

TRADEMARK REGISTRATION IN NIGERIA: EXAMINATION OF THE PROCEDURES AND EXCLUSIONARY CRITERIA

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Abstract

Trademarks play a vital role in protecting business identities and minimizing consumer confusion. This paper critically examines the trademark registration process in Nigeria, alongside the legal grounds for exclusion from registration within the Nigerian legal framework. The discussion begins with an overview of trademarks, emphasizing their significance in safeguarding brand identity and distinguishing products and services. The primary objective is to provide a detailed analysis of the trademark registration procedures in Nigeria. This includes an exploration of the application process, The role of the Registrar, the opposition period, and the issuance of certificates. Utilising a doctrinal research approach, the analysis reviews relevant statutes, judicial decisions, and academic commentary. Notable sections of the Trade Marks Act, sections 9 to 11 are discussed alongside landmark cases like PZ Cussons Ltd. v Unilever Plc. Findings indicate that while Nigeria's trademark registration framework is comprehensive, challenges such as lengthy application timelines and outdated procedures persist. The paper concludes by recommending that, streamlining registration processes

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and embracing technological innovations could enhance efficiency, ultimately fostering fair competition and consumer protection in Nigeria.

Keywords: Exclusion from Registration, Mark or Sign, Non - registrable, Registration, Trademarks,

1.0 Introduction

Trademarks serve as essential identifiers that help consumers distinguish between different brands in the marketplace. As stated by Lord Nicholls of Birkenhead in *Scandecor Development AB v Scandecor Marketing AB*,¹ the fundamental function of a trademark is to guarantee the identity of the origin of a product by ensuring that all goods bearing the mark originate under the control of a single entity responsible for their quality. In Nigeria, as in other common law jurisdictions, distinctiveness is a key requirement for trademark registration. This was emphasized in *Nigerian Bottling Co. Plc v. Yusuf*,² where the court held that a mark must not only be distinctive but also not deceptive or confusing in the marketplace. The Nigerian Trade Marks Act Cap T13, Laws of the Federation of Nigeria, 2004, governs trademark registration, stipulating that trademarks must be distinctive and capable of distinguishing goods or services. Despite this general framework, certain exclusions apply, particularly concerning the registration of the shape or other characteristics of goods, which pose challenges for legal practitioners, trademark owners, and scholars of intellectual property law.

A particularly complex aspect of trademark law is the exclusion of shapes and other characteristics of goods that arise from the nature of the goods themselves or are necessary to achieve a technical result.

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¹ (2002) FSR 122@ 33

² (2010) 4 NWLR (Pt. 1183) 610

Section 9 of the Trade Marks Act sets out the general requirements for distinctiveness but does not explicitly address the exclusion of non-conventional trademarks such as three-dimensional shapes, colours, or product configurations. These exclusions exist to prevent monopolisation of functional product features, ensuring fair competition. The exclusionary provisions regarding shapes and characteristics are influenced by international frameworks such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the European Union Trademark Directive (DTM). These international instruments prevent the registration of functional aspects of a product to avoid unfair competition and encourage innovation. However, understanding the rationale behind such exclusions can be challenging due to their nuanced nature.

Unlike the European Union's Trademark Regulation 2017/1001, which explicitly lists shape exclusions, Nigerian law implicitly adopts similar principles through its TRIPS obligations. In *Baker Hughes Ltd. v Impac Oil and Gas Ltd.*,³ the Nigerian Court of Appeal ruled that a shape essential to a product's function cannot be monopolised under trademark law, as trademarks should not be used to gain an unfair advantage by preventing other manufacturers from using functional designs. Exclusions from trademark registration typically arise in three circumstances: where the shape results from the nature of the goods, where the shape is necessary to achieve a technical result, and where the shape gives substantial value to the goods. For example, a cylindrical pipe cannot be registered as a trademark since its shape is intrinsic to its function. Similarly, a shape designed to achieve a technical result, such as an engine component, is excluded from trademark protection to prevent companies from monopolising functional elements that should fall under patent law. Moreover, aesthetic features that significantly contribute to a product's value,

³ (2017) LPELR-43314(CA)]

such as the unique design of a luxury handbag, are also excluded to prevent anti-competitive practices.

