

Nigeria

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The Trademarks Registry, Commercial Law Department, Federal Ministry of Industry, Trade and Investment Administers Protection of Trademarks, Patents and Designs in Nigeria is the relevant authority.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant laws are:

1. The Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria 2004.
2. The Trademark Regulations 1990.
3. The Merchandise Marks Act Cap. M10 LFN 2004.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

The Act defines a mark as including a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. Trademarks are used to identify and distinguish the source of the goods of one party from those of others in the course of trade.

Where, however, a trademark contains one or all of the above qualities, it will not be registrable without evidence of its distinctiveness. Distinctiveness basically means adapted to distinguish in relation to the goods.

2.2 What cannot be registered as a trade mark?

The following cannot be registered as a trademark:

- Marks that are deceptive, scandalous, and contrary to law or morality.
- Marks that contains a word which is commonly used and an accepted name of any single chemical element or single chemical compound, as distinguished from a mixture in respect of a chemical substance or preparation.
- Marks that contain prohibited words and/or symbols such as the names of chemical substances, Coat of Arms, the word “patent”, “patented”, “registered”, “registered design”, “copyright” or words to the like effect and so on.

- Non-traditional trademarks such as musical jingles, smells and taste are not registrable.
- Three dimensional marks, marks containing names of chemical substances and marks containing identical or resembling names.

2.3 What information is needed to register a trade mark?

The information needed to register a trademark is as follows:

- The name, nationality and address of the applicant.
- The name of the trademark or device mark.
- The Class in which it is to be registered (note that Nigeria follows the International Classification of Goods and Services).
- The Specification of goods in the Class. Note that the general term “all goods included in the class” is no longer acceptable, and the specific goods for which the registration is sought should be indicated. The Class Heading of goods may be adopted.
- A duly signed Power of Attorney/authorisation of an agent

2.4 What is the general procedure for trade mark registration?

1) Search & application

The first step required is to conduct a search, which is conducted on the trademark, and if it is not in conflict with or too similar to any existing trademark, an application for the registration can proceed. The Registrar will issue an acknowledgement form upon the recipient of any due application.

It is worthy of note to state that different payments are to be made at this stage for search and application processing.

2) Acceptance

Prior to issuance of an acceptance notice, applications are further examined on both relative and absolute grounds of objections. Again, a search is conducted, but this time for possible conflicts with existing applications, which have been filed but have not been registered in addition to a search for conflicts with registered trademarks. If the application is cleared on the above-mentioned grounds, then an acceptance notice is issued, otherwise a refusal notice will be issued.

An acceptance letter is initial evidence that the trademark has been duly registered.

3) Publication and certification

The third stage involves publication in the Trademark Journal and certification. This is the final stage.

a) Publication

Once an application has been accepted, it is advertised in the Trademark Journal, and it stands open for a non-extendible period of two months in which a third party may file an opposition notice or bring third party actions against the applicant.

b) Certification

Where there is no opposition to the publication in the journal, or where opposition was made and resolved in favour of the applicant, a Certificate of Registration will be issued for the trademark sought.

2.5 How is a trade mark adequately represented?

For a trademark to be adequately represented, it must be distinctive. Section 9 of the TMA provides that a trademark must be distinctive. As indicated, the desired mark can take the form of a design, device or label or a combination of a word(s) and design and, if a word mark, can be stylised or represented in special script. The TMA also provides that a trademark may be limited in whole or in part to one or more specified colours. If a trademark is registered without limitation to colour, it shall be taken to be registered for all colours.

2.6 How are goods and services described?

The trademark registration is classified into 45 different categories in accordance with the Nice international system of classification. It is important for every applicant to understand the classes the registering trademark belongs to or closely aligns with. However, a trademark may be registered in more than one class where the applicant is seeking protection in both classes. And where the applicant is seeking protection in multiple classes, separate filing fees must be paid for each of the classes.

