

**THE CHALLENGES OF TRADEMARK PROTECTION LAW IN NIGERIA**

**BY**

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## **DEDICATION**

To

The Almighty Father

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## ABSTRACT

The trademark protection law is recognised in Nigeria but its key components - service marks, trade dress, and counterfeit of domain names - are yet to be incorporated into the law. Previous studies noted the absence of these key components but did not advance arguments for their full incorporation into the Act. This study examined the validity, adequacy or otherwise of the components under the Nigerian Trade Marks Act (NTMA) 1965 and in comparison with the United Kingdom Trade Marks Act 1994 (UKTMA) with a view to proposing their incorporation into NTMA.

The theoretical framework for this study is sited within the sociological jurisprudence school and the economic analysis of law. Doctrinal and comparative legal research methodologies were adopted. The primary sources used included the Constitution of the Federal Republic of Nigeria 1999, Merchandise Marks Act, 1916, NTMA 1965, Economic and Financial Crimes Commission Act 2004; the UKTMA 1938 and 1994, Paris Convention for the protection of Industrial Property 1963, Trade-Related Aspects of Intellectual Property Rights (TRIPs) 1995, Universal Declaration of Human Rights 1948. Case laws from Nigeria and United Kingdom were used. Secondary sources included legal books, law journals and articles. Unstructured interviews were conducted with accidentally selected intellectual property practitioners and experts in Abuja, Ibadan, Ilishan-Remo and Lagos; and randomly selected petty traders and shop keepers in Ibadan were also interviewed. Data were subjected to descriptive and comparative analysis.

The substantive law on trademark is the Trade Marks Act 1965 which regulates trademark in Nigeria today. The NTMA 1965 is based substantially on the old United Kingdom Trade Mark Act 1938, replaced with the UKTMA 1994, but the NTMA has remained unreviewed. The definition of trademark under section 67 of the NTMA excludes service mark and packaging contrary to other legislations such as the United Kingdom's. The NTMA is inadequate in that it applies only to goods unlike the UKTMA which apply to both goods and services. In 2007, the Minister of Commerce extended classes of goods and services under the Nice Classification of Goods 1957 but Nigeria does not subscribe to this treaty; it only adopts an observer status. The Minister's exercise of his power to make regulations extends to goods and not to services as goods are not services and vice versa. Nigeria has, over the years, incorporated commerce into the Act but this is still premised on the UKTMA 1938

which does not reflect new trends on trademarks. The NTMA, unlike UKTMA, does not recognise trade dress. The NTMA is flawed in the absence of legislative protection on trade dress which results in endless cases of unrecognised infringement. The NTMA, unlike the UKTMA, does not define infringement.

The Trademark law in Nigeria is an integral aspect of industrial property but its key components have not been accorded due rights and privileges compared to the United Kingdom Trade Mark Act. This makes the Nigerian Trade Marks Act to be unfavourably comparable to that of the United Kingdom. Therefore, appropriate amendments should be made for competitiveness.

Keywords: Nigerian Trade Mark Act, United Kingdom Trade Mark Act, Service marks, Trade dress, Counterfeit of domain names

