

INTELLECTUAL
PROPERTY

OWNERSHIP OF TRADEMARKS IN NIGERIA

Nigeria operates a “**first to file**” system and our Trade Marks Act grants the owner of a registered trademark exclusive rights to use the trademark and protect it from any form of infringement¹. This means that the first to register a trademark has the right to prevent others from using an identical or confusingly similar trademark for the same goods or services or description of goods or services in respect of which the first trademark was registered. However, there are certain instances where the owner of a registered trademark is not allowed to interfere with the use of a mark which is identical or confusingly similar to his trademark. Such instances include; where the use of the unregistered trademark predates the use or registration of the registered trademark. Such prior use may be by the owner, the business owner or even a predecessor-in- title.²

In *American Cyanamid Co. v. Vitality Pharmaceuticals Ltd.*³, the Nigerian Supreme Court held that the rights of the owner of an unregistered identical or confusingly similar trademark may override that of a later registered proprietor, where the owner of that unregistered trademark proves that he had been using his mark **continuously** for some period before the registration of the later registered trademark. In this case, the court held that although, the mark was first registered by the Plaintiff/Appellant, the Defendant/Respondent is the rightful owner of the mark, having continuously put it to use before the registration by the Plaintiff/Appellant.

In that case, the Plaintiff/Appellant asserted that it had registered the trademark, **GONOCIN**, which was used for antibiotics preparations in 1973 and instituted an infringement action against the Defendant/Respondent based on the latter's use of its trademark. In response, the Defendant/Respondent asserted that it had sold antibiotics preparation called **GONORCIN** since 1968, and even registered the name with the Pharmacy Board in Lagos in 1978. The Defendant/Respondent further contended at the trial that the Plaintiff/Appellant's trademark, which was registered in 1973, ought not to have been registered in the first place and that the registration was invalid on the ground that the Plaintiff/Appellant's trademark interferes with the use of its **GONORCIN** trademark, a trademark that the

¹ Section 5 of the Trade Marks Act (hereinafter referred to as the 'Act') Cap T 13, LFN 2004

² See Sections 7 and 8 of the Act.

³ (1991) LPELR-461(SC)

Defendant/Respondent had been using and under which it had been distributing antibiotics continuously in Nigeria since 1968, a date prior to the plaintiff's registration or use.

The trial court ruled in favour of the Defendant/Respondent and the decision was affirmed by the Court of Appeal and Supreme Court respectively. Hon. Justice Karibi-Whyte JSC (as he then was) held that where a Defendant proves that he had been using his mark **continuously** for some period before the registration of the trademark by the proprietor, his right to use the mark may override that of later registered proprietor.

This case illustrates one of the several exceptions recognized under our laws to the principle of first to file. Other exceptions are covered under Section 13 of the Trade Marks Act, where registration of trademarks that are identical or confusingly similar in respect of the same goods or description of goods by more than one proprietor may be allowed in case of honest concurrent use, or other special circumstances which, in the opinion of the court or the Registrar, make it proper so to do. While an infringement action is hinged on registration, the right to use a trademark under our laws does not depend solely on registration; rather, our laws recognize other vested rights as highlighted above. **Nevertheless, it is advisable to register your trademark to ensure wider protection.**

The Grey Matter Concept is an initiative of the law firm, Banwo & Ighodalo

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For further information on how to protect your trademark, kindly contact our **Intellectual Property and Technology Practice Group** at ipgroup@banwo-ighodalo.com

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