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Trademarks not defined in the TMA or distinctive to a particular good or service cannot be registered in Nigeria as "exotic" or unusual trademarks. Trademarks that can, however, be justified to the Registrar might be registered under Part B if it is not deceptive, scandalous or contrary to law or morality.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

The Act does not state proof of use as a requirement for registration, however, for renewal, a non-use action may be brought on an application made by any person concerned, to the court against a trademark on the following grounds:

1. that the trademark was registered without any *bona fide* intention, on the part of the applicant for registration, to be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trademark in relation to those goods by any proprietor thereof, up to one month before the application date; or
2. that, up to one month before the application date, a continuous period of five years or longer has elapsed during which the trademark was a registered trademark and during which there was no *bona fide* use thereof in relation to those goods by the proprietor.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The Trademark rights in Nigeria are territorial in nature, therefore registration must be made in each country for which protection is sought.

2.10 Who can own a trade mark in your jurisdiction?

Natural and legal persons can own a trademark in Nigeria. Legal persons include companies, partnerships, religious societies and charitable organisations.

2.11 Can a trade mark acquire distinctive character through use?

A trademark may acquire a distinctive character through use and adaptation in Nigeria, where the trademark has been used in such a manner as to become so associated with a particular good or service, it is capable of creating an awareness in the minds of the purchasing public, with a connection in the course of trade as well as with the proprietor. Registration under Part B of the Register and the provisions on savings for vested rights anticipate that distinctiveness may be acquired based on actual use.

2.12 How long on average does registration take?

On average, registration takes about 10 to 18 months from the time the application is filed up to the issuance of the certificate of registration.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost of registering a trademark is \$681.66, broken down as follows:

- Official fees for a single trademark registration in one class: \$41.66.
- Average professional fees: \$500.
- Disbursements/out-of-pocket expenses: \$120.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

No. The only route to obtaining a trademark registration is through the Nigerian Trade Marks, Patents and Designs Registry.

2.15 Is a Power of Attorney needed?

Yes. Since only registered agents/attorneys can engage in administrative dealings at the Registry, a Power of Attorney/authorisation of an agent is almost always necessary.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Notarisation, certification or other legalisation of the document is unnecessary, unless the document is issued in a language other than English. For bodies corporate, the signature of two authorised persons and the seal of the body corporate is required.

2.17 How is priority claimed?

An application may be made in Nigeria, claiming priority on the basis of an earlier mark filed in a Convention country. The application is made in the same manner as an ordinary application with the certified copies of the earlier trademark application on the basis of which priority is being claimed. The Nigerian application must be filed within six months of filing the foreign application.

Although the necessary executive order that would specify countries to be recognised in Nigeria as Convention countries is yet to be made, the Registry collects priority applications.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Certification marks are recognised in Nigeria. Such trademark registrations are generally open to certifying authorities rather than individual persons/entities carrying on business in the kind of goods so certified. The Act is silent on Collective marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal are as follows:

- If the trademark is devoid of distinctive character.
- If the trademark is deceptive.
- If the trademark is scandalous, contrary to law or morality.
- Names of chemical substances, use of the Coat of Arms of Nigeria, use of any emblem or title such as President or Governor without the authorisation of the appropriate authority.
- Use of words like 'Patent', 'Copyright', 'Registered', 'Registered Design', 'Red Cross', 'Geneva Cross' and like terms cannot be registered.

3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds objection can be overcome by making representations, either oral or written to the Registrar, or by amending the proposed trademark application, in the case of a claim that the mark lacks any distinctive character.

Refusal can also be overcome via proof that the relevant mark has acquired secondary meaning or distinctiveness by virtue thereof and honest concurrent/prior use.

In the case of deceptive and scandalous marks, or use of marks that are contrary to law or morality, evidence tending to show that the mark sought to be registered is in fact not deceptive, or that the laws and morals of the society have changed.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of an application for registration at the Trademarks registry is to be appealed at the Federal High Court being the court with the jurisdiction and the appeal shall be made upon the grounds and materials as stated by the registrar in his objection.

3.4 What is the route of appeal?

After refusal, an initial right of appeal lies with the Federal High Court of Nigeria; a further appeal can be made to the Court of Appeal and a final appeal to the Supreme Court of Nigeria.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are as follows:

- Where the proprietor is not the actual owner.
- Where the trademark was registered in bad faith.
- Where the trademark was fraudulently obtained.
- Where the trademark is identical or confusingly similar to a previously registered trademark.

