

# International Comparative Legal Guides



TM

## Trade Marks 2021

A practical cross-border insight into trade mark work

10<sup>th</sup> Edition

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# Nigeria

G. Elias & Co.



Fred Onuobia SAN



Similoluwa Oyelude

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in Nigeria is the Nigerian Trademarks Registry, under the Federal Ministry of Trade and Investments.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The following laws are the relevant trade mark legislations in Nigeria:

- (i) Trademarks Act, CAP T13 Laws of the Federation of Nigeria, 2004 (the “**Trademarks Act**”).
- (ii) The Trademarks Regulation, 1967.
- (iii) The Merchandise Marks Act, CAP M10 Laws of the Federation of Nigeria, 2004 (the “**Merchandise Marks Act**”).
- (iv) The Trademark Malpractices (Miscellaneous Offences) Act CAP T12 LFN 2004.
- (v) The Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act.
- (vi) The Cybercrimes (Prohibition, Prevention) Act 2015.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any device, brand, heading, label, ticket, name, signature, word, letter, colour marks, numeral, or any combination thereof may be registered as a trade mark. Three dimensional marks are also eligible for trade mark protection.

### 2.2 What cannot be registered as a trade mark?

Deceptive or scandalous marks or designs or marks that are likely to cause confusion are not eligible for trade mark protection. Names of chemical substances and geographical names in their ordinary signification are also ineligible for trade mark protection.

### 2.3 What information is needed to register a trade mark?

The following documents and information will be required for registration of a trade mark in Nigeria:

- (i) the name, nationality and address of the proprietor of the trade mark;
- (ii) representation of the trade mark;
- (iii) specification of goods/services for which the trade mark is sought to be registered;
- (iv) the class of goods/services; and
- (v) an executed power of attorney in favour of an authorised agent or attorney to be filed at the Trademarks Registry.

### 2.4 What is the general procedure for trade mark registration?

An availability search is conducted at the Trademarks Registry. It takes about three (3) days to obtain a search report: (i) the trade mark application is filed. It is subsequently examined for registration; (ii) an Acceptance Form is usually issued within one to three months. After the mark has been accepted, it is listed for publication in the trade marks register. (The publication timeline is determined by the Trademarks Office); (iii) after publication in the Trademarks Journal, the trade mark application is open to oppositions. The opposition period is two (2) months from the date of publication in the Trademarks Journal; and (iv) where there are no oppositions, an application for sealing of the trade mark application is filed in order to obtain the certificate of registration. This usually takes between three to six months.

### 2.5 How is a trade mark adequately represented?

There is no statutory provision governing how a trade mark can be adequately represented. All that is required under the Trademarks Act is that the mark should be distinctive. The trade mark may be limited in whole or in part to one or more specified colours. If it is registered without limitation, then it is taken to be registered for all colours.

### 2.6 How are goods and services described?

The description of goods and services in Nigeria is based on the Nice Classification. Protection may be claimed under the whole class heading or if a specific line of goods/services is being targeted, a more narrow description might be preferable.

**2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

Non-traditional trade marks such as colour marks, three dimensional marks, labels and devices are registrable with the Trademarks Registry.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

Proof of use is not required for the registration or renewal of trade marks in Nigeria.

**2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

Trade marks registration and protection is territorial. A trade mark registered in Nigeria is limited to Nigeria.

**2.10 Who can own a trade mark in your jurisdiction?**

Nigerians, foreigners, companies, partnerships, associations or societies can register a trade mark.

**2.11 Can a trade mark acquire distinctive character through use?**

Yes, a trade mark can acquire distinctive character through use and adaptation. Before a trade mark can acquire distinctive character, the mark must be capable of creating an association in the minds of the purchasing public of a connection in the course of trade between the proprietor and the goods/services to which the mark is applied.

**2.12 How long on average does registration take?**

It usually takes between 12–18 months to register a trade mark in Nigeria where there are no oppositions.

**2.13 What is the average cost of obtaining a trade mark in your jurisdiction?**

The official cost for obtaining a trade mark in Nigeria is USD80. This is subject to an upward or downward review by the Trademarks Registry.

**2.14 Is there more than one route to obtaining a registration in your jurisdiction?**

No. Registration can only be obtained through application to the Trademarks Registry.