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## **TABLE OF INTERNATIONAL INSTRUMENTS/TREATIES**

Paris Convention 1883

Trade-related-aspects of Intellectual Property 1995

## ABBREVIATIONS

ALL E.R. – ALL England Report

ALL N.L.R. – ALL Nigeria Law Report

A.C. – Appeal Cases

BERKELY TECH. L.J. –Berkely Technology Law Journal

CAP- Chapter

CARDOZO L. REV. –Cardozo Law Review

Ch.D- Chancery Division

CHI-KENT L. REV. –Chicago Kentucky Law Review

COLUM. L. REV. - Columbia Law Review

EFCC- Economic and Financial Crimes Commission

EIPR- European Intellectual Property

EMORY L.J. – Emory Law Journal

EWCA Civ – England and Wales Court of Appeal (Civil Division) Decisions

EWHC – High Court of Justice of England and Wales

FHC- Federal High Court

FORDHAM L.J.- Fordham Law Journal

FSR- Fleet Street Reports

GATT- General Agreement on Tariffs and Trade

GEO. L.J. – Georgetown Law Journal

HARV. L. REV. - Harvard Law Review

HARV. J.L. & PUB. POL'Y- Harvard Journal of Law and Public Policy

HOUS. L. REV. – Houston Law Review

IPO – Intellectual Property Organisation

LFN- Laws of the Federation

NEB. L. REV. – Nebraska Law Review

NILQ- Northern Ireland Legal Quarterly

NOTRE DAME L. REV. – Notre Dame Law Review

NTMA – Nigerian Trade Marks Act

PITT. L. REV. - Pittsburgh Law Review

STAN. L. REV. – Stanford Law Review

TM Rep. – Trademark Reporter

TMA – Trade Marks Act

UCLA L. REV. – UCLA Law Review

UC DAVIS L. REV.- University of California Davis Law Review

UKTMA – United Kingdom Trade Marks Act

VAND. L. REV. –Vanderbilt Law Review

WIPO – World Intellectual Property Organisation

WTO- World Trade Organisation

YALE L.J. - Yale Law Journal

## CHAPTER ONE

### GENERAL INTRODUCTION

#### 1.1 Background to the Study

The concept of trade marks signifies the materialization of creative minds toward branding of products which is essential in the 21<sup>st</sup> century business as purchasing decisions are constantly influenced by trade marks which help distinguish products and services from those of competitors and help identify a particular company as a source. A trademark performs certain functions such as identifying a seller's goods and distinguishing them from others, associates the goods with the provider, serves as a representation of a certain level of quality and is regarded as a strong advertising instrument.<sup>1</sup> A trademark enhances the economic efficiency of the marketplace by “lessening consumer search costs; by making products and producers easier to identify in the open market,” and “encouraging producers to invest in quality by ensuring that the owners, and not their competitors, reap the reputation-related rewards of that investment.”<sup>2</sup> Another name for a trademark is a mark which is regarded as an insignia of “dependable source and superiority.”<sup>3</sup>

For a trademark to be registered, it has to be situated in the country where it is found as the rationale behind every registration is that the owner of the trademark has the right to protect its trademark property from persons who do not have the right to use that trademark.<sup>4</sup> It prevents the simultaneous existence of similar trademarks which are confusing and serves as proof of ownership, especially in cases of infringement. Trademark registration gives the trademark owners the exclusive right to commercially use the protected names or symbols, including licensing them to third parties. These exclusive rights are enforced by a country's judicial system. For example, in order to immediately stop infringing activities, such as the sale of counterfeit products, trademark holders can request seizures or preliminary injunctions through the court system.<sup>5</sup>

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<sup>1</sup> McCarthy, J.T. 2004. McCarthy on Trademarks and Unfair Competition. 4<sup>th</sup> Edition. Section 26: 1-4, 29: 1-7 Retrieved August 12, 2013 from <https://www.carswell.com/product-detail/Mccarthy-on-Trademark-and-Unfair-Competition>

<sup>2</sup> Beebe, B. 1995. The Semiotic Analysis of Trademark Law, 51 *UCLA L. REV.* 621, 623; *Accord Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64

<sup>3</sup> Klieger, R.N. 1997. Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection, 58 *U. of PITT. L. REV.* 789, 790; cf. Lemley, M.A. and McKenna, M. 2010. Irrelevant Confusion, 62 *STAN. L. REV.* 413, 414

<sup>4</sup> Landes, W. M. & Posner, R. A. 1987. Trademark Law: An Economic Perspective, 30 *Journal of Law and Economics*, 265, 271-73

<sup>5</sup> Eugenia Baroncelli, et.al., 2005. The Global Distribution of Trademarks: Some Stylized Facts. Blackwell Publishing Ltd. *World Economy*, Volume 28, Issue 6. Pages 765-782. Retrieved August 20, 2013 from <http://dx.doi.org/10.1111/j.1467-9701.2005.00706.x>

