

ÁLEX

GUIDEBOOK ON INTELLECTUAL PROPERTY IN NIGERIA



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INTRODUCTION



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Very broadly, Intellectual Property Rights ("IPRs") mean the legal rights which result from intellectual activity in the industrial, scientific, literary and artistic fields. Protection of IPRs provides exclusive exploitation of the moral and economic rights of creators in their creations vis-à-vis the right of the public to access those creations.

IP rights can be categorised as follows:

1. Trademark;
2. Copyright;
3. Patent;
4. Industrial designs; and
5. Trade secrets.

TRADEMARKS



TRADEMARKS

1. TRADEMARKS

1.1 Overview

An invented word, device, label, ticket, brand, letter, numeral, company name or any combination of them can be registered as a trademark in Nigeria. Marks which are deceptive or scandalous, generic and descriptive, geographical names in their ordinary signification or chemical substances cannot be registered as trademarks.

Nigeria is a first-to-file jurisdiction, therefore, for a mark to enjoy statutory protection in Nigeria, it must be registered in Nigeria.

1.2 Legal Framework

The principal legislation regulating trademarks in Nigeria is the Trademarks Act [1]. The Act establishes the office of the Registrar of Trade Marks to which applications for the registration of trademarks are to be made.

1.3 Procedure for the Registration of Trademarks

From the filing of a trademark application up to examination

a. Filing the Application: An application is made in the prescribed manner to the Registrar of Trademarks. The documents required to file a trademark application in Nigeria are as follows:

- Duly completed T.M. Form 1 'Authorization of Agent'.
- The name and address of the proprietor of the trademark.
- A representation of the trademark to be registered.
- An indication of the class of goods and/or services in which the trademark is to be registered.

b. Acknowledgement of Application: The Registrar, on receipt of the application, issues a letter of acknowledgement which contains all relevant filing details on the trademark (e.g. Temporary Number, date of application, the trademark etc.)

c. Examination of the Application: The Registrar examines the trademark for distinctiveness, similarity with existing registered trademarks and general compliance with the requirements of the law. Where the Registrar is satisfied, he issues a Notification of Acceptance for the mark to be advertised in the Trade Marks Journal for opposition purposes. Otherwise, the mark is refused and a Letter of Refusal is issued stating the reason(s) for the refusal.

It takes about 6-12 weeks from filing an application to obtain an acceptance form.

[1] CAP. T13 Laws of the Federation of Nigeria (LFN), 2004.

d. Refusal of Application: Where an application is refused, the applicant must apply for a hearing in the matter within two (2) months, otherwise the application will be deemed abandoned. The hearing is an ex-parte forum for the applicant to lead evidence to persuade the Registrar to accept its application. Such evidence may include prior use, bad faith on the part of the proprietor of the cited mark, honest concurrent user etc.

However, in practice, the Trademarks Registry does not schedule a physical hearing where an application is refused, rather, an applicant is allowed to file a written appeal outlining the reasons why its trademark application ought to be accepted by the Registry.

From acceptance up to publication

Publication of the mark for opposition in the Trade Marks Journal may take as long as 36 months because the Journals are not published regularly; as such there is a backlog of applications awaiting publication for opposition.

The opposition period

When a trademark is advertised, any person may within two (2) months from the date of the publication give notice to the Registrar, of his/her opposition to the registration of the mark.

The Registrar shall send a copy of the Notice of Opposition to the applicant and the applicant shall within one month of receipt of the Notice of Opposition, file a Counterstatement containing the grounds on which it relies for its application to be registered. Failure to file the Counterstatement within the prescribed period will result in the application being deemed abandoned (at the application of the opponent) as Nigerian law does not provide for extension of time within which to file a Counterstatement.

Where a Counterstatement is filed, the Registrar shall furnish a copy thereof to the opponent. The opponent shall within one month of receipt of the Counterstatement lead evidence in the form of a Statutory Declaration after which the applicant shall also lead evidence in the form of a Statutory Declaration within one month of receipt of the opponent's Statutory Declaration.

Please note that a party may apply for extension of time to file its Statutory Declaration (the Registry has been known to grant between 1 to 3 months extension). After both parties have submitted their Statutory Declarations, the Registrar shall invite them for a hearing, and after hearing the parties, decide on whether the application should be registered or not.

The time frame for the issuance of hearing notices and delivery of a ruling is at the discretion of the lawyers in the opposition department. In practice, this could take as long as 1 to 2 years.

The Registrar's decision is subject to appeal to the Federal High Court. The parties may further exercise their right of appeal to the Court of Appeal and finally to the Supreme Court of Nigeria.

From the expiration of the opposition period up to the issuance of the registration certificate

Where no opposition is received at the expiration of the opposition period or the opposition is determined and resolved in favour of the applicant, the Registrar is obliged to issue a Certificate of Registration for the trademark on payment of the prescribed fee. The registration date of the trademark will be the date of filing. This could take up to 6 months after publication depending on the backlog of certificates awaiting the Registrar's signature.