**2.15 Is a Power of Attorney needed?**

Yes, a Power of Attorney must be executed in order to enable the registered agent/attorney file and obtain the registration of a trade mark on behalf of an applicant.

**2.16 If so, does a Power of Attorney require notarisation and/or legalisation?**

No. Notarisation or legalisation is not needed. A duly executed Power of Attorney by an authorised person is sufficient for filing a trade mark application.

**2.17 How is priority claimed?**

Section 44 of the Trademarks Act requires the President of Nigeria to designate the relevant Convention Countries to which claims for priority are applicable by means of a formal declaration. Such declaration is then subsequently published in a federal gazette. These twin requirements have not been fulfilled, and as such, priority cannot be claimed for the time being.

**2.18 Does your jurisdiction recognise Collective or Certification marks?**

Certification marks are recognised in Nigeria. The Trademarks Act is silent on the registration regime for Collective marks.

### 3 Absolute Grounds for Refusal

**3.1 What are the absolute grounds for refusal of registration?**

The absolute grounds for refusal are as follows:

- Where the trade mark is bereft of distinctive character.
- Where a trade mark is contrary to law, or is immoral, deceptive or scandalous.
- Where a trade mark is likely to deceive or cause confusion.
- Where a trade mark contains names of chemical substances, use of the Coat of Arms of Nigeria, the National Flag of Nigeria, use of any emblem or title such as President or Governor without appropriate authorisation.
- Where the trade mark contains words such as "patent", "Patented", "Registered", "Registered Design", or "Copyright".
- Where the trade mark contains words such as "Red Cross" or "Geneva Cross" and representations of the Geneva and other crosses in red or of the Swiss Federal Cross in white on a red ground or in a silver tone on a red ground or such representations in a similar colour or colours.

**3.2 What are the ways to overcome an absolute grounds objection?**

Grounds such as illegality, immorality, deceptiveness or scandal can only be overcome by providing evidence that such mark sought to be registered is not deceptive, or that the laws and morals of the society have changed or metamorphosed over time or an alternative interpretation showing contrary view. For grounds like use of words or designs that have restricted use because of affiliation with the government or an international organisation, it can be overcome where appropriate consent and permit is sought and obtained. In the case of a claim that the mark lacks any distinguishing character, evidence that the mark has acquired secondary meaning or distinctiveness can be given.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal to register a trade mark can be appealed to the Registrar of Trademarks (the “Registrar”). The timeline for filing an appeal is within two months from the date of refusal. There is no official cost involved. The timeframe for receiving a review of the appeal filed is three months post filing of the appeal.

The decision of the Registrar can be further appealed to the Federal High Court of Nigeria.

### 3.4 What is the route of appeal?

An appeal in the first instance lies to the Registrar. If an applicant is dissatisfied with the decision of the Registrar, she may further appeal to the Federal High Court of Nigeria. Appeals from the Federal High Court are made to the Court of Appeal of Nigeria and a final appeal lies to the Supreme Court of Nigeria.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration are:

- A trade mark application is filed by a person other than the actual owner.
- A trade mark is sought to be registered in bad faith.
- The trade mark sought to be registered was fraudulently obtained.
- The trade mark sought to be registered is identical or confusingly similar to an already registered trade mark.

### 4.2 Are there ways to overcome a relative grounds objection?

The following are ways to overcome such objections:

- In the case of an allegation that the applicant is not the actual owner, evidence showing that the applicant has secured permission from the rightful owner or is an assignee or registered user of the trade mark can be provided.
- Evidence dismissing any allegation of fraud or bad faith.
- Evidence showing that prior user rights or concurrent/equivalent rights were lawfully acquired.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see response to question 3.3 above.

### 4.4 What is the route of appeal?

Please see response to question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The following are the grounds upon which a trade mark can be opposed:

- (i) The applicant for the trade mark has no intention of using it.
- (ii) The trade mark is scandalous, immoral or contains any matter that is likely to cause confusion or is disallowed by law.
- (iii) The trade mark contains geographical names.
- (iv) The applicant is not the true owner entitled to register the trade mark.
- (v) The trade mark is likely to deceive the general public.
- (vi) The trade mark is confusingly similar or identical to a previously registered trade mark or a famous mark.
- (vii) The trade mark contains some restricted words (listed under question 3.1 above) or symbols such as representations of the Geneva cross and other crosses in red or of the Swiss federal cross in white on a red background, or in silver on a red background.
- (viii) The trade mark contains the name(s) of a chemical substance.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any individual or corporate body, whether or not such individual or entity has prior proprietary interest, who believes that a trade mark application before the Nigerian Trademarks Registry should not be registered may file an opposition to the registration of the trade marks.

