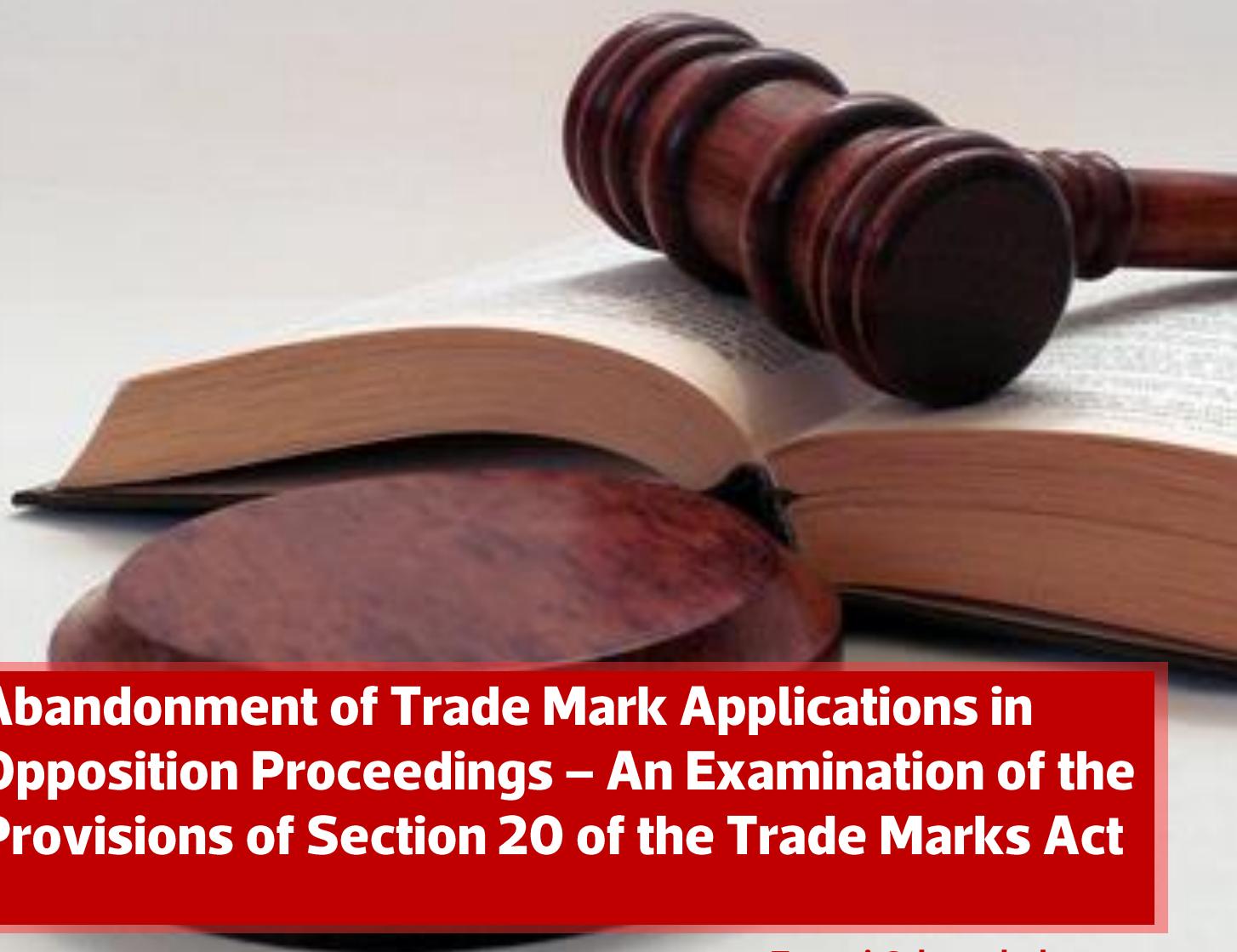




Jackson, Etti & Edu



Abandonment of Trade Mark Applications in Opposition Proceedings – An Examination of the Provisions of Section 20 of the Trade Marks Act

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Case Notes in Appeal No.: CA/L/622/2017 Visafone International Service Association vs Visafone Nigeria Limited & the Registrar of Trade Marks

In a recent appeal, successfully prosecuted by Jackson, Etti and Edu on behalf of Visa International Service Association, the Nigerian Court of Appeal upturned the decision of the Registrar of Trade Marks to register Visafone Nigeria Limited's "VISAFONE" trade mark in class 16, on the ground that the said mark was in conflict with the trade mark "VISA". The Court of Appeal also held that Visafone Nigeria Ltd's VISAFONE trade mark should not have been registered as it was subject of an already abandoned trade mark application.

