

Onyilo

Repositioning The Trademark Registration and Opposition Proceeding in Nigeria  
for Greater Efficiency: A Call for Legislative Intervention

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### **Repositioning the Trademark Registration and Opposition Proceedings in Nigeria for Greater Efficiency: A Call for Legislative Intervention**

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**Abounu Peter Onyilo\***

#### **Abstract**

In the world of increasing globalization and the aggressive growth of the creative economy, the importance of intellectual property (IP) to ensure freedom of fair competition and respect for honesty in trade cannot be overemphasized. Trademarks are important components of the IP system which have strong influence on investment and marketing decisions. Protected trademarks are granted monopolies by government and enforced by the courts in favour of merchants who reserve them. Save in exceptional circumstances, trademarks are protected through registration. The Nigeria Trademark Act makes provisions for guidelines and procedure for the registration of trademarks and opposition thereto. However, it is doubtful if the Nigeria Trademark Act and its Regulations made almost six decades ago are still in conformity with the global trends in trademark registration and opposition proceedings. Therefore, this work seeks to examine trademark registration and opposition in Nigeria in the light of practical realities with a view to suggest ways for improved effectiveness and efficiency. The paper adopted doctrinal research approach. The main sources of information and data collection for this study were the relevant statutes, case laws, textbooks, articles and the internet. The work found that it is imperative to improve trademark registration and opposition proceedings in Nigeria in consonance with the universal trends in trademark practice and administration. The paper recommended inter alia, for the amendment of the Trademark Act and Regulations with a view to establishing a full-fledged trademark tribunal with its composition, powers, finances and administration for expedited opposition hearing process.

***Keywords: Trademark, Registration, Opposition- Proceedings, Efficiency.***

## 1.0 INTRODUCTION

Intellectual Property (IP) is the legal right which results from intellectual activity in the industrial, scientific, literary and artistic fields.<sup>1</sup> IP law offers a regulatory framework that provide protection for the output of human creativity and inventions. IP law provides protection to IP rights (IPRs) which are granted in terms of statutory provisions and, in some cases, common law to grant economic exclusivity over inventions in all fields of technology and a variety of works including in art and literature.<sup>2</sup> These legal rights can be infringed upon when the same rights granted to the proprietors are exploited by a third party without a lawful consent and authorization. Indeed, there is a positive correlation between IP rights and economic growth in every jurisdiction, Nigeria is not an exception. Therefore, IP rights need to be protected and enforced in Nigeria. For IP rights to be protected, registration is key in some deserving circumstances.

Trademarks, as a branch of intellectual property (IP), contribute immensely to the economic growth and development of many countries across the world. Indeed, trademarks are important components of the IP system which have strong influence on the private investment and marketing decisions as they are intangible capital<sup>3</sup>. Laws are made to safeguard trademarks against unauthorized usage which may likely mislead or confuse consumers and the general public. Therefore, to create an environment where a high influx of Foreign Direct Investment (FDI), would flourish, a nation such as Nigeria, is placed with the onus to put necessary machinery in motion for effective protection and enforcement of trademark rights. This measure will attract and boost the investors' confidence that their investments are adequately protected and returns on investment are assured. This will certainly transcend into creating huge

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<sup>1</sup> World Intellectual Property Organization (WIPO), Intellectual Property Handbook: Policy, Law and Use. (WIPO Publication No. 489(E) ) 3

<https://www.wipo.int/publication/en/details.jsp?I'd=275&plang=EN> accessed 3 April 2022

<sup>2</sup>Caroline Ncube, 'Harnessing Intellectual Property for Development: Some Thoughts on an Appropriate Legal Framework' (2013) 16(4) *Potchefstroom Electronic Law Journal* 370 at 373

<sup>3</sup>Jackson, Etti & Edu, 'Intellectual Property: A Tool for Economic Growth in Nigeria' <https://www.mondaq.com/nigeria/trademark/82368/intellectual-property-a-tool-for-economic-growth-in-nigeria> accessed 4 April 2022

investment opportunities and increased revenue generation<sup>4</sup>. It is for this reason that this article examines trademark registration and opposition proceedings in Nigeria with a view to proffering some suggestions for a greater efficiency in the system.

The article is structured into seven parts. The first segment is the introductory part. The general overview of trademark titled “trademark panorama” appears in the second part whereas registration of trademark in Nigeria follows progressively in the third segment of the work. Part four examines the benefits of trademark registration and part five x-rays trademark opposition proceedings in Nigeria and the challenges thereto. The sixth segment of the work draws the conclusion while part seven proffers useful recommendations for greater efficiency in trademark operations in Nigeria.

## **2.0 TRADEMARK PANORAMA**

A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors<sup>5</sup>. In order to individualize a product for the consumer, the trademark must indicate its source. However, this does not mean that the trademark must inform the consumer of the actual person who has manufactured the product or even the one who is trading in it.<sup>6</sup> What is important is for the consumer to have trust in a given enterprise responsible for the product sold under the trademark.

Trademark denotes a word, symbol or picture that a company uses to help consumers identify the company's products or services and distinguish them from those of other companies.<sup>7</sup> Therefore, trademarks protect distinctive words, logos, slogans, specific colours and in some countries, sounds or other manners of identifying products or services. The term “trademark” can be used to distinguish goods (including services or goods related to the provision of services) of one business from those of others.<sup>8</sup> This means trademark

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<sup>4</sup>Onoji E, ‘Intellectual Property Rights Protection as a Tool for Economic Growth in Nigeria’ <https://primeraal.com/news/intellectual-property-rights-protection-as-a-tool-for-economic-growth-in-nigeria> accessed 5 April 2022

<sup>5</sup>WIPO, Intellectual Property Handbook (n1) 68

<sup>6</sup> Wolters Kluwer, Introduction to Intellectual Property, Theory and Practice (Kluwer Law International BV 2017) 200

<sup>7</sup>Isaac Ogbah, Understanding Trademark Law in Nigeria (Legal Jurisprudence Limited 2019) 5

<sup>8</sup>Ji Seon Yoo, ‘Requirement of Trademarks Registration and Examination Practice’ (being a paper presented at WIPO-KIPO Training Course on Trademark Law and Examination held in Daejeon, Republic of Korea, from November 11 – 15, 2019)

distinguishes the proprietor's goods and services from those of others. As to what constitute trademark, Article 15 of the TRIPS Agreement<sup>9</sup> provides that:

Any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting trademarks, such signs in particular words including personal names, letters, numerals, figurative elements and combination of colours as well as any combination of such signs shall be eligible for registration as trademark.

