

# Challenges of Transnational Trademark Law Practice: The Case of Nigerian Companies' Brands in OAPI States

Caroline Joëlle Nwabueze

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## Résumé de l'article

La croissance industrielle du Nigeria a fait de ce pays un soutien économique indispensable pour ses voisins. Pour ne citer que l'exemple du Cameroun, le Nigeria en a été le principal fournisseur avec respectivement 22 % et 17,8 % des importations en 2011 et 2012 et des importations dont la valeur s'élève à 328 milliards fr. cfa par année. Ceci résulte en partie des exportations des compagnies nigérianes vers les marchés locaux. Les marques de commerce nigérianes dans le domaine des cosmétiques, des meubles et des produits électroniques et pharmaceutiques abondent dans les pays voisins. Cependant, le renforcement des compagnies nigérianes dans les marchés régionaux englobe des stratégies pour éviter d'enfreindre les droits de propriété industrielle et commerciale. Dans le cadre de ces stratégies, les différentes institutions qui régissent la propriété intellectuelle (PI) dans les marchés d'exportation des pays voisins pertinents devraient prendre en compte des caractéristiques particulières relatives aux marques de commerce. Ne serait-ce que du simple fait que le statut juridique de ces produits, bien qu'ils soient des biens physiques, repose principalement sur le droit substantiel applicable, le droit de la marque de commerce dans ce cas. Parce que le principe de territorialité nécessite que la protection de la marque de commerce soit demandée dans le territoire où les biens sont vendus, et que cette protection doit être demandée dans chaque pays individuellement, les compagnies nigérianes qui prévoient externaliser des activités commerciales dans des marchés voisins chercheront à se conformer aux normes en matière de marques de commerce qui sont applicables au sein de l'Organisation africaine de la propriété intellectuelle (OAPI), dont font partie le Bénin, le Cameroun, le Tchad et la Guinée. Le partenariat commercial entre des entreprises soulève inévitablement, et ce, tant du point de vue de la common law que celui du droit civil, des frictions et des problèmes lorsqu'il s'agit de marques de commerce. Le présent article analyse les défis relatifs aux marques de commerce découlant de la décision commerciale des entreprises nigérianes de faire leur entrée dans les marchés de l'OAPI et d'y exporter des biens et services. L'article souligne premièrement les problèmes qui doivent être pris en considération, dont l'inscription et la mise en application des marques des entreprises membres de l'OAPI. Ensuite, ce texte examine simultanément les problèmes résultant des différences entre la *Nigerian Trademark Act* et le système de marques de commerce de l'OAPI, système auquel les entreprises nigérianes sont confrontées. Si la protection des marques de commerce facilite l'accès aux marchés transnationaux pour les entreprises, la mise en place, avec les pays voisins, d'une communauté en matière de marques de commerce aide assurément les industries nationales à établir des partenariats avec d'autres entreprises dans le but d'assurer un développement durable dans des domaines tels que la production, la commercialisation, la distribution ou la livraison de biens et services. À la lumière de l'harmonisation des marques de commerce dans le marché intérieur de l'Union européenne, le présent article conclut en recommandant la création d'une communauté de marques de commerce dans la région de l'Afrique occidentale et centrale, et qui réunirait le Nigeria et ses pays voisins.

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## Challenges of Transnational Trademark Law Practice: The Case of Nigerian Companies' Brands in OAPI States

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CAROLINE JOËLLE NWABUEZE\*

### ABSTRACT

*Nigeria industrial growth has turned the country into an indispensable economic support for its neighbours. Only for the case of Cameroon, Nigeria has been the leading supplier with respectively 22% and 17.8% of imports in 2011 and 2012 with trade amounting to 328 billion FCFA per annum.<sup>1</sup> This results in part from Nigerian companies' exportations in local markets. Nigerian trademarks related to cosmetics, furniture, electronics, and pharmaceutical goods abound in neighbouring countries. However, a strengthening of Nigerian companies in regional markets encompasses strategies to avoid infringing on the trademark rights. Such strategies should include the consideration of special trademarks features by different institutions of the intellectual property (IP) system in the relevant neighbour export markets. This is by the mere fact that the legal status of those goods, although physical property, relies mainly on the material law applicable, which is trademark in the present case.<sup>2</sup> Because the principle of territoriality requires that trademark protection be sought in the place where the goods are sold—and trademark applications filed in each country in which protection is sought—, Nigerian companies planning to outsource some business activity in neighbour markets will seek compliance with trademarks norms applicable in the Organisation africaine de la propriété intellectuelle (OAPI) of which those countries—Benin, Cameroon, Chad, and Guinea—are part. The trade partnership between companies from a common law trademark background on one hand, and civil law intellectual property community on the other, inevitably raises some frictions and trademarks issues. This article analyses the trademark challenges arising from Nigerian companies' business decision to enter OAPI markets and export*

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\* Dr. (Mrs.) Caroline Joëlle Nwabueze is holder of a PhD in law with First Class Honours from Douala University, Cameroon. She is currently Dr. (iur) Candidate, of the European Union at Bern University, Switzerland. Graduate from the WIPO LL.M. Course in intellectual property from Turin University in Italy. Dr. Nwabueze is equally holding a Master in international law from Handong International Law School in South Korea. Specialist in intellectual property and international law, she is lecturer in law at the Faculty of Law, Enugu State University of Science and Technology, Agbani, Nigeria.

1. Business in Cameroon, online: Business in Cameroon <<http://www.businessincameroon.com/publicmanager>>.

2. See Nicolas Bouche, *Le principe de territorialité de la propriété intellectuelle*, coll "Logiques Juridiques" (Paris: L'Harmattan, 2002) 387 at para 732.

goods and services. The article firstly underlines the issues to be taken into consideration, including registration and enforcement of the companies' marks in OAPI. Then the paper simultaneously reviews the dissimilarities issues between the Nigerian Trademark Act and the OAPI Trademark System to which the Nigerian companies are confronted. If trademark protection makes it easier for an enterprise to access transnational markets, the establishment of a Trademark Community with neighbouring countries helps for sure national industries to establish partnerships with other firms for sustainable development in the areas such as production, marketing, distribution or delivery of goods and services.<sup>3</sup> In light of the trademark harmonisation in the European Union internal market,<sup>4</sup> the present paper concludes by recommending the creation of a Trademark Community in the West and Central African region between Nigeria and its neighbouring countries.

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**KEY-WORDS:**

*Transnational trade, trademark practice, western Africa, OAPI, Nigerian companies, principle of territoriality, intellectual property rights, enforcement, community trademark.*

**RÉSUMÉ**

La croissance industrielle du Nigeria a fait de ce pays un soutien économique indispensable pour ses voisins. Pour ne citer que l'exemple du Cameroun, le Nigeria en a été le principal fournisseur avec respectivement 22 % et 17,8 % des importations en 2011 et 2012 et des importations dont la valeur s'élève à 328 milliards fr. cfa par année<sup>1</sup>. Ceci résulte en partie des exportations des compagnies nigérianes vers les marchés locaux. Les marques de commerce nigérianes dans le domaine des cosmétiques, des meubles et des produits électroniques et pharmaceutiques abondent dans les pays voisins. Cependant, le renforcement des compagnies nigérianes dans les marchés régionaux englobe des stratégies pour éviter d'enfreindre les droits de propriété industrielle et commerciale. Dans le cadre de ces stratégies, les différentes institutions qui régissent la propriété intellectuelle (PI) dans les marchés d'exportation des pays voisins pertinents devraient prendre en compte des caractéristiques particulières relatives aux marques de commerce. Ne serait-ce que du simple fait que le statut juridique de ces produits, bien qu'ils soient des biens physiques, repose principalement sur le droit substantiel applicable, le droit de la marque de commerce dans ce cas<sup>2</sup>. Parce que le principe de territorialité nécessite que la protection de la marque de commerce soit demandée dans le territoire où les biens sont vendus, et que cette protection doit être

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3. IP and International Trade, *Module 9 – IP Panorama: Intellectual Property and International Trade* (Korean Intellectual Property Office, 2013) at 5, online: World Intellectual Property Organization [WIPO] <[http://www.wipo.int/export/sites/www/sme/en/documents/pdf/ip\\_panorama\\_9\\_learning\\_points.pdf](http://www.wipo.int/export/sites/www/sme/en/documents/pdf/ip_panorama_9_learning_points.pdf)> [IP Panorama].

