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# Rethinking Nigerian geographical indications law

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## Abstract

This note makes the case that Nigeria needs to reconsider its legal framework for the protection of geographical indications. It is divided into three main parts. The first part focuses on the rules governing the protection of geographical indications at the international level. The second part examines the current legal framework for the protection of geographical indications in Nigeria. The second part of the note further highlights the gaps between the Nigerian legal framework and the international rules for the protection of geographical indications. The third part of the note explains how the gaps identified in the second part of the note can be closed. This note recommends that Nigeria should enact a *sui generis* law for the protection of geographical indications. This would enable geographical indications from Nigeria to be effectively protected both inside and outside the country.

## KEYWORDS

Geneva Act, geographical indications, Lisbon system, Nigeria, *sui generis* law

## 1 | INTRODUCTION

It is time for Nigeria to rethink its approach to the protection of geographical indications. There are various communities in different parts of Nigeria where certain unique agricultural and non-agricultural products are produced.<sup>1</sup> These communities can potentially benefit from the proper protection of these locally made products via a new geographical indications law.<sup>2</sup> While it is acknowledged that the enactment of a statutory framework for

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the protection of geographical indications may not necessarily be the panacea to all the challenges faced by some of these communities, it is suggested here that a robust legal framework in this regard could contribute to the advancement of the socioeconomic development of these communities.<sup>3</sup>

It is therefore necessary to critically revisit and reconsider the current legal framework for the protection of geographical indications in Nigeria. Crucially, it is contended here that it is now time for Nigeria to reform its geographical indications law to ensure that there is effective protection, both inside and outside Nigeria, of its unique agricultural and non-agricultural products. This would require, among other things, facilitating the international registration of Nigerian geographical indications.

It is important to clarify at the outset what is meant by the term 'geographical indication' and to distinguish it from other related terms like 'indication of source' and 'appellation of origin'. According to Bodenhausen, indications of source include 'all expressions or signs used to indicate that a product or service originates in a given country or group of countries, region or locality'.<sup>4</sup> As Bodenhausen further points out, appellations of origin are a species of the *genus* 'indications of source' and are 'characterized by their relationship with quality or characteristics derived from the source'.<sup>5</sup> Concerning the difference between an appellation of origin and a geographical indication, the World Intellectual Property Organisation notes that:

The basic difference between the two terms is that the link with the place of origin must be stronger in the case of an appellation of origin. The quality or characteristics of a product protected as an appellation of origin must result exclusively or essentially from its geographical origin. This generally means that the raw materials should be sourced in the place of origin and that the processing of the product should also happen there. In the case of [geographical indications], a single criterion attributable to geographical origin is sufficient, be it a quality or other characteristic of the product, or only its reputation. Moreover, the production of the raw materials and the development or processing of a [geographical indication] product do not necessarily take place entirely in the defined geographical area.<sup>6</sup>

In this note, the focus is specifically on the protection of geographical indications. This note is structured into three main parts (i.e. parts 2 to 4 below). Part 2 focuses on the rules governing the protection of geographical indications at the international level. Part 3 examines the current legal framework for the protection of geographical indications in Nigeria. Part 3 of the note further highlights the gaps between the Nigerian legal framework and the international rules for the protection of geographical indications. Part 4 of the note explains how the gaps identified in part 3 of the note can be closed. Basically, this note recommends that Nigeria should enact a *sui generis* law for the protection of geographical indications. Essentially, despite any perceived shortcomings of a *sui generis* system, from the perspective of international intellectual property law, the best option for Nigeria with regard to the protection of geographical indications is the enactment of a *sui generis* geographical indications law.

## 2 | THE PROTECTION OF GEOGRAPHICAL INDICATIONS AT THE INTERNATIONAL LEVEL

There are four main treaties that govern the protection of geographical indications at the international level, namely: (1) the Paris Convention for the Protection of Industrial Property of 1883 (as amended); (2) the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891; (3) the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 which was updated via the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications of 2015; and (4) the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 1994.<sup>7</sup> The first three treaties are administered by the World Intellectual Property Organisation (WIPO) while the fourth treaty is administered by the World Trade Organisation (WTO).

The Paris Convention for the Protection of Industrial Property (Paris Convention) does not contain detailed provisions regarding the protection of geographical indications. It equally does not provide a mechanism for the international registration of geographical indications. Nevertheless, Article 10bis of the Paris Convention, which requires parties to the Convention to provide effective protection against unfair competition, does contain a provision that is apposite to the protection of geographical indications. Specifically, Article 10bis(3)(iii) of the Paris Convention imposes an obligation on parties to the Convention to prohibit 'indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.' The Paris Convention does not however specify how states should implement Article 10bis(3)(iii) of the Convention. This implies that states can implement Article 10bis(3)(iii) of the Paris Convention via trademark law, a *sui generis* law, or the common law tort of passing off.

