



UDO UDOMA &
BELO-OSAGIE

**DID YOU
KNOW SERIES**

(Vol. 3)

**EXPANSION OF THE SCOPE OF A
“TRADEMARK”
UNDER THE TRADE MARKS ACT**





Shape of Goods, Packaging and Combination of Colours

Did you know that you can register the shape of goods, their packaging or a combination of colours as trademarks in Nigeria?

- Traditionally, business owners view trademark registration as a way of protecting their brands by registering the distinguishing names, logos, and symbols for their business. However, trademark protection ought to extend beyond names, symbols, and logos. For example, the unique design, packaging, combination of colours, and services owned by a business ought to be afforded statutory protection upon registration.
- While the Trade Marks Act, Cap 436, LFN 1990 ("**Trade Marks Act**") does not provide an exhaustive list of what "marks" could be registered as a trademark, the Business Facilitation Act 2023 ("**BFA**"), has amended the definition of a "trade mark" to include the shape of goods, packaging and combinations of colours.¹ Thus, section 69(b) of the BFA amends section 67 of the Trade Marks Act and provides thus:

"trade mark" means — (a) a mark used or proposed to be used in relation to goods or services for the purpose of indicating a connection between the goods or services and a person having the right, either as a proprietor or as a registered user, to use the mark, whether with or without any indication of the identity of that person, and may include shape of goods, their packaging and combination of colours; (amendment emphasised)

- The inclusion of packaging in the definition of a trademark acknowledges the dynamic nature of consumer tastes and the significance of visual components for brand recognition. This also extends to the shape of goods that may now be registered as trademarks. Thanks to amendments by the BFA, businesses that invest in unique and innovative packages and product designs may now protect these components, encouraging competition and innovation in the market.
- Additionally, the inclusion of a combination of colours further enhances the role and importance of creative distinctiveness through colour combination. This acknowledges the potential aesthetic effect and originality of a brand resulting from original colour combinations. Businesses that use certain colour schemes as a component of their brand identification may now benefit from legal protection, giving them a competitive edge.

¹ Section 69 of the BFA.



- The amendment by the BFA is consistent with the recent Supreme Court decision in *Intl Tobacco (Nig.) Ltd & Ors v. B.A.T (Nig.) Ltd & Anor*,² where the apex court recognised the significant role the colour(s) of a trademark plays in protecting its distinct identity.
- It is important to note, however, that this does not suggest that any one brand can decide to lay a monopolistic claim to a particular colour or common product shape. To qualify for trademark registration, the proposed trademark is still required to meet the set standard of distinctiveness under the Trade Marks Act.
- Although first appearing minor, the amendments to the definition of “trademarks” could have far-reaching implications for businesses operating in Nigeria. First, it provides businesses with broader protection for their brand elements, fostering creativity and innovation in product design, service offering, packaging, and colour schemes. This increased protection helps safeguard businesses against potential infringement and counterfeiting.
- Additionally, the expanded definition of trademarks promotes healthy competition by encouraging businesses to invest in distinctive and innovative elements. This creates a dynamic market environment where consumers are presented with a diverse range of unique products and services.

Service Marks

Did you know that under international Intellectual Property law, there is a framework for the registration of marks that identify the services provided by a person or an organisation?

- The BFA has regularised the framework for the registration and protection of marks referred to as service marks. Before the amendment of Section 67 of the Trade Marks Act Cap T13, LFN 2004 (“**Trade Marks Act**”) by the BFA, there was no legislative framework in Nigeria recognising service marks as a registrable category of intellectual property rights and outlining a procedure for the registration of such marks.
- Service marks are a category of trademarks used to identify services rather than tangible goods or products. As opposed to conventional trademarks, service marks refer to brand names, brand images, or logos that identify and distinguish the provider of a particular service or group of services.

² (2023) LPELR-60272(SC)



- The concept of service marks protection in Nigeria became increasingly popular in the early 2000s. This increased popularity formed a basis for the amendment of Trade Marks Regulations in 2007, by the then Minister of Commerce and Industry in furtherance of his administrative powers under Section 42(1) and Section 45 of the Trade Marks Act, to include a special classification of goods that could be registered to cover both goods and services.
- Section 69 of the BFA, in amending the definition of “goods” under the Trade Marks Act, extended the scope of the definition to include “services”. Under the same Section 69, the BFA substituted the definition of “trade mark” under Section 67 of the Trade Mark Act with a new definition of “trade mark”, which now includes – “services.”
- In terms of the benefits of the amendment, this will help businesses maintain consistency and uniformity across different markets, facilitate brand recognition, and allow customers to differentiate between similar services offered by different service providers with more ease than would otherwise be possible.

This update is for general information purposes only and does not constitute legal advice. If you need any legal advice in relation to your intellectual property or information about our practice offerings, please contact us at IPTeam@uubo.org.