

SB/80

A
BILL
FOR

AN ACT to repeal the Trade Marks Act Cap T13 Laws of the Federation of Nigeria 2004 and enact the Trade Marks 2019 to provide for a comprehensive law relating to trademarks and related matters, 2019.

Senator

[] Commencement

ENACTED by the National Assembly of the Federal Republic of Nigeria as follows:
PART I

Citation

1: This Act may be cited as the Trade Marks Act, 2019

Interpretations

2. (1) In this Act, unless the context otherwise requires—

“business” includes a trade or profession;

“business identifier” means any sign capable of being represented graphically which is used to identify any business;

“certification mark” has the meaning assigned to it in section 73(2);

“collective mark” has the meaning assigned to it in section 64(2);

“Convention country” means—

(a) a country or territory, other than Nigeria, which is a—

(i) party to the Paris Convention; or

(ii) member of the World Trade Organization; and

(b) in any other provision of this Act, a country or territory which is a—

(i) party to the Paris Convention; or

(ii) member of the World Trade Organization;

“counterfeit goods” and “counterfeit trade mark” have the meanings assigned to them in section 35;

“Court” means the High Court;

“dilution” in relation to a trade mark, means the lessening of the capacity of the trademark to identify and distinguish goods or services, regardless of whether there is any—

(a) competition between the proprietor of the trade mark and any other party; or

(b) likelihood of confusion on the part of the public;

“earlier trade mark” means—

(a) a registered trade mark or an international trade mark

(Nigeria), the application for registration of which was made earlier than the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trademarks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or, where appropriate, of the priority claimed in respect of the application, was a well-known trade mark, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph

(a) subject to its being so registered;

“exclusive licence” means a licence, whether general or limited, authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence, and the expression “exclusive licensee” shall be construed accordingly;

"infringement proceedings" means proceedings relating to the infringement of a registered trademark; "infringing goods, materials or articles" has the meaning assigned to it in section 35;

"Intellectual Property Office" has the meaning assigned to it in section 2 of the Patents Act; "International Classification" means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as may be revised from time to time;

"Minister" means the Minister with responsibility for Trade and Investment;

"Officer" has the meaning assigned under section 2 of the Customs Act;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as may be revised from time to time;

"prescribed" means prescribed by the Regulations;

"priority date" means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

"proprietor" means—

(a) in relation to a registered trade mark, the person in whose name the trade mark is registered; or

(b) in relation to an unregistered trade mark that is a well-known trade mark, the person to whom the trade mark belongs;

"Register" means the Register referred to in section 83;

"Regulations" means Regulations made under section 123;

"sign" includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof; "trade" includes any business or profession;

"trade mark" means, except in relation to a certification trade mark, any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person, from goods or services so dealt with or provided by any other person; "trade name" means the name or designation identifying and distinguishing an enterprise or its goodwill;

"TRIPS Agreement" means the Agreement on Trade Related Aspects of Intellectual Property Rights, set out in Annex 1C to the WTO Agreement, as revised or amended from time to time; "well-known trade mark" means—

(a) any registered trade mark that is well known in Nigeria; or

(b) any unregistered trade mark that is well known in Nigeria and that belongs to a person who is—

(i) a national of a Convention country; or

(ii) domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in Nigeria

"WTO" means the World Trade Organization;

"WTO Agreement" means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

(2) References in this Act to a trade mark include any trade mark which relates to a service that is ancillary to goods or services dealt with or provided in the course of trade by a person, whether or not the service is provided for money or money's worth.

(3) References in this Act to a trade mark include, unless the context otherwise requires, a collective mark or a certification mark.

(4) References in this Act to use, or any particular description of use, of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use, or that description of use, otherwise than by means of a graphic representation.

(5) References in this Act to registration are, unless the context otherwise requires, to registration in the Register.

(6) In this Act, a sign is taken to be applied to goods, material or any other thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing.

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Nigeria, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to, or recognised by any relevant sector of the public in Nigeria;

(b) the duration, extent and geographical area of any—

(i) use of the trade mark; or

(ii) promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;

(c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;

(d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory; and

(e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Nigeria, the trade mark shall be deemed to be well known in Nigeria.

(9) In subsections (7) and (8), "relevant sector of the public in Nigeria" includes any of the following:

(a) all actual consumers and potential consumers in Nigeria of the goods or services to which the trade mark is applied;

(b) all persons in Nigeria involved in the distribution of the goods or services to which the trade mark is applied; and

(c) all businesses and companies in Nigeria dealing in the goods or services to which the trade mark is applied.

PART II

REGISTRATION OF TRADE MARKS

4. A registered trade mark is a property right obtained by the registration of a trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.

Application for Registration of a Trade Mark

5. (1) An application for registration of a trade mark shall be made in the prescribed manner to the Controller

(2) An application under subsection (1) shall—

(a) contain a request for the registration of a trade mark;

(b) state the name and address of the applicant;

(c) contain a clear representation of the trade mark;

(d) list the goods or services in relation to which the applicant seeks to register the trade mark; and

(e) state—

(i) that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services; or

(ii) that the applicant has a *bona fide* intention that the trade mark should be so used.

(3) An application under subsection (1) shall be accompanied by such fees as may be prescribed.

(4) The date of an application under subsection (1) shall be the earliest date on which—

- (a) all the requirements under subsection (2) have been satisfied; and
- (b) all the fees payable under subsection (3) — expressed or worked into, or arrived or annexed to the —
- (i) have been paid; or
- (ii) are treated by the Controller as paid.

Division of application for registration

6. (1) Subject to subsection (2) and the Regulations, an application under section 5 may, at the request of the applicant, be divided into two or more separate applications.

- (2) A request under subsection (1) shall be —
- (a) made to the Controller —
- (i) in the prescribed manner; and
- (ii) before the trade mark is registered; and
- (b) accompanied by the prescribed fee.

Classification of goods and services

7. (1) Goods and services shall be classified for the purposes of the registration of trademarks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Controller, whose decision shall be final.

Grounds for Refusal of Registration

8. (1) Subject to subsection (2), the following shall not be registered:

- (a) a sign which does not satisfy the definition of a trade mark in section 3;
- (b) a trade mark which is devoid of any distinctive character;
- (c) a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; or

(d) a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of —

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) A trade mark shall not be registered if it is —

- (a) contrary to public policy or to morality; or
- (b) of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services.

(5) A trade mark shall not be registered if, or to the extent that, its use is prohibited in Nigeria by any written law.

(6) A trade mark shall not be registered if, or to the extent that, the application is made in bad faith.

(7) Notwithstanding subsection (2), a trade mark shall not be registered if it contains or consists of a geographical indication and the trade mark is used or intended to be used in relation to goods or services not originating from the place indicated in the geographical indication.

(8) Subsection (7) shall apply —

- (a) whether or not the trade mark has, or is accompanied by —
- (i) an indication of the true geographical origin of the goods or services, as the case may be; or

(ii) an expression such as "kind", "type", "style", "imitation" or the like; and (b) all the fees payable under subsection (7) (b) irrespective of the language in which the geographical indication is expressed in the trade mark.

(9) A trade mark shall not be refused registration by virtue of subsection (7) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration, or its predecessor, in title, either—

- (a) before the commencement of this Act; or
- (b) before the geographical indication in question is protected in its country of origin.

(10) A trade mark shall not be refused registration by virtue of subsection (7) if the geographical indication in question has—

- (a) ceased to be protected; or
- (b) fallen into disuse, in its country of origin.

(11) A trade mark shall not be registered in the cases specified in sections 60 and 61.

Relative grounds for refusal of registration

9. (1) A trade mark shall not be registered if it is identical to an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical to the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if there exists a likelihood of confusion on the part of the public because the trade mark is—

- (a) identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
- (b) similar to an earlier trade mark and is to be registered for goods or services identical to, or similar to those for which the earlier trade mark is protected.

(3) Where an application for registration of a trade mark is made and the trade mark is—

- (a) identical to, or similar to an earlier trade mark; and
- (b) to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, the trade mark shall not be registered if—

(c) the earlier trade mark is well-known in Nigeria and—

- (i) use of the trade mark in relation to the goods or services for which the trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
- (ii) there exists a likelihood of confusion on the part of the public because of such use; and
- (iii) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use; or

(d) the earlier trade mark is well-known in Nigeria and would—

- (i) cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (ii) take unfair advantage of the distinctive character of the earlier trade mark.

(4) A trade mark shall not be refused registration by virtue of subsection (3) if the application for the registration of the trade mark was filed before the earlier trade mark became well-known in Nigeria, unless it is shown that the application was made in bad faith.

(5) In deciding whether any such application was made in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier trade mark.

(6) A trade mark shall not be registered if, or to the extent that, its use in Nigeria is liable to be prevented by virtue of—

- (a) any rule of law, in particular the law of passing off, protecting an unregistered trade mark or other sign used in the course of trade; or

(b) an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of design.

(7) A person entitled under subsection (6) to prevent the registration of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(8) Notwithstanding subsections (1) to (4), the Controller shall register a trade mark where the proprietor of the earlier trade mark, or of an earlier right in relation to the trade mark, consents to the registration.

(9) The Controller may, in his discretion, register any trade mark referred to in subsection (3) or (6) where the proprietor of the earlier trade mark or other earlier right fails to give to the Controller notice of opposition to the registration in accordance with section 14.

(10) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of "earlier trade mark" in section 3 and whose registration expires, shall continue to be taken into account in determining the registrability of a trade mark for a period of one year after its expiration, unless the Controller is satisfied that there was no *bona fide* use of the trade mark during the two years immediately preceding the expiration.

(11) Where separate applications are made by different persons to be registered as proprietors respectively of trademarks that are identical or nearly resemble each other in respect of the same, similar or related goods or services or description of goods or services, the Controller may refuse to register any of them until their rights have been determined by the Court.

Raising of relative grounds in case of honest concurrent use

10. (1) Where, on an application for the registration of a trade mark, it appears to the Controller—

(a) that there is an earlier trade mark in relation to which the conditions set out in section 9(1), (2) or (3) apply; or

(b) that there is an earlier right in relation to which the conditions set out in section 9(6) is satisfied, but the applicant shows to the satisfaction of the Controller that there has been honest concurrent use in the course of trade in Nigeria of the trade mark for which registration is sought, the Controller shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect the—

(a) refusal of registration on the grounds mentioned in section 8; or

(b) making of an application for a declaration of invalidity under section 24(3).

Claim of priority

11. (1) Subject to subsection (6), where—

(a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;

(b) the application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (referred to in this section as "the first Convention application"); and

(c) within six months after the date on which the first Convention application is filed, the person or his successor in title applies under this Act for the registration of the trade mark in respect of all or any of those goods or services, the person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark in Nigeria shall not be affected by any use of the trade mark in Nigeria in the period between—

(a) the date on which the first Convention application was filed; and

(b) the date on which the application under this Act was filed.

(4) Any filing which in a Convention country is equivalent to a regular national filing under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) For the purposes of subsection (4), "regular national filing" means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the subsequent result of the application. (6) Where a subsequent application concerning the same subject as an earlier Convention application is filed in the same or a different Convention country, and these are the first two applications concerning that subject to be filed in any Convention country, and—

(a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) the earlier application has not yet served as a basis for claiming a right of priority, the date on which the subsequent application was filed, rather than the date of the earlier application, shall be considered the starting date of the period of priority under subsection (2), and the earlier application shall not thereafter serve as a basis for claiming priority.

(7) A right of priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in Subsection (1) to the applicant's successor in title shall be construed accordingly.

Claim to priority from other relevant overseas application

12. (1) The Minister may, on the advice of the Controller, by Order, confer on a person who has filed an application for the registration of a trade mark in a country or territory with which the State has entered into a treaty, convention, arrangement, or engagement for the reciprocal protection of trademarks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(2) An Order under this section may make provisions corresponding to those set out in section 11 or such other provisions as appear to the Minister to be appropriate.

(3) An Order made under this section shall be subject to negative resolution of the National Assembly

Examination of application

13. (1) The Controller shall examine whether an application for registration of a trade mark satisfies the requirements of this Act.