By the provisions of Article 15, TRIPS Agreement, trademark may consist of words (including personal names), a logo, or combination of both. A mark also consists of figurative elements, letters, numerals or the shape of goods or their packaging. Statutorily, Section 67 of the Nigerian Trade Marks Act,<sup>10</sup> defined trademark thus:

Trademark means, except in relation to a certification trademark, 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 mark, a mark registered or deemed to have been registered under section 43 of this Act.

The definition of trademark as enshrined under the Trademarks Act appears narrower than the requirements of the TRIPS Agreement. The reason is obvious: whereas the Nigerian Trademarks Act was enacted in 1965, the TRIPS Agreement became operational in 1995. However, the phrase '**used or proposed to be used**' and '**connection in the course of trade**' as appeared in the TMA's definition of trademark needs further explanation. The former implies that the actual use of a mark is not a precondition before the mark can be accepted for registration. In other words, the Registrar of Trademark can accept and register a trademark if it has either been used before application for registration or there is a plan to use it after registration in future. The latter, on the other, means that the proposed mark must be registered for trade-related purposes. Therefore, where a

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<sup>9</sup>The Agreement on Trade Related Aspect of Intellectual Property Rights. It is an international legal agreement between all member nations of the World Trade Organization (WTO), Nigeria inclusive.

<sup>10</sup> Cap T13 Laws of the Federation of Nigeria (2004) hereinafter referred to as "TMA".

mark is proposed for registration with the intention of using it for religious or non-commercial purpose, it will not be registered even if it meets other requirements for registration.

Certification mark as used in the TMA definition of trademark equally deserves further elucidation. A certification mark indicates that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of a given standard or characteristics such as origin, materials, mode of manufacture of the goods or performance of service, quality or accuracy.<sup>11</sup> Under the TMA,<sup>12</sup> Certification mark is defined as:

A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristics from goods not so certified shall be registrable as a certification trade mark in Part A or the register in respect of those goods in the name, as proprietor thereof, of that person.

While the TMA definition of certification mark appears verbose, it can be deduced that certification marks are used to indicate that a good or service complies with a standard or specification, or those who provide a service have a certain level of skills or training. For example, in 2011, the first application for a certification mark was filed in Chile by the National Association of Wineries for Certified Sustainable Wine of Chile<sup>13</sup>. This trademark can only be used by any winery which products comply with a series of standard in regards to sustainability and labour conditions.

Trademarks are usually registered to protect marketing tools such as brand names, logos, or company slogans, among others, from third-party use or plagiarism. For a designation or other identifiers to function as a trademark, it must be distinctive or must have acquired distinctiveness in relation to goods in the course of trade<sup>14</sup>. Whether a mark is distinctive or not, upon application for registration, the Registrar of Trademarks does not only possess the discretion to refuse marks that mislead or tends to cause confusion to the public, the TMA disallow some marks to function as trade mark such as deceptive or scandalous

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<sup>11</sup> See Section 50 United Kingdom Trademark Act 1994

<sup>12</sup>Section 43(1)

<sup>13</sup>Raj Pagariya, ‘Module 2 Flashcards’ <https://www.brainscape.com/flashcards/module-2-7455755/packs/12224094> accessed 15 April 2022

<sup>14</sup>Section 9(2) Trade Mark Act ( TMA)

marks<sup>15</sup>, identical or resembling trademarks<sup>16</sup> names of chemical substances<sup>17</sup>, and the Coat of Arms of Nigeria or a State or other emblem of authority.<sup>18</sup>

However, once a trademark is validly registered, it gives the proprietor the exclusive right to use the mark in marketing or selling of goods. If without the proprietor's consent, anyone else uses an identical mark or one nearly resembling it as to be likely to deceive or cause confusion, the registered proprietor will be entitled to sue for infringement of the trademarks. To acquire a status of a trademark proprietor, the person must, in relation to the trademark, be the owner, importer, exporter, shipper or any other person for the time being possessed of or beneficially interested in the goods to which the trademark is applied<sup>19</sup>.

A trademark registered is valid and remains on the register of trademark for seven years from the date of registration and the registration may be renewed for additional period of fourteen years.<sup>20</sup> An application for renewal is expected to be made not less than three months before the expiration of the last registration of the trademark<sup>21</sup>. Trademark needs to be protected as it fosters competition and the maintenance of quality by securing to the producer the benefits of good reputation. Therefore, trademark law encourages the production of quality products and discourages the manufacturing, sale and proliferation of inferior products.

In Nigeria, trademarks are governed by the Nigerian Trademark Act, Cap T13, Laws of the Federation of Nigeria (LFN) 2004, The Merchandise Marks Act, Cap M10, LFN 2004 and the Nigerian Trademark Regulations 1967. It is to be noted that the Nigeria Trademark Act (TMA) was actually enacted in 1965 and it is a replica of the United Kingdom Trademarks Act of 1938 applicable to English colonies, Nigeria inclusive. The 1938 English Trademark Act which was more comprehensive than its predecessors, was notwithstanding, fraught with legislative lacuna which prompted **Lord Justice MacKinnon, LJ** in the case of *Bismag Ltd. V. Amblins (Chemists) Ltd*<sup>22</sup> to declare, out of frustration, while ruling on the infringement section of the Trademarks Act that the 1938 Act was beset with "fuliginous obscurity". It is to be noted that Nigeria adopted almost

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<sup>15</sup>Ibid Section 11(a)-(b)

<sup>16</sup>Ibid 13(1)

<sup>17</sup>Ibid Section 12(1)

<sup>18</sup>Ibid Section 62

<sup>19</sup>See *Dyktrade Limited v Omnia Nigeria Limited* (2000) FWLR (Pt. 11) 1784 SC Per Belgore JSC

<sup>20</sup>TMA, Section 23

<sup>21</sup>Section 66, Nigerian Trade Marks Regulations 1967

<sup>22</sup>(1940) Reports of Patent, Design and Trademark Cases, Volume 57, Issue 8, pp 209-244

wholesale the United Kingdom's Trademarks legislation which has been amended severally and is currently being regulated by the 1994 English Trademarks Act. It is to be further noted that the TMA remains unaltered since 1965.

