

## The nature of Trademarks, Patents and Designs:- An Overview

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### *Abstract*

*The purpose of this study was to examine the nature and types of intellectual property available and protected under the Nigeria jurisprudence. To achieve this, Nigerian legislations on the subject was examined, and comparative analysis made with references to British statutes. The paper provided insight and distinguished between the nature of trademarks, patents and designs; which terms are often times used mistaken as meaning the same thing.*

**Key Words: Trademarks, Patents and Designs**

### **Introduction**

Intellectual property law was developed essentially to protect the intangible property in works or inventions which are created from human intellect. The need to protect property dates as far back as the mid 16<sup>th</sup> century, when Queen Mary granted a Charter to the British Stationers Company in 1556<sup>1</sup>, which eventually resulted in the Copy Right Act of 1710 enacted during the reign of Queen Anne. In like manner, in demand for protection against the imitation of marks and names from the early years of industrialization in the late 19<sup>th</sup> century England led

to the promulgation of the Trade Mark Act of 1875 and the subsequent legislations passed in England from 1883 to the present day<sup>2</sup>. Similarly, patents were originally protected by the Statute of Monopolies of 1601<sup>3</sup> and Industrial Designs by the Industrial Designs Act of 1787<sup>4</sup>.

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<sup>1</sup> Babafemi, F. O. Intellectual Property, The Law and Practice of Copyright, Trade Marks, Patents And Industrial in Design Nigeria, (Ibadan, Justinian Books Ltd. 1<sup>st</sup> Edition, 2007), Pages 2-3

<sup>2</sup> Ibid Pages 74-75

<sup>3</sup> Ibid Page 343

Most of the patents granted at this time were to encourage trade in general rather than new inventions<sup>5</sup>. Intellectual Property Law encompasses Copyright, Trade Mark, Patent and Designs<sup>6</sup>.

## Definitions

### (i). Trade Mark

The Trademarks Act (T.M.A.)<sup>7</sup>, defines trademark, inter alia, as a mark used, in relation to goods, for the purpose of indicating a connection in the course of trade, between the goods and some persons having the right either as proprietor, or as registered user to use the mark, whether with or without any indication of the identity of that person.

This Statutory definition of “trademark” received judicial approval of the Supreme Court, in the case of **Ferodo Ltd. & Anor v. Ibeto Industries Ltd**<sup>8</sup>. Two conditions discernable from this statutory definition is that for purposes of a trademark, the right of user in the relation to the goods must be in the course of trade; and that it is connected to either the proprietor or the registered user.

### (i). Patents

The Patents and Designs Act (P.D.A.)<sup>9</sup> does not define “patent” rather it provides for when an invention is patentable. Patent has however been defined as a monopoly right granted by the Government through the Patent Office to an individual who has invented a product process<sup>10</sup>.

### (iii). Designs

The P.D.A. defines industrial design as any combination of lines or colours or both, and any three dimensional form, whether or not associated with colours, if it is intended by the creator to

<sup>4</sup> Ibid Page 413

<sup>5</sup> Uloko, G. Modern Approach to Intellectual property Laws in Nigeria, (Lagos, Princeton Publishing Co., 2010), Page 14

<sup>6</sup> Garner, B. A. (ed) Black's Law Dictionary, (Thomson West Publishing Co., 8<sup>th</sup> Edition, 2004) Page 824

<sup>7</sup> Section 67(1) of the Trade Marks Act Cap T13 Laws of the Federation of Nigeria (LFN) 2004, herein referred to as T.M.A.

<sup>8</sup> (2004) 5NWLR (PT. 866) P. 371 at 347

<sup>9</sup> Cap P.2 Laws of the Federation of Nigeria, 2004, herein referred to as P.D.A.

<sup>10</sup> Hart, T. (et al) Ibid Page 2

be used as a model or patent to be multiplied by industrial process and is not intended solely to obtain a technical result<sup>11</sup>. This definition was also given judicial approval by the Court of Appeal in the case of **Alliance International Ltd v. Saam Kolo International Enterprises Ltd**<sup>12</sup>.

### **Nature of Protection of Intellectual Property Law.**

Basically, the nature of the protection given for intellectual property law is negative. The legislation usually describes the owner's right as exclusive, thus giving the owner the right to restrain others from using his intellectual property without authority<sup>13</sup>.

In same vein, it has been submitted that one characteristic shared by all types of intellectual property is that they are essentially negative and they are rights to stop others doing certain things; rights to stop pirates, counterfeiters, imitators and even in some cases third parties who have independently reached the same ideas, from exploiting them without the license of the rightful owner<sup>14</sup>.