(2) For the purpose of subsection (1), the Controller shall, to such extent as he considers necessary, carry out a search of earlier trademarks.

(3) If it appears to the Controller that the requirements for registration are not met or that additional information or evidence is required to meet applicant and give him an opportunity, within such those requirements, the Controller shall inform the period as may be prescribed, to make representations, to amend the application or to furnish additional information or evidence.

(4) If the applicant responds within the period referred to in subsection (3) but fails to satisfy the Controller that those requirements are met, or to amend the application or furnish additional information or evidence so as to meet them, the Controller may refuse to accept the application.

(5) If the applicant fails to respond within the period referred to in subsection (3), the application shall be treated as withdrawn.

(6) If it appears to the Controller that the requirements for registration are met, the Controller shall accept the application.

(7) Where the application is treated as withdrawn under subsection (5), the Controller may reinstate the application in such manner and in such conditions as may be prescribed.

Publication and opposition proceedings

14. (1) Where the Controller accepts an application under section 13, he shall cause the application, as accepted, to be published in the prescribed manner.

(2) A person may, within the prescribed time from the date of the publication of the application, give notice to the Controller of opposition to the registration.

(3) A notice under subsection (2) shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition and such other matter as may be prescribed.

(4) Where an application has been published, any person may, at any time before the registration of the mark, make observations in writing to the Controller as to whether the mark should be registered and the Controller shall inform the applicant of any such observations.

(5) A person who makes observations does not thereby become a party to any proceedings in relation to the application.

Withdrawal, restriction or amendment of restriction

15. (1) An applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If an application has been published, the withdrawal or restriction shall also be published.

(3) Subject to subsection (1), an application may only be amended at the request of the applicant, by correcting—

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes, where the correction does not substantially affect the identity of the mark or extend the goods or services covered by the application.

Registration of trade mark

16. (1) Where an application has been accepted and—

(a) no notice of opposition is given within the period referred to in section 14(2); or

(b) all opposition proceedings are withdrawn or decided in favour of the applicant, the Controller shall register the trade mark.

(2) A trade mark, when registered, shall be registered as of the date of the application for registration, and that date is deemed, for the purposes of this Act, to be the date of registration.

(3) On the registration of a trade mark, the Controller shall issue to the applicant a certificate of registration.

Revocation of acceptance

17. (1) Notwithstanding section 16(1) if, before a trade mark is registered, the Controller is satisfied—

(a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or

(b) that, in the special circumstances of the case, the trade mark should not be registered, the Controller may revoke the acceptance of the application.

(2) If the Controller revokes the acceptance of an application—

(a) the application shall be taken to have never been accepted; and

(b) section 13 shall apply in relation to the application.

Registration of Series of Trade Marks

18. (1) A person may make a single application under section 5 for the registration of a series of trade marks in respect of the same goods or services, or of similar goods or services which fall within a single class in accordance with the system of classification referred to in section 7.

(2) For the purposes of this Act, "series of trademarks" means a number of trademarks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act, the Controller shall register the trademarks as a series in one registration.

Duration, Renewal and Alteration of Registered Trade Mark

19. (1) A trade mark shall be registered for a period of ten years from the date of registration.

(2) Registration may be renewed in accordance with section 20 for further periods of ten years.

Renewal of Registration

20. (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the fee referred to in subsection (3) or the fees referred to in subsection (4), as the case may be.

(2) A request for renewal shall be made not later than six months after the date of expiration of the registration.

(3) Where the request for renewal is made on or before the date of expiration of the registration, the fee payable shall be the prescribed renewal fee.

(4) Where the request for renewal is made within the period of six months after the date of expiration of the registration, the fees payable shall be the prescribed renewal fee and the prescribed late renewal fee.

(5) Renewal shall take effect from the expiration of the previous registration.

(6) If the registration is not renewed in accordance with this section and the Regulations, the Controller shall remove the trade mark from the Register.

(7) Upon the filing of a renewal application, if the goods in respect of such application to be renewed were classified under the National Classification, the renewal application shall be accompanied by an amendment to reclassify the goods from the National classification to the International Classification.

Alteration of Registered Trade Mark

21. (1) Subject to subsection (2), a registered trade mark shall not be altered in the Register, either during the period of registration or on renewal.

(2) The Controller may, at the request of the proprietor, allow the alteration of a registered trade mark where the trade mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the trade mark.

Cancellation, Revocation of Trade Mark

22. A registered trade mark may be cancelled by the proprietor in respect of some or all of the goods or services for which it is registered.

Revocation of registration

23. (1) The registration of a trade mark may be revoked on any of the following grounds:

(a) that, within the period of five years following the date of completion of the registration procedure, it has not been put to *bona fide* use in the course of trade in

- Nigeria, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that its use has been suspended for a continuous period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered; or
- (d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is likely to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (2) For the purposes of subsection (1)—
- (a) "use of a trade mark" includes use in a form differing in elements which do not alter the distinctive character of the trade mark in the form in which it was registered; and
- (b) "use of a trade mark in Nigeria" includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Nigeria solely for export purposes.
- (3) The registration of a trade mark shall not be revoked on the grounds mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiration of the five-year period and prior to the application for revocation.
- (4) Any commencement or resumption of use referred to in subsection (3) after the expiration of the five-year period but within the period of three months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application may be made.
- (5) An application for revocation may be made by any person to the Controller or to the Court, except that—
- (a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; or
- (b) if, in any circumstances other than those referred to in paragraph (a), the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.
- (6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.
- (7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor are deemed to have ceased to that extent from—
- (a) the date of the application for revocation; or
- (b) an earlier date, if the Controller or the Court is satisfied that the grounds for revocation existed at an earlier date.

Grounds for Invalidity of registration

24. (1) The registration of a trade mark may be declared invalid on the grounds that the trade mark was registered in breach of section 8.
- (2) Where the registered trade mark was registered in breach of section 8 in that it is a trade mark referred to in subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered.
- (3) The registration of a trade mark may be declared invalid on the ground—
- (a) that there is an earlier trade mark in relation to which the conditions set out in section 9(1), (2) or (3) apply; or
- (b) that there is an earlier right in relation to which the condition set out in section 9(6) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(4) The registration of a trade mark may be declared invalid on the ground of fraud in the registration or on the ground that the registration was obtained by misrepresentation.

(5) An application for a declaration of invalidity may be made by any person to the Controller or to the Court, except that—

(a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; or

(b) if, in any circumstances other than those referred to in paragraph (a), the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

(6) An application for a declaration of invalidity of the registration of a trade mark on the ground that it was in breach of section 8(7) shall not be made after the expiration of five years from—

(a) the date of registration of the trade mark; or

(b) the date on which use of the trade mark by the person who applied for its registration or his predecessor in title became generally known in Nigeria, whichever is the earlier, unless the applicant shows to the satisfaction of the Controller or the Court that the registration of the trade mark was applied for in bad faith.

(7) An application for a declaration of invalidity of the registration of a trade mark on the ground that there is an earlier trade mark in relation to which the conditions set out in section 9(3) apply—

(a) shall not be made after the expiration of five years from the commencement of this Act or the date of completion of the registration procedure, whichever is the later, unless the applicant for the declaration shows that—

(i) the registration of the later trade mark was applied for in bad faith; or

(ii) the later trade mark was never used; and

(b) shall not be granted, if the registration of the later trade mark was applied for before the earlier trade mark became well-known in Nigeria, unless the applicant for the declaration shows that the registration of the later trade mark was applied for in bad faith.

(8) In deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark.

(9) Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(10) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

(11) Subsection (10) shall not affect transactions past and closed.

(12) The use of a trade mark by the proprietor in a form differing in elements which do not alter the distinctive character of the trade mark in the form in which it was registered in Nigeria shall not entail invalidation of the registration and shall not diminish the protection granted to the trade mark.

Effects of acquiescence

25. (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use in the course of trade or a registered trade in Nigeria being aware of that use, there shall cease to be any entitlement, on the basis of that earlier trade mark or other right—

(a) to apply for a declaration that the registration of the later trade mark is invalid; or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been used, unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

(3) For the purposes of subsection (1), in deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark or the right.

Amendments of other documents

26. (1) At the written request of a person or an agent of a person, who has—

(a) made an application, other than an application for the registration of a trade mark; or
(b) filed a notice or other document for the purposes of this Act, the Controller may amend the application, notice or document in accordance with subsection (2).

(2) The Controller may amend an application, notice or document under subsection (1)—

(a) to correct a clerical error or an obvious mistake; or
(b) if the Controller is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

Rights and Remedies of Proprietor of Registered Trade Mark

27. (1) The proprietor of a registered trade mark has the exclusive rights to—

(a) use the trade mark; and
(b) authorise other persons to use the trade mark, in relation to the goods or services for which the trade mark is registered.

(2) The proprietor has the right to obtain relief under this Act for infringement of his trade mark.

(3) The acts amounting to infringement of a registered trade mark are set out in section 28, and references in this Act to the infringement of a registered trade mark shall be construed accordingly.

(4) The rights under subsections (1) and (2) shall accrue to the proprietor as from the date of registration of the trade mark, except that—

(a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and

(b) no offence under section 49, 50, 51 or 52 is committed by anything done before the date on which the trade mark is in fact registered.

(5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.

Acts constituting Infringement of a registered Trade Mark

28. (1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade, a sign which is identical to the trade mark in relation to goods or services which are identical to those for which it is registered.

(2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which—

(a) is identical to the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or

(b) is similar to the trade mark and is used in relation to goods or services identical to or similar to those for which the trade mark is registered, and if, as a result of such use of the sign, there exists a likelihood of confusion on the part of the public.

(3) A person infringes a registered trade mark which is well-known in Nigeria if—

(a) without the consent of the proprietor of the trade mark, he uses in the course of trade, a sign which is identical to, or similar to the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered;

- (b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor;
- (c) there exists a likelihood of confusion on the part of the public because of such use; and
- (d) the interests of the proprietor are likely to be damaged by such use.

(4) For the purposes of this section and sections 29, 30 and 32, a person uses a sign if, in particular, he—

- (a) applies it to goods or the packaging thereof;
- (b) offers or exposes goods under the sign for sale;
- (c) puts goods on the market under the sign;
- (d) stocks them under the sign for the purpose of offering or exposing them for sale or putting them on the market;
- (e) offers or supplies services under the sign;
- (f) imports or exports goods under the sign;
- (g) uses the sign on an invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
- (h) uses the sign in advertising.

(5) Notwithstanding subsection (4), a person who—

- (a) applies a sign to any material used or intended to be used for labelling or packaging goods; or
- (b) uses a sign on any document described in subsection (4)(g), or in advertising, is deemed not to use the sign if, at the time of such application or use, he does not know, or does not have reason to believe, that the proprietor or a licensee of the registered trade mark did not consent to such application or use of the sign.

(6) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as any document described in subsection (4)(g), or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.

Acts not constituting infringement

29. (1) notwithstanding section 28, a person does not infringe a registered trade mark where—

- (a) he uses—
 - (i) his name or the name of his place of business; or
 - (ii) the name of his predecessor in business or the name of his predecessor's place of business;
- (b) he uses a sign to indicate—
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or
 - (c) he uses the trade mark to indicate the intended purpose of goods, in particular as accessories or spare parts, or services, and such use is in accordance with honest practices in industrial or commercial matters.

(2) Notwithstanding section 28, a person does not infringe a registered trade mark by using an unregistered trade mark that is identical to, or similar to the registered trade mark in relation to goods or services identical to, or similar to those for which the trade mark is registered if he, or he and his predecessor in title, have continuously used in the course of trade the unregistered trade mark in relation to those goods or services from a time before—

- (a) the date of registration of the registered trade mark; or
- (b) the date the proprietor of the registered trade mark, or a predecessor in title, or a person who was a registered user of the trade mark under the former Act, first used the trade mark, whichever is the earlier.

- (3) Notwithstanding section 28, a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.
- (4) Notwithstanding section 28, a person who uses a registered trade mark does not infringe the trade mark if such use—
- (a) constitutes fair use in comparative commercial advertising or promotion;
 - (b) is for a non-commercial purpose; or
 - (c) is for the purpose of news reporting or news commentary.