1.4 Duration/Maintenance of Trademarks

A trademark is registered for an initial period of seven years but can be renewed for further periods of fourteen years.

To maintain the registration of a trademark, the proprietor is required to pay the prescribed renewal fee of N12,000 before the expiry of the initial term granted and any subsequent term. It is possible to renew a trademark up to three months before it is due for renewal and up to three months after the renewal deadline.

A trademark can be removed from the Register of Trademarks for failure to pay the renewal fee within the prescribed period.

1.5 General Trademark Issues

a. Infringement

By virtue of the provisions of the Trademarks Act, the proprietor of a registered trademark is conferred with the exclusive right to use that trademark and any unauthorised use of the registered trademark or a trademark similar to it will be deemed an infringement.

To enforce his rights, the proprietor of a registered trademark may institute an action at the Federal High Court. The proprietor may also take advantage of the opposition procedure provided under the Act in respect of pending trademark applications that have been published.

Please note that it is only the proprietor of a trademark registered in Nigeria that can bring an action for infringement of his trademark in Nigeria. The proprietor of a trademark which is registered in other countries but not in Nigeria cannot bring an action for infringement.

Also note that the rights of the proprietor of a registered trademark will not affect the rights of any person who had been using that trademark in good faith from a date prior to the registration of the trademark.

b. Passing Off

As stated above, the owner of an unregistered trademark cannot bring an action for infringement under the Act. However, he can institute an action in passing off against an unauthorised user of his trademark. This action is based on the common law action of passing off.

To succeed in an action for passing off, the owner of the unregistered trademark must show that:

- he has been using the trademark;
- it has acquired good will; and
- there is a likelihood that consumers may be deceived into believing that there is some connection between the goods and/or services of the owner of the unregistered trademark and the goods and/or services of the counter party [2]

[2] The owner of the unregistered trademark does not need to show actual deceit or damages suffered as a result of the passing off.



COPYRIGHT

COPYRIGHT

2. COPYRIGHT

2.1 Legal Framework

The principal legislation regulating copyright in Nigeria is the Copyright Act [3] (the “Act”).

Under the Act, the following works are afforded copyright protection if sufficient effort has been expended to give them an original character and they are fixed in a definite medium of expression (“Eligible Works”):

- **Musical works** – covers all musical works, irrespective of musical quality and includes works composed for musical accompaniment;
- **Literary works** – includes novels, plays, computer programmes, textbooks, encyclopaedias and dictionaries;
- **Artistic works** – includes paintings, drawings, etchings, lithographs, woodcuts, engravings, prints and works of sculpture;
- **Cinematograph films** - includes the first fixation of a sequence of visual images capable of being the subject of reproduction, and the recording of a soundtrack associated with the cinematograph film:
- **Sound recordings** – covers any fixation of a sequence of sound capable of being perceived aurally and of being reproduced; and
- **Broadcasts** – covers sound or television broadcast by wireless telegraphy or wire or both, or by satellite or cable programmes.

2.2 Registration Formalities

The Act does not provide for the registration of Eligible Works as copyright arises automatically upon the creation of such works. However, in fulfilling its mandate of creating a databank of authors and their works, the Nigerian Copyright Commission (NCC) has established a voluntary notification process by which authors can notify it of their works.

Notifying the NCC of the creation of an Eligible Work is advantageous as it serves as evidence of the existence and date of creation of the work which may be helpful in the event of a dispute regarding ownership of the work.

2.3 Duration of Copyright

Copyright in literary, artistic and musical works lasts for 70 years from the date of the author’s death. Copyright in cinematograph films and photographs subsists for 50 years from the date of the first publication of the work while copyright in sound recordings and broadcasts subsists for 50 years from the date of the making of the first recording or the broadcast [4]

2.4 Infringement of Copyright

Copyright gives the owner of an Eligible Work the exclusive right to exploit that work. Where the right of a copyright owner is infringed, he may institute a civil action against the infringer.

A criminal action may also be instituted against such infringer and if convicted, such a person may be liable to a fine, a term of imprisonment or both.

[3] Chapter C28 Laws of the Federation of Nigeria

[4] See the First Schedule of the Copyright Act

PATENT



PATENT

PATENT

3. Patent

3.1 Overview

A patent is an exclusive right granted in respect of an invention, which may be a product or a process that provides a new and inventive way of doing something or offers a new and inventive technical solution to a problem [5]

Note that in Nigeria, computer software, codes and computer programs is usually not granted a patent in Nigeria and is typically protected as a copyright.

3.2 Legal Framework

The primary legislation governing patent in Nigeria is the Patents and Designs Act 1970, (the "Patents and Designs Act"). The Patent and Designs Act provides that a patent may be granted for an invention where it satisfies the following requirements:

a. It is new or novel, results from inventive activity and is capable of industrial application or; a. It constitutes an improvement of a patented invention and also is new, results from inventive activity and is capable of industrial application.

