

# NAVIGATING TRADEMARK ISSUES IN NIGERIA:

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PRACTICAL STRATEGIES  
FOR BUSINESSES

# INTRO DUCATION



Trademark issues in Nigeria present various challenges related to the safeguarding, registration, enforcement, and violation of trademarks within the country's legal framework. As one of the top investment destinations in Africa, Nigeria attracts numerous businesses from around the world. A significant obstacle for these businesses is protecting their brand names in Nigeria. Thus, it is essential to analyze and address trademark issues in Nigeria. This typically involves a combination of securing a knowledgeable local trademark expert, understanding the existing legal frameworks for trademark protection, and navigating the enforcement mechanisms and nuances at the trademark registry. This approach is essential for safeguarding the business interests of both local and foreign trademark owners in the Nigerian market.

## **NAVIGATING TRADEMARK ISSUES IN NIGERIA: WHAT ARE THE ISSUES?**

Navigating trademark issues in Nigeria begins with understanding the various issues that may arise when registering a trademark in Nigeria. This includes fraudulent registration of trademark by a third-party, trademark refusal, trademark opposition, undue registration delay, cancellation for non-use, cyber-squatting, amongst other issues.

### **Fraudulent registration by Third parties/Bad-faith registration**

The Nigerian Trademark Act adheres strictly to the principle of territoriality, meaning that a trademark registered in Nigeria is only protected within the country's borders. Therefore, for a foreign trademark to receive protection in Nigeria, it must be registered with the Nigerian Trademarks Registry.

Trademark squatting is a significant issue happening across the world, including in Nigeria. Fraudsters often register foreign trademarks that are not yet registered in Nigeria, anticipating the brand's future popularity, and intending to exploit its reputation and goodwill. We have often observed that distributors of the trademark owner's products in Nigeria and other African countries engage in this practice. This becomes a big challenge for trademark owners when they discover that their mark has been fraudulently registered, as they have to face substantial legal challenges and undertake costly legal actions to resolve the issue. This typically involves pursuing passing off, cancellation or invalidation proceedings through the Nigerian Trademarks Registry or the courts.

### **Trademark Refusal**

Refusal of trademark by the Nigerian trademark registry can arise for various reasons listed below:

- a. A mark that lacks distinctiveness whether inherently or by virtue of use<sup>1</sup>
- b. It is a mark that is likely to deceive or cause confusion<sup>2</sup>
- c. any mark contrary to law or morality or any scandalous designs<sup>3</sup>.
- d. Mark identical with a trademark belonging to a different proprietor and already on the register in respect of the same goods or description of goods<sup>4</sup>

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<sup>1</sup> Section 9 of the Trademarks Act Cap T 13, Laws of the Federation of Nigeria 2004 ("TMA").

<sup>2</sup> Section 11(a) of the Trademarks Act Cap T 13, Laws of the Federation of Nigeria 2004 ("TMA").

<sup>3</sup> Section 11 (b) of the Trademarks Act Cap T 13, Laws of the Federation of Nigeria 2004 ("TMA").

<sup>4</sup> Section 13 TMA

- e. Name of chemical element or single chemical compound, as distinguished from a mixture, in respect to registration of a chemical substance or preparation<sup>5</sup>
- f. A mark which contains the words "patent", "patented", "registered", "registered design", "copyright", or words to the like effect, and so on<sup>6</sup>.
- g. A mark which contains a representation of the Nigerian coat of arms or flag or other government emblems<sup>7</sup>.
- h. Marks that contain "Red Cross" or "Geneva Cross" or such representations of the Geneva, Swiss Federal Cross in white/silver on a red background and other such crosses as the case may be<sup>8</sup>.
- i. any words such as "President", "Governor," or any letters or devices

Additionally, the registry may partly refuse a mark or issue a conditional acceptance notice where the examiner believes that the trademark contains any part not separately registered by the proprietor as a trademark or contains matter common to the trade or otherwise of a non-distinctive character. In this case the registry can require a disclaimer.

### **Trademark Opposition**

Nigerian Trademark Law, specifically Regulation 48 of the Trademarks Regulations, stipulates that any person may file a notice of opposition with the Registrar within two months from the date of a trademark's publication based on certain grounds. Trademark opposition challenges usually arises when brands proceed to file their application without conducting availability searches or conduct any form of due diligence.