### 5.3 What is the procedure for opposition?

According to the Trademarks Act, a party who intends to oppose a trade mark application must do so by filing a Notice of Opposition (the “Notice”) within two (2) months from the date of the publication of the application for the registration of the trade mark, and containing ground(s) for such opposition.

Upon the filing of the Notice, the Registrar must send a copy of the Notice to the Applicant. Within one (1) month of the receipt of the Notice, the Applicant shall send to the Registrar a Counter Statement stating the grounds upon which the Applicant relies for the application for the registration of the trade mark. Where no Counter Statement is filed, the application shall be deemed abandoned.

Where the Applicant files a Counter Statement, the Registrar shall send a copy of the Counter Statement to the opposing party. Both parties will then exchange statutory declarations in the form of evidence. The Registrar shall fix a date for a hearing, and after hearing the parties and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration of the trade mark is to be permitted. The Registrar’s decision is subject to appeal to the Federal High Court.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

When a trade mark registration is granted, a certificate of registration bearing the Registered trade mark number is issued by the Registrar to the Applicant. A trade mark registration grants the trade mark owner rights to institute an action at the Federal High Court for infringement of the trade mark, the right to the exclusive use of the registered trade mark and right to stop a third party from using a similar or identical trade mark in the course of commerce or business.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Registration of a trade mark takes effect from the date the application for the registration of the trade mark was filed.

### 6.3 What is the term of a trade mark?

Registration of a trade mark is effective for an initial term of (seven) 7 years from the date of filing. Thereafter, the trade mark is renewed perpetually every (fourteen) 14 years.

### 6.4 How is a trade mark renewed?

To renew a trade mark, an application is made to the Registrar through the appropriate form along with the prescribed fees and the certificate of registration or the certificate of last renewal, as applicable. A proprietor of a trade mark can make a late application for the renewal of a trade mark but the prescribed renewal fee and penalty fee for late renewal must be paid.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. A trade mark assignment can be only be recorded (registered) by an assignor, assignee or authorised agent of either the assignor or assignee at the Trademark Registry.

### 7.2 Are there different types of assignment?

Yes. A trade mark is assignable with or without the goodwill of the business either in respect of all goods or services or a part thereof. A trade mark can be assigned with: (i) all the goods of a business; (ii) particular goods and services of the business; or (iii) the goodwill of the business. Where the assignment is without the goodwill of the business, the Registrar may direct that the assignment should first be advertised in the Trademarks Journal.

### 7.3 Can an individual register the licensing of a trade mark?

The registration of the right to use a trade mark (“licensing”) may be done by a proprietor, licensee or an agent of the proprietor or the licensee at the Trademark Registry. A foreign proprietor requires a local agent to register the right to use a trade mark.

### 7.4 Are there different types of licence?

There is no specific classification of licence. However, in practice, the usual types of licence available in commercial transactions are recognised and registrable in Nigeria. This may include sole licence, exclusive licence, non-exclusive licence or other restrictions imposed by the licensor.

### 7.5 Can a trade mark licensee sue for infringement?

The conditions or restrictions to a licence can be determined by the Licensee and the trade mark owner. A licence agreement

may state that a licensee can sue for infringement where the trade mark owner does not take action in cases where trade mark infringement arises.

Section 33 of the Trade marks Act allows a licensee subject to any agreement between the proprietor of a trade mark and a licensee, to institute proceedings for infringement in his own name where the registered proprietor having been informed by the licensee, within two (2) months fails to take necessary action to take proceedings to prevent infringement.

### 7.6 Are quality control clauses necessary in a licence?

No. Subject to the agreement of the parties, a quality control clause may or may not be included in a registered user agreement.

### 7.7 Can an individual register a security interest under a trade mark?

Yes. A trade mark can be the subject of a security interest. Similarly, the Trade marks Act, Section 65 (2) states that equities in respect of a trade mark may be enforced in the same manner as in respect of any other personal property.