The exclusion of shapes necessary for achieving a technical result is particularly significant in preventing companies from using trademark law to secure patent-like protection. This principle was established in the EU case C-299/99 *Philips Electronics v Remington*,⁴ where the European Court of Justice ruled that functional shapes cannot be registered as trademarks. While Nigerian courts have not produced a landmark ruling on this specific issue, they have adopted similar reasoning in cases concerning functional product features. In *Cussons (Nig.) Ltd v Unilever Plc*,⁵ the court acknowledged the importance of the functionality doctrine, affirming that trademarks should not extend to technical product features as this could stifle innovation and hinder competition. This approach aligns with global legal trends that exclude functional shapes from trademark protection. These exclusions are vital for maintaining market competition and preventing trademark law from encroaching upon other intellectual property regimes such as patent and industrial design laws. However, these legal distinctions often create challenges for legal practitioners and scholars. Distinguishing between a protectable trademark and a functional or value-based exclusion can be difficult, leading to inconsistencies in judicial interpretations and academic discourse. Questions such as whether a particular shape is essential to a product's nature or merely a design choice, and how Nigerian courts interpret "substantial value" within trademark law, remain contentious and require further analysis.

This paper seeks to clarify these exclusionary provisions by conducting a detailed examination of Nigeria's trademark registration process and the legal grounds for excluding shapes and other product characteristics from registration. The discussion will begin with an

⁴ (2002) ECR I-5475

⁵ (2010) 9 NWLR (Pt. 1198) 232

overview of the trademark registration process in Nigeria, outlining the procedural steps and the role of the Nigerian Trademarks, Patents, and Designs Registry. The paper will then explore the specific grounds for exclusion under Nigerian law, analysing relevant statutory provisions and judicial interpretations. The exclusion of shapes, technical results, and value-based characteristics will be examined in light of Nigerian case law and international legal developments. Through a comparative analysis, the paper will evaluate how Nigerian courts and the Trademark Registrar have approached these exclusions, drawing insights from legal precedents in the European Union and other jurisdictions. This approach will help identify inconsistencies in Nigerian trademark law and propose potential reforms or clarifications to enhance legal certainty and practical application.

2.0 Definitions and Clarification of Terms in Trademark Law

This section aims to define and clarify essential terms and terminologies crucial for understanding trademark law, particularly in the context of Nigeria.

i. Mark or Sign

A ‘mark or sign’ encompasses any sign capable of being graphically represented, including words, personal names, designs, letters, numerals, and the shapes of goods or their packaging. Such signs must distinguish the goods or services of one entity from those of others. The inclusion of shapes in statutory definitions has altered previous legal interpretations, such as the House of Lords' ruling in *Re: Coca Cola Trademarks*,⁶ which initially deemed bottle shapes non-registrable to prevent unfair monopolies. The term ‘sign’ was further clarified in *Philips Electronics NV v Remington Consumer Products*,⁷

⁶ (1986) RPC 421

⁷ (1998) RPC 283

confirming that words are inherently included within this definition. Essentially, any perceptible message can function as a trademark.

ii. Trademarks

A 'trademark' is defined as a distinctive sign used by individuals or entities to identify the origin of their products or services and differentiate them from those offered by others. In *Proctor & Gamble Co. v G.S & D. Ind. Ltd.*,⁸ the court described a trademark as a distinctive image that enables consumers to recognize the source of a product. Typically, trademarks can be names, logos, symbols, phrases, or combinations thereof. The case of *Society Bic S.A. v Charzin Ind. Ltd.*⁹ further defined trademarks as marks of authenticity that distinguish a manufacturer's products through various identifiers.

Non-conventional trademarks also exist, including those based on color, smell, or sound. Informally, the term "trademark" can refer to any distinguishing feature associated with an individual, such as a celebrity's well-known traits. The court in *Virgin Ent. Ltd. v R. Bev. (Nig.) Ltd.*¹⁰ noted that trademarks indicate to consumers the quality and source of goods.

iii. Registration

In intellectual property law, particularly concerning trademarks, 'registration' refers to the formal process through which rights to a mark are recognized and protected by law. This typically involves applying to a national or regional intellectual property office, such as Nigeria's Trademarks, Patents and Designs Registry or the UK

⁸ (2013) 2 NWLR p. 409 CA

⁹ (2014) 4 NWLR (Pt. 1398) 497 SC

¹⁰ (2009) 12 NWLR (Pt. 1156) 498 CA

Intellectual Property Office (UKIPO). According to Section 9 of the Nigerian Trademarks Act, a mark must be distinctive for registration; it should effectively distinguish the applicant's goods or services from others. In *Registered Trustees of the Roman Catholic Archdiocese of Lagos v Registered Trustees of the Catholic Church of the Latter-Day Saints*,¹¹ the Court emphasized that trademarks must not be merely descriptive but capable of distinguishing products or services distinctly. Cornish and Llewelyn argue that distinctiveness is fundamental for trademark registration in common law jurisdictions, asserting that non-distinctive marks mislead consumers and lack protectability¹²

