

ARTICLE SERIES

**REVOCAION OF TRADEMARKS IN NIGERIA:  
AN ANALYSIS OF NON-USE AS A KEY  
CONSIDERATION**



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## ABSTRACT

*Under the Trademarks Act of Nigeria (“TMA” or the “Act”), there are various grounds for which the Registrar may revoke a trademark upon the application of an applicant. One of these grounds is the concept of non-use, which appears to be one of the most compelling and universally accepted grounds for revoking a trademark. However, the application of non-use in Nigeria is quite distinct from other countries, as will be further explored in this paper. While several jurisdictions commonly associate prior-use and non-use of a registered trademark, this is not the case in Nigeria. The Act clearly defines the parameters for the application of this ground, including the time frame and its exceptions, as outlined in sections 31 and 32 of the Act. Against this backdrop, this article examines non-use as a ground for revoking a trademark in Nigeria.*

**Keywords:** Revocation; Non-use; Trademark; Well-known marks; Nigeria.

## 1.0 INTRODUCTION

The registration of a trademark in the Register of Trademarks does not guarantee perpetual protection of the mark under the registered class. Registration is valid for seven years, with the possibility of renewal for subsequent fourteen-year periods. Moreover, the Act stipulates specific instances in which a registered trademark may be cancelled or revoked from the Trademark Register upon application. These instances include:

- a) Non-use of the registered trademark.
- b) Failure to observe a condition precedent entered on the register in relation to a trademark.
- c) Failure to renew an expired trademark registration.

This article will primarily focus on the topic of "non-use of the registered trademark." It is important to note that Nigeria lacks sufficient case law that provides a comprehensive interpretation of the application of this ground. To gain a better understanding of its scope and operation, a comparative analysis will be conducted with other jurisdictions.



## 2.0 NON-USE AS A GROUND FOR REVOCATION OF TRADEMARK

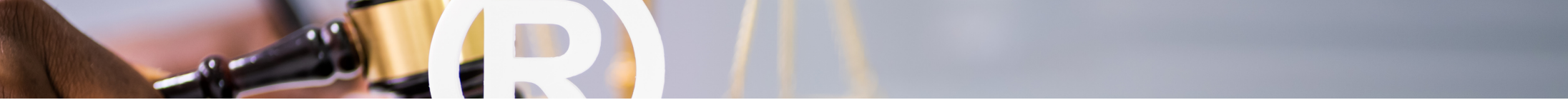
Section 31(1) of the TMA states that a registered trademark can be removed from the Register of Trademarks in relation to specific goods for which it is registered. This removal can be initiated through an application made by any party with a vested interest, either to the court or to the Registrar, at the applicant's discretion. The grounds for such removal are as follows:

- a) The trademark was registered without any bona fide intention on the part of the applicant for registration to use it in relation to those goods, and there has been no bona fide use of the trademark in relation to those goods by any proprietor up to one month before the date of the application.
- b) A continuous period of five years or longer has elapsed, during which the trademark was registered but not used in relation to those goods by any proprietor.

The first ground refers to a situation where the proprietor had no bona fide intention to use the mark at the time of registration, and there was no actual use of it after being registered for one month preceding the application for removal. Therefore, if the proprietor had no intention to use the mark at the time of registration but later used it in relation to the registered goods, there would be no claim of non-use, and the mark cannot be removed from the register. The Court of Appeal, in *The Procter and Gamble Company v Global Soap and Detergent Industries Ltd & Anor*, interpreted Section 31(2)

(a) of the TMA as follows:

"It is well established that when the provision of a statute is clear and unambiguous, the Court must give effect to its literal meaning... To establish non-use of the trade mark under Section 31(2)(a), two conjunctive elements must exist: 1. At the time of registration, the trademark was registered without a bona fide intention to use it, and 2. There has been no bona fide use of the trademark by the proprietor up to one month before the date of the application... The word 'and' in Section 31(2)(a) indicates that both elements are conjunctive and must be construed as such. Therefore, the applicant seeking to remove a trade mark must prove an intention not to use the trade name at registration and no bona fide use by the proprietor up to one month before the application."



The second ground refers to a situation where there may have been an initial bona fide intention to use the mark in relation to the registered goods or services, but a continuous period of five years and one month has elapsed without any use of the mark in relation to those goods or services. The computation of time for the second ground is important because the applicant must show that the mark was not used for five years, counting backward from within a month of the application, rather than five years from the date of registration. The Court of Appeal, in *The Procter and Gamble Company v Global Soap and Detergent Industries Ltd & Anor*, explained the two grounds for revocation based on non-use:

"A recurring factor in both grounds (Section 31(2)(a) & (b)) is that non-use is computed from a month before the application to expunge the trade mark is made. The difference lies in the first ground dating back to the time of registration, while the second ground dates back five years. In essence, the first ground consists of two concurrent elements before an order of removal can be made. The second ground has only one element: a continuous period of non-use for five years preceding a month before an application for removal is made."

