

MAKING A MARK

Intellectual Property
for Business Series / Number 1



An Introduction to Trademarks for Small and Medium-sized Enterprise

Publications in the “Intellectual Property for Business” series:

1. Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises. WIPO publication No. 900.
2. Looking Good: An Introduction to Industrial Designs for Small and Medium-sized Enterprises. WIPO publication No. 498.
3. Inventing the Future: An Introduction to Patents for Small and Medium-sized Enterprises. WIPO publication No. 917.
4. Creative Expression: An Introduction to Copyright and Related Rights for Small and Medium-sized Enterprises. WIPO publication No. 918.

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Introduction

This guide is the first in a series of guides on “Intellectual Property for Business”. It is devoted to trademarks, a central element in the marketing and branding strategy of any company.

This guide seeks to explain trademarks from a business perspective. Its approach is practical and explanations are illustrated with examples and pictures to enhance the reader’s understanding.

Small and Medium-sized Enterprises (SMEs) in Nigeria are encouraged to use the guide with a view to integrating their trademark strategy into their overall business strategy.

In compilation of this booklet, efforts of the Law and Allied Resourcery team comprising Ayo Ayeni (Project Coordinator), Tinukemi Alabi, Alexandria Adesuwa, Yahaya Maikori and Ese Oraka of Law Allianz, and the meticulous Aisha Y. Salihu from the Registry, without whose effort this guide would not exist, have been most commendable..

I hope Nigerian SMEs will benefit from this joint effort on the part of World Intellectual Property Organisation (WIPO) and The Registry of Trademarks, Patents and Designs, Federal Ministry of Trade and Investments, for seeking protection and drawing maximum economic gains through the appropriate commercialization of their original creative work.

J.K. Ahmadu-Suka
Registrar, Trademarks, Patents and Designs.

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1. Trademarks

(sounds).

Examples

What is a Trademark?

A trademark is a sign capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises.

Any distinctive words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels or combinations used to distinguish goods or services may be considered a trademark. In Nigeria, advertising slogans are also considered trademarks and may be registered as such at The Registry of Trademarks, Patents and Designs. An increasing number of countries also allow for the registration of less traditional forms of trademarks such as single colors, three-dimensional signs (shapes of products or packaging), audible signs (sounds) or olfactory signs (smells). However, Nigeria presently does not provide for the registration of olfactory signs (smells), and audible signs

Word:

The image shows the word "Cadbury" in a blue, cursive script font.

NIGERIA

Courtesy: Cadbury Nigeria Plc

Logotype:



Reproduced by the permission of Julius Berger Nigeria Plc

Combination of letters with logotype:



Courtesy of United African Company of Nigeria Plc.

WHAT ARE TRADEMARKS FOR?

The main function of a trademark is to enable consumers to identify a product (whether a good or a service) of a particular company so as to distinguish it from other identical or similar products provided by competitors. Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products.

Three-dimensional mark (shape of product):



Ziza is a trademark registered by Dangote Group of Companies

By enabling companies to differentiate themselves and their products from those of the competition, trademarks play a pivotal role in the branding and marketing strategies of companies, contributing to the definition of the image, and reputation of the company's products in the eyes of consumers. The image and reputation of a company create trust which is the basis for establishing a loyal clientele and enhancing a company's goodwill. Consumers often develop an emotional attachment to certain trademarks, based on

a set of desired qualities or features embodied in the products bearing such trademarks.

company with a competitive edge.

Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trademark have a positive reputation.



Courtesy: IBM Nigeria

The Value of Trademarks

A carefully selected and nurtured trademark is a valuable business asset for most companies. For some, it may be the most valuable asset they own. Estimates of the value of some of the world's most famous trademarks such as Coca-Cola or IBM exceed 50 billion dollars each. This is because consumers value trademarks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trademark that they recognize and which meets their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a

Why Should Your Company Protect Its Trademark(S)?

While most businesses realize the importance of using trademarks to differentiate their products from those of their competitors, not all realize the importance of protecting them through registration.

Registration, under the relevant trademark law, gives your company the exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark.

Without trademark registration, your investments in marketing a product may become wasteful as rival companies may

use the same or a confusingly similar trademark for identical or similar products. If a competitor adopts a similar or identical trademark, customers could be misled into buying the competitor's product thinking it is your company's product. This could not only decrease your company's profits and confuse your customers, but may also damage the reputation and image of your company, particularly if the rival product is of inferior quality.

Given the value of trademarks and the importance that a trademark may have in determining the success of a product in the marketplace, it is critical to make sure that it is registered in the relevant market(s).

In addition, a registered trademark may be licensed to other companies, thus providing an additional source of revenue for your company, or may be the basis for a franchising agreement.

On occasion, a registered trademark with

a good reputation among consumers may also be used to obtain funding from financing institutions that are increasingly aware of the importance of brands for business success.

Trademarks:

- ensure that consumers can distinguish between products;
- enable companies to differentiate their products;
- are a marketing tool and the basis for building a brand image and reputation;
- are licensed and provide a direct source of revenue through royalties;
- are a crucial component of franchising agreements;
- may be a valuable business asset;
- encourage companies to invest in maintaining or improving product quality;
- may be useful for obtaining financing.