Exhaustion of rights conferred by registered trade marks

30. (1) notwithstanding section 28, a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market, whether in Nigeria or outside Nigeria, under that trade mark by the proprietor of the registered trade mark or with his express or implied consent, conditional or otherwise.

(2) Subsection (1) does not apply where—

- (a) the condition of the goods has been changed or impaired after they have been put on the market; and
- (b) the use of the registered trade mark in relation to those goods has caused dilution in an unfair manner of the distinctive character of the registered trade mark.

Registration subject to disclaimer or limitation

31. (1) An applicant for registration of a trade mark, or the proprietor of the registered trade mark, may—

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation, and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 27 are restricted accordingly.

Infringement Proceedings

Action for infringement

32. (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In infringement proceedings, all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of any other property right.

Order for erasure of offending sign

33. (1) Subject to subsection (3), where a person is found to have infringed a registered trade mark, the Court may make an order requiring him—

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears to the Court likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered up to such person as the Court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

(3) Where a person who is found to have infringed a registered trade mark has in his possession, custody or control any infringing goods, the Court shall order that the infringing goods be delivered up to such person as the Court may direct for destruction if the—

- (a) claimant applies to the Court for such an order; and

(b) Court is of the view that there are no exceptional circumstances which justify the refusal of such an order.

registered trade mark in relation to goods or services in which
(4) Notwithstanding section 23, a person who uses a registered

Order for delivery up of infringing goods, materials or articles

34. (1) The Court may, in addition to any relief granted under sections 32 and 33 in any action for an infringement of a registered trade mark, order any infringing goods, material or articles in the possession of the defendant or before the Court to be delivered up to the claimant.

(2) No order shall be made under this section unless the Court also makes, or it appears to the Court that there are grounds for making, an order under section 36.

(3) A person to whom any infringing goods, material or articles are delivered up pursuant to an order under this section shall, if an order under section 36 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

Meaning of "infringing goods, material or articles" and "counterfeit goods and trade marks"

35. (1) In this Act, the expressions "infringing goods", "infringing material", "infringing articles", "counterfeit goods" and "counterfeit trade mark" shall be construed in accordance with this section.

(2) Goods are "infringing goods", in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and the—

(a) application of the sign to the goods or their packaging was an infringement of the registered trade mark; or

(b) goods are proposed to be imported into Nigeria and the application of the sign in Nigeria to them or their packaging would be an infringement of the registered trade mark; or

(c) sign has otherwise been used in relation to the goods in such a way as to infringe the registered mark.

(3) Material is "infringing material", in relation to a registered trade mark, if it bears a sign identical or similar to that mark and either—

(a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or

(b) it is intended to be so used and such use would infringe the registered trade mark.

(4) "Infringing articles", in relation to a registered trade mark, means articles—

(a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and

(b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

(5) Goods are "counterfeit goods", in relation to a registered trade mark, if—

(a) they are infringing goods in relation to that mark; and

(b) the sign borne by them or their packaging is a counterfeit trade mark.

(6) A sign is a "counterfeit trade mark", in relation to a registered trade mark, if the sign—

(a) is identical to, or so nearly resembling the registered trade mark as to be calculated to deceive; and

(b) is applied to goods or services—

(i) without the express or implied consent (conditional or otherwise) of the proprietor of the registered trade mark; and

(ii) to falsely represent the goods or services to be the genuine goods or actual services of the proprietor or a licensee of the registered trademark.

Order as to disposal of infringing goods, material or articles

36. (1) Where infringing goods, material or articles have been delivered up pursuant to an order under section 34, an application may be made to the Court for—

- (a) an order that they be destroyed or forfeited to such person as the Court may think fit; or
- (b) a decision that no such order should be made.
- (2) In considering what order, if any, should be made, the Court shall have regard to the—
 - (a) adequacy of other remedies; and
 - (b) need to ensure that no infringing goods, material or articles are disposed of in a manner that would adversely affect the claimant.
- (3) Notwithstanding subsection (2), where the infringing goods are counterfeit goods, the Court shall order that the goods be destroyed if the—
 - (a) claimant applies to the Court for such an order; and
 - (b) Court is of the view that there are no exceptional circumstances which justify the refusal of such an order.
- (4) The Court shall issue directions as to the service of notice on persons having an interest in the goods, material or articles.
- (5) Any person having an interest in the goods, material or articles is entitled—
 - (a) to appear in proceedings for an order under this section, whether or not that person is served with notice; and
 - (b) to appeal against any order made, whether or not that person appears in the proceedings.
- (6) An order made under this section shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.
- (7) Subject to subsection (3), where there is more than one person interested in the goods, material or articles, the Court may direct that the goods, material or articles be sold, or otherwise dealt with, and the proceeds divided, and shall make any other order as it thinks just.
- (8) If the Court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up, is entitled to their return.

Remedy for groundless threats of infringement proceedings

37. (1) Where a person threatens another with infringement proceedings other than proceedings relating to the—
- (a) application of the mark to goods or to material used or intended to be used for labelling or packaging goods;
 - (b) importation of goods to which, or to the packaging of which, the mark has been applied; or
 - (c) supply of services under the mark, any aggrieved person may bring proceedings for relief under this section.
- (2) A person may apply for the following relief:
- (a) a declaration that the threats are unjustifiable;
 - (b) an injunction against the continuance of the threats; and
 - (c) damages in respect of any loss the claimant has sustained by the threats.
- (3) The claimant is entitled to the relief referred to in subsection (2) unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned.
- (4) If the defendant showed that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned, the claimant is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.
- (5) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

PART III

REGISTERED TRADE MARK AS OBJECT OF PROPERTY

Nature of registered trade mark

38. A registered trade mark is personal property.

Co-ownership of registered trade mark

39. (1) Where a registered trade mark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) Subsections (3) to (8) apply where two or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor shall not, without the consent of the other or others—

(a) grant a licence to use the registered trade mark; or

(b) assign or charge his share in the registered trade mark.

(5) Infringement proceedings may be brought by any co-proprietor, but he shall not, without the leave of the Court, proceed with the action unless the other, or each of the others, is either joined as a claimant or added as a defendant.

(6) A co-proprietor who is added as a defendant under subsection (5) is not liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in subsection (5) affects the granting of interlocutory relief on the application of a single co-proprietor.

(8) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations.

Assignment of registered trade mark

40. (1) A registered trade mark is assignable and transmissible in the same way as other personal property and is so assignable or transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by, or on behalf of the assignor or a personal representative, as the case may be.

(4) Where the assignor or personal representative is a body corporate, subsection (3) may be satisfied by the affixing of its seal.

(5) Subsections (1) to (4) apply to assignment by way of security as they apply to any other assignment.

(6) A registered trade mark may be the subject of a charge in the same way as other personal property.

(7) Nothing in this Act shall be construed as affecting the assignment or transmission of an unregistered trade mark as part of the goodwill of a business.

Registration of transactions affecting registered trade mark

41. (1) On application being made to the Controller by—

(a) a person claiming to be entitled to an interest in, or under a registered trade mark by virtue of a registrable transaction; or

(b) any other person claiming to be affected by such a transaction, the prescribed particulars of the transaction shall be entered in the Register.

(2) The following are registrable transactions under subsection (1):

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant of a licence under a registered trade mark;
- (c) the granting of any security interest, whether fixed or floating, over a registered trade mark or any right in or under it;
- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and
- (e) an order of the Court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for the registration of the prescribed particulars of a registrable transaction referred to in subsection (2)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction.

(4) A person who becomes the proprietor or a licensee of a registered trade mark by virtue of any registrable transaction referred to in subsection (2)(a), (c), (d) or (e) is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the date of the application for the registration of the prescribed particulars of the transaction.

(5) For the avoidance of doubt, subsections (3) and (4) shall not apply to any registrable transaction relating to—

- (a) a licence under a registered trade mark; or
- (b) any right in or under the licence.

Trusts and equities

42. (1) No notice of any trust shall be entered in the Register, and the Controller shall not be affected by any such notice.

(2) Subject to this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal property.

Application for registration of trade mark as object of property

43. (1) The provisions of sections 38, 39, 40 and 42 shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.

(2) For the purposes of subsection (1), the reference in section 39(1) to the granting of a registration shall be construed as a reference to the making of an application for the registration of a trade mark.

(3) Any person claiming to be—

- (a) entitled to an interest in or under an application for registration of a trade mark by virtue of a registrable transaction; or
- (b) affected by a registrable transaction, shall give to the Controller notice of the prescribed particulars of the transaction.

(4) The following are registrable transactions under subsection (3):

- (a) an assignment of an application for registration of a trade mark or any right in it;
- (b) the grant of a licence under an application for registration of a trade mark;
- (c) the grant of any security interest, whether fixed or floating, over an application for registration of a trade mark or any right in or under it;
- (d) the making by a personal representative of an assent in relation to an application for registration of a trade mark or any right in or under it; and
- (e) an order of the Court or other competent authority transferring an application for registration of a trade mark or any right in or under it.

(5) The Controller shall maintain a record of each notice given to him under subsection (3).

(6) Until the notice referred to in subsection (3) has been given to the Controller in respect of a transaction referred to in subsection (4)(a), (c), (d) or (e), the transaction is ineffective

as against a person acquiring a conflicting interest in or under the application for registration of a trade mark in ignorance of the transaction.

(7) Subsection (6) does not apply to any registrable transaction relating to—
(a) a licence under an application for registration of a trade mark; or
(b) any right in or under the licence.

PART IV LICENSING

Licensing of registered trade mark

44. (1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

(4) Where the grantor is a body corporate, subsection (3) may be satisfied by the affixing of its seal.

(5) Subject to subsection (7), a licence to use a registered trade mark is binding on every successor in title to the interest of the grantor, unless—

(a) any person who, in good faith and without any notice of the licence, has given valuable consideration for the interest in the registered trade mark; or

(b) the licence provides otherwise, and any reference in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(6) A person is deemed to have notice of a licence if the prescribed particulars of the grant of the licence are entered in the Register under section 41(1).

(7) Where the licence so provides, a sub-licence may be granted by the licensee and references in this Act to a licence or licensee include references to a sub-licence or sub-licensee.

Exclusive licences

45. Section 44 applies, with the necessary modifications, to an exclusive licence.

General provisions as to rights of licensees in case of infringement

46. (1) This section applies to the rights of a licensee in relation to infringement of a registered trade mark.

(2) This section does not apply where the licensee has a right to bring proceedings in his own name under section 47(1).

(3) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(4) If the proprietor refuses, or fails within two months, to take infringement proceedings after being called upon to do so by the licensee in accordance with subsection (3), the licensee may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee shall not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant.

(6) Subsection (5) does not affect the granting of interlocutory relief on an application by a licensee alone.

(7) A proprietor who is added as a defendant under subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) In infringement proceedings brought by the proprietor of a registered trade mark—

(a) any loss suffered or likely to be suffered by licensees shall be taken into account; and

(b) the Court may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(9) This section applies in relation to an exclusive licensee if or to the extent that he has, by virtue of section 47(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

Exclusive licensee having rights and remedies of assignee

47. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) Where or to the extent that the provision referred to in subsection (1) is made, the licensee is entitled, subject to the provisions of the licence and to the provisions of this section, to bring infringement proceedings against any person, other than the proprietor, in his own name.

(3) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark, and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(4) In an action brought by an exclusive licensee by virtue of this section, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(5) Where infringement proceedings brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee shall not, without the leave of the Court, proceed with the action, unless the other is either joined as a claimant or added as a defendant, but this does not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(6) A person who is added as a defendant as mentioned in subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Where infringement proceedings are brought which relate wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—

(a) the Court shall, in assessing damages, take into account—

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed by the Court, if an award of damages has been made; and

(c) the Court may, if an account of profits is directed, apportion the profits between them as the Court considers just, subject to any agreement between them.

(8) Subsection (7) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action, and if only one is a party, the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(9) The proprietor of a registered trade mark, before applying for an order under section 34, shall notify any exclusive licensee who has a concurrent right of action and the Court may on application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(10) The provisions of subsections (5) to (9) shall have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

Use of trade marks on the Internet

48. (1) The use of a sign on the Internet shall constitute use in Nigeria only if the use has a commercial effect in Nigeria.