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (Madrid Agreement) essentially requires the seizure on importation of goods bearing false or deceptive indications of source. Crucially, Article 1(1) of the Madrid Agreement provides that: 'All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.' The Madrid Agreement, like the Paris Convention, contains no mechanism for the international registration of geographical indications.

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 (Lisbon Agreement) only provides for the protection of appellations of origin. As noted above in the introduction, appellations of origin are distinct from geographical indications. Importantly, the requirements for protecting appellations of origin are stricter than that for geographical indications. As defined in Article 2(1) of the Lisbon Agreement, 'appellation of origin' means 'the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.'

While the requirements for protecting appellations of origin are quite strict, the Lisbon Agreement does provide for a high level of protection for products that are able to satisfy this strict requirement. Thus, Article 3 of the Lisbon Agreement provides that: 'Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or the like.' Also, as stated in Article 6 of the Lisbon Agreement, as long as an appellation of origin is protected in its country of origin, it cannot be deemed to have become generic in any country where it enjoys protection pursuant to the agreement.

Importantly, the Lisbon Agreement provides for a system of international registration of appellations of origin via WIPO. As stipulated in Article 5(1) of the Lisbon Agreement: 'The registration of appellations of origin shall be effected with the International Bureau, at the request of the Authorities of the countries of the Special Union, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, the right to use such appellations.' Moreover, once registered with WIPO, there is no requirement for renewal of registration as stated in Article 7(1) of the Lisbon Agreement.

The Lisbon Agreement was updated in 2015 through the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications of 2015 (Geneva Act). Both the Lisbon Agreement and the Geneva Act now constitute the Lisbon system. Importantly, the Geneva Act now extends the Lisbon Agreement to include the protection of geographical indications.<sup>8</sup> This means that the Geneva Act now provides a means for the international registration of geographical indications via WIPO. Furthermore, like the Lisbon Agreement, the Geneva Act provides for a high level of protection,<sup>9</sup> prohibits renewal fees after registration,<sup>10</sup> and provides for perpetual protection as long as there is protection in the country of origin.<sup>11</sup> The Geneva Act thus provides a very good means for Nigeria to secure international registration and protection for its unique agricultural and non-agricultural products.

The TRIPS Agreement contains certain minimum standards regarding the protection of geographical indications. Geographical indications, for the purposes of the agreement are defined in its Article 22.1 as: 'indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.' This definition is broadly similar to the one that can also be found in Article 2(1)(ii) of the Geneva Act.

Article 22.2 of the TRIPS Agreement requires that geographical indications should be protected against misleading uses and acts of unfair competition.<sup>12</sup> Article 23 of the TRIPS Agreement further provides for a higher level of protection for geographical indications for wines and spirits. It provides that:

Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

This higher level of protection for wines and spirits under the TRIPS Agreement is somewhat similar to the level of protection available to appellations of origin and geographical indications under the Lisbon system. It is however worth noting that the TRIPS Agreement, like the Paris Convention, does not specify how states should implement Articles 22 and 23 of the Agreement. The TRIPS Agreement only requires that WTO members should provide 'the legal means' for the protection of geographical indications against the uses prohibited by the agreement.

Furthermore, unlike the Lisbon system, the TRIPS Agreement does not provide a means for the international registration of geographical indications. Thus, to secure the international registration and protection of geographical indications from Nigeria, it is not enough to implement the provisions of the TRIPS Agreement on geographical indications. In other words, to facilitate the protection of Nigerian geographical indications outside Nigeria, it would be helpful for Nigeria to seriously consider acceding to the Lisbon system, specifically the Geneva Act.

### 3 | THE CURRENT LEGAL FRAMEWORK FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN NIGERIA

Nigeria is currently a party to both the Paris Convention and the TRIPS Agreement. However, as noted in part 2 above, both of these treaties do not provide a means for the international registration of geographical indications. Nigeria is not a party to the Madrid Agreement, the Lisbon Agreement, or the Geneva Act. As noted above in part 2, both the Lisbon Agreement and the Geneva Act constitute the Lisbon system which provides a means for the international registration and protection of geographical indications via WIPO. Thus, Nigeria is currently not a party to any multilateral agreement that can be used to protect Nigerian geographical indications outside Nigeria.

