



An Overview of the Concept of Defensive Trade Mark Registration in Nigeria

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A defensive trademark is an important trade mark protection strategy that can be employed by proprietors of well-known trade marks in Nigeria to protect their legal rights beyond the protections offered by traditional trade marks in a particular class.

Under section 5 of the Nigerian Trade Marks Act, the rule is that the Proprietor of a trade mark has a right over the registered trade mark or any other similar mark with respect to the specific goods or class of goods for which the trade mark was registered. There has, however, been an additional recognition of the need to protect well-known trade marks where they are used in dissimilar products or services in order to avoid the dilution of the trade mark. The Trade Marks Act in section 32 permits a Proprietor to apply for the defensive registration of its well-known trade marks. It provides thus:

“Where a trade mark consisting of an invented word or invented words has, as respects any goods in respect of which it is registered and in relation to which it has been used (in this subsection referred to as the familiar goods), become so well known that its use in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the familiar goods, the trade mark may, on the application in the prescribed manner of the proprietor

registered in respect of the familiar goods, be registered in his name in respect of those other goods as defensive trade mark, notwithstanding that the proprietor registered in respect of the familiar goods does not use or propose to use the trade mark in relation to those other goods, and notwithstanding anything in section 31 of this Act, and while so registered, the trade mark shall not be liable to be taken off the register in respect of those goods under section 31 of this Act.”

It is important to note that even where there is no use or proposed use of the trade mark in respect of those other goods or description of goods for which it was defensively registered, the defensive registration remains valid and cannot be cancelled on the grounds of non-use. This is an exception to the rule of use and non-use in section 31 of the Trademarks Act.

The basis of registration is to prevent the exploitation of the goodwill and value associated with a trade mark by third parties in another class who wish to profit from goodwill and well-known status of the proprietor and which may ultimately lead to trade mark dilution.

It protects a trade mark proprietor against third-party applicants and dispenses with rigorous trade mark opposition and litigation that may arise from trade mark infringement as the Trade Marks Registry will refuse an infringing trade mark application based on the existence of a defensive trade mark even though the trade mark is not being used in that class. It also serves to protect the distinctive character of the trade mark and prohibit persons who intend to take advantage of the absence of registration of the trademark for unrelated goods or services.

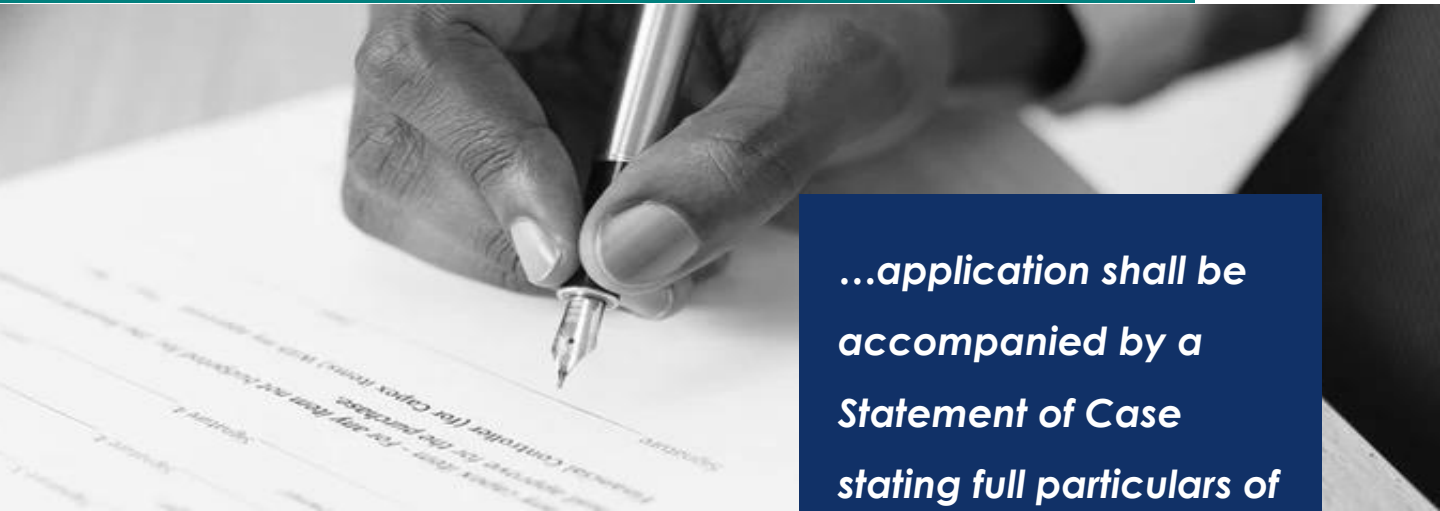


Advantages of registering a Defensive Trade Mark

Some of the advantages of registering a defensive trade mark are stated below:

- a. It ensures maximum protection of the trade mark for the proprietor of the mark as it prevents trade mark dilution and other associated risks.
- b. It ensures that there is no consumer confusion in the market.
- c. It ensures that the trade mark is not exploited by third-parties or potential competitors.
- d. The successful registration of a mark as a defensive mark, is an affirmation of the fact that the trade mark is well-known and this might be useful in any litigation matter in Nigeria given that Nigeria does not have a Register for well-known trade marks; and may be persuasive when used in other jurisdiction.
- e. The Registrar of Trade Marks is under obligation to refuse third party applications to register a trade mark similar to a defensive trade mark for the goods and services covered thereby preventing lengthy and financially draining oppositions or rectification actions.
- f. Defensive Trade mark registration is an exception to the doctrine of non-use under the Trade Marks Act. It is not subject to removal or cancellation on the grounds of non-use; the Proprietor is also not required to use the defensive trade mark at the time of filing.
- g. The registration can be relied upon in alleging trademark infringement and may be afforded wider protection given its well-known status. See the case of *Proctor and Gamble v. Global Soap & Detergent Industries Ltd & Ors* (2012) LPELR - 8014 (CA) on the protections offered to well-known trade marks in Nigeria
- h. Enforcing a defensive trade mark is more reliable and cost effective as compared to infringement or passing off actions.

Procedure for Registering Defensive Trade Marks in Nigeria



...application shall be accompanied by a Statement of Case stating full particulars of the facts relied upon by the Applicant in support of his application...



According to Regulation 39 of the Trade Marks Regulation, an application for the registration of a defensive trade mark under section 32 of the Act shall be made, addressed and sent to the Registrar of Trade

This application shall be accompanied by a Statement of Case stating full particulars of the facts relied upon by the Applicant in support of his application. The application is also required to be accompanied by a verifying Statutory Declaration made by the Applicant or some other person approved for the purpose by the Registrar.

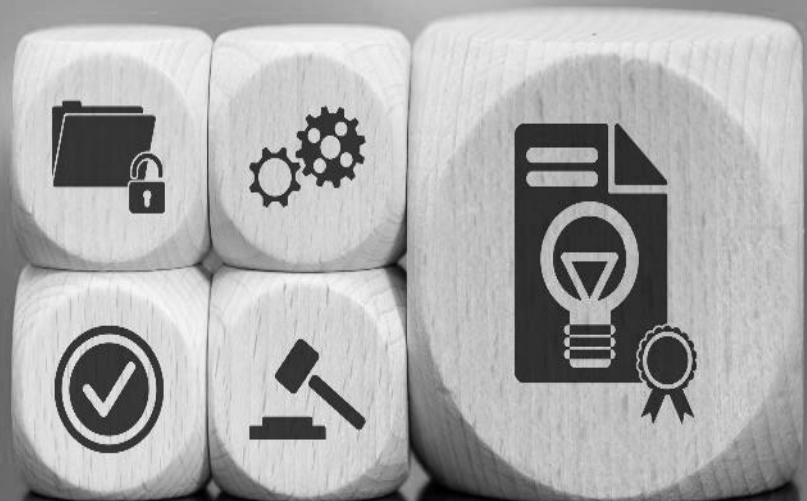
The Applicant is further required to furnish such other evidence showcasing that it is a well-known trade mark as he may desire. The Registrar shall in turn consider the whole of the evidence before deciding on the application.

Once the Application is examined and accepted, then it proceeds to publication and after the two months opposition window under the Trade Marks Act, it will proceed to registration.

Conclusion

Registration of defensive trade marks creates a defensive perimeter around a registered trade mark and although, well-known marks are not expressly protected in Nigeria within the context of Article 6 bis of the Paris Convention, the registration of well-known invented words as a defensive trade mark gives well known-marks wider protections as envisaged Article 6 bis of the Paris Convention.

Indeed, it is recommended that all well-known brands register their trade marks as defensive trade marks in Nigeria (including a registration in the principal class) as this also prevent trade mark trolls from registering such trade marks in other





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