

REGISTRATION OF TRADEMARKS IN NIGERIA - THE PROBLEM OF CLASSIFICATION

Trademark registration in Nigeria has maintained a steady increase over the years. With increased awareness in the local market and the dominant position of Nigeria in the African market, the registration of marks has become a top priority for many an investor. However, a major challenge in the registration of marks is the classification of such mark for registration purposes. Three major parameters for classification may be identified under Nigerian trademarks law - viz: Parts A and B, Third and Fourth Schedule classifications and classification within the schedules.;

The Parts A & B Dichotomy

An applicant for a trademark must determine from the start whether his application should be brought under Part A or Part B of the register. The distinction between these two parts is not clear-cut. The provisions of Sections 9 and 10 of the Trademarks Act attempt to distinguish between marks registerable in Part A and those registerable in Part B. Section 9(1) of the Act provides as follows:

“In order for a trademark (other than a classification trademark) to be registerable in Part A of the register it must contain or consist of at least one of the following essential particulars:

- a) *the name of a company, individual, or firm, represented in a special or particular manner;*
- b) *the signature of the applicant for registration or some predecessor in his business;*
- c) *an invented word or inverted words;*
- d) *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 a surname;*
- e) *any other distinctive mark.*

Provided that a name, signature or word or words other than such as fall within paragraphs A-D of this section, shall not be registrable under paragraph E of this section, except upon evidence of its distinctiveness.

The term ‘distinctiveness’ as used in the above provision is defined by Section 9(2) of the Act to mean “adapted, in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or where the trademark is registered or proposed to be registered subject to limitations, in relation to use within the extent of registration”.

It is not in doubt therefore that the purpose of this section is to ensure that only marks which are distinct in themselves are registrable under Part A of the Act. However, in a bid to create a less onerous criterion for qualifying registrable marks, Section 10 of the Act provides as follows:

“In order for a mark to be registrable in Part B of the register, it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists”

The question however is - what in reality is the difference between Part A and Part B? What nature of mark is contemplated by the provision of Section 10? The difficulty here is that once a mark is capable of distinguishing goods of the proprietor from all other goods, then that mark is distinctive and therefore capable of being registered in Part A of the register.

It was a welcome development therefore when the law reform commission in Nigeria expressed its difficulty in appreciating the distinction when it stated:

“We were unable to trace any Nigerian decision on the precise implications of the sections (sections 9 & 10) but believe that our courts would experience the same difficulties as the English courts in attempting to interpret each section viz-a-viz the other”.

While this provision was adapted from English statute law, the English Trademarks Act of 1994 has dispensed with this dichotomy. Thus, under the English Act of 1994, a mark is registrable once it is capable of distinguishing the goods or services in the market place.

It is our view that the provisions relating to the classification into Parts A and B of the register are anachronistic and should be dispensed with.

The Third and Fourth Schedule Dichotomy

Besides determining whether the application should be brought under Part A or Part B of the register the application must also determine in what schedule the application is to be brought. Prior to 1st June 1967 classification of marks was done in accordance with the third schedule to the Act. Under the schedule there are 50 (fifty) classes into which goods are classified. However, a new format of classification was introduced with the promulgation of the Act in 1967.

The choice of which format of classification is to be utilized by an applicant is settled by Regulation 5 of the Trademarks Regulations. According to that provision, for registrations dated prior to the commencement of the Act and of registrations of registered users there under, goods are to be classified in the manner appearing in the Third Schedule. But for registrations dated thereafter, classification is done in accordance with the Fourth Schedule.

However, under the provisions of Regulation 6, a mark that was classified under the Third Schedule may, by application to the Registrar, be re-classified under the Fourth Schedule. A re-classified mark retains its original date of registration. However, this procedure may involve the striking out of some of the goods to which it originally relates so as to bring it in tune with the goods classified under the Fourth Schedule.

Classification Within The Fourth Schedule

For practical purposes, modern day applications no longer have recourse to the classification of marks under the Third Schedule. Thus an applicant must consider the provisions of the Fourth Schedule to determine the specific class under which the application may be brought.

There are 34 (thirty-four) different classes under this schedule and there is no exclusivity in the registration of marks in these classes. Thus, a single mark may be registered in as many classes as there are goods for which the mark is, or is intended to be, associated. Every registration in any class, however, constitutes a distinct application.

Conclusion

The problem of classification is real and a daunting task even for seasoned practitioners of Intellectual Property Law. However, as has been shown above, the classification into Parts A and B is of little relevance and its abandonment is long overdue. Pending the passing of the proposed Intellectual Property Law, it is a problem that Nigerian practitioners have to contend with. It is also of particular relevance to non-Nigerian practitioners whose international practice necessitates their contact with the Nigerian Trade Marks Law and practice. Less difficulty is encountered with regard to the classification as between the third and fourth schedules and as between goods within the Fourth Schedule, which, thankfully, are more straightforward.