The facts

Visa International Service Association (through Jackson, Etti and Edu) filed an opposition against the registration of Visafone Nigeria Ltd's trade mark application for VISAFONE in class 16. The said opposition was filed on the ground that the VISAFONE mark conflicted with Visa International Service Association's prior trade mark registration for VISA in the same class. Visafone Nigeria Ltd however failed to file a Counter-statement in response to the opposition filed by Visa International Service Association, and the Registrar subsequently deemed the trade mark application for VISA in class 16 as abandoned on this basis. Notwithstanding the abandonment issued by the Registrar, the same Registrar re-opened opposition proceedings, and summarily held that Visafone Nigeria Ltd's trade mark application for VISA in class 16 (which was previously deemed abandoned) should proceed to registration despite the fact that counter-statement was not filed and evidence was not exchanged by parties. Visa International Service Association was constrained to appeal this decision to the Federal High Court, and subsequently to the Court of Appeal, following the decision of the Federal High Court to endorse the decision of the Registrar of Trade Marks.

The Judgment of the Court of Appeal

In a well-considered judgment, the Court of Appeal, per Kolawole J.C.A (who delivered the lead judgment) held that once an applicant for a trade mark application fails to file a Counter-Statement in an opposition proceedings within the timeline of one month (as provided under Section 20 of the Trade Marks Act), the trade mark application would immediately be deemed as abandoned. The Court per Kolawole J.C.A. held as follows:

"My Lords, I am of the view that, this judicial labour being expended here is worth the significance of attempting a modest development of this rudimentary concept of law. "Abandonment" as a concept as provided for in



section 20(3) of the Act, in my view, does not require it to be activated at either issuance of notice to that effect by the Registrar as in the instant case or any letter at all reflecting an application as being abandoned, it will suffice that once the timeline prescribed by the Act has elapsed, the concept of "abandonment" automatically becomes activated in effect...."

The implication of this decision is that abandonment automatically takes effect, once an applicant fails to file a counter-statement within the timeline of one month. What is more, the Registrar of Trade Marks has no powers to set-aside such abandonment or re-open opposition proceedings, towards issuing a registration certificate for a trade mark that has been subject of an abandonment. The Court of Appeal held that the Registrar of Trade Marks certainly did not have the competence to re-open opposition proceedings and issue registration, where an applicant (for trade mark registration) fails to file a counter-statement after one month, upon service of the Notice of Opposition.

The Court further considered the confusing similarity in the trade marks VISA and VISAFONE in respect of goods in class 16. The Court of Appeal held that the two trade marks were clearly in conflict as the first and second syllables of VI-SA was adopted in the subsequent trade mark VI-SA-FONE. The Court summarily held that the trade mark registration for VISAFONE should be expunged from the Trade Marks Registry due to the irregularity in the procedure of registration and as a result of the conflict with the prior trade mark registration for VISA in class 16.

Abandonment of trade mark applications due to failure to file counter-statement

The legal implication of the failure to file counter-statement within the statutory timeline (which results in abandonment) is a novel issue in Nigerian trade mark jurisprudence. This was however resolved in this case. Indeed, the above judicial decision clarified the provisions of Section 20 of the Trade Marks Act, and further indicated that the issuance of a Notice of Abandonment (upon failure of the applicant to file a counter-statement) may be superfluous, as the provisions of the Trade Marks Act implies that abandonment is automatic and inferred by operation of law. Thus, whether or not the Registrar issues a Notice of Abandonment, the trade mark application is considered abandoned, and no action or further proceedings can be taken on such trade mark application.

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