

**Trade Marks – Unlocking Brand
Protection: Avoiding Non-Use
Pitfalls Navigating Cancellation
Proceedings**

Part 4



 LAGOS | ABUJA | CALABAR

INTRODUCTION

In the competitive landscape of modern commerce, trademark registration is only the beginning of a brand's legal journey. The continued protection and enforceability of a trademark hinge not merely on formal registration but on consistent, demonstrable use in the marketplace. This fourth instalment of our "*Unlocking Brand Protection*"¹ series delves into two critical but often overlooked dimensions of trademark maintenance in Nigeria: the legal imperative of genuine use to avoid non-use cancellation, and the procedural and substantive grounds upon which registered marks may be challenged through cancellation or rectification proceedings. In highlighting the statutory framework, practical implications, and evolving legal reforms, this article offers brand owners, legal practitioners, and stakeholders a strategic guide to sustaining trademark rights and pre-emptively mitigating vulnerability to third-party challenges.

1. MAINTAINING TRADEMARK USE AND AVOIDING NON-USE CANCELLATION

1.1. Legal Basis for Non-Use Cancellation Under Nigerian Law

Under Section 31(2) of the Trade Marks Act, a registered trademark in Nigeria may be subject to cancellation and removal from the Trademark Register if it has not been used for a continuous period of five years or more from the date of its registration. It is important to note that actual use of a mark is not a prerequisite for its initial registration in Nigeria; a bona fide intention to use the mark is sufficient at the time of application. However, this intention must be genuine and not merely a speculative registration.

1.2. Intention to Use vs. Genuine Use

Genuine use of a trademark must be in the course of trade and directly in relation to the goods and/or services for which the mark is registered. This implies commercial activity, marketing, sales, and actual application of the mark to products or services. A significant provision is that use of the trademark by a registered user or licensee is legally "deemed" to be use by the proprietor. This is a critical factor in satisfying the use requirement and defending against non-use cancellation actions. Conversely, mere token use, sporadic sales, or isolated instances of use that do not reflect genuine commercial activity may not suffice to defend against a robust non-use cancellation action.

1.3. Grounds for Non-Use Cancellation

The grounds for non-use cancellation typically include situations where the trademark was registered without any genuine intention to use it in relation to the goods or services for which it was registered, and there has been no bona fide use of the trademark up to one month before the application for cancellation.

Another common ground is when the trademark has not been used for a continuous period of five years or more from the date of registration, without justification. The primary and most severe

¹ You can catch up with the other instalments using the links below:

1. Part 1: <https://advocaat-law.com/wp-content/uploads/2025/05/Trade-Marks-Unlocking-Brand-Protection.pdf>
2. Part 2: <https://advocaat-law.com/wp-content/uploads/2025/06/Fundamentals-of-Trade-Marks-Registration-in-Nigeria-part-2.pdf>
3. Part 3: <https://advocaat-law.com/wp-content/uploads/2025/10/Trade-Marks-Unlocking-Brand-Protection-Part-3-Now-That-You-Have-Filed-Your-Mark-Post-Registration-Matters.pdf>

consequence of sustained non-use is the cancellation and removal of the trademark from the Register, effectively stripping the proprietor of their exclusive rights and rendering the brand vulnerable to adoption and use by third parties.

1.4. Defences and Exceptions to Non-Use Cancellation

However, there are exceptions and defences to non-use cancellation. If the trademark had been used in good faith at some point within the five years by the proprietor for the goods for which it is registered, it is exempt from removal due to non-use; this is the most direct defence. The Act may also provide for other special circumstances that justify non-use, such as trade restrictions or other external factors beyond the proprietor's control.

Furthermore, well-known trademarks that are registered across various goods classes are generally not susceptible to cancellation for non-use in Nigeria due to their popular status and widespread recognition. This protection applies even if the mark is not actively used for all registered classes. Defensive registration, specifically, eliminates the need for lengthy trademark opposition proceedings, as the Registry will typically reject any infringing application based on the existence of the defensive trademark, even if it is not actively used in that particular class.

1.5. Evidentiary Best Practices for Proving Trademark Use

Proprietors should meticulously maintain comprehensive records of all activities demonstrating genuine commercial use of their mark. This includes, but is not limited to, marketing materials, advertising campaigns, sales figures, invoices, product labelling, packaging designs featuring the mark, and any other evidence of commercial exploitation. Such robust documentation is invaluable if the need arises to prove genuine use in a non-use cancellation proceeding. The "use" requirement and the detailed grounds for non-use cancellation highlight a fundamental tension inherent in trademark law: while registration grants exclusive rights, those rights are ultimately contingent on the mark's active commercial engagement. The nuance that "intention to use" is sufficient for initial registration but "genuine use" is mandated for continued maintenance implies a probationary period for the mark to enter the stream of commerce.

1.6. Practical Realities of Non-Use Enforcement in Nigeria

It is a practical observation worthy of note that registered trademarks are hardly taken off the register for non-use without an order of a court of competent jurisdiction, often attributed to the disorganised state of the records at the Registry. This suggests that while the legal framework for non-use cancellation exists, its administrative enforcement can be challenging, often necessitating more complex, court-driven processes. Therefore, proprietors should not rely on potential administrative laxity but rather proactively ensure and document genuine use to robustly protect their investment.

