

Published in IP Value 2006 Magazine

PROTECTING AND ENFORCING TRADEMARKS AND COPYRIGHTS

In order to keep up with global economic trends and challenges relating to intellectual property, Nigeria has signed up to various international treaties and conventions with the intention of creating an avenue for the rapid development and appreciation of intellectual property, brand names and quality products as an intangible business asset.

This chapter focuses on the protection and enforceability of trademarks and copyrights in relation to effective implementation in accordance with the...read more.

Trademarks

In Nigeria, trademarks are regulated by the Trademarks Act 1965. This act was modelled on the UK Trademarks Act 1938, which repealed the Trademarks Ordinance 1914. The act came into force on June 1 1967. It does not provide for the registration of service marks.

Registration Procedures

A trademark is protected under the act if its registration is applied for in the prescribed manner. The procedure for registering a trademark involves filing an application using the approved forms. The applicant is required to provide a representation of the trademark as well as relevant information (eg, its address, goods specifications). Upon filing the application at the Trademarks Registry, the applicant receives an acknowledgement form. The application is then submitted to the registrar of trademarks for examination.

The registrar's examination consists of a search of the register to determine whether there are any registered trademarks that are likely to conflict with the application - if not, the mark is registrable under the act.

If the registrar is satisfied that the trademark is registrable and free for registration, he will issue an acceptance to the applicant. The application is then advertised in the Trademarks Journal - this is to allow third parties to oppose the registration of the application. If no opposition is filed against the registration within two months of publication, the trademark is registered.

The processing of an application through to registration takes between 18 and 24 months. Once the trademark has been registered it is effective from the date of filing and will remain in force for a period of seven years, renewable every 14 years thereafter.

Protecting your Trademark

In Nigeria, the active protection of a trademark goes beyond statutory registration, although this is the first step towards protection against possible infringement.

The Trademarks Registry is not automated and therefore all matters relating to trademarks (ie, searches, acknowledgements, acceptances, registrations) are dealt with manually. This inadequacy sometimes leads to errors such as double registration, which occurs where the registrar erroneously accepts a trademark that is identical to an already registered or accepted trademark. Where the true owner of a trademark finds itself in this situation, it must establish its entitlement to the trademark, as registration in Nigeria is based on a first-to-file system.

Under these circumstances, the remedies available to the true owner include, but are not limited to, the following:

- a formal application to the registrar demanding withdrawal of the acceptance or cancellation of the certificate of registration of the offending trademark. The application must be supported by documents showing ownership of the trademark and registrations/acceptances in Nigeria and other countries that precede the offending registration/application. If the registrar finds in favour of the true owner, it may unilaterally withdraw the acceptance or cancel the certificate given to the other party. Where appropriate, the registrar permits the disputing parties to make representations before making a decision at a hearing. This is a cost-effective method of correcting the anomaly;
- filing an opposition against the registration of the offending trademark as soon as it is advertised in the Trademarks Journal. This option is more time consuming but still effective - it involves the filing of various documents by both parties, including notice of opposition, counter-statement and statutory declaration. The matter is determined at a hearing before the registrar;
- writing a cease-and-desist letter to the infringer;
- the legal option of filing an action in court. This option is usually explored where there has been active use of the trademark by the infringer with respect to goods of the same class; and
- placing notices in the newspapers and other media. This may have far-reaching effects as the information is passed directly to consumers. It also helps to raise the level of awareness among consumers.

Enforcing trademark rights

A proprietor that wishes to enforce its trademark rights must act quickly and aggressively in order to maintain the integrity of the brand. It may apply common law and any other applicable statutes to achieve this.

