

THE GROWING NECESSITY FOR THE PROTECTION FOR SERVICE MARKS IN NIGERIA

Are Service Marks registrable currently registrable in Nigeria?

Most trademark law practitioners in Nigeria must have come across this particular question numerous times in the course of their practice lives. .

In over 10 years of practising Trade Mark Law in Nigeria, we have encountered this question at least once or twice a week from both local and international owners of trade and service marks seeking protection under the laws of industrial property, in particular trademark law.

- ❖ What is a service mark?
- ❖ Why should it be protected in Nigeria?
- ❖ Who will benefit from the protection?
- ❖ What do we stand to lose as a nation, as consumers and as practitioners if service marks continue not to be protected in Nigeria ?

This article shall attempt to answer these and other questions in the course of this article.

In doing so, May I suggest that we proceed from our knowledge of industrial property law, particularly our knowledge of trade mark law because a service mark is similar in all respect to a trade mark.

The function of a trade mark as denoting the source of a product was well known before the introduction of registration by the colonial government.

To illustrate, local manufacturers such as weavers, blacksmiths, pot makers, have for a very long time used 'signs' to identify their products and distinguish them from similar products of other manufacturers. It is not uncommon for purchasers of such utensils as knives, hoes cutlasses etc to look for products of particular manufacturers at market places by looking for their 'signs' on products on display in the markets.

These signs are sometimes placed conspicuously and sometimes hidden, but they perform the same function, namely, to identify the

manufacturer and to distinguish his products from those of other manufacturers.

With this background knowledge, I proceed to the statutory definition of a trade mark which I take from section 67 of the Trade Marks Act Cap 436 Laws of Nigeria as follows:

“trademark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act;”..

In essence, a trademark is used to tell purchasers of goods that those goods are connected with and come from a particular manufacturer.

The function of a service mark is similar to that of a trade mark, namely identifying the provider of certain services and distinguishing such service from the service provided by others in the industry.

While a trade mark relates to products, service marks relate to services. Manufacturers, sellers and distributors of products use trade marks while providers of services use service marks.

As the law stands in Nigeria, today we do not have a definition for what qualifies for protection as a service mark, because there is no protection expressly provided for the registration of service marks in the current Trade Mark law.

I shall therefore look for the definition of a service mark outside our laws. First, let me refer to **Black’s Law Dictionary (6th ed)** which defines a service mark as

“A mark used in the sale of advertising of services of one person and distinguishing them from the services of others “

The term service mark means any word, name, symbol or device, or any combination thereof

(1) used by a person, or

- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by the Trademark Act, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

The other source of my definition of a **trade mark** is the statutory definition of the term by the U.K. Trade Marks Act 1994 as amended.. By section 1(1) a trademark is defined as follows, "

"A trademark means any sign capable of being represented graphically, which is capable of distinguishing goods or **services of one undertaking from those of other undertakings**"

A service mark therefore is similar to a trademark, but it is used in the sale or advertising of services to identify and distinguish the services of one company from those of others.

There are many commercial entities that provide various services in Nigeria today. Many of whom use distinctive "signs" to distinguish their services from those of others.

Two prominent local examples will suffice for the purpose of this article.

The capital letter **B** in blue colour found on heavy vehicles denote that such vehicles belong to one and only one company, JULIUS BERGER which provides services in the construction industry in Nigeria.

Similarly the **WHITE STALLION** on vehicles, cheque books and buildings belongs to the Union Bank of Nigeria Plc which provides banking services in Nigeria.

With the advent of the Internet the world is rapidly shrinking, it is therefore necessary for Nigeria to move with the tide of globalization and uniformity of protection for this important aspect of trademark law.

Our laws for the registration of trade marks which I referred to earlier are not up to date and are therefore not adequate for modern day development.

Our current Trademark Act was enacted in 1967 based on the U.K Trademark Act of 1938.

That U. K Act made no provision for the registration of service marks, because of this and other inadequacies, the U K amended the 1938 Act in 1984 to accommodate the registration of service marks. This was further amended in 1994 to bring the UK up to par with the European Union.

Today service marks are registrable in the United Kingdom but we are still saddled with the 1938 Act which makes no provision for the registration of service marks.

We need to be able to afford both the local and foreign business person/entity the confidence and opportunity to have their trade and service marks registered and protected in Nigeria.

Let me refer to the anomaly created by not bringing our law up to date.

Nigeria is a member of the Paris Union. However, it has not yet published a Convention Countries Order concerning Trade Marks in the federal gazette as a result of which it is not possible, to claim convention priority.