iii. Exclusion from Registration

Exclusion from registration pertains to circumstances under which a mark may be disqualified for registration due to various legal reasons related to public policy, distinctiveness, or prior rights. Grounds for exclusion include lack of distinctiveness,¹³ descriptiveness or generic nature,¹⁴ and marks contrary to public order or morality.¹⁵ The case of *Procter & Gamble Company v Office for Harmonisation in the Internal Market (OHIM)*¹⁶ illustrates exclusion grounds. Here, the European General Court ruled that "BABY-DRY" was descriptive and thus unregistrable under Article 7(1)(c) of EU Trade Mark Regulation. This aligns with exclusionary provisions in Nigeria's Trademark Act and other common law jurisdictions. Bently and Sherman emphasise that inherently descriptive marks are unlikely to be accepted for registration due to distinctiveness thresholds determining registrability.¹⁷ Specific statutory provisions include exclusions based

¹¹ (2019) LPELR-47002(CA)

¹² Cornish, W.R., & Llewelyn, D., *Intellectual Property: Patents, Copyright, Trademarks & Allied Rights*, (2010 Sweet & Maxwell). p. 650

¹³ See Section 9 of the Nigerian Trademarks Act

¹⁴ See Section 11 of the UK Trade Marks Act 1994

¹⁵ See Section 11(2) of the Nigerian Trademarks Act

¹⁶ (T-625/13)

¹⁷ Bently, L., & Sherman, B., *Intellectual Property Law*, (2014 Oxford University Press) p. 924

on public policy and morality.¹⁸ For instance, in *Re Deichmann SE's Application*,¹⁹ UKIPO rejected a deceptive mark suggesting qualities not possessed by the product based on Section 3(3)(b) of the UK Trade Marks Act 1994. Davis argues that public policy exclusions safeguard trademark law by preventing misleading or offensive marks from entering the register, thereby balancing commerce protection with ethical standards.²⁰

3.0 Legal Frameworks

In both Nigeria and the UK, exclusion from trademark registration is grounded in the principles of protecting public policy. This part will outline the relevant legal frameworks in Nigeria and the UK, highlighting the key sections and provisions that set out the grounds for exclusion.

3.1 Legal Framework in Nigeria:

Nigeria's trademark law is governed by the Trademarks Act, Cap T13, Laws of the Federation of Nigeria 2004.²¹ It sets out the conditions under which a mark may be refused registration. These provisions are aimed at ensuring that only distinctive, non-deceptive, and non-controversial marks are registered.

i. Section 9 of the Nigerian Trademarks Act stipulates the requirement of distinctiveness. A trademark must be capable of distinguishing goods or services of one enterprise from another. Failure to meet this criterion is grounds for exclusion. It states that:

In order for a mark to be registrable, it must contain or consist of at least one of the following

¹⁸ Section 11(2) of the Nigerian Trademarks Act excludes scandalous or deceptive marks.

¹⁹ (2003) RPC 11

²⁰ Davis, J, *Intellectual Property Law Handbook*, (2017 Routledge), p. 85,

²¹ Trademarks Act, Cap T13, Laws of the Federation of Nigeria 2004.

essential particulars - the name of a company, individual, or firm represented in a special or particular manner; the signature of the applicant; an invented word or words; a word or words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or surname.

Section 11 thereof prohibits the registration of deceptive or scandalous marks, which is another ground for exclusion. It states that it shall not be lawful to register as a trademark or part of a trademark

Any matter the use of which would, by reason of its been likely to deceive or cause confusion, or otherwise be disentitled to protection in a court of justice or be contrary to law or morality or any scandalous design.

Section 13 (1) deals with the exclusion of marks that are similar or identical to prior registered marks. It ensures the protection of prior rights. Essentially, it provides that “No trademark shall be registered in respect of any goods or description of goods that is identical with a trademark belonging to a different proprietor or so nearly resembles such a trademark as to be likely to deceive or cause confusion.”

3.2 Legal Framework in the United Kingdom:

The UK trademark regime is governed by the Trade Marks Act 1994,²² which incorporates provisions from the EU Trade Marks Directive. The UK Intellectual Property Office (UKIPO) is responsible for examining and registering trademarks under this legislation. Several

²² Trade Marks Act 1994 (UK).

grounds for refusal of registration exist in the UK framework, some of which align with international norms.

i. Section 3(1) of the Trade Marks Act 1994 sets out the absolute grounds for refusal. A mark must not be devoid of distinctive character, descriptive, or generic. It states that:

The following shall not be registered—(a) signs which do not satisfy the requirements of section 1(1), (b) trademarks which are devoid of any distinctive character, (c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of goods or of rendering of services, or other characteristics of goods or services.