A trademark proprietor may receive support from various enforcement agencies by:

- employing private investigators to conduct investigations into whether the infringers have stopped actual use of the trademark;

- employing a local agent to take over the maintenance of the trademark and keep a constant watch on subsequently published issues of the Trademarks Journal to ensure that the application is not mistakenly re-advertised and inadvertently registered;
- applying to the court for the grant of a search and seizure order. If granted, the order empowers the applicant to conduct a raid (without notice) on the infringer's premises and seize all infringing goods found. To do this, the applicant may need to collaborate with law enforcement agencies such as the police, the Standards Organisation of Nigeria, the Nigerian Customs Services and the National Agency for Food and Drug Administration and Control. This option is effective as it disrupts the business activities of the infringer and sends a signal that the applicant intends to defend its trademark rights;
- sending a cease-and-desist letter written by the trademark owner or a local attorney. However, this has not proved to be an effective deterrent as the letter may not be taken seriously without the backing of a valid court order. It also has the disadvantage of alerting the infringer of any future enforcement action; and
- advertising in the newspapers and other media. This has proved to be effective as the message is passed directly to consumers. It also has the advantage of providing information on who the original owners are and how to recognise the genuine products.

Successful Owners

Many local and international trademark owners have successfully fought and prosecuted the unlawful use of their trademarks in Nigeria. In order to protect the integrity of their brands, multinational companies which have invested substantially in their brand have launched various campaigns against counterfeit products and counterfeiters. They have been able to do this successfully in conjunction with the law enforcement agencies.

Judicial reforms

Before 2003 all actions dealing with registered and unregistered trademarks were heard by the Federal High Court. However, in 2003 the Supreme Court, in *Ayman Enterprises Limited v Akuman Industries Limited*, had cause to interpret the combined provisions of the relevant sections of the Nigerian Constitution, Trademarks Acts and the Federal High Court Act relating to trademarks. The Supreme Court held that the jurisdiction of the Federal High Court to deal with actions on passing off depends on the registration of trademarks. Therefore, the Federal High Court will have jurisdiction to hear an action for passing off arising only from an infringement of a registered trademark.

When the trademark is unregistered, the cause of action for passing off is in tort, for which action should be brought in a state high court. This decision has clarified the jurisdiction of both courts with respect to infringement and passing-off cases, and has also helped to decongest the courts and speed up trials.

The common remedies available for trademark infringement/passing off are an injunction, a damages award and delivery up and destruction of the infringing goods.

Copyrights

In Nigeria, copyright in a work means that its author has the exclusive right to control certain actions in respect of the whole or a substantial part of a work, either in its original form or in any form recognisably derived from the original. However, this is subject to certain statutory exceptions, including carrying out a specified act for research purposes, private use, criticism or review and use in prescribed educational institutions.

The works eligible for copyright protection include literary, musical and artistic works, cinematography films, sound recordings and broadcasts.

For a work to be eligible for copyright protection it must be original. A literary, musical or artistic work will not be eligible for copyright unless it has been fixed in a definite medium from which it can be perceived, reproduced or otherwise communicated either directly or with the aid of any machine or device.

There is no registration requirement for copyright in Nigeria. Copyright is vested automatically by the Copyright Act in all eligible works that qualify for protection.

Governing Legislation

The Copyright Act 1988 sets out the law relating to the protection, transfer, remedies and penalties for infringement of copyright in Nigeria. The Copyright Act provides for the protection of the property rights of literary, musical and artistic works, cinematograph films, sound recordings and broadcasts.

Section 5 of the Copyright Act stipulates that copyright shall be conferred on every work if: "On the date of its first publication at least one of the authors is a citizen of or domiciled in a country or a body corporate established by or under the laws of a country that is a party to an obligation in a treaty or other international agreement to which Nigeria is a party" and if "the work is first published in a country that is a party to an obligation in a treaty or other international agreement to which Nigeria is a party, by the United Nations or any of its specialised agencies or by the Economic Community of West African States."

If the question arises as to whether a country is a party to an obligation in a treaty or other international agreement to which Nigeria is also a party, a certificate from the commission to that effect is accepted as conclusive proof.

Where any country is a party to a treaty or other international agreement to which Nigeria is also a party, and the minister is satisfied that the country in question provides for protection of copyright in works that are protected under the Copyright Act, the minister may, by order in the Federal Gazette, extend the application of the Copyright Act in respect of any or all of the works referred to in the act.