4. Office for Harmonization in the Internal Market, *Trade Marks, Designs and European Union OHIM*, online: <<https://oami.europa.eu/ohimportal/en/trade-marks>>.

demandée dans chaque pays individuellement, les compagnies nigérianes qui prévoient externaliser des activités commerciales dans des marchés voisins chercheront à se conformer aux normes en matière de marques de commerce qui sont applicables au sein de l'Organisation africaine de la propriété intellectuelle (OAPI), dont font partie le Bénin, le Cameroun, le Tchad et la Guinée. Le partenariat commercial entre des entreprises soulève inévitablement, et ce, tant du point de vue de la common law que celui du droit civil, des frictions et des problèmes lorsqu'il s'agit de marques de commerce. Le présent article analyse les défis relatifs aux marques de commerce découlant de la décision commerciale des entreprises nigérianes de faire leur entrée dans les marchés de l'OAPI et d'y exporter des biens et services. L'article souligne premièrement les problèmes qui doivent être pris en considération, dont l'inscription et la mise en application des marques des entreprises membres de l'OAPI. Ensuite, ce texte examine simultanément les problèmes résultant des différences entre la Nigerian Trademark Act et le système de marques de commerce de l'OAPI, système auquel les entreprises nigérianes sont confrontées. Si la protection des marques de commerce facilite l'accès aux marchés transnationaux pour les entreprises, la mise en place, avec les pays voisins, d'une communauté en matière de marques de commerce aide assurément les industries nationales à établir des partenariats avec d'autres entreprises dans le but d'assurer un développement durable dans des domaines tels que la production, la commercialisation, la distribution ou la livraison de biens et services<sup>3</sup>. À la lumière de l'harmonisation des marques de commerce dans le marché intérieur de l'Union européenne<sup>4</sup>, le présent article conclut en recommandant la création d'une communauté de marques de commerce dans la région de l'Afrique occidentale et centrale, et qui réunirait le Nigeria et ses pays voisins.

MOTS-CLÉS :

Commerce transnational, pratiques en matière de marques déposées, Afrique occidentale, OAPI, compagnies nigérianes, principe de territorialité, droits de propriété intellectuelle, mise en œuvre, communauté de marques de commerce.



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## INTRODUCTION

Nigeria is the largest economy in Africa, on track to become one of the 20 largest economies in the world by 2020.<sup>5</sup> Its manufacturing sector is the third-largest on the continent, and produces a large proportion of goods and services for the West African region.<sup>6</sup> Trade between Nigeria and its neighbours in West Africa (Niger and Benin) and in Central Africa (Cameroon, Chad, and Equatorial Guinea) is intense and long-standing. This trade involves primarily agricultural products and manufactured goods, in large part hydrocarbons,<sup>7</sup> and comprises 3 to 4 percent of total trade.<sup>8</sup> For the past few years those neighbouring countries' markets have witnessed the carrying on of business transactions devised across national borders to satisfy the regional objectives of Nigerian companies. These transactions often revolve around the integration of national marks into the regional economy through trade, and the capital flows. As a consequence, regional

5. Based on rebased figures announced in April 2014. See "Economy of Nigeria", online: Wikipedia <[en.wikipedia.org/wiki/Economy\\_of\\_Nigeria](http://en.wikipedia.org/wiki/Economy_of_Nigeria)>.

6. *Ibid.*

7. Bio Goura Soulé, "The Agro-Pastoral Product Trade with Neighbouring Countries: What's at Stake?" (2010) 51 Grain de sel 23 (Special Issue: Nigeria).

8. Mongabay, *Nigeria-Foreign Trade Foreign Trade and Balance of Payments*, online: Mongabay <<http://www.mongabay.com/history/nigeria>>.

markets are permanently exposed to hundreds of Nigerian trademarks granted by the relevant Nigerian trademark authority.<sup>9</sup>

The trademark certificate of registration issued to the applicant upon registration gives him the exclusive rights to the use of the trademark in relation to his goods. According to the principle of territoriality, the scope of protection of a trademark right delivered by the Nigerian Registry is limited to the State territory as authority where the right has been granted. Meanwhile, neighbouring countries Benin, Cameroon, Chad, Equatorial Guinea and Niger are part of the Organisation africaine de la propriété intellectuelle (OAPI), the African intellectual property organisation which ensures the protection of intellectual property rights in most African French-speaking countries.<sup>10</sup> OAPI introduced a uniform law on trademark for all its Member States.<sup>11</sup> As corollary, exist alongside each other in the regional market independent, national and regional trademarks rights' protection subject to different legal regimes. Firstly, Nigerian trademarks issued by the Trademarks, Patents and Designs Registry under the Commercial Law Department of the Federal Ministry of Trade and Investment in Abuja, Nigeria, and recognizing Nigerian companies' exclusive rights to the use of trademark in relation to their goods on the Nigerian territory.<sup>12</sup> On another side, regional trademark rights are issued by OAPI common industrial property law office in Yaoundé, Cameroon, and territorially competent to rule over trademarks matters in Nigeria neighbouring countries. Trademark protection is, quintessentially, territorial. That is because a trademark registration is a property right that protects a sign in a defined territory.<sup>13</sup> The trade expansion of Nigerian companies in neighbouring OAPI markets is therefore inevitably confronted to the territoriality of intellectual property rights, which do raise numerous transnational issues in the regional trademark practice. This paper

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9. *Trademarks, Patents and Designs Registry Under the Commercial Law Department of the Federal Ministry of Industry, Trade and Investment, Federation of Nigeria*, online: <<http://88.150.164.30/lpoNigeria/#/>>.

10. OAPI is composed of 17 Member States: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo. OAPI headquarters are located in Yaoundé, Cameroon.

11. See World Intellectual Property Organization, *Background information on Member States of OAPI*, online: WIPO <<http://www.wipo.int/wipolex/en/outline/oapi.html>>.

12. *Trade Marks Act*, Cap T13 LFN 2004, ss 5(1), 43(1).

13. See European Union Case: *Leno Marken BV v Hagelkruis Beheer BV*, C-149/11 (5 July 2012) (AG Sharpston) at para 1.

reviews the challenges related to marks recognition and enforcement as a result of the territorial conception of Nigeria and OAPI countries' national/regional marks and international intellectual property protection. The paper examines two underlying international conventions in the field—the *Paris Convention for the Protection of Industrial Property*<sup>14</sup>, and the *Agreement on Trade-Related Aspects of Intellectual Property Rights*<sup>15</sup>—, and the national/regional laws governing the protection of intellectual property rights. Two statements are common ground: firstly, the applicable law to the protection of the right; and secondly, the jurisdiction where the right is protected.<sup>16</sup> The present research underlines in the first part the conditions of protection and trademark rights conferred within Nigeria and OAPI, as well as their limitations. In the second part, the paper analyzes the issues related to the enforcement of those trademark rights according to the jurisdiction where the right is protected and the place of infringement. Finally, the paper concludes by giving some recommendations for a proper management of Nigerian brands within OAPI market.

