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Nigeria Trademark Regime: A Comparative Analysis With South Africa And Ghana

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Abstract

The paper examines the comparative analysis of Nigeria's trademark laws with those in South Africa and Ghana is its main objective. This is justified by the fact that such a comparison will not only highlight the shortcomings of the Nigerian trademark system, but will also guide reform initiatives aimed at improving trademark management. In this paper, both comparative and qualitative methods were used to make the case for reforming the Nigeria trademark regime. The article identifies crucial areas of the Nigerian trademark regime that demand updating. Additionally, it is discovered that the Nigerian trademarks regime does not grant a trademark application or prospective user a broad variety of advantages over those that exist in other jurisdictions. In order to reflect current developments in product/service identification, the report consequently suggests that a new Trademark Act be passed that is modeled after the existing trademark laws in Ghana and South Africa.

Key words: - Trademark, Identification, Product, Services, Trade

1INTRODUCTION

The trademark is a key medium or format via which business owners project their products into streams of trade, goods, and services. **(Cornish ER, 1999)** It performs vital origin, differentiation, quality assurance, and marketing functions for the specific production. Through the use of names, designs, letters, numbers, logos, trademarks, marks, or the shape of the good or their packaging to which the mark is applied, this in turn helps to distinguish their products and services from others' offerings and build goodwill for them. **(Cornish ER, 1999, Mordi M, 2011)**

Particularly in nations where trademark rules are periodically revised to reflect contemporary trends in product/service identification, trademarks are extremely important for the promotion of trade and economic development. Numerous jurisdictions have passed laws protecting and regulating the use of trademarks in response to this role. **(Olugbenga OA and Suliyat OO, 2014/2015)**

The Nigerian Trademark Regime: A Comparative Analysis with South Africa and Ghana will be discussed in this essay against this backdrop. After this introduction, which constitutes the first section, the paper is broken into five parts.

The Nigeria trademark prospect for national growth is examined in Section 2. It makes the case that an effective system for defending and enforcing trademark rights would increase foreign

investors' faith in the Nigerian economy. This would enable the country to attract more crucial foreign direct investment.

The crucial aspects of the Nigeria Trademark Act are covered in Section 3. It claims that the Nigeria Trademark Act (NTMA), which aims to regulate trademark administration, addresses crucial issues like the definition of marks, the requirements for registration, a trademark owner's rights and their effects, the process for acquiring rights, acts constituting infringement, remedies, etc.

Section 4 compares the trademark laws of Ghana and South Africa with those of Nigeria. It makes the case that, according to contemporary trends, the definition of trademarks in Nigeria appears to be narrow, whereas those in South Africa and Ghana are more inclusive and broad. Furthermore, it claims that even though Nigeria is a party to the Paris Convention on the protection of industrial property, this international duty is mostly ineffective in the nation since it has not been domesticated into local legislation.

The paper ends in section five with a suggestion.

2 Nigeria Trademark Prospect for National Development

The majority of the common traits of low-income developing nations are claimed to be present in Nigeria. **(Todaro MP and Smith SC, 2009)** She depends on oil for more than 90% of her export revenue, nearly 30% of her GDP, **(Todaro MP and Smith SC, 2009)** and 70% of her federal budget funding. **(Todaro MP and Smith SC, 2009)**

If Nigeria is to buck this trend, she has been recommended to enhance domestic food production and labor productivity, pursue more foreign investment, and utilize market price incentives for resource allocation more effectively, among other things. **(Todaro MP and Smith SC, 2009)** In these ways, trademarks can act as a catalyst for the growth of the national economy. The confidence of foreign investors in the Nigerian economy would increase if there was a robust, effective, and efficient system for the protection and enforcement of trademark rights. This would enable the country to attract more crucial foreign direct investment. The nation's economy would experience an increase in commercial and industrial activity, leading to an increase in the country's gross domestic product. This is especially true because companies and corporations would be able to take use of the advantages of trademarks that were previously listed in this work. (One of the major advantages of trademarks is that firms and businesses would record higher sales and increased revenue. This also has a direct effect on the economy as tax revenues accruing to the governments at various levels are expected to receive a boost. This serves as an alternative source of revenue to the governments, and with that, they are expected to be better positioned to provide social services, more funding for education at all levels and maintain infrastructure within the state.) A higher GDP would lead to a higher per capita income, which would improve the distribution of the nation's resources. The local populace would be able to innovate more effectively if there was a reliable system in place for the protection and enforcement of trademarks. All of these would make the economy more globally competitive because local companies could export their goods and services in accordance with international norms thanks to standardization and packaging. Above all, there would be a supportive environment for both the transfer and development of foreign and domestic technology.

