



Trade Marks – Unlocking Brand Protection
Now That You Have Filed Your Mark:
Post-Registration Matters

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The enduring value of a registered trademark is intrinsically linked to its active management, proper use, and timely updates. A trademark is not a static asset; its sustained protection and commercial viability extend far beyond the initial issuance of a certificate. Failure to proactively manage these aspects can lead to significant legal vulnerabilities, dilution of brand value, or even the ultimate loss of rights through cancellation.

This article serves as the crucial third instalment in the series, "Trade Marks – Unlocking Brand Protection." In the preceding sections, the various types of trademarks registrable in Nigeria were examined,¹ and the procedural steps for their initial filing and registration were carefully outlined.² Building upon that foundational understanding, this segment now shifts its focus to the critical post-registration lifecycle, that is, the key legal and administrative considerations that arise during the entire lifetime of a registered trademark in Nigeria. The discussion will emphasise that trademark protection requires continuous vigilance and adherence to statutory requirements to ensure the mark remains a robust, protected and enforceable asset.

1. Recording Changes in Proprietor Details: Name and Address

Maintaining accurate records at the Trademarks Registry is a fundamental aspect of trademark management. Under Section 40 (b) of the Trade Marks Act (Trade Marks Act) and Regulation 82 of the Trade Marks Regulations (the Regulations), it

is a statutory requirement that any change in the registered proprietor's name or address must be promptly recorded with the Registry.

The process for recording such changes involves several key steps and documentation. A formal request letter, addressed to the Registrar of Trademarks, must clearly state the nature of the change (whether it is a change of name or address) and provide the new particulars. This letter must be accompanied by compelling evidence of the change. For a name change, such as due to corporate restructuring or an individual's legal name change, a certified copy of the Certificate of Change of Name issued by the Corporate Affairs Commission (CAC) or another official document reflecting the new name is typically required. In the case of an address change, any verifiable document that reflects the new address suffices.

While not strictly mandatory for the application to be processed, submitting the certificate of registration is strongly encouraged. The application must also be accompanied by the payment of the prescribed fees. Furthermore, if the application is being filed by a registered agent or attorney on behalf of the proprietor, a duly executed Power of Attorney is a mandatory requirement.

Failure to promptly record these fundamental changes can significantly complicate future legal actions. This includes hindering the proprietor's ability to effectively pursue infringement actions, as their legal standing might be questioned if the Registry's records do not reflect their current identity or location. Such omissions can also create procedural hurdles in licensing arrangements or subsequent assignments, as third parties might face difficulty verifying the true proprietor.

¹ Read Trade Marks – Unlocking Brand Protection, Part 1 here: <https://advocaat-law.com/wp-content/uploads/2025/05/Trade-Marks-Unlocking-Brand-Protection.pdf>

² Read Trade Marks – Unlocking Brand Protection, Part 2 here: <https://advocaat-law.com/wp-content/uploads/2025/06/Fundamentals-of-Trade-Marks-Registration-in-Nigeria-part-2.pdf>

2. Assignments: Transferring Trademark Ownership

The transfer of ownership of a registered trademark in Nigeria is governed by Section 26 of the Trade Marks Act and Regulations 73-78 of the Regulations. This transfer can be done through an assignment, which can be made "with or without the goodwill of the business" to which the mark relates (Section 26(1) Trade Marks Act).

An assignment of all goods involves the transfer of the entire rights related to the trademark for all goods and/or services for which it was originally registered, making the assignee the new, full owner of the trademark (Section 26(2) of the Trade Marks Act). Conversely, an assignment of some, but not all, goods means that ownership is transferred only for specific goods or services, with the registered owner retaining rights over the goods or services not assigned (Section 26(2) of the Trade Marks Act).

In an **assignment with goodwill**, the assignee is expected to use the trademark in relation to the goods for which the assignor previously used it, thereby acquiring the established reputation and customer loyalty associated with the brand.