## I. MANAGEMENT OF NIGERIAN BRANDS' RECOGNITION WITHIN NEIGHBOURING OAPI COUNTRIES

Marketing strategies usually imply brands development to attract customer's attention. The value of brands has different interpretations: firstly from marketing or consumer perspective, the promise and delivery of an experience; secondly from a business perspective, the security of future earnings; and thirdly from a legal perspective, a separable piece of intellectual property.<sup>17</sup> Regional business development in Central and Western African regions by Nigerian companies do raise several issues within the spectrum of brand recognition. Intellectual property is for sure the cornerstone for the security and earning of Nigerian companies business abroad. Effective trademark management

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14. *Paris Convention for the Protection of Industrial Property* of March 20, 1883 [*Paris Convention*].

15. *Agreement on Trade-Related Aspects of Intellectual Property Rights* (Annex 1C to the Agreement establishing the World Trade Organization of 15 April 1994) [*TRIPS Agreement*].

16. See in this sense Alexander von Mühlendahl & Dieter Stauder, "Territorial Intellectual Property Rights in a Global Economy – Transit and Other 'Free Zones'" in Wolrad Prinz zu Waldeck und Pymont et al, eds, *Patents and Technological Progress in a Globalized World*, coll "MPI Studies on Intellectual Property, Competition and Tax Law, vol 6" (Berlin: Springer, 2009) 653.

17. IP Panorama, *supra* note 3.

and enforcement mechanisms are therefore indispensable. The goal is to enable greater global business cooperation and a mutually beneficial investment climate.<sup>18</sup>

## A. Mandatory territorial registration

For Nigerian companies to benefit from brand proposition and developments of brand preference in the regional market, those brands should be legally protected. Intellectual property rights do not extend beyond the territory of the sovereign which has granted the rights in the first place.<sup>19</sup> The principle of territoriality forms the basis for international trade and trademark protection as regulated under the *Paris Convention for the Protection of Industrial Property* of 20 March 1883, and the 1995 *Agreement on Trade Related Aspects of Intellectual Property Rights* of April 15, 1994, OAPI Member States and Nigeria are equally parties to both treaties.<sup>20</sup> Those international intellectual property conventions regulate the protection of both Nigerian and OAPI trademarks abroad. Article 24 of the *Paris Convention* is the basic law of international industrial property protection. The convention requires any country to declare in its instrument of ratification or accession, that this convention's provisions shall be applicable to all or part of its designated territories, for the external relations of which it is responsible.<sup>21</sup>

After the entry into force of the *Paris Convention* in Nigeria on 2 September 1963,<sup>22</sup> the provisions of territorial rights contained in the *Paris Convention* were implemented into the national legal framework. The *Nigerian Trademark Act* stipulates to this effect that:

The application in Nigeria of a trade mark to goods to be exported from Nigeria, and any other act done in Nigeria in relation to goods to be so exported which, if done in relation to

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18. See on this issue: Dominic E Obozuwa, *Enforcement of Foreign Judgments and Regulating Fiduciary Services in Nigeria in Furtherance of Enhancing International Commerce, Trade and Investments*, online: Wali-Uwais & Co <[http://www.wali-uwais.com/?page\\_id=778](http://www.wali-uwais.com/?page_id=778)>.

19. See Peter Drahos & Herchel Smith, "The Universality of Intellectual Property Rights: Origins and Development" in *Intellectual Property and Human Rights* (WIPO No 762 (E), 1998) at 6.

20. See Contracting Parties of *Paris Convention* in "WIPO-Administered Treaties" online: WIPO <[http://www.wipo.int/treaties/en/ShowResults.jsp?treaty\\_id=2](http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2)> [WIPO-Administered Treaties]. See also Contracting Parties of Agreement on Trade-Related Aspects of Intellectual Property Rights (*TRIPS Agreement*) in "Other IP Treaties" online: WIPO <[http://www.wipo.int/wipolex/en/other\\_treaties/parties.jsp?treaty\\_id=231&group\\_id=22](http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22)>.

21. *Paris Convention*, *supra* note 14, s 24(1).

22. WIPO-Administered Treaties, *supra* note 20.



goods to be sold or otherwise traded in within Nigeria would constitute use of a trade mark therein, shall be taken to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.<sup>23</sup>

The Registrar of Trademarks is the administrative head of the Trade-marks Registry in Nigeria, competent to issue to the applicant of a trademark a certificate of registration.<sup>24</sup> Upon recognition, the owner of a trademark generally has the exclusive rights to use the trademark in relation to his goods in the country.<sup>25</sup> The territoriality of the so conferred trademark right justifies the exclusive jurisdiction of the Nigerian authorities as granting State with respect to questions related to the existence and validity of the trademark right on the Nigerian territory.<sup>26</sup> As supplement to the *Paris Convention*, the *TRIPS Agreement* regulates the protection of Nigerian trademarks abroad. Article 1(3) declares in this sense that:

Members shall accord the treatment provided for in this Agreement to the nationals of other Members. In respect of the relevant intellectual property right, the nationals of other Members shall be understood as those natural or legal persons that would meet the criteria for eligibility for protection provided for in the Paris Convention (1967) [...] <sup>27</sup>.

The principle of “National Treatment” so enunciated requires that, in dealing with matters falling within the purview of the Convention, such as the registration of trademarks, States parties to the *Paris Convention* be mandated “to treat the citizens of other Member States the way it treats its own citizens without any form of discrimination, provided that those foreigners fulfils the conditions imposed by the States concerned on its own citizens.”<sup>28</sup>

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23. *Trade Marks Act*, *supra* note 12, s 37.

24. *Ibid*, s 22(3).

25. *Ibid*, s 5(1). The registration of a person as proprietor of a trade mark in respect of any goods gives to that person the exclusive right to the use of the trademark in relation to those goods.

26. Drahos & Smith, *supra* note 19.

27. *TRIPS Agreement*, *supra* note 15, art 1(3).

28. Quoted by Templars, *The Legal Regime for International Trade Mark Protection: An Introduction*, 2014 at 10, online: Templars Law <<http://www.templars-law.com/media/publications/Nigeria%20and%20Madrid%20Protocol%20revised.pdf>>.

Since the marks granted by the Nigerian Trademark Registry are intellectual property rights protected only within and in accordance with the legal rules of the Nigerian jurisdiction where they have been granted, a national company using a registered trademark in relation to his goods and willing to reach out neighbouring OAPI States' markets must seek protection under the OAPI System of which all neighbouring countries are part.<sup>29</sup>

OAPI trademark protection can be obtained through registration, by filing the appropriate application form with the regional Intellectual Property located in Yaoundé, Cameroon, and paying the required fees.<sup>30</sup> A single registration in OAPI System has the advantage to provide legal certainty for Nigerian companies in the marketplace of the neighbouring Chad, Guinea, Cameroon, and Niger. This will reinforce the position of the companies as right holder, for example, in case of litigation. The mark registration is the only channel through which Nigeria companies could be conferred the exclusive right to use inside those OAPI countries their marks in connection with their goods or services.<sup>31</sup> OAPI policy made it clear in Annex II of the *Bangui Agreement* regulating trademarks that foreigners shall enjoy the benefits of the Act if they fulfill the conditions imposed by it.<sup>32</sup>

## B. Rights conferred in neighbouring countries and dissimilarities

The *Bangui Agreement* as revised on 24 February 1999 is the law regulating intellectual property related to matters in OAPI Member States. *Bangui Agreement* acts as a common code of intellectual property as the principles and provisions of the Agreement have the force of national laws in each Member State. The path to acquisition and subsistence of trademark rights by Nigerian companies willing to secure their interests in the OAPI System is paved with important challenges as regards to the scope of rights. By virtue of the territoriality of trademarks, the area of rights conferred to Nigerian companies'

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29. See in this sense von Mühlendahl & Stauder, *supra* note 16.

30. *Bangui Agreement Relating to the Creation of an African Intellectual Property Organization, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property (Official translation)*, 2 March 1977, TRT/OA002/001 [*Bangui Agreement*], Annex III, art 8.