Section 3(3) excludes marks that are contrary to public policy or morality. “A trademark shall not be registered if it is contrary to public policy or to accepted principles of morality.” Section 3(6) excludes marks filed in bad faith. “A trademark shall not be registered if or to the extent that the application is made in bad faith.”

ii. Section 5(2) relates to relative grounds for refusal, where a mark may be excluded if it conflicts with earlier rights. “A trademark shall not be registered if, because of its identity with an earlier trade mark and the identity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public.”

3.3 International Norms:

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the European Union Trademark Directive. These norms have shaped the way Nigeria approaches trademark law particularly in excluding certain marks from registration, notably those related to the shapes or characteristics of goods.

3.3.1 TRIPS Agreement:

The TRIPS Agreement (1994), which Nigeria is a signatory to, provides the foundational framework for global intellectual property laws, including trademarks. Article 15 of the TRIPS Agreement establishes general rules for the registrability of trademarks but also introduces important exclusions, particularly regarding the shape or characteristics of goods.

- i. Article 15(1) of TRIPS defines what constitutes a registrable trademark but notes that “...members may make registrability depend on distinctiveness acquired through use.” The exclusionary provision applies to marks that lack inherent distinctiveness, particularly those that consist of the shape or characteristic of goods that is necessary for the product’s function. “Signs that are not capable of distinguishing the goods or services of one undertaking from those of other undertakings shall not be eligible for registration as trademarks.”
- ii. Article 15(2) provides the flexibility to exclude specific signs such as the shape of goods from registration. It allows national laws to define the criteria for the exclusion of certain marks based on the characteristics of the goods themselves. “Members may require, as a condition of registration, that signs be visually perceptible.”

3.3.2 European Union Trademark Directives:

The European Union Trademark Directive (Directive 2015/2436) has further refined the exclusionary provisions regarding shapes. Though Nigeria is not bound by EU laws, the Directive’s influence is felt globally due to its comprehensive approach to excluding functional, descriptive, or non-distinctive marks.

- i. Article 4(1)(e) of the EU Trademark Directive explicitly excludes signs consisting exclusively of the shape or another characteristic that results from the nature of the goods, is necessary to achieve a technical result, or gives substantial value to the goods:

A trademark shall not be registered if it consists exclusively of: (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods.

This exclusion ensures that monopolies are not granted on functional features or essential characteristics of products, maintaining a balance between trademark protection and market competition.

4.0 Registrable Trademarks and The Registration

Though the focus of this paper is not on registrable trademarks, for purposes of giving perspective to the subject of exclusion from registrability, we will first discuss the scope of what constitutes a registrable mark. Suffice to say at this stage that there are registrable and non - registrable trademarks.²³

4.1. Registrable Trademarks

The scope of registrable trademarks has significantly expanded under the UK Trademarks Act 1994 compared to previous legislation and the Nigerian Trade Marks Act T. 13 LFN 2004. As discussed in paragraph 3.0, the Trademarks Directive and the 1994 Act, along with the Trade Marks Act LFN 2004, serve as guiding laws. Notably, Article 2 of the Trademarks Directive is not exhaustive. In *Shield Mark BV v. Joost Kist*,²⁴ the court confirmed that Article 2 allows for non-traditional marks such as sounds, colours, smells, and motion marks, provided they meet the graphical representation requirement, which include:

²³ See generally paragraph 3.1 above especially sections 9 - 16 of the Act

²⁴ (2004) All ER (EC) 277

i. Capable of Distinguishing

In *Philips Electronics BV v Remington Consumer Products*,²⁵ the court held that a trademark with distinctive character (either inherently or through use) must be capable of distinguishing. Article 2 of the Directive stipulates that a sign must differentiate goods or services of one undertaking from another and guarantee the origin of products. In *Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc.*,²⁶ the court reinforced that only signs fulfilling this definition are registrable. Article 3(1)(a) further states that non-distinctive signs shall not be registered and are liable for invalidation.

ii. Capable of Graphic Representation

Graphic representation is a critical requirement for trademark registration, especially for non-traditional marks like colours, sounds, shapes, and smells. The representation must be included in the application form - TM 3, and published in the Trademark Journal as per the Trade Mark Rules 2001 r.71. Some challenges arise with:

a. Colour Marks: Registering a single colour or abstract colour combination is complex. In *Libertel Groep BV v. Benelux-Merkenbureau*,²⁷ the court held that a single colour may be registrable if an internationally recognised colour code is used. Simply reproducing a colour on paper does not suffice.

b. Sound Marks: Conventional musical notation is generally accepted for representing music as a trademark. The case of *Direct Line Insurance Plc telephone jingle*²⁸ exemplifies this. In the future, digital formats (e.g., MP3 files) may become acceptable.

