

# NEWS LETTER



## Lets talk Trademark Registration in Nigeria

### 1.1. Introduction

*Hello Entrepreneurs! You guys always talk about brand recognition and brand identity, Well let's talk trademark.*

*A trademark is a distinctive sign that identifies a product or service and distinguishes it from those of other producers. It could be a word, phrase, symbol, or design, or a combination of these elements.*

Trademarks are an invaluable resource for businesses both MSME'S and Large companies as they distinguish the source of products and services.

In Nigeria, trademarks are regulated by the **Nigerian Trademarks Act**, which provides the framework for registration of trademarks, service marks, collective marks and other related matters.

***Trademark registration is a legal process by which a business can acquire exclusive rights to use a particular mark for its goods or services.***

This publication will provide a detailed overview of trademark registration in Nigeria, including the advantages and benefits of having a trademark, the difference between trademark and company registration, steps to trademark registration, trademark searches, filing, acknowledgment, acceptance, publication, renewal of trademarks, remedies available for trademark infringement, and some notable cases of trademark infringement in Nigeria and around the world.

## **2.1. Benefits of Trademark Registration in Nigeria**

The benefits that accrue to a business that registers its trademark in Nigeria are immense and far reaching. Here are some enhanced benefits (that) a trademark registration provides to a business:

**Exclusive rights:** Registration of a trademark in Nigeria confers exclusivity on the owner to use the trademarking in relation to the goods or services for which it is registered.

**Legal protection:** By registering a trademark in Nigeria, a business protects its brand identity and reputation against infringement by third parties. In cases of infringement, trademark owner can sue for damages and obtain injunctive relief to prevent others from using the mark.

**Brand recognition:** We can easily identify our favorite brands because of their distinct marks. A registered trademark can help a business build brand recognition and loyalty among its customers.

**Licensing and franchising:** If you're lover of football you would know the **CR7** brand or must have heard of the sneakers brand '**AirJordans**'. A registered trademark can be licensed or franchised, allowing other businesses to use your brand in exchange for royalties or fees.

**Increased value:** Let's imagine the **GUCCI AND LOUIS VUITTON** brands, trademark can increase the value of your business, making it more attractive to investors and potential buyers.

**Asset value:** We have seen this happen severally in the world of sports and entertainment, where registered trademarks of athletes and artistes sell or license there marks to other businesses.

### 3.1. Requirements for Trademark Registration in Nigeria

The Nigerian Trademarks, Patents, and Designs Registry, a department of the Federal Ministry of Industry, Trade, and Investment, handles trademark registration in Nigeria. The following conditions must be completed in order to register a trademark in Nigeria:

- **A completed application form:** An application for trademark registration in Nigeria must be made on the prescribed form, which can be obtained from the Nigerian Trademarks, Patents and Designs Registry.
- **A clear depiction of the trademark:** A clear representation of the trademark sought to be registered must be included in the application.
- **A description of the goods or services:** The application must include a description of the goods or services for which the trademark will be used.
- **Payment of the prescribed fees:** The applicant must pay the prescribed fees for trademark registration in Nigeria.
- **Power of Attorney:** The applicant must provide a power of attorney if the application is being filed by an agent.

### 4.1. Classes of Trademark in Nigeria

Trademarks are categorized into different classes based on the goods or services they represent. The classes are established under the Nice Classification system, which is an international classification of goods and services for the registration of trademarks. In Nigerian law, there are 45 classes of trademark registration. Classes 1–34 cover items regarded as goods, while Classes 35–45 are exclusively for service-based businesses.

- **Conducting Trademark Searches:** When conducting a trademark search, it's essential to search within the specific class or classes relevant to the goods or services associated with the proposed trademark. This ensures that the search results are relevant and comprehensive within the intended scope of the mark.
- **Registration in Multiple Classes:** Applicants can register their trademarks in one or more classes depending on the goods or services they offer. Each class requires a separate application and registration process.
- **Avoiding Conflicts:** Conducting a thorough trademark search within the relevant classes helps identify potential conflicts with existing trademarks. If a similar or identical trademark is found within the same class, it could lead to objections or refusals during the registration process.

