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ANNUAL NATIONAL LEGAL INSIGHTS CONFERENCE

**AN ANALYSIS: TRADEMARK LAW IN THE
MUSIC AND FILM INDUSTRIES IN
NIGERIA**

BY

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OUTLINE

- 1.0 Introduction to intellectual property (IP)
- 2.0 Trademarks (Definition, types, requirement of a mark, non-registrable marks, first to file/ first to use, how to proof infringement.
 - 2.1 Trademark in the Music industry
 - 2.2 Trademark in the Film industry

INTRODUCTION TO IP

- WIPO defines intellectual property as creations of the mind such as inventions, literary and artistic works, designs, symbols, names and images.
- There are various types of intellectual property.
- Trademarks, copyright, patent, industrial design, utility model, geographical indication, traditional knowledge.

TRADEMARKS

- WIPO- A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors.
- INTA: A trademark is any word, name, symbol or device (or any combination thereof) that identifies and distinguishes the source of the goods of one party from that of another.
- Simply, trademark is any sign or mark that distinguishes one entity's goods or services from that of its competitors.
- In Nigeria, Trademark is governed by the Trademarks Act, 1967.
- Trademarks are broadly registered under the NICE Classification system which has 45 classes.
- Classes 1 – 34 – Goods
- Classes 35-45- Services

CRITERIA FOR REGISTRABILITY

- Article 6quinquies.B of the Paris Convention states that trademarks enjoying protection under Article 6quinquies A “may be neither denied registration nor invalidated except in the following cases:
 - 1) when they are of such nature as to infringe rights acquired by third parties in the country where protection is claimed”;
 - 2) when they are devoid of any distinctive character”;
 - 3) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public”

MOST NATIONAL LAWS COMPLY WITH THE ABOVE

What is obtainable in Nigeria?

- Sections 9 and 10 of the Trademark Act
- In Nigeria, a trademark must contain or consist of at least one of the following essential particulars-
 - (a) the name of a company, individual, or firm, represented in a special or particular manner;
 - (b) the signature of the applicant for registration or some predecessor in his business;
 - (c) an invented word or invented words;
 - (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
 - (e) any other distinctive mark

Summarised criteria for registrability in Nigeria

Distinctiveness- A trade mark must be distinctive and not descriptive of the good or service.

Apple, samsung, nokia for Phones. BMW, BENZ for cars. They may have no meaning.



Mercedes-Benz

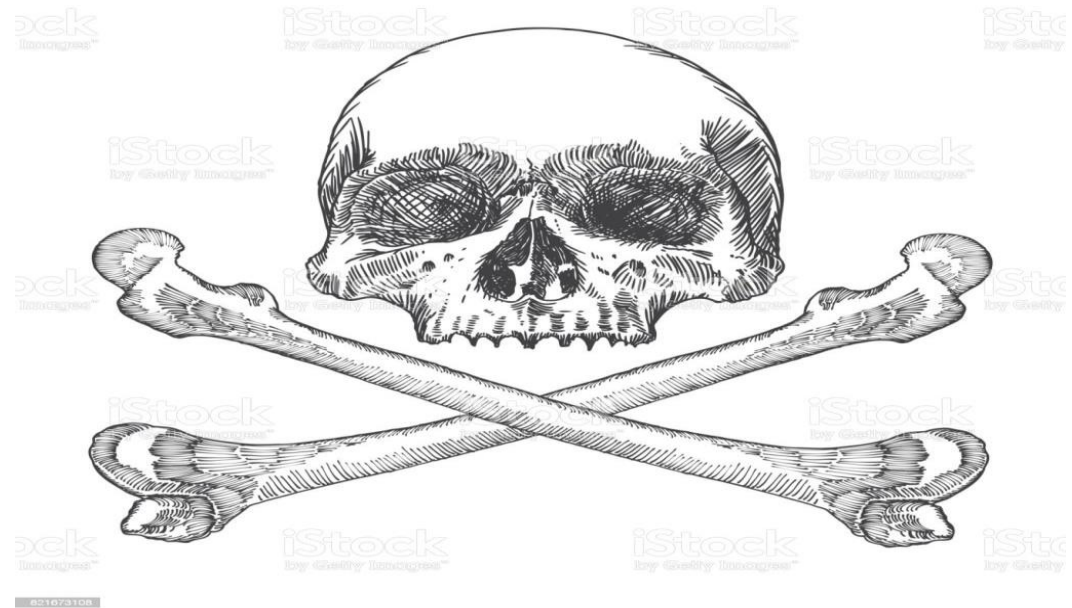


The proprietor of a mark must ensure that the mark does not lose its distinctiveness by becoming generic.