2. Protecting Trademarks

How can your company protect its trademark(s)?

In Nigeria, Trademark protection can be obtained through registration and through use. Even where trademarks can be protected through use, you are well advised to register the trademark by filing the appropriate application form at the national trademark office (Nigeria has no facilities for applying for registration on-line). Registering a trademark will provide stronger protection, particularly in case of conflict with an identical or confusingly similar trademark. For the registration of a trademark, the services of a trademark agent are often very useful.

Is the registration of the trade name of your company sufficient?

Many people believe that by registering their business and its trade name at the Corporate Affairs Commission (CAC), this name would also be automatically protected

as a trademark. This is a rather common misconception. It is important to understand the difference between trade names and trade marks.

A trade name is the full name of your business, such as: “Dangote Group of Companies Ltd” and it identifies your company. It often ends with Ltd, PLC. or other similar abbreviations that denote the legal character of the company.

A trademark, however, is the sign that distinguishes the product(s) of your company. A company may have various trademarks. For instance, Dangote Group of Companies Ltd. may sell one of its products as DANSA but another as ZIZA. Companies may use a specific trademark to identify all their products, a particular range of products or one specific type of product. Some companies may also use their trade name or a part of it, as a trademark and should, in that case, register it as a trademark.

Who is authorized to apply for trademark registration?

In general, any person who intends to use a trademark or to have it used by third parties can apply for registration. It can be either an individual or a legal entity.

Is it compulsory to register a company's trademarks?

While it is not compulsory, it is highly advisable, as registration provides exclusive rights to prevent unauthorized use of the trademark. However, in Nigeria the National Agency for Food and Drug Administration Commission (NAFDAC) requires that all food and pharmaceutical products must be registered as trademarks.

What are the main reasons for rejecting an application?

While selecting a trademark it is helpful to know which categories of signs are usually not acceptable for registration. Applications for trademark registration are usually

rejected on what are commonly referred to as “absolute grounds” in the following cases:

- **Generic terms.** For example, if your company intends to register the trademark CHAIR to sell chairs, the mark would be rejected since “chair” is the generic term for the product.
- **Descriptive terms.** These are words that are usually used in trade to describe the product in question. For example, the mark SWEET is likely to be rejected for marketing chocolates as being descriptive. In fact, it would be considered unfair to give any single chocolate manufacturer exclusivity over the word “sweet” for marketing its products. Similarly, qualitative or laudatory terms such as “RAPID” “BEST” “CLASSIC” or “INNOVATIVE” are likely to give rise to similar objections unless they are part of an otherwise distinctive mark. In such cases, it may be necessary to include a disclaimer clarifying that no exclusivity is sought for that particular part of the mark.

- **Deceptive trademarks.** These are trademarks that are likely to deceive or mislead consumers as to the nature, quality or geographical origin of the product. For example, marketing margarine under a trademark featuring a COW would probably be rejected, as it would be considered misleading for consumers, who are likely to associate the mark with dairy products (i.e. butter).

- Marks considered to be contrary to public order or morality. Words and illustrations that are considered to violate commonly-accepted norms of morality and religion are generally not allowed to be registered as trademarks.

- Flags, armorial bearings, official hallmarks and emblems of states and international organizations which have been communicated to the International Bureau of WIPO are usually excluded from registration.

Applications are rejected on “relative grounds”

when the trademark conflicts with prior trademark rights. Having two identical (or very similar) trademarks for the same type of product could cause confusion among consumers. Some trademark offices check for conflict with existing marks, including unregistered well-known marks, as a regular part of the registration process, while many others only do so when the trademark is challenged by a third party after publication of the trademark. In either case, if the trademark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be rejected or cancelled, as the case may be.

It would, therefore, be wise to avoid using trademarks that risk being considered confusingly similar to existing marks.

What should be kept in mind when selecting or creating a trademark?

Selecting or creating an appropriate trademark is a critical step, as it is an important element of the marketing strategy

of your business. So what is an appropriate trademark for your product(s)? Evidently, there are no hard and fast rules. But the following five-point checklist may be useful.

Five Point Checklist for Selecting Your Trademark

- Check that your trademark of choice meets all the legal requirements for registration (see reasons for rejecting applications on page 9).
- Do a trademark search to make sure that it is not identical or confusingly similar to existing trademarks.
- Make sure the trademark is easy to read, write, spell and remember and is suitable to all types of advertising media.
- Make sure the mark does not have any undesired connotations in your own language or in any of the languages of potential export markets.
- Check that the corresponding domain name (i.e. Internet address) is available for registration. (for more on the relationship between trademarks and domain names see

page 26).

While selecting one or more words as your trademark you should also take into consideration the implications of selecting certain types of words:

- Coined or “fanciful” words. These are invented words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, however, they may be more difficult to remember for consumers, requiring greater effort to advertise the products.

Example:

Etisalat is a registered trademark of Emerging Markets Telecommunication Services (EMTS), trading as Etisalat Nigeria.



