

## **Non-Traditional Trademarks in Nigeria – A Comparative Analysis**

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### **Introduction**

Non-traditional trademarks are trademarks which do not belong to a pre-existing, conventional category of trade mark, and therefore often difficult to register, but which may nevertheless fulfill the essential trademark function of uniquely identifying the commercial origin of products or services.<sup>1</sup> Such conventional trademarks include words which are invented and must not have an ordinary dictionary meaning, for instance, Kodak (both the camera and name) which is an invention of founder George Eastman, he made it up. A mark may also include letters, numerals, or combinations of both. A logo may be an abstract design, stylization or simple reproduction of everyday objects or images.<sup>2</sup>

However, over time other elements besides words, logos or graphic designs have served to identify the source of goods or services, thus serving the function of marks. These are called non-traditional marks, such as smells, colours, shapes, sounds, tastes and holograms etc. Different countries grant them varying levels of protection. What is considered a protectable "non-traditional" mark in a country may not be granted any level of protection in another.<sup>3</sup> This paper therefore seeks to look into the level of protection afforded non-traditional trademarks, if any, by Nigerian trademark law and practice.

### **Trade Marks Act (TMA),1965**

Under section 9(1) of the Nigerian Trade Marks Act 1965, in order for a trademark to be registrable it must contain or consist of at least one of the following:

- 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 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:

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<sup>1</sup> [http://en.wikipedia.org/wiki/Non-conventional\\_trademark](http://en.wikipedia.org/wiki/Non-conventional_trademark)

<sup>2</sup> <http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx>

<sup>3</sup> <http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx>

provided that a name, signature or word or words other than such as fall within paragraphs (a) to (d) of this section, shall not be registrable under paragraph (e) of this section, except upon evidence of its distinctiveness.<sup>4</sup>

It appears from the above definition that, as regards registration of non-traditional trademarks in Nigeria, paragraph (e) provides an avenue for registration. Accordingly, should an application be made at the Nigerian Trade Marks Registry for a non-traditional trademark, it is potentially registrable, as there are no express prohibitions under Nigerian trade mark law. However, the major hurdle to be faced by an applicant of a non-traditional trademark is satisfying the Registry that the mark possesses the element of distinctiveness. Another major hurdle, as will be identified below, is the criterion of graphical representation. Let us now look to examples in other jurisdictions, in particular the European Community, where non-traditional trademarks are being applied for and protected, bearing in mind that filings in the Community are invariably filings in the United Kingdom, the trademark laws and practice of which are of a persuasive nature to Nigerian trademark law and practice.

The European Community Trade Marks Directive sets out a non-exhaustive list of signs that may be registrable as trademarks. This open-ended list allows for the registration of various types of trademarks, traditional and non-traditional.

### **Smells**

In *Ralf Sieckmann*<sup>5</sup> the European Court of Justice (ECJ) indicated that a smell will not be adequately graphically represented by a verbal description because it will not be 'sufficiently precise'. Sieckmann had sought to register the smell of cinnamon as a trademark in Germany, and as well as providing a verbal description had also attempted to represent the mark by way of a chemical formula and a sample. The ECJ also indicated that these other mechanisms would not meet the requirements of the EU Trade Marks Directive: a deposit of a sample is not a graphic representation, but in any case would not be sufficiently durable or stable; and a chemical formula (though probably a representation of a chemical rather than an odour) would not be sufficiently intelligible, clear or precise.<sup>6</sup>

It was also held that in order to render a sign registrable as a trade mark the graphic representation must be **clear, precise, self-contained, easily accessible, intelligible, durable, and objective**. These criteria are collectively referred to as the 'seven *Sieckmann* criteria', and are generally used as criteria for the registration of non-traditional trademarks.

### **Colours**

In the case of *Libertel*,<sup>7</sup> the ECJ considered the extent to which trade marks comprising a single colour could be registered. In this case the applicant had sought to register the colour orange for telephone books in class 9 and telecommunication services in classes 35-38. The court held that a mere sample of a colour would not satisfy the *Sieckmann* requirements, because the exact shade of colour on paper cannot be protected from the effects of the passage of time. The court noted that a designation using an internationally recognized identification code (such as a colour's Pantone number) might be considered to constitute a graphic representation, adding that such codes are precise and stable.

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<sup>4</sup> Section 9(1) Trade Marks Act, 1965

<sup>5</sup> Case C-104/01 [2004] FSR (4) 65 (ECJ).

<sup>6</sup> Bently & Sherman, Intellectual Property Law, 2<sup>nd</sup> edition, p.773.

<sup>7</sup> *Libertel Groep BV v. Benelux-Merkenbureau* Case C-104/01 [2004] FSR (4) 65.