²⁵ Ibid (n.7)

²⁶ C-39/97 (1998) ECR I-5507

²⁷ C-104/01 (2003) ECR I-3793

²⁸ UK Registration Nos. 2030045, 2127794, 2127799

c. Olfactory Marks: Registering smells, odours, and fragrances remains difficult due to challenges in graphical representation. However, some successes exist, such as the trademark registration for a floral fragrance reminiscent of roses for tyres.²⁹

d. Shape Marks: Shapes can be represented graphically through drawings from different angles. In *Koninklyke Philips Electronics NV v. Remington Consumer Product Ltd*,³⁰ the court confirmed that shape marks should be treated like other signs under Article 2. However, in *Triomed (Proprietary) Ltd v Beecham Group Plc*,³¹ the South African High Court revoked a pharmaceutical shape mark, highlighting ongoing challenges in registering shape marks globally.

4.2 Trade mark Registry/Registration Procedure:

i. The first step is Search and Application: Before applying for registration, a comprehensive search is conducted to ensure that the mark is not already in use, after which an application is filed. The application includes details about the trademark and the goods or services it will represent. Under the registration and registry procedure in Nigeria and the UK, S.32 of the UK Act³², and S.18 of the Trademark Act of Nigeria³³ an application to register a trademark requires the submission of the following items:

- a. A request for Registration
- b. The name and address of the applicant
- c. A statement of goods and services in relation to which is sought to register the trademark
- d. A representation of the trademark

²⁹ Registration No. 2001416

³⁰ Ibid (n.25)

³¹ (2001) FSR 583

³² Ibid (n.22)

³³ See generally paragraph 3.1 above

- e. A statement that the trademark is being used, by the applicant or with his consent, in relation to those goods or services or he has bonafide intention of so using it, and
- f. Payment of the prescribed fee.

Note that, the filling date of record is the date when all necessary documents have been furnished to the registrar, while S.44 (international arrangements) of the Nigerian law provides for priority from earlier fillings from Paris Convention countries for up to six months.

ii. Examination: Next, the trademark office examines the application to ensure it meets all legal requirements. This includes assessing distinctiveness, descriptiveness, and compliance with public policy. In *Niger Chemists Ltd. v Nigerian Chemists*³⁴ the Supreme Court of Nigeria held that the use of the word "Chemists" by the defendant was likely to deceive or cause confusion with the plaintiff's business, thereby affirming the importance of distinctiveness in trademark registration. If the mark passes examination, it is published in an official gazette. This allows third parties to oppose the registration if they believe it conflicts with their existing rights, and If no opposition is filed or if opposition is resolved in favour of the applicant, the trademark is registered, and a certificate of registration is issued.

It is important to note that in the absences of any ground to challenge an application on the outlined basis above, it remains possible that any other person claiming to have the right to use it may oppose the application on the basis of the relative grounds or on the ground that the application was made in bad faith. A good example is the case of *Ball v Eden Project Ltd.*³⁵ An infringement action where it

³⁴ (1961) 1 All NLR 171

³⁵ (2002) FSR 686

was held that registration of a company name by a director of that company without that company's consent for the apparent purpose of giving the director a personal benefit was a breach of the director's fiduciary duty. For more clarification on the statutory provisions available for registration of trademark, see sections 37-41 Trademark Act 1994 and sections 17-22 of the Trademark Act of Nigeria.

5.0 Non-Registrable Trademarks (Grounds for Exclusion from Registration As Trademarks in Nigeria)

There are two main categories of grounds available for refusal of trademark applications. They are: Absolute Grounds, and Relative Grounds. The European Union Trademark Directive³⁶ has further refined the exclusionary provisions regarding shapes. Though Nigeria is not bound by EU laws, the Directive's influence is felt globally due to its comprehensive approach to excluding functional, descriptive, or non-distinctive marks. This part of the essay will discuss the two grounds below:

5.1 Absolute Ground for Refusal

These are concerned with the internal features of the trademark, that is, with some innate quality which means it cannot be registered. This head is set out in Art 3 of the DTM. Note that the trademark must have been inherent or acquired distinctiveness.