1.3 The Crucial Aspects of the Nigerian Trademark Act

In its effort to regulate trademark administration, the Nigeria Trademark Act (NTMA) addresses crucial issues like what can be registered as a trademark, the rights of a trademark proprietor, the scope of these rights, the process leading to the acquisition of rights, acts constituting infringement, remedies, etc. Below, we address a few of these concerns.

i. Definition of Trademark

According to Section 67 of the Nigeria Trademark Act (NTMA), trademark means:

Except in the case of a certification trademark, the Nigeria Trademark Act **(Section 67 Trademark Act, 2004, *Onayemi v Bouari*)** prohibits the use of marks on goods to suggest,

or to make clear, a connection in the course of commerce between those goods and a person who has the legal right to use the mark as the owner or a registered user, whether or not that person's identity is made known...

Two sentences from this wordy but substantively constrictive definition need more research. These have been "used or are intended for use." furthermore "suggest a link in the course of trade." The explanation that follows will also make the case that service markings and non-conventional marks are not covered by the definition above.

ii. Used or Proposed to be Used

According to the definition of "use or proposed to be used," a mark will be registered as a trademark if it has either been used or is planned to be used after registration. So, using a mark in actual commerce prior to registration is not required. This clause is advantageous since it permits trademark owners to get legal protection before actual use. The owner of the proposed mark must nonetheless show an intention to use even though actual use is not necessary before registration. The necessity for this is clear: it prevents trademark trafficking, in which a person registers a trademark in Nigeria that is well-known in another country with no intention of using it and only with the idea of selling it to the legal owner if he tries to do business there.

iii. Indicate a Connection in the Course of Trade

This implies that a proposed mark must be registered in order to serve commercial interests. (**Imperial Group Limited v Phillips Morris Co Ltd, 1982**) Therefore, even if a mark satisfies all standards for registration, it will not be registered if it is submitted with the aim to use it for religious or other non-commercial purposes. To this aim, unless it can be shown that the magazine plans to generate advertising revenues, a mark that is sought to be registered (**Update Trademark, 1979**) for a non-profit publication will not be approved. (**Golden Pages Trademark, 1985, Edenborough M 1995**) The court ruled in *Aristoc Ltd v Rysta Ltd (1945)* that there was insufficient evidence to support the use of a mark to imply a connection in the course of business for the defendants' laundry and stocking mending services, hence the mark could not be registered. The defendants had no trade or activity on which the proposed mark, if registered, will be used, the court determined because they were not the stockings' manufacturers. The usage of the term "trade" in this expression has another significant significance. Therefore, if a mark is on a good, it cannot have indicated a connection in the course of trade since, as correctly argued by Edenborough, a mark that is not made apparent until after the purchase of the goods with which it is associated cannot be connected with the goods "in the course of trade"; it can only be so connected in the course of their use. (**Edenborough M, 1995**).

iv. Trademark not Inclusive of Service Mark

The limited nature of the aforementioned definition is one of its flaws. Service marks are specifically excluded. Thus, service marks were not registrable in Nigeria prior to the Minister of Commerce's 2007 Regulation. By means of this Regulation, the Minister increased the number of goods classes from 34 to 45, referring to the newly added classes primarily as relating to services. He claimed to have done this in accordance with the authority granted to him by Sections 42 (1) and 45 of the Trademark Act. Intellectual property (IP) practitioners and academics are debating whether the minister's behavior is legally sound in light of this contentious Regulation.

According to Section 42(1), the Minister has the authority to enact regulations giving the trademark registrar the authority to "amend the register" in order to conform to any "amended or substituted classification that may be specified." The minister has the authority to issue regulations "for classifying commodities for the purposes of the registration of trademarks," according to Section 45, (1)(b).