Non-registration of trademarks on the other hand, creates confusion especially where two similar trademarks are used in the same market. When this occurs, consumers may become confused and disillusioned when a mark they think they know and recognise does not actually represent the source of the good they understood it to represent.<sup>6</sup> The end result is that the goodwill of the first trademark user can be irreparably harmed.<sup>7</sup> Infringement can occur when there are no effective laws and where the general consuming public are not educated on the law of trademarks and are therefore, illiterate. The trademark system is designed to protect the reputational assets of a natural person or a legal entity by providing incentives for investments in the value of products sold to the public.<sup>8</sup>

Registers containing trademark registrations are found in virtually every country but national regimes often differ as to particular signs which qualify as trademark, the scope of protection, guidelines for avoiding confusing marks, registration costs, legal means available to fight infringement and other important details.<sup>9</sup> Under the NTMA, the ownership of trade mark which has been registered is for a period of seven years and this can be renewed in accordance with the provisions of this Act from time to time.<sup>10</sup> When the right to use the trade mark has expired, an owner can renew for a further period of fourteen years.<sup>11</sup> As such, where a trademark is registered, the owner is able to build goodwill and reputation in its enterprise and to prevent others from misleading consumers by false association with an enterprise, with which they are not connected.<sup>12</sup>

Trademark rights are, like all other intellectual property rights, characteristically territorial.<sup>13</sup> The territorial nature of these rights means that each state or region determines, for its own territory and independently from any other state or country, what is to be protected as trademark; who should benefit from such protection and for how long the protection should

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<sup>6</sup> Ibid.

<sup>7</sup> Ibid.

<sup>8</sup> Landes, W. M. and Posner, R. A. 1987. Trademark Law: An Economic Perspective, 30 *Journal of Law and Economics*, 265, 271-73

<sup>9</sup> Eugenia Baroncelli, et.al., *ibid.*

<sup>10</sup> Section 23(1), NTMA, Laws of the Federation 2004

<sup>11</sup> Ibid.

<sup>12</sup> Eugenia Baroncelli, et.al., 2005. The Global Distribution of Trademarks: Some Stylized Facts. Blackwell Publishing Ltd. *World Economy*, Volume 28, Issue 6. Pages 765-782. Retrieved August 20, 2013 from <http://dx.doi.org/10.1111/j.1467-9701.2005.00706.x>

<sup>13</sup> Alexander, M.J. & Coil, J.H. 1978. Geographical Rights in Trademark and Service Marks 68 *Trademark Rep.* 101, 102



be enforced.<sup>14</sup> That is, each nation protects its intellectual property rights only insofar as these rights are exercised under domestic laws. Where a person seeks to register a trademark in another country apart from where the person is situated, the territorial nature of trademark is brought to the fore-front and such a person would have to pay the required procedural fees in each country where such protection is required and the probabilities of its success differs in each country.<sup>15</sup>

Different countries signed treaties that are overseen by WIPO, such as the Paris Convention, TRIPs Agreement, Protocol to Madrid, and so forth, to improve industrial property rights on an international scale.<sup>16</sup> The Paris Convention is the oldest among all the other treaties,<sup>17</sup> and it imbibes the territorial doctrine and provides that when a mark is registered in country A, it will be independent of marks registered in Countries B and C that are members of the Union,<sup>18</sup> and hence, the treaty provides guidelines for the domestic trademark system of each country.<sup>19</sup> Each country, therefore, has its own trademark system governed by its own domestic statutory provisions.<sup>20</sup> Thus, to obtain trademark protection in a given country, the requirements as designated in that country's domestic law must be satisfied. For example, to establish trademark rights in Nigeria, for instance, priority of use must be established in Nigeria, but not priority of use anywhere else in the world as a trade mark's registration in one country does not have any effect in other countries. If a trademark has been registered, the effect of the registration will cover the country for which it was registered. In order to obtain protection in other countries, the trade mark must be registered in each country except in the case of an international or regional registration or used in countries where use without registration may lead to protection.<sup>21</sup> Where trade mark protection is based on mere use without registration, the territorial scope of protection may be limited to the area, that is, the