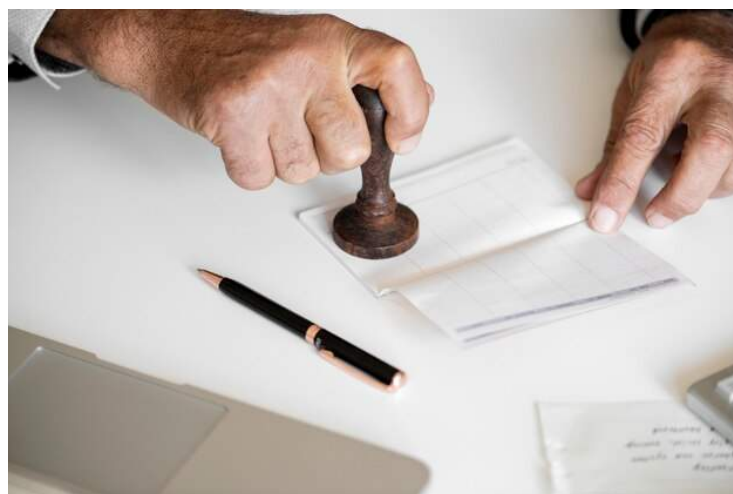


## 5.1. Trademark Registration Process:

The process of trademark registration varies by jurisdiction, but generally, it involves the following steps:

- **Conduct a search:** Before applying for a trademark, it's essential to search within the specific class or classes relevant to the goods or services associated with the proposed trademark. This ensures that the search results are relevant and comprehensive within the intended scope of the mark. This search can be conducted through various online databases or by hiring a trade mark attorney.
- **File an application:** Once the search has been conducted, the business can file a trademark application with Nigerian Trademarks, Patents and Designs Registry.
- **Acknowledgment:** The Nigerian Trademarks, Patents and Designs Registry will issue an acknowledgment of the application within two months.
- **Examination:** After the application is filed, it will be examined by a trademark examiner to ensure that it meets the requirements for registration. If the application is rejected, the applicant may have an opportunity to respond to the examiner's objections.
- **Acceptance:** If the application is accepted, the Nigerian Trademark Office will issue an acceptance certificate.

- **Publication:** After the application is approved, the acceptance certificate will be published in the official gazette i.e Nigerian Trademarks Journal to allow other parties to oppose the registration.
- **Objections:** Third parties who are opposing to the said mark are given two months to file an application objecting to the registration of the trademark.
- **Registration:** If no opposition is filed, or if the opposition is unsuccessful, the mark will be registered, and the business will receive a certificate of registration.



### 5.1. What happens if the trademark objection succeeds

If a trademark objection succeeds, it typically means that the objection raised against the trademark application has been upheld by the relevant authority responsible for trademark registration, such as the trademark office in a particular jurisdiction. Here are some common outcomes that might result from a successful trademark objection:

- **Refusal of Trademark Registration:** If the objection is upheld, the trademark application may be refused, meaning that the mark will not be registered.

This could be due to various reasons such as similarity to existing trademarks, lack of distinctiveness, poor descriptive nature of the mark, or violation of certain legal provisions.

- **Amendment or Modification:** In some cases, the applicant might be given an opportunity to amend or modify the trademark application to address the concerns raised in the objection. This could involve altering the mark itself, its description, or other elements of the application.
- **Appeal or Review:** Depending on the jurisdiction, the applicant may have the option to appeal the decision or request a review of the objection. This process typically involves presenting arguments and evidence to support the registration of the trademark despite the objections raised.
- **Opposition Proceedings:** If the objection is raised by a third party, such as a competitor or another trademark owner, it might lead to formal opposition proceedings. In such cases, both parties have the opportunity to present their argument and evidence before a decision is made on whether the trademark should be registered.
- **Abandonment or Withdrawal:** If the applicant decides not to pursue the trademark application further or fails to respond to the objection within the specified timeframe, the application may be deemed abandoned or withdrawn.

- **Legal Action:** In some cases, a successful trademark objection may lead to legal action if there are disputes over the ownership or use of the trademark. This could involve litigation to resolve the matter in court.