### **Nature of Trademarks**

From the earliest times, traders distinguished their goods by “marking” them. As the practice continued, marks applied more to goods that had become distinctive and had an intrinsic value and were worthy of some form of legal protection which, at the time, was available through the use of Royal Charters and court action in common law<sup>15</sup>. Hence in common law, a manufacturer could seek an injunction and damages against another person who was passing off his goods as those of the manufacturer. The basis for each an action was the Plaintiff's reputation acquired by use of the mark. This is what is known as a “passing off” action. Another remedy available in early times was an action for infringement of a trademark, which had been granted by a Charter. But the difficulties faced in this form of action was that each time the mark was infringed, the owner of the mark (the Plaintiff) had to prove title to the mark and the court had to resolve the problem of what exactly constituted a trademark in each separate case. As a result, the

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<sup>11</sup> Section 12 PDA

<sup>12</sup> (2010) 13NWLR (Pt. 1211) P. 270

<sup>13</sup> Hart, T. (et all) Ibid Page 2

<sup>14</sup> Cornish, W. & Llewellyn D. Intellectual Property; Patents, Copyright, Trade Marks and Allied Rights, (London, Sweet & Maxwell, 6<sup>th</sup> Edition, 2007), Page 6

<sup>15</sup> Hart, T. (et all) op. cit Page 83

trademarks registration Act 1875 was enacted, to overcome the difficulties encountered in such infringement actions by establishing a statutory register of trademarks, which is full in use in the present day United Kingdom<sup>16</sup>. The Trademarks Act 1928<sup>17</sup> which combined the common law remedy of passing off and the statutory infringement was eventually enacted.

(b) Distinction between trademark and passing off.

The basic difference between trade infringement and passing off is that once a trademark is registered, protection against infringement is automatic and the proprietor need not prove anything more whereas on the other hand, the plaintiff in a passing off action must demonstrate the presence of goodwill in order to have a right of action. In other words, the common law protects the goodwill of a business associated with a trade name<sup>18</sup>. In **Virgin Enterprises Ltd v. Richday Beverages (Nig). Ltd**<sup>19</sup>. the Court of Appeal held that there is a distinction between passing off and infringement of trade mark in that an action for infringement of trade mark is a statutory remedy conferred on the registered proprietor of a registered trade mark for the enforcement of his right to use the trade mark in relation to the goods for which the mark has been registered, whereas an action for passing off is a common law action for deceit, for colourable imitation of a mark adopted by a person in relation to his goods which has acquired distinctive reputation in the market as referring to goods belonging to or produced by that person only.

(c) **Functions of Trade Mark**

The main function of a trademark is to differentiate one traders' goods or services from those of another. This is more so in this era of mass production in the wholesale and retail markets. The trademark thus allows the consumer to distinguish between similar products. The trademark has a guarantee function in that once a customer has tried a product with a particular name and found it satisfactory, repeat purchases of goods bearing that name will guarantee repetition to that satisfaction and the converse is the case where a customer has had a bad experience with a product, the trademark will either advertise or act as a warning against further purchases. Their

<sup>16</sup> Ibid Page 84

<sup>17</sup> The Nigeria Trademarks Act NO. 29 of 1965 was modeled after this Act

<sup>18</sup> Hart, T. (et all) op. cit Page 132

<sup>19</sup> (2009) 12NWLR (PT. 1156) PAGE. 498

hope is that this will trigger an association in consumers' minds between origin and good value or quality<sup>20</sup>. In **Scandecor Developments AB v. Scandecor Marketing AV & Ors**<sup>21</sup> a trademark was said to be a “badge of origin”. Similarly, in **Ferodo & Anor v. Ibeto Industries Ltd**<sup>22</sup>, a trademark was described as a distinctive picture which would indicate to a purchaser of an article bearing the trademark, the means of getting the same article in future by getting an article with the same mark on it. It needs to be emphasized at this point that for a mark to become a protectable trademark, it must be used in relation to the goods, “a connection in the course of trade”. This was the decision of the House of Lords in **Aristoc Ltd v. Rysta Ltd**<sup>23</sup>.

#### (d) Registration of the Trademark

We had earlier shown that the distinction between an action for trademark infringement and a passing off action is that in an infringement act, all the Plaintiff needs to prove is the registration. Under the T.M.A. a trademark must be registered before the proprietor of the mark can institute any proceeding to prevent or recover damages for an infringement<sup>24</sup>. The mark is registrable either in Part A or Part B of the register<sup>25</sup>. For registration in Part A, a trademark must contain or consist of at least one of the essential particulars listed therein, such as a name represented in a special or particular manner; signature; an invented word(s) or any other distinctive mark<sup>26</sup>. In **Ferodo Ltd v. Ibeto Industries Limited**<sup>27</sup> on what a “mark” is in relation to trademark, the Supreme Court held that a mark in the context of trademark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.

