

Trademark Ownership and Protection in Nigeria: Some Reflections on the Trademark Act Cap T13, Laws of the Federation of Nigeria 2004

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Abstract

Trademark is a form of intellectual property. Globally, trademark has contributed immensely to the economic growth and development of many nations. It acts as a means of identifying a business. It is employed or used in the field of trading to distinguish and build reputation for one's product from that of others or competitors. Successful businesses often have their trademarks infringed by competitors through attempting to exploit their goodwill. It is against this background that trademark owners usually take necessary steps to protect their trademarks and goodwill. This article seeks to examine trademark ownership and protection in Nigeria. In doing so, the paper critically examines the provisions of the Nigerian Trademarks Act Cap T13, Laws of the Federation 2004. This paper adopted doctrinal research methodology approach. The main sources of information and data collection for this study were the relevant statutes, case laws, textbooks, journal articles and the internet. The article found that the Act is deficient and do not address or take cognizance of recent developments in international trademark administration and practice. The paper recommended that the Nigerian Trademark Act be amended in order to bring it in tandem with global best practices in trademark administration and practice.

Keywords: Trademark, Ownership, Protection

1. Introduction

There are three distinct types of property that an individual or a company can own. They are:

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Real property which refers to land or real estate; personal property which refers to specific items and things that can be identified such as jewelries, cars and artwork; and intellectual property which refers to the fruits or products of human creativity, including literature, advertising slogans, songs or new inventions.¹ Many of the rights of ownership common to real and personal property are also common to intellectual property.² Intellectual property rights give rise to a form of property that can be dealt with just as with any other property, and which can be assigned, mortgaged and licensed.³ It can be bought and sold. Similarly, it can be protected against theft or infringement by others.⁴ It is something that can be owned and dealt with. Intellectual property is a field of law that aims at protecting the knowledge created through human effort in order to stimulate and promote further creativity.⁵ Intellectual Property (IP) is an umbrella term for a set of intangible assets that are not physical in nature. The concept of intellectual property relates to the fact that certain products of the human intellect should be afforded the same protective rights that apply to physical property, which are called tangible assets.⁶ Trademark is a branch of intellectual property. Due to the economic value of intellectual property, the law confers some rights on the owner of trademark against unauthorized use by other people.⁷

This article examines trademark ownership and protection in Nigeria. In doing so, it critically examines the provisions of the Trademarks Act Cap T13 laws of the Federation 2004. The paper is divided into seven parts. Part one is the introduction. Part two examines the concept of trademark. Part three focuses on trademark ownership and protection in Nigeria. Part four deals with trademark infringement. Part five centers on enforcement of the right to a trademark owner while part six identifies some pitfalls in the Nigerian Trademark Act. The last part concludes and makes a case for the Amendment of the Act by way of recommendations.

2. What is a Trademark?

The concept of trademark evolved as a result of the increased competition among traders and

¹ D. E. Bouchoux, *Intellectual property, the law of trademark, copyrights, patents and Trade secrets*, 4th edn, Delmar cengage learning, USA, 2000, P.3

² *Ibid*

³ D. Bainbridge, *Intellectual property*, 4th edn, Financial Times, Pitman Publishing, 1999, P. 10

⁴ D. E. Bouchoux, (n 1)

⁵ *Ibid* P. 3

⁶ A. P. Onyilo, 'Towards effective Enforcement Mechanism of Trademarks Rights Infringement in Nigeria', Nnamdi Azikiwe University Awka, *Journal of Commercial and Property Law*, vol 8 (2) 2021, P.98

⁷ F.S Akinlolu, 'An Analysis of Statutory Provisions and Case law for Trademarks Registration under the Nigeria Trademark Act', *International Journal of Business & law research*, 3(3): 24–31, July – Sept 2015, P. 24.

trading companies in the world of commerce.⁸ Trademark may not have the glamour of inventions or creative works but they are, nevertheless, of substantial importance in an industrial and commercial sense. Trademarks are closely associated with business image, goodwill and reputation. Goods or services are often requested by reference to a trademark and the public rely on many marks as indicating quality, value for money or origin of goods and services.⁹ A trademark basically refers to any distinctive sign or mark used to identify goods and services. They are marks or a combination of marks used to distinguish the goods and services offered by a business.