Moreover, it should be noted that Nigeria currently has no *sui generis* law for the protection of geographical indications. Nevertheless, geographical indications can currently be protected within Nigeria as certification marks under Section 43 of the current Nigerian Trademarks Act. Section 43(1) of the Trademarks Act provides that:

A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, method of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A or the register in respect of those goods in the name, as proprietor thereof, of that person: Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

Arguably, Section 43 of the Trademarks Act in combination with the common law tort of passing off satisfies Nigeria's obligations under Article 22.2 of the TRIPS Agreement. This combination should equally suffice with regard to satisfying the relevant minimal obligations under the Paris Convention. However, it should be noted that Nigeria is yet to satisfy its obligations regarding providing a higher level of protection for geographical indications for wines and spirits as required under Article 23 of the TRIPS Agreement. In addition, it should also be noted that there is currently no statutory framework for resolving conflicts between geographical indications and trademarks in Nigeria.

Thus, in terms of rethinking Nigerian geographical indications law, there are three key gaps that need to be addressed. First, there is a need for Nigeria to accede to the Geneva Act to facilitate the international registration and protection of Nigerian geographical indications. Second, Nigeria needs to fulfil its obligation under Article 23 of the TRIPS Agreement by providing for a higher level of protection for geographical indications for wines and spirits. Third, Nigeria should adopt a legal framework for resolving conflicts that may arise between the protection of trademarks and geographical indications.

## 4 | THE NEED FOR A *SUI GENERIS* LAW ON GEOGRAPHICAL INDICATIONS IN NIGERIA

To successfully close the three key gaps identified in part 3 above, it is suggested here that the best way forward for Nigeria is to enact a stand-alone, *sui generis* law on geographical indications. In this regard, Nigeria can follow the examples of some other common law jurisdictions that have equally enacted a *sui generis* law for the protection of their geographical indications such as India<sup>13</sup> and Ghana.<sup>14</sup> Indeed, Ghana has also recently acceded to the Geneva Act in 2021 and this provides a means for Ghana to register and protect its geographical indications at the international level via WIPO.

There are a number of reasons why the enactment of a *sui generis* law on geographical indications is the best option when it comes to rethinking Nigerian geographical indications law. First, it would help to satisfy all of Nigeria's obligations regarding the protection of geographical indications under the TRIPS Agreement. Second, it would enable Nigeria to adopt provisions that are aimed specifically at resolving conflicts between trademarks and geographical indications. Third, it would help Nigeria to adopt provisions that would facilitate its accession to the Geneva Act and thus provide a means for the registration and protection of Nigerian geographical indications abroad via WIPO in other countries that are part of the Lisbon system.

## 5 | CONCLUSION

In sum, it is time to rethink the protection of geographical indications in Nigeria. Securing the protection of the unique agricultural and non-agricultural products manufactured in Nigeria both inside and outside the country can contribute to the socioeconomic advancement of the communities where some of these products are manufactured. It could also contribute to the generation of employment opportunities in these communities. Alongside other measures aimed at improving these communities,<sup>15</sup> and with the acknowledgement that not all communities and products may benefit from the protection of geographical indications, the enactment of a *sui generis* law on geographical indications would go some way in improving the lives of the people living in some of these communities.<sup>16</sup>

### CONFLICT OF INTEREST

The author declares no conflict of interest.

## DATA AVAILABILITY STATEMENT

Data sharing not applicable to this article as no data sets were generated or analysed during the current study.

