



TRADEMARK INFRINGEMENT IN NIGERIA: LEGAL REMEDIES

Background

Trademarks are unique marks or a combination of marks used to distinguish the goods or services offered by a business. Trademarks of successful businesses are often subject to infringement by competitors attempting to exploit their good will. It is therefore important for businesses to take necessary steps to protect their trademark and enforce them when the need arises.

A registered trademark grants to the proprietor exclusive rights to use his trademark in relation to the goods and services it was registered for, and also institute an action in court for the infringement made on such trademark or to prevent the unauthorized use of the mark. But in the case of an unregistered trademark, the owner may institute an action for passing-off made on his mark. Section 5(1) of the Trade Marks Act 1967 provides for the exclusive right of a proprietor to use the trademark in respect of the goods it was registered for. Section 5(2) states that

“without prejudice to the generality of the right to use a trademark, the marks shall be deemed to be infringed by any person who not being the proprietor of the trademark, uses a mark identical to it or so nearly resembling it as it is likely to deceive or cause confusion in cause of trade in relation to any goods in respect of which it was registered.”

Trademark infringement is the unauthorized and illegal use of a trademark without the consent of the proprietor of the mark, whereby it is used to cause confusion between the original mark and the mark used.

Proprietors of unregistered trademarks on the other hand cannot not claim infringement of their trademarks as they are not entitled to the exclusive use of their trademarks. As such the law only entitles them to institute a claim for passing off.

Enforcement of Trademark Rights in Nigeria: Available Remedies.

1. **Notice of Opposition-** The proprietor of a trademark can file a notice of opposition at the Trademarks Registry, challenging the application for the registration of an infringing trademark. The Trademarks Act grants persons the right to file a notice of opposition to the registration of a mark when the mark is published in the Nigerian Trademark Journal. The purpose of publishing marks submitted for registration before they are finally registered is to give the public notice of the intention of the Trademarks Registry to register the mark. Persons who are of the opinion that the mark infringes on their trademark have the opportunity to file an opposition within 2 months from the date of the publication. The notice must be in writing and must contain the grounds for opposition.

Upon filing of the opposition, the Trademarks Registrar ("Registrar") will send a copy of the notice to the applicant who is entitled to respond to the notice. The Registrar will after hearing the parties and considering the evidence decide whether the registration will be permitted. The Registrar will after hearing the parties and considering the evidence decide whether the registration will be permitted.

2. **Cease and Desist Notification-** Proprietors can enforce their rights by sending a cease and desist letter to the infringing entity, containing a description of the trademark that is being infringed and a warning to the infringing party to cease and desist from performing further acts of infringements, otherwise legal actions will arise.

3. **Application for Cancellation of the trademark-** Where the infringing trademark has already been registered, the proprietor of the trademark may make a formal application to the Registrar of Trademarks or to the Federal High Court for the cancellation of the trademark. The application will be required to be supported by evidence of registration of the proprietor's trademark which should precede the trademark it seeks to cancel.
4. **Institution of a civil action for trademark infringement-** A proprietor is entitled by the Trademarks Act to institute an action against the infringing entity for infringement of his trademark. Upon institution of an action, the burden of proof rests on the proprietor to prove infringement on his trademark. Remedies available to the proprietor under this action includes: damages; injunctive reliefs; an order of the court compelling the infringing party to give account and pay to the proprietor the profits from the infringement; delivery up or destruction of infringing goods or products, etc.
5. **Formal Application to Relevant Government Agencies-** Agencies such as the Corporate Affairs Commission and the Nigeria Internet Registration Association prohibit the registration of a name either as a company, partnership or a domain name which violates an existing registered trademark/domain name unless the consent of the owner has been obtained. The proprietor can therefore make a formal application to these agencies seeking the withdrawal or cancellation of the name on the basis of infringement.

The options highlighted above are not mutually exclusive and an aggrieved proprietor may decide to pursue one or more of the options listed above. It is recommended that the proprietor considers all possible avenues to enforce its trademark and prevent continued or further infringement before commencing legal action so as to save time and reduce the costs involved in litigation. Overall, it is important that all steps taken in relation to the enforcement of a trademark be taken immediately infringement occurs to prevent further damage to the business of the proprietor.

Conclusion

Due to the numerous applications received daily, the Trademark Registry can sometimes make mistakes in the process of registering trademarks, thereby leading to double applications or a situation where the Registrar accepts a mark identical to an existing trademark. As a result of this, it is important to emphasize that trademark goes beyond registering the mark and obtaining the Certificate of Registration; the proprietor must be alert and be on the lookout for any possible infringement likely to occur on its mark. Where an infringement occurs, the owner of the mark shall have a right to enforce its mark and may be entitled to the remedies or reliefs stated above.

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