

## IP MANAGEMENT IN NIGERIA: TRADEMARKS & DESIGNS

The aim of this article is to inform practitioners and IP owners the possibilities available to them for the protection of trademarks and registered designs in Nigeria.

In Nigeria, Intellectual Property Rights is governed by the Trademarks Act Cap. 436 Laws of the Federation of Nigeria, the Patents and Designs Act Cap. 344 Laws of the Federation of Nigeria 1990 and the Copyright Law Cap. 68 Laws of the Federation of Nigeria 1990. respectively.

For the purposes of this article the requirements of the Trademark and the Patent and Designs Act in relation to trademarks and designs respectively shall be examined.

The Trademarks, Patents and Designs laws are currently implemented by the Trademarks, Patents and Designs Registry under the Federal Ministry of Commerce.

Between 1972 and 2000, 12,707 Trademarks, 6,099 Patents and 4,343 Industrial Designs were registered. Out of the 12,707 Trademarks registered from 1975 to 2000, 8,874 were foreign while 3,843 were domestic. As for Patents, out of the total of 6,099 registered between 1980 and 2000, 5,752 were conventional (foreign) and 347 were non-conventional (local).

The industrial designs on the other hand were categorized into textiles and nontextiles and out of the 4,318 registered from 1972 to 2000, 1,419 were textiles while 2,924 were non - textiles.

## **Trademarks**

Legal basis for the protection of trademarks in Nigeria is the Trademarks Act Cap 436 Laws of the Federation 1990, and the trademark rules of 1967.

Nigeria is a member of the Paris union. We have not yet published a convention countries order concerning Trademarks in the Federal Gazette, as a result of which it is not possible to claim convention priority.

Trademarks applications are accepted from the manufacturer or trading agent, provided he has the

permission of the proprietor, an individual, a firm or a corporation.

The word "mark" is defined by the Act as including "a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof"

Colours may be limited in whole or in part to one or more specified colours and the fact that it is limited is to be taken into consideration by any tribunal having to decide on the distinct character of the trademark.

The International Classification of Goods is used for the registration of trademarks in Nigeria.

Collective, Defensive, Series marks can be registered.

Service marks cannot yet be registered.

Examination of the application is strictly as to registrability, once accepted the application is published in the trademark journal. If the application is refused, the applicant has a right to attend a hearing before the registrar presenting additional evidence as to why his application be granted.

In the event that there is a dispute as to ownership, after publication, the process originates from an

opposition proceeding before the registrar, evidence in the form of statutory declaration is admissible. Appeal lies to the Federal High Court, the Court of appeal and the Supreme Court respectively.

The trademark is valid for 7 years from the date of application, renewable for further periods of 14 years.

It is possible to renew three months prior to expiry date.

Duration of application process, varies due to frequent delays, it could take anything from 2-3 years to obtain registration from date of filing the application.

The proprietor of a registered trademark is given power under the Act to bring an Action in the Federal High court against anyone to prevent and to recover damages for the infringement of the registered trademark.

The common law of passing off is also available to him. Criminal proceedings may also be brought against an infringer of a registered trademark under the Merchandise Act Cap 117 provided he prosecutes the infringer before the expiration of three years after the commission of the offence or one year after the discovery thereof whichever expiration happens first.

The trademark Act provides for a licence which may be either with or without conditions or restrictions, it is recommended that all licences, granted in respect of registered trademarks be registered as user by such registered licences.

Use by the registered licensees is deemed by the Act to be use by the registered proprietor when the question of use of the registered trademark comes into question.

It is possible to assign the trademark with or without goodwill.

It is necessary to note that a trademark may be taken off the register in any of the following circumstances:

- i) non use, on the request of any person concerned, if it can be established that the mark was registered without any bona fide intention to use, and there has in fact been bona fide use of the trademark;
- ii) it may be removed for non use during a continuous period of at least five years during which the trademark was registered.
- iii) If the entry has been made in the register without sufficient cause.
- iv) If an entry remains wrongly on the register
- v) Non compliance to the registrar's statutory notice to renew by the registered proprietor.

The legal basis for the protection of industrial designs is contained in the Patent and designs act Cap 344 of the LOFN and the Design rules.

The creator or his assignee may apply for the registration of the design, through his agent.

What qualifies as a design?

The Act states that any combination of lines or colour or both, and any three dimensional form, whether or not associated with colours is an industrial design, provided it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is intended solely to obtain a technical result.

It is possible to apply for up to fifty designs if the products are the same kind. Reliance on convention priority must be claimed at filing, whilst the priority documents need to be filed three months after filing the application.

It is a requirement that the design be novel.

It is also possible for an application to be filed under sealed cover for a period of 12 months from the date of the application under the Act.

There is currently no formal examination of design applications. Once the documents required are complete and in order the registrar proceeds to issue a certificate of registration.

The registration of an industrial design is effective for the first 5 years, renewable for a further period of 5

year, upon the payment of the prescribed fees. The renewal fees must be paid within the 12 months immediately preceding the renewal period.

A six month grace period operates after the beginning of the renewal period.

It is possible for the court to nullify the registration of an industrial design if among other things the design because of its failure to conform to the requirements, ought not to have been registered.

The rights of a design owner are infringed where another person without prior licence of the right owner does or causes the doing of any act which that other person is precluded from doing.

This is a brief introduction to the general requirements for the protection of trademarks and designs in Nigeria.