The Nigeria Trademark Act has plain and straightforward language, therefore it is unclear how those provisions (The Nigerian courts have variously held that when the words of statutes are clear and unambiguous, they should be given their literal meanings) (**Buhari v Obasanjo, 2005, Oluwalogbon v Government of UK 2005**) could be interpreted to provide the minister the authority to classify "services" as products, which would be contrary to the application of

trademark registration to things. This is especially true as Sections 42(1) and 45(1)(b) only give the Minister authority to categorize commodities, not services, and Section 67 expressly defines trademark as marks placed on goods (again, not on services). We contend, along with a number of other academics, that the minister's action was *extra vires*, unconstitutional, and void because only the National Assembly has the authority to change or repeal any of its Acts. (**Section 5 Constitution of the Federal Republic of Nigeria 1999**). Since service marks are not included in the determination of this Regulation's validity in Section 67 above.

Restricted Definition

It is also apparent that the definition of mark provided above does not include non-traditional signs like fragrance, forms, and product packaging. The attempt to register the shape of the Coca-Cola bottle under this Act, which was unsuccessful in the UK before 1994, (**Re coca-cola, 1986**) would undoubtedly fail. Even though the duration is shorter than what would have been acquired if the shapes had been registrable as trademarks, (**Laws of the Federation of Nigeria, 2004**) even though the duration is shorter (**Section 23 Trademark Act**) the shape of items is protected under the Patent and Design Act (PDA).

Types of Trademarks

Similar to other jurisdictions that recognize fewer categories of trademarks, the Nigeria Trademark Act (NTMA) recognizes five (5) different types. (Type of marks in other jurisdiction like the UK is limited to well-known, certification and collective trademarks.) A number of distinctive, defensive, linked, certification, and related trademarks may be registered under the Act's various provisions. (**Section 24; 25; 32; 27; 28; 43; trademark Act, 2004**) According to Section 24 of the Act, if a portion of a trademark is to be claimed separately, it must be registered as a separate mark. In other words, the owner of a mark that combines a term, an image, and a color will only be granted exclusivity with respect to the entire trademark following registration, not for each component. The supreme court gave this legal approval in the case of *Ferodo Ltd v Ibetto Industries Ltd* (2004) because it did not buy the argument that the registration of the word mark "FERODO" also gave the owner monopoly over the mark's backdrop design. According to the court, the owner should have filed the backdrop design as a separate trademark if protection for it was required, presuming it was registrable.

A trademark that has been registered defensively is one that was created and is well-known enough to support its defensive registration in classes of goods aside from the one in which it is typically used. Before their marks to be protected in Nigeria, owners of well-known marks must register them under Section 32.

According to Section 27 of the Trademark Act, a mark must be registered as an associated trademark when it is the same as another mark of its kind, is used to identify goods that are the same as or very similar to the mark in question, and is held by the same person. Separate, defensive, and similar trademarks that have been registered in a succession are examples of marks that can be registered as linked trademarks. It is not possible to assign or transmit individual marks that have been registered as related trademarks. (**Section 28, 27 (2) NTMA 2004**)

Another approved mark under the Act is the certification mark. It refers to marks that set apart from items that aren't certified in the course of trade those that are with regard to origin, material, method of manufacture, quality, accuracy, or other attributes. (**Section 43 Trademark Act 2004**). Finally, similar trademarks filed as a series under Section 25 are protected under the Nigeria Trademark Act (NTMA). When a trademark holder has many trademark registrations for the same items that differ only in quality, price, place names, color, etc., he is required to register all of the trademarks as a series in a single registration. This is exemplified perfectly by a number of Coca-Cola Company products. Therefore, after each has been registered independently, Coca-Cola, Coca-Cola Black Cherry Vanilla, Coca-Cola Cherry Zero, Coca-Cola Zero Caffeine Free, Diet Coke with Lime, Diet Coke with Splenda, etc. will all be registered in one registration as a series. This is done to prevent origin-related misunderstandings or deceit. (It however remains to be seen if this typology is useful in avoiding confusion or deception in practice.)

Registrable and Non- Registrable Marks

Marks are separated between registrable and non-registrable marks under the Nigeria Trademark Act (NTMA). For a mark to be registrable under the Act, it must either have passed the test laid down in Section 9, that is, it must be inherently distinctive; **(Section 9 Trademark Act 2004)** or where it is required that the proposed mark must have the capability to distinguish **(Section 10 (2) (a) & (b) Trademark Act 2004)** even if it is not presently inherently distinctive. Section 9 (1) (a)- (e) provides a guide on marks which may pass this test as follows:

- The name of a company, individual or firm (represented in a special manner);
- Signature of the applicant;
- Invented words;
- Non –descriptive words; and
- Any other distinctive marks.