### 7.8 Are there different types of security interest?

Yes. Mortgages and charges are also recognised under the Trademarks Act.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark may be revoked on the following grounds:

- (1) non-use – when a trade mark owner registers a trade mark without a *bona fide* intention to use the trade mark in commerce or after the registration, or has not used the trade mark (five) 5 years prior to an application by an interested party for revocation on the ground of non-use;
- (2) non-renewal of a trade mark;
- (3) that the trade mark registration was obtained fraudulently;
- (4) that the trade mark is likely to cause confusion, is scandalous or contrary to law and morality; and
- (5) that the trade mark is not distinctive. Where the registered mark is descriptive and generic and was registered in error.

### 8.2 What is the procedure for revocation of a trade mark?

An application for the revocation of a trade mark can be made to the Registrar or to the Federal High Court. If made to the Registrar, it shall be in a prescribed form and accompanied by a statement of the applicant's interest, facts relevant to the application and reliefs sought. Where a matter is already before the court, in relation to the concerned trade mark, an application for revocation of the mark should be made to the court in the prescribed form.

### 8.3 Who can commence revocation proceedings?

Any person who establishes sufficient interest to the satisfaction of the Registrar can commence revocation proceedings.



#### 8.4 What grounds of defence can be raised to a revocation action?

The following grounds of defence can be raised to a revocation:

- (1) For alleged non-use, proof of use within the relevant period shall be sufficient defence.
- (2) For alleged lack of distinctiveness, proof of sufficient distinctiveness shall be sufficient defence.
- (3) For alleged non-renewal, proof that the Registrar did not issue the required statutory notice is sufficient defence.
- (4) Proof of fulfilment of conditions precedent is sufficient defence where non-compliance is alleged.

#### 8.5 What is the route of appeal from a decision of revocation?

An appeal from a decision of revocation by the Registrar lies firstly to the Federal High court, then to the Court of Appeal and finally to the Supreme Court.

## 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

Where a mark registered under the Act has attained incontestable status following its subsistence on the register for a period of at least seven years, it is deemed to have become conclusively valid for all purposes unless it was obtained by fraud or the trade mark is deceptive, scandalous, contrary to law or public morality or a court of law. A trade mark can be invalidated on these grounds. Also, where the trade mark registration was issued in error and without sufficient cause, it can be invalidated.

#### 9.2 What is the procedure for invalidation of a trade mark?

An application is made to the Registrar where the invalidation procedure is instigated at the instance of a registered proprietor, registered user or other interested/concerned person(s), stating the grounds and particulars for seeking to invalidate the registration. The owner of the trade mark is entitled to a notice as well as an opportunity to respond to the allegations.

#### 9.3 Who can commence invalidation proceedings?

The Registrar, a registered proprietor, registered user, or any person who establishes sufficient interest to the satisfaction of the Registrar may commence invalidation proceedings.

#### 9.4 What grounds of defence can be raised to an invalidation action?

In the case of an invalidation action, one can raise evidence that the trade mark sought to be invalidated was in fact not obtained by fraud or misrepresentation or that the trade mark is not scandalous, deceptive or contrary to law or morality, or that the proprietor has acquired rights or used the trade mark in commerce prior to applying for the trade mark registration.

#### 9.5 What is the route of appeal from a decision of invalidity?

An initial right of appeal lies to the Trademark Registrar, then to the Federal High Court of Nigeria, if one is dissatisfied with the decision of the Trademark Registrar, a further appeal can be made to the Court of Appeal. If one is then dissatisfied with the decision of the Federal High Court, a final appeal can be made to the Supreme Court of Nigeria.

## 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark infringement action can only be brought with respect to a registered trade mark. The Federal High Court has exclusive jurisdiction over trade mark matters. The Trademarks Act also empowers the Trademarks Registry to refuse registration, preside over opposition proceedings and take certain other administrative actions with respect to proposed registrations.

Furthermore, the Companies and Allied Matters Act, 2020 empowers the Registrar General of the Corporate Affairs Commission to direct a registered company or business name to change its name if the name is confusingly similar to a prior registered trade mark.