4.2 Are there ways to overcome a relative grounds objection?

Such an objection may be overcome via the following:

- Where the applicant is said not to be the actual owner, proof that the applicant has authority or a licence from the rightful owner or is an assignee would help.
- Evidence tending to dispel claims of fraud or bad faith.
- Where the mark can be shown to have acquired distinctive secondary meaning or use.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see answer 3.3.

4.4 What is the route of appeal?

Please see answer 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The following are grounds for opposition:

- a. The trademark is confusingly similar or identical to a previously registered trademark or a famous mark.
- b. The applicant for the trademark has no intention to use it.
- c. The trademark is likely to deceive the general public.
- d. The trademark is scandalous, immoral or contains any matter that is likely to cause confusion or is disallowed by law.
- e. The trademark contains geographical names.
- f. The trademark contains some restricted words (listed under question 3.1 above) or symbols such as representations of the Geneva cross and other crosses in red or of the Swiss federal cross in white on a red background, or in silver on a red background.
- g. The applicant is not the true owner entitled to register the trademark.
- h. The trademark contains the name(s) of a chemical substance.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested person (including third parties) may give notice of an intention to oppose the application for the registration of a trademark.

5.3 What is the procedure for opposition?

The procedure entails the issuance of a Notice of Opposition by the opponent enumerating the basis for the objection to registration. The applicant has one month to file a counterstatement indicating the grounds upon which it relies for its application. An application will be deemed abandoned if an applicant fails to file a counterstatement within the limited time frame.

Where the applicant files a counterstatement, the Registrar shall send a copy of the counterstatement to the opponent and the parties can then exchange statutory declarations in the form of evidence. If no additional evidence is adduced, the Registrar shall subsequently give notice of hearing and the matter shall be decided based on the exchanged documentary evidence.

The Registrar's decision one way or the other is subject to appeal to the Federal High Court.

6 Registration

6.1 What happens when a trade mark is granted registration?

Once the Registrar issues the applicant with a certificate of registration upon payment of the sealing fees, the proprietor is automatically conferred with the right to the exclusive use of the registered trademark, right of assignment and transmission, as well as right to bring an infringement action.

6.2 From which date following application do an applicant's trade mark rights commence?

The registration of a trademark takes effect retrospectively, i.e. from the date the application is filed.

6.3 What is the term of a trade mark?

In Nigeria, trademarks have an initial granted period of seven years but can be renewed thereafter for 14-year periods indefinitely and as long as the mark remains in use.

6.4 How is a trade mark renewed?

To renew a trademark registration in Nigeria, the prescribed form must be filed, and the prescribed fees paid at the Registry and the initial Trademark Certificate.

An application for a trademark renewal may be filed not more than three months before the expiration of the registration. Late renewal of a trademark is allowed if the renewal fee and the penalty fee for late renewal are paid within a month of the publication of the notice of the expiration of the registration of the trademark by the Registrar.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Only the assignee, the assignor or an authorised agent of either the assignee or the assignor can record the assignment of the trademark at the Registry.

7.2 Are there different types of assignment?

A trademark assignment may be in respect of all the goods in respect of which it is registered or in respect of some (but not all) of the goods and services. It may also be with or without goodwill. Where the assignment is without the goodwill associated with the business, the Registrar may direct that the request for registration of the assignment be first advertised in the Trade Marks Journal. Failure to comply with this directive implies that the assignee acquires no title or rights under the assignment. No document which has not been duly recorded is admissible as evidence in proof of title to any trademark, unless the court directs otherwise.

7.3 Can an individual register the licensing of a trade mark?

A trademark licence may be registered at the Registry by the licensee and the registered proprietor by filing the prescribed form and paying the prescribed fees. The Nigerian TMA does not adopt the term 'licence' but describes this as a right of use or the 'permitted use' of a trademark.

Under the TMA, this is known as the Registered User agreement (Sections 33 and 34 TMA). A copy of the licence may be accepted by the Registrar.