The term “trademark” means a mark used to distinguish goods (including services or goods related to the provision of services) of one business from those of others.¹⁰ It can be any sign capable of being represented graphically which is used to distinguish goods and services of one undertaking from those of others.¹¹ David Kitchin *et al*¹² defined Trademark as a sign which distinguishes particular goods or services particular to one undertaking from the goods and services of other undertakings. A trademark is a recognizable sign, design or expression which identifies product or services of a particular source from those of others called service marks. The trademark owner can be an individual, business organization or any legal entity. A trademark may be located on a package, a label, a voucher or on the product itself.¹³ Section 67 of the Nigerian Trademark Act defines Trademark as follows:

*Trademark 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 a registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trademark, a mark registered or deemed to have been registered under Section 43 of the Act.*¹⁴

⁸P. Solomon, 'A virtual world without borders: The infringement of Trademarks on the internet', Available at <https://unilagreview.org/ accessed 4/3/2022>

⁹D. Bainbridge, (n3)

¹⁰J. Yoo, 'Requirement of Trademarks Registration and Examination practice', Wipo-Kipo Training course on Trademark Law and Examination 2019, available at <https://www.wipo.int/academy/en/news/2020/news-0014ihtml, accessed 4/3/2022>

¹¹ *Ibid*

¹² David Kitchin *et al*, *kerly's Law of Trademarks and Trade Names*, 14th edn, 2005, P.10

¹³ See I. Ogbah, *Understanding Trademark law in Nigeria*, legal jurisprudence Ltd, Ota, Ogun state, 2019, P. 5

¹⁴ S. 67 of the Trademarks Act, Cap T 13, LFN 2004

This definition is unnecessarily complicated and restrictive.¹⁵ The definition restricts the use of trademarks to goods. It does not cover service marks used by service organizations to distinguishing their services from those of others.¹⁶ Article 15 of TRIPS Agreement¹⁷ provides that:

Any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting trademarks, such signs in particular words including personal names, letters, numeral, figurative elements and combination of colours as well as any combination of such signs shall be eligible for registration as trademark.

Drawing from the provisions of Article 15 of TRIPS Agreement above, trademark may consist of words, a logo or a combination of both. The World Intellectual Property Organization (WIPO) defines it as follows:

*A trademark is any sign that individualizes the goods of a given-enterprise and distinguishes them from the goods of its competitors.*¹⁸

The Supreme Court of Nigeria in the case of ***Ferodo Limited & Anor v. Ibeto Industries Limited***¹⁹ defined it thus:

Trademark is 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 persons having the right either as a proprietor or a registered user of the mark. A trademark can also be defined as distinctive picture which would indicate to a purchaser of an

¹⁵ See the working paper on the reform of industrial property law (Nigeria law reform commission, Lagos. 1990) P. 153

¹⁶ A. O. Oyewunmi, *Nigerian Law of Intellectual Property*, University of Lagos Press, 2015, P.236

¹⁷ The Agreement on Trade Related Aspect of Intellectual Property Rights. It is an international legal agreement between all member nations of the world Trade Organization (WTO) Nigeria inclusive.

¹⁸ World Intellectual property organization, *Introduction to intellectual property theory and practice*, Kluwer Law International Ltd, 1998, P. 184

¹⁹ (2004) 5 NWLR Part 866 at 325

article bearing it, the means of getting the same article in future, by getting an article with the same mark on it.

Similarly, in *Smithkline Beechman Plc v. Farmex Limited*²⁰ the Court of Appeal defined trademark thus:

A Trademark or Trade name is a name protected by law (Trademarks Act). It could be a name, word, design or symbol used by a manufacturer to identify his product and also distinguish it from other products made by other manufacturers and sellers.