### **3.0REGISTRATION OF TRADEMARK IN NIGERIA**

Trademarks enjoy legal recognition by virtue of their registration as trademarks pursuant to the provision of the TMA. Thus, from the wordings of section 3 TMA, a registered trademark enjoys both legal recognition and legal protection. On its part, an unregistered trademark enjoys only legal recognition and its proprietor can maintain an action for passing off available under the common law. Thus, the legal rights and protection of trademark are more guaranteed upon registration of trademark.

In Nigeria, registration of Trademark is carried out by the Nigerian Trademark Registry, domiciled in the Commercial Law Department, Federal Ministry of Industry, Trade and Investment, Abuja, Nigeria. Registration of trademark is available in respect of goods and services and there exist two categories of Trademark – those falling under part A<sup>23</sup> and part B<sup>24</sup> of the Register, in respect of which different consideration arise. In addition to its distinctiveness, for a trade mark to be registered in part A of the register, it must consist of at least one of these essential particulars:

- a. the name of a company, individual or firm, represented in a special or particular manner,
- b. the signature of the applicant for registration or some predecessors in his business,
- c. an invented word or invented words,
- d. a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification, a geographical name or a surname, and
- e. any other distinctive mark.<sup>25</sup>

Marks that can acquire distinctiveness through use under section 10 of the TMA are registered in Part B. The implication of section 10 TMA is that Part B mark does not have to be distinctive at the point of registration. All that is necessary is that the mark should be capable of becoming distinctive in use<sup>26</sup>.

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<sup>23</sup> See section 9 TMA

<sup>24</sup> Ibid section 10

<sup>25</sup> Ibid section 9(1)

<sup>26</sup> Ibid section 10(2)

Procedurally, registration of trademark in Nigeria is set out under the phases below:

### **Phase 1: Application and Acknowledgement**

It is important for the applicant for registration of trademark to provide the following details and documents at the Trademark Registry for formality examination:

- a. Details of the applicant/proprietor-including name and nationality.
- b. Class and specification of goods or services for which the trademark is to be registered.
- c. Authorisation of Agent- Trademark Form 1.
- d. Trademark Application Form 2. This is an application form addressed to the Registrar of Trademark for the registration of trademark which shall be signed by the applicant or his agent in compliance with Regulation 23(1) of the Trademark Regulations 1967.
- e. Trademark bromide in form 3.

Upon successful presentations of the above documents and **formality examination** by the Trademark Registry, the applicant will be issued an **acknowledgement**, which signifies that the trademark application has been successfully filed. It is to be noted however, that trademark application before the Nigerian Trademark Registry can either be filed manually through the Industrial Property Administration System (IPAS) or online depending on the choice of the applicant.

### **Phase 2: Substantive Examination**

Upon issuance of acknowledgment to the applicant, a search will be conducted within the Trademark Registry to ascertain whether or not there is already in existence, a trademark in the registry's database, in the same class and identical to the trademark sought to be registered. Similarly, substantive examination is also carried out to determine the distinctiveness and other conditions for registrability of the mark sought to be registered.

### **Phase 3: Acceptance**

Upon the conclusion of the substantive examination and the satisfaction of the Registrar of Trademark of the conditions, inclusive of the distinctiveness of the mark sought to be registered, the Registrar may accept the application. The acceptance may be absolute, or subject to conditions, amendments, disclaimer,

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modifications or limitations<sup>27</sup>. However, where the Registrar refuses the application, the reason for refusal should be stated.<sup>28</sup>

#### **Phase 4: Publication**

An accepted trademark will be published by the Registrar of Trademark in the Nigerian Trademark Journal in accordance with section 19(1) of the TMA. The justification for the publication is to give notice to the general public that the mark sought to be registered is in the process of registration and aggrieved parties can bring an opposition action to the registration of the mark.

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<sup>27</sup>Regulation 34 Trademark Regulation 1967

<sup>28</sup>Ibid Regulation 35

### **Phase 5: Registration and Issuance of the Notice of Opposition**

Unopposed trademark application will be processed by the Registry and certificate is accordingly issued. The opposed application can be determined at the opposition proceedings and when successful, certificate of registration can be issued to the applicant by the Registrar.

#### **4.0 BENEFITS OF TRADEMARK REGISTRATION (RIGHTS CONFERRED)**

Under section 5(1) TMA, registered trademark conferred exclusive right on the owner in relation to the goods registered. In addition to the exclusive right conferred on the owner under the TMA,<sup>29</sup> the registered proprietor, in a suit relating to the trademark, may not necessarily adduce evidence of use and reputation of the trademark, it suffices when he produces the certificate of registration.<sup>30</sup>

Evidence of registration is a condition precedent to an action of infringement. Therefore, if a mark is unregistered, its proprietor cannot bring an action for an infringement.<sup>31</sup> Similarly, a registered trademark confers the right to assignment and transmission on its proprietor in return for fees, royalties and other payments as envisaged by the provision of the TMA.<sup>32</sup> A registered trademark also affords the proprietor to bequeath the trademark in a will; and to acquire incontestable status after a seven-year period under section 14(1) of the TMA.

As can be seen from the analysis, trademark protection is based on the premise that the protection of distinctive marks to distinguish proprietor's goods and services from other proprietors' goods and services, and shield the public from deception and confusion. Therefore, a proprietor of a registered trademark has a positive right to use the mark exclusively and a negative right to prevent others from using the same mark without authorization. Registration of trademark further serves as constructive notice to the public and as a *prima facie* evidence of the ownership and validity of the trademark.