7.4 Are there different types of licence?

The Nigerian TMA does not make various distinctions. The common types of licences are the 'exclusive', 'non-exclusive' and 'sole' licences. It would appear that any of these licensing arrangements may be registered at the Trade Marks Registry under a registered user arrangement.

7.5 Can a trade mark licensee sue for infringement?

A licensee may institute an infringement action, depending on the terms of its licence. A Registered User is entitled to institute an infringement action where there is any subsisting agreement between the registered user and the proprietor, however in the case of the latter's refusal within two months of being called upon to do so, the registered user can then bring such an action in his or her own name as if he were the proprietor, provided he joins the proprietor as a defendant in the suit.

7.6 Are quality control clauses necessary in a licence?

The TMA does not prescribe the inclusion of quality control clauses in licence agreements as a basis on which a registered user agreement can be filed. Absence of quality control clauses will not invalidate a licence.

7.7 Can an individual register a security interest under a trade mark?

There are no provisions for the registration of a security interest under a trademark in our laws.

7.8 Are there different types of security interest?

This is not applicable in Nigeria.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The grounds for the revocation of a trademark include:

- Non-use, that is, where the trademark was registered without any *bona fide* intention by the applicant for it to be used and there has in fact been no *bona fide* use of the trademark up to one month before the date of the application; or that up to one month before the date of the application, the trademark has not been used for a continuous period of at least five years.
- Contravention of, or failure to observe, a condition entered on the register in relation to a trademark.
- Non-renewal.
- Lack of distinctiveness: where it is alleged that a trademark was registered in error, i.e without a basis of its distinctiveness as a key ingredient for registration.

8.2 What is the procedure for revocation of a trade mark?

An application may be made to the court or the Registrar for the revocation of a trademark. Where made to the Registrar, it shall be in the prescribed form and accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which it bases its case and the relief which it seeks. Where the applicant is not the registered proprietor of the trademark in question, copies of the application will be provided by the applicant and sent by the Registrar to the registered proprietor, following which the procedure for opposition proceedings will be adopted with necessary amendments to suit the occasion.

In the case of non-renewal, a statutory duty is placed on the Registrar to notify the registered proprietor of the trademark of the impending expiration thereof not less than one month and not more than two months to the expiration date in the first instance and not less than 14 days but not more than one month to the expiration date in the second instance. Where the proprietor fails to pay the renewal fee prior to the expiration date, the Registrar shall advertise the expiration of the trademark in the Trade Marks Journal and shall be free to remove the trademark from the Register and record such removal therein where the proprietor fails to pay the renewal fee with any surcharge for late renewal within one month after the advertisement.

8.3 Who can commence revocation proceedings?

Any person who establishes sufficient interest to the satisfaction of the Registrar or Tribunal can commence revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

The following grounds of defence can be raised:

- For revocation on the ground of non-use, proof of *bona fide* use (at least one month prior to the application for revocation) is good defence.
- Use by a Registered User qualifies under Nigerian law as *bona fide* use by the registered proprietor.
- For revocation on the grounds of non-renewal, proof that the Registrar did not issue the statutory notice on the applicant may be a defence.
- Also, where the Registrar had stipulated some conditions to be satisfied, fulfilment of the same shall be a defence to a revocation action.

8.5 What is the route of appeal from a decision of revocation?

An appeal against the decision of the Registrar lies in the first instance to the Federal High Court and thereafter to the Court of Appeal, and finally to the Supreme Court.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The registration of a trademark is deemed to be valid, except where:

- the registration was obtained by fraud or misrepresentation of facts;
- the trademark is deceptive, scandalous, contrary to law or public morality or disentitled to protection by a court of law; or
- the registration was issued in error and without sufficient cause and it wrongfully remains on the Register.

9.2 What is the procedure for invalidation of a trade mark?

The procedure for invalidating a trademark is similar to that of revocation of a trademark. An application in the prescribed format would be made to the Registrar where the procedure is instigated at the instance of a registered proprietor, registered user or other interested/concerned person(s), stating the grounds and particulars for seeking to invalidate the registration. The owner of the subject mark is entitled to be placed on notice and given an opportunity to respond to the allegations.