The Federal Competition and Consumer Protection Act, 2018 established the Federal Competition and Consumer Protection Commission (“FCCPC”) which prohibits any undertaking from knowingly applying to any goods, a trade description that is likely to mislead consumers or remove or obscure a trade description or trade mark in a manner that is likely to deceive the consumers. Upon obtaining a warrant, a search can be conducted by the FCCPC to search and seize such products.

The Economic and Financial Crimes Commission Act 2004 defines “economic and financial crimes” to include theft of intellectual property and the Economic and Financial Crimes Commission is empowered to investigate such crimes.

Regulatory authorities like the National Agency for Food and Drug Administration, Standard Organisation of Nigeria, the Nigerian Customs Authorities and the Nigerian Police can conduct investigations into cases of counterfeiting and also conduct searches, raids and seizures of infringing products.

For online infringements, a trade mark owner can also approach and seek the assistance of the Nigerian Internet Registration Association (“NIRA”) on abusive and bad faith registration pertaining to trade marks and domain name matters.

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Parties are required to file the writ of summons, statements of claim/defence, written statements on oath, documents to be relied on during trial as well as a list of non-documentary exhibits. The exchange of pleadings together with accompanying processes by the parties may take about three months.

Once pleadings have been exchanged by the parties, the court will set the matter down for trial in the absence of pending interlocutory applications which must first be determined. Where such interlocutory applications exist, the proceedings of hearing them may take between five to six months to conclude, not taking into account interlocutory appeals arising therefrom or other bureaucratic delays.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary (interim and interlocutory) and final injunctions are available.

Preliminary injunctions are usually granted for the preservation of the applicant's rights in the subject matter of the suit, pending the final determination of the rights of both parties in the suit. Interim injunctions are granted *ex parte* (without the respondent being heard) and only in cases of emergency and urgency and for a short period (seven (7) to fourteen (14) days) pending the hearing of an interlocutory application. On the other hand, interlocutory injunctions are granted, after both parties have been heard, pending the final determination of the suit.

Final injunctions are granted by the court upon the conclusion of trial, based on the final determination of the parties' rights by the court, where the trade mark action succeeds.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled to provide disclosure of relevant documents or materials to the other party through a procedure known as "interrogatories" (to provide information) and "discoveries" (to provide documents).

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence of parties' witnesses are required to be presented in writing under oath, filed together with the pleadings and adopted during trial. All witnesses except subpoenaed witnesses are mandated to file written statements on oath. The written statement on oath stands as the relevant party's evidence-in-chief after adoption by the party or witness deposing to it and such witness must be cross-examined by the opponent's counsel, otherwise, his testimony will be of little or no probative value. Where necessary, the witness can be re-examined after cross-examination.

Furthermore, submissions in support of interlocutory applications and final addresses at the conclusion of the trial must be presented in writing. When the written submissions are being adopted in court, Counsel may be permitted to address the court orally for the purpose of emphasis. Also, an affidavit rather than oral evidence is used to support interlocutory applications but when two affidavits conflict, the court shall call oral evidence to resolve such conflicting averments, if the conflict is irreconcilable on the basis of the affidavits.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings can be stayed pending the resolution of questions relating to the validity of the relevant trade marks in another court. Where the parties and issues are the same in both proceedings, the proceedings may be consolidated and adjudicated in the same court to prevent multiplicity of proceedings, conflicting rulings and the abuse of court process. The court may not stay an action because there are pending proceedings

before the Trademarks Registry. Where there is an interlocutory appeal on a fundamental subject like jurisdiction, *locus standi*, etc., proceedings before the Trial Court (Federal High Court) are likely to be stayed until the appeal is determined.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Trade mark infringement claims can be classified as tort claims under the common law. The time frame for instituting such actions is six (6) years under the Limitations Act, 1966.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. The Merchandise Marks Act criminalises trade mark- and trade description-related offences like forgery of trade marks, false application to goods of any trade mark or any marks so nearly resembling a trade mark as to be calculated to deceive. Anyone convicted of an offence under the Merchandise Marks Act is liable to imprisonment for six (6) months and a fine and if convicted in proceedings before the High court, the offender is liable to imprisonment for two (2) two years or a fine or both.