31. *Ibid*, 1999, art 7(1).

32. *Ibid*, art 4.

trade activities in OAPI is defined by the *Bangui Agreement*. This includes at the same time a reference to the legal rules governing their protection. As a corollary, the authorities of the OAPI jurisdictions where the trademark has been registered have exclusive competence for decisions regarding its validity in Member States. A number of limitations arise as regards to the OAPI jurisdiction under which the rights are protected.

Nigerian law provides that a trademark can be registered only for goods or classes of goods in respect of which the owner of the mark has acquired or intends to acquire a reputation for dealing in within Nigeria.<sup>33</sup> Where therefore goods are dealt in outside Nigeria, only a trademark in respect of such goods cannot be registered in Nigeria unless the owner of the mark has the intention to deal in those goods within Nigeria. However, in practice, the Trademarks Registry does not require applicants to produce evidence of such intention.<sup>34</sup> Companies involved in regional business usually register their marks at the national level.<sup>35</sup> The subsequent registration in OAPI unveils several conflicting features in both systems.

### 1. Well-known marks protection

The *Nigerian Trademark Act* states that a trademark is a mark used in relation to goods for the purpose of indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user of the mark, whether with or without any indication of the identity.<sup>36</sup> The *Paris Convention* to which both OAPI and Nigeria nations are parties requests States parties to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits

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33. *Trade Marks Act*, *supra* note 12.

34. Quoted by AElex Legal Practitioners and Arbitrators, *Nigeria – Issues in Intellectual Property Law in Nigeria*, online: AElex Legal Practitioners & Arbitrators <[http://www.aelex.com/media/archive/article\\_intellectual.pdf](http://www.aelex.com/media/archive/article_intellectual.pdf)>.

35. See for e.g. the case of South Korean local textiles producers involved in Asian regional and registering their appellations of origin at the national level. Quoted by Caroline Joëlle Nwabueze, "The Role of Intellectual Property in Safeguarding Intangible Cultural Heritage in Museums" (2013) 8 *IJH* 181.

36. *Trade Marks Act*, *supra* note 12, s 67.

of this Convention and used for identical or similar goods.<sup>37</sup> Well-known marks are justified on the grounds that a trademark that has acquired goodwill and a reputation in a use in a Member country ought to give rise to a right for its owner.<sup>38</sup>

OAPI has implemented the protection of the owner of a well-known mark within the meaning of article 6*bis* of the *Paris Convention*, and article 16(2) of the *TRIPS Agreement*.<sup>39</sup> In OAPI, the owner has the right to apply to the court for the invalidation, on the national territory of one of the Member States, of the effects of the filing of a mark liable to be confused with his own.<sup>40</sup>

Nigeria is applying a lower standard in the context of well-known marks protection. The protection of well-known marks in the country is limited to registered trademark consisting of an *invented word* or *words* which has become so well known, that its use by other persons in relation to other goods, "would be likely to be taken as indicating a connection in the course of trade"<sup>41</sup> between those other goods and the owner of the well-known mark. The owner may apply for defensive registration to use the trademark in respect of the familiar goods. The *Nigerian Trademark Act* therefore excludes other categories of marks and also services from the scope of well-known marks. Secondly, the protection envisaged under the Act for well-known words used as trademarks is a defensive registration, not invalidation in case of infringement. This regulation cannot be said to be in conformity with the *TRIPS Agreement* which specifically mentioned that article 6*bis* of the *Paris Convention* (1967) shall apply, *mutatis mutandis*, to services.<sup>42</sup> Also, article 6*bis* did not restrict the scope of understanding of well-known marks. The convention only defines well-known marks as marks well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. A common understanding of *Paris Convention*

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37. *Paris Convention*, *supra* note 14, art 6*bis*(1).

38. See Frederick Abbot, Thomas Cottier & Francis Gurry, *International Intellectual Property in an Integrated World Economy* (Wolter Kluwer, Law & Business, Aspen Publishers, 2007) at 293.

39. *TRIPS Agreement*, *supra* note 15, art 16(2) mentions that "[i]n determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark."

40. *Bangui Agreement*, *supra* note 30, Annex III, art 6.

41. *Trade Marks Act*, *supra* note 12, s 32(1).

42. *TRIPS Agreement*, *supra* note 15, art 16(2).

and *TRIPS Agreement* invites countries to refuse or to cancel the registration, and to prohibit the use, of all types of marks and services—or essential part of it—which constitute a reproduction, an imitation, or a translation, liable to create confusion.

Nigeria however grants to other trademarks the distinctiveness through use. This is the case where the trademark has been used in such a manner as to become so associated with a particular good or service. The law is, however, silent on the number of years of use and advertising that would be required to acquire distinctive character.

## 2. *Services marks and Nice International Classification for Goods and Services*

As trademark registration grants a monopoly to the owner to use the mark, the object of such exclusive right must be restricted to a specific class of goods or services in most jurisdictions. The *International Classification of Goods and Services for the Purposes of the Registration of Marks* [*Nice Classification*], Nice Act, 15 June 1957, ensures an international uniformity in classifying such goods or services.<sup>43</sup> Countries' parties to the *Nice Classification* are requested to implement the classes of goods for the national registration of marks. The classification consists of a list of classes, including 34 classes for goods and 11 for services and an alphabetical list of goods and services comprising of about 11,600 items. Both lists are amended and supplemented periodically by a committee of experts on which all contracting States are represented. There are 83 countries who are parties to the *Nice Agreement*. The OAPI is included among the countries implementing the *Nice Classification* in the registration of marks. The trademark office of the OAPI uses the *Nice Classification*.<sup>44</sup> Service marks are an integral part of the definition of marks under the *Bangui Agreement*,<sup>45</sup> and the Organization undertakes the examination, registration and publication

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43. Spoor & Fisher Jersey, *Circular No 351: Trade Mark Classification Systems for Goods and Services in Africa* (1 April 2002), online: Spoor & Fisher <[http://www.spoor.com/articles/Circular\\_No\\_351\\_Trade\\_Mark\\_Classification\\_Systems\\_for\\_Goods\\_and\\_Services\\_in\\_Africa-225.html#sthash.D3VzVtHj.dpuf](http://www.spoor.com/articles/Circular_No_351_Trade_Mark_Classification_Systems_for_Goods_and_Services_in_Africa-225.html#sthash.D3VzVtHj.dpuf)>.

44. *The International Classification of Goods and Services for the Purposes of the Registration of Marks*, 7th ed (WIPO Publication No 500.1 (E), 1996) at viii [*Nice Classification*].

45. *Bangui Agreement*, *supra* note 30, 1999, Annex III, art 2(1): "Any visible sign used or intended to be used and capable of distinguishing the goods or services of any enterprise shall be considered a trademark or service mark [...]."

of trademarks and service marks according to the common procedure provided for in its Agreement.<sup>46</sup>

However, and unlike OAPI jurisdictions, Nigeria is not a Member to the *Nice Agreement*.<sup>47</sup> The *Nigerian Trademarks Act* does not include service marks in its definition of what constitutes a trademark for registration purposes.<sup>48</sup> In its trademark practice however, Nigeria makes use of the *Nice Classification* despite the fact that the country has no provisions for the registration of service marks, and is not a Member to the *Nice Agreement*.<sup>49</sup> The registration of trademarks in spirit drinks is a notable illustration. The country uses the *Nice Classification*<sup>50</sup> placing the spirit drinks in class 33.<sup>51</sup>

### 3. Trademark packaging protection

Nigeria does not accommodate the packaging of goods or their get-up in the trademark protection. The shape of goods or their packaging has not been included in the definition of a trademark.<sup>52</sup> These are therefore not registrable, which does not strengthen the function of identification of goods. In an illiterate society, there is the possibility that the packaging, on the other hand, is likely to cause confusion where the buyer is dependent on the packaging rather than the registered name or a word to purchase brake linings like was the case in

46. *Ibid*, 1999, Title 1, General Provisions, s 2, art 9(1).