When seeking to register a trademark, another party might oppose your application for several reasons. Firstly, if your proposed trademark is similar to an existing trademark in a way that could confuse consumers, this could lead to opposition based on likelihood of confusion. Secondly, opposition may arise if the opposing party believes they have prior rights to the trademark, whether through earlier use or common law rights. Finally, trademarks that are merely descriptive or generic for the goods or services they represent can face opposition.

### **Undue Registration Delay**

Many trademark applicants usually find that the registration process and issuance of certificate takes a long period of time in some cases. Delays in the trademark

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<sup>5</sup> Section 12 TMA

<sup>6</sup> Regulation 17 (a) Trademarks Regulation 1967

<sup>7</sup> Regulation 18 (a) Trademarks Regulation 1967

<sup>8</sup> Regulation 17 (b) Trademarks Regulation 1967

registration process in Nigeria can be attributed to a combination of factors, including backlogs at the registry and ongoing digitization efforts. The trademark office currently faces a backlog of applications due to high volumes of application. This is further worsened by the transition from old online platform to new online platform at the registry. The migration to digital platforms is plagued with the challenge of several technical glitches which slows down the output of the registry. These complexities, compounded by the coexistence of online and physical processes, contribute to delays in processing trademark applications.

### **Cancellation for Non-Use**

The proprietor of a registered trademark may face cancellation action upon an **application made by any concerned person to the court** or at the option of the applicant on the following grounds<sup>9</sup>

- a. That the trademark was registered without any bona fide intention on the part of the applicant and that there has been in fact no bona fide use of the trademark in relation to those goods by any proprietor for the time being up to the date one month before the date of the application.<sup>10</sup>
- b. 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 (5) years.<sup>11</sup>

It is essential for a trademark applicant or proprietor to actively use their mark after registration to avoid potential issues. However, defensive trademark registration constitutes an exception to the non-use doctrine under the Trademarks Act. The law permits a Proprietor to apply for the defensive registration of its well-known trademark notwithstanding that the proprietor registered in respect of the familiar goods does not use or propose to use the trademark in relation to those other goods.<sup>12</sup> In this case, the applicant needs to demonstrate that the mark is so well-known that its use with different goods would likely be perceived as indicating a connection in trade between those goods and the person entitled to use the trademark for the well-known goods. Once registered defensively, the trademark is safeguarded against removal under Section 31 of the Act for those goods, preserving its status on the register.

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<sup>9</sup> section 31 of the TMA

<sup>10</sup> Section 31(1), of the TMA

<sup>11</sup> Section 31(2), of the TMA

<sup>12</sup> Section 32, of the TMA

## Cybersquatting/Typo squatting

Cybersquatting and typo-squatting is another significant trademark issue that arises in Nigeria and across the world. Cybersquatting involves registering domain names similar to established trademarks with the intent to profit unfairly from the goodwill associated with those brands. Similarly, typo-squatting exploits common misspellings or typographical errors of popular domain names to divert web traffic for illicit purposes.



## RESOLVING TRADEMARK ISSUES IN NIGERIA

**A. Bad Faith Registration:** Addressing bad faith registration of intellectual property rights in Nigeria typically involves legal remedies and procedures. Some of the steps that can be taken to remedy bad faith registration in Nigeria include:

- i) **Issuing a cease-and-desist Letter:** Before proceeding to legal action, consider sending a cease-and-desist letter outlining your concerns and demanding that the other party stop using the trademark.
- ii) **Instituting opposition Proceedings:** where you have discovered that a malicious party has applied for a trademark similar to your brand name in bad faith, you can file an opposition at the Trademarks Registry in Nigeria against the infringing mark. This is typically done within two months of the publication of the trademark in the Trademarks Journal. In this case ensuring that you have

local counsel on ground conducting watch service would help discover such loophole in a timely manner for an opposition proceeding.

### **Case Study**

The case of **Piaggio C.S.P.A. vs. Autobahn Techniques Limited & Registrar of Trademarks (FHC/L/CS/1307/12)** revolves around trademark infringement in Nigeria. This was an appeal which flowed from decision of the registrar of trademarks to the Federal High Court.

Piaggio has a global business, and it uses various trademarks including the word Piaggio and a hexagonal device. Piaggio registered its trademark in Nigeria, before going on to appoint Nigerian company, Autobahn Techniques as its local distributors. Subsequently, Autobahn Techniques filed seven trademark applications for the word Piaggio together with the hexagonal device. Piaggio opposed these applications on the ground that Autobahn Techniques could not claim to be the true proprietor of the trademark. Autobahn Techniques in turn applied to cancel Piaggio's registration for non-use.