This two-pronged approach to trademark protection in Nigeria resulted in the division of the trademark register into Part A and Part B, **(Section 2 (3) Trademark Act 2004)** with the implication that marks that are already distinctive by nature under Section 9 are registered in Part A while marks that can only become distinctive through use under Section 10 are registered in Part B. **(Edenborough M, 1995)** Edenborough claims that this duality under the previous 1938 UK TMA (which the NTMA faithfully adopted) was intended to grant a superior right to marks registered under Part A. **(Edenborough M, 1995)** But it is impossible to perceive this purpose in action. This dichotomy, according to some scholars, is untenable for this reason. **(Mordi M, 2011)** The dichotomy is unnecessary, in our opinion, for the following reasons.

While a general reading of Section 9 clearly indicates that the section is meant for inherently distinctive marks (marks which, by their very nature, come with distinctive ability), which require no proof of prior use to be registered, a close reading of Sections 9 and 10 reveals inelegant drafting on the part of the draftsmen as a result of which the intended superiority cannot be seen in practices (even if they had been in use before application for registration is made), For marks other than those listed in Section 9 (1) (a)–(d), paragraph 1 (e) of this section requires confusingly evidence of distinctiveness, and the main piece of evidence needed for this is proof of the mark's earlier use.

In a similar spirit, Section 9(3) (b) mentions proof of use as a determinant in defining "suited to differentiate." Therefore, the issue arises: why do we still have Section 10 of the NTMA, which is intended for such marks, if marks that are not intrinsically distinctive can be registered under Section 9 because they have acquired uniqueness through use? Simply put, Section 9 should be for trademarks that do not require proof of use, while Section 10 should be for trademarks that do. It becomes challenging to understand the reasoning for the dichotomy as it currently stands for this reason.

The NTMA also allows for the registration of marks that are either not registrable at all or that can only be registered after receiving approval from the relevant authorities. Such marks include false and scandalous marks, **(Section 11 Trademark Act 2004, HN Brock \$ Co Ltd 1909, Kevin Scranages Application, Ghazillian's Trademark Application, 2002)** similar and identical marks, **(Section 13 Trademark Act 2004, Alban Pharmacy Ltd. v. Sterling products int. Inc. 1968, Wholesale colonial Trading Co. v. Ikorodu Trading Co)** chemical compound names, **(Section 12 Trademark Act 2004)** and coats of arms for Nigeria and its states. **(Section 62 Trademark Act 2004)**

Rights Conferred by Registration

Whether a mark is registered under Part A or Part B of the Act determines the rights granted to the holder by that section. This is so because Section 5 of the Act exclusively grants rights to owners of marks registered under Part A, whereas Section 6 grants rights to owners of marks registered under Part B. There is little to no distinction between the rights formed under the two Sections, notwithstanding the legislature's intention to create a superior right in Section 5 (1) and an inferior one in Section 6(1), as already mentioned. This clause is just one of the many ambiguities brought about by clumsy language that were carried over from the 1938 UK TMA.

Section 5(2), which presumes infringement when another person uses an identical or strikingly similar mark in connection with goods similar to those for which the former mark is registered, should have been used to establish the supremacy of Section 5(1) right. When it comes to trademark infringement, its counterpart provision in Section 6(2) imposes a higher duty on owners of marks registered under Part B by stating that:

No injunction or other relief shall be granted to the plaintiff if the defendant proves to the satisfaction of the court that the use of which the plaintiff complains is not likely to mislead, cause confusion, or give rise to the belief in a connection in the course of trade between the goods and someone entitled either as a proprietor or as a registered user to use the trademark. A closer examination of Section 5 (2) reveals, however, that a defendant will not be held responsible for an infringement if he can persuade the court that the usage in question is not likely to mislead, confuse, or produce any of the links noted in subsections 2(a) and (b). Therefore, the aforementioned reasoning makes it impossible to understand how Section 5(1) rights differ from Section 6(1) rights, **(Section 6(1) Trademark Act 2004)** and therefore, it also renders the duality of the trademark registry into two parts meaningless. However, a trademark owner's general rights include both a positive right to use the mark and a negative right to forbid others from doing so without his or her permission. **(Section 33 Trademark Act 2004, Section 13(2) Trademark Act 2004)**