Worthy of note from both the statutory and judicial definition of trademark is the reference to the phrase “used or proposed to be used” and “a connection in the course of trade”. Firstly “used or proposed to be used” clearly indicate that the actual use of a mark is not required before the mark can be accepted for registration. Secondly “a connection in the course of trade” entails that the mark must however be used or proposed to be used in relation to goods in the course of trade.

A trademark helps to distinguish a particular product or business from another thus making it easy for the consumer to identify such product or business. Trademarks can be seen as serving two main purposes. First, to protect business reputation and goodwill and secondly, to protect consumers from deception, that is, to prevent the buying public from purchasing inferior goods or services in the mistaken belief that they originate from or are provided by another trader.²¹ Trademark is a form of consumer protection and it has been an effective weapon against counterfeit and inferior goods. A related area of law to trademark law is Passing Off. It is the Common Law version of trademark law. Both of these areas of law share a common background. Passing off in relation to goods can be said to be the use by a person on his own goods of an unregistered mark or get-up belonging to another person with the intention of passing off the goods as being those of that other person.²² Quite often, a particular set of circumstances will give rise to the possibility of a cause of action in both trademark law and passing off. Indeed, it is usual to add a claim for passing off in a trademark action because of the risk of the registration being held invalid.²³

²⁰ (2010) 1 NWLR 285

²¹ D. Bainbridge, (n 3) p. 524

²² *Ibid* P. 535

²³ *Ibid*

3. Trademark Ownership and Protection in Nigeria

Trademark ownership or proprietorship in Nigeria and its protection is regulated by the Trademarks Act.²⁴ The principal objective of the trademark law is to ensure that no-one, not being the proprietor of a trademark or a registered user thereof 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.²⁵ The Nigerian Trademark Act provides measures for the protection of trademarks. Trademark regime in Nigeria consist of a dual system of protection where duly registered marks exist and are protected alongside unregistered marks.²⁶

The unregistered marks are protected under Section 3 of the Act and they enjoy recognition and protection by reason of use and renown in the market place.²⁷ Thus, unlike other branches of intellectual property such as patents and industrial design, non-registration of a trademark does not deprive it of legal recognition and by extension, the existence of a right. Despite these dual systems of protection and recognition, registration is still preferable to the common law action which requires a claimant to undertake the herculean task of proving the existence of reputation or goodwill in the mark. The situation is different in the case of registered marks, where the certificate of registration is *prima facie* proof of existence of the right to the mark.²⁸ Registration thus dispenses with the need to prove public reputation and goodwill in a mark as a condition precedent to protecting rights in the marks concerned.²⁹ Also evidence of registration is a condition precedent to an action for infringement of trademark. Therefore, if a mark is unregistered, its proprietor cannot bring an action for infringement.³⁰ A trademark must be registered before the proprietor of the mark can benefit from the protection granted under the law. Such a mark may be registered under part 'A' or part 'B' of the Register.³¹

The protection granted proprietors of registered mark under the law however, is without prejudice to recognition of unregistered mark in appropriate circumstances notably under the

²⁴ Cap T. 13 laws of the Federation 2004

²⁵ F. O Babafemi, *Intellectual Property, the Law and Practice of Copyright, Trademarks, Patents and Industrial Designs in Nigeria*, Justinian Books Limited, 1st edn, 2006, P. 173

²⁶ A. O. Onyewumi, (n 16) P. 234

²⁷ Section 7 of the Act

²⁸ Section 5 (1), 6(1) and 49 of the Act. See also the case of *Crysterlight overseas Agency Ltd v Yugoles Drugs Co Ltd* (1998) FHCL 390