Courtesy: Etisalat Nigeria.

- **Arbitrary marks:** These are words that have a meaning that has no relation to the product they advertise. While these types of marks will also be easy to protect, they may also require heavy advertising to create the association between the mark and the product in the minds of consumers.

Example: The trademark ELEPHANT for marketing banking services.



Courtesy: First Bank Nigeria Plc.

- **Suggestive marks.** These are marks that hint at one or some of the attributes of the product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that some countries may consider a suggestive mark to be too descriptive of the product.

Example: The trademark CREAMI for marketing dairy products would hint at the fact that the product is creamy. In Nigeria, the Registrar of Trademarks, Patents and Designs, may find the mark too descriptive and thus may not register it.

Irrespective of the type of mark you choose, it is important to avoid imitating existing trademarks. A slightly altered competitor's trademark or a misspelt well-known or famous mark is unlikely to be registered.

Example: Honeywell is a registered trademark for HONEYWELL GROUP NIGERIA. It would be unwise to try to sell the same or similar products using the trademark HONIWELL as it would probably be considered confusingly similar to the existing mark and is unlikely to be registered.



Courtesy: Honeywell Group Nigeria.

Registering a Trademark - Step by Step

The Applicant

As a first step, you have to send or hand in a duly completed trademark application form, which will include the contact details of your company, a Power of Attorney authorizing the applicant's agent, a graphic illustration of its mark (hard copies) a description of the goods and services and/or class(es) for which your business wishes to obtain trademark registration, and pay the required fees.

Trademark Office: The Registry of Trademarks, Patents and Designs.

The following are steps taken by the Registry to register a trademark;

Formal examination: the registry examines the application to make sure that it complies with the administrative requirements or formalities (i.e., whether the application fee

has been paid and the application form is properly filled in).

Substantive examination: the registry also examines the application to verify whether it complies with all the substantive requirements (e.g., whether it belongs to a category which is excluded from registration by the trademark law and whether the trademark is in conflict with an existing mark on the register in the relevant class(es), a Letter of Acceptance is issued if trademark is registrable.

Publication and opposition: The trademark is published in a journal with a set period of 60 days for third parties to oppose its registration.

Registration: In the absence of any opposition, the applicant applies for registration, and a registration certificate is issued that is generally valid for 7 years.

Renewal: the mark may be renewed

subsequently every 14 years by paying the required renewal fees but the registration may be canceled entirely for certain goods or services if the trademark has not been used for a period of 5 years.

How long does it take to register a trademark?

In Nigeria, the time required for the registration of a trademark ranges from six months to two years, depending, among other things, on whether the trademark is opposed or not. Make sure that you apply for registration of a trademark well in advance so that its registration is secured in time for its use in the advertising and marketing of the relevant products.

What are the costs associated with trademark creation, protection and use?

It is important to keep in mind, and properly budget, the costs related to trademark creation and registration:

- There may be costs associated with the creation of a logo or word to be used as a trademark, as many companies outsource this task.
- There are costs associated with the registration process (See Table Below):

TRADEMARK FEES

<u>S/NO</u> <u>(N)</u>	<u>CATEGORY</u>	<u>NEW FEES</u>
1.	Search Form (Availability)	1,500
2.	Request for Preliminary advice On availability of Trademark For registration	1,500
3.	Forms for registration of Trademarks (Forms 1, 2 & 3)	2,000
4.	Application for registration of trademark	10,000
5.	Application for issuance of trademark certificate.	
6.	Application and registration of certification trademarks.	12,000
7.	Application and registration of defensive trademarks	10,000
8.	Notice of opposition	8,000
9.	Counter Statement	8,000
10.	Statutory Declaration	8,000
11.	(a) Preliminary Opposition (Hearing within Hearing) to correct irregularities (b) Security for cost, subject to Registrar's discretion Reg. 58	10,000
12.	Changes in registered Particulars (Names, Addresses etc.) (each)	8,000
13.	Renewal of trademarks certificate.	12,000
14.	Penalty for late renewal of trademark	6,000
15.	Certified True Copy (CTC) of Certificate	8,000

16. (a) Certified True Copy Renewal Certificate	8,000
(b) CTC of every other form or document	4,000
17. Registration of Assignment within the prescribed period	15,000
18. Penalty for late registration of assignment of trademark	6000
19. Applications for directives from the registrar for advertisement of assignment.	5000
20. Registration of registered user of trademarks	15,000
21. Cancellation of registered user	8,000
22. Reclassification of trademarks	15,000
23. Application to intervene in rectification proceedings	20,000
24. Application for rectification of trademark	8, 000
25. Application for leave to correct or add to registered trademarks particulars	10,000
26. Restoration of trademark on the register	10,000
27. Search fees (Trademarks status)	5,000
28. Service in compliance with other statutory provisions and regulations as per statutory forms not otherwise provided for in the present schedule of fees e.g forms 4,8, 20,25 37,38, 39,43 & 51.	5,000
29. Temporary file	1,000
30. Application for extension of time	10,000
31. Extract of Trademark application/	6000

Application status

- Companies choosing to use a professional trademark agent to assist in the registration process would face additional costs but would probably save significant time and energy in following the registration process.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

Before submitting an application for registering a trademark, you should ensure that a proper trademark search has been carried out. This is done to make sure that the trademark you intend to use, or a similar one, is not already registered by another company for identical or similar products.