Trademark Infringement

In Nigeria, use of a trademark that is not by the owner or a registered user on the same or similar classes of goods in a manner that is likely to mislead, confuse, or suggest a relationship between the owner or registered user and the alleged infringing user constitutes trademark infringement. **(Section 5(2) Trademark Act 2004)** Therefore, according to the NTMA, there can only be infringement if a mark that is identical or nearly same is used on goods that are identical or nearly identical. Therefore, it won't be illegal to use a comparable or strikingly similar mark on unrelated goods.

The issue with this narrow interpretation of infringement is that it leaves many well-known brands, who have spent a lot of money building their reputations and goodwill, vulnerable to infringement. Mischievous businesses have violated well-known brands like Coca-Cola, Nokia, etc. by using them on products that are identical to or substantially similar to those infringed upon. In categories other than the ones in which their owners have registered them. Therefore, before making an investment in the Nigerian markets, owners of well-known marks will need to think about their possibilities. A straightforward solution is for the owners of these well-known marks to defensively register them under section 32. However, this will cost more money and might affect the choice to conduct business in Nigeria. **(Alban pharmacy Ltd v sterling product int. inc.1968, Beecham Group Ltd v Esdee food products Nigeria Ltd, 1980)**
Convention Applications and Priority Rights

The Paris Convention on the protection of Industrial Property is a treaty that Nigeria has ratified. (Nigeria acceded to the Convention on 17 July 1963 while the convention came into force in Nigeria on 2nd September 1963) Given this, she must domesticate and uphold the Convention's fundamental provisions, including national treatment, priority rights, and common standards. **(See Articles 2 and 3)** To make sure that the Nigerian trademarks Act's provisions regarding convention applications and priority rights are followed. Section 44 mandates that the Nigerian Trademark Registry safeguard convention applications submitted in Convention countries by applications having ties to any of these Convention countries, so long as a later Nigerian application is filed within six months of the earlier Convention application. However, the Nigerian Trademark Act's Section 44(5) has rendered it impossible to protect trademark priority rights or convention applications. A country is considered a "Convention country" under that clause if the president has made a declaration designating it as such, and the statement is currently in effect. However, the president has yet to make the necessary announcement. This has the result that even if convention petitions satisfy all other Section 44 conditions, they would not be granted priority privileges in Nigeria.

1.4 Trademark Laws of Ghana and South Africa with those of Nigeria.

Following a description of the key elements of the Nigeria Trademark Act, this section compares the trademark laws of Nigeria, South Africa, and Ghana in order to highlight the advantages and disadvantages of each.

1. Definition of Trademark

The definitions found in the South African and Ghana Trademark Acts and those found in the Nigeria Trademark Act have quite different texts and outcomes. The Nigeria Trademark Act's definition is awkward, verbose, and constrictive, as has already been mentioned. It does not include standard trademarks like flavor, aroma, or product packaging (***Ferodo Ltd v Ibeto Industries Ltd SC 95***) etc. and service marks. There is a lot of ambiguity about the legality of the service mark protection now provided in Nigeria due to the Minister of Commerce's 2007 attempt to address issue. Additionally, the concept regards certification marks differently from trademarks. One is left questioning the rationale behind this.

Additionally, the Nigeria Trademark Act upholds the necessity of a mark "showing a relationship in the course of trade." This disregards the use of distinguishing logos or signs/marks by non-governmental organizations (NGOs) and other non-profit organizations, such as mosques and churches, unless those uses are in conjunction with a specific trade or enterprise. Anyone can register these marks and use them in the course of business without risk of legal repercussions because their unique marks/logos cannot be registered for failure to indicate a link in the course of trade. (***Olugbenga OA and Suliyat OO, 2014/2015***)

Given that it excludes service marks and distinctively shaped containers or designs, the Nigerian definition of trademarks looks to be restrictive in the present marketplace. It excludes services from the registration of trademarks and restricts them to products. Even though the minister, acting within the scope of Section 42(1) of the Act, expanded the classification of commodities to include services by adopting Nice classification, this issue is still up for debate in some circles. Furthermore, the definition of trademark is overly limited because under Nigeria's Patents and Designs Act, a "container for products" can only be registered as a design. The author of this essay believes that a creation's true status as a design should not prevent it from being registered as a trademark in a separate proceeding. If it serves the goal of a trademark, which is to differentiate a particular proprietor's goods or services from those of competitors', it is unique to that proprietor and is used in the course of business. (***See Marett P, 1996***)