## ENDNOTES

- <sup>1</sup> Ayoyemi Lawal-Arowolo, 'Geographical Indications and Cultural Artworks in Nigeria: A Cue from other Jurisdictions' (2019) 22 *JWIP* 364 (noting that: 'Nigeria has abundant indigenous products (derived from biological and cultural resources) that can benefit from the kind of protection offered by geographical indications (GIs) ... In Nigeria, these products include but are not limited to: (a) Food and beverages: ofada rice, palm wine, Kilishi, cocoa/coffee beans, cassava products, such as "garri," (b) textiles: adire and ofi amongst others, and (c) artworks: carvings, pottery, sculpture, metal works, and paintings...').
- <sup>2</sup> See, Adebambo Adewopo, Helen Chuma-Okoro, and Adejoke Oyewunmi, 'A Consideration of Communal Trademarks for Nigerian Leather and Textile Products' in Jeremy de Beer, Chris Armstrong, Chidi Oguamanam, and Tobias Schonwetter (eds.), *Innovation and Intellectual Property: Collaborative Dynamics in Africa* (UCT Press 2014) 123 (noting that: 'Small-scale operators engaged in the production and manufacture of leather and textile goods in Nigeria hold great potential for improved economic performance, but they face myriad challenges. Key among these challenges is market access, both locally and internationally. Based on the findings of this study study, we are of the view that one of the tools with potential to ameliorate the market position of the three producer clusters studied is the use of communal trademarks (i.e., certification marks, collective marks and/or GIs). The authors define communal trademarks to include geographical indications (GIs).
- <sup>3</sup> *Ibid* (observing that: '...the successful implementation of a communal trademark could have many economic and social benefits, including increased income levels and livelihood opportunities for the large and growing percentage of the population made up of young Nigerians.').
- <sup>4</sup> See, GHC Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property* (United International Bureaux for the Protection of Intellectual Property 1969) 23.
- <sup>5</sup> *Ibid*.
- <sup>6</sup> WIPO, *Geographical Indications: An Introduction* (2017) 14.
- <sup>7</sup> See generally, Muriel Lightbourne, 'What's in a Name? The Journey of Geographical Indications from Paris 1883 to Geneva 2015' (2021) 70(10) *GRURI* 932; Anna Micara, 'The Geneva Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration: An Assessment of a Controversial Agreement' (2016) 47 *IRIPCL* 673; Daniel Gervais, 'Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law' (2015) 53(2) *HLR* 339.
- <sup>8</sup> Article 2(1) of the Geneva Act which deals with subject matter provides that: This Act applies in respect of: (i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation; as well as (ii) any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.
- <sup>9</sup> Article 11 of the Geneva Act provides that:
  - (1) [*Content of Protection*] Subject to the provisions of this Act, in respect of a registered appellation of origin or a registered geographical indication, each Contracting Party shall provide the legal means to prevent:
    - (a) use of the appellation of origin or the geographical indication
    - (i) in respect of goods of the same kind as those to which the appellation of origin or the geographical indication applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication;
    - (ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation;
  - (b) any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods.
  - (2) [*Content of Protection in Respect of Certain Uses*] Paragraph (1)(a) shall also apply to use of the appellation of origin or geographical indication amounting to its imitation, even if the true origin of the goods is indicated, or if the appellation of origin or the geographical indication is used in translated form or is accompanied by terms such as 'style', 'kind', 'type', 'make', 'imitation', 'method', 'as produced in', 'like', 'similar' or the like.

(3) [Use in a Trademark] Without prejudice to Article 13(1), a Contracting Party shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).

<sup>10</sup> Articles 7(1) and 8(1) of the Geneva Act.

Article 7(1) of the Geneva Act provides that:

[*International Registration Fee*] International registration of each appellation of origin, and each geographical indication, shall be subject to payment of the fee specified in the Regulations.

Article 8(1) of the Geneva Act provides that:

[*Dependency*] International registrations shall be valid indefinitely, on the understanding that the protection of a registered appellation of origin or geographical indication shall no longer be required if the denomination constituting the appellation of origin, or the indication constituting the geographical indication, is no longer protected in the Contracting Party of Origin.

<sup>11</sup> Articles 8(1) and 12 of the Geneva Act.

Article 12 of the Geneva Act provides that:

Subject to the provisions of this Act, registered appellations of origin and registered geographical indications cannot be considered to have become generic in a Contracting Party.

<sup>12</sup> Article 22.2 of the TRIPS Agreement provides that:

In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

(b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).

<sup>13</sup> See, the Geographical Indications of Goods (Registration and Protection) Act No. 48 of 1999 of India.

<sup>14</sup> See, Geographical Indications Act, 2003 (Act 659) of Ghana.

<sup>15</sup> Adewopo et al. (n 2); (noting that: 'Beyond IP and standardisation matters, there is a need to address factors leading to the high cost of production. Policies are needed to minimise the manufacturing costs of local manufacturers, so that they can compete with imported products in terms of quality and price.')

<sup>16</sup> See also, Ayoyemi Lawal-Arowolo (n 1); (contending that: 'The existence of an effective enforcement mechanism for GIs protection provides an alternative economic stream for indigenous communities that are dominant features of developing countries. GIs is not limited to the monetary benefits of indigenous products, nonmonetary benefits, such as the protection of knowledge and community rights is another aspect i.e. protected ... Provisions for registering GIs in communities with low levels of technology provides the opportunity to promote and benefit from indigenous products and know-how. Indeed GIs can be a development tool.')

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