47. See Mark Mordi, "Towards Trademark Law Reform in Nigeria: A Practitioner's Note" in *NIALS Journal of Intellectual Property* (Nigeria: Maiden Edition, 2011) 193 at 204. Mark Mordi explains that:

[i]n order to cover the gap in the law resulting from the non-inclusion of services as subject matters of trademarks, on 19 April 2007, the Honourable Minister for Commerce and Industry ostensibly exercised his powers under sections 4230 and 4531 of the *Nigerian Trade Marks Act* by issuing a regulation (the "Regulation") expanding the classification under the Fourth Schedule of the *Trade Marks Regulations* covering 34 classes of goods to include service marks "according to the manner and structure" of the *Nice Classification*.

48. *Trade Marks Act*, *supra* note 12, s 67.

49. *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*, *Nice Agreement* (1957), revised at Stockholm (1967), and at Geneva (1977), and amended in 1979 (Nice Union), Status on 15 October 2014, online: WIPO <<http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/nice.pdf>>.

50. The current one being the 10th edition which entered into force on 1 January 2015.

51. See Nigerian Law Intellectual Property Watch, *Nigeria: IP and Brand Protection Issues for Spirit Producers*, online: <<http://www.nlipw.com/ip-and-brand-protection-issues-for-spirit-producers-in-nigeria>>.

52. See *Trade Marks Act*, *supra* note 12, s 67. A mark defined as a "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

*Ferodo Limited v IBETO Industries Limited*.<sup>53</sup> Unlike Nigeria, the OAPI trademark protection however includes the packaging among the signs recognized as marks. The *Revised Bangui Agreement* mentions on this matter that:

Any visible sign used or intended to be used and capable of distinguishing the goods or services of any enterprise shall be considered a trademark or service mark, including in particular surnames by themselves or in a distinctive form, special, arbitrary or fanciful designations, the characteristic form of a product or its packaging, labels, wrappers, emblems, prints, stamps, seals, vignettes, borders, combinations or arrangements of colors, drawings, reliefs, letters, numbers, devices and pseudonyms.<sup>54</sup>

A Nigerian company reaching out to the OAPI market will benefit greater packaging protection by registering its mark under OAPI laws, while at a national level, to prevent infringement, their registration is possible as designs under the *Patent and Design Act*.<sup>55</sup>

#### 4. Non-recognition of collective marks by Nigeria trademark system

Collective marks are usually reserved to the Members of unions, groups officially recognized, to distinguish their goods or services from those of other Members of union undertakings.<sup>56</sup> In Nigeria, despite

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53. *Ferodo Limited and Ferodo Nigeria Limited v Ibeto Industries Limited*, SC.95/1999 reported in [2004] 5 NWLR Pt 866 317. See also Ayoyemi Lawal Arowolo, "Ferodo Limited and Ferodo Nigeria Limited v Ibeto Industries Limited: Another Critical Review" in *NIALS Journal of Intellectual Property* (Nigeria: Maiden Edition, 2012) 118 at 135:

[t]he fact that the plaintiffs/appellants billboards found in different locations in Lagos did not have some of the components on the packaging of the brake lining and the evidence of a witness that the brake lining is known as FERODO and that customers purchase the product by asking for it by its brand name was not enough to reach the decision that was reached by the Supreme Court that the FERODO packaging was not distinctive and that the trade mark was just in the name FERODO. The Supreme Court would have broken jurisprudential ground in the Nigeria trademark law in reflecting current trends in the world of trading and marketing practice to give credence to distinctive devices beyond the word "Ferodo" in order to uphold the right of the appellant in this case.

54. *Bangui Agreement*, *supra* note 30, Annex III, art 2(1).

55. See *Patents and Design Act*, c 344 LFN 1990, s 12:

Any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, is an industrial design, if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result.

56. See *WIPO Intellectual Property Handbook*, 2nd ed (WIPO Publication No 489 (E), 2004) at 20.

the fact that certification marks have been well recognized, there are however no provisions on collective marks,<sup>57</sup> whilst collective marks in OAPI are duly established under the *Bangui Agreement*. Article 3(2) of the Agreement stipulates that the trademarks shall be considered collective marks where the conditions for their use are laid down in rules approved by the competent authority and where they may be used only by enterprises of public character, unions or groups of unions, associations, groups of producers, manufacturers, craftsmen or tradesmen, provided that the latter are officially recognized and have legal personality.<sup>58</sup> Because of this lack of recognition, Nigerian enterprises cannot get protection on collective marks on the Nigerian territory, while such rights are conferred to them in OAPI States, provided they fulfill the requirements laid down by the local administrative authorities.<sup>59</sup>

This comparative analysis highlights that Nigerian protection appears to be more limitative for local companies in terms of scope of protection. It becomes therefore more profitable for local traders who envisage transnational trade to carry over their business activities or trade extension to neighbouring OAPI markets. OAPI secures foreign companies on its territory, provided they are conform to the *Bangui Agreement* dispositions. It will be therefore advantageous for the success of transnational trade for the national companies to define the trademarks rights and profits by reference to their new geographic reach, in accordance with OAPI trademark requirements. They could also benefit from enforcement regime.

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57. See *Trade Marks Act*, *supra* note 12, First Schedule, Certification trade mark, s 67.

58. See Caroline Joëlle Nwabueze, "Unlocking Appellation of Origin Protection for OAPI States Economies" 2:2 Turin IP J 18.

59. *Bangui Agreement*, *supra* note 30, Annex III, art 2(2) enunciates the conditions for collective marks recognition in OAPI:

The trademarks or service marks shall be considered collective marks where the conditions for their use are laid down in rules approved by the competent authority and where they may be used only by enterprises of public character, unions or groups of unions, associations, groups of producers, manufacturers, craftsmen or tradesmen, provided that the latter are officially recognized and have legal personality.

See also art 34:

The filing application for registration of a collective mark shall include the approved rules for its use. If those rules are contrary to the provisions of Article 3 or if the prescribed fees have not been paid, the application shall be rejected. Any amendments to the said rules that are contrary to public policy or morality shall likewise be rejected.



## II. ENFORCEMENT OF NIGERIAN COMPANIES' TRADEMARK IN NEIGHBOURING COUNTRIES

Current regional developments have caused the scope of trademark law practice to expand beyond territorial frontiers.<sup>60</sup> In the absence of a valid legislation enacted for the purpose, the adoption of a trademark does not project the right of protection in advance of the extension of trade in a new territorial area.<sup>61</sup> Trademark rights granted to Nigerian companies under the national *Trademark Act* cannot be projected to OAPI as the companies extend their business into the neighbourhood's regional markets. It is a custom in the practice of international intellectual property that States that are worried about the free-riding problem usually negotiate bilateral treaties with other States.<sup>62</sup> This is not the case with Nigeria and its neighbouring countries. In case of infringement, the local national laws will therefore apply, basically the *OAPI Agreement*.

Nigerian companies' involvement in transnational commerce restricts *ipso facto* the nation from the domestic law practice and administration. The application of OAPI trademark law—foreign to Nigerian intellectual property domestic law and practice—, inevitably restricts the involvement of national companies in transnational commerce.<sup>63</sup> The companies have to adopt the standards placed at the regional level by OAPI trademark institution for a right recognition, implementation and enforcement of their trademarks. Questions of infringing goods arise in this context especially when there are some gaps in the protection between the country of origin—Nigeria—and the country/region of destination—OAPI.

### A. Trademark enforcement issues

In OAPI, territorial enforcement systems have been established to palliate in case of infringement of foreign protected trademarks. Enforcement mechanisms in OAPI for trademarks registered on its Members' territories derive their territorial character from the national institutions

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60. *United Drug Co v Theodore Rectanus Co*, 248 US 90 (1918).