## 6.1. Renewal Of Trademarks

The tenure for trademark registration in Nigeria is for an initial period of (7)seven years, after which it can be renewed for an additional period of (14)fourteen years. The renewal process involves filing an application for renewal with the Nigerian trademarks, patents, and designs registry and investment and paying the prescribed renewal fee.

## 7.1. Difference Between Trademark And Registration Of Your Company

Lets look at it this way, a company registration provides the needed legal permit to operate and run a business in Nigeria and in most cases, it gives the business a legal persona separate from the owners. On the other hand, a trademark registration protects your brand identity.

**N/E:** Registering a company does not provide any legal protection for your brand and it is possible for other businesses to use a similar name or logo.

## 8.1. Rights Conferred on Trademark Owners

Here are some of the Rights and Privileges that trademark registration confers on the owner:

- The exclusive right to use the trademark in relation to the goods or services for which it is registered.
- The right to take legal action against any person who infringes on the trademark.
- The right to prevent others from using a trademark that is identical or similar to the registered trademark in relation to similar goods or services.

## 9.1. Remedies Available For Trademark Infringement

When can we say a trademark infringement has occurred? Basically when a person uses a similar mark or logo that is likely to cause confusion among customers. The following remedies are available for cases of trademark infringement in Nigeria:

**Injunction:** The trademark owner can obtain an injunction aka 'hold it there', to prevent further use of the infringing mark.

**Damages:** This is a personal favorite, a trademark owner can claim damages for any losses suffered as a result of the infringement (Huge and hefty damages).

- **Dilution:** A trademark owners can sue for dilution if another party uses a similar mark for non-competing goods or services that may harm the trademark owner's reputation.
- **Counterfeiting:** Where are my Aba brothers, a trademark owners can sue for counterfeiting if another party tries to reproduce there mark without due authorization.
- **Account of profits:** The trademark owner can claim a share of the profits made by the infringing party as a result of the infringement.
- **Seizure and destruction:** The infringing goods can be seized and destroyed.



## Conclusion

I would like to draw the curtain here by saying that trademarks are an essential part of our intellectual property and it is expedient that we safeguard them either as businesses or individuals and also stay away from infringing on other brands, as such infringement can result in severe legal repercussions, such as substantial fines, damages, and even the loss of the infringing party's business.

There have been various high profile cases in which companies have been penalized for violating trademarks. I will show you a few;

In this case **Apple Inc. v. Samsung Electronics Co. Ltd 678 f.3d 1314 (fed. cir. 2012)** the court \$1.05billion in damages to be paid to Apple, for Samsung's intentional infringement of Apple's patents and trademarks.

Similarly, in **LVMH Moet Hennessy Louis Vuitton v. Dooney & Bourke Inc. 454 F.3d 108 (2006)** LVMH sued Dooney & Bourke for trademark infringement, and the court granted LVMH \$8.7 million in damages.

Another notable case is **Gucci America Inc. v. Guess? Inc. 271 F.R.D. 58 (S.D.N.Y. Sept. 23, 2010)** in which Gucci sued Guess for trademark infringement, and the court awarded Gucci \$4.7 million in damages.

There are a lot more cases that show the significance of protecting one's intellectual property and respecting others' trademarks. To our Young Entrepreneurs out there and Business Moguls you must take necessary measures to ensure that you are not infringing on anyone's trademarks and also to immediately address any potential infringement issues **(this cannot be done if your trade mark is not registered, don't be Tboss who goes crying out for failing to trademark a name she was known by before Ka3na beat her to it).**

For your inquiries and more information, you can reach us through any of our contact details

**Website:** [kalepronattorneys.com](http://kalepronattorneys.com)

**Email:** [Contact@kalepronattorneys.com](mailto:Contact@kalepronattorneys.com)

**Instagram:** [Kalepron\\_Attorneys](https://www.instagram.com/Kalepron_Attorneys)

**Phone number:** 07037721612

**Address:** Suite 208, Second Floor, Nwukpabi Plaza, Ibrahim Waziri Crescent, Apo, Abuja, FCT.