2. CANCELLATION AND RECTIFICATION PROCEEDINGS: CHALLENGING TRADEMARK VALIDITY

Trademarks may be removed from the Register or have their entries rectified (corrected) in various scenarios. These proceedings can be initiated either voluntarily by the proprietor or, more commonly, by interested third parties seeking to clear the Register.

2.1. Statutory Grounds for Cancellation and Rectification

The grounds for cancellation and rectification are extensive. The registered proprietor may, at any time, **voluntarily apply to the Registrar to cancel their own trademark**. As extensively detailed in Section 31, a trademark can be cancelled for **non-use** if it was registered without a bona fide intention to use it (and no use occurred up to one month before the application for cancellation), or if it has not been used for a continuous period of five consecutive years without justification. Section 38 of the Act provides grounds for removing or varying an entry that was **made without sufficient cause, or where there is an error or defect in the entry**. This covers situations where a mark should not have been registered in the first place or where the registration details are incorrect. A significant ground for cancellation is where the trademark registration was **obtained by fraud or in bad faith**. This includes instances where an applicant had no intention of using the mark, or where an agent or distributor attempts to register a mark belonging to their principal without authorisation.

Marks that are unlawful, contravene public policy, **deceptive, scandalous, or contrary to law/public morality**, are not registrable and can be removed if they were improperly registered. This also applies to marks disentitled to protection by a court of law. If the registered mark is **confusingly similar or identical to a previously registered or famous trademark**, it can be challenged, especially if it was registered in error or bad faith.

Furthermore, if the proprietor fails to pay the prescribed renewal fees prior to the expiration date or within the grace period (with surcharge) after receiving due notice from the Registrar, the trademark can be removed from the Register due to **non-renewal**.

Finally, a registered trademark can be revoked if it is shown that the proprietor **failed to comply with or observe a condition precedent** related to the trademark's registration or maintenance.

2.2. Procedure for Cancellation or Rectification

Any interested person (individual or corporate body), irrespective of proprietary interest, who believes that a registered trademark should not have been granted or should be removed, may apply for cancellation or rectification. An application for the cancellation or rectification of a trademark in Nigeria can be made either to the Registrar of Trademarks or directly to the Federal High Court.

If the application is made to the Registrar by a party other than the registered proprietor, copies of the application will be provided to the registered proprietor, who is then entitled to file a Counter-Statement or Defence to the applicant's claims. The Registrar's decision in such proceedings is subject to appeal to the Federal High Court.

The Federal High Court of Nigeria has inherent jurisdiction over trademark enforcement and can issue orders for rectification or cancellation, and the Trademarks Registry is statutorily obligated to give effect to such court orders. Applicants must present all available evidence to support their claims, which may include evidence of prior use, arguments demonstrating the differences between their mark and existing trademarks, or proof of fraud.

The provision allowing interested parties to initiate cancellation or rectification proceedings at both the Registrar and the Federal High Court highlights a dual-layered system of intellectual

property governance in Nigeria. While the Registrar is equipped to handle administrative aspects and serves as a first-instance resolver for certain disputes, the ultimate authority and jurisdiction for complex legal challenges, particularly those involving intricate evidentiary matters or significant commercial interests, reside with the Federal High Court. This implies that the Registry acts as a gatekeeper and an initial administrative tribunal, but for definitive and binding judgments that carry the full force of law, judicial intervention is often necessary. This also suggests that the state of records at the Registry might, in practice, compel more complex cancellation cases towards the courts for a more thorough and authoritative resolution.

2.3. Remedies for Bad-Faith Registration and Infringement

Beyond formal cancellation proceedings, various remedies exist for bad faith registration and infringement.

- a. **Cease-and-Desist Actions:** A preliminary, non-litigious step is to issue a **cease-and-desist letter** to notify the infringing party and demand cessation of unauthorised use.
- b. **Trademark Opposition Proceedings:** If the infringing or bad-faith mark is still in the application stage and has been published in the Trademarks Journal, an **opposition** can be filed within two months from the date of publication.
- c. **Domain Name Disputes and Online Enforcement:** Disputes involving domain names that infringe on trademark rights may also be addressed through proceedings under the **Uniform Domain Name Dispute Resolution Policy (UDRP)** for *.com* domain names and the **NiRA Dispute Resolution Policy (NDRP)** for *.ng* domain names.
- d. **Protection of Unregistered Marks:** Finally, for owners of unregistered trademarks, rights can be enforced through a common law **action for passing off**, where there is a misrepresentation of a confusingly similar mark, to establish their right. It has been decided that both the Federal High Court and State High Court have competent jurisdiction to hear passing off actions.

CONCLUSION

Trademark rights in Nigeria are not immune to challenge merely by virtue of registration. As this article has illustrated, the law demands more than a formal claim to exclusivity; it requires ongoing, good-faith commercial use and legal vigilance. The risks of non-use cancellation and rectification proceedings are real and increasingly relevant in a market where brand value is paramount. Proprietors must adopt a proactive approach: maintain meticulous records, regularly audit brand usage, and understand the dual channels, administrative and judicial, through which rights may be defended or contested. Ensuring that registered marks remain active, accurate, and legally defensible is essential to unlocking and sustaining true brand protection.

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