### **5.0 OPPOSITION PROCEEDINGS IN NIGERIA**

#### **5.1 ACTION BEFORE THE TRADEMARK REGISTRY**

Accessible, sufficient and adequate arrangement for the protection of rights are crucial in any worthwhile IP system. It is not possible for the right-owners to enforce their rights effectively in a world where expanding technologies have

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<sup>29</sup> See sections 5 and 6 TMA

<sup>30</sup> See *Crysterlight Overseas Agency Ltd v Yugoles Drugs Co Ltd* (1998) FHCL 390

<sup>31</sup> See Section 3 TMA

<sup>32</sup> Ibid section 26

facilitated infringements of protected rights to hitherto unprecedented extent.<sup>33</sup> Trade marks proprietors must evolve measures to take action against infringers in order to prevent further infringement and recover losses incurred from any actual infringement.

Failure to sufficiently protect and enforce trademark can have financial consequences for the business and more importantly for the health of their customers. In addition, failure to take prompt enforcement action can seriously undermine the value of a trademark. Aside from cases of actual confusion, where customers mistakenly buy the products of proprietor's competitors, the proprietor's trademark may become generic, where consumers use the trademark as a purely descriptive term for the goods or services in question. In other words, the consequences of failure to protect and enforce trademarks infringement are enormous. Therefore, proprietor must seek to improve the protection and enforcement strategies in order to maximize return on investment. In Nigeria, in situations where an identical or similar marks is to be registered in the Trademark Registry, the proprietor of an existing trademark in the Register may exercise the option to enforce his right through the instrumentality of opposition proceedings.

A trademark opposition is pre-registration opportunity given to third parties to object to trademark applications before they are registered. It serves as a useful system for warding off the registration of deceptively or confusingly similar marks.<sup>34</sup> The Nigerian Trademarks Registry has quasi-judicial function in trademarks administration in Nigeria and provides a forum for procedures for contesting trademark rights. These procedures are often referred to as opposition procedures. Opposition procedures are governed by the TMA<sup>35</sup> and the Trademark Regulations.<sup>36</sup> When an application for registration of trademark has been accepted in the Trademark Registry, the Law<sup>37</sup> requires the Registrar of Trademark to cause notice of application to be published in the **Trademark Journal**.

As soon as the Trademark Journal is advertised by the Registrar, any person can file for opposition within two months<sup>38</sup> of the publication in the trademark

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<sup>33</sup>WIPO, Intellectual Property Handbook (n1) 207

<sup>34</sup>John Onyido, 'Principle and Processes of Trademark Opposition in Nigeria: A Review of some recent Trademark Rulings'. ( Being a paper presented at the IPLAN Training for the Opposition Tribunal of the Nigerian Trademark Registry, May 3<sup>rd</sup>, 2021)

<sup>35</sup>See sections 20-22

<sup>36</sup>TMR 1967, Regulations 48-61

<sup>37</sup> See section 19(1) TMA

<sup>38</sup>Ibid section 20(1)

journal against the registration of a similar or identical mark which is likely to cause confusion and setting out other possible grounds in writing for the opposition.<sup>39</sup> Once the Notice of Opposition is filed within the statutory period of two months after the publication of the Trademark Journal, the Trademark Registry is prevented from taking further steps in the registration of mark under consideration until the opposition is determined by the Trademark Tribunal. At the opposition proceedings, an aggrieved party who initiates and files the Notice of Opposition is referred to as the ‘Opponent’, whereas the party that made application for the registration of the mark in question is called the ‘Applicant’.

Opposition proceedings entails filing of relevant documents by the applicant and the opponent, including notice of opposition, counter-statement, statutory declaration and written address. Once the Notice of Opposition filed by the Opponent is served on the Applicant, the latter is expected under Regulation 50 of the TMR to file a Counter-Statement in response to the Notice of Opposition within one month of the receipt of the Notice of Opposition stating the grounds upon which he relies on for his application.<sup>40</sup> However, in the event that the Applicant fails to file the Counter- Statement within the statutory specified period, the Opponent may apply to the Registrar of Trademark to have the mark under contention deemed abandoned<sup>41</sup> which brings to an end the opposition proceedings and equally the registration of mark sought to be registered. Where the application is deemed abandoned, the Trademark Registry is expected to issue a ‘Notice of Abandonment’ to the effect that the Registry cannot proceed with the registration of mark sought to be registered.

However, where the Applicant files a Counter- Statement, the TMR<sup>42</sup> directs that within one month after receipt of the Counter Statement, the Opponent shall file the evidence he/she intends to adduce at hearing by way of Statutory Declaration in which the Opponent makes averments on why the trademark should not proceed to registration. The Applicant, upon the receipt of the opponent’s Statutory Declaration, is required under the TMR<sup>43</sup> to file its Statutory Declaration within one month. The opponent is equally bestowed with the right under Regulation 53 of the TMR to within one month from the receipt of the Applicant’s Statutory Declaration, to file a Reply Statutory Declaration.

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<sup>39</sup>See also Regulation 48 TMR

<sup>40</sup>See also section 20(3) TMA

<sup>41</sup>ibid

<sup>42</sup>Regulation 51

<sup>43</sup>Regulation 52

After the filing of the required processes including the Briefs of Argument, the matter is set down for hearing in compliance with Regulation 56 of the TMR and determined at the hearing before the Registrar after consideration of relevant evidence.<sup>44</sup> It is apposite to state that the TMA does not provide a prescribed method of tendering evidence nor the nature or context of the evidence to be adduced at the hearing. However, Regulations 51 and 52 of the TMR provide that evidence to be adduced must be by way of Statutory Declaration. Similarly, Regulation 55 of the TMR states that original exhibits shall be produced at the hearing.

