Section 9 of the Trade Mark Act, a trademark must be distinctive to be registrable; moreover where a name does not have a dictionary meaning. A trademark gives the proprietor the exclusive right to use the trademark in marketing or selling his goods. Thus, without his consent, any use of an identical mark or one so near in resemblance as to deceive or cause confusion with the registered mark, would incur actionable sanction for infringement or passing off or both. The right of exclusive use under SECTION 5 OF THE TRADE MARK ACT¹⁵ relates to the entire components in the manner or character in which they are used. The Hague system is in charge of intellectual registration for industrial designs. They allow the owner of a design the chance to have protection in a few countries by submitting an application that’s in one language¹⁶. The trade mark registration in Nigeria provided for by Trade Mark Act is one important way to protect and distinguished someone’s trade symbols in Nigeria. Registering a trade mark in Nigeria is the only way to protect a unique brand for goods or services in the market place¹⁷.

Procedures and Cost for Trademark and Patent Registration

Trade mark registration in Nigeria gives the owner the right to use such registration to exclude others from violating or willfully copying or using by a third party without his consent. It is provided by Trade Marks Act¹⁸, and it is one important way to protect and distinguish someone’s trade symbol in Nigeria. Registering a

¹¹ CAP T 13 Laws of the Federation of Nigeria 2004 (TMA)

¹² Meluille I.N., *Precedents on Intellectual Property and International Licensing*, 2nd Edition (London: Sweet & Maxwell 1972) Pg 296. Carla Tardi. *Supra*.

¹³ <https://www.wipo.int/faq.des>. Accessed 3/7.2023

¹⁴ Epi Information Journal 2/2001 (June) pages 81-87

¹⁵ Laws of the Federation 1990.

¹⁶ *Uzukwe v Dansy Industries Nigeria Ltd & Anor* (2002) FWLR PT 90 1322 @ 1331-5 5 SC

¹⁷ <https://www.wipo.int/designs>. Accessed 3/7.2023

¹⁸ Laws of the Federation 1990.

trademark in Nigeria is the only way to protect a unique brand for goods or services in the marketplace¹⁹. A trademark is a recognisable name or design, which is legally registered and used to identify and distinguish a product or services. Trademark may institute an action in court to block any infringements or unauthorised use of their trademark. The owner of a registered trademark also has the right to oppose any future trademark registration that may infringe on its own trademark²⁰.

How to Register a Trademark

Essentially, there are three major stages involved in trademark registration, which i will briefly explain as follows:

Search and Application:

This is the first step any person or organisation might take to register a trademark and it might be by briefing an Agent, usually a lawyer with the trademark or the description of a symbol or logo or design to be registered. A search is conducted on the trademark, and if it is not in conflict or too similar to any existing trademark, an application for the registration may proceed. It is worthy of note to state that different payments are to be made at this stage for search and application processing.

Acceptance:

Whereupon an application has been approved after a successful search has been conducted, the Registry will accept, register the trademark and issue an Acceptance letter to the applicant. Acceptance letter is initial evidence that the trademark has been duly registered.

Publication and Certification:

The third stage involved publication in the trademark journal and certification. This stage is the final stage. Upon the acceptance of the registration of trademark, the Registrar will ensure that the notice of the application is published in the trademark journals. Such notification will include the full details of the application and the applicant. The certification indicates the evidence of due registration and completion of all process. It confers a right on the proprietor or any owner to use the trademark to the exclusion of any other entity. However, where any other person or entity successfully challenged the applicant in opposing a trademark registration, the registrar will issue a letter of refusal to the applicant.

4. Conclusion

The development and growth of intellectual property law has assumed a universal dimension to the extent that its impart has become a subject of discourse and deliberation among countries, as regards to the protection of individuals and group intellectual activities. Intellectual property reflects a subject matter which is the product of the mind or the intellect. It is an umbrella term for various legal entitlements which attract to certain names, written and recorded media and inventions. The holders of these legal entitlements are generally entitled to exercise various exclusive rights in relation to the subject matter of the intellectual property. The laws are designed to protect different forms of subject matters, although in some cases there is a degree of overlap

¹⁹ Resotution Law Firm: infor@resolutionlawng.com. Accessed 3/7.2023

²⁰ <https://www.wipo.int/designs>. Accessed 3/7.2023