²⁹ A. O. Oyewumi, (n 16) P. 235

³⁰ See Section 3 of the Act

³¹ F. O. Babafemi, (n 25) P. 117

common law passing off regime.³² It is the registration of the trademark that confers on the owner/proprietor an exclusive right to use the mark and he can sue for its infringement by an unauthorized user.³³ Similarly, a registered trademark confers the right to assignment and transmission on its proprietor in return for fees, royalties and other payments as envisaged by the provision of the Act.³⁴ A registered trademark also affords the proprietor the right to bequeath the trademark in a will; and to acquire incontestable status after a seven-year period.³⁵ Whether the registration of a trademark is in Part A or Part B, it must be in respect of particular goods or classes of goods as specified by the applicant.³⁶ Where there is any question regarding the class of goods within which any goods fall, the matter shall be determined by the Registrar, whose decision is final.³⁷ Where registration is made under Part 'A', the application must contain the proprietor's name or entity name, his/ her signature, an invented or invented words, 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 and any other distinctive mark.³⁸ Any other distinctive mark as used in section 9(e) is a broad head which accommodates marks falling within the other heads, provided the mark passes the test of distinctiveness. Where a mark is not distinctive to qualify for registration in Part A of the register, it may nevertheless be registered under Part B.³⁹

In order for a trademark 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, of distinguishing goods with which the proprietor of the trademark is or may be connected to in the course of trade from goods in the case of which no such connection subsists.⁴⁰ Unlike the Part A mark, Part B mark does not have to be distinctive when registered. All that is required is that it should be capable of becoming distinctive in use. As soon as it becomes distinctive, the owner of the mark could make a fresh application to register it in Part A.⁴¹ The right conferred on a proprietor of a mark by the Nigerian Trademark Act depends on whether the mark is registered under Part A or

³² Sections 3 and 8 of the Act

³³ S. A. Fagbemi, 'An Analysis of the Statutory Provisions and Case Law for Trademarks Registration Under the Nigerian Trademarks Act', *International Journal of Business and Law Research*, Seahi publications, 3 (3): 24-31, July-Sept, 2015

³⁴ See section 26 of the Act

³⁵ Section 14(1) of the Act

³⁶ Section 4 of the Act

³⁷ Ibid

³⁸ See section 9 of the Act

³⁹ A. O. Oyewumi, (n16) P. 246

⁴⁰ Section 10 (1) of the Act

⁴¹ F. O. Babafemi, (n 25) P. 186

Part B of the Act. The right in Section 5 of the Act accrues only to the proprietor of a mark registered in part A, and the right in section 6 accrues to mark registered under Part B.⁴² Registration of Trademark is vested in the owner namely proprietor, Joint proprietors, corporate bodies, registered users and assignees. These are the categories of persons that can apply to register their mark. Registration of trademark also has territorial limitations. In *Smithkline Beechman Plc v Farmex Ltd*,⁴³ the Court held that Trademark registration is territorially limited. Accordingly, a trademark registered in one country has effect only within the territorial boundaries of that country.⁴⁴

The registration of a trademark shall be for a period of seven years but may be renewed from time to time in accordance with the provision of the Act.⁴⁵ It should be noted that certain marks are not permitted to be registered under the Act. This may be on ground of safeguarding the interest of businesses, consumer protection or other public policy considerations. Thus, marks that are deceptive or scandalous, those that falsely imply official patronage, those that seek to appropriate commonly known or generic designations and marks that are capable of causing confusion among consumers are all prohibited.⁴⁶

4. Infringement of Trademark

Nigeria operates a 'first to file' system and the Trademark Act grants the owner of a registered trademark the exclusive rights to use the trademark and protect it from any form of infringement.⁴⁷ This means that the first to register a trademark has the right to prevent others from using an identical or confusingly similar mark for the same goods or services or description of goods and services in respect of which the first trademark was registered.⁴⁸ The purpose and/or rationale for the registration of trademark is, of course, the prevention of unauthorized use of the registered mark. Registration of trademark is evidence of title and is also a condition precedent to an action for infringement.⁴⁹ It is the registration that confers on the proprietor of trademark exclusive rights to use the mark in relations to goods or classes of goods in respect of which it is registered. Any unauthorized use of a registered trademark on

⁴² O. A. Olatunji, 'Fundamentals of the Nigerian Trademarks Act and Implication for Foreign Trademarks Owners', *Journal of Intellectual Property Law and Practice*, 2016, Vol. 11 No. 2, P. 134

⁴³ (2010) 1 NWLR Part 1175 at 285

⁴⁴ *Ibid*, per Lord Bode Rhodes Vivour JCA at P. 299

⁴⁵ See Section 23(1) of the Act

⁴⁶ A. O. Oyewumi (n16) P. 241

⁴⁷ Ownership of Trademark in Nigeria', available at <https://www.proshare.co/articles>, accessed 4/3/2022.