The judge held that the opposition should succeed and the application for cancellation should fail. The reason for the decision focuses on the concept of true proprietorship and bad faith. The court held, that all trading activities carried out by the Autobahn Technologies in respect of the PIAGGIO branded products in Nigeria were pursuant to the authorization and active support of the Piaggio. The ration for this decision is that an agent or distributor may not exclude the trademark owner from enjoying the goodwill accrued in the local market simply because the agent has been involved in the promotion of the products in the local market. To this end the court held that Autobahn Technologies trademark application was unlawful and must be refused. Piaggio as the inventor of the mark and its first user will have superior claim to proprietorship. This decision is very important as it shows the importance of early registration.

- iii) **Cancellation/Rectification Proceedings:** For trademarks that have already been registered, you can file for cancellation or rectification of the trademark registration. This can be done if you can prove that the trademark was registered in bad faith or that the registrant is not using the trademark.
- iv) **Institute a Passing off Action:** Passing off action primarily pertains to unregistered trademarks. Passing off happens when someone deliberately or unintentionally passes off their goods or services as those belonging to another party. To prove passing off an applicant must be able to proof the following issues in Court:

- **Goodwill/Reputation:** Show that your mark is associated with specific goods or services in the public's perception, establishing goodwill.
- **Misrepresentation:** Demonstrate that another trader's actions have confused or misled customers into believing their goods or services are yours.
- **Damage:** Prove that this misrepresentation has harmed your goodwill, leading to actual or foreseeable financial or reputational loss.

**B. Trademark refusal & trademark opposition:** In the case of trademark refusal or opposition it is essential to understand the reasons for the query/refusal/opposition. This can be determined by examining factors such as:

- i) **Industry/Class:** Determine if the query or refusal was because of conflicting marks in the same or related industries/class. If two marks are used in unrelated industries, the likelihood of confusion is generally lower, and a conflict might be avoided. To resolve the issue of conflicting marks in the same industry, one may consider limiting the scope of goods or services of their mark.
- ii) **Distinctiveness of the mark:** The strength of a trademark is crucial for its registration, as it must meet regulatory standards regarding distinctiveness<sup>13</sup>. This entails evaluating the mark's distinctiveness inherently or acquired distinctiveness through long term use to prevent a trade description that is likely to mislead consumers.<sup>14</sup>

it is also essential to present all available evidence when filing a written representation to overturn. Such evidence may include; Evidence of prior use or arguments demonstrating the differences between your mark and existing trademarks, as this will be very helpful to overturn refusals. In some cases, it may be possible to negotiate with the opposing party to reach a mutually acceptable resolution. This could involve a little compromise from one end, for example, modifying the trademark, limiting the scope of goods or services, or entering into coexistence agreements.

### **C. Undue registration delay**

Navigating this evolving landscape requires patience, proactive monitoring, and potentially seeking guidance from professionals familiar with the changing trademark registration procedures in Nigeria.

### **D. Cancellation for non-use**

In this case it is important to show proof of use of the mark within the stipulated period in Nigeria. In the absence of proof of use, a brand will also be overcome a non-use action where the brand is a well-known mark that has opted for

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<sup>13</sup> Sec 9(2) of the Trademarks Act.

<sup>14</sup> Issac Ogbah, Understanding Trademark Law in Nigeria (Legal Jurisprudence Limited 2019)184.



defensive trademark registration. Under the law owners of well-known marks particularly an invented word or phrase, that has gained significant recognition in specific goods (referred to as "familiar goods") to register such mark defensively for other goods. This registration is permissible even if the trademark owner does not use or intend to use the mark for these additional goods.