(2) In determining whether use of a sign on the Internet has a commercial effect in Nigeria, the Controller shall take into account all relevant circumstances including—

- (a) circumstances indicating that the user of the sign is doing, or has undertaken significant plans to do, business in Nigeria in relation to goods or services which are identical or similar to those for which the sign is used on the Internet;
- (b) the level and character of commercial activity of the user in relation to Nigeria;
- (c) the connection of an offer of goods or services on the Internet with Nigeria;
- (d) the connection of the manner of use of the sign on the Internet with Nigeria; and
- (e) the relation of the use of the sign on the Internet to a right in that sign in and Nigeria.

PART V

OFFENCES

Counterfeiting a trade mark

49. (1) Any person who counterfeits a registered trade mark commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand naira and imprisonment for a term of ten years.

(2) A person who—

- (a) makes a sign identical to or so nearly resembling a registered trade mark as to be calculated to deceive; or
- (b) falsifies a genuine registered trade mark, whether by alteration, addition, effacement, partial removal or otherwise, without the consent of the proprietor of the registered trade mark shall be deemed to counterfeit a registered trade mark.

Falsely applying a registered trade mark to goods or services

50. (1) Any person who falsely applies a registered trade mark to goods or services commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand naira and to imprisonment for ten years on indictment.

(2) For the purposes of this section and sections 52, 56 and 57, a person falsely applies a registered trade mark to goods or services if—

- (a) without the consent of the proprietor of the registered trade mark, the person applies the trade mark or a sign likely to be mistaken for that trade mark to the goods or services; and
- (b) in the case of an application to goods, the goods are not the genuine goods of the proprietor or licensee of the registered trade mark.

(3) For the purposes of subsection (2), a trade mark shall be deemed to be applied to goods or services if it is used in any—

- (a) sign or advertisement; or
- (b) invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium, and the goods are delivered, or services provided, as the case may be, to a person in pursuance of a request or order made by reference to the trade mark as so used.

(4) For the purposes of subsection (2)—

- (a) a sign shall be deemed to be applied to—
 - (i) it is applied to the goods themselves; or
 - (ii) it is applied to any covering, label, reel or thing in or with which the goods are sold, offered or exposed for sale or kept in possession for the purpose of trade or manufacture; and

(b) a sign shall be deemed to be applied to goods or services if it is used in a manner that is likely to lead persons to believe that it refers to, describes or designates the goods or services.

(5) In subsection (4)—

“covering” includes any stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper; “label” includes any band or ticket.

Making or possessing of article for committing offence

51. Any person who—

(a) makes an article specifically designed or adapted for making copies of a registered trade mark or a sign likely to be mistaken for that trade mark; or
(b) has such an article in his possession, custody or control, knowing or having reason to believe that it has been, or is to be, used for or in the course of committing an offence against section 49 or 50, commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand naira and to imprisonment for ten years.

Importing or selling of goods with falsely applied trade mark

52. (1) Subject to subsection (2), a person who—

(a) imports into Nigeria for the purpose of trade or manufacture;
(b) sells or offers or exposes for sale; or
(c) has in his possession for the purpose of trade or manufacture any goods to which a registered trade mark is falsely applied; commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand naira and to imprisonment for a term of ten years.

(2) It is a defence to a charge under subsection (1) if the person proves that—

(a) having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark and on demand made by, or on behalf of, the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods; or
(b) he had acted innocently.

Falsification of Register

53. Any person who—

(a) makes, or causes to be made, a false entry in the Register;
(b) makes, or causes to be made, anything false purporting to be a copy of an entry in the Register; or
(c) produces or tenders or causes to be produced or tendered in evidence anything referred to in paragraph (b), knowing or having reason to believe that the entry or thing, as the case may be, is false commits an offence and is liable on conviction on indictment to a fine of one hundred thousand naira and to imprisonment for a term of five years.

Falsely representing trade mark as registered

54. (1) Any person who—

(a) falsely represents that a mark is a registered mark; collective mark or certification mark; or
(b) makes a false representation as to the goods or services for which a mark is registered, knowing or having reason to believe that the representation is false commits an offence and is liable on summary conviction to a fine of ten thousand naira.

(2) For the purposes of this section, the use in the course of trade in Nigeria in relation to a mark of—

(a) the word "registered"; or
(b) any other word or symbol importing a reference, express or implied, to registration, shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Nigeria and that the mark is in fact so registered for the goods or services in question.

Forfeiture and destruction of goods on conviction

55. (1) Subject to subsection (2), where any person commits an offence under any provision of this Part, the Court may, where it considers appropriate, order the person to forfeit to the State all or any—

(a) goods in relation to which; or

- (b) articles by means of which, the offence was committed.
- (2) Where any person commits an offence under section 50 or 52 in relation to a registered trade mark, the Court shall, unless it is of the view that there are exceptional circumstances for deciding otherwise, order to be forfeited to the State and destroyed any goods which satisfy all of the following conditions:
- (a) the goods are goods in relation to which—
- (i) the offence was committed; and
 - (ii) the trade mark has been falsely applied; and
- (b) the goods or their packaging bear the trade mark or sign giving rise to the false application of the trade mark.
- (3) Any—
- (a) forfeiture of goods or articles under subsection (1); or
 - (b) forfeiture and destruction of goods under subsection (2),
- shall be in addition to any penalty or punishment that the Court may impose for the offence committed.

Enforcement measures

56. (1) Any police officer may arrest without a warrant any person who, in any street or public place—
- (a) sells or offers or exposes for sale; or
 - (b) has, or is reasonably suspected of having, in his possession for the purpose of trade or manufacture, any goods to which a registered trade mark is falsely applied.
- (2) Any police officer or Officer designated by the Comptroller may, pursuant to a warrant issued under subsection (3)—
- (a) stop, search and board, whether forcibly or otherwise, any conveyance in which he reasonably suspects there are goods to which a registered trade mark has been falsely applied; and
 - (b) seize, remove or detain any such goods and anything which appears to him—
 - (i) to be or to contain; or
 - (ii) to be likely to be or to contain, evidence of any offence under section 49, 50, 51 or 52.
- (3) If information is given upon oath to a Magistrate that there is reasonable cause for suspecting that there is in any premises or conveyance—
- (a) any goods which are the subject of an offence under section 49, 50, 51 or 52;
 - (b) any material or article which has been used in the commission of an offence under section 49, 50, 51 or 52; or
 - (c) any document which is evidence that an offence under section 50, 51, 52, 53 or 55 has been committed, the Magistrate may issue, either unconditionally or subject to such conditions as the Magistrate thinks fit, a warrant authorising a police officer to enter and search the premises or conveyance for any goods, material, article or document referred to in the warrant, whether specifically or in any general category, and to seize any such goods, material, article or document found at the premises or conveyance.
- (4) If any goods, material, article or document has been seized under subsection (3) and—
- (a) in proceedings brought under section 49, 50, 51 or 52, no order is made as to the disposal of the goods, material, article or document; or
 - (b) no such proceedings are instituted within six months of the seizure, the goods, material, article or document shall be returned to the person in whose possession it was when it was seized or, if it is not reasonably practicable to return it to that person, shall be disposed of in such manner as the Magistrate may order.
- (5) No action or other legal proceeding shall lie against the State or any officer or employee thereof for anything which is in good faith done or omitted to be done in the exercise of any power, duty or function under this section.
- (6) In this section—
- "conveyance" includes any vehicle, vessel or aircraft in which persons or goods can be carried;

"document" means anything in which information of any description is recorded;
"premises" includes any land, building or structure.

PART VI

INTERNATIONAL MATTERS

The Madrid Protocol

Power to make provision giving effect to Madrid Protocol etc.

57. (1) The Minister may make regulations to give effect to the provisions of the Madrid Protocol or of any treaty, convention, arrangement or engagement relating to trade marks to which Nigeria is a party.

(2) Regulations under subsection (1) may, in particular, provide for—

(a) the making of applications for international registrations by way of the Intellectual Property Office as the office of origin;

(b) the procedures to be followed where the basic application or registration in Nigeria fails or ceases to be in force;

(c) the procedures to be followed where the Intellectual Property Office receives from the International Bureau or any body specified in the rules, a request for extension of protection to Nigeria;

(d) the effects of a successful request for extension of protection to Nigeria;

(e) the transformation of an international application for registration into a national application for registration;

(f) the communication of information to the International Bureau;

(g) the payment of fees and amounts in respect of applications for international registrations, extensions of protection and renewals of international registrations; and

(h) the application of section 37 and Parts V and XI to an international trade mark (Nigeria).

(3) For the purposes of this section—

"basic application" has the meaning assigned by Article 2(1) of the Madrid Protocol;

"basic registration" has the meaning assigned by Article 2(1) of the Madrid Protocol;

"international application" has the meaning assigned by Article 2(2) of the Madrid

Protocol; "International Bureau" has the meaning assigned by Article 2(1) of the Madrid

Protocol; "international registration" has the meaning assigned by Article 2(1) of the Madrid

Protocol; "international trade mark (Nigeria)" means a trade mark which is entitled to protection in Nigeria under the Madrid Protocol;

"Madrid Protocol" means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June, 1989, as revised or amended from time to time.

The Paris Convention, the TRIPS Agreement and Well-known Marks: Supplementary Provisions

Protection of well-known trade marks

58. (1) A well-known trade mark is entitled to protection under this section whether or not the—

(a) trade mark has been registered in Nigeria, or an application for the registration of the trade mark has been made to the Controller; and

(b) proprietor of the trade mark carries on business, or has any goodwill, in Nigeria.

(2) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Nigeria, in the course of trade and without the proprietor's consent, of any trade mark which, or an essential part of which, is identical with, or similar to, the proprietor's trade mark in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Nigeria, in the course of trade and without the proprietor's consent, of any trade mark which, or an essential part of which, is identical with, or similar to, the proprietor's well-known trade mark in relation to any goods or services, where the use of the trade mark would—

(a) indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor;

(b) cause dilution in an unfair manner of the distinctive character of the proprietor's well-known trade mark; or

(c) take unfair advantage of the distinctive character of the proprietor's well-known trade mark.

(4) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Nigeria, without the proprietor's consent, of any business identifier which, or an essential part of which, is identical with, or similar to, the proprietor's well-known trade mark where the use of the business identifier would—

(a) indicate a connection between the business in respect of which it is used and the proprietor, and is likely to damage the interests of the proprietor;

(b) cause dilution in an unfair manner of the distinctive character of the proprietor's well-known trade mark; or

(c) take unfair advantage of the distinctive character of the proprietor's well-known trade mark.

(5) If the Court grants an injunction under subsection (4) restraining the use by any business of any business identifier, the Court may make such other order as the Court deems fit in respect of any entry in any record maintained by any person, body or authority which associates that business with that business identifier.

(6) The proprietor is not entitled to the right referred to in subsection (2), (3) or (4) if the use of the trade mark or business identifier, as the case may be, began before the proprietor's trade mark became well-known in Nigeria, unless the trade mark or business identifier has been used in bad faith.

(7) The proprietor ceases to be entitled to the right referred to in subsection (2), (3) or (4) if the proprietor has acquiesced for a continuous period of five years in the use of the trade mark or business identifier, as the case may be, in Nigeria, being aware of that use, unless the trade mark or business identifier has been used in bad faith.

(8) In deciding whether the trade mark or business identifier, as the case may be, has been used in bad faith, it shall be relevant to consider whether the person who used the trade mark or business identifier had, at the time he began to use the trade mark or business identifier, knowledge of, or reason to know of, the proprietor's well-known trade mark.

(9) Nothing in subsection (2) affects the continuation of any use referred to therein in good faith of a trade mark that began before the commencement of this Act.

(10) Nothing in subsection (3) or (4) shall affect the continuation of any use referred to therein in good faith of a trade mark or business identifier, as the case may be, that began before the commencement of this Act.

(11) For the purposes of this section and sections 59, 60, 61 and 63, "use", in relation to a trade mark, means use within the meaning of section 28(4).