⁴⁸ *Ibid*

⁴⁹ See Section 3 of the Act

such goods or services constitutes an infringement of the proprietor's rights.⁵⁰

Trademark is said to be infringed when a registered trademark is used by a person who is neither the registered proprietor nor the licensee of the said trademark in relation to the goods or services for which it is registered.⁵¹ Trademark infringement in Nigeria connotes the violation of the exclusive rights granted to the registered proprietor under the Trademark Act 2004, to use the same in relation to the goods or services in which the trademark is registered.

Section 5(2) of the Trademark Act stipulates that the right of the proprietor “shall be deemed to be infringed by any person, who not being the proprietor of the trademark or a registered user thereof using it by way of 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 used as a trademark;
- (b) in a case in which the use is use 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 trademark or to goods with which such a person as aforesaid is connected in the course of trade”⁵²

Flowing from the above provision, only a registered proprietor or anyone duly authorized by him has the right to use the mark. In the case of the authorized user, there has to be strict compliance with the term of use, else he may be liable for infringement.

The rights conferred on proprietors registered under Part B of the register is provided for in Section 6 of the Act. Section 6 (1) grants similar rights as those conferred under Section 5, subject however, to Section 6 (2). The said Section 6 (2) provides that in any action for infringement of a Part B mark, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to lead to the belief in a connection in the course of trade between the goods and some person entitled either as proprietor or as a

⁵⁰ A. O. Oyewumi, (n16) P. 283

⁵¹ I. Ogbah, (n 13), P. 125

⁵² See Section 5(2) (a) and (b) of the Act

registered user to use the trademark.⁵³

The right to a trademark is also infringed if another person without the license of the proprietor does or uses any mark that the other persons are precluded from registration under the merchandise mark Act.⁵⁴ Section 4(a) and (b) of the Merchandise Mark Act provides that:

A person shall be deemed to forge a trademark who either:

- (a) Without the assent of the proprietor of the trademark, makes that trademark or a mark so nearly resembling that trademark as to be calculated to deceive, or
- (b) Falsifies any genuine trademark, whether by alteration, additional effacement, or otherwise, and any trademark or mark so made or falsified is in this Act referred to as a forged trademark: provided that, in any prosecution for forging a trademark, the burden of proving the assent of the proprietor shall lie on the defendant.⁵⁵

What constitutes infringement of trademark received judicial *imprimatur* in the case of ***Smithkline Beechman Plc v. Farmex Ltd***⁵⁶ Where the court held that:

... the rights accruable under the Act will be deemed infringed by any person who not being the proprietor or registered user, uses a mark or marks so nearly resembling as to be likely to deceive or cause confusion in the course of trade in relation to any goods in relation to which it is registered.

Similarly, in ***Alliance International Ltd v. S. K. International Enterprises Ltd***,⁵⁷ learned Justice Rhodes-Vivour agreed with Section 5 (2) of the Trademark Act when he stated as follows:

... trademark is infringed by a person who not being the proprietor of the trademark uses mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade.

⁵³ See Section 6(2) of the Act

⁵⁴ Merchandise Mark Act, Cap. M10, Laws of the Federation of Nigeria, 2004.