i. Article 4(1)(e) of the EU Trademark Directive explicitly excludes signs consisting exclusively of the shape or other characteristic that results from the nature of the goods, is necessary to achieve a technical result, or gives substantial value to the goods. It provides that, a trademark shall not be registered if it consists exclusively of: (i) the shape, or other characteristic, which results from the nature of the goods themselves; (ii) the shape, or other characteristic, of goods which is necessary to obtain a technical result;

³⁶ Ibid paragraph 3.3.3 above (Directive 2015/2436)

(iii) the shape, or other characteristic, which gives substantial value to the goods. Thus in *Philips Electronics NV v. Remington Consumer Products Ltd.*³⁷ Philips sought to register the shape of the head of a three-headed rotary shaver. The European Court of Justice (ECJ) held that the shape was necessary to obtain a technical result and thus could not be registered as a trademark. This decision reinforces the principle that shapes which are essential to the functionality of a product cannot be monopolized through trademark registration. Another exclusion under trademark law involves shapes or characteristics that add substantial value to the goods. This exclusion aims to prevent manufacturers from monopolizing aesthetic elements that contribute significantly to the product's market appeal. This principle is closely linked to design rights rather than trademarks, which should be reserved for distinctive branding rather than ornamental or value-enhancing features. In the case of *Lego Juris, A/S v. OHIM*³⁸, the Court of Justice of the European Union (CJEU) found that Lego's famous brick shape could not be protected under trademark law because it provided a technical result and had substantial value due to its function and aesthetic appeal. Nigerian courts have not directly dealt with a case involving substantial value exclusions, but similar principles have been applied, such as in *Spar Nigeria Ltd. v Suntex International Ltd.*³⁹, where the aesthetic and functional qualities of a product design were found to limit its eligibility for trademark protection.

It is imperative to read Art 3(1) (a)-(d) and also Article 3(3), the DTM for a better understanding of the heads and purpose of these sections in the light of case C-329/02 P SAT.1 *Satelliten Fernsehen GmbH v*

³⁷ Ibid (n.25)

³⁸ Case C-48/09, 2010

³⁹ (2009) 15 NWLR (Pt. 1165) 427

*OHIM*⁴⁰ which held that each of these paragraphs require the trademark to be considered concretely, that is in relation to the goods and services to which the mark will be applied, judged through the eyes of the average consumer of these goods. These Articles are discussed below:

a. Art 3(1) (a) states that, if it lacks the required ingredient of a trademark namely sign, capable of graphic representation and capable of distinguishing then it is not a trademark.

b. Art 3(1) (b) is about devoid of any distinctive character: Shapes, single colours and descriptive or laudatory words may all fall into this ground for refusal. A good example is the case C-104/01 *Libertel Groep NV v. Benelux Merkenbureau*,⁴¹ which concerned an application to register the colour orange in the abstract to be used in relation to telecommunications. Of course, it does not follow as a matter of inexorable logic that a mark, which is not wholly descriptive must be distinctive. Thus, for a trademark to be caught by the ground under Art 3 (1) (b) it must be potentially capable of distinguishing the goods or services of one undertaking from those of others, because of lack of use, it is not perceived as a badge of origin.

c. Art 3(1) (c) - Descriptive of characteristics: The public interest in allowing others freely to describe their goods or services is paramount here and subject only to acquired distinctiveness under Art 3(3). Thus, in *Besnier SA's Trademark Application*⁴² it was held that the use of the trademark for which registration was sought 'Day by Day' would naturally, be used by other traders to describe the time of delivery for their goods and services and the main purpose of this Article was to prevent the registration of words and phrases that other undertakings would want to use in a non - trademark sense.

⁴⁰ (SAT 2), ECJ, 16 December, 2004

⁴¹ (2003) ECR I -3793

⁴² (2002) RPC 260

d. Art 3 (1) (d) - Customary Signs or Indications: This ground excludes those trademarks consisting of signs or indications that are in common use in trade, note that this applies only in respect of the goods or services for which registration is sought. See case C-517/99 *Merz & Krell GmbH*,⁴³ where the court held that for ground refusal to apply the sign or indication in question must designate the goods and services in respect of which registration is sought.

Other grounds for refusal or invalidity apply where the mark is contrary to public policy or accepted principles of morality, deceptive (Art 3(1) (g)) or if the application is made in bad faith (Art 3 (2) (d)). See the case of *Lindt & Sprüngli AG v Franz Hauswirth GmbH*⁴⁴ which highlights the principle of bad faith, where the filing of a trademark application for purposes other than genuine trade intentions (e.g., blocking competitors) leads to exclusion. Also as in the UK where an application was made to register 'JESUS' for a range of goods in *Basic Trademark SA's Application*,⁴⁵ it was rejected on the basis that it was contrary to public policy or accepted principle of morality.