#### (e) Prohibition of Registration

However, there are grounds upon which an application for registration of a trademark, which has passed the “distinctiveness” test, may be refused. They are commonly called the absolute and the relative grounds. Under the Act, a trademark shall not be registered if it is likely to deceive or

<sup>20</sup> Cornish & Llewellyn, op cit Page 603

<sup>21</sup> (2001) UKCHL 21, (referred to at Hart, T. (et all) Ibid Page 83

<sup>22</sup> Supra Page 347

<sup>23</sup> (1945) 62 RPC 65 (referred to in Cornish, W. Cases and Materials on Intellectual Property, (London, Sweet & Maxwell, 5<sup>th</sup> Edition, 2006), Page 581

<sup>24</sup> Section 3

<sup>25</sup> Section 9(1) & Section 10 T.M.A.

<sup>26</sup> Section 9(1) (a)-(e) T.M.A.

<sup>27</sup> Supra Page 347

cause confusion or contrary to law or morality or scandalous<sup>28</sup>. Hence, the trademarks which fall under this category are absolutely prohibited for registration under Part A or Part B of the Register. For example, in **Beecham Ground Ltd. v. Esdee Food Products Nig. Ltd**<sup>29</sup>, the court held that the proposed trademark “Glucos-aid” infringed the respondent’s trademark “Lucozade” and re-stated the law that a trademark must not deceive the public or cause confusion. Similarly, in **Ghazilian’s trademark Application**<sup>30</sup>, the application to register as a trade mark, “Tiny Penis” for a clothing manufacturer was refused, on grounds that the mark was likely to offend public decency.

Lastly, it need be emphasized that registration of trademark shall be for a period of seven years but may be reviewed from time to time<sup>31</sup>. Besides, a trademark is in the form of personal property as is assignable and transmissible<sup>32</sup>. It may be removed from the register on ground on non use<sup>33</sup>.

### Nature of Patents

Patent simpliciter; means the governmental grant of a right, privilege or authority<sup>34</sup>. The word patent referred originally to the Royal letters patents, which were a royal proclamation that the earner had the crown’s authority to do whatever had been authorized within the letters<sup>35</sup>. In Nigeria, the law that regulates the grant of patents in the Patents and Designs Act, 1970, which is in now embodied in Cap P2, Laws of the Federation of Nigeria 2004.

Where a patent is granted to an inventor, (known as the patentee) the right of the patent is usually effective for a period of 20 years before its expiry<sup>36</sup>. Once a patent has been granted in respect of a product, the patent confers upon the patentee the right to preclude any other person from the act of making, importing, selling or using the product, or stocking it for the purpose of sale or use<sup>37</sup>. It has been suggested that the grant of the patent is the reward for sharing

<sup>28</sup> Section 11 T.M.A.

<sup>29</sup> (1980) FHCL. 17 (referred to in Babafemi, F. O. op cit Page 243)

<sup>30</sup> (2002) R.P.C. 628, referred to in Hart, T. (et all) op. cit Page 102

<sup>31</sup> Section 23 T.M.A.

<sup>32</sup> Section 26 T.M.A.

<sup>33</sup> Section 31 T.M.A.

<sup>34</sup> Black’s Law Dictionary op cit Page 1156

<sup>35</sup> Uloko, G. op cit. Page 13

<sup>36</sup> Section 7(1) PDA

<sup>37</sup> Section 6(1) (a) PDA

knowledge regarding new inventions and that the inventor who is rewarded in this way may be encouraged to make other useful inventions. Hence, a patent is an incentive to be more creative and as new products are invented, the economy is stimulated as there are more products for consumers to buy<sup>38</sup>. For a product to be patentable, it must be new; results from inventive activity; and is capable of industrial application<sup>39</sup> and must not be excluded section 1 (4) & (5) PDA. Note that there is a similar provision in the United Kingdom Patents Act<sup>40</sup> conditions precedent for patentability.