⁵⁵ Section 4 (a) and (b) of the Merchandise Mark Act

⁵⁶ (2010) 1 NWLR Part 1175 at 285

⁵⁷ (2010) 13 NWLR Part 1211 at 270

In order to successfully establish the case of infringement of trademark, the plaintiff or proprietor of the mark will have to take certain steps. The first is the provision of evidence of registration of the trademark alleged to be infringed. In *Crysterlight Overseas Agency Limited v. Yugolles Drugs Company Limited and Anor*,⁵⁸ the plaintiff a pharmaceutical company engaged in the importation and distribution of pharmaceutical products claimed to be the registered proprietor of the trademark “Mycetamol” with a certificate of registration. It alleged that the 2nd defendant had, by using its trademark on the drugs supplied to the 1st defendant, thereby infringed its trademark. The plaintiff did not however, produce or tender in evidence the said certificate of registration. The Court held that the non-production or tendering of the certificate of registration was fatal to the plaintiff’s claim, as the certificate was evidence of the plaintiff’s title to the trademark in dispute.

It should be noted that in a finding of infringement, the intention of the defendant need not be fraudulent or deliberate.⁵⁹ In *Re: Egg Products Ltd's Application*,⁶⁰ the Court expressed the view that this phrase, “Likely to deceive” does not necessarily imply fraud, or anything of that kind on the part of the defendant. The relevant consideration is the likely effect on the members of the consuming public. Where the mark is likely to confuse them, the likelihood of deceit is deemed to be present.⁶¹ This is particularly important where illiteracy levels are high. What will not confuse or deceive an educated diligent and careful purchaser may well deceive an illiterate.⁶²

5. Enforcement of the Right of a Trademark Proprietor

By virtue of the provision of the Trademark Act, only registered marks can form the basis for instituting any action for infringement of Trademark. Although infringement of unregistered marks can equally form the basis for seeking redress in a court of law, such action can only come under the tort of passing-off and not the Act. A civil action lies in all infringement cases.⁶³ The proprietor of a trademark can bring an action to prevent the registration of a mark similar to or resembling his own registered mark by another person. He can also institute an action if the mark which infringes his own mark has already been registered.⁶⁴ Indeed, where the two marks resemble or nearly resemble each other as to be likely to deceive or cause

⁵⁸ (1998) FHCL 390

⁵⁹ A. O. Oyewumi, (n 16) P. 286

⁶⁰ (1922) 39 R.P.C 155

⁶¹ *Bell sons and Co Ltd v. Aka & others* (1977) 1 All N.L.R. (Part 1) 34

⁶² *The United Kingdom Tobacco Co. Ltd v. Carreras* 16 NLR 1

⁶³ F. O. Babafemi, (n 25), P 233

⁶⁴ *Ibid*

confusion, the proprietor is likely to succeed in an action for infringement.⁶⁵ The Act also provides for enforcement of the right of a trademark proprietor through criminal prosecution.⁶⁶ Also, criminal prosecution of infringement of trademark can be conducted under the Merchandise Mark Act⁶⁷ Counterfeit and Fake Drugs Act⁶⁸ and the Penal code.⁶⁹

6. Some Pitfalls in the Trademark Act Cap T13, Laws of the Federation 2004

A careful scrutiny of the Nigerian Trademark Act, Cap T13, Laws of the Federation 2004 reveals that it has numerous pitfalls and in need of legislative reform. These pitfalls have succeeded in making the Act a stand-alone legislation detached from similar legislation in other jurisdictions. Some of the identified pitfalls are: Restrictive definition of trademark, Dichotomy of Registration and limited scope of what constitutes trademark infringement under the Act. These identified pitfalls shall now be treated in Seriatim.

(a) Restrictive definition of 'Trademark'

The current definition of trademark under the Act is verbose, restrictive and inelegantly drafted.⁷⁰ Section 67 which provides for the definition of trademark is so worded that it has succeeded in confusing the readers. For example, it is not clear whether the word “goods” as used in the section include “service” marks since “goods” itself was not defined.⁷¹ Despite the length of the definition, it fails to include non-traditional marks such as smell, shape and packaging, all of which are now being used by traders, especially in developed countries, to denote the origin of their products and services.⁷² The Trademark Act apparently and expressly excludes service marks, well known marks and non-traditional marks which are accorded international recognition in trademarks law and practice.⁷³ This is as a result of the lack of the provision in the United Kingdom Trademark Act of 1938 that served as a template for the Nigerian Trademark Act.⁷⁴ This is a major lacuna which has