To conduct a trademark search, you engage the services of a trademark agent. The Registry of Trademarks, Patents and Designs require the payment of a Search fee. In

whatever manner it is done, bear in mind that any such trademark search is only preliminary. It may be difficult to make sure that your trademark of choice is not “confusingly similar” to existing validly-registered trademarks. This is why the guidance of an experienced trademark agent, who is familiar with the practice of the trademark office and court decisions, may be very helpful.

Trademarks are grouped into “classes” according to the goods or services they serve to identify (see the international classification system in Annex II). You may therefore begin by familiarizing yourself with the 45 different trademark classes.

A Well-classified System

While filling in your trademark application form you are required to indicate the goods and/or services for which you wish to register your trademark and to group them according to classes. These refer to the classes in the trademark classification system. The

trademark classification system allows for the storage of data on registered trademarks in an orderly manner in relation to the types of goods or services. This makes it easier to retrieve information from trademark databases. It is critical to register your trademark in all classes in which you intend to use your trademark.

The most widely used classification system, which Nigeria has adopted, is the International Trademark Classification system (the so-called Nice system for classification of word marks), which has 34 classes for goods and a further 11 for services. More information on the Nice classification system is available in Annex II. See also: www.wipo.int/classifications/en/nice/about/.

Example:

How are products classified? Let us take an example. If your company is producing knives and forks, then your trademark application should be made for the corresponding goods in class 8. If, however, you wish to market

other kitchen utensils (such as containers, pans or pots) using the same trademark you will also have to register the mark for the corresponding goods in class 21. You would have to make a separate application for each class of product.



Do you need a trademark agent to file a trademark application?

As a general rule, most countries do not require you to hire a trademark agent to file an application; you may file the application yourself. However, the services of a trademark agent skilled in conducting trademark searches and familiar with the detailed procedure for trademark registration may be used to save time, ensure that you apply for protection in the appropriate trademark class(es) and avoid refusal on absolute grounds. If you apply for trademark registration abroad you may be required to have a trademark agent

who is resident in the relevant country. The relevant trademark office will be able to advise you on the need, if any, to be represented by an agent and provide you with a list of officially approved trademark agents (see Annex I).

For how long is your registered trademark protected?

Registered trademarks are protected for 7 years. Registration may be renewed indefinitely (for consecutive periods of 14 years) provided renewal fees are paid in time. Make sure that someone in your company is made responsible for ensuring timely renewal of trademark registrations of continuing interest to your business.

Outsourcing Trademark Creation

Designing a trademark is a creative process. In most countries, a creator automatically owns the copyright over creative or artistic works, such as the artwork of a trademark, in Nigeria it all depends on the contractual agreement. Therefore, when the creation of

a trademark is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and/or to make sure the copyright over the trademark is formally assigned to your company.

Is trademark registration in Nigeria valid internationally?

The legal rights arising out of a trademark registration are normally limited to the territory to which they pertain; so, ordinarily, valid registration of a trademark in Nigeria gives you rights only in Nigeria unless your mark is considered to be a well-known mark. (For information on well-known marks see page 23.)

Should you consider protecting your trademark abroad?

All the main reasons for registering your trademark in your home country also apply to the commercialization of your products in foreign markets. It is, therefore, highly advisable to register your trademark abroad if you

are currently engaged in export operations or intend to do so in the near future. Exporting goods bearing a distinctive trademark will enable your export products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers that may result in higher profits for your company.

How can you register the trademark of your company abroad?

If you have registered the trademark of your company in Nigeria where it is located (home country) but now wish to export or grant a license to use the trademark in other countries, then it is advisable to register the trademark abroad. There are three main ways to do so:

The National Route: your business may apply to the trademark office of each country in which it is seeking protection by filing the corresponding application in the required language and paying the required fees. As indicated earlier, a country may require you to use the services of a locally-based trademark

agent for this purpose.

The Regional Route: if you wish to apply for protection in countries which are members of a regional trademark system you may apply for registration, with effect in the territories of all Member countries, by filing an application at the relevant regional office. The regional trademark offices are:

- The African Regional Industrial Property Office
- The Benelux Trademark Office
- The Office for the Harmonization of the Internal Market of the European Union.
- The Organisation Africaine de la Propriété Intellectuelle.

The International Route: An applicant may use the Madrid system (administered by WIPO) to register your trademark in the more than 70 countries that are party to the system. Note however that Nigeria is not signatory to any of the above systems.

Advantages of using the Madrid system

The principal advantages of using the Madrid system are that the trademark owner can register his trademark in all the countries party to the system by filing:

- a single international application;
- in one language;
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure.