In any event, the evidence being considered by the Trademark Tribunal must be relevant to the facts in issue and material in the circumstance of the case.<sup>45</sup> However, in a situation where the facts though not in issue are connected to the fact in issue, such as registration of trademark in other jurisdictions, the tribunal may admit such evidence on the strength of the court decision in *Jolayomi v. Olaoye*.<sup>46</sup> After the hearing and adoption by the parties of the processes filed before the Trademark Tribunal, the Tribunal then delivers a ruling. However, the decision of the Registrar by way of ruling in this regard is subject to appeal by an aggrieved party to the Federal High Court<sup>47</sup>. In the case of *Nabisco Inc. v. Allied Biscuits Company Ltd*,<sup>48</sup> the Registrar's ruling was appealed up to the Supreme Court of Nigeria.

Relatedly, after the registration of trademark, an aggrieved proprietor of earlier trademark in the register can apply to the Trademark Registrar for removal of the subsequent registered mark from the register or to seek its modification.<sup>49</sup> The application must be supported by documents showing ownership of the trademark in Nigeria that precede the offending registration/application. If the Registrar finds in favour of the true owner, he may withdraw the acceptance or cancel the certificate already issued to the infringer. Where necessary, the Registrar may permit the contending parties to make representations at a hearing before decision is made in that respect.

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<sup>44</sup> See section 20(4) TMA

<sup>45</sup> See *Ogu V. M.T & M.C.S LTD* (2011) 8 NWLR (PT.1249) CA

<sup>46</sup> (1999) 10 NWLR (PT.624) 600 CA

<sup>47</sup> See section 21(1) TMA

<sup>48</sup> (1998) 7 SC (PART 11)99

<sup>49</sup> See section 39 TMA

## 5.2 Grounds for Trademark Oppositions in Nigeria

Neither the Nigerian Trademark Act nor the Trademark Regulations explicitly provides for the grounds for trademark opposition. In addition to already mentioned marks prohibited from registration by the TMA, opposition to registration of trademark can be brought on the following grounds, among others:

### 1. **That the trademark is identical or nearly resembles a registered mark as to be likely to deceive or cause confusion.**

The right of an owner of trademark is deemed to be infringed by any person who uses a mark identical with it or nearly so resembling it as to be likely to deceive or cause confusion, in relation to any goods in respect of which it is registered.<sup>50</sup> Similarly, it is unlawful to register a trademark that is likely to confuse to deceive or cause confusion.<sup>51</sup> On the other hand, section 13(1) of the TMA makes it unlawful to register a trademark that is identical with a trademark belonging to a different proprietor and already on the register, and a trademark which so nearly resembles an existing mark as to be likely to deceive or cause confusion. What that can be deduced from the cited provisions of the TMA is that a trademark that is identical or confusingly similar to a prior existing mark cannot be accepted for registration by the Trademark Registry.

In determining confusing similarity, deception or otherwise between conflicting marks as enshrined in the TMA, the Court of Appeal in *Holdent International Ltd. V. Petersvilie Nig. Ltd*<sup>52</sup> was of the view that:

The question is not whether if a person is looking at two trademarks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trademark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection.

The test of confusing similarity espoused by the Court of Appeal in *Holdent's* case has been consistently followed by the same court. Thus, in *Rikichi & Ors v. Gambo*<sup>53</sup> where the court stated that deciphering deceptiveness or similarity is not by merely placing the elements of the conflicting marks side by side, but by the impression the opposed mark leaves in the mind of the consumer. The question is

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<sup>50</sup>Ibid section 5 (2)

<sup>51</sup>Ibid Section 11(a)

<sup>52</sup> (2013) LPELR-21474(CA)

<sup>53</sup>(2019) LPELR- 47676 (CA)

“whether the person who sees or has seen the proposed trademarks will confuse it with the existing trade mark, as to create confusion and be deceived that the proposed trade mark is the same as the existing one.”<sup>54</sup>

In the same vein, in *Alban Pharmacy v. Sterling Products International*<sup>55</sup>, an earlier case, the Supreme Court was invited to determine whether the Respondent’s proposed mark, “Casorina” was likely to cause confusion in the mind of a person who sees the proposed mark in the absence of the already registered trademark, “Castoria.” The court held inter alia that:

The question is whether the applicants have satisfied us that the use of the word ‘Casorina’ is not likely to cause confusion in the minds of the public which use the two babies’ medicine. We feel that the apprehension of the appellants are well founded and in our view if the proposed trademark, ‘Casorina’ be registered, the syllable ‘Cas’ will no doubt form the essential part of the name of the medicine and it is likely to cause confusion in the minds of the public. In this particular case, the end of the ‘Casorina’ namely, ‘Rina’ in its self is not free from causing confusion with ‘Ria’ in ‘Castoria’. As all the cases show, the court must consider the person with imperfect recollection, the incautious and the illiterate as well as those who may place an order by telephone. All these considered, the appellants’ counsel has satisfied us that it would be wrong to allow the applicant to register this trademark.

Further, it is important to establish that the determination of the similarity or deceptiveness is not restricted to the impression the mark creates in the minds of the consumers or by visual examination of the elements of the conflicting marks, but equally applies to the sound of the trademark. Thus, in *Beecham Group Ltd v. Esdee Food Products Nigeria Ltd*,<sup>56</sup> where the claimant who was the owner of the registered trademark, “Lucozade” instituted an action for infringement against the Respondent for the use of the trademark “Glucose-Aid”, it was held that the phrase “Glucose-Aid” was confusing in sound to “Lucozade” and that it would no doubt deceive the public.

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<sup>54</sup>Ibid

<sup>55</sup>(1968)3 alr comm.311

<sup>56</sup>28 NIPJD (CA.1985) 12/1984

**2. That the trademark is descriptive of the goods for which is to be registered, or that it is generic for those goods.**

Opposition proceedings can be brought against the trademark that is descriptive of the goods or services for which it is to be registered, or that is generic for those goods or services. Thus, Section 9(1)(d) of the TMA provides that for a mark to be registrable under part A of the register, it must contain a word or words having no direct reference to the character or quality of the goods. For trademark to have a direct character as to the quality of the goods means that the trademark contains a word or phrase which is an adjective that directly describes the character of the goods.<sup>57</sup> Descriptive marks are those that designate the kind, quality, intended purpose and value of the goods. Other instances of phrases that have a direct character as to the quality of the goods include, “Durable Leather Shoes”, “Fast Cars”, “Sweet Sugar” and so on.