(i). **New or Novel**

An invention is new if it does not form part of the state of the art. State of the art means everything concerning that art or field of knowledge which has been made available to the public by means of a written or oral description, or by use of the product before the date of filing the application for a patent, except the invention was exhibited in an official or officially recognized intentional exhibition<sup>41</sup>. In order for prior documentary (or oral) information to invalidate a patent on the ground that it lacks novelty, that information must amount to a clear disclosure of the invention. This test was laid down in the case of **General Tire and Rubber Company v. Firestone Tire and Rubber Co. Ltd**<sup>42</sup>. Where the test laid down was that to anticipate the patentee's claim, the publication must contain clear and unmistakable directives to do what the patentee claims to have invented. Hence, an invention cannot be said to have been made available to the public merely by a published statement of its existence, unless the method of working it is so self evident as to require no explanation. Thus in **Bristol-Myers Squibb Co. v. Baker Norton Pharmaceuticals**<sup>43</sup>, a lecture given by the patentee's Director of Research on the use of a drug to treat ovarian cancer over a shorter period was held to amount to enabling disclosure as members of the public could use the information from the lecture and carry out the procedure without the need for any further information from the patent.

<sup>38</sup> Hart, T (et al) Op. Cit Page.11

<sup>39</sup> Section 1(1) (a) & (b) PDA

<sup>40</sup> Section 1 Patents Act 1977

<sup>41</sup> Section 1(2) (a) & (3) PDA

<sup>42</sup> (1972) RPC 457. (referred to in Hart, T (et al) Op Cit at P. 23

<sup>43</sup> (2001) RPC 1(referred to in Hart, T. (et al) Op. Cit at P. 24

This process of denial of patent by publication (or use of), prior to the date of application, is referred to as “anticipation of the application”. For example in **Van Der Lay v. Bramford**<sup>44</sup> a patent application for a hay raking machine was held to have been “anticipated” by a photograph in a journal which showed a hay rake with the same features sought to be patented.

The overall relevance of anticipation is that by disproving the claim’s novelty, anticipation bars the allowance of a claim and provides a defence to an action for infringement based on that claim<sup>45</sup>.

### **Prior Use.**

The way in which publication can anticipate an application, is the same way prior use can anticipate an application for patent. Prior use of the invention in question is considered as part of the state of the art and this is based on the principle that a monopoly (which a patent creates) should not be granted to stop individuals from doing what they had been doing legitimately before the date of the application.

#### **(ii). Inventive Activity**

The PDA provides that an invention results from inventive activity if it does not obviously follow from the state of the art, either as to the method, the application, the combination of methods or the product which it concern, or as to the industrial result it produces<sup>46</sup>. What it then means is that even after satisfying the newness or novelty test, to qualify for patentability, an invention must have been produced from an inventive activity or steps. The inventive activity must move the science forward and not be something that would obviously have followed the state of the art, either as to the method(s) or as to the result it produces.

The question of “obviousness” came up in the case of **Windsurfing International v. Tubur Marine G.B. Ltd**<sup>47</sup>. and the Court of Appeal established the steps required to be taken by the court in answering the question of “obviousness”, and they include the following: identify the inventive concept embodied in the patent in the suit; identify what, if any, difference exist

<sup>44</sup> (1963) RPC 61 (referred to in Babafemi F. O. Op Cit Page. 351

<sup>45</sup> Black’s Law Dictionary Op Cit. Page 102

<sup>46</sup> Section 1(2) (b)

<sup>47</sup> (1985) RPC 9

between the matter cited as being “known or used” and the alleged inventions. Thus in **Lux Traffic Controls Ltd. v. Pike Signals Ltd**<sup>48</sup>. the contention was that the Plaintiffs patent in traffic control signals which was developed as a means of varying the “inter-green” period (that is, the safety period between the lights in one direction changing to red before the lights in the other direction change to green, the amber period), was obvious apparently because traffic lights had existed before the invention. The court held that although simple, the invention represented an advance and technical contribution to the art, and that if the process had been obvious, it would have been proposed before.

### (iii). **Industrial Application**

Even if the invention satisfied the requirement of novelty and inventiveness, it will only be patentable if it is of industrial application. An invention will be said to be capable of “industrial application” if it can be manufactured or used in any kind of industry, including agriculture<sup>49</sup>.

### (c) **Non Patentable Products**

Patent cannot be validly obtained in respect of the following: (i) Plant or animal varieties or biological processes for the production of plants or animals other than microbiological processes and their products; (ii) principles and discoveries of a scientific nature or (iii) inventions which would be contrary to public order or morality<sup>50</sup>.