A mark is generic when it is already been used as a name for a category of goods. I.e. cornflakes, cellophane, escalator

Continuation

- Not against public morality or policy:



Not deceptive or misleading

Names of chemicals cannot be registered

**Must not be a state emblem or logo or identical i.e Trademark of e-naira,
NigeriaAir.com, NigeriaAir.ng**

Test for confusingly similar marks

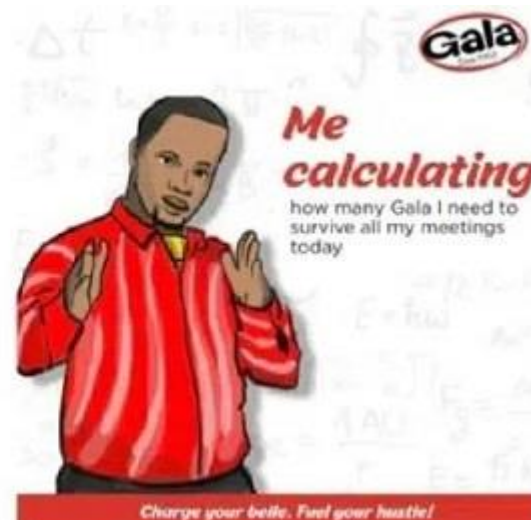
The consumer who averagely purchases the good or receives the service is a perfect person to determine this.

- **Appearance:** If the marks are exactly the same in spelling, there is a greater chance that consumers may be confused if they assume that the goods and services emanate from the same source.



Sound: If the marks have a slightly different spelling but are pronounced the same, there is a greater likelihood of confusion between them. For example, using the “Koka Kola” mark to sell beverages may cause consumers to confuse the products with the Coca-Cola® brand of beverages.

- **Commercial Impression:** When a mark gives consumers the impression that it is sponsored by, endorsed by, or somehow affiliated with a different brand or its products, confusion could be likely.



VARIOUS MARKS

a logo	a slogan	a word
a numeral	a personal name	a scent
a color	a building	a sound
a letter	a device	a shape
a phrase	a package design	a combination of any of these

EXAMPLES

- Words: 'Apple' for computers; Samsung, Apple, Nokia
- Arbitrary or fanciful designations: Coca-Cola, Nikon, Sony, NIKE, Easy Jet.
- Names: Ford, Peugeot, Hilton (hotel)
- Slogans: 'Fly me' , for an airline;
- Devices: the star for Mercedes Benz, the flying lady for Rolls Royce
- Number: the 4711 cologne
- Letters: CNN, GM, FIAT, VW, KLM
- Pictures or symbols: Lacoste (small crocodile)

TYPES OF TRADEMARKS

- Collective marks
- Certification marks
- Well known marks

COLLECTIVE MARKS

- A collective mark may be owned by an association which itself does not use the collective mark but whose members may use the collective mark.
- Members may use the collective mark if they comply with the requirements fixed in the regulations concerning the use of the collective mark.
- Its purpose is to indicate membership.
- An enterprise entitled to use the collective mark may in addition also use its own trademark.
- A collective mark can be for goods or services.
- I.e FCI Arb for persons that belong to Chartered Institute of Arbitrators

CERTIFICATION MARKS

- The certification mark may only be used in accordance with the defined standards.
- A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of a given standard or characteristics such as origin, materials, mode of manufacture of the goods or performance of services, quality or accuracy.
- Used to confirm that the good or service conforms with a standard.
- The main difference between collective marks and certification marks is that the former may be used only by particular enterprises, for example, members of the association which owns the collective mark, while the latter may be used by anybody who complies with the defined standards.
- Thus, the users of a collective mark form a “club” while, in respect of certification marks, the “open shop” principle applies.

WELL KNOWN MARKS

Agreement on Trade-Related Aspects of Intellectual Property (TRIPS)

- ❖ Well known, famous, familiar foreign marks
- ❖ Protected whether registered or not
- ❖ Should be known in the jurisdiction by intended consumer or industry

The Google logo, consisting of the word "Google" in its characteristic multi-colored font (blue, red, yellow, blue, green, red).

FIRST TO FILE/ FIRST TO USE

- The principle of first to file means that trademark protection will only be accorded to a person that first makes an application for registration to the Trade marks registry.
- The principle of first to use means that protection is accorded to the person who first commenced the use of the mark.
- Nigeria adopts the first to file principle.

EXCEPTIONS OF FIRST TO FILE PRINCIPLE IN NIGERIA

- Well known marks
- Proprietor of a mark is not allowed to interfere with a confusingly similar mark in line with section 7 of the Trademarks Act and American Cyanamid company v. Vitality pharmaceuticals limited (1991) LPELR-SC.12/1989.
- In this case, Vitality Chemist was registered as a business name and was into the business of importing and marketing drugs with the brand; GONORCIN. The plaintiff later trademarked the brand GONOCIN for the sale of drugs and took out an action against vitality and prayed for an injunction amongst several other reliefs. Vitality raised the defence of first use in line with section 7 of the trade marks Act and counter-claimed. All the courts from trial, court of appeal up to the supreme court dismissed the claims.
- The section is a shield and not sword for the first user.

THE FIRST USER CAN ONLY SHIELD HIMSELF AND NOT FIGHT THE PERSON WHO FILED FIRST



TRADEMARK IN THE MUSIC INDUSTRY

- Record Label
- All marks in both industries must satisfy the criteria for registrability i.e distinctiveness



Name of Artist

Lagbaja

Wizkid

Beautiful Nubia

Zlatan Ibile

Phyno

Others

- Band names
- Title of song
- Slogan/ slang – Gbe body e by Zlatan
- Short lyrics
- All the above can be used for merchandise

TRADEMARK IN FILM INDUSTRY

- Film title
- Name of unique characters- Domitilla case
- Name and logo of film companies

- All the above can be used for merchandise

ANY QUESTION?

THANK YOU