

RECORDAL OF CHANGE OF ADDRESS AND TRADEMARK ASSIGNMENT IN NIGERIA





INTRODUCTION

Intellectual property, particularly trademarks, is a dynamic and expanding field in Nigeria. Beyond initial registration, trademark owners must navigate various post-registration processes, such as updating their address and transferring ownership. Effective management and maintenance of trademarks are crucial to preserving their legal protection and market value.

This article explores key post-registration activities, focusing on the procedures for recording a change of address and assigning trademarks, which ensure that trademark records remain accurate and current.

WHAT IS A TRADEMARK

A trademark is a distinctive symbol, sign, logo, device, or slogan used to identify and differentiate the goods and services of one business from those of another. It is crucial for a trademark to be unique, not misleading, contrary to law, immoral, or similar to existing trademarks. While trademark registration is not mandatory, it is highly recommended to provide legal protection and prevent unauthorized use by competitors.

The regulation of trademarks in Nigeria is primarily governed by the Trade Marks Act (“TMA”)¹, which outlines the procedures for trademark registration, rectification, and transmission. Additional regulations include the Merchandise Marks Act² and

1. Cap T13 LFN, 2004.
2. Cap M10 LFN, 2004.

the Nigerian Trade Marks Regulation,³ which together ensure proper management and enforcement of trademark rights in the country.

REGISTRATION OF A TRADEMARK

In Nigeria, trademarks are registered through the Trademarks, Patents, and Design Registry, which operates under the Commercial Law Department of the Ministry of Trade and Investment. It is highly recommended to involve a lawyer or an accredited agent to navigate the registration process.

The process of registering a trademark is as follows:

- ✓ Conduct a search at the Nigerian Trademark Registry (either manually or electronically) to ensure that the proposed trademark does not conflict with existing ones.
- ✓ Submit an application to the Trademark Registry after confirming availability, detailing the applicant's name, address, nationality, a representation of the trademark, and the goods and services for which the trademark will be used.
- ✓ The Trademark Registry will examine the application for legal compliance. If necessary, the Registry may request additional information or issue objections.
- ✓ Accepted applications are published in the Nigerian Trademarks Journal, allowing third parties to oppose the registration within two (2) months if they believe their rights are infringed.
- ✓ If an opposition is raised, the trademark registrar will investigate the matter, and a hearing may be held to resolve the opposition.
- ✓ If no opposition is filed, or it is resolved in favour of the applicant, a certificate of registration is issued, reflecting the initial filing date as the registration date.

The Nigerian trademark registration is valid for an initial period of seven (7) years and can be renewed indefinitely in fourteen (14) year periods. Renewal applications should be submitted at least three (3) months before the due date.

RECORDAL OF CHANGE OF ADDRESS

This is the process of updating the registered address of the trademark proprietor or their representative with the Trademark Registry. It is a vital step to ensure that all communications are correctly directed. The Registrar may record any changes in the name or address of the registered proprietor upon receiving a properly submitted request.⁴ Therefore, if a company changes its address with the Corporate Affairs

3. 1967.

4. Section 40(1)(b) of the TMA.



Commission, it is also necessary to update this information with the Trademark Registry to maintain accurate records.

PROCEDURE FOR CHANGE OF ADDRESS

To update the address of a trademark proprietor, the following steps must be taken:

- ✓ The registered proprietor must apply to the registrar using FORM 19⁵ to update the trade or business address. If the address for service in Nigeria entered in the register is being changed, FORM 33⁶ should be used instead.
- ✓ The application must be accompanied by a resolution indicating the change of address for the registered proprietor.
- ✓ If the application is submitted by an agent, a power of attorney authorizing the agent to act on behalf of the registered proprietor is required.
- ✓ The prescribed fee for the address change must be paid.
- ✓ Once the registrar is satisfied with the submitted information, the address will be updated in the register accordingly.

5. Regulation 82(1) of the Trade Mark Regulations, 1967.
6. Regulation 82(2) of the Trade Mark Regulations, 1967.

ASSIGNMENT OF TRADEMARKS

Once a trademark is lawfully registered, the proprietor (assignor) has the legal right to transfer ownership to another person or entity (assignee). This transfer can encompass either the entire trademark or be limited to specific goods and services covered by the trademark.

If the assignment covers all the goods for which the trademark is registered, the assignor transfers full ownership and all association rights to the assignee. This includes the ability to further transfer the trademark and the right to earn royalties from it. However, if the assignment is limited to certain goods, only the rights pertaining to those specified goods are transferred. In this case, the assignor retains ownership and rights over the trademark concerning the remaining goods.

Under Section 26(1) of the TMA, a trademark assignment can occur either with or without the goodwill of the business. When a trademark is assigned with the goodwill, the assignee inherits the reputation and business associated with the trademark and is generally expected to use the trademark for the same goods or services as the assignor.⁷ In contrast, an assignment without the goodwill means the assignee does not inherit the associated business reputation and is not obligated to use the trademark for the same business purposes previously linked to the brand.⁸

PROCEDURE FOR ASSIGNMENT

To assign a registered trademark, the following procedure must be followed:

- ✓ An application for assignment must be submitted to the Registrar. The application can be made jointly by both the assignor and the assignee to record the assignee as the new owner, or it can be initiated by the assignor alone.
- ✓ The application must include the name, trade or business address, and description of the party entitled to the trademark, along with the instrument of title that supports the claim to the trademark.
- ✓ The required documents include:
 - A power of attorney authorizing representation.
 - A Deed of Assignment containing the details of the assignment, which must be stamped at the Federal Inland Revenue Service.
 - A statement of case outlining the assignee's claim and confirming the assignment.
- ✓ Payment of the prescribed fee must be made.
- ✓ Once the Registrar is satisfied with the provided information, the assignment will be registered in the trademarks journal.

7. Section 26(4) of the TMA.

8. *ibid.*

It is important to note that an unregistered trademark can also be assigned alongside a registered trademark, provided it is used in the same business and for the same goods or services as the registered trademark. However, it is generally advisable for an assignor to register all their trademarks before assigning them to another party to ensure full legal protection and clarity of ownership.

TRADEMARK INFRINGEMENTS AND LEGAL PENALTIES

Unauthorized use of a registered trademark constitutes trademark infringement, allowing the trademark proprietor to take legal action to protect their rights. Remedies for infringement include damages, injunctive relief, and the seizure of infringing goods. Under Section 60 of the TMA, making a false entry in the trademark register is considered a criminal offense, punishable by imprisonment for a term not exceeding seven (7) years.

CONCLUSION

Trademarks play a vital role in branding and are crucial to the identity and success of any business. To ensure robust protection of a trademark, meticulous registration is essential. It is pertinent to emphasise that effective management of trademarks in Nigeria extends beyond initial registration to include crucial post-registration processes like updating addresses and assigning ownership. Ensuring accurate records through prompt updates safeguards legal rights and enhances the trademark's market value. The outlined procedures for changing addresses and assigning trademarks are essential for compliance with the Trade Marks Act. Additionally, awareness of the implications of trademark assignments and potential legal penalties for infringement affirms the importance of diligent trademark management. By following these guidelines, trademark owners can protect their intellectual property and maintain their competitive edge in the marketplace. Ultimately, proactive trademark management not only fosters brand loyalty but also strengthens the overall business reputation, making it indispensable for long-term success.

This article is to provide general guidance and information and does not in any way constitute legal advice. Should you require any legal advice or further assistance on the above, please contact:

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