9.3 Who can commence invalidation proceedings?

Any person who establishes sufficient interest to the satisfaction of the Registrar or Tribunal can commence invalidation proceedings.

9.4 What grounds of defence can be raised to an invalidation action?

Grounds of defence includes prior genuine use and may be a defence to an invalidation action. An honest mistake may be another defence.

See other grounds relevant to this in question 8.4.

9.5 What is the route of appeal from a decision of invalidity?

Please see question 8.5.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An infringement action can only be maintained in respect of a registered trademark. The Federal High Court has exclusive original jurisdiction over trademark matters. The Registry is also empowered by the TMA to take certain administrative actions while the Registrar General of the Corporate Affairs Commission may direct a registered company to change its name for infringing a registered trademark which predates the registration of the company.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The Federal High Courts do not mandate a mediation or settlement procedure prior to trial, although a judge has general powers under the rules to allow a 30-day period to encourage the peaceful resolution of a dispute. The Federal High Court operates a 'frontloading system' which requires parties to file written witness statements on oath, copies of all documents to be relied on during trial and a list of non-documentary exhibits, along with their pleadings (Statement of Claim/Statement of Defence/Reply to Statement of Defence). Once pleadings have been exchanged by all the parties to the action, the court will set the matter down for trial if there are no pending interlocutory applications which must first be determined. Interlocutory proceedings may, depending on their nature, take between five to six months to conclude, barring any bureaucratic delays or interlocutory appeals.

Upon receiving a plaintiff's statement of claim with the frontloaded processes, a defendant is required to file his statement of defence with frontload processes, after which the plaintiff may also file a reply with accompanying frontloaded processes in response to the statement of defence. This usually takes about two months.

Following the conclusion of pleadings by all the parties to the action, the court will set the matter down for judgment.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary (interim and interlocutory) injunctions may be granted to preserve the rights of the applicant, pending the final determination of the parties' rights by the court.

Interim injunctions are granted *ex parte* (without hearing the respondent) only in cases of real emergency, for a short period (seven to 14 days), pending the hearing of an application for interlocutory injunction. Interlocutory injunctions are granted where the justice of the case requires the same, pending the final determination of the case.

Final injunctions are usually granted based on the final determination of parties' rights by the court, usually upon conclusion of the trial.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party may be compelled to provide disclosure of relevant documents or materials to an adversary through procedures called "interrogatories" (to provide information) and "discoveries" (to provide documents).

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence of parties' witnesses is presented in writing under oath at the time pleadings are filed and adopted during trial. Only subpoenaed witnesses are not mandated to file Statements on Oath. Every witness who adopts his Statement on Oath must be presented for cross-examination by the opponent's counsel, otherwise, his testimony will have little or no probative value. All submissions in support of interlocutory applications and final addresses at the conclusion of trial must be presented in writing. Counsel are permitted to orally address the Court for the purpose of emphasis when the written submissions are being adopted in Court. Affidavit evidence is used during interlocutory proceedings, but when there are conflicts in affidavits, the deponents thereof need not attend court to be cross-examined.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings can be stayed pending resolution of validity of the relevant trademarks in another court. The proceedings should be consolidated where the parties and the issues are the same in both proceedings. The court may not stay action because of proceedings before the Trade Marks Registry. If there is an interlocutory appeal on a crucial subject like validity, jurisdiction, standing, etc., proceedings before the Federal High Court are likely to be stayed to abide the outcome of such proceedings.

10.7 After what period is a claim for trade mark infringement time-barred?

The TMA does not expressly specify a time limit for bringing a claim of trademark infringement.

10.8 Are there criminal liabilities for trade mark infringement?

The Merchandise Marks Act Cap M10 Laws of the Federation of Nigeria 2004 prescribes imprisonment, upon conviction by a High Court of an offence under the Act, for a term of two years or a fine, or both imprisonment and a fine. It also prescribes imprisonment for six months or payment of a fine or summary conviction by a Magistrate. In both cases, such offender is liable to forfeiture of all chattel, articles or instruments by means of or in relation to which offence has been committed.