The definition of a trademark is broader in the South African Trademark Act, in contrast. According to the Act, a mark means: "... any indication that can be graphically represented, including a device, name, signature, words, letters, digits, forms, configuration, pattern, decorative, color, or container for commodities, or any combination of the aforementioned." So, both the registration of products and services is provided for. The requirement that a mark must be registered in relation to certain goods or services is expressed very clearly. (**Section 11 South African Trademark Act**)

Since services providers are clearly protected, there are no unnecessary restrictions on the registration of marks. In this approach, the Act offers a broader level of protection for a business owner or brand owner. (**Section 1(2) (XI) Trademarks Act of South Africa**)

In a similar vein, Ghana's trademark definition is also more expansive than Nigeria's. The Ghanaian Act defines a trademark to include both products and services. (**Section 1 Ghana Trademark Act, Mordi M, 2011**)

ii. Protection of Well-known Marks

The Paris Convention on the protection of industrial property is ratified by Nigeria, but because local laws have not been adapted to reflect this international commitment, it is essentially unenforceable there. The Nigerian Trademark Act has provisions for international agreements, however these agreements' actual provisions are rarely carried out or enforced in practice, save from when they are used as convincing arguments.

The safeguarding of renowned or well-known marks is one such clause. Well-known marks may only be registered as defective marks under this Nigerian Trademark regime, as per Section 32 of the Nigerian Trademarks Act. This means that a proprietor of a well-known mark is required to register it in every class that is open, regardless of whether he currently uses or intends to employ it there. The question of whether a well-known mark receives protection against infringement arises in the event that the owner of the mark does not register in every class, particularly if those classes are unrelated to the business that it conducts. Theoretically, the response appears to be no. (It may be argued that on the strength of Section 11 of the Act an application to register a mark that is confusingly similar ought to fail irrespective of if the contending classes for the goods are different.)

In contrast to the stances taken by South Africa, this Well-known marks are protected in favor of owners in member states under the South African Trademarks Act as amended (as stipulated by the Paris Convention on the protection of industrial property). **(Section 35 of the South Africa Trademark Act, Mordi M 2011)**

iii. Collective Trademarks

A collective trademark is a mark that can be used to identify in the course of commerce between goods or services provided by people who are members of one association and those provided by people who are not. **(See Section 49(1) of the United Kingdom Act)** It acts as a type of source indication for members of a specific group, such as geographic names or appellations of origin. **(Mordi M, 2011)** In accordance with Article 7 of the Paris Convention, collective markings are recognized. Collective markings are becoming more significant as a branding strategy in international trade, and as a result, they are becoming more prevalent in national trademark regulations.

There are no provisions for the registration of collective trademarks under the Nigerian Trademarks Act, **(Mordi M, 2011)** although there are provisions for the registration of collective trademarks under the Ghanaian **(Mordi M, 2011)** and South African trademark laws.

iv. Dichotomy of Register

Nigeria maintains two registers: **(Section 2 Nigeria Trademark Act 2004)** One for inherently distinctive marks under Section 9 (also known as Part A), and another for less distinctive marks that have become distinctive through extensive use under Section 10. (13). However, examining the entire terms of Sections 9 and 10, which establish the dichotomy, and Sections 5 and 6, which grant the mark owner rights in each component. Whether this distinction is justified is the question at hand. This distinction is artificial and unclear, as we have already discussed above **(Section 2 Nigeria Trademark Act, 2004)** and in agreement with Mordi, **(Mordi M, 2011)** it has to be eliminated. Instead of showing that a mark recorded in one portion is better to another, it just causes confusion.