The rationale behind refusal of trademarks that have a direct character to the quality of the goods is that firstly, the qualifying words such as “Good”, “Tasty” and “Sumptuous” are too generic and they do not have a distinctive character. Furthermore, the words are such which are commonly used in the market of food and confectioneries and it would be against the interest of the public to grant a proprietor exclusive right to the use of those words. It is essential to commerce that nobody should be allowed to monopolize generic terms<sup>58</sup>.

**3. That the trademark contains scandalous words and or design.**

It shall not be lawful to register as a trade mark or part of a trade mark any scandalous design.<sup>59</sup> Generally, a scandalous mark has been construed to mean a mark that contains elements that may be considered as obscene, incorporating racial or ethnic abuse, incorporating abuse of a national flag, incorporating elements of religious intolerance, inciting violence and/or terrorism.<sup>60</sup> While there is no available judicial decision on scandalous phrase or design in Nigeria, an important factor to consider while looking into the scandalous nature or otherwise of an opposed mark, is the prevalent culture of the society and what is deemed morally acceptable or unacceptable. Thus, In *Greyhound Corp. v. Both Worlds, Inc.*<sup>61</sup>, the Trademark Trial and Appeals Board in the United States

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<sup>57</sup>Folashade Alli, ‘Critical Analysis of the Grounds for Trademark Opposition’, (being a paper delivered at the IPLAN Training for the Trademarks Opposition Tribunal, Abuja on the 29<sup>th</sup> April 2021)

<sup>58</sup>ibid

<sup>59</sup>Section 11(b) TMA

<sup>60</sup>Alli, (n58)11

<sup>61</sup>6 U.S.P.Q.2d 1635 (1998)

refused to register a logo of a defecating dog as a mark for shirts. In Nigeria, the Trademark Registrar reserves the right to refuse registration of a trademark that deems immoral or scandalous and this is still recognized as a valid ground for opposition of registration of trademark.

**4. That the trademark contains restricted words or symbol.**

Registration of trademark that contains restricted words or symbol is prohibited in Nigeria. Therefore, application for the registration of a trademark containing a national emblem without authorization of the appropriate authority risks opposition. Section 62 of the TMA put it succinctly thus:

If in connection with any trade, business, calling or profession any person, without the authorisation of the appropriate authority –

(a) uses the Arms of Nigeria or the Arms of a State (or arms so closely resembling the same as to be calculated to deceive) in any manner calculated to lead to the belief that he is duly authorised to use the Arms of Nigeria or the Arms of that State, as the case may be; or

(b) uses any device, emblem or title in any manner calculated to lead to the belief that he is employed by or supplies goods to the President or the Governor of a State in his official capacity as such, he shall be guilty of an offence and liable on summary conviction to a fine not exceeding forty naira.

Similarly, application of trademarks containing the words “President”, “Governor”, or any letters or devices if used in such a manner as to be likely to lead persons to think that the applicant is or has been employed by or supplies goods to the President or the Governor of a State in his official capacity shall not be accepted by the Registrar<sup>62</sup>. Furthermore, the Registrar of Trademark is empowered under Regulation 17 of the Trademark Regulations to refuse any application for the registration of a mark upon which any of the following appear-

- a. the words “Patent”, “Patented” “Registered” “Registered Design”, “Copyright”, “To counterfeit this is a forgery”, or words/phrases that alike to those mentioned;
- b. the words “Red Cross or Geneva Cross” and representations of the General and other crosses in red, or of the Swiss Federal cross in white on a red ground, or in silver on a red ground or such representations in a similar color.

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<sup>62</sup>Regulation 18 (c) Trademark Regulation

### **5. That the applicant has no intention to use the mark.**

Where the applicant for the registration of trademark has no intention to use a mark, an application can be made by any person concerned for the registered trademark to be taken off the register.<sup>63</sup> The determination whether or not a trademark owner has no intention to use the mark is a question of fact. In *Procter and Gamble Company v. Global Soap and Detergent Industries Ltd & Anor*,<sup>64</sup> the Court of Appeal stated the elements that must exist in order to make a finding of non-use of a trademark as follows:

To make a finding of non-use of the trademark under Section 31- (2) (a) of the Trademark Act, two conjunctive elements must exist. They are:

1. at the time of registration, the trademark was registered without bona fide intention to use same; and
2. a month before the application to remove a trademark is made, there has been no bona fide use of the trademark in relation to those goods by a proprietor thereof.<sup>65</sup>

It can therefore be deduced that in a trademark opposition proceeding, the opponent must prove that the applicant/proprietor has no bona fide intention to use the mark. The Trademark Act<sup>66</sup> further provides that the tribunal may refuse an application made on this ground if it is shown that before the relevant date or during the relevant period, as the case may be, there has been bona fide use of the trade mark, by the proprietor for the time being in relation to the goods to which the application relates, being goods in respect of which the trade mark is registered.

### **6. That the trademark lacks distinctive character.**

A mark is distinctive when consumers are able to identify that the product is from a particular trade source<sup>67</sup>. The distinctive character must therefore be examined in relation to the goods or services in which the trademark is applied. For example, the word “Apple” cannot be registered for an apple drink business but it is highly distinctive for computers, for example, iPhone. Indeed, invented words or coined trademarks are easier to protect and they are more likely to be deemed inherently distinctive because they are meaningless except in relation to the product it is applied for. Common words from everyday language can also be

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<sup>63</sup> See section 31 TMA

<sup>64</sup>(2012) LPELR-8014 (CA)

<sup>65</sup>*Per OGUNWUMIJU, J.C.A. (P.46, Paras.C-E)*

<sup>66</sup> Section 31(3)

<sup>67</sup> Alli, (n58)11

distinctive if they communicate a meaning that is arbitrary in relation to the products for which they are being applied for. An example is the famous APPLE mark for computers.

