



MY INTELLECTUAL PROPERTY LAW GUIDE

Emerging Trends and Trademark Protection in Nigeria

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What is Trademark and Trademark Protection?

A trademark is a distinctive phrase, word, symbol, logo, picture attached to goods used to distinguish a business merchandise, while Trademark protection refers to safeguarding intellectual property rights (specifically a trademark) from counterfeiting and infringement.

In Nigeria, for a sign to qualify as trademark, such symbol, sign, logo or picture must be such that distinguishes the goods in the course of trade in relation to which it is used from the goods of another in the same class. In essence, if it is not **distinctive**, it cannot be a trademark.

How are Trademarks protected in Nigeria?



Trademarks can be protected by registration under the Trade Marks Act (TMA) and being placed on the Register of Trademarks.



Registration under the TMA can be under Part A or B of the Trademarks Register.



To qualify for registration under Part A, such mark must **inherently distinguish** the goods in relation to which it is used in the course of trade from the goods of another in the course of trade.



To qualify for registration under Part B, such mark must not inherently distinguish the goods, but it must be such that is **capable of distinguishing** the goods in relation to which it is used.



Notwithstanding registration in Part A, a trademark can still be registered in Part B.



Prepare a power of attorney authorizing an agent to register the mark on your behalf



Conduct of pre-registration search to determine the availability of the trademark to be registered



Submit an application for registration of mark. The application should be addressed to the Registrar of Trademarks and accompanied by a representation of your mark. Where the mark contains words in any language other than English language, such words must be translated.



Complete the application for registration indicating the Part under which it would be registered



An acknowledgement is issued by the Registry confirming receipt of the application and a temporary registration number is issued to the trademark pending the allocation of a permanent registration number

Procedure for registration of trademarks in Nigeria

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- ▶ Upon issuance of the acknowledgement, the registry embarks on an examination of the mark to confirm that there are no conflicting trademarks already registered. In addition, the mark is considered to determine its distinctiveness and to determine if it is scandalous, deceptive or contains any prohibited words (names of single chemical substances, arms of Nigeria, national flag, president, governor, arms of states, towns, society, names of living persons or persons recently dead)
- ▶ Upon satisfaction that the mark is qualified to be registered, an Acceptance Form will be issued. This is usually within 3 weeks after the issuance of the Acknowledgement. If the mark is not qualified, a Refusal Form is issued.
- ▶ Publication of the mark on the Trademark Journal is done upon acceptance and it is usually within 12 -18 months of acceptance. This is an invite to the public to object to the registration of the mark.

Procedure for registration of trademarks in Nigeria

- ▶ Where there are no objections or where objections are resolved in favour of the applicant, the Registrar will issue a Certificate of Registration.
- ▶ Once a trademark is registered, its protection begins retrospectively from the date on which the application for registration was brought. This entitles the applicant to bring an action for infringement which occurred during the period before issuance of the certificate. The 7 years validity period for trademark also begins from the date of application. A trademark can however be renewed from time to time for a period of 14 years.

▶ Trademarks can be protected outside the country of registration and to achieve this, various conventions have been made to ensure protection of trademarks among countries.

▶ The conventions include:

▶ The Paris Convention

▶ The Paris Convention on the Protection of Industrial Property 1883, (the Paris Convention) as amended is an international treaty concerning the protection of intellectual property that has been adopted by 177 countries. The convention provides uniform rights of protection and enforcement for nationals of member states of the union in other member states as such later member state would afford its citizens.

Can Trademarks be protected outside Nigeria?

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- ▶ The Madrid Agreement and Protocol
- ▶ The Madrid Agreement Concerning the International Registration of Marks 1891 (as variously amended) and its Protocol, the Madrid Protocol is made for the international registration of trademarks simultaneously in a large number of jurisdictions. It seeks to harmonize the process of registering and enforcing trademarks against infringements across borders.
- ▶ Although Nigeria has not acceded to the Madrid Agreement or protocol, article 2 of the Protocol adopted countries under the Paris Convention. Nigeria being a member of the Paris Convention comes under the purview of the Madrid Agreement and Protocol.

Can Trademarks be protected outside Nigeria?

TRIPS Agreement

The Agreement on the Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) in 1994 by the state parties to World Trade Organization (WTO). The effect of the TRIPS Agreement was to consolidate the globalization of intellectual property as an integral part of the international commercial regime. By express mention, TRIPS incorporated the Paris Convention on the Protection of Industrial Property 1883, (the Paris Convention) as amended, which had long made provisions, albeit somewhat onerous, for cross-border intellectual property protection.

The implication of the above protocols is to provide a uniform acceptable means of protecting trademarks across borders. Each of these conventions and protocols have basic requirements to assure protection.

Commercialisation of Trademarks

Trademarks are an essential intellectual property right in a business enterprise or going concern which can be licensed via a franchise agreement. In a Franchise agreement, the franchisor usually licenses the use of its trademark to a franchisee that in turn pays a fee or royalty for such use. Examples of some popular franchise brands in Nigeria include: Chicken Republic, Domino Pizza, Debonairs Pizza, Kentucky Fried Chicken (KFC), Coldstone creamery, Slot, Mr. Biggs, Tantalizers etc.