5.2. Relative Grounds for Refusal

These are the second grounds for refusal of trademark application. It is important to note that the relative grounds are usually raised in opposition proceedings brought by proprietors of earlier trademarks or other earlier rights. Earlier trademark has been defined in Article 4(2) and in section 6 of the UK Trademark Act 1994 as one having an earlier application date, taking any priority into account, being a community trademark, one registered in a member state or registered

⁴³ (2001) ECR I-6959

⁴⁴ (2009) C-529/07

⁴⁵ (2005) RPC 611

under international arrangements having effect in the member state.⁴⁶ It is imperative to note that where an earlier trademark has not been registered, it will be treated as an earlier trademark subject to its registration. It is advisable that section 5 (1) - (3) of the UK Trademarks Act 1994 be read in sequence in order to achieve the prior trademark registration. See *Reed Executive Plc v. Reed Business Information Ltd*⁴⁷ Specifically, the relative grounds include:

i. Identical Goods or Services -Art 4 (1) (a): An earlier registration of the identical mark for identical goods or services will bar the application under S.5 (1). However, where there is an incomplete identity of the sign, the trademark shall not be registered or if registered, shall be liable to be declared invalid. See the case of *Anheuser Busch Inc v Budejovicky Budvar*.⁴⁸ Identical goods mean the goods for which the senior mark is actually registered. However, the test for what an 'identical sign' is has been explained by the ECJ in Case C-291/00 *LTJ Diffusion SA v Sadas Vertaudet SA*,⁴⁹ where the court stated that identity must be strictly interpreted and requires that the two marks be the same in all respects.

However, in the UK it has been accepted that, applying to register a trademark which is identical to an earlier trademark but to which additional material has been added may still be caught by this ground of refusal. See *Decon Laboratories Ltd v Fred Baker Scientific Ltd*⁵⁰, where it was held that the use of an identical sign with a suffix descriptive of the nature and quality of the goods was used for an identical sign. This case can be contrasted with *Compass Publishing BV v. Compass Logistics Ltd*,⁵¹ where it was held that 'COMPASS

⁴⁶ See also Section 44 of the Trademark Act T13 LFN 2004

⁴⁷ (2004) RPC 767 (CA).

⁴⁸ C-245/02 (2004) ECR-10989

⁴⁹ (2003) ECR I-2799

⁵⁰ (2001) RPC 293

⁵¹ (2004) RPC 809

LOGISTICS' was not identical to COMPASS as the difference were apparent and the public would distinguish them without prior coaching.

As a likelihood of confusion is presumed where there is complete identity of the sign and the earlier trademark and the goods and services, the ground of refusal under Art 4 (1) (a) should be reserved for those cases where a significant proportion of consumers would think there was complete identity, given that consumers do not usually make a direct comparison between the sign and the earlier trademark. In *Reed Executive Plc v. Reed Business Information Ltd.*⁵² Jacob LJ held that he did not think that Reed Business Information was identical to Reed.

ii. Incomplete Identity of Mark and goods or services: This is a ground that is commonly used in opposition or invalidity proceedings. Article 4 (1) (b), and section 13 (1) Trademark Act stipulate that a trademark shall not be registered:

if because of its identity with, or similarity to the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trademark.

The appreciation of confusion depends on numerous elements, in particular, the recognition of the trademark on the market, of the association, which can be made with the used or registered sign, the degree of similarity between the trademark and the sign and between the goods or services identified. In Case C-251/95 *Sabel BV v. Puma AG, Rudolf Dassler Sport*⁵³, the court stated that:

‘...it is therefore not impossible that the conceptual similarity resulting from the fact that two marks use

⁵² (2004) RPC 767

⁵³ (1997) ECR I-6191

images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public’.

Note that confusion as to origin might also result from the association the public makes between a very distinctive mark and mark applied for. See Case C-425/98 *Mara mode CV v. Adidas AG*.⁵⁴ See also Case C-39/97 *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.*⁵⁵, where it was held that confusion requires that the relevant section of the public believes the goods or services come from the same undertaking or economically linked undertakings.

ii. Unfair Advantage of or Damage to Repute of Trademark: An earlier registration of the identical or similar mark will bar the application where the earlier has acquired a reputation and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark. See Case C-292/00 *Davidoff & Cie SA v Gofkid Ltd*,⁵⁶ where the Swiss based claimant used the trademark 'Davidoff' in relation to high class goods. The defendant, established in Hong Kong, used a word and devise mark 'Duffee' which was alleged to be similar to those of the claimant. It was claimed that the defendant had tried to take unfair advantage of the prestige value of the claimant and there would be damage to the reputation of its trademark as persons do not tend to associate high-quality goods with China. An example of successful opposition is *CA Sheimer (M) Sdn Bhd's Trademark*

⁵⁴ (2000) ECR I-4861.