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<sup>14</sup> Slováková, Z. 2006. Protection of trademarks and the Internet with respect to the Czech Law. Retrieved March 29, 2014 from [www.jiclt.com/index.php/jiclt/article/ViewFile/9/8](http://www.jiclt.com/index.php/jiclt/article/ViewFile/9/8)

<sup>15</sup> Landas, S.P. 1975. *Patents, Trademarks & Related Rights: National and International Protection*. Harvard University Press, pgs.3-4

<sup>16</sup> Oyewunmi, A.O. 2015. *Nigerian Law of Intellectual Property*. University of Lagos Press Ltd., at p. 316

<sup>17</sup> It was enacted in 1883. See Paris Convention for the Protection of Industrial Property- WIPO. Retrieved August 20, 2016 from [www.wipo.int/treaties/en/ip/paris/](http://www.wipo.int/treaties/en/ip/paris/)

<sup>18</sup> The Union here, means the countries that are signatories to the Paris Convention. There are over one hundred and seventy countries that are members. Nigeria acceded to this convention on July 17, 1963 but it entered into force on September 2, 1963. See World Intellectual Property Organization. *Treaties and Contracting Parties*. Retrieved August 20, 2016 from [www.wipo.int](http://www.wipo.int)

<sup>19</sup> Article 6(3) Paris Convention, 1883

<sup>20</sup> Brook, R. 2009. The United States' Adoption of the Well-known Foreign Mark Exception, 36 *Fordham Urb. L.J.* 889, 892

<sup>21</sup> Shyllon, F. 2003. *Intellectual Property Law in Nigeria*. Volume 21. Published by the Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, at p. 205

original country, where the trade mark is used.<sup>22</sup> In other words, a United Kingdom trade mark covers the United Kingdom whilst a Community trade mark covers the Community of the European Union.<sup>23</sup>

Nigeria is a member of WIPO and ratified the Paris Convention for the Protection of Industrial Property in September 1963; and TRIPs in 1995.<sup>24</sup> In providing for a single application by which the process of securing a trademark can be opened in designated countries simultaneously, the United Kingdom also signed the above treaties in addition to the Protocol Madrid Agreement and this is well provided for, under the UKTMA. Hence, in order to succeed in registering any trademark, each country will have to follow national laws and procedures in dealing with the application.<sup>25</sup>

However, a disadvantage of a trademark is that it may lose its legal protection and distinctiveness if it is too successful. In other words, a trademark would become generic whereby the public uses it to identify all products of a certain type rather than the products manufactured by the owner of the mark and the result being that the mark will enter the public domain and invariably, lose its legal protection.<sup>26</sup>

Trademark law avoids the existence of similar goods resembling each other by preventing companies from diluting the marks of other firms. Dilution is not discussed under the NTMA and it occurs when a similar mark adversely affects the reputation of a distinctive trademark regardless of whether it leads to consumer misperception or not.<sup>27</sup> It arises when a third party uses a mark that is similar to a known mark such that the end result is that it harms the perception of consumers. There are two types of harm which occur from dilution and they are dilution by blurring and tarnishment.<sup>28</sup> Blurring is when a famous mark's distinctiveness is

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<sup>22</sup> Shyllon, F., *ibid.* at p. 205

<sup>23</sup> Morcom, C., Roughton, A. and Malynicz, S. 2008. *The Modern Law of Trade Marks* (3<sup>rd</sup> Edition) Lexis Nexis, 431-432

<sup>24</sup> World Intellectual Property Organisation (WIPO) Nigeria: IP Laws and Treaties. Retrieved October 16, 2018 from [www.wipo.int/wipolex/profile](http://www.wipo.int/wipolex/profile). See further Iberiyenari, L.: A Brief Analysis of Intellectual Property Law in Nigeria. *The Lawyers Chronicle*. Retrieved June 15, 2014 from <http://thelawyerschronicle-com/a-brief-analysis-of-intellectual...>

<sup>25</sup> This would include strict time limits for processing the application. Derenberg, W.J. 1973. *The Myth of the Proposed International Trademark "Registration" Treaty (TRT) 63 T.M.R.* 531, 541.