You can find more information on international registration of marks either at Registry of Trademarks, Patents and Designs or on the WIPO website: www.wipo.int/madrid/. A list of the Member countries of the Madrid system is available in Annex III. class of product.

3. Types of Trademark

Trade marks Marks used to distinguish certain goods as those produced by a specific enterprise.

Service marks Marks used to distinguish certain services as those provided by a specific enterprise.

Collective marks Marks used to distinguish goods or services produced or provided by members of an association.

Certification marks Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority.

Well-known marks Marks that are consid

ered to be well-known in the market and as a result benefit from stronger protection.

What is a service mark?

A service mark is very similar in nature to a trademark. Both are distinctive signs; trademarks distinguish the goods of one enterprise from those of others, while service marks fulfil the same function in relation to services. Services may be of any kind, such as financial, banking, travel, advertising or catering, to name a few. Service marks can be registered, renewed, cancelled, assigned and licensed under the same conditions as trademarks.

Example:



Courtesy: Skye Bank Plc

What are collective marks?

A collective mark is generally owned by an association or cooperative whose members may use the collective mark to market their products. The association generally establishes a set of criteria for using the collective mark (e.g., quality standards) and permits individual companies to use the mark if they comply with such standards. Collective marks may be an effective way of jointly marketing the products of a group of enterprises which may find it more difficult for their individual marks to be recognized by consumers and/or to be accepted for distribution by the main distributors.

What are certification marks?

Certification marks are given for compliance with defined standards, but are not confined to any membership. They may be used by anyone whose products meet certain established standards. In many countries, the main difference between collective marks and certification marks is that the former

may only be used by a specific group of enterprises, e.g., members of an association, while certification marks may be used by anybody who complies with the standards defined by the owner of the certification mark.

An important requirement for certification marks is that the entity which applies for registration is considered “competent to certify” the products concerned.

Example:

Superbrands® Nigeria is a subsidiary of Superbrands® Ltd., the international independent authority and arbiter on branding. The organization promotes the discipline of branding and pays tribute to exceptional brands through programs in over 83 countries across 4 continents.

The goal of Superbrands® is to identify those brands which perform above and beyond others within the market. It identifies and honors exceptional brands by recognizing, rewarding, and reinforcing leading brands from all over the world. Its logo is sealed on identified

brands as a mark of quality.



Courtesy: Superbrands Nigeria.

What are well-known marks?

“Well-known marks” are marks that are considered to be well-known by the competent authority of the country where protection for the mark is sought. Well-known marks generally benefit from stronger protection. For example, well-known marks may be protected even if they are not registered (or have not even been used) in a given territory. In addition, while marks are generally protected against confusingly similar marks only if used for identical or similar products, well-known marks are protected against confusingly similar marks for even dissimilar products, if certain conditions are met. The main purpose of this stronger protection is to prevent companies from free-riding on the reputation

of a well-known mark and/or causing damage to its reputation or goodwill.

Example: Let us assume that WONDERCOLA is the famous trademark of a soft drink. Wondercola Ltd. would then benefit from automatic protection in those countries where well-known marks enjoy a stronger protection and where the mark is well-known for soft drinks. The protection would also be available for unrelated goods and services. That is to say that if another company decides to market other products, ranging from T-shirts to sunglasses, using the WONDERCOLA mark, it will have to seek the authorization of Wondercola Ltd. or risk being sued for violation infringement of trademark rights.

4. Using Trademarks

Can you register a trademark without having used it?

You may apply for registration before you

have used the trademark. Also, in Nigeria, a trademark that has not been used for five years following registration may be taken off the trademark register.

TM or ®?

The use of ®, TM, SM or equivalent symbols next to a trademark is not a requirement and generally provides no further legal protection. Nevertheless, it may be a convenient way of informing others that a given sign is a trademark, thus warning possible infringers and counterfeiters. The ® symbol is used once the trademark has been registered, whereas TM denotes that a given sign is a trademark; SM is sometimes used for service marks.

How should you use trademarks in advertising?

If your mark is registered with a specific design or font, make sure that the trademark is used exactly as it is registered. Monitor its use closely as it is crucial for the image of your company's products. It is also important to avoid using the trademark as a verb or noun so that it does not come to be perceived

by consumers as a generic term.

Can your company use the same trademark for different products?

Different trademarks may be used for the different products lines of a company.

Depending on its branding strategy, each company will decide whether to use the same trademark for its products, extending the brand every time a new product is released, or to use a different mark for each product line.

Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, more specific and relevant to the new product, may also prove advantageous and enable the company to target the new product to a specific customer group (e.g. children, teenagers, etc) or to create a specific image for the new product line. Many companies also choose to use a new brand in conjunction with an existing brand (e.g., Chi Limited).



Caprisonne



Chi Jelly



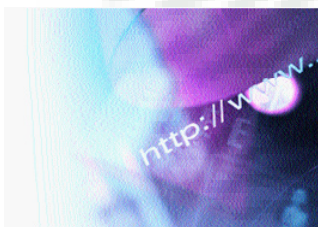
Chivita Juice

Courtesy of Chi Limited.