Permitted use of well-known trade marks

59. (1) Notwithstanding section 58, the proprietor of a well-known trade mark is not entitled to restrain by injunction the use, in Nigeria in accordance with honest practices in industrial or commercial matters, by any person of—

(a) the name of—

(i) the person himself;

(ii) the person's place of business;

- (iii) the person's predecessor in business; or
 - (iv) the place of business of the person's predecessor in business;
 - (b) any sign to indicate—
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or
 - (c) the trade mark to indicate the intended purpose of goods, in particular as accessories or spare parts, or services.
- (2) Notwithstanding section 58, the proprietor of a well-known trade mark shall not be entitled to restrain by injunction the use, in Nigeria, of any registered trade mark in relation to goods or services for which the latter is registered.
- (3) Notwithstanding section 58, the proprietor of a well-known trade mark shall not be entitled to restrain by injunction the use, in Nigeria, of the trade mark if the use—
- (a) constitutes fair use in comparative commercial advertising or promotion;
 - (b) is for a non-commercial purpose; or
 - (c) is for the purpose of news reporting or news commentary.

National emblems, etc., of Convention countries: Article 6ter of Paris Convention and TRIPS Agreement

60. (1) A trade mark which consists of, or contains, the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Controller that use of the flag in the manner proposed is permitted without such authorisation.
- (2) A trade mark which consists of, or contains, the armorial bearings or any other State emblem of a Convention country which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the competent authorities of that country.
- (3) A trade mark which consists of, or contains, an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered in relation to goods or services of the same or a similar kind, as those in relation to which it indicates control and warranty in relation to goods and services, without the authorisation of the competent authorities of the country concerned.
- (4) The provisions of this section as to national flags and other State emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.
- (5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a State emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.
- (6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use in the course of trade of the trade mark in Nigeria without their authorisation.

Emblems, etc., of certain international organisations: Article 6ter of Paris Convention and TRIPS Agreement

61. (1) This section shall apply to—
- (a) the armorial bearings, flags or other emblems; and
 - (b) the abbreviations and names, of international organisations of which one or more Convention countries are members.
- (2) A trade mark which consists of, or contains, any emblem, abbreviation or name which is protected under the Paris Convention or the TRIPS Agreement shall not be registered

without the authorisation of the international organisation concerned, unless it appears to the Controller that the use of the emblem, abbreviation or name in the manner proposed—

(a) does not suggest to the public that a connection exists between the organisation and the trade mark; or

(b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem.

(4) Where, by virtue of this section, the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation is entitled to restrain, by injunction any use in the course of trade of the trade mark in which the emblem, abbreviation or name of that organisation is used, without its authorisation.

(5) Nothing in this section affects the rights of a person whose *bona fide* use of the trade mark in question began before August 1, 1964.

Notification under Article 6ter of Paris Convention and TRIPS Agreement

62. (1) For the purposes of section 60, State emblems of a Convention country, other than the national flag, shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that—

(a) the country in question has notified Nigeria in accordance with Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) Nigeria has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of section 61, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that—

(a) the organisation in question has notified Nigeria in accordance with Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) Nigeria has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Controller shall keep and make available for public inspection by any person, during the hours when the Intellectual Property Office is open for business and free of charge, a list of—

(a) the state emblems and official signs or hallmarks; and

(b) the emblems, abbreviations and names of international organisations, which are for the time being protected under the Paris Convention or the TRIPS Agreement by virtue of a notification under Article 6ter (3) of that Convention or under that Article as applied by the TRIPS Agreement.

Acts of agent or representative: Convention country

63. (1) Subsections (2) to (6) apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the trade mark in a Convention country.

- (2) If the proprietor opposes the application, registration shall be refused.
- (3) If the application is not opposed and is granted, the proprietor may—
- apply for a declaration of the invalidity of the registration; or
 - apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.
- (4) Notwithstanding the rights conferred by this Act in relation to a registered trade mark, the proprietor may, by injunction, restrain any use in the course of trade of the trade mark in Nigeria which is not authorised by him.
- (5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.
- (6) An application under subsection (3)(a) or (b) shall be made within three years of the proprietor becoming aware of the registration.
- (7) No injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

PART VII

COLLECTIVE MARKS

Collective marks

64. (1) The provisions of this Act shall apply to collective marks subject to the provisions of this Part.

(2) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

(3) In relation to a collective mark, the reference in the definition of "trade mark" in section 3 to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association.

Registration of collective marks

65. (1) Notwithstanding section 8(1)(c), a collective mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered.

(2) The proprietor of a mark under subsection (1) is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, including, by a person who is entitled to use a geographical name.

(3) A collective mark shall not be registered if the public is likely to be misled as regards the character or significance of the mark, including, if it is likely to be taken to be something other than a collective mark.

(4) The Controller may require that a mark in respect of which application is made for registration as a collective mark include some indication that it is a collective mark.

(5) Notwithstanding section 15(3), an application may be amended so as to comply with subsections (3) and (4).

Rules governing use of collective marks

66. (1) An applicant for registration of a collective mark shall, within the prescribed period following the date of the application, file with the Controller rules governing the use of the mark and pay the prescribed fee.

(2) The rules under subsection (1) shall specify—

(a) the persons authorised to use the mark;

(b) the conditions of membership of the association; and
(c) where they exist, the conditions of use of the mark, including any sanctions against misuse, and further requirements with which the rules shall comply may be imposed by Regulations.

(3) A collective mark shall not be registered unless the rules governing the use of the mark—

(a) comply with subsection (2); and

(b) are not contrary to public policy or to accepted principles of morality.

(4) An application for registration of a collective mark shall be deemed to be withdrawn if an applicant fails to comply with subsection (1).

Controller's discretion regarding rules

67. (1) If it appears to the Controller that the requirements under section 66(3) are not satisfied, he shall inform the applicant and give him an opportunity, within such period as the Controller may specify, to make representations or to file amended rules.

(2) If the applicant responds within the specified period but fails to satisfy the Controller that the requirements under section 66(3) are satisfied, or to file rules that have been amended so as to satisfy those requirements, the Controller may refuse the application.

(3) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Controller that the requirements under section 66(3), and any other requirements for registration are satisfied, he shall accept the application and shall proceed in accordance with section 14.

(5) The Controller shall publish a notice that the rules governing the use of the collective mark are open to public inspection in accordance with section 68 and notice of opposition may be given and observations may be made relating to the matters mentioned in section 66(3), in addition to any other grounds on which the application may be opposed or observations made.

Rules to be open to inspection

68. The rules governing the use of a registered collective mark shall be open to public inspection in the same manner as the Register.

Rights of authorised users regarding infringement of a collective mark

Amendment of rules

69. (1) An amendment of the rules governing the use of a registered collective mark is of no effect unless the amended rules are filed with the Controller and accepted by him.

(2) Before accepting any amended rules, the Controller shall publish a notice that the amended rules have been filed and are open to public inspection in accordance with section 68 and notice of opposition may be given, and observations may be made, relating to the matters mentioned in section 66(3).

Rights of authorised users regarding infringement of a collective mark

70. (1) Section 28(5) and section 97 apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark.

(2) Section 46 has effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

(3) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to request the proprietor to take infringement proceedings in respect of any matter which affects his interests.

(4) Subject to subsection (5), if the proprietor—

(a) refuses to do so; or

- (b) fails to do so within two months after being called upon, the authorised user may bring the proceedings in his own name as if he were the proprietor.
- (5) Where infringement proceedings are brought under this section, the authorised user shall not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant.
- (6) Subsection (5) does not affect the granting of interlocutory relief on an application by an authorised user alone.
- (7) A proprietor who is added as a defendant under subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (8) In infringement proceedings brought by the proprietor of a registered collective mark any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court which may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of the authorised users.

Grounds for revocation of registration of collective marks

71. (1) In addition to the grounds of revocation provided for in section 23, the registration of a collective mark may be revoked on the ground that—
- (a) the manner in which the mark has been used by the proprietor has caused it to become likely to mislead the public in the manner referred to in section 65(3);
- (b) the proprietor has failed to observe, or to secure the observance of, the rules governing the use of the mark; or (c) an amendment of the rules has been made so that the rules—
- (i) no longer comply with section 66(2) and any further requirements imposed by Regulations; or
- (ii) are contrary to public policy or to accepted principles of morality.

Grounds for revocation of registration of collective marks

72. In addition to the grounds of invalidity provided for in section 24, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of section 65(3) or section 66(3).

PART VIII

CERTIFICATION MARKS

Certification marks

73. (1) The provisions of this Act shall apply to certification marks subject to the provisions of this Part.
- (2) A certification mark is a sign used, or intended to be used, to distinguish goods or services—
- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods, or performance of services, quality, accuracy or other characteristics, from other goods or services dealt with or provided in the course of trade but not so certified.
- (3) In relation to a certification mark, the reference in the definition of "trade mark" in section 3(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in subsection (2)(b) from those which are not so certified.

Registration of certification marks

74. (1) Notwithstanding section 8(1)(c), a certification mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered.

(2) The proprietor of a mark under subsection (1) is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, including, by a person who is entitled to use a geographical name.

(3) A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

(4) A certification mark shall not be registered if the public is likely to be misled as regards the character or significance of the mark, including if it is likely to be taken to be something other than a certification mark.

(5) The Controller may require that a mark in respect of which application is made for registration as a certification mark include some indication that it is a certification mark.

(6) Notwithstanding section 15(3), an application may be amended so as to comply with subsections (4) and (5).

Rules governing use of certification mark

75. (1) An applicant for registration of a certification mark shall within the prescribed period file with the Controller the rules governing the use of the mark.

(2) The rules under subsection (1) shall specify—

(a) who is authorised to use the mark;

(b) the characteristics to be certified by the mark;

(c) how the certifying body is to test those characteristics and to supervise the use of the mark; and

(d) the fees, if any, to be paid in connection with the use of the mark and the procedures for resolving disputes, and further requirements with which the rules shall comply may be imposed by Regulations.

(3) A certification mark shall not be registered unless—

(a) the rules governing the use of the mark—

(i) comply with subsection (2); and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(4) An application for registration of a certification mark shall be deemed to be withdrawn if an applicant fails to comply with subsection (1).

Controller's discretion regarding Rules

76. (1) If it appears to the Controller that the requirements under section 75(3) are not satisfied, he shall inform the applicant and give him an opportunity, within such period as the Controller may specify, to make representations or to file amended rules.

(2) If the applicant responds within the specified period but fails to satisfy the Controller that the requirements under section 75(3) are satisfied, or to file rules that have been amended so as to satisfy those requirements, the Controller may refuse the application.

(3) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Controller that the requirements under section 75(3), and any other requirements for registration, are satisfied, he shall accept the application and shall proceed in accordance with section 14.

(5) The Controller shall publish a notice that the rules governing the use of the certification mark are open to public inspection in accordance with section 77 and notice of opposition may be given and observations may be made relating to matters mentioned in section 75(3), in addition to any other ground on which the application may be opposed or observations made.

Rules to be open to inspection

77. The rules governing the use of a registered certification mark shall be open to public inspection in the same manner as the Register.

Consent to assignment of registered certification mark

78. (1) An amendment of the rules governing the use of a registered certification mark is of no effect unless and until the amended rules are filed with the Controller and accepted by him.

(2) Before accepting any amended rules, the Controller may in any case where it appears to him expedient to do so cause them to be published and if he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in section 75(3).

Rights of authorised users regarding infringement of a identification mark

79. (1) The assignment or other transmission of a registered certification mark is of no effect without the written consent of the Controller.

Grounds for revocation of registration

80. (1) Section 28(5) and section 97 apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark.

(2) In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court which may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of authorised users.

Grounds for revocation of registration

81. (1) In addition to the grounds of revocation provided for in section 23, the registration of a certification mark may be revoked on the ground that—

- (a) the proprietor has begun to carry on such a business as referred to in section 74(3);
- (b) the manner in which the certification mark has been used by the proprietor has caused it to become likely to mislead the public in the manner referred to in section 74(4);
- (c) the proprietor has failed to observe, or to secure the observance of, the rules governing the use of the certification mark;

- (d) an amendment of the rules has been made so that the rules—
 - (i) no longer comply with section 75(2) and any further conditions imposed by Regulations;
 - (ii) are contrary to public policy or to accepted principles of morality; or
- (e) the proprietor is no longer competent to certify the goods or services for which the certification mark is registered.