⁵⁵ Ibid (n.26)

⁵⁶ (2003) ECR I-389

Application (VISA),⁵⁷ where VISA for credit if allowed to be registered for condom would tarnish the reputation of the earlier registration. It is worthy of note that, other grounds for refusal of trademark under Art 4 (4) (d)-(f) relate to recently expired trademark, collective marks and certification marks.

6.0 Challenges and Ambiguities in Interpretation

As stated in Paragraph 1.0 above, among these grounds for exclusion certain provisions regarding the registration of the shape or other characteristics of goods have proven particularly challenging, and in many cases, confusing for legal practitioners, trademark owners, and students of intellectual property law alike. The challenges in interpreting these exclusions stem from the complex nature of non-conventional trademarks and the overlap between different intellectual property regimes. Professor Ian Currie's in his book, "The Interplay between Trade Marks and Design Rights: Lessons from International Law"⁵⁸ provides a thorough analysis of the difficulties in distinguishing between marks that add substantial value and those that merely serve a brand-distinguishing function. Nigerian legal scholars, such as Emmanuel Nwabueze in "Trade Marks and the Limits of Protection in Nigerian Law"⁵⁹, have similarly noted the need for clearer statutory language and judicial interpretations to address these ambiguities.

6.0 Findings, Recommendations and Conclusion

6.1 Findings:

This essay finds that:

- i. Trademark registration protects the distinctiveness of marks that differentiate goods and services, while excluding deceptive, non-

⁵⁷ (2000) RPC 484

⁵⁸ Oxford University Press, 2019, pp. 121-125

⁵⁹ Nigerian Journal of Business Law, Vol. 5, 2016, pp. 45-58

distinctive, or policy-violating marks from registration to uphold fairness.

ii. Restrictions on trademarking functional shapes or features ensure fair competition by keeping functional aspects free for all. This fosters innovation and prevents monopolies over technical solutions essential to product design.

iii. Features that add substantial aesthetic value cannot be monopolized, allowing competitors to offer appealing alternatives. These rules prevent misuse of trademark law to gain unfair market advantages, ensuring equitable access.

6.2 Recommendations for Reform

Based on the above findings it is hereby recommended follows:

i. Enhancing Legal Clarity - Nigerian trademark law should incorporate more precise statutory provisions regarding shape and functional exclusions, drawing inspiration from the EU Trade Mark Regulation. This will provide clearer guidelines for distinguishing between protectable and non-protectable features, thus improving legal certainty for applicants.

ii. Reform for Accessibility and Efficiency - A comprehensive review of Nigeria's intellectual property laws is necessary to ensure that functional elements and value-based features remain accessible to all market participants. Additionally, the creation of a modern registration process and registry that leverages technological advancements is essential. This system should facilitate real-time global searches, eliminate unreasonable delays, and ensure timely registration.

iii. Strengthen Judicial Interpretation - The adoption of clearer judicial guidelines is essential to improve the interpretation of trademark laws, especially concerning non-conventional trademarks. This will help streamline the registration process and reduce conflicts, benefiting both applicants and trademark owners while ensuring fair

competition in the market. That's why Bolaji Owasanoye⁶⁰ advocates for a comprehensive review of Nigeria's IP laws, particularly regarding non-conventional trademarks and exclusions.

6.3 Conclusion

This paper therefore concludes that prohibition on registering shapes that result from the nature of the goods, are necessary to obtain a technical result, or give substantial value to the goods, and serves a crucial role in preserving the balance between protecting brand identity and maintaining competitive markets. By upholding these principles through case law and statutory provisions, jurisdictions like the European Union and Nigeria ensure that functional and aesthetically significant product features are not monopolised as trademarks, and remain accessible to all manufacturers, promoting innovation and consumer choice. Trademark registration is a detailed process that requires careful attention to legal requirements and strategic planning, understanding the procedural and legal aspects of trademark registration, applicants can better navigate the system, thereby ensuring that their marks are protected and enforced effectively.

⁶⁰ Bolaji Owasanoye, "Reforming Intellectual Property Law in Nigeria: A Comparative Analysis", Nigerian Institute of Advanced Legal Studies, (2017), pp. 202-210