Section 31(3) of the TMA is worth mentioning, as it allows the trademark tribunal to refuse an application made under Section 31(1) and/or (2) if it is shown that there has been bona fide use of the trade mark by any proprietor, in relation to goods of the same description as those to which the application relates, before the relevant date or during the relevant period. However, the tribunal cannot refuse the application for removal of the trade mark if the applicant has been permitted under Section 13(2) of the TMA to register an identical or nearly resembling trade mark for the goods in question, or if the tribunal deems it appropriate to permit the applicant to register such a trade mark.

Section 31(4) of the TMA provides specific parameters for non-use in the second ground. It states that an applicant cannot rely on non-use of a trademark if it can be demonstrated that such non-use was due to special circumstances in the trade, rather than an intention to refrain from using or abandoning the trademark in relation to the relevant goods.



### **3.0 EXCEPTION TO REVOCATION ON THE GROUND OF NON-USE: WELL-KNOWN MARKS**

According to Section 31(1) of the TMA, a registered trade mark cannot be removed from the Register of Trademarks if it falls under the category of well-known marks, registered in respect of various classes of goods in the trademark register due to their popular status among the public. This applies even if the mark is not employed for all the classes of goods for which it is registered.

The law on well-known marks is explicitly provided in Section 32(1) of the TMA. It states that when a trade mark consisting of an invented word or words has become so well known, as respects any goods in respect of which it is registered and in relation to which it has been used (referred to as "the familiar goods"), that its use in relation to other goods would likely indicate a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the familiar goods, the trade mark may be registered in the name of the proprietor in respect of those other goods as a defensive trade mark. This registration can occur even if the proprietor registered in respect of the familiar goods does not use or intend to use the trade mark in relation to those other goods, and notwithstanding anything in Section 31 of the Act. Once registered as a defensive trade mark, the trade mark cannot be removed from the register in respect of those goods under Section 31 of the Act.

The principle of non-use stipulates that the absence of utilization of a trademark in the registered class constitutes a valid ground for revocation. However, an exception to this rule is recognized for well-known marks. Section 31(1) acknowledges that a highly renowned mark may be exempted from revocation on the Trademark Register if the proprietor submits an application and the mark receives appropriate acknowledgment from the Registry as a well-known mark.



## **4.0 COMPARATIVE ANALYSIS WITH OTHER JURISDICTIONS: UNITED STATES OF AMERICA & UNITED KINGDOM**

### **4.1 United States of America**

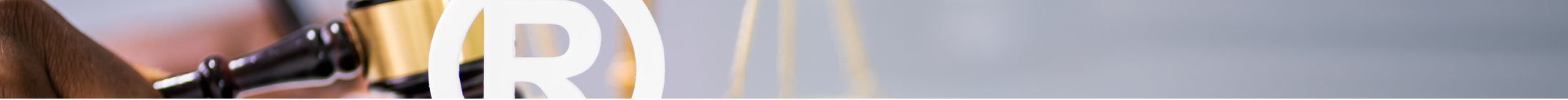
Unlike the Nigerian Trade Mark Act, the trademark system in the United States requires compelling proof of commercial usage for a mark to be eligible for registration, known as prior use. The United States operates a use-based Register, where genuine utilization of the mark in regular trade practices is necessary, rather than a mere attempt to secure rights to the mark.

To qualify for trademark registration in the United States, the applicant must demonstrate that the marks are visible on the goods themselves, their containers, or the displays associated with the goods. Furthermore, the goods must be sold or transported in commerce. For services, the applicant must provide evidence that the mark is actively used or displayed in the sales or advertising of those services, and the services themselves must be rendered in commerce.

The prerequisite of prior use for trademark registration in the United States can pose challenges for individuals initiating their business endeavors without substantial usage of the mark. This requirement may limit their ability to obtain trademark protection, potentially hindering the establishment and protection of their brand identity in the early stages of their business operations. Unlike in Nigeria, the responsibility of providing evidence of prior use in commerce lies with the applicant, rather than the individual challenging the registration.

### **4.2 United Kingdom (UK)**

Similar to Nigeria, trademarks in the UK can be removed from the Register on the ground of non-use, referred to as revocation for reasons of non-use. The UK does not require prior use of the trademark as a condition for registration. Under the UK Trademarks Act of 1994, an individual can initiate an application to revoke a registered trademark if the mark has remained unused for a continuous period of five years from its registration, without valid justification for the non-use. Additionally, an applicant may seek revocation of a trade mark if its use has been suspended for an uninterrupted period of five years, with no proper reasons for the non-use.



The applicant has the option to seek revocation of either the entire trademark registration or only for specific goods and services covered by the mark. The application for revocation can be submitted to the Intellectual Property Office on the day following the fifth anniversary of the registration date or from the date when the registered mark ceased to be in use.

## **5.0 CONCLUSION**

The concept of utilizing non-use as a basis for the revocation of a trademark is commendable and an essential aspect of trademark legislation. Despite variations across jurisdictions, the fundamental principles of trademark protection remain intact within the prevailing trademark regime in Nigeria. These principles uphold the notion that individuals should not unfairly exploit another person's brand, and trademarks should not be monopolized by those with no genuine intention of utilizing them.



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