⁶⁵ *Ibid*

⁶⁶ See Section 60 and 61 of the Act

⁶⁷ See Section 3 of the Merchandise Mark Act

⁶⁸ Section 3 counterfeiting and Fake Drugs and unwholesome processed foods (Miscellaneous provisions) Act 70 Cap C 34, laws of the Federation of Nigeria, 2004

⁶⁹ Section 54 of the Penal code

⁷⁰ O. A. Olatunji, (n 42) P. 135

⁷¹ I. Ameh, 'Analysis of the legal and institutional frameworks for the protection of Intellectual property right in Nigeria', An unpublished PhD Thesis, Ahmadu Bello University, Zaria, 2014, P. 228

⁷² O. A. Olatunji, (n 42) P. 135

⁷³ O. C. Nwachukwu and N. C. Okolie, (2022) 'Examination of the legal effect of regulation of trademarks in Nigeria', *Beijing Law Review*, Vol. 13 No. 3, 555-574

deprived a significant section of business in Nigeria of the opportunity to safeguard the distinctive devices, logo and other marks used to identify their service-based businesses and to distinguish them from those providing similar types of service.⁷⁵ A service mark is a word, phrase, symbol or logo that is used to brand, identify and distinguish a service. For instance, 'McDonald's brand name' is an example of service mark for restaurant service.⁷⁶

However, Section 42 (1) and 45 of the Trademark Act confers on the Minister of Industry, Trade and Investment a discretionary power to make regulation empowering the Registrar of Trademarks to amend the register so as to be in compliance with any amended or substituted classification that may be prescribed.⁷⁷ The Trademark Act in Section 45(b) further cloths the Minister with the power to make regulation for classifying goods for the purposes of registration of trademarks.⁸⁰ In the exercise of the power conferred on him by the Statute in Section 42 (1) and 45(b), the then Minister of Commerce in March 2007 by Ministerial Order extended the classes under which a trademark may be registered from 34 classes to 45 classes, in line with the provision of the 9th edition of the Nice Classification of Goods. Accordingly, and effective from that date, service marks became registrable in those classes. Despite the extended classification made by the then minister, it has been observed that the powers of the Minister to make regulations under Section 45(1) are limited to regulations for classifying goods for the purposes of registration of trademarks. It has further been argued that making of regulations for classifying services is *ultra-vires* the powers of the Minister, thus bringing into question the validity of the extended classification.⁸¹ It is therefore necessary, that despite the intervention of the Minister through this interim measure, an amendment to the Act is needed in order to simplify and extend the definition to cover the essentials, as has been done in the trademark laws of several other countries such as the UK,⁸² Ghana⁸³ and south Africa.⁸⁴ In the UK and

⁷⁴ I. Ameh (n 71) P. 229

⁷⁵ A. O. Oyewumi, (n 16) P. 236

⁷⁶ O. C. Nwachukwu and N. ^{C. Okolie, (n73)}

⁷⁷ *Ibid*

⁷⁸ See Section 45 (b) of the Act

⁷⁹ I. Ameh (n 71) P. 229

⁸⁰ A. O. Oyewumi, (n 16) P. 239

⁸¹ M. Mark, 'Trademark Law Reform in Nigeria: A Practitioner's Analysis', (2011) *Nials Journals of Intellectual Property* (NJIP) Maiden Edition 2011, P. 205

Australia, the qualification for registration is determined by the twin factors of capability to distinguish and capability of graphical representation.

(b) **Dichotomy in Registration**

There is actually no justification for retaining the division of the trademark register into Parts A and B. The distinction between registration under Part A and Part B is entirely unclear: The sole purpose of registration of trademark is to protect the proprietor. Of what use is the registration in Part B of the register when the proprietor is not protected by such registration.