Grounds for invalidity of registration

82. In addition to the grounds of invalidity provided for in section 24, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of section 74(3), 74(4) or 75(3).

PART IX

REGISTER OF TRADE MARKS

The Register

83. (1) The Controller shall maintain a Register of Trade Marks.

(2) There shall be entered in the Register in accordance with this Act—

- (a) registered trade marks;
- (b) such particulars of registrable transactions affecting a registered trade mark as may be prescribed; and
- (c) such other matters relating to registered trademarks as may be prescribed.

(3) The Register may be kept, in whole or in part, in electronic form.

(4) Any record of a particular or other matter made electronically for the purpose of keeping the Register is taken to be an entry in the Register.

Inspection of, and extract from, Register

84. (1) The Register shall be available at the Intellectual Property Office for inspection by any person during the hours when the Intellectual Property Office is open for business.

(2) If the Register, or any part of the Register is kept in electronic form, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

(3) Any person who applies for a certified copy of an entry in the Register or a certified extract from the Register shall be entitled to obtain such a copy or extract on payment of the prescribed fee and any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of the prescribed fee.

(4) In relation to any portion of the Register kept otherwise than in documentary form, the right to a copy or extract conferred by subsection (3) is a right to a copy or extract in a form in which it can be taken away.

(5) In this section, "certified copy" or "certified extract" means a copy or extract, respectively, which is certified by the Controller and sealed with the seal of the Controller.

Rectification or correction of Register

85. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the Register.

(2) An application for rectification shall not be made in respect of a matter affecting the validity of the registration of a trade mark.

(3) An application for rectification may be made either to the Controller or to the Court, except that—

(a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; and

(b) if in any other case the application is made to the Controller, he may at any stage of the proceedings refer the application to the Court.

(4) Except where the Controller or the Court directs otherwise, the effect of rectification of the Register is that the error or omission in question shall be deemed never to have been made.

(5) The Controller may, on request made in the prescribed manner by the proprietor of a registered trade mark or a licensee, enter any change in his name or address as recorded in the Register.

(6) The Controller may remove from the Register matters appearing to him to have ceased to have effect.

PART X

POWERS AND DUTIES OF CONTROLLER

Costs awarded by Controller

86. (1) The Controller may award costs in respect of the matters, and in the amounts, provided for in the Regulations, against any party to proceedings brought before him.

(2) The Regulations may provide for the taxation of the costs, or any part of the costs, by the Controller.

(3) A party desirous to obtain costs or to have the costs taxed shall apply to the Controller in accordance with the Regulations.

(4) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

Extensions of time

87. (1) If the Controller is satisfied that the circumstances justify it, he may, upon receiving a written request and upon payment of the prescribed fee, extend the time for doing any act or taking any proceeding under this Act, other than the filing of a notice of opposition.
- (2) Where an extension is granted under subsection (1), the Controller shall give notice to the parties concerned.
- (3) An extension under subsection (1) may be granted—
- (a) subject to such terms as the Controller may direct; and
 - (b) notwithstanding that the time for doing the act or taking the proceeding has expired.

Hearing before exercise of Controller's discretion

88. Where any discretionary or other power is given to the Controller by this Act, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without giving to the applicant or registered proprietor an opportunity of being heard or making representation in writing.

Security for costs

89. If a person who neither resides nor carries on business in Nigeria—

- (a) gives notice of opposition under section 14; or
- (b) applies to the Controller under section 23 or 24 for the registration of a trade mark to be revoked or to be declared invalid, as the case may be, the Controller may require the person to give security for the costs for the proceedings and may, if security is not given, dismiss the proceedings.

Evidence before Controller

90. The Controller may, for the purposes of any proceedings before him under this Act—

- (a) summon witnesses, including independent expert witnesses;
- (b) receive evidence on oath, whether orally or otherwise; and
- (c) require the production of documents or articles.

Disobedience to summons an offence

91. (1) A person who has been summoned to appear as a witness before the Controller shall not, without lawful excuse, fail to appear in obedience to the summons.

(2) A person who has been required by the Controller to produce a document or article shall not, without lawful excuse, fail to produce the document or article.

(3) Any person who contravenes subsection (1) or (2), commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for one year.

Refusal to give evidence an offence

92. (1) A person who appears before the Controller shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

(2) A person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine of two hundred thousand naira and to imprisonment for one year.

Exclusion of liability in respect of official acts

93. (1) The Controller shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which Nigeria is a party.

(2) The Controller is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings shall lie against an officer of the Intellectual Property Office in respect of any matter for which, by virtue of this section, the Controller is not liable.

Jurisdiction of Court

94. (1) The Court shall have jurisdiction in cases of disputes relating to the application of this Act.

(2) An appeal lies to the Court from any decision of the Controller under this Act.

Recognition of agents

95. Except as otherwise provided by the Regulations, any act required or authorised by this Act to be done by, or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by, or to an agent authorised by that person in the prescribed form.

PART XI

BORDER ENFORCEMENT MEASURES

Interpretation of Part XI (Border Enforcement Measures)

96. (1) In this Part, unless the context otherwise requires—

"aircraft" has the meaning assigned under section 2 of the Customs Act;

"Comptroller" means the Comptroller of Customs;

"conveyance" means any vessel, train, vehicle or aircraft in which persons or goods can be carried;

"goods" includes all kinds of goods, wares, merchandise and livestock;

"goods in transit" means goods imported, whether or not landed or transhipped within Nigeria, which are to be carried to another country either by the same or another conveyance;

"importer" has the meaning assigned to it in the Customs Act;

"infringement action" means an action for an infringement of a registered trade mark arising from the importation of seized goods;

"master" has the meaning assigned under section 2 of the Shipping Act;

"objector", in relation to seized goods, means the person who gave the notice under section 97 as a result of the giving of which the goods were seized;

"proprietor", in relation to a registered trade mark, includes a licensee of the trade mark;

"retention period", in relation to seized goods, means—

(a) the period specified in a notice given under section 100 in respect of the goods; or

(b) if that period has been extended under section 100, that period as so extended;

"seized goods" means goods seized under section 97;

"vehicle" includes any vehicle in which persons or goods can be carried by land, whether drawn or propelled or set or kept in motion;

"vessel" includes any ship or boat or other description of vessel used in navigation.

(2) Any act, matter or thing required by this Part to be done or performed by, with, to or before then Comptroller, if done or performed by, with, to or before any Officer appointed by the Comptroller for that purpose shall be deemed to be done or performed by then Comptroller.

Restriction of importation of infringing goods

97. (1) A person who is the proprietor or a licensee of a registered trade mark may give the Comptroller a written notice—

(a) stating that he is—

(i) the proprietor of the registered trade mark; or

(ii) a licensee thereof having the power to give such a notice;

(b) stating that goods which, in relation to the registered trade mark, are infringing goods, are expected to be imported;

(c) providing sufficient information—

- (i) to identify the goods;
 - (ii) to enable the Comptroller to ascertain when and where the goods are expected to be imported; and
 - (iii) to satisfy the Comptroller that the goods are infringing goods; and
- (d) stating that he objects to such importation.

(2) A notice given under subsection (1) shall be supported by such documents and information, and accompanied by such fee, as may be prescribed.

(3) A notice under subsection (1) shall remain in force until the end of the period of sixty days commencing on the day on which the notice was given, unless it is withdrawn before the end of that period, by letter given to the Comptroller—

- (a) by the licensee, if the person giving the notice is a licensee of the registered trade mark and he has power to withdraw the notice; or
- (b) by the proprietor of the registered trade mark in any other case.

(4) If—

- (a) a notice has been given under this section in respect of a registered trade mark;
- (b) the notice has not lapsed or been withdrawn; and
- (c) a person imports goods, not being goods in transit, which bear a sign that, or whose packaging bears a sign that, in the opinion of the Comptroller is identical with or similar to the registered trade mark in question, the Comptroller may seize the goods.

Security for liability or expense of seizure

98. The Comptroller may refuse to seize goods under section 97 unless—

(a) the objector has deposited with the Comptroller a sum of money that, in the opinion of the Comptroller, is sufficient to—

(i) reimburse the State for any liability or expense it is likely to incur as a result of the seizure of the goods; and

(ii) pay such compensation as may be ordered by the Court under section 104(2) or 105(6); or

(b) the objector has given security, to the satisfaction of the Comptroller, for the reimbursement of the State for any such liability or expense and the payment of such compensation.

Secure storage of seized goods

99. Seized goods shall be taken to such secure place as the Comptroller directs.

Notice of seizure

100. (1) As soon as is practicable after goods are seized under section 97, the Comptroller shall give to the importer and the objector, either personally or by post, a written notice identifying the goods and stating that they have been seized.

(2) A notice under subsection (1) shall state that the goods shall be released to the importer unless—

(a) an infringement action in respect of the goods is instituted by the objector within a specified period from the date specified in the notice, being no more than one month from the date of the notice; and

(b) the objector gives written notice to the Comptroller within the specified period stating that the infringement action has been instituted.

(3) The date specified for the purposes of subsection (2)(a) shall not be earlier than the date on which the notice is given.

(4) The objector may, by written notice given to the Comptroller before the end of the specified period referred to in subsection (2)(a), request that the period be extended.

(5) Subject to subsection (6), if—

- (a) a request is made in accordance with subsection (4); and

(b) the Comptroller is satisfied that it is reasonable that the request be granted, the Comptroller may extend the specified period by such period as he thinks fit.

(6) A decision on a request made in accordance with subsection (4) shall be made within ten working days after the request is made, but such a decision shall not be made after the end of the specified period referred to in subsection (2)(a).

Inspection, release, etc., of seized goods

101. (1) The Comptroller may permit the objector or the importer to inspect the seized goods.

(2) If the objector gives the requisite undertakings, the Comptroller may permit the objector to remove a sample of the seized goods from the custody of the Comptroller for inspection by the objector.

(3) If the importer gives the Comptroller the requisite undertakings, the Comptroller may permit the importer to remove a sample of the seized goods from the custody of the Comptroller for inspection by the importer.

(4) The requisite undertakings are undertakings in writing that the person giving the undertaking shall—

(a) return the sample to the Comptroller at a specified time that is satisfactory to the Comptroller;

(b) take reasonable care to prevent damage to the sample; and

(c) deposit with the Comptroller a security, in the amount of which the Comptroller shall determine, upon his satisfaction that the security deposit can be used to offset the cost of the sample if the goods are used for testing purposes.

(5) A person under this section who does not return the sample in accordance with subsection (4) commits an offence and is liable to a fine of Five Hundred thousand Naira unless the Comptroller is satisfied that the sample had to be used for testing purposes.

(6) If the Comptroller permits inspection of the seized goods, or the removal of a sample by the objector, in accordance with this section, the Comptroller is not liable to the importer for any loss or damage suffered by the importer arising out of—

(a) damage to any of the seized goods incurred during that inspection; or

(b) anything done by the objector or any other person to, or in relation to, a sample removed from the custody of the Comptroller or any use made by the objector of such a sample.

Forfeiture of seized goods by consent

102. (1) Subject to subsection (2), the importer may, by written notice to the Comptroller, consent to the seized goods being forfeited to the State.

(2) A notice under subsection (1) shall be given before any infringement action in relation to the seized goods is instituted.

(3) If the importer gives a notice under subsection (1), the seized goods shall be forfeited to the State and shall be disposed of—

(a) in the manner prescribed; or

(b) if no manner of disposal is so prescribed, as the Comptroller directs.

Compulsory release of seized goods to importer

103. (1) The Comptroller shall release seized goods, not being goods forfeited to the State under section 102, to the importer on the expiration of the retention period for the goods if the objector has not, before the expiration of that period—

(a) instituted an infringement action in relation to the goods; and

(b) given written notice to the Comptroller stating that the action has been instituted.