The situation under the South African and Ghanaian trademark regimes, in contrast, does not have a dichotomization of the register or a split of marks into those that are intrinsically distinctive and those that have acquired distinctiveness via usage. It uses a simple system whereby a mark becomes registrable in the sole Trademark Register once it is capable of differentiating and may be represented graphically. So long as a mark does not fall under one of the listed grounds for refusal, it should be presumed that it should be registered under the South African Trademark Act and the Ghanaian Trademark Act.

v. Convention Application and Priority Right

The Nigeria Trademark Act recognizes convention applications and grants priority rights to applicants from convention countries who have applied to register their marks in either their home country or any other convention country, provided they submit the same or a similar application in Nigeria within six months of submitting the same or a similar application in Nigeria within six months of the prior application in other convention countries. **(Section 44 (1 – 4) Nigeria Trademark Act 2004)** Since the whole point of a convention application and priority right is to grant an applicant greater time to make future applications in other convention countries of interest, this is a praiseworthy feature. The provisions of Section 44 of the Nigeria

Trademarks Act are the main issue since they fail to fully implement the Paris Convention's intentions despite the fact that Nigeria is a party to that convention. A presidential declaration identifying the convention countries to which the provisions shall apply is required, per that section, for the provisions therein to take effect. Convention applications and priority rights are currently not recognized in Nigeria because this declaration has not been made. The Madrid Agreement and/or its supporting protocol have not been ratified by Nigeria, which means that international applications cannot benefit from the comprehensive coverage provided by a single application submitted to the International Bureau under the Madrid system.

The trademark laws of South Africa and Ghana, on the other hand, recognize and grant priority rights to convention applications submitted in convention countries above other outside applications. This has significant implications because, while South African and Ghanaian provisions will promote international applications and facilitate international registration, Nigerian provisions on convention applications are still in the early stages and thus give potential international applicants the option of submitting individual applications. This will have a negative impact on commerce and investment in Nigeria since business owners will prefer to go somewhere where they can benefit from priority privileges and a wide coverage system like the Madrid system.

vi. Trademark Infringement

Any trademark system must prohibit trademark infringement. Therefore, it is not surprising that the trademark infringement provisions in the Ghana, South Africa, and Nigeria trademark regimes under discussion. However, the South African Act and Ghana Act generously provision for newer kinds of infringement, such as dilution and cyber squatting, while the Nigeria Trademark Act does not. Additionally, whereas the South African Trademark Act and Ghana Trademark Act both permit comparable advertising, the Nigeria Trademark Act strictly forbids it.

1.5 Conclusion

The Nigeria Trademarks Act has been shown to have various deficiencies and to not meet the standards of Ghanaian and South African statutes that are similar to it. This is justified by the fact that a comparison of the two will not only highlight the Nigeria Trademarks Act's deficiencies, but will also guide reform efforts aimed at improving trademark administration in Nigeria. The paper consequently urges lawmakers to pass a new trademarks law that is modelled after the ones already in effect in Ghana and South Africa.

The study concludes by highlighting key provisions of the Nigerian Trademark Act that need to be updated in order to address the demands and challenges of modern business. Therefore, it is obvious that the definition of a trademark should be expanded to cover devices, designs, and service marks; well-known marks also require legal protection as a matter of right, as opposed to being the subject of litigation. The Paris Convention must be incorporated into national laws governing passing off.

REFERENCE

(1945) AC 68.

(2004) 5NWLR pt. 866 pp. 317-378.

A mark is inherently "distinctive," vide Section 9(2), if it is "adapted... to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade, from goods in the case of which no such connection subsists, either generally... or in relation to which the extent of the registration"

Articles 2 and 3 for treatments and Article 4 for priority rights. The common rules are scattered across the Convention.

Buhari v Obasanjo (2005)13 NWLR 1, at p. 206 Paragraph C-D

CAP P2 Laws of the Federation of Nigeria, 2004.

Cases where the Nigerian courts have construed the provision of Section 5(2) above include: *Alban pharmacy Ltd v sterling product int. inc.* (1968) All N.L.R. 292, *Beecham Group Ltd v Esdee food products Nigeria Ltd* (1980) F.H.C.L.662, etc.

Cornish ER (1999) *Intellectual Property, Patents, Copyright, Trademarks and Allied Rights* London: Sweet and Maxwell 597. Para 1501 – 1502.

Edenborough M (1995) *Intellectual Property Law* Britain: Cavendish Publishing Ltd 323, 272 *Ferodo Ltd v Ibeto Industries Ltd* SC 95/1999 Reported in (2004) 5 NWLR pt. 866 pp. 317 – 378.

The Supreme Court denied the protection for a non-traditional marks (background design of the mark in question).