The Trademark Malpractices (Miscellaneous Offences) Act, CAP T12 LFN, 2004 criminalises labelling, packaging, sale or advertisement of a product in a manner that is false, misleading or likely to create a wrong impression as to its quality, character, brand name, value, composition, merit or safety. Any person convicted is liable to a fine of not less than NGN50,000 (approx. USD135).

The Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act, CAP C34, Laws of the Federation of Nigeria, 2004 prohibits the sale, distribution, importation and possession of counterfeit, adulterated and fake drugs or unwholesome processed food. Any person convicted is liable to a fine not exceeding NGN500,000 (approximately USD1,315) or a term of imprisonment of not less than five years or more than 15 years or both fine and imprisonment.

The Cybercrimes (Prohibition, Prevention) Act, 2015 prohibits any person from intentionally taking or making use of a trade mark on the internet or any other computer network without authority or right and for the purpose of interfering with the use by the owner. Upon conviction, the person is liable to imprisonment for a term of not more than two years or a fine of not more than NGN5 million (approximately USD13,200) or both fine and imprisonment.

### 10.9 If so, who can pursue a criminal prosecution?

The Police and the Attorney-General of either the Federation or a State is empowered to prosecute criminal offences. The Attorney General can also give a fiat to a private person to prosecute offenders on his behalf.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no specific provisions for unauthorised threats of trade mark infringement in Nigeria. However, lawsuits can be commenced to restrain such conduct and prevent the occurrence of an infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following are the grounds of defence that can be raised by way of non-infringement to a claim of trade mark infringement:

- The trade mark said to have been infringed has not been registered.
- The use of the trade mark was within the context of the conditions and limitations of which the trade mark said to be infringed had been registered and did not extend to the rights conferred on the registered trade mark.
- The trade mark is a registered trade mark and is one of two or more registered trade marks that are identical or nearly resemble each other which its use does not constitute an infringement of the right to the use of any other trade mark.
- The user of the trade mark or its predecessor in title has used the trade mark from a date prior to the registered trade mark said to be infringed.
- *Bona fide* use by a person of his or her predecessor's name, or his or her predecessor's place of business.
- Use by any person of a *bona fide* description of the character or the quality of his goods.
- The use of the trade mark is not likely to deceive or cause confusion.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The following are the grounds of defence that can be raised in addition to non-infringement:

- honest concurrent use;
- non-use or abandonment of the trade mark by the proprietor;
- continuous prior use;
- *bona fide* use of a name; or
- permitted use by a licensee.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available for trade mark infringement:

- Damages – punitive, special and general damages.
- Injunctive reliefs – interlocutory, interim and perpetual.
- Order for account of profits to recover all the profits made from the unauthorised use of the trade mark.
- Delivery up of infringing products.
- Payment of legal costs.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, costs may be recoverable from the losing party, although this lies with the discretion of the court. However, regarding specific costs, for example, legal fees may be recoverable if it can be proven.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A judgment of the Federal High Court can be appealed to the Court of Appeal at first instance, and further to the Supreme Court. The right of appeal from the first instance judgment is as of right and can be on point of law, facts or mixed law and facts.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be adduced at the appeal stage with the leave of court on special grounds. Such evidence must be that which with due diligence could not have been obtained at the trial stage and such evidence would be one that would have a significant effect on the case.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, there are mechanisms for seizing and preventing the importation of infringing goods or services into the country. In 2014, the Nigeria Customs Service (“NCS”) created an IP rights unit (IP enforcement agency). Where the NCS suspects, on reasonable grounds, that some goods are counterfeit goods, the NCS can seize the IP infringing goods and in which case, the infringer would forfeit the goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The Trademarks Act recognises the rights of the owner of an unregistered trade mark to sue for passing off of its goods and also to obtain other remedies. However, an unregistered trade mark owner cannot sue for the infringement of an unregistered trade mark under the Trademarks Act.

### 15.2 To what extent does a company name offer protection from use by a third party?

The Companies and Allied Matters Act, 2020 clearly prohibits the registration of names of companies that are similar names. No company shall be registered by a name or trade mark which is identical with the name by which another company in existence is already registered or so nearly resembles that name as to be calculated to deceive, except the company with the said name is in the process of being dissolved and signals its approval for the use of its name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no specific laws or judicial pronouncements on whether a book title or film title rights confer IP protection. One may argue, however, that book titles and film title rights

may come under the definition of “mark” in the Trademarks Act. One may also argue that a book title or film title may have become distinctive/acquired distinctiveness through use or where a mark acquires unique significance over time due to the trade mark owner’s usage in commerce and the public has come to associate the trade mark with the source.