**E. Cyber-squatting:** it is important to have a proactive monitoring service for monitoring the marketplace for unauthorized use of client mark and take appropriate legal action, such as sending cease-and-desist letters<sup>15</sup>, initiating civil or criminal litigation, initiating proceedings under the Uniform Dispute Resolution Policy (UDRP) or lodging compliant at the Nigerian Internet Registration Association.

i) **Criminal action under Cybercrime Act 2015 as amended:** Section 25(1) and (2) of The Cybercrimes Act addresses the unauthorized use of names, trademarks, domain names, or other identifiers on the internet or computer networks in Nigeria. If a person intentionally uses any of these identifiers without proper authorization, with the aim of interfering with the legitimate owner's use, it is deemed to be an offense under this Act. The penalty for this offense can include imprisonment for up to 2 years, a fine of up to ₦5,000,000.00, or both. When deciding on the penalty, the court considers factors such as my refusal to relinquish the identifier upon formal request by the rightful owner or any attempt I make to obtain compensation for releasing the identifier to the rightful owner.

ii) **Initiating proceedings under the Uniform Dispute Resolution Policy (UDRP):**

The Uniform Dispute Resolution Policy (UDRP), developed by the Internet Corporation for Assigned Names and Numbers (ICANN) and the World Intellectual Property Organization (WIPO), aims to resolve domain name disputes swiftly outside traditional courts. It allows global complaints against abusive domain registrations. Registrants of certain top-level domains agree to UDRP terms, binding them to its dispute resolution procedures. To file a UDRP complaint, the complainant must prove that the domain name is identical or confusingly similar to their trademark/service mark, the registrant lacks legitimate rights or interests in the domain, and the domain was registered and used in bad faith. UDRP decisions can result in domain cancellation or transfer, but no financial awards. Proceedings can continue based on the complainant's evidence even if the domain owner doesn't participate.

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<sup>15</sup>Yetunde Okojie and Bisola Scott 'Recommended ways to Protect Pending Trademarks in Nigeria' <https://www.mondaq.com/nigeria/trademark/740682/recommended-ways-to-protect-pending-trademarks-in-nigeria>

**Case Study: Menarini Silicon Biosystems S.p.A. v. Domain Administrator, Sugarcane Internet Nigeria Limited<sup>16</sup> (Case No. D2023-4373).**

Menarini Silicon Biosystems, part of the Menarini Group, owns the Italian trademark SILICON BIOSYSTEMS THE LIVING CELL COMPANY and operates the website “www.siliconbiosystems.com”. The disputed domain name, <siliconbiosystem.com>, was registered by Sugarcane Internet Nigeria Limited (the Respondent) and used for pay-per-click links.

The Respondent has been found to have registered and used domain names in bad faith in a number of UDRP (Uniform Domain name Resolution Policy) cases. See, e.g., Sentara Healthcare v. Domain Administrator, Sugarcane Internet Nigeria Limited WIPO Case No. D2023-0745. The Complainant having established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent on the other hand failed to rebut the Complainant’s claim and failed to come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain.

The Panel found that a domain name that consists of a common, obvious, or intentional misspelling of a trademark is confusingly similar to the relevant mark and considers that the use of “silicon biosystem” in the disputed domain name was likely intended as misspelling of the pluralized version of “SILICON BIOSYSTEMS”, which is the dominant part of the Complainant’s mark. **paragraph 4(b)(iv) of the Policy.** The Panel ordered that the disputed domain name be transferred to the Complainant.

iii) **Seeking redress at the Nigeria Internet Registration Association (NIRA):** For domain names registered through the Nigeria Internet Registration Association (NiRA) with a .ng country code top-level domain (ccTLD), proprietors may elect to resolve disputes via NiRA’s Dispute Resolution Policy (NDRP). Analogous to the Uniform Domain-Name Dispute-Resolution Policy (UDRP), the NDRP delineates procedures for adjudicating disputes concerning .ng domain names. Paragraph 4a of the NDRP corresponds to paragraph 4b of the UDRP, specifying the criteria a complainant must satisfy to obtain a favorable ruling. Successful complainants may secure the transfer or cancellation of the cybersquatter’s domain name under the NDRP.

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<sup>16</sup> <https://www.wipo.int/amc/en/domains/decisions/pdf/2023/d2023-4373.pdf>

## **CONCLUSION**

Navigating trademark issues in Nigeria requires businesses to understand and address challenges such as fraudulent registrations, trademark refusals, oppositions, registration delays, cancellations for non-use, cyber-squatting, amongst several other issues. By conducting thorough due diligence, engaging experienced Intellectual property (IP) legal counsel, proactively monitoring trademarks, and understanding the different enforcement pathways available to tackling infringement issues, companies can effectively mitigate these risks.

DISCLAIMER: This article is intended to be a general guide on the subject matter and does not constitute advice to readers in and of itself. Readers should seek expert advice regarding their specific circumstances.

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