Hence, an invention will not be patentable where it has been made known to the public by oral disclosure or by a document or there has been some form of prior use.

3.3 Registration Formalities

An application for a patent is made to the Registrar of Patents and accompanied by a description of the relevant invention with any appropriate plans and drawings. The true inventor must be named in the application, even if he or she is not the person applying for the patent.

There is no substantive examination of patents before a grant. Therefore, a patent is granted without a guarantee of its validity. The application process typically takes about 12 months.

The right to patent an invention is vested in the first to file a patent application in Nigeria. However, by virtue of the Patents and Designs Convention Countries Order 1971, if a Nigerian application is made within 12 (twelve) months of the making of the earlier application in a foreign country in which Nigeria has signed a treaty or a convention, such application will be treated as having been made on the same date on which the corresponding foreign application was made.

3.4 Duration and Maintenance of Patents

Patents remain in force for a period of twenty (20) years from the date of filing the application. A renewal application is to be made annually during the 20-year duration of the patent, by lodging the relevant application and the prescribed fee not later than the due date at the Registry. Failure to renew a patent will result in the patent lapsing.

[5] Definition by World Intellectual Property Organisation (WIPO).

3.5 Infringement of Patents

Registration of a patent gives the patent holder the right to exclude other persons from using the registered invention. A patent holder is also entitled to grant third parties contractual licenses to exploit such invention, on an exclusive, sole or non-exclusive basis or may assign the patent rights to a third party. This can be a lucrative source of revenue for a business owner.

A patentee whose rights have been infringed may institute a civil action against the infringer and claim reliefs such as damages, injunction and account of profits. The patentee's rights under a patent, however, extend only to acts done for industrial or commercial purposes.



INDUSTRIAL DESIGNS

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4. Industrial designs

4.1 Overview

Industrial design protects the aesthetic value and nature of a finished product and not the technical or functional features of the product. It is distinct from any technical or functional aspects.

Industrial design is relevant to a wide variety of products as well as the packaging, containers and “get-up” of those products.

4.2 Legal Framework

The Patents and Designs Act 1970 is the primary legislation on industrial designs in Nigeria.

An industrial design is defined by the Act as any combination of lines and/or colours and three-dimensional form whether or not associated with colours, if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result.

4.3 Registration Formalities

An industrial design can be protected by registration, with the Nigerian Patents and Designs Registry. An industrial design is registrable if it is new and not contrary to public order or morality. An industrial design will not be considered new if, before the date of application for registration, it has been made available to the public unless the creator of the design can prove that they had no knowledge that it had been made so available.

The right to registration of an industrial design is vested in the person who, whether or not they are the true creator, is the first to file, or validly to claim a foreign priority for, or an application for registration of, the design. The true creator is, however, entitled to be named in the application.

An application to register an industrial design is to be made to the Registrar of Patents and Designs and accompanied by a specimen of the design or a photographic or graphic representation of the design and an indication of the kind of product for which the design will be used.

4.4 Duration and Maintenance of Industrial Designs

A registered design is protected for a period of five (5) years from the date of the application for registration. Protection may be renewed for two further consecutive periods of five (5) years each upon payment of the prescribed fees.

4.5 Infringement of Industrial Designs

The owner of a registered industrial design has the exclusive right to prevent unauthorised copying or imitation of such design by third parties. This improves the competitiveness of a business and often attracts additional revenue.

The creator's rights, however, extend only to acts done for industrial or commercial purposes. A creator whose rights have been infringed may institute a civil action against the infringer and claim reliefs such as damages, injunction and account of profits.



TRADE SECRETS

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5. Trade Secrets

5.1 Overview

A trade secret is a formula, process, device, or other business information that is kept confidential to maintain an advantage over competitors; information - including a formula, pattern, compilation, program, device, method, technique, or process [6]

Not all "inventions" can be protected as patents - scientific theories, food recipes, mathematical methods and commercial methods cannot be patented. However, they can be protected as trade secrets.

Trade secrets can be broadly classified into:

- trade secrets that protect inventions or manufacturing processes that do not meet the patentability criteria and therefore can only be protected as trade secrets. An example of this is a manufacturing process or customers list that cannot be protected as a patent but is considered valuable; and
- trade secrets for inventions that fulfil the patentability criteria and could therefore be protected by patents.

Under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), the factors that qualify confidential information as trade secrets are as follows:

- a. It is a secret not generally known to the public;
- b. Due to the fact that the information is not publicly disclosed, it must have commercial value; and
- c. It is the subject of reasonable efforts by the holder to maintain its secrecy.

5.2 Legal Framework

Trade secrets are not statutorily protected in Nigeria. As such, there is no procedural formality for the registration of trade secrets. Thus, unlike patents and trademarks that are registered for a period of time, a trade secret can be protected for an indefinite period, provided it is not disclosed to the public.

[6] Black's Law Dictionary.

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