Nigeria is a signatory to the Universal Copyright Convention 1952, the Berne Conventions 1886 and 1971 for the protection of rights in literary, musical and artistic works and the Rome Convention 1961 for the protection of performers, producers of phonogram and broadcasting organisations.

Administration of Copyright

The Nigerian Copyright Council is the statutory body charged with the administration of all copyright matters in Nigeria. The council runs seminars and workshops to educate the general public and authors on copyright. Its functions include regulating conditions for the conclusion of bilateral and multilateral agreements between Nigeria and other countries, and maintaining an effective database on authors and their works. The council also issues certificates of notification to copyright owners that notify it of their rights in the work.

The council, with the consent of the minister, has the power to make regulations specifying the conditions necessary for the operation of a business involving the production, public exhibition, hiring or rental of any work in which copyright subsists.

One of the council's most notable achievements was the launch of a national anti-piracy campaign in 1991. In addition, the council, in conjunction with rights holders, occasionally conducts raids on markets and warehouses and publicly destroys seized goods as a deterrent.

Infringement of copyright

Under Section 15 of the Copyright Act, copyright is infringed by any person who, without the licence or authorisation of the copyright owner:

- carries out, or causes any other person to carry out, an act that is controlled by copyright;
- imports or causes to be imported into Nigeria any copy of a work that, if it had been made in Nigeria, would be an infringing copy under this section of the Copyright Act;
- exhibits in public any article in respect of which copyright is infringed under the first bullet point above;
- distributes by way of trade, offers for sale, hire or otherwise or for any purpose prejudicial to the copyright owner any article in respect of which copyright is infringed under the first bullet point above;
- makes or has in its possession plates, master tapes, machines, equipment or contrivances used for the purpose of making infringing copies of the work;
- permits a place of public entertainment or business to be used for a public performance of the work where the performance constitutes copyright infringement, unless the person permitting the place to be used for the performance was not aware,

and had no reasonable grounds to suspect, that the performance would be an infringement of copyright; or

- performs or causes to be performed, for the purposes of trade or business or as a supporting facility to trade or business, any work in which copyright subsists.

Action for infringement

An action for infringement of copyright is provided for under Section 16 of the Copyright Act. Copyright infringement is actionable at the instigation of the owner, assignee or an exclusive licensee of the copyright in the Federal High Court which has jurisdiction in the place where the infringement occurred.

Remedies for infringement of copyright

The principal remedies available in Nigeria are as follows.

Damages: In awarding damages, the court considers the loss of profits caused to the plaintiff by the infringer's diversion of trade from the plaintiff. In addition, the flagrancy of the infringement and any benefit shown to have accrued to the defendant by reason of the infringement are considered.

Injunction: This is the most useful and frequent remedy available to victims of copyright infringement. The plaintiff can seek an interim injunction pending the determination of the case and perpetual injunction as a final remedy. It should be noted that injunctions are an equitable remedy and the granting of injunctions is discretionary.

Account of profits: The copyright owner can seek an account of profits arising from the infringement. It is important to note that the plaintiff cannot claim for both damages and account of profits, but must choose one or the other.

Delivery up or destruction: The infringed materials can be confiscated or destroyed. The destruction extends to receipts, containers, vehicles, ships, aircraft etc. This order is frequently applied in Nigeria, especially with respect to smuggling cases.

Conversion rights: All infringing copies of a work in which copyright subsists, or of any substantial part of the work, and all plates, master tapes, machines, equipment or contrivances used or intended to be used for the production of such infringing copies, are deemed to be the property of the owner, assignee or exclusive licensee of the copyright, which accordingly may take action to recover the possession or conversion of these articles. Therefore, the owner may have three causes of action:

- an action for infringement of copyright;
- an action for conversion of the offending articles; and
- recovery of the offending articles.

In an infringement action, if an ex parte application is made to the court supported by an affidavit stating that there is reasonable cause that there are infringing articles in any house or premises, the Federal High Court may issue an order authorising the applicant (accompanied by a police officer) to seize, detain and preserve such infringing articles and to inspect all or any relevant documents in the custody of or under the control of the defendant.