Different companies adopt different strategies. Whatever your choice, you should make sure that your trademark is registered for all categories of goods and/or services for which it is, or will be, used.

What should be kept in mind when using trademarks on the Internet?

The use of trademarks on the Internet has raised a number of controversial legal problems with no easy or uniform solution. One important problem stems from the fact that trademark rights are territorial (that is, they are only protected in the country or region where the mark has been registered or used), whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or companies legitimately owning identical or confusingly similar trademarks for identical or similar goods or services in different countries. Legislation in this area is still developing and treatment may differ from one country to another.



What is a domain name and how does it relate to trademarks?

An important problem concerns the conflict between trademarks and domain names. Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'wipo.int' is used to locate the WIPO website at www.wipo.int. Over time, domain names have come to constitute business identifiers thus often coming into conflict with trademarks.

Therefore, it is important that you chose a domain name which is not the trademark of another company, particularly a well-known trademark. This is because many national laws, or courts, treat registration of the trademark of another company or person as a domain name as trademark infringement, popularly known as cybersquatting. If this happens, then, your business may not only have to transfer or cancel the domain name, but it may also have to pay damages or a heavy fine.

In order to find out whether a particular trademark is already protected, you can directly contact the Registry of Trademarks, Patents and Designs.

On the other hand, if the trademark of your company is being used in a domain name or is being cybersquatted by another individual or company then you may take action to stop such misuse/infringement of the rights of your company. In such a case, one option would be to use WIPO's very popular online administrative procedure for domain name dispute resolution at: arbiter.wipo.int/domains/. This WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name cases that have already been decided.

Can you license your trademark to other companies?

Trademarks can be licensed to other companies. In such cases, the trademark owner retains ownership and merely agrees to the

use of the trademark by one or more other companies. This is usually done on payment of royalties and involves the consent of the trademark owner, which is usually specified in a formal licensing agreement. Depending on the nature of the agreement, the licensor often retains some degree of control over the licensee to guarantee that a certain quality is maintained.

In practice, trademark licenses are frequently granted within broader licensing agreements, for example, franchising agreements or agreements including the licensing of other intellectual property rights such as patents, know-how and some degree of technical assistance for the production of a given product.

What does a franchising agreement have to do with trademarks?

The licensing of a trademark is central to a franchising agreement. In franchising agreements the degree of control of the trademark owner over the franchisee is generally greater than is the case for standard trademark

licensing agreements. In the case of franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trademarks, know-how, customer service, software, shop decoration, etc.) in accordance with a set of prescriptions and in exchange for compensation or royalty.

Example: A restaurant selling chicken meals operates under the trademark NANDO'S. It has developed a system for preparing and selling these products, which are sold in large volumes and in a uniform manner. The system includes various factors that contribute to the success of NANDO'S restaurants, including recipes and methods of preparing meals that result in a product of consistent quality, the design of employees' uniforms, the design of the buildings, the design of packaging, and management and accounting systems. NANDO'S imparts its knowledge and experience to its franchisees and retains the right to supervise and control local franchises. As a crucial component of the franchising agreement the franchisees will also be authorized

and obliged to use the NANDO'S trademark.



Courtesy: UAC of Nigeria Plc

Is there any restriction in selling or assigning the trademark of your company to another company?

It is increasingly possible to sell or assign a trademark independently from the business that currently owns it. In the case of sale or assignment of a trademark, it is required to pay for stamp duties and also an Assignment Fee to have the Assignment recorded in the Trademarks Register.

Do you need to register all small modifications to your trademark?

Many trademarks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of

a company or adapt to new advertising media. Marks may be changed or adapted, but your company will have to be careful and consult with the registry concerned or a competent trademark agent as to whether a specific change will require the submission of a new application and payment of relevant fees.



Shell Courtesy Shell Producing Nigeria



5. Enforcing Trademarks

What should your business do if its trademark is being used by others without authorization?

The burden of enforcing a trademark is mainly on the trademark owner. It is up to your company as a trademark owner to identify any infringement and to decide what measures should be taken to enforce trademark rights.

It is always useful to seek expert advice if you believe that someone is infringing your trademark. An intellectual property lawyer would be the right person to give you information on the existing options in Nigeria and, presumably, also in neighboring countries to initiate action against counterfeiting and infringement and will provide you with advice on how to enforce your rights.

If you are faced with infringement of your trademark rights, then you may choose to begin by sending a letter (commonly known as a “cease and desist letter”) to the alleged

infringer informing him/her of the possible existence of a conflict. In writing such a letter, the assistance of a trademark lawyer is recommended.

If your business considers the infringement to be willful and knows the location of the infringing activity, then it may wish to take surprise action by obtaining, with the help of a trademark lawyer, a search and seize order (usually, from a competent court or the police) to conduct a raid without prior notice to the allegedly offending company/person.

The infringer may be compelled by the judicial authorities to inform you of the identity of persons involved in the production and distribution of the infringing goods or services and their channels of distribution. As an effective deterrent to infringement, the judicial authorities may order, upon your request, that infringing goods and materials be destroyed or disposed of outside the channels of commerce without compensation of any sort.