61. *Ibid.*

62. Drahos & Smith, *supra* note 19.

63. Adebambo Adewopo, "Challenges of Transnational Law Practice: Intellectual Property Law Curricular Approach" (Paper delivered at the AALS Conference on Educating Lawyers for Transnational Challenges, Hawaii, 26-29 May 2004), [unpublished].

offering for example administrative grant or judicial enforcement with territorially defined sovereignty, including the national industrial property offices supervised by the Ministry of Industry and responsible of trademark policy management at the national level, the OAPI regional office, the national courts implementing the harmonized African business law,<sup>64</sup> and civil law procedures. Trademark enforcement mechanisms in OAPI regarding Nigerian trade companies backed by a common law inheritance encompass a number of disparities. In case of infringement, seeking transnational protection or enforcement of foreign Nigerian companies' brands within OAPI States will definitively raise sustainable issues.

### *1. Legal personality requirement for parties to trademarks infringement cases*

In Nigeria, the right to sue or be sued abides in the proprietor of a trademark.<sup>65</sup> A person who made a party to an action either as a plaintiff or as a defendant in trademark infringement cases must be a legal person, or, if not, a body vested by law with power to sue or be sued. In contrary, in OAPI, any person wishing to obtain the registration of a mark shall become the owner upon successful completion of the registration procedures.<sup>66</sup> OAPI intellectual property law does not discriminate between physical or legal person for ownership purpose. Ownership of a mark shall vest in the person who files it first.<sup>67</sup>

### *2. The common law protection for unregistered marks in Nigeria*

Contrary to *Nigerian Trademark Act*, mark registration is the only mean to ascertain ownership of a mark under OAPI. However, it has been a legal certainty in the Nigerian trademark practice that unregistered trademarks may be enforced via passing-off action under common law. Regarding this issue, section 3 of the *Trademark Act* mentions that:

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64. *New Uniform Act*, African Organization for the Harmonization of Business Law in Africa, 15 December 2010. Almost all OAPI States are Members of the Organisation pour l'harmonisation en Afrique du droit des affaires [OHADA] and implement the different OHADA acts adopted at the community level.

65. *Maersk Line Anor v Addide Investments Limited & Anor*, 45 NIPJD [SC 2002] 248/2000.

66. *Bangui Agreement*, *supra* note 30, 1999, Annex III, art 8.

67. *Ibid*, art 5(1).

No person shall be entitled to institute any proceeding to prevent or to recover damages for, the infringement of an unregistered trade mark; but nothing in this Act shall be taken to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

Passing-off in Nigeria common law inherited system is a cause of action in tort which only lies for persons with unregistered trademarks and actionable at the State High Courts.<sup>68</sup> Whilst, under the *Bangui Agreement*, no person may claim exclusive ownership of a mark by performing the acts specified in the provisions of the annex unless he has filed it for registration in accordance with the prescribed conditions.<sup>69</sup> It is therefore evident that Nigerian companies cannot be granted protection for their unregistered trademarks. This is because OAPI States are more of civil law countries not recognizing common law practices such as passing-off. Nevertheless, protection is still affordable under unfair competition law for any tort arising as regard to the use of intellectual property rights.<sup>70</sup>

### 3. *The face of trademarks enforcement mechanisms in Nigeria and OAPI*

The regional trademark practice in Central and West Africa has witnessed several cases of foreign imitations of national brands.<sup>71</sup> It

68. See e.g. *Omnia Nigeria Limited v Dyketrade Limited*, 50 NIPJD [SC. 2007] 176/2003. In determining the jurisdiction of the court for such matters, the Supreme Court held that the Federal High Court has jurisdiction to hear and determine cases of passing off.

69. *Bangui Agreement*, *supra* note 30, 1999, Annex III. Trade Marks and Service Marks, art 5(2).

70. *Ibid*, Annex VII. Protection against unfair competition, art 7.

71. See e.g., *Reemtsma Cigaretten Fabriken GmbH v Sitabac*, 26 January 2001, OAPI Jurisprudence No 604771011 at 38. In this case, at the request of the interested parties the court has declared the registration of a mark invalid since it did not conform to the provisions of the Act and conflicted with a prior right. This is in conformity with the *Paris Convention*, *supra* note 14, art 6bis(1):

The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. [emphasis added]

has been the case when goods infringing in Nigeria jurisdictions are sent to their final destination in OAPI neighbour countries. The shared borders and visa free movement between ECOWAS States located along the West African coast<sup>72</sup> on one side, and Nigeria and Cameroon on another side<sup>73</sup>, is a facilitating agent for regional counterfeiting. The question presents itself whether trademark rights could be enforced, and whether these goods may be intercepted where they are found as illegal goods subject to seizure and destruction. This raises the necessity of mutual enforcement of foreign companies' trademark in case of infringement.

Trademark enforcement mechanisms in OAPI refer to opposition, claim of ownership and action on infringement. There are two types of oppositions to infringing trademarks in OAPI States: the opposition for mark registration, and the opposition of trade name registration. Any interested party may oppose the registration of a mark within a period of six months from the publication based either on an infringement, or of a prior right belonging to the opposing party.<sup>74</sup> While the opposition to the registration of a trade name is possible from the publication, reasons must be based on infringement and the opposition only stands if there is evidence of trade name infringement.<sup>75</sup> Where a mark has been filed by a person who at the time of filing knew, or should have known that another person had a prior right to use the said mark,<sup>76</sup> the latter may file a claim of ownership of the mark within six months following the publication.<sup>77</sup> In case of unlawful exploitation of registered marks, a civil action for the infringement of a mark can

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72. ECOWAS—Economic Community of West African States—was established by the Treaty of Lagos signed in May 28, 1975. The countries Member of ECOWAS are Benin, Burkina Faso, Cote-d'Ivoire, Gambia, Ghana, Guinea-Bissau, Guinea, Liberia, Mali, Niger, Nigeria, Senegal, Sierra Leone, Togo and Cape Verde. According to the ECOWAS Protocol, all nationals of countries that are signatories to the ECOWAS treaty enjoy free entry within 90 days.

73. As facilitating factor for trade relations between the two countries is the Nigeria-Cameroon Multinational Highway, Beside, Cameroon and Nigerian authorities have entered into a visa-free entry arrangement for their citizens visiting any of the countries on business, tourism, or other purposes.

74. *Bangui Agreement*, *supra* note 30, 1999, Annex III. Trade Marks and Service Marks, art 18(1).

75. *Ibid*, Annex V, Trade Names, art 9(1).

76. See Max-Lambert Ndéma Elongué, *L'action en revendication de propriété de marque dans l'espace OAPI* (Master in Intellectual Property Law, University of Yaoundé II-Soa, 2008) [unpublished].

77. *Bangui Agreement*, *supra* note 30, 1999, Annex III, art 5(3). See e.g., OAPI, *Decision No 0024/CSR/OAPI of 4 July 2002*, [2002], RDCSR at 60.

be brought in OAPI by the owner.<sup>78</sup> A trade name can equally be invalidated if at the request of interested parties it is found that the mentioned trade name does not conform to the Act provisions or conflicts with a prior right.<sup>79</sup>

In Nigeria, a civil action lies in practically all infringement cases, including: (i) action to prevent the registration of similar marks; (ii) action to cancel registered infringing marks; (iii) action to recover damages for the infringement of a registered trademark. An opposition phase exists at the administrative level and in relation with the registration of a trademark. This procedure is equally granted under the *Nigerian Trademark Act*.<sup>80</sup> Within two months from the date of the publication, the Act recognizes to interested parties the right to give notice to the Registrar of opposition to the registration, in a notice containing a statement of the grounds of opposition.<sup>81</sup> The registrar shall hear the parties, if so required, also consider the evidence, and decide whether registration is to be permitted, and the conditions or limitations it is subject to, if any.<sup>82</sup> Trade names used by Nigerian business companies to distinguish themselves and their trading objects from all other businesses are protected under the *Companies and Allied Matters Act* [CAMA].<sup>83</sup> It protects against deceiving trade names, or the ones causing confusion or even possibly misleading members of the public as to the distinctiveness between two separate trading entities.<sup>84</sup>

## B. Support of unfair competition laws to foreign trademark owners in OAPI

OAPI has established a common system of protection against unfair competition in order to facilitate recognition of the rights provided for in the legislation of their countries. An act of unfair competition shall be constituted by any act or practice which, in the course of industrial

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78. See *Bangui Agreement*, *supra* note 30, 1999, Annex III, art 46.