<sup>26</sup> Itanyi, N. 2015. When a Trademark becomes a Victim of its own Success: The Irony of the concept of Genericide. *The Nigerian Juridical Review*, Vol. 13, p. 157

<sup>27</sup> What is the purpose of trademark law? Retrieved December 28, 2013 from [www.matecaboy.com/...7dBf58d340539a](http://www.matecaboy.com/...7dBf58d340539a)

<sup>28</sup> Justia. Trademark Dilution Overview. Retrieved October 12, 2018 from <https://www.justia.com/trademarks/tra...>

harmed because it becomes or is likely to become associated with a similar mark. That is, the third party's mark weakens the consumer's perception that the mark which is famous is in some way connected to the plaintiff's goods or services.<sup>29</sup> Tarnishment on the other hand, occurs when the famous mark's reputation is harmed through association with a similar mark or trade name and this applies generally when the defendant's use of the mark is connected to inferior products or services. Trademark dilution is a concept of the United States of America and is covered under some state and federal laws.<sup>30</sup> In a simpler sense, the purpose of trademark protection law is to permit firms to establish or maintain goodwill, and to preserve their reputation among consumers.<sup>31</sup>

Globalization and new technological developments has made trademarks more important especially in relation to the internet domain name system and the advent of electronic commerce. Trademarks are an essential part of e-commerce business as identification of products, customer recognition and goodwill are essential elements of web-based business, which are protected by trademarks and unfair competition laws.<sup>32</sup> Domain names consists of different components such as the "Top Level Domain" (TLD) which appears as a suffix to the name of the site such as "uk", "org", or ".com", and the "Second Level Domain" (SLD), which includes the trademark or business name of the registrant, and this facilitates the functioning of domain names as business identifiers in a manner similar to trademarks.<sup>33</sup> Domain names function as a type of mnemonic, or alias that assists Internet users in finding particular websites and are also a key element of the Uniform Resource Locators ("URL") needed to reach computers on the Internet.<sup>34</sup> Domain names are seen as symbols that identify the source of particular products and services.<sup>35</sup> The rationale behind protecting domain names is the purpose it serves is that first, the public gain easy access to information

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<sup>29</sup> Ibid.

<sup>30</sup> Ibid. There is the Federal Trademark Dilution Act of 1995. Hence, under this law, only famous marks are protected against dilution

<sup>31</sup> Landes, W.M. & Posner, R. A. 1987. Trademark Law: An Economic Perspective, 30 *Journal of Law and Economics*, 265

<sup>32</sup> Understanding How Intellectual Property (IP) Relates to E-Commerce (WIPO). Retrieved January 3, 2018 from [www.wipo.int/sme/ip\\_ecommerce](http://www.wipo.int/sme/ip_ecommerce)...

<sup>33</sup> Carolina, R. & Stokes, S. 2006. *Encyclopaedia of E-Commerce Law*. Thompson Sweet and Maxwell, 41

<sup>34</sup> Rony, E. & Rony, P. 1998. The domain name handbook: High stakes and strategies in cyberspace. Retrieved December 10, 2013 from <https://www.amazon.com/Domain-Handbook-Stakes/> 1-136. See also Halpern, M.O. and Mehrotra, A.J. 2000. From international treaties to internet norms: The evolution of international trademark disputes in the internet age. *University of Pennsylvania Journal of International Economic Law*, 21(3) Articles from Maurer Faculty, Paper 288; 523-527. Retrieved December 10, 2013 from <http://www.repository.law.indiana.edu/facpub/288>

<sup>35</sup> Anthony, S. 1999. Domain Name: The New Trademarks, in Trademark Law and the Internet (Lisa E. Cristal & Neal S. Greenfield eds., 1999).