Trademark should possess a distinctive character.<sup>68</sup> Thus, section 9(1) TMA, empowers the Registrar of Trademark to refuse the registration of any trademark that lacks a distinctive character. Non distinctive character reflects the situation where the mark sought to be registered is either generic or incapable of distinguishing the applicant's goods/services from those of others. Section 9(3) of the TMA went further to state that in determining whether a trademark is adapted to distinguish, the Tribunal should examine the extent to which the trademark is inherently adapted to distinguish and by reason of the use of the mark, the trademark is in fact adapted to distinguish.

Therefore, a generic word used as a trademark cannot be said to have a distinctive character.

In the case of *Ferodo Limited & Anor. v. Ibeto Industries Limited*<sup>69</sup>, the Supreme Court defined "distinctiveness" an essential element of a device that identifies the goods of a particular merchant and distinguishes them from the goods of others. It added that certain marks are inherently distinctive while others only acquire distinctiveness over time. A distinctive mark could also lose its distinctiveness overtime and become generic.

It is to be note however that although lack of distinctiveness is a ground for trademark opposition, the Registrar of Trademark may decide to register such a trademark (that is common in the trade or lacks distinction)<sup>70</sup> subject to the conditions that the proprietor shall disclaim any right to the exclusive use of any part of the trademark; and that the proprietor shall make other disclaimers as the tribunal may find necessary in order to define the rights of the proprietor under the registration; provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such arise out of the registration of the trade mark in respect of which the disclaimer is made.

### **5.3 KEY CHALLENGES IN OPPOSITION PROCEEDINGS IN NIGERIA**

#### **1. Jurisdictional Challenge**

One of the key issues in conducting trademark opposition proceedings relates to the jurisdiction of the tribunal. Jurisdiction is fundamental to the exercise of

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<sup>68</sup> See Section 15(b) TMA

<sup>69</sup>(2004) LPELR-1275(SC)

<sup>70</sup>See the proviso to section 15 TMA

judicial power vested in a court and action without jurisdiction, no matter how well conducted must eventually come to nullity.<sup>71</sup> It appears from the combined wordings of sections 1 and 20(4) of the TMA that it is only the Registrar of Trade Mark that can take opposition decision after hearing from the parties in contention under the general direction of the Minister<sup>72</sup> which can be subject of appeal to court. The TMA further provides that ‘any act or thing directed to be done by or to the Registrar may be done by or to any other officer in the public service of the Federation authorized by the Minister’.<sup>73</sup>

It is worthy of note that aside the Registrar, there are many other trained officers in the Trade Mark Registry with requisite legal and IP knowledge that can handle opposition matters at the Opposition Tribunal.<sup>74</sup> However, under the TMA,<sup>75</sup> ‘Registrar’ is defined as the ‘Registrar of Trademarks appointed under section 1 of the Act’ and ‘Tribunal’ means ‘the Registrar or the court, as the context or circumstances may require’. This means the Registrar of Trademark Marks shall be appointed by the Federal Civil Service Commission and whose office is situated in the Federal Capital Territory, Abuja.<sup>76</sup> It is to be noted also that the other officers at the Trademark Registry are equally employed with their letter of appointment issued by the Federal Civil Service Commission and placed on registrar cadre. This has generated a debate as to the legality or otherwise of the competency of other officers in the Trade Mark Registry to conduct and determine opposition matters on behalf of the Trademark Registrar at the Trademark Tribunal.

The ensuing legal debate was accorded judicial interpretation by the Federal High Court in *Caporn Industries Limited v. Registrar of Trademark and Sunmark Limited*<sup>77</sup> where it was held *inter alia*, that the opposition proceedings conducted and concluded by a Principal Assistant Registrar at the Trademark Registry must be quashed for lack of jurisdiction as the Tribunal was not properly constituted.<sup>78</sup>

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<sup>71</sup> See *Funduk Engineering V McArthur* (1993) 4 NWIR (Pt 329) 640@651

<sup>72</sup> Presently, under the Minister of Industry, Trade and Investment.

<sup>73</sup> See section 1(3) TMA.

<sup>74</sup> These officers are variously called Principal Assistant Registrar, Senior Assistant Registrar and Assistant Registrar respectively.

<sup>75</sup> See section 67(1) TMA

<sup>76</sup> Ibid section 1(1)

<sup>77</sup> Was a subject of Trademark Opposition Proceedings in Application Number F/TM/2011/17678

<sup>78</sup> See, Jude David Mbamalu, ‘Conducting Opposition Proceedings at Nigeria’s Opposition Trade Mark Registry: Jurisdictional and Adjunct Issues’ <https://guardian.ng/features/law/conducting-opposition-proceedings-at-nigerias-trade-mark-registry-jurisdictional-and-adjunct-issues> accessed 30 May 2022

The implication of the Federal High Court's decision under consideration is to the effect that it is not within the precinct and contemplation of the TMA for officers at the 'registrar cadre' to adjudicate and determine opposition matters, as the Registrar of Trademarks is the only recognized tribunal in the eye of the law to conduct opposition proceedings. Indeed, this decision has imposed a huge responsibility on the Trademark Registrar to, apart from the day-to-day running of the Trademark Registry, conduct and determine all opposition proceedings before the Trademark Tribunal. We submit, with profound respect, that this huge responsibility may be practically impossible for the Trademark Registrar to discharge alone. For effectiveness and efficiency in service delivery, we further submit that the TMA be reviewed to empower trained officers at Trademark Registry to conduct and determine opposition matters within the purview of the law.