## 16 Domain Names

### 16.1 Who can own a domain name?

By the Nigerian Internet Registration Association (“NIRA”) General Registration Policy, any Nigerian citizen who has attained the age of majority, which is 18 years, a permanent resident in Nigeria as recognised by law, a legal representative of a Nigerian citizen or permanent resident, a company, a registered group, a trade union, a government institution, an educational institution, and a registered trade mark can own a domain name in Nigeria.

### 16.2 How is a domain name registered?

Any person eligible to own a domain name (as provided in question 16.1) shall conduct a domain name search within NIRA’s “WHOIS” look-up system. The applicant will be required to select a registrar certified by NIRA who will, on behalf of the applicant, submit an application for the registration of the domain name to NIRA (the Registration Application). The applicant shall further furnish the registrar with all information relevant to the Registration Application for the registrar’s onward transmission to NIRA.

NIRA will validate the applicant’s Registration Application using set criteria and any decision on the acceptance or rejection of the Registration Application shall be communicated to the registrar by email. If the Registration Application is not rejected by NIRA, NIRA shall proceed to process it. If the Registration Application is ultimately successful, NIRA shall accordingly advise the registrar. An applicant who is registering a domain name must accept to be bound by NIRA’s policies, rules and procedures. The applicant shall also be required to confirm, electronically, the endorsement of the NIRA Registrant Agreement.

### 16.3 What protection does a domain name afford *per se*?

A domain name protects against unauthorised use (including similar or identical domain names) by third parties.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

.ng is the internet country code top-level domain (“ccTLD”) for Nigeria.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there is a mechanism for the resolution of ccTLD-related disputes. The NIRA Dispute Resolution Policy spells out the procedures for the resolution of ccTLD disputes from start to finish, including the procedures for an appeal. NIRA is responsible for these procedures.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

In the last year, more trade marks journals have been published signifying major public awareness regarding the protection of their intellectual property rights. In January 2020, the WIPO Nigeria Office was established in Abuja with core objectives of promoting awareness, raising, training and capacity building in the field of Intellectual Property.

To further ease the process registration of trade marks, new features have been introduced to the IPO Nigeria website, though this is yet to be tested) including uploading court judgments, filing appeals as well as obtaining Acceptance Letters.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Please see below for the three important trade mark judgments over the last 18 months:

- *D & S Trading Company Limited vs. Remia C.V et. al.* (2019) LPELR -47628 (“CA”), where the Court of Appeal held that the registration of a generic name cannot claim distinctiveness or exclusivity and that while mere application does not confer proprietary right, the Acceptance Letter is a loud statement to the effect that the applicant has satisfied the entire requirement of registration and is only awaiting administrative issues outside its control for the Certificate to be issued.
- *Piaggio C.S.P.A. vs. Autobahn Techniques Limited & Registrar of Trade marks.* FHC/L/CS/1307/12. Although this decision was delivered by the Federal High Court in 2017, it is important in the trade marks space. The Federal High Court held that sales of a product by a licensee or a distributor does not confer any goodwill in the trade mark on the licensee or distributor.
- *Toyota Motor Corporation vs. Subaya Metalware Nigeria Ltd. & Anor-CA/1003/2016.* The Court of Appeal held that mere filing of a trade mark application before the Trademarks Registry, does not constitute “use” or infringement of an “existing” trade mark.

### 17.3 Are there any significant developments expected in the next year?

The significant developments expected will be the rejuvenation of efforts geared towards ensuring that the Industrial Property Commission Bill (“IPCOM Bill”) and Trademark Bill (the “Bills”), two proposed legislations currently awaiting passage into law by Nigeria’s National Assembly, are eventually passed into law.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There have been no enforcement trends different from the usual ones. Both registered and unregistered owners of trade marks have always deployed the use of cease-and-desist letters, the use of the symbol “TM” to notify the public of the existence of a trade mark and also the use of opposition proceedings to fight the regulation of potential infringing marks.



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