(2) If—

(a) an infringement action has been instituted in relation to the seized goods; and

(b) at the end of a period of ninety days commencing on the day on which the action was instituted, there is not in force an order of the Court in which the action was instituted preventing the release of the goods, the Comptroller shall release the goods to the importer.

(3) If the objector gives written notice to the Comptroller stating that he consents to the release of the seized goods, the Comptroller shall release the goods to the importer.

Compensation for failure to take action

104. (1) Where goods have been seized pursuant to a notice given under section 97, and the objector concerned fails to take infringement action within the retention period for the goods, a person aggrieved by such seizure may apply to the Court for an order of compensation against the objector.

(2) Where the Court is satisfied that the applicant had suffered loss or damage as a result of the seizure of the goods, the Court may order the objector to pay compensation in such amount as the Court thinks fit to the applicant.

Actions for infringement of registered trade mark

105. (1) The Court in which an infringement action is pending may, on the application of a person having a sufficient interest in the subject matter of the action, allow the person to be joined as a defendant to the action.

(2) The Comptroller is entitled to be heard on the hearing of an infringement action.

(3) In addition to any relief that may be granted apart from this section, the Court may—

(a) at any time, order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;

(b) order that the seized goods not be released to the importer before the end of a specified period; or

(c) order that the seized goods be forfeited to the State.

(4) The Court shall not make an order under subsection (3)(a) if it is satisfied that the State or any statutory authority, person or entity is required or permitted under any other law to retain control of the seized goods.

(5) The Comptroller shall comply with an order made under subsection (3).

(6) If—

(a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trade mark was not infringed by the importation of the seized goods; and

(b) a defendant to the infringement action satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods, the Court may order the objector to pay compensation in such amount as the Court thinks fit to that defendant.

Retention of control of seized goods

106. Notwithstanding section 103, in a case in which no order has been made under section 105(3) in relation to seized goods, the Comptroller is not obliged to release or dispose of the goods if the State is required or permitted, under any other law, to retain control of the goods.

Disposal of seized goods ordered to be forfeited

107. If the Court orders that seized goods are to be forfeited to the State, the goods shall be disposed of—

(a) in the manner prescribed; or

(b) if no manner of disposal is so prescribed, as the Comptroller directs.

Insufficient security

108. (1) If the reasonable expenses incurred by the Comptroller in relation to any action taken by the Comptroller under this Part, or taken in accordance with an order of the Court

under this Part, exceed the amount deposited, or the amount of the security given, under section 98, the amount of the excess is a debt due to the State.

(2) The debt created by subsection (1) is due by the objector, or, if there are two or more objectors, by the objectors jointly and severally.

Detention and examination of counterfeit goods

109. (1) Notwithstanding section 97(4), an Officer may—

(a) detain any goods—

(i) that are imported into, or that are to be exported from, Nigeria; and

(ii) that are not goods in transit; or

(b) examine any goods, including goods in transit, which he reasonably suspects are counterfeit goods in relation to a registered trade mark.

(2) As soon as practicable after goods are detained under subsection (1)(a), the Officer shall give—

(a) to the importer, exporter or consignee, as the case may be, of the detained goods; and

(b) to the proprietor of the registered trade mark, a written notice identifying the goods, stating that they have been detained and setting out the matters referred to in subsection

(3).

(3) The detained goods shall be released to the importer, exporter or consignee, as the case may be, of the goods, unless, within the prescribed period, the proprietor of the registered trade mark—

(a) in the case of goods that are imported into Nigeria and that are not goods in transit—

(i) gives the Comptroller a written notice referred to in section 97(1);

(ii) submits the documents and information, and pays the fee referred to in section 97(2) to the Comptroller; and

(iii) deposits with the Comptroller the sum of money referred to in section 98(a) or gives the security referred to in section 98(b); or

(b) in the case of goods that are to be exported from Nigeria or goods in transit that are consigned to a person with a commercial or physical presence in Nigeria—

(i) institutes an action for the infringement of his trade mark;

(ii) serves on the Comptroller an order of the Court authorising the further detention of the goods; and

(iii) deposits with the Comptroller a sum of money that, in the opinion of the Comptroller, is sufficient to—

(A) reimburse the State for any liability or expense it has incurred and is likely to further incur as a result of the detention of the goods; and

(B) pay such compensation to any person who suffers loss or damage as a result of the detention of the goods as may be ordered by the Court or gives security, to the satisfaction of the Comptroller, for the reimbursement of the State for any such liability or expense and the payment of such compensation.

(4) Every order of the Court authorising the further detention of goods under subsection (3)(b)(ii) shall be subject to the condition that the proprietor of the registered trade mark complies with subsection (3)(b)(iii) within the prescribed period under subsection (3).

(5) Where the Court has made an order authorising the further detention of goods under subsection (3)(b)—

(a) the detained goods shall be taken to such secure place as the Comptroller directs; and

(b) sections 101, 102 and 104 to 108 shall apply, with the necessary modifications, to the further detention of the goods, and for the purposes of such application—

(i) any reference to the objector shall be read as a reference to the proprietor of the registered trade mark;

(ii) any reference to the importer shall be read as a reference to the exporter or consignee, as the case may be, of the detained goods;

- (iii) any reference to the seized goods shall be read as a reference to the detained goods;
- (iv) any reference to the seizure of goods shall be read as a reference to the detention or to the further detention of the goods;
- (v) any reference to the import or importation of goods shall be read—
 - (A) in the case of goods that are to be exported from Nigeria, as a reference to the export of the goods; or
 - (B) in the case of goods in transit that are consigned to a person with a commercial or physical presence in Nigeria, as a reference to the import or export, of the goods by the consignee;
- (vi) any reference to infringement action shall be read as a reference to an action for the infringement of the registered trade mark under subsection (3)(b)(i); and
- (vii) any reference to the retention period shall be read as a reference to the prescribed period under subsection (3).

Powers of search in relation to vessels, aircraft and vehicles

110. (1) The Comptroller may board any conveyance in Nigeria and may search all parts of the conveyance for goods liable to be seized under section 97 or detained under section 109.

(2) For the more effective exercise of the powers conferred by this section, the Comptroller may do all or any of the following:

- (a) require the master of any vessel in Nigeria to heave to;
- (b) by direction to the master of any vessel or the pilot of any aircraft in Nigeria, require the vessel or aircraft, as the case may be, not to proceed until so authorized;
- (c) require any documents which ought to be on board any vessel or aircraft, being documents relating to any goods therein, to be brought to him for inspection;
- (d) break open and forcibly enter any place or receptacle in any conveyance to which he cannot otherwise reasonably obtain access;
- (e) by direction to the master of any vessel in Nigeria, require the vessel to proceed to any specified anchorage, wharf or place to which the vessel may lawfully go;
- (f) by direction to the master of any vessel in Nigeria, require him to move or discharge any cargo or other goods therein;
- (g) require the person in charge of a vehicle—
 - (i) to stop and not to proceed until so authorised; or
 - (ii) to bring the vehicle to any police station or Customs area;
- (h) direct that the removal of any goods from or placed in any vessel be prohibited until so authorised; and
- (i) require the master of any vessel or the pilot of any aircraft to produce a complete manifest of the whole cargo of the vessel or aircraft and a complete list of stores carried by that vessel or aircraft.

(3) The Comptroller may exercise, in respect of any vehicle or any vessel not exceeding 75 tons net tonnage, the powers which are conferred upon the Comptroller by subsection (2) other than the powers conferred by paragraph (d) of that subsection.

(4) If any vessel or aircraft fails to comply with any lawful requisition or direction given or made under this section, the Comptroller may take all such steps as appear to him to be necessary to secure such compliance.

(5) Any person who contravenes this section or who fails to comply with any lawful requisition or direction given or made thereunder commits an offence and is liable on summary conviction to a fine of two hundred thousand naira and to imprisonment for one year.

(6) The Comptroller may exercise the powers conferred by this section in respect of a vessel under way if he reasonably suspects that it is not in transit through Nigeria.

Examination of packages, etc.

111. (1) Any goods, package, box, chest or other article which is being or has recently been imported and in regard to which a reasonable suspicion exists that it is or that it contains goods liable to be seized under section 97 or detained under section 109 may be—

- (a) examined and searched by the Comptroller;
- (b) subjected to such tests or analysis as the Comptroller thinks fit;
- (c) forcibly opened by, or by order of, the Comptroller to facilitate the examination and search except that any person in charge of the package, box, chest or other article shall be afforded every reasonable facility for being present at the opening, examination and search;
- (d) marked, locked, sealed or otherwise secured by the Comptroller pending examination and search.

(2) Any person, other than the Comptroller, who removes, opens, breaks or tampers with any mark, lock, seal or other means of securing any goods, package, box, chest or other article referred to in subsection (1)(d) commits an offence and is liable on conviction to a fine of two Hundred thousand naira and to imprisonment for one year.

Power to remove packages and goods to police station or Customs area

112. (1) For the more convenient exercise of the powers conferred by section 109, the Comptroller may remove any package, box, chest or other article or any goods to a police station or Customs area or may require it to be so removed by the owner thereof or his agent or any person having the custody, charge or control thereof.

(2) Any person who fails to comply with any such requisition commits an offence and is liable on conviction to a fine of two hundred thousand naira and to imprisonment for one year.

(3) Upon the failure by a person to comply with such a requisition, the Comptroller may remove the goods in the manner provided by subsection (1) and all the expenses of such removal shall be recoverable as a fine from that person or from the owner of the goods.

113. Search of persons and Baggage

(1) Any person landing or being about to land or having recently landed from any vessel or aircraft, or leaving any vessel or aircraft in Nigeria whether for the purpose of landing or otherwise, or entering or having recently entered Nigeria by land, sea or air, shall—

(a) on demand by the Comptroller, either permit his person and goods and baggage to be searched by the Comptroller for any goods liable to be seized under section 97 or detained under section 109 or, together with the goods and baggage, accompany the Comptroller to a police station or an examination station, and there permit his person and goods and baggage to be searched in the presence and under the supervision of the Comptroller for any goods liable to be seized under section 97 or detained under section 109; or

(b) on demand by the Comptroller, permit his person and goods and baggage to be searched by the Comptroller for any goods liable to be seized under section 97 or detained under section 109.

(2) Whenever it is necessary to cause a woman to be searched, the search shall be made by another woman and with strict regard to decency.

(3) The goods and baggage of any person who requests to be present when they are searched shall not be searched in his absence, unless he fails to be present after being given reasonable opportunity to be present.

(4) Any person who refuses to comply with any lawful demand made under this section may be arrested without warrant by the officer making the demand.

Obstruction

114. Any person who—

(a) refuses an Officer access to any vessel, aircraft, vehicle or place which the officer is entitled to under this Part; or

(b) obstructs or hinders an Officer in the execution of any power conferred upon him by this Part, commits an offence and is liable on summary conviction to a fine of five hundred thousand naira and to imprisonment for one year.

115. No action or other legal proceedings shall lie against an Officer for anything which is, in good faith, done or omitted to be done in the exercise of any power, duty or function under this Part.

PART XII

MISCELLANEOUS

Immunity of Officers

116. The Controller may issue Practice Directions relating to the procedures under this Act.

Practice Directions

117. In all legal proceedings relating to a registered trade mark, including proceedings for rectification of the Register—

(a) the register shall be *prima facie* evidence of anything contained therein;

(b) the registration of the prescribed particulars of any registrable transaction under section 41 shall be *prima facie* evidence of the transaction; a

(c) the registration of a person as proprietor of a registered trade mark shall be *prima facie* evidence of—

(i) the validity of the original registration; and

(ii) any subsequent assignment or other transmission of the registration.

Registration to be *prima facie* evidence

118. (1) If in proceedings before the Court the validity of the registration of a trade mark is contested and it is found by the Court that the trade mark is validly registered, the Court may certify to that effect.

(2) If the Court certifies the validity of the registration under subsection (1) and in subsequent proceedings—

(a) the validity of the registration is again questioned; and

(b) the proprietor obtains judgment in his favour, he is entitled to his costs as between Attorney-at-law and client unless the Court directs otherwise.

(3) Subsection (2) does not extend to the costs of an appeal in any such proceedings.