In order to prevent the importation of counterfeit trademark goods, measures at the international border are available to trademark owners in many countries through the national customs authorities. As a trademark owner, your company may seek the assistance of the customs authorities at the border, that is, before the counterfeit goods have been distributed in the country concerned. The assistance of customs would generally require payment of prescribed fees, for which you will have to contact the relevant customs authorities.

In some instances, an effective way of dealing with infringement is through arbitration or mediation. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court proceedings, and an arbitral award is more easily enforceable internationally. An advantage of mediation is that the parties retain control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your company

may like to collaborate in the future. For more information on arbitration and mediation, see the website of the WIPO Arbitration and Mediation Center at: [/arbitrator.wipo.int/center/index.html](http://arbitrator.wipo.int/center/index.html).

Useful websites for further information:

On other intellectual property issues from a business perspective:

www.wipo.int/sme/

On trademarks generally:

- "About IP" at the WIPO website: www.wipo.int/about-ip/en/

- International Trademark Association: www.inta.org

On practical aspects relating to the registration of marks, see list of websites of national and regional trademark offices available in Annex I or www.wipo.int/news/en/links/ipo.

On the Madrid system for the International Registration of Marks:

www.wipo.int/madrid/en

For a list of on-line trademark databases maintained by industrial property offices throughout the world: ecommerce.wipo.int/databases/trademark/

On the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement: www.wipo.int/classifications/en/ (under Nice Agreement)

On the International Classification of the Figurative Elements of Marks under the Vienna Agreement: www.wipo.int/classifications/en (under Vienna Agreement)

On the conflict between trademarks and domain names: ecommerce.wipo.int/domains/
www.icann.org

On alternative dispute resolution procedures for domain names: arbiter.wipo.int/domains/

ANNEX I

Website Addresses of National and Regional Trademark Offices

Algeria	http://www.inapi.org
Andorra	http://www.omp.a.ad
Argentina	http://www.inpi.gov.ar/
ARIPO (African Regional Industrial Property Organization)	http://www.aripo.wipo.net/
Armenia	http://www.armpatent.org
Austria	http://www.patent.bmwa.gv.at/
Australia	http://www.ipaustralia.gov.au/
Barbados	http://www.caipo.gov.bb/
Belize	http://www.belipo.bz
Belgium	http://www.european-patent-office.org/patlib/country/belgium
Benelux (Benelux Trademarks Office - BTO)	http://www.bmb-bbm.org/
Bolivia	http://www.senapi.gov.bo
Bosnia and Herzegovina	http://www.bih.net.ba/-zsmp
Brazil	http://www.inpi.gov.br
Bulgaria	http://www.bpo.bg/
Canada	http://opic.gc.ca
China	http://www.sipo.gov.ch
China (Marks)	http://www.saic.gov.ch
China (Hong Kong -SAR)	http://www.info.gov.hk/ipd
Chile	http://www.proind.gov.cl
Colombia	http://www.sic.gov.co
Costa Rica	http://www.registronacional.go.cr
Croatia	http://pubwww.srce.hr/patent
Cuba	http://www.ocpi.cu
Czech Republic	http://www.upv.cz
Democratic People's Republic of Korea	http://www.epa.ee
Denmark	http://www.dkpto.dk/
Dominican Republic	http://www.seic.gov.do/onapi/
Egypt	http://www.egypo.gov.eg
Estonia	http://www.epa.ee
Eurasian Patent Office	http://www.eapo.org
Europe Union (Office for the Harmonization in the Internal Market - OHIM)	http://oami.eu.int/
Finland	http://www.prh.fi
France	http://www.inpi.fr
Georgia	http://www.sakpatenti.org.ge/
Germany	http://www.dpma.de
Greece	http://www.ggr.gr
Hungary	http://www.hpo.hu/
Iceland	http://www.els.stjr.is
India	http://www.tmrindia.com
Indonesia	http://www.dgip.go.id
Ireland	http://www.patentsoffice.ie
Israel	http://www.justice.gov.il/rasham+haptentin/default.asp
Italy	http://www.european-patent-office.org/it/