The franchise agreement should contain certain obligations required of the franchisee while utilizing the trademark and brand name of the franchise. The obligations could entail in addition to the franchisor acknowledging ownership of the Franchise trademark by the franchisor, that all products distributed by the franchisee be sourced from a verifiable third-party or the franchisor itself, and that any unauthorized use or modification of the trademark or the sale of third-party goods (under the franchise brand) without prior written approval of the franchisor, may result in the repudiation of the franchise agreement

Commercialisation of Trademarks

Also, it is important that the Franchisor obtains legal protection for the trademark of its franchise in the jurisdiction of the franchisee since trademark registrations are territorial in nature with the exceptions of some regional registration bodies. Registration will give the franchisor exclusive rights and protection of its trademark in the jurisdiction of the franchisee. However, apart from the registration of the franchisor's trademark in Nigeria, there is a need for the franchisor to grant a right of use (i.e., a license) to the franchisee to use its brand name in Nigeria and such license must be recorded at the Nigerian Trade Mark Registry to avoid objections by interested parties seeking a declaration of abandonment for non-use.

What is new with Trademarks?

With the advancement in technology, change is expected to occur in the legal sphere in diverse ways, trademark law and practice would also be affecting in several ways by the following;

- **The use of Artificial Intelligence**

This will affect trademark practice, notably in a due diligence and transactional IP context, where large amounts of material must be reviewed quickly. AI is used in **trademark clearance searches** by some services, notably when it comes to the comparison of logos and similarity levels, including conceptual similarity

If the Trademark registry were to deploy the use of AI, it would reduce the length of time for examination by the registry to determine whether a trademark can be registered or not. The ripple effect would be a reduced length of time for the whole process.

What is new with Trademarks?

On 1 April 2019 World Intellectual Property Organization(WIPO) launched its state of the art AI based search tool for brands which improves on earlier-generation image search tools. It primarily determines trademark image similarity by identifying shapes and colors in marks.

This technology uses deep machine learning to identify combinations of concepts - such as an apple, an eagle, a tree, a crown, a car, a star - within an image to find similar marks that have previously been registered.

The commercial implication is that brands who want to expand and register a new trademark can strategically plan because AI would have sorted out the marks with similarity before their marks are designed.

For the registry, it save labour cost for trademark examiners. The challenge is that the current trademark law does not envisage finding of trademark that is independent of human intervention. This would have to change.

What is new with Trademarks?

- **Blockchain Technology**

Blockchain technology creates a date-stamped, trustworthy and transparent record by allowing multiple parties to a transaction to verify what will be entered onto a ledger in advance without any single party having the ability to later change any ledger entries.

In terms of trademarks, it could be used in the following ways

- record keeping: providing an immutable, secure, timestamped record of the creation of IP

Not only would this be an immutable record, but it would also resolve the practicalities of collating, storing and providing such evidence. This could be particularly helpful in those cases where proof of first or genuine use is required or where the extent of use is crucial, such as in disputes or other proceedings involving recognition of well known marks, or defending a non-use revocation action.

What is new with Trademarks?

- to provide evidence of first use in commerce/trade and/or (genuine) use of a trademark

This is already being used in china. The Chinese Supreme People's Court' issued a judicial interpretation on the hearing of cases by the country's newly created internet courts which allows, inter alia, for evidence which is stored and verified on blockchain platforms to be used in legal disputes.

China's Hangzhou Internet Court in in a July 2018 decision accepted blockchain-based evidence in an online copyright infringement case on the premise that the technical verification was consistent and other evidence could be mutually verified.

What is new with Trademarks?

The obvious challenge in the use of blockchain evidence is that the process of adducing Computer generated evidence in Nigeria may make the use of block chain evidence impossible unless the law is amended. The use of block chain evidence as it currently stands under our laws will require the production of [.] from every person who imputed the data which forms the blockchain evidence.

- to register and clear trademarks or other IP rights
- to control and track the distribution of (un-)registered trademarks or IP rights
- digital rights management to transmit payments in realtime to IP owners- payment between licensee and licensor of a trademark. Etc.
- for authentication: detection of counterfeit or fake goods

What is new with Trademarks?

- **Registration of Scents**

It is indeed a registration of scents. The first ever registration has been done in Mexico. The Mexican Trademark law was recently amended to allow for non-traditional trademarks registration such as scent. Many challenges are already raised by this especially as regards the description of the scent.

Perhaps in the near future Nigeria would amend its laws to recognize the registration of scents. Prior to such a time, the current challenges of the trademark regime must have been addressed for such a task to be undertaken.

Trending issues in the Nigerian Trademark Space

The Industrial Property Commission Bill (IPCOM) and the Trademark Bill are currently being considered by the legislature, they have passed both first and second reading.

The bills propose the following:

- The IPCOM bill proposes the establishment of an Industrial Property Commission which would have the responsibility of administering the relevant industrial property laws.
- To repeal the current Trademark Act
- To harmonize the current law in tandem with international best practices
- To provide for exotic forms of trademarks, associated trade marks etc.

Trending issues in the Nigerian Trademark Space

- The TM bill proposes the registration of trademarks as a series. It provides for the extension of the validity period to 10 years and renewable for another 10 years.
- To provide regulations that recognize and protect international trademarks under the Madrid Protocol
- TM bill provides for increased protection of famous trademarks by allowing proprietors seeks injunctions to prevent possible infringement. It also provides for more stringent punishment for infringement.

THANK YOU