In an **assignment without goodwill**, the assignee does not acquire the brand's attached goodwill. To obtain rights under such an assignment, the assignee must apply to the Registrar of Trademarks within six months from the date of the assignment (or an extended period granted by the Registrar) for directions regarding the advertisement of the assignment.³ The assignment must then be advertised in the manner directed by the Registrar.⁴ The Registrar will also cause notice of the assignment to be published in the Journal.⁵

Even an unregistered trademark can be assigned, provided that at the time of the assignment, the

unregistered mark is used in the same business as a registered trademark and is assigned concurrently and to the same person as the registered mark.⁶ Furthermore, the assignment must cover all goods related to which the unregistered trademark is used in that business.

Recordal of an Assignment

The recordal of an assignment at the Trademarks Registry is a critical legal step. Where a person becomes entitled to a registered trademark by assignment or transmission, they may, conjointly with the registered proprietor, make an application to the Registrar on the appropriate form to register their title.⁷ If a conjoint application is not made, the person entitled must also make an application to the Registrar on the appropriate form.⁸

An application under Regulation 73 or 74 must contain the name, trade or business address, and description of the person claiming to be entitled, along with full particulars of the instrument under which they claim. This instrument, typically a Deed of Assignment, must be produced for inspection by the Registrar, and the Registrar may require and retain an attested copy (Regulation 75(2)). If the application doesn't claim under a document that can prove title, the applicant must provide a case stating the full particulars of the facts upon which the claim is based (Regulation 76).

An application relating to an assignment of a trademark in respect of any goods must state whether the trademark was, at the time of the assignment, used in a business in any of those goods and whether the assignment was made otherwise than in connection with the goodwill of that business (Regulation 78(1)). If both circumstances subsisted, the applicant must provide a copy of the Registrar's directions to

³ (Section 26(4) Trade Marks Act

⁴ Section 26(4)(b) Trade Marks Act

⁵ Section 26(5) Trade Marks Act

⁶ Section 26(3) Trade Marks Act

⁷ Regulation 73

⁸ Regulation 74

advertise the assignment and proof that those directions have been fulfilled (Regulation 78(1)(b)).⁹ If the Registrar isn't satisfied that the directions have been fulfilled, they shall not proceed with the application.¹⁰

Importance of Recordal

Until an assignment is formally registered, the assignee may not be recognised as the legal owner in enforcement proceedings (e.g., against infringers) or opposition proceedings. This is because their rights against third-party infringers or in disputes with other claimants could be severely hampered, leaving the new owner vulnerable.

3. Licensing and Registered Users

While the Nigerian Trade Marks Act does not explicitly use the modern term "licensing," it provides a robust legal framework for granting permission to use a registered mark through the concept of "**Registered Users**" under Sections 33–35. This mechanism effectively serves as the legal equivalent of trademark licensing in Nigeria. Licensing a trademark means that the trademark owner (licensor) grants permission to another party (licensee) to use the trademark under defined terms and conditions. Crucially, this arrangement does not transfer ownership of the mark but rather allows for shared usage rights, typically in exchange for a fee or royalty. Despite the Act's terminology, trademark licensing is widely recognised and allowed under common law principles and the established regulation of the Trademarks Registry. The Registry explicitly recognises and facilitates the recordal of license agreements.

Trademark licenses can be structured in various ways. Under a **sole license**, the trademark owner grants permission to a single licensee to use the trademark for a specified period and within a specified scope. In this arrangement, both the

owner (licensor) and the sole licensee may use the trademark, but the owner is precluded from granting the same rights to any other third party.

Exclusive licensing is a more restrictive form where the owner grants the licensee the sole commercial right to use their trademark. In an exclusive license, the licensor typically relinquishes their own commercial rights to use the trademark within the agreed scope and territory, making the licensee the exclusive commercial operator of the mark. Conversely, **non-exclusive licensing** occurs where the proprietor permits one or more licensees to exploit the trademark. The licensor retains the right to use the mark itself and can grant similar licenses to multiple other parties.