Nigeria as a member of the World Trade Organization (WTO) is a signatory to the TRIPs Agreement (Trade-Related Aspects of Intellectual Property Rights).

The agreement amongst other things, defines what types of signs must be eligible for protection as trademarks, and what the minimum rights conferred on their owners must be. It says that service marks must be protected in the same way as trademarks used for goods. Marks that have become well-known in a particular country enjoy additional protection

The basic rule contained in **Article 15 of the agreement** is that any sign, or any combination of signs, capable of distinguishing the **goods and services of** one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually perceptible. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, must be eligible for registration as trademarks.

The Agreement requires service marks to be protected in the same way as marks distinguishing goods (see e.g. Articles 15.1, 16.2 and 62.3).

Another relevant case in hand is the Nice Classification which is based on a multilateral treaty administered by WIPO. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, which was concluded in 1957.

This Classification is commonly referred to as the Nice Classification. The Nice Agreement is open to States party to the Paris Convention for the Protection of Industrial Property, of which Nigeria is a party, although we had signed the agreement in 1963, we have not acceded to it nor has it been ratified in 2005.

While we use the classification for goods in our trade mark legislation, we have no provision in our law for the classification of services.

The Nice Classification comprises the Class Headings accompanied by Explanatory Notes and an Alphabetical List of Goods and Services, with the class in which each product or service is placed.

The *Class Headings* describe in very broad terms the nature of the goods or services contained in each of the 34 classes of goods and 11 classes of services.

This list of goods and services comprises about 10,000 indications referring to goods and 1,000 indications referring to service, as indicated below:

**Nice classification of goods and services (8th edition) –
Headings SERVICES**

Class 35

Advertising; business management; business administration; office functions.

Class 36

Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37

Building construction; repair; installation services.

Class 38

Telecommunications.

Class 39

Transport; packaging and storage of goods; travel arrangement.

Class 40

Treatment of materials.

Class 41

Education; providing of training; entertainment; sporting and cultural activities.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

Class 43

Services for providing food and drink; temporary accommodation.

Class 44

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

Class 45

Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

These are the type of services which are currently not being protected by the Nigerian Trademark Laws.

The amendment of our current laws will provide for the addition of 11 classes to the current classification of Goods in use in Nigeria, and provide for the protection of up to 1000 difference service industries which are currently excluded.

Nigeria, like several other developing nations, is facing new developments and challenges in the process of strengthening its intellectual property system, as a result of rapid globalization which is currently the order of the day.

It is worth mentioning here that on the 8th of May 2005 Nigeria acceded to the PCT (**Patent Cooperation Treaty**)

The Treaty makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an "international" patent application.

Such an application may be filed by anyone who is a national or resident of a Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva.

If the applicant is a national or resident of a Contracting State which is party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the revised Bangui Agreement Relating to the Creation of an African Intellectual Property Organization or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Industrial Property Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

It should be noted that International treaties and Agreements signed by the government will only be binding after local legislation is made incorporating such treaties and agreements.

The practice here is that once it is notified that the government has signed a treaty, the international community assumes that it has the force of law and begins to act thereon.

Practitioners are placed in the awkward situation years after the signing of such treaties; they are unable to effect these treaties as our laws would not have been amended to accommodate the requirements.

To compound the situation, civil servants within the relevant departments in the Ministry's concerned, immediately after Nigeria's signing begin to act on such treaties as if they were binding laws in Nigeria.

In the spirit of moving along with International standards of Intellectual Property protection regimes, it is submitted with due respect that the time is now for service marks to be protected.

It is also suggested that government should endeavour to ensure that local laws are enacted incorporating signed treaties immediately after signature

Who will benefit from the protection of Service marks?

The consuming public, Industry such as Banking, Information Technology, food and beverage manufacturers, textile manufacturers, construction industry, health care providers, the trademark registry ultimately the economy of the country.

In the African continent, as at March 2005, 39 countries, all the ARIPO AND OAPI countries provide for the protection of service marks, through Registration.

There are currently **Six countries (6)** which do not provide for the protection of service marks in their trademark laws, they are:

- Gambia
- Malawi
- **Nigeria**
- Sierra Leone
- Uganda
- Zambia

What is the way forward?

In the first instance an amendment to our current trademark laws, to provide for the registration of service marks.

Ultimately, a complete overhaul of the industrial property law regime, (trademarks, patents and designs inclusive) to bring Nigeria up to date with the rest of the world.

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