79. *Ibid*, Annex V, art 14(2).

80. *Trade Marks Act*, *supra* note 12, s 20.

81. *Ibid*, s 20(1)(2).

82. *Ibid*, s 20(4).

83. *Companies and Allied Matters Act*, CAP c 20, LFN 2004 (CAMA) Part B. Business Names, s 652-672.

84. Oserogho & Associates, "Trade Names and Trade Marks Protection in Nigeria" *Legal Alert* (May 2010), online: Proshare Nigeria <<http://www.proshareng.com/articles/2093>>.

or commercial activities, is contrary to honest practice.<sup>85</sup> A Nigerian company or investor who has suffered damage or is liable to suffer damage due to an act of unfair competition, and legally barred under other existing actions on trademark infringements, may institute proceedings before the court of an OAPI Member State and may obtain injunctions, damages and any other remedy provided by civil law.<sup>86</sup>

There are other trademark rights, such as those pertaining to a trade dress used by infringers on counterfeit products. As mentioned earlier, packaging is not granted protection under *Nigerian Trademark Act*. A company which extends its business in OAPI and fails to register its goods packaging as trademark, can still benefit from unfair competition laws. OAPI laws specifically punish acts damaging another's image or reputation,<sup>87</sup> the acts causing confusion with another's enterprise or activities,<sup>88</sup> the acts deceiving the public,<sup>89</sup> the disorganization of a competing enterprise and of the market,<sup>90</sup> as well as the acts disparaging another's enterprise or activities.<sup>91</sup> However, the companies must go through the difficult exercise of proving the mark recognition on the market, the element of a free ride, and then the confusion. For the cases of damages to another's image or reputation, the *Bangui Agreement* has extended the recognition of confusion to six main areas, including: (i) a trademark, whether registered or not; (ii) a trade name; (iii) the distinctive sign of an enterprise other than a trademark or a trade name; (iv) the external appearance of a product; (v) the get-up of products or services; (vi) a famous person or well-known fictional character.<sup>92</sup>

The advent of Nigerian economy in the regional field of trade, commerce and industry of Africa certainly leads to a pressure on the traditional requirements of territoriality of the Nigeria national trademark law firstly, and OAPI regional intellectual property rights secondly.<sup>93</sup> The trade expansion of Nigerian companies in neighbouring OAPI

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85. *Bangui Agreement*, *supra* note 30, 1999, Annex VIII, art 1.

86. *Ibid*, art 1(1)(b).

87. *Ibid*, art 3.

88. *Ibid*, art 2.

89. *Ibid*, art 4.

90. *Ibid*, art 7.

91. *Ibid*, art 5.

92. *Ibid*, art 2(2).

93. See in that sense von Mühlendahl & Stauder, *supra* note 16.

markets is confronted to the territoriality of intellectual property rights to palliate to above-mentioned restrictions. Both OAPI and Nigeria could agree to cooperate with each other with a view to eliminating international trade in goods infringing intellectual property rights. For this purpose, they shall establish and notify contact points in their administrations and be ready to exchange information on trade for a better trademark enforcement in the case of infringing goods. They shall, in particular, promote the exchange of information and cooperation between customs authorities with regard to trade in counterfeit trademark goods and pirated trademark goods.

### C. Remedies for trademarks infringement

Intellectual property rights are intangible rights. The attributes of intellectual property has to focus on two elements: the property element, and the object to which the property element relates. As above mentioned, and based on the principle of territoriality, Nigerian brands' goods sold in OAPI countries market can be granted protection under *OAPI Trademark Act* sovereign to know all jurisdictional matters related to the enforcement of the right upon the national territories in the region. As corollary, *Nigeria Trademark Act* has not granted recognition to a trademark in use in case of infringement happening in neighbouring territory. As mentioned by Peter Drahos, a world in which States regularly claimed jurisdiction over the property rights established by other nations would be a world in which the principle of negative comity would have largely vanished.<sup>94</sup> This inevitably affects the use of the mark or sign apposed, and the trade of the goods where the mentioned mark has been affixed to. According to the Mozambique rule formulated in the case *British South Africa Co v Companhia de Moçambique*,<sup>95</sup> national courts' jurisdiction are limited in respect of actions relating to: (i) titles to foreign land; (ii) possession to foreign land, and (iii) damages of trespass to foreign. As consequence, OAPI nations' courts cannot exercise jurisdiction in actions of trespass to intellectual properties situated abroad. By virtue of the Mozambique

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94. See Drahos & Smith, *supra* note 19 at 5.

95. *British South Africa Co v Companhia de Moçambique*, [1893] AC 602 at 622-24. The Supreme Court of Judicature has no jurisdiction to entertain an action to recover damages for a trespass to land situated abroad; the rules of procedure under the *Judicature Acts* with regard to local venue did not confer any new jurisdiction.

rule, their competence is limited to OAPI titles delivered by this Organization in one of the following countries: Benin, Burkina Faso, Burundi, Cameroon, Chad, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, and Guinea. Judicial enforcement structures derive their territorial character from those countries' judicial institutions with territorially defined sovereignty. It is therefore evident, according to the territoriality principle of trademarks, that the remedies for trademark infringement of designations that identify and distinguish Nigerian goods in commerce within OAPI neighbourhood will be envisaged.

It has been a TRIPS requirement that Members shall ensure enforcement procedures against any act of infringement of intellectual property rights.<sup>96</sup> In terms of provisional measures, Members have been requested that:

The judicial authorities shall have the authority to order prompt and effective provisional measures:

- (a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
- (b) to preserve relevant evidence in regard to the alleged infringement.<sup>97</sup>

Upon legal confirmation of the existence of fate of counterfeited marks and goods in the channels of commerce within OAPI, courts may order the confiscation of goods bearing a mark recognized as being infringing, and also that of the implements or tools that served specifically for the commission of the offense.<sup>98</sup> Additionally, courts may order that the confiscated objects be surrendered to the owner of the mark that has been counterfeited or fraudulently affixed or imitated, regardless of the right to any further damages that may be appropriate.<sup>99</sup> The *Bangui Agreement* equally allows courts to order the destruction of goods bearing marks recognized as being contrary to the provisions of the Act.<sup>100</sup>

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96. *TRIPS Agreement*, *supra* note 15, art 41(2).

97. *Ibid*, art 50.

98. *Bangui Agreement*, *supra* note 30, 1999, Annex III, art 43(1).

99. *Ibid*, art 43(2).

100. *Ibid*, art 43(3).



Companies may obtain civil and criminal remedies for infringements of trademark rights inside OAPI. The remedies available pre-trial include the provisional or interim measures and prevention of importation. At full trial, criminal remedies, and other civil remedies like injunctions and damages are available. The remedies to be examined are part of contracting parties' implementation of obligations imposed by the TRIPS and *OAPI Agreement*. In addition, several States have enacted domestic laws related to remedies. There are also specific remedies found under OHADA.<sup>101</sup> The preliminary measures that may be ordered include an interim injunction, seizure of counterfeited goods, seizures of assets, freezing of assets, and can request the alleged infringer to deposit an amount of money to act as a caution which may be used to satisfy the plaintiff's claim if judgment is subsequently entered in his favour.<sup>102</sup>

Article 28 of the *OHADA Uniform Act on Simplified Recovery Procedures and Enforcement Measures* enables a creditor to take provisional measures in order to preserve his rights.<sup>103</sup> Many OAPI States are not equipped with appropriate national civil procedure rules. Some

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101. OHADA—Organisation for the Harmonisation of Business law in Africa—, system of business laws and implementing institutions adopted by Benin, Burkina Faso, Cameroon, Central Africa Republic, Chad, Comoros, Republic of Congo, Cote d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Mali, Niger, Senegal, Togo, and Democratic Republic of Congo.