Certificate of validity

119. A certificate purporting to be under the hand of the Controller as to any entry, matter or thing which he is authorised to make or do under this Act, shall be *prima facie* evidence of—

(a) the entry having been made, and of the contents; or

(b) the matter or thing having been done or not done, as the case may be.

Certificate of Controller

120. In all proceedings before the Court under this Act, the Court may award to any party, including the Controller, such costs as it may consider reasonable, but the Controller shall not, except in a case in which he has appeared in the proceedings, be ordered to pay the costs of any other of the parties.

Costs of proceedings before Court

121. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

Burden of proving use of trade mark

122. (1) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of any partner of the partners but without prejudice to any liability of the partners under subsection (3).

(2) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(3) Where a partnership commits an offence under this Act, every partner, other than a partner who is proved to have been ignorant of, or to have attempted to prevent the commission of the offence, also commits the offence and is liable to be proceeded against and punished accordingly.

(4) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate commits the offence and is liable to be proceeded against and punished accordingly.

Regulations

123. The Minister may make Regulations—

(a) for the forms to be used for any purpose relating to the registration of a trade mark other than proceedings before the Controller under this Act;

(b) prescribing fees in respect of applications, registration and other matters under this Act;

(c) for the remission of fees;

(d) in relation to the division of an application for the registration of a trade mark, including the—

(i) circumstances in which the application may be divided;

(ii) conditions to be satisfied before a request for the division may be granted; and

(iii) effect of dividing the application;

(e) for the classification of goods and services for the purposes of the registration of trademarks;

(f) to provide that a sign specified shall not be registered as a trade mark, or shall not be so registered unless such conditions as may be prescribed are satisfied;

(g) for the manner of claiming priority under section 11;

(h) to provide for opposition proceedings and for related matters;

(i) in relation to amendments to applications and the making of objections to such amendments;

(j) for the issuance of notices with respect to the expiration and renewal of the registration of trade marks;

(k) to provide for the restoration of the registration of a trade mark which has been removed from the Register;

(l) for the publication of an alteration of a registered trade mark and the making of objections by any person claiming to be affected by it;

(m) to provide for the manner and effect of a cancellation of a registered trade mark;

(n) for protecting the interests of persons having a right in a registered trade mark that is cancelled;

(o) for the publication and entry in the Register of a disclaimer or limitation;

(p) for the amendment of registered particulars relating to a licence;

(q) as to the removal of particulars from the register—

(i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or

(ii) where no fixed period is indicated and, after such period as may be prescribed, the Controller has notified the parties of his intention to remove the particulars from the register;

- (r) for the amendment of, or removal from, the Register of particulars relating to a security interest;
- (s) for the publication by the Controller of the particulars of any application for the registration of a trade mark, including a representation of the mark, and such other information relating to trademarks as the Controller thinks fit;
- (t) for the times at which, and the manner in which, notices are to be given under this Act;
- (u) for the practice and procedure of any proceedings or other matter before the Controller;
- (v) for the manner of filing of applications or other documents;
- (w) requiring persons to make statutory declarations in support of any application, notice or request;
- (x) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (y) for the service of documents;
- (z) for the rectification of irregularities of procedure;
- (aa) for time limits and extensions thereto for anything required to be done in connection with any proceedings under this Act;
- (ab) for the giving of evidence in proceedings before the Controller;
- (ac) for the reinstatement of—
 - (i) any application which is treated as withdrawn; or
 - (ii) a trade mark, and the conditions for such reinstatement; and
- (ad) generally for carrying out the provisions of this Act.

PART XIII

TRANSITIONAL

Interpretation of Part XIII (Transitional)

124. (1) In this Part—

“existing registered mark” means a mark or certification mark registered under the former Act immediately before the commencement of this Act.

(2) For the purposes of this Part—

(a) an application under the former Act shall be treated as pending on the date of the commencement of this Act if it was made but not finally determined before that date; and

(b) the date on which an application under the former Act was made shall be the date of filing under the former Act.

Existing registered trade marks

125. (1) Any existing registered mark, whether registered in Part A or B of the Register kept under the former Act, is a registered trade mark for the purposes of this Act.

(2) Any existing registered mark registered as a certification trade mark in the Register kept under the former Act is a registered certification mark for the purposes of this Act.

(3) Any existing registered mark registered as a series of trade marks in the Register kept under the former Act is registered as a series of trade marks in the Register for the purposes of this Act.

(4) Any entry in the Register kept under the former Act indicating that an existing registered mark is associated with any other mark shall cease to have effect on the commencement of this Act.

(5) A condition entered on the Register kept under the former Act in relation to an existing registered mark immediately before the commencement of this Act shall cease to have effect on the commencement of this Act.

(6) Notwithstanding section 141, proceedings under section 47 of the former Act which are pending immediately before the commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.

(7) A disclaimer or limitation entered on the Register kept under the former Act in relation to an existing registered mark immediately before the commencement of this Act shall be deemed to be transferred to the Register and have effect as if entered on the Register in pursuance of section 31.

Effects of registration infringement

126. (1) Sections 27 to 30 apply in relation to an existing registered mark as from the commencement of this Act and subject to subsection (3), section 32 applies in relation to infringement of an existing registered mark committed on or after the commencement of this Act.

(2) Notwithstanding section 141, the former Act continues to apply in relation to infringements committed before the commencement of this Act.

(3) It is not an infringement of—

(a) an existing registered mark; or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services, to continue on or after the commencement of this Act, any use which did not amount to infringement of the existing registered mark under the former Act.

Infringing goods, materials or articles

127. Section 34 shall apply to infringing goods, material or articles whether made before, on or after the commencement of this Act.

Rights and remedies of licensee or authorised user

128. (1) Section 46 shall apply to licences granted before the commencement of this Act, but only in relation to infringements committed on or after the date of commencement.

(2) Section 80(2) applies only in relation to infringements committed on or after the commencement of this Act.

Co-ownership of registered mark

129. (1) Subject to subsection (2), the provisions of section 39 apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before that date registered as joint proprietors.

(2) Where the relations between the joint proprietors remain as described in section 68 of the former Act there shall be taken to be an agreement to exclude the operation of section 39(1) and (3).

Assignment of registered mark

130. (1) Section 40 shall apply to transactions and events occurring on or after the date of commencement of this Act in relation to an existing registered mark and notwithstanding section 141, the former Act continues to apply in relation to transactions and events occurring before that date.

(2) Entries in the Register kept under the former Act relating to the assignment and transmission of registered marks and of applications for registration of marks shall be deemed to be transferred on commencement of this Act to the Register and have effect as if made under section 41.

(3) Provision may be made by Regulations for putting entries referred to in subsection (2) in the same form as is required for entries made under this Act.

(4) An application for registration under section 34 of the former Act which has not been determined by the Controller before the commencement of this Act, shall be treated as an application for registration under section 41.

(5) The Controller may require the applicant to amend his application so as to conform with the requirements of this Act.

- (6) An application for registration under section 34 of the former Act which has been determined by the Controller but not finally determined before the commencement of this Act shall notwithstanding section 141, be dealt with under the former Act and subsections (2) and (3) shall apply in relation to any resulting entry in the Register.
- (7) Where, before the date of commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration on or after that date shall be made under section 41.

Licensing of registered trade mark

131. (1) Section 44 shall apply only in relation to licences granted on or after the commencement of this Act and notwithstanding section 141, the former Act continues to apply in relation to licences granted before the commencement of this Act.
- (2) Existing entries under section 37 of the former Act shall be deemed transferred on the commencement of this Act to the Register and have effect as if made under section 41.
- (3) Provision may be made by Regulations for putting entries referred to in subsection (2) in the same form as is required for entries made under this Act.
- (4) An application under the former Act for registration as a registered user which is pending before the Controller immediately before the commencement of this Act shall be treated as an application for registration of a licence under section 41(1).
- (5) The Controller may require the applicant to amend his application so as to conform with the requirements of this Act.
- (6) An application for registration as a registered user which has been determined by the Controller but not finally determined before the date of commencement of this Act shall be dealt with under the former Act and subsections (2) and (3) shall apply in relation to any resulting entry in the Register.
- (7) Any proceedings pending immediately before the commencement of this Act under section 41 of the former Act shall be dealt with under the former Act and any necessary alteration made to the Register.

Pending applications for registration

132. (1) Subject to section 133, an application for registration of a mark under the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and, if registered, the mark shall be treated for the purposes of this Part as an existing registered mark.
- (2) The power of the Minister under section 123 to make Regulations regulating practice and procedure is exercisable in relation to an application referred to in this section.
- (3) Section 32 of the former Act shall be disregarded in dealing with an application for registration on or after the commencement of this Act.

Conversion of pending application

133. (1) In the case of an application for registration of a trade mark under the former Act which—
- (a) has not been advertised under section 20 of the former Act; and
- (b) is pending, immediately before the commencement of this Act, the applicant may give notice to the Controller to have the registrability of the mark determined in accordance with the provisions of this Act.
- (2) The notice under subsection (1) shall be—
- (a) in the prescribed form;
- (b) accompanied by the prescribed fee; and
- (c) given no later than six months after the commencement of this Act.
- (3) A notice under this section is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

Claim to priority from overseas application

134. (1) Section 12 applies to an application for registration made on or after the commencement of this Act notwithstanding that the Convention application was made before the commencement of this Act.

(2) Where, before the commencement of this Act, a person has duly filed an application for protection of a trade mark in a foreign State, to which section 76 of the former Act applies, which is not a Convention country (referred to in this paragraph as a "relevant overseas application"), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application.

(3) If the application for registration under this Act is made within the six-months period referred to in subsection (2)—

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the relevant overseas application; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in Nigeria in the period between the date of filing of the relevant overseas application and the date of the application under this Act.

(4) Any filing which in a foreign State referred to in subsection (2) is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be deemed to give rise to the right of priority.

(5) For the purposes of subsection (4), a "regular national filing" means a filing which is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application of the former Act and subsections (2) and (3).

(6) A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, shall be considered the relevant overseas application, of which the filing date is then starting date of the period of priority; if at the time of the subsequent application—

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) it has not yet served as a basis for claiming a right of priority, and the previous application may not thereafter serve as a basis for claiming a right of priority.

(7) The Minister may make Regulations to provide for the manner of claiming a right to priority on the basis of a relevant overseas application.

(8) A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (2) to the applicant's "successor in title" shall be construed accordingly.

(9) Nothing in this section shall affect proceedings on an application for registration under the former Act made before the commencement of this Act.

Renewal of registration

135. Notwithstanding section 141, section 20 applies where the renewal of an existing registered mark falls due on or after the commencement of this Act and the former Act continues to apply in any other case.

Pending application for registration for alteration of registered mark

136. An application under section 49 of the former Act which is pending on the date of commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.

Revocation for non-use

137. (1) An application under section 35 of the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.
(2) Subject to subsection (3), an application under section 23(1)(a) or (b) may be made in relation to an existing registered mark at any time on or after the commencement of this Act.
(3) No application referred to in subsection (2) for the revocation of the registration of an existing registered mark registered under section 13A of the former Act may be made until more than five years after the commencement of this Act.

Application for rectification and correction

138. (1) An application under section 46 or section 48 of the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and any necessary alteration made to the Register.
(2) An application under section 24 of this Act may be made in relation to an existing registered mark at any time on or after the commencement of this Act and the provisions of this Act shall be deemed to have been in force at all material times.

Rules as to use of certification mark

139. (1) Rules governing the use of an existing registered certification mark submitted to the Controller in pursuance of section 50 of the former Act shall be treated after the commencement of this Act as if filed under section 75.
(2) Any request for amendment of the rules which was pending on the commencement of this Act shall be dealt with under the former Act.

Certificate of validity

140. A certificate given before the commencement of this Act under the former Act shall have effect as if given under section 118.

PART XIV

REPEAL

141. The Trade Marks Act Cap T13 Laws of the Federation of Nigeria 2004 is hereby repealed.

Explanatory Memorandum.

This Bill seeks to repeal the Trade Marks Act Cap T13 Laws of the Federation of Nigeria 2004 and enact the Trade Marks 2016 to provide for a comprehensive law relating to trademarks in Nigeria.