- Golden Pages Trademark* [1985] FSR 27 and Edenborough M (1995) *Intellectual Property Law* Britain: Cavendish Publishing Ltd 270.
- HN Brock & Co Ltd* (1909) 26 RPC 683,
- I CAN'T BELIEVE IT'S TRADEMARK* [1992] RPC 533.
- Imperial Group limited v Phillips Morris Co Ltd* (1982) FSR 72, where it was held that the phrase “indicate a connection in the course of trade” implied that there was an intention on behalf of the trademark user to make a profit and to establish trading goodwill.
- Kevin Scranages Application, *Ghazillian's Trademark Application* (2002) R.P.C 628
- Marett P (1996) Marett: *Intellectual Property Law* London: Sweet and Maxwell, 159 – 160.
- Mordi M (2011) Toward, Trademark Law Reform in Nigeria: A Practitioners Note *NIALS Journal of Intellectual Property* 193, 199, 201, 215, 193-216
- Olugbenga OA and Suliyat OO (2014/2015) The Trademark Act of Nigeria and the United Kingdom: A Comparative Examination. *NIALS Journal of Intellectual Property* 63, 89 – 90.
- Oluwalogbon v Government of UK* (2005) 14 NWLR 760 (pt 946) at p. 787, paragraph B-C where it was stated that in the construction of statutory provision, where specific things are mentioned, the intention is that those not mentioned are not be included.
- Onayemi v Bouari* 14 WACA.
- Re coca-cola* (1986) 2 All ER 274.
- Section 1(2) (XI) Trademarks Act of South Africa.
- Section 1 Ghana Trademark Act – Meaning of Trademark:
- Section 2 (3) Trademark Act.
- Section 5 Constitution of the Federal Republic of Nigeria 1999 (as amended).
- Section 6(1) Trademark Act provides that the provisions of section 5(2)-(4) shall also apply to Section 6.
- Section 10 (2) (a) & (b) Trademark Act, provides a guide to the tribunal on what can amount to capability to distinguish. It specifically provides that tribunal may have regard to the extent to which the “mark is inherently capable of distinguishing ...” or “by reason of the use of the trademark or of any other circumstances, the trademark is in fact capable of distinguishing.”
- Section 11 South African Trademark Act.
- Section 11 Trademark Act.
- Section 12 Trademark Act. Marks under this section may however be registered they are a mixture or denote only a brand element.
- Section 13 Trademark Act. See also the case of *Alban Pharmacy Ltd. v. Sterling products int. Inc.* (1968) ALL NLR 292 and *Wholesale colonial Trading Co. v. Ikorodu Trading Co.* 10 W.A.C.A 67.
- Section 28 NTMA; but note that the Registrar has the power to dissolve such associated registration where an application is properly brought before him by the proprietor under Section 27 (2) NTMA.
- Section 33 (registered use) and 26 (assignment and transmission) Trademark Act. Exceptions are however recognized to their exclusive right. They include: honest concurrent use under Section 13(2) Trademark Act, prior use under Section 7 Trademark Act, conditional or limitation registration of trademark under Section 13(2) Trademark Act and use of own name or description of goods, etc. provided it is bona fide under Section 8 Trademark Act.
- Section 35 of the South Africa Trademark Act. Mordi M (2011) Toward, Trademark Law Reform in Nigeria: A Practitioners Note *NIALS Journal of Intellectual Property* 214 – 215.
- Section 43 TMA 2004 thereof.
- Section 44 (1 – 4) Nigeria Trademark Act
- Section 49(1) of the United Kingdom Act.
- Section 62 Trademark Act. This class of marks can also be registered as trademarks if the required consent has been obtained from the appropriate authority.
- Section 67 Trademark Act, Cap T13 Laws of the Federation of Nigeria 2004 which is the definition section of the Act further defines a mark to include a device, brand, heading, label, ticket, names, signatures, words, letter, numeral or any combination thereof.
- Separate trademark is protected in Section 24; defensive in Section 32; associated in Section 27 28; certification in Section 43; and resembling trademark registered as a series in Section 25.
- The rules governing the registration and use of this class of mark are expressly and copiously provided for in Section 43 Trademark Act.
- Todaro MP and Smith SC (2009) *Economic Development*. Delhi: Dorling Kindersley Pvt. Ltd 106, 107.
- Update Trademark* [1979] RPC 166.