102. See *Nguefiko K Mathieu, Mikengue Tobie, Tanga Alain et autres c SCAAP-MANA NGWOA*, Trib de 1<sup>ère</sup> instance de Bertoua, No 37/RG/06-07 Ordonnance No 03/ORD/PTPI/BE du 1<sup>er</sup> février 2007. The SCAAP aims at defending the material and moral interests of its Members. It needs a mandate from the owners of channels distributed by cable distributors in order to make any recovery in relation with the use of their works.

See also *Taparia Tools Limited v Eastman Cast and Forge Limited*, India, Bombay High Court Case No 90/2004, 7 April 2004. Plaintiffs were in the market for considerable length of time. Defendants on the other hand had started manufacturing wrenches and pliers on their own showing from October 2000 only. There being substance in the plaintiff's contention that the design and configuration of the defendants' adjustable wrench as well as sleeve of pliers being in all respects identical and fraudulent and obvious imitation of the plaintiffs' registered designs. Court issued an injunction restraining defendants from applying in any manner or causing to be applied relation to wrenches and pliers or any other goods contained in clause 0.1 of 4th Schedule of Designs Act and Rules thereunder, designs described in Exhs C and E to the plaint or any other design which is identical to or deceptively similar to or a fraudulent imitation of the plaintiffs registered designs Nos 167097 and 178415 in Class 01 described in Exhs A and B to the plaint so as to pirate the plaintiffs registered design Nos 167097 and 178415 in class 01 or from doing anything with a view to enable the plaintiffs design Nos 167097 and 178415 from being pirated.

103. See OHADA, *Acte uniforme portant organisation des procédures simplifiées de recouvrement et des voies d'exécution*, [1998] OJ, No 6/1.

even refer to foreign rules.<sup>104</sup> For example, the Niger Republic, neighbouring country to Nigeria, since its independence has been referring to the *Code de procédure civile français* established before 1960.<sup>105</sup> The slowness of the procedures related to the grant of an interim measure by OAPI states' civil law has been vehemently criticized.<sup>106</sup>

The common law equity remedies such as those granted to the plaintiff in infringement cases in Nigeria seem more advantageous and less costly in terms of time saving and efficiency. Under the *Nigerian Trademark Act*, the plaintiff may claim an account of profits made by the infringer. Also, an injunction can be granted by the court to prevent a person from doing or continuing to do a wrong; injunctions exist before trial or *ex parte*. Finally, the court can order inspection, delivery up, of infringing materials, destruction, etc.<sup>107</sup>

Common law proceedings as applied by Nigeria in trademark infringement cases, and compared with the proceedings such as those led in OAPI civil law system, seem to be in alignment with the TRIPS requirements according to which procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.<sup>108</sup>

## CONCLUSION

The underlying relationship between regional trade law and trademark law cannot be doubted having regard to the issue of protecting the use of designations that identify and distinguish a country's goods

104. See in this sense, Edou Edou Paulin, *Les incidences de l'accord ADPIC sur la protection de la propriété industrielle au sein de l'Organisation Africaine de la Propriété Intellectuelle (OAPI)*, thèse de doctorat en droit privé, Université de Strasbourg, 2005.

105. *Europress-Editores E Distribuidores De Publicacoes Lda c Cie Beauchemin International*, 2004 CA 13 (JN). See also Caroline Joelle Nwabueze, *Harnessing Intellectual Property Law to Protect Traditional Works Applied to Industry: Case Study of Craftsmanship in OAPI States* (Ph D Dissertation, University of Douala, 2013) at 123:

[...] l'article 62 annexe VII de l'accord de Bangui consacré aux mesures conservatoires a prévu la saisie d'exemplaires d'œuvres soupçonnés d'avoir été contrefaits, ainsi que les comptes se rapportant à ces exemplaires. Les procédures sont toutefois soumises aux codes de procédure civile des États membres. Presque tous les États membres de l'OAPI appliquent les dispositions de l'Acte uniforme OHADA sur les procédures simplifiées. [unpublished]

106. Sadjó Mabí, "Comité provincial de lutte contre la piraterie" (2005) 67 *Juridis Périodique* 23.

107. Jide Babafemi, *Intellectual Property: The Law and Practice of Copyright, Trade Marks, Patents and Industrial Designs in Nigeria*, 1st ed (Justinian Books, 2006) at 266-76.

108. *TRIPS Agreement*, *supra* note 15, art 41(1).

or services in commerce within foreign marketplaces. Unfortunately, the current West African legal framework is far from promoting the development of regional trade.<sup>109</sup> The traditional nation-State approach to intellectual property rights inherited from the colonial masters for many African countries is dating from the 19th century and is inadequate to deal with this phenomenon. Today, goods are made where the business decisions of global operating enterprises see advantages of cost, efficiency and quality; legislation therefore needs to close the gaps. In West African region, promoting the development of economic activities implies for regional authorities to create conditions which are similar to those obtained in a national market. Some learned African intellectual property experts have long pleaded for an African intellectual property community.<sup>110</sup> Arrangements could be instituted to ensure that competition is not distorted through different trademark standards from one country in the region to another. Nigerian companies for example can benefit from better trademarks registration conditions in OAPI, while the enforcement procedures offered under civil law proceedings are far from being better compared to common law offered back home. OAPI companies registering their trademarks in Nigeria will suffer some restrictions in brand recognition such as collective marks, registration of service marks however granted under *Bangui Agreement*, because such marks categories are not recognized under the *Nigerian Trademark Act*. Legal conditions should be created which enable undertakings of national companies to adapt their activities to the scale of the region, and vice versa for foreign business companies, whether in manufacturing and distributing goods or in providing services. Disregarding States territorial borders in regional trade is one successful mean to promote trademark and business explosion. In Europe, for example, in order to attain the objective of free movement of judgments in civil and commercial matters, countries have agreed that the rules governing jurisdiction and the recognition and enforcement of judgments be governed by a community legal instrument which is binding and directly applicable.<sup>111</sup>

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109. Caroline Joëlle Nwabueze, "Unveiling the Protection of Traditional Textiles under Collective Marks in Nigeria" (2015 edition) Nnamdi Azikiwe University, Law faculty Journal, Nigeria [forthcoming in 2015].

110. See Tshimanga Kongolo, "The African Intellectual Property Organizations: The Necessity of Adopting One Uniform System for All Africa" (2000) 3:2 Journal of World Intellectual Property 265.

111. EC, *Council Regulation 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters*, [2001] L12/1 s 6.

Dynamics of global economic regulation through the World Trade Organization affect intellectual property regional systems and the responses of Member States to the trade-related aspects of intellectual property provisions. The focus should not only be on the nature and substance of international instruments involving intellectual property, but also on the manner in which those international instruments are applied and interpreted in the domestic contexts of developing countries. In view of the flourishing regional business, it is maybe the time for Nigeria and its neighbours OAPI nations to think of a community trademark with a unitary character, and with equal effect throughout the community. This principle was successfully applied by the European Union,<sup>112</sup> and led to tremendous economic growth in the community.

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112. See EC, *Council Regulation No 207/2009 of 26 February 2009 on the Community trade mark (codified version)* [2009] OJ L 78/1 art 1(2).