For a trademark to be formally licensed and its user registered under Nigerian law, a crucial prerequisite is that the trademark must first be registered or at least have a pending application with the Trademarks Registry.¹¹ A non-registered trademark cannot be formally licensed. The application for registration as a Registered User must be submitted jointly by both the trademark proprietor and the proposed registered user. The core contractual document governing the relationship is the **User Agreement or Licence Agreement**. This agreement must be meticulously drafted and should clearly specify: the names and addresses of both the licensor and licensee; a precise description of the trademark (including its classes of goods/services); the defined territory where the trademark will be used; the duration of the license; the type of license (e.g., exclusive, non-exclusive); and detailed terms and conditions of use, including quality control provisions. An **Affidavit Setting Out Particulars of the Relationship** is also required, providing essential details about the relationship between the proprietor and the proposed user, particularly concerning the degree of control the proprietor exercises over

⁹ Regulation 75(1)

¹⁰ Regulation 78(1)

¹¹ Regulations 97 and 98

the licensee's use of the mark. A **Statement of Case** outlining the full particulars of the relationship and the specific goods and/or services for which the mark is to be used by the licensee must also be provided. If the application is being filed by an authorised agent on behalf of either the proprietor or the proposed registered user, a duly executed **Power of Attorney** is required. Finally, the prescribed government fees for the Registered User application must be paid.

Trademark licensing through the *Registered User* mechanism in Nigeria presents a strategic means for brand expansion and commercialisation, as the licensee's use is legally deemed to be that of the proprietor, crucial in defending against non-use cancellation actions. This arrangement not only preserves ownership rights and legitimises the licensee's use but also enhances market penetration while fulfilling statutory use requirements. However, the legal validity and enforceability of such agreements depend on formal recordal, well-drafted user agreements, and strict quality control provisions. Failure in these areas risks brand dilution, disputes, or loss of trademark rights.

4. Recordal of Mergers and Corporate Restructuring

In the event of corporate mergers, acquisitions, or other significant forms of corporate restructuring, the trademark rights of the absorbed or merging entity must be formally recorded under Regulation 73, which specifically covers the transfer of ownership of trademarks. This critical step ensures the continuity of ownership of the trademark portfolio, aligns the Trademarks Registry's records with the new legal entity, and proactively prevents future legal complications or challenges to ownership and enforceability.

The documentation and procedures for recording trademark rights post-merger are specific. The foundational legal document is the **Merger**

Agreement or Court-Sanctioned Scheme of Merger, which formally evidences the corporate restructuring and the transfer of assets, including intellectual property. This must be accompanied by **evidence of completion of the merger**, which may include official notices from the Corporate Affairs Commission (CAC) confirming the new corporate structure or name change, the FCCPC's certificate of approval for the merger, or certified copies of court orders sanctioning the scheme of merger. Similar to the process for assignments, the form for "*Application for Registration of Title*" is typically utilised to record the change in proprietorship of the trademark due to the merger. The prescribed government fees for recordal must be paid, and if the application is filed by an authorised agent on behalf of the new entity, a Power of Attorney is required.

While not every internal corporate restructuring directly impacts trademark rights in the same way a direct assignment does, it is highly advisable to ensure that the Trademarks Registry's records are fully aligned with the current legal entity responsible for the mark. This proactive measure prevents ambiguities regarding ownership, facilitates any future commercial transactions (such as licensing or further assignments), and significantly strengthens the proprietor's legal position in any potential enforcement actions or disputes.

CONCLUSION

The journey of trademark protection extends far beyond the initial registration. As this series has demonstrated, the post-registration management of trademarks is as critical, if not more so, than their initial filing. The legal rights conferred by a registered trademark are only as strong and enduring as the diligent efforts made to maintain, monitor, and enforce them throughout their commercial lifetime.

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