## **2. Absence of Virtual Opposition Proceedings**

Another noticeable challenge to the efficient adjudication of opposition matters is the seemingly absence of virtual tools in determination of opposition proceedings. In early 2020, many nations across the world were forced to impose lockdown in major cities to contain the spread of covid-19. In March, 2020, the Federal Government of Nigeria directed all non-essential workers from Grade Level 12 and below to work from home in adherence to the advice of the Presidential Task Force on Covid-19.<sup>79</sup> This situation continued until December, 2021 when it was finally lifted.<sup>80</sup>

Consequent upon the lockdown imposed by the Federal Government, and the need to safeguard the health of judges, lawyers and litigants, the CJN<sup>81</sup> directed all heads of courts in Nigeria to suspend courts activities save for urgent or time-bound matters.<sup>82</sup> Indeed, the Covid-19 pandemic greatly affected judicial proceedings across various courts in Nigeria and opposition proceedings was not an exception. In a bid to savage the impact of covid-19 in administration of judicial system, in his capacity as the Chairman of the NJC,<sup>83</sup> the CJN, in 2020 set-up a committee headed by Justice Olabode Rhode-Vivour to come up with urgent practical strategic measures to

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<sup>79</sup>See 'Federal Civil Servant to work from home as Nigeria battles coronavirus'  
<https://guardian.ng/news/federal-civil-servant-to-work-from-home-as-nigeria-battles-coronavirus/>  
accessed 30 May 2022

<sup>80</sup>See 'Covid-19: Nigerian government directs all workers to resume, get vaccinated'  
<https://www.premiumtimesng.com/news/headlines/497587-covid-19-nigerian-government-directs-all-workers-to-resume-get-vaccinated.html> accessed 29 May 2022

<sup>81</sup>Chief Justice of Nigeria

<sup>82</sup>Contained in circular no. NJC/CIR/HOC/11631 issued on the 23<sup>rd</sup> March, 2020

<sup>83</sup>National Judicial Council

ensure the continuity of judicial proceedings despite the lockdown and the Committee, *inter alia*, recommended the use of technology by way of virtual court proceedings and the recommendation was expeditiously approved by both the CJN and the NJC.<sup>84</sup> This development prompted many courts across Nigeria to issue practice direction for the judicial system to embrace virtual tools in judicial process to ameliorate the difficulty in accessing justice, delay in the administration of justice and non-compliance with filing timeliness. For instance, the Chief Judge of the Federal High Court authorized the use of virtual tools such as zoom and skype for court proceedings as contained in the 2020 practice direction effective from May 18, 2020.<sup>85</sup> Subsequently, the Supreme Court affirmed the constitutionality of virtual hearing in the case of Attorney General of Lagos State v. Attorney General of the Federation.<sup>86</sup>

Despite the judicial approval of virtual hearing of cases in Nigeria, Opposition Tribunal at the Trademark Registry is yet to activate this technology driven process with the capacity to timeously reduce the voluminous number of opposition matters filed before the Trademark Tribunal. This author is not oblivious of the challenge this may pose to the Trademark Registry because, to facilitate effective virtual opposition hearing, provision of fast and reliable internet, end-user hardware,<sup>87</sup> collaborative platforms<sup>88</sup> are key and essential. In any event, it is submitted that the virtual hearing of the opposition matters is achievable with positive determination and collaborative efforts of the critical stakeholders in IP industry in Nigeria. With the activation of virtual opposition hearings either through the amendment of the Trademark Regulations or issuance of practice direction, service of opposition processes and hearing notices can be effected by emails, WhatsApp or as may be directed by the Trademark Tribunal, and be deemed as good service.

## 6.0 CONCLUSION

Businesses need trademarks to individualize their products. Similarly, consumers need to be given the guidance that will allow them to consider the alternatives and make their choice between the competitive goods and services in the market. Therefore, trademark serves as an instrument for advertising and selling of products by the owners and equally serve the economy in general sense by

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<sup>84</sup> See 'Bill for virtual court hearing fails at Senate' <https://www.ripplenigeria.com/bill-for-virtual-court-hearings-fails-at-senate/?amp> accessed 29 May 2022

<sup>85</sup> See 'Federal High Court Practice Direction' <https://fhc-ng.com/virtual.htm> accessed 29 May 2022

<sup>86</sup> In suit no. SC/CV/260/2020

<sup>87</sup> Such as desktops, laptops, tablets etc.

<sup>88</sup> Such as Zoom, Skype, Google meetings etc

helping to rationalize the commercialization of goods and services. The instrumentality of trademark which enables consumers to make their choice between the various products available in the market encourages trademark owners to maintain and improve the quality of the products sold under the trademark, in order to meet consumer expectations. For a strong protection of trademark in a particular jurisdiction, registration is necessary.

The Nigerian Trademark Act makes provision for a guide as to application and registration of trademark in Nigeria including the procedure for registration and opposition to trademark registration. The Nigeria Trademark Registry, statutorily vested with the responsibility for registration and opposition to registration of trademark in Nigeria, should be commended in view of the circumstance under which the Trademark Registry operate. However, there is room for improvement by way of repositioning the trademark registration and opposition proceedings in Nigeria. This can be achieved through the amendment of the legal framework of trademark in Nigeria in conformity with universal trends in trademark practice and administration, and adoption of global best practices in trademark opposition hearings and delivery of rulings.

## **7. RECOMMENDATIONS**

- 1.** Nigeria Trademark Registry operation should be fully digitalized and automated for effective and efficient trademark registration process.
- 2.** Training and retraining of trademark examiners in efficient system of searches and trademark examination in line with global realities and best practices will drastically reduce the increasing number of trademark oppositions being experienced at the Trademark Registry.
- 3.** Amendment of the Trademark Act and Trademark Regulations with a view to establishing a full-fledged trademark tribunal with its composition, powers, finances and administration defined by the enabling law, will no doubt formalise and expedite opposition hearing process.
- 4.** Establishment of virtual trademark opposition hearings backed up by an enhanced internet and other relevant facilities will tremendously fast track the opposition hearings process.
- 5.** Entrenchment of alternative dispute resolution (ADR) mechanism in the legal framework is necessary for parties to trademark dispute to explore amicable means of resolving disputes failure which before opposition action can be brought. This will save Parties the stress and cost of trademark opposition proceedings and reduce the work load of the opposition tribunal.