Japan	http://www.jpo.jp
Jordan	http://www.mit.gov.jo
Kazakhstan	http://www.kazpatent.kz - http://www.kazpatent.org
Kenya	http://www.kipo.ke.wipo.net
Kyrgyzstan	http://www.krygyzpatent.kg
Lao People's Democratic Republic	http://www.stea.la.wipo.net/index.html
Lithuania	http://www.vpb.lt/
Luxembourg	http://www.etat.lu/ec/
Macao	http://www.economia.gov.mo
Malaysia	http://kpdnhq.gov.my
Mexico	http://www.impi.gob.mx/
Monaco	http://www.european-patent-office.org/patlib/country/monaco/
Mongolia	http://www.mongol.net/ipom
Morocco	http://www.ompic.org.ma/
Netherlands	http://www.bie.minez.nl
Netherlands Antilles	http://bureau-intellectual-property.org/
Nepal	http://www.ip.np.wipo.net
New Zealand	http://www.iponz.govt.nz
Norway	http://www.patentstyret.no
Organisation Africaine de la Propriété Intellectuelle (OAPI)	http://www.oapi.wipo.net/
Panama	http://www.mici.gob.pa/comintf.html
Pakistan	http://www.ipo.gov.pk/
Peru	http://www.indecopi.gob.pe/
Philippines	http://www.ipophil.gov.ph/
Poland	http://www.uprp.pl/
Portugal	http://www.inpi.pt/
Republic of the Congo	http://www.anpi.cg.wipo.net
Republic of Korea	http://kipo.go.kr
Republic of Macedonia	http://www.ippo.gov.mk/
Republic of Moldova	http://www.agepi.md/
Romania	http://www.osim.ro
Russian Federation	http://www.rupto.ru
Serbia and Montenegro	http://yupat.sv.gov.yu
Singapore	http://www.ipos.gov.sg
Slovak Republic	http://www.indprop.gov.sk
Slovenia	http://www.uil-sipo.si/
Spain	http://www.oepm.es
Sri Lanka	http://www.nipo.lk/
Sweden	http://www.prv.se
Switzerland	http://www.ige.ch
Tajikistan	http://www.tipat.org
Thailand	http://www.ipthailand.org
Turkey	http://www.turkpatent.gov.tr
Ukraine	http://www.spou.kiev.ua
United Kingdom	http://www.patent.gov.uk
United States	http://www.uspto.gov
Uruguay	http://www.dnpi.gub.uy
Uzbekistan	http://www.patent.uz
Venezuela	http://www.sapi.gov.ve

<http://www.nipo.lk/>
<http://www.ipo.gov.pk/>

Annex II

International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement

Goods

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrice.
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5. Pharmaceutical and veterinary preparations; sanitary preparations for

medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.

7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

8. Hand tools and implements (hand-operated); cutlery; side arms; razors.

9. Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.

11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.

12. Vehicles; apparatus for locomotion by land, air or water.

13. Firearms; ammunition and projectiles; explosives; fireworks.

14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.

15. Musical instruments.

16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

21. Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

23. Yarns and threads, for textile use.

24. Textiles and textile goods, not included in other classes; bed and table cov-

ers.

25. Clothing, footwear, headgear.

26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles;
artificial flowers.

27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.

30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

32. Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

33. Alcoholic beverages (except beers).

34. Tobacco; smokers' articles; matches.

Services

35. Advertising; business management; business administration; office functions.

36. Insurance; financial affairs; monetary affairs; real estate affairs.

37. Building construction; repair; installation services.

38. Telecommunications.

39. Transport; packaging and storage of goods; travel arrangement.

40. Treatment of materials.

41. Education; providing of training; entertainment; sporting and cultural activities.

42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

43. Services for providing food and drink; temporary accommodation.

44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

45. Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals. In October 2003, 72 States were party to the Nice Agreement. They have adopted and apply the Nice Classification for the purposes of the registration of marks.

Annex III

Members of the Madrid Union (As of November, 2003)

Albania (A&P)	Egypt (A)
Algeria (A)	Estonia (P)
Antigua and Barbuda (P)	Finland (P)
Armenia (A&P)	France (A&P)
Australia (P)	Georgia (P)
Austria (A&P)	Germany (A&P)
Azerbaijan (A)	Greece (P)
Belarus (A&P1)	Hungary (A&P)
Belgium* (A&P)	Iceland (P)
Bhutan (A&P)	Ireland (P)
Bosnia and Herzegovina (A)	Italy (A&P)
Bulgaria (A&P)	Japan (P)
China (A&P)	Kazakhstan (A)
Croatia (A)	Kenya (A&P)
Cuba (A&P)	Kyrgyzstan (A)
Cyprus (A&P)	Latvia (A&P)
Czech Republic (A&P)	Lesotho (A&P)
Democratic People's Republic of Korea (A&P)	Liberia (A)
Denmark (P)	Liechtenstein (A&P)
	Lithuania (P)
	Luxembourg* (A&P)
	Monaco (A&P)
	Mongolia (A&P)
	Morocco (A&P)
	Mozambique (A&P)

Netherlands* (A&P)	United States of America (P)
Norway (P)	Uzbekistan (A)
Poland (A&P)	Viet Nam (A)
Portugal (A&P)	Yugoslavia (A&P)
Republic of Korea (P)	Zambia (P)
Republic of Moldova (A&P)	
Romania (A&P)	(A) indicates a party to the Agreement (54)
	(P) indicates a party to the Protocol (59)
Russian Federation (A&P)	
San Marino (A)	* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.
Sierra Leone (A&P)	
Singapore (P)	
Slovakia (A&P)	
Slovenia (A&P)	
Spain (A&P)	
Sudan (A)	
Swaziland (A&P)	
Sweden (P)	
Switzerland (A&P)	
Tajikistan (A)	
The former Yugoslav	
Republic of Macedonia (A&P)	
Turkey (P)	
Turkmenistan (P)	
Ukraine (A&P)	
United Kingdom (P)	

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