

HOW EARLY TRADE MARK FILING PROTECTS YOUR BRAND



In this advanced digital age, where imitation has become extremely easy, the best way to guarantee the protection of your brand is by registering it with the Trade Mark Registry. The earlier you register your brand, the more likely it is protected. This is because under Nigerian law, specifically section 3 of the Trade Marks Act, 1967 (“Trade Marks Act”) you are not entitled to institute any proceeding to prevent, or to recover damages for, the infringement of a trade mark until it is registered.^[1]

What Marks are Protected under the Trade Marks Act?

A trade mark is any sign, or any combination of signs, used to distinguish the goods and/or services offered by a person or organisation or brand from those offered by another person or organisation. Article 15.1 of the Trade Related Aspects of Intellectual Property Rights (TRIPS) describes a trade mark as follows:

“Any sign or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements, and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade mark.”

Section 67 of the Trade Marks Act defines a “mark” to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. The amendment of Section 67 of the Trade Marks Act by Section 69 of the Business Facilitation (Miscellaneous Provisions) Act, 2023 (BFA) further defines “trade mark” to include “...shape of goods, their packaging and combination of colours”.

When we combine the content of these sources together, it becomes clear that the definition or constitution of “trade mark” is wide. It goes beyond just a word or logo. It also covers shapes, signatures, numerals etc. In jurisdictions like the United States of America, Australia, United Kingdom etc., non-traditional marks like sound marks, figurative elements, smell and texture marks, and hologram marks can also be registered as a trade mark provided they meet certain requirements.

Notably, the non-traditional marks like hologram marks, smell, sounds, etc., are yet to be recognized as registrable under the Nigerian legislation.

Registration and Protection of Trade Marks

As earlier stated, the best and most common way to protect your trade mark is by registering it at the Trade Mark Registry. Trade mark registration gives your brand an exclusive identity and protection against unauthorized use of your brand name, logo, or identifier. Furthermore, it enhances your brand's value and business assets.

[1]See Dyktrade Ltd v. Omnia (Nig) LTD (2000) LPELR-977(SC)

For instance, a registered trade mark gives you the right to assign, license, and sell the trade mark, providing potential revenue streams for your brand. Trade mark registration also protects your brand by providing you with the right to seek legal remedies in cases of infringement or potential infringement. The Court may grant restraining injunctions to prevent acts or potential acts of infringement and may also grant monetary damages in favour of a Trade mark owner whose trade mark has been infringed upon if financial loss flows from the infringement or if the trade mark infringer secured undue financial benefits from the infringement.

How does the early filing of trade marks protect your brand?

- **Priority rights**

Filing your trade mark early secures the earliest possible filing date and, in the long run earliest registration, which effectively gives you priority rights in Nigeria, where we operate the first-to-file system. This date becomes a legal claim of ownership even before the certificate is granted. Once you file your application, you gain priority over anyone who tries to register the same or a similar trade mark after your filing date, even if the application is still pending. In case there is a dispute, your filing date serves as proof of priority.

- **It prevents brand theft or Imitation.**

The digital space is rapidly evolving, and it is important for brands to protect their brand names and ideas from public imitation. Any delay in filing or registering your trade mark exposes you to the risk of leaving your brand open to exploitation by opportunists, including competitors, counterfeits, or domain squatters who might (upon noticing your thriving brand) rush to register your trade mark before you do.

- **Trade Mark filing acts as public notice**

Once a trade mark application is filed and published in the trade mark Journal, it becomes a public record. This means when someone else seeks to register a similar mark and searches the registry portal, the search would show that your mark has been filed. The publication therefore insulates your brand from deterrents or potential infringers who might want to register your trade mark or a similar trade mark.

Additionally, a registered trade mark shows professionalism and preparedness to potential investors seeking to commit their resources to your brand. It also shows that your brand's intellectual property is legally protected, and this would, in turn give the comfort that any investment in your brand would enjoy an additional layer of protection.

- **Registration protects your business plans**

Under Nigerian Law, a trade mark does not need to be in actual use before it can be registered, an intention to use the mark is sufficient for registration. What the law requires is that you are the proprietor of the trade mark. A lot of people begin to build their businesses and brands before they are fully launched. Some even have ideas and do not have the resources to execute them. Whether you are developing a product or building a service, early filing/registration helps secure your brand identity while you are still acting behind the scenes.

In essence, you can protect your trade mark at the earliest possible stage, even at the pre-launch stage, especially when pitching to potential partners, investors, etc.

Class of trade mark registration

Trade marks are typically registered according to classes. Thus, at the time of filing, a trade mark applicant will be required to indicate and register his trade mark in respect of particular goods or classes of goods under the relevant classes. Any question arising as to the class within which any goods fall shall be determined by the Trade Mark Registrar, whose decision is final. The implication of this is that trade mark registration only protects the trade mark owner only within the registered class or category, subject to certain exceptions such as trade mark dilution.^[2]

Conclusion

Although registering your trade mark and obtaining a trade mark certificate is an important step for brand protection, doing so at the earliest possibility is more advantageous. Simply filing a trade mark application even before the certificate is granted can offer significant legal advantages. By initiating the registration process, you effectively establish a priority date, which secures your place in line, ahead of others who may attempt to register or use a similar mark later. This early filing can serve as a strong foundation for opposing subsequent applications or pursuing passing off actions against infringing parties. It signals your intent to claim ownership of the mark and puts others on notice, reducing the risk of legal disputes down the line. Therefore, taking prompt action to apply, even without immediate certification, is a proactive and strategic move in safeguarding your brand's identity and market position.

[2] See section 4 of the Trade mark Act.

At Abe & Asotie LP, we help clients to protect their brands, identity, trademarks etc., by helping them to register their trade marks at the Trade Marks registry. We also represent them at the Trade Marks Registry and Court where:

- (i) their trade marks are infringed upon;
- (ii) their trade mark registration is being challenged; and
- (iii) when they seek to challenge registration of an infringing mark.



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