### **Nature of Industrial Designs.**

The P.D.A. defines designs as any combination of lines or colours or both and any three dimensional form, whether or not associated with colours, is an industrial design. A design can only be considered as industrial design if it is intended by the creator to be used as a model or

<sup>48</sup> (1993) RPC 107

<sup>49</sup> Section 1(2) (b) P.D.A

<sup>50</sup> Section 1 (4) & (5) of the P.D.A. Note that a biological process is the science of the processes of life in animals and plants whereas a microbiological process is the science of the study of micro-organisms such as bacteria, viruses or fungi from which vaccines are produced and, which can be manufactured and applied in the drug industry.

pattern to be multiplied by industrial process and is not intended solely to obtain a technical result<sup>51</sup>.

**(a) Objective of the Law**

It has been submitted that the primary objective of the law governing industrial design, is to protect a design that is new, and that this protection is of immense important to artists, designers of clothing and designers of other types of products such as ceramic, marble, earthenware, plastics products et certera<sup>52</sup>.

The protection extends only to acts done for commercial and industrial purposes and it durable for a period of five (5) years and renewable for two further consecutive periods of 5years<sup>53</sup>.

**(c) Criteria for Registration**

The condition precedent for registration of an industrial design is that the industrial design is new; it is not contrary to public order or morality; and it must not have been made available to the public<sup>54</sup>. The same definition of newness; morality; and publication that applies to patents (discussed earlier) also applies to industrial designs and there is no need for repetition here except to refer to some decided cases to buttress the points.

**Conclusions**

This paper has attempted to show the nature of protection given to intellectual property law by the Trademarks, Patents and Design Law. In concluding this discourse, it is considered important to critically examine the submission of the learned author Babafemi, F. O., at page 428 of his book cited by us in this paper. He submitted that the P.D.A. does not sate specifically which designs should be excluded for registration, and suggested that works of sculpture (other than casts or models used for industrial process), wall plaques and medals, and printed matter, primarily of a literary or artistic character et cetera should be excluded form registration.

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<sup>51</sup> Section 12 P.D.A.

<sup>52</sup> Babafemi, F. O. Op. Cit Page 412

<sup>53</sup> Sections 19(2) (a) & 20(1), P.D.A.

<sup>54</sup> Section 13(1) – (4)

With the greatest respect to the learned author, one finds it extremely difficult to fully appreciate that submission because by law, works of sculpture, wall plaques and medals and printed matter are protected under Copyright Law<sup>55</sup>. This is more so as the learned author's discussion of Copyright works in the earlier chapter of his book, rightly categorized sculptures, wall plaques and medals as works of arts, whereas book jackets, calendars, coupons are literary works. It is therefore correct to submit that Copyright is available to protect artistic designs, whether in two-dimensional form as graphics works or photographs, or in a three dimensional form as sculptures works or architecture or works of artistic craftsmanship<sup>56</sup>.

### **Recommendations:**

It is submitted that many provisions of the Nigeria trademark Act are anachronistic. It is therefore recommended that the entire law should be overhauled to cater for modern commercial activities like the British did, in promulgating the 1994 Trademarks Act. For example, under the old United Kingdom 1938 Act (Modeled by the current Nigeria Act), shapes could not be registered, but this position has changed under new British U.K. Act and ought to be reflected in the Nigeria Law. The relevance of this can be likened to the Coca-Cola case<sup>57</sup>, which concerned an application in 1986 to register the famous Coca Cola bottle as a trademark, and the House of Lords held that the shape of the bottle was not registerable as a trademark. But after the 1994 Trade Marks Act, which provided that a trademark may consist of words, designs, or the shape of goods or their packaging (et cetera), the Trade Mark Registry accepted the shape of the Coca-Cola bottle as a trade mark.

Similarly under the U.K. 1994 Trade Mark Act, will not be registered if its use could be presented by the passing off action in law<sup>58</sup>. It is recommended that S. 11 of the Nigerian Trade Marks Act be amended to reflect this important position. It will strengthen trade mark protection.

There is no criminal remedy for infringement of a patent or a Trade Marks or Industrial Design Rights under both Trade Marks and Patent and Designs Act, the same way, it is provided for under the copyright Act. Since the purpose of these intellectual property Acts are to protect

<sup>55</sup> Section 6 of Copyright Act Cap 28 LFN 2004

<sup>56</sup> Hart, T. (et al) Op Cit. Page 260

<sup>57</sup> Coca – Cola Trade Mark Applications (1986) 2 All E.R. 274 (referred to in Hart, T. (et al) Op Cit. Page 93

<sup>58</sup> Section 5(4) (a)



from annexation, the fruits of another person's work, which in turn will stimulate the economy, it is recommended that there is need to further protect Trade Marks, Patents and Designs, by providing for criminal remedies in both Acts. This criminal aspect is imperative to enable the law catch up with those persons who are in the business of producing and selling counterfeits and forgeries.