The Trademark Malpractices (Miscellaneous Offences) Act Cap. T12 LFN 2004 criminalises trademark-related offences like false labelling, false packaging, sale, offering for sale or advertising

of any product in a manner that is false or misleading or is likely to create a wrong impression as to its quality, character, brand name, value, composition, merit or safety. The penalty prescribed for the offences under the Act is a fine of not less than 50,000 Naira.

The Counterfeit and Fake Drugs and Wholesome Processed Foods (Miscellaneous Provisions) Act Cap. 73 LFN 2004 prohibits the sale, distribution, importation and possession of counterfeit, adulterated and fake drugs or unwholesome processed food. The Act prescribes a fine or a term of imprisonment or both in appropriate cases.

10.9 If so, who can pursue a criminal prosecution?

The power to prosecute criminal offences lies with the Police and Attorney General (of the Federation or the state, depending on whether it is a federal or state crime).

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Although there are no specific provisions for unauthorised threats of trademark infringement in Nigeria, it is feasible to restrain such conduct by means of an appropriate lawsuit, as constituting the misuse of a trademark right, either upon the basis that the alleged registration was obtained fraudulently, or that the registrant seeks to extend the scope of the registration beyond the rights granted.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence may be raised:

- *Bona fide* use of a mark that is identical or similar to a registered trademark for a continuous period predating the use or registration of the registered trademark by the registered proprietor.
- Non-registration and/or invalidity of the claimant's trademark; absence of a likelihood of deception; where the streams of distribution or specification of goods/services are distinct; and permitted user, consent or acquiescence.
- *Bona fide* use by a person of his name or the name of his place of business or that of his predecessor in title.
- *Bona fide* description of the type or quality of the alleged infringer's goods.

11.2 What grounds of defence can be raised in addition to non-infringement?

The following grounds may be raised:

- Fair use.
- Honest, concurrent use.
- Abandonment of the trademark by the proprietor of the trademark or non-use, as well as non-renewal by the proprietor.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available:

- Damages – punitive, special and general damages.

- Injunctions – preliminary and final injunctions restraining current and future acts of infringement.
- Delivery up for destruction of infringing articles and items.
- Account of profits.
- Costs of the action and solicitors' fees.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs are usually recoverable from the losing party. A specific amount may be recovered where specifically proven (e.g. filing fees). Otherwise the quantum of costs recoverable is usually at the discretion of the court.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An aggrieved party has the right to file an appeal against the decision of the Federal High Court to the Court of Appeal at the first instance, and finally to the Supreme Court. Appeals can be on points of law or facts, or mixed law and facts.

13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be added at the appeal stage with the leave of the court where there are special circumstances making it necessary to call such evidence.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The existing mechanism for preventing the importation of infringing goods, and the primary government agency authorised to seize and/or prevent the importation of infringing goods into Nigeria is the Nigerian Customs Service (NCS). The NCS has the authority to impound such goods where it suspects, upon reasonable grounds, that the goods imported are fake or counterfeit goods. Such goods are liable to be detained, seized or forfeited immediately upon entry into the Nigerian ports or borders. These measures can be resolved fairly quickly where petition is provided in a timely manner, and all relevant information supplied to the agency.

The services of the Standard Organisation of Nigeria (SON) may be utilised. A petition will be made to the Director of SON requesting for the involvement of SON with regards to the prevention of the importation and sale of counterfeit goods into the ports and in the country.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trademarks may only be enforced in Nigeria via a passing-off claim under common law which can be instituted

before the Federal High Courts either alone or as part of an infringement action, for the Trademark Act does not address or affect the right of action for passing off or for the remedies relating thereto. The length, extent or intensity of use required to found a case of passing-off will vary with the peculiar facts of each case and will be such as is required to establish the plaintiff's goodwill or reputation attached to the goods or service in question.

15.2 To what extent does a company name offer protection from use by a third party?

No company or business name identical or confusingly similar to that of a prior company or business name registered in Nigeria can be registered without the consent of the prior company or business name owner. Where a company's name contravenes the foregoing prohibition, the Corporate Affairs Commission is empowered to require such company or person to change its name or the business name.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no specific provisions addressing the protection of book titles and film titles in the TMA. In this case, the Anti-Counterfeiting and Anti-Piracy Laws may become applicable.