Moreover, the use of a sample, verbal description and international code might, in combination, satisfy the *Sieckmann* criteria.<sup>8</sup>

### **Shapes**

In practice, protection of shapes is approached with some caution under EU law, even though the shape of goods or their packaging is expressly mentioned in the definition of what can be a sign. Among other things, EU law prohibits registration of signs consisting exclusively of shapes that:

- result from the nature of the goods themselves;
- are necessary to obtain a technical result; or
- give substantial value to the goods.<sup>9</sup>

It has been held that a verbal description of shape or packaging will rarely ever be satisfactory because it will not convey the precise appearance of the sign: rather design drawings or photographs will be necessary.<sup>10</sup>

### **Sounds**

In *Shield Mark BV*<sup>11</sup>, the court considered the application of the graphic representation requirement to sounds. The case concerned two marks: the first nine notes of the melody for Beethoven's 'Für Elise' and the crowing of a cock. The applicant had used musical notation (including the instructions to be played on the piano), onomatopoeic representation (kukelekuuuuuu) as well as a verbal description 'the crowing of a cock'. The court stated that a score which comprised a stave with a clef, musical notes, and rests whose form indicates relative values and, where necessary, accidentals (sharp, flat, etc.) would satisfy the seven *Sieckmann* requirements. This was so even though no one can read music: the requirement is 'intelligibility', not 'immediate intelligibility'.<sup>12</sup>

In contrast, the mere verbal description of sounds (of the type involved in the case) would lack clarity and precision. The court held that onomatopoeic representation was problematic for two reasons: first because there is a lack of consistency between the onomatopoeia itself and the sound; secondly, because perceptions of an onomatopoeia are individual (and hence subjective) or at least culturally determined (in English, for example, such a sound would be represented as 'cock-a-doodle-do'). Consequently, a simple onomatopoeia cannot without more constitute a graphical representation of the sound of which it purports to be a phonetic description'.<sup>13</sup>

### **Taste**

In *Eli Lilly*, the applicant applied to register the taste of artificial strawberry in respect of pharmaceuticals. This application was initially rejected on the ground that the mere verbal description was not sufficiently precise, but ultimately the examiner based her objection on lack of distinctiveness.<sup>14</sup>

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<sup>8</sup> Bently & Sherman, *Intellectual Property Law*, 2nd edition, pp. 771-772.

<sup>9</sup> Marsland, V., *Non-Traditional Trademarks in the Community Trademark System*, *World Trademark Review* (July/August 2007), pp. 86-87.

<sup>10</sup> Bently & Sherman, *Intellectual Property Law*, 2nd edition, pp. 771.

<sup>11</sup> *Shield Mark BV v. Kist*, trading as Memex, Case C-283/01 (27 November 2003).

<sup>12</sup> Bently and Sherman, *Intellectual Property Law*, 2<sup>nd</sup> edition, p. 773.

<sup>13</sup> Bently and Sherman, *Intellectual Property Law*, 2nd edition, pp. 773-774.

<sup>14</sup> *Eli Lilly/The Taste of Artificial Strawberry flavor*, R120/2001-2 (4 August 2003).

### **Holograms**

Applicants of holographic trademarks must ensure that their trademarks satisfy the seven Sieckmann criteria. They would also have to use high-resolution frames to avoid fading or picture overlapping, as the ECJ does not allow descriptions of the visual effects alone. The registration of holograms usually require the use of a sequence of pictures or drawings to depict how the trademark functions.<sup>15</sup> The National Agency for Food, Drug Administration and Control (NAFDAC) use holograms for its product registration numbers, whether the same will be accepted as trademark in Nigeria will be a decision of our trademark office.

### **Non-Traditional Trademarks and Nigeria**

Although the TMA allows for the possibility of the registration of non-traditional trademarks, we are yet to see whether the Nigerian Trade Marks registry will allow the registration of trademarks of this nature. As mentioned above, there is no express prohibition on the registration of non-traditional trademarks. It also appears that the definition of trademarks under the TMA is inexhaustive, and as such the Act envisages several forms of trademarks, such as non-traditional trademarks. As trademarks continue to evolve and especially in light of the fact that recognition of scent and sound marks, amongst others, appear to be imminent, the future looks good for brand owners in this particular area of trademark development. Furthermore, as work on non-traditional mark progresses to another level and the business world continues to create new products, we may see a fascinating transformation of the world of trademarks.<sup>16</sup> Only time will tell whether non-traditional trademarks will become commonplace filings at the Nigerian Trade Marks Registry.

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Uche manages the Intellectual Property portfolio of Aluko & Oyebode. She advises clients on the full range of brand related matters including trademark clearance, exploitation, acquisition, protection and enforcement. Prosecution of trademark, patent and design applications, conducting opposition proceedings, dispute resolution and registering licensing, franchising, technology transfer agreements and product registration with the National Agency for Food and Drug Administration and Control (NAFDAC) and Standard Organisation of Nigeria (SON), NCC, and related agencies.

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<sup>15</sup> [http://www.cpaglobal.com/newlegalreview/1117/holograms\\_the\\_next\\_generation\\_of\\_trademarks](http://www.cpaglobal.com/newlegalreview/1117/holograms_the_next_generation_of_trademarks).

<sup>16</sup> [http://www.wipo.int/wipo\\_magazine/en/2009/01/article\\_0003.html](http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html) - Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks, February 2009.

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