Section 6 (1) of the Act provides that registration of trademarks in Part B of the register confer same rights as that under Part A, Section 6 (2) of the Act turn round to provide that in an action for infringement of a trademark registered in Part B, the Court should not grant an injunction or/other relief if the defendant in such a case establishes to the satisfaction of the Court that the use of which the plaintiff complain is not likely to deceive or cause confusion or lead to the belief in a connection in the course of trade between the goods and some entitled to either as proprietor or as a registered user to use the trademark.⁸⁶ The said Section 6 (2), negatives any measure of protection offered by the registration of trademark. This provision is an open invitation to potential infringers to actually infringe a trademark duly registered and defend themselves hiding under the provision that no one was misled by their conduct or action. This provision, to say the least, is at variance with the intendment of the law, which is to protect trademarks.

Another worrisome provision in relation to dichotomy in registration is section 14. Section 14(1) of the Act provides *inter alia*, that a trademark registered in Part 'A' shall after seven years be deemed as “valid in all respect: unless the registration was obtained by fraud or the trademark is scandalous or deceptive”. Now Section 14 (2) expressly excludes part 'B' trademarks from the benefit of the said provision. In other words, the validity of a part 'B' trademark can be challenged at anytime.⁸⁷ Indeed, the registration in part 'B' seems inferior and offers no protection at all to the

⁸²See Section 1(1) United Kingdom's Trademark Act, 1994

⁸³Section (1) Ghanaian Trademarks Act (No. 664) of 2004

⁸⁴Article 2 (XXIV) of the South African Trademarks Act, 1997

⁸⁵See Section 1 of the Uk Trademarks Act 1994, See also section 1 (1) of the Australian Trademarks Act No. 119 of 1995 (as amended) ss 17, 40 and 41 (Australian TMA)

⁸⁶See section 6 (1) and 6 (2) of the Act.

⁸⁷I. Ameh (n 71) P. 216

proprietor. In the UK, the 1938 Act⁸⁸ from which the Nigerian Act was generously borrowed have been scrapped and replaced with the 1994 Act⁸⁹ which has since abolished the dichotomy of Part A and B registration.

(c) Limited Scope of What Constitutes Trademark Infringement Under the Act

What constitute trademark infringement in Nigeria is quite limited and restrictive. What qualifies as infringement as provided in section 5 (2) of the Act does not include other special cases such as dilution (by blurring or tarnishment) and cyber-squatting.⁹⁰ Owing to the fact that the Act do not provide for these special-case infringements, reputable trademarks belonging to foreign proprietors are prone to dilution and cyber-squatting.

6. Conclusion and Recommendation

The world today has become a global village, making life easier especially in areas such as advertising and trade. Trademarks play an important role in industrialization and they have since become a key factor in the modern world of International Trade and market oriented economies. Industrialization and the growth of the system of the market-oriented economies allow competing manufacturers and traders to offer consumers a variety of goods in the same category.⁹¹ Trademark is a measure or format by which product owners project into streams of commerce, goods and service.⁹² Its function is to show the origin of a good and guarantee quality and earn goodwill. It is a fact that the practice of trademark registration is daily expanding and several innovations are being introduced globally.⁹³ The Nigerian Trademark Act, 2004 in its present state is deficient in several areas and fall below the standard obtainable internationally. Therefore, in order to meet up with international best practice in trademark administration, this paper recommends the amendment of the Trademark Act cap T13, Laws of the Federation of Nigeria 2004, particularly in the following areas amongst others:

1. Section 67 of the Act amended to include service marks and other classes of marks

⁸⁸See Articles 1 -10 of the 1938 United Kingdom's Trademark Act

⁸⁹United Kingdom's Trademark Act 1994, See Section 3 (1)

⁹⁰O. A. Olatunji, (n 42), P. 136

⁹¹O. C. Nwachukwu & N. C Okolie, (n 73)

⁹²E. R Cornish, *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 24th edn. (London: Sweet and Maxwell, 1999) P. 597

⁹³O. C. Nwachukwu & N. C Okolie, (n 73)

2. Unifying the registration process and removing the dichotomy of Part 'A' and 'B'
3. Expanding the scope of what constitutes trademark infringement to include special cases such as dilution and cyber-squatting.