If the title can be argued not to be under any of the grounds for refusal, and it is distinctive enough or acquired a secondary meaning, it could be registered at least under Part B.

16 Domain Names

16.1 Who can own a domain name?

Regulation 2 of the General Registration Policy of the Nigerian Internet Registration Association (NIRA) provides that persons resident in Nigeria can register a '.ng' domain name. The term "Person" includes natural and legal persons.

16.2 How is a domain name registered?

An availability search may be conducted by using the search feature on a domain name registrar's site. Only a Nigeria Internet Registration Association (NIRA) accredited registrar may register a domain name. Applications may then be filled out online and submitted via the registrar's website.

16.3 What protection does a domain name afford *per se*?

A registered domain name protects against unauthorised use of similar or identical names by third parties. The courts and NIRA are empowered to enforce unauthorised use by third parties.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The country code top level domain names (ccTLDs) available in Nigeria is .ng.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there is a dispute resolution procedure in Nigeria. The body responsible for the procedures is the Nigeria Internet Dispute Resolution (NIRA) Dispute Resolution Policy ("NDRP")

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The current law on trademarks in Nigeria is the Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria 2004, which is long overdue for review or amendment. Efforts have been made over the years for the overhaul of Nigeria's industrial property laws, in the form of the bill on Industrial Property Commission (IPCOM), which was drafted under the supervision of the Federal Ministry of Industry, Trade and Investment.

The IPCOM bill proposed to create an Industrial Property Commission of Nigeria through the harmonisation of current industrial property laws, repealing existing laws, and providing comprehensive legislation on the subject matter.

This bill is now back with the Ministry, and will soon be updated and returned to the Federal law.

However, in addition to these bills (and because of legislative delays), there have been two private member bills in the works for some time. Those bills have passed the second reading at the National Assembly and are awaiting further legislative action.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

We are not aware of any three important judgements in the trademarks and brand sphere for this period.

17.3 Are there any significant developments expected in the next year?

We anticipate the passage into law of the composite and updated Industrial Property Commission Bill (IPCOM) and the Trade Mark Bill 2016, SB.357, which seeks to repeal the current TMA 1965. The individual Bills have passed through the first and second reading stages and are awaiting further legislative action. The Trade Mark Bill, like the IPCOM Bill, seeks to harmonise Nigerian law in tandem with international best practices. The Bills address exotic forms of trademarks, associated trademarks, geographical indications, Internet service providers (ISPs), famous trademarks, etc.

We also anticipate that in the next year, Nigeria will be joining the Nice International Classification of Goods and Services and other World Intellectual Property Organization (WIPO) Agreements. We look forward to the implementation of more effective rules and regulations such as new practice directives and examination guides.

Other developments include: a planned review and increase of fees, which currently are the lowest in the region; the improved

and ongoing printing of trademark journals and a compendium of trademark rulings on opposition cases; and the harmonisation and integration of our Industrial Property Automation System (IPAS) and online systems. (IPAS is a system developed by WIPO to assist national IP offices in automating their processes.)

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There has been a concurrent increase in the measures to combat the menace of IP theft, anti-counterfeiting and anti-piracy and efforts are being made to make the entire process, together with the various options available, more efficient over the past year.



Dayo Adu is the Managing Partner in Famsville Solicitors and leads the firm's business and corporate practice group. He provides general advisory services on a broad range of intellectual property issues, with a particular focus on Patents, Copyrights, Trademarks and Design Rights in Nigeria.

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The firm's core business is advising clients on innovative and complex transactions and representing them in Corporate and Commercial Transactions and Intellectual Property. Our goal is to be our clients' best partner. We put our clients at the centre of everything we do and collaborate with them to deliver truly innovative solutions.

Famsville's Intellectual Property Practice Group efficiently assists local and foreign associates in the establishment, management and enforcement of their intellectual property rights in Nigeria. The firm has clearly emerged as one of the leading firms in Intellectual Property in Nigeria.

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