and secondly, the owner is able to advertise its goods.<sup>36</sup> Trademark owners have found that their marks are being used as domain names by unauthorized persons, often in a deliberate attempt to profit from the business of the owner of the trademark without permission.<sup>37</sup> A company's website can be a vital tool in promoting business online and for generating sales. The risk which is evident is that as e-commerce increases, so does the risk that others may copy the look and feel of the original owner of the website.<sup>38</sup> In other words, as identifiers of the source of commercial goods and services, trademarks are necessarily industry-specific and geographically limited. E-commerce continues to grow rapidly in Nigeria and is considered the fastest and preferred platform for buying and selling goods and services.<sup>39</sup> Trademark protection exists to prevent confusion over the origins of particular products or services in a specific commercial area. As long as there is no likelihood of confusion, companies using the same mark, can and will generally operate at the same time in different industries or locations.<sup>40</sup>

The main objective of the law on trademark is to guarantee that a third party does not use a mark which is identical to or closely resembling the owner's trademark which would likely cause confusion to the public when trading.<sup>41</sup> In *CPL Industries Limited v. Morrison Industries Plc*, it was held that it is the duty of the court to determine likelihood of deception. In cases of infringement, the question whether one Mark is likely to cause confusion is a matter upon which the Judge must discern and which he alone must decide<sup>42</sup>.

The protection of trademark is of great importance to manufacturers of goods and products, for example, chemical, pharmaceutical and mineral substances, furniture and upholstery, paper, mineral and aerated waters, tobacco and other products and it also applies to those who trade in these goods and products, using specified trademarks and trade names.<sup>43</sup> Trademarks

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<sup>36</sup> Oyewunmi, A., op.cit. at pp. 346-347

<sup>37</sup> Dueker, K.S. 1996. Trademark law lost in cyberspace: Trademark protection for internet addresses. *Harvard Journal of Law and Technology*, Volume 9, No. 2, 483 at 500

<sup>38</sup> Verbaughede, L. 2004. Intellectual property and e-Commerce: How to take care of your Business' Website. *Journal of Intellectual Property Rights*, Vol. 9, pp.568-580

<sup>39</sup> Nigerian Law Today. E-Commerce evolution in Nigeria: Opportunities and Threats. Retrieved January 3, 2018 from [nigerianlawtoday.com>e-commerce-evo...](http://nigerianlawtoday.com/e-commerce-evo...)

<sup>40</sup> See McCarthy, J.T. 2004. McCarthy on Trademarks and Unfair Competition. 4<sup>th</sup> Edition. Section 26: 1-4, 29: 1-7 Retrieved August 12, 2013 from <https://www.carswell.com/product-detail/Mccarthy-on-Trademark-and-Unfair-Competition>

<sup>41</sup> Section 5 (2) NTMA, Cap. T 13, Laws of the Federation 2004

<sup>42</sup> (2003-2007) 5 I.P.L.R.,

<sup>43</sup> Babafemi, F.O. 2007. *Intellectual Property: The Law and Practice of Copyright, Trade Marks, Patents and Industrial Designs in Nigeria*. Justinian Books Limited.

can therefore be equated as an asset or symbol which identify and convey information to the consumer about the product.<sup>44</sup>

It is essential that trade mark and intellectual property right be protected. Where trademarks are not protected, there would be a high level of counterfeiting of trademarks and every major producer of brand name such as clothing, shoes, agricultural chemicals and pharmaceuticals would be victimized by organized piracy and inadequate protection under trademark law in various third World countries; and many of the counterfeit goods make their way into Nigeria, and other foreign markets.<sup>45</sup> The importance of intellectual property is further expounded under the Universal Declaration of Human Rights,<sup>46</sup> that the owners of copyright, trademark, patent and design, have the right to benefit from their innovations and at the same time, be able to protect their economic interests resulting from such intellectual property rights.

The inadequate protection of intellectual property in developing countries can be viewed at two levels: the non-existent governmental enforcement of the law and the deficient coverage of intellectual property in the law itself. The second view is that although some countries have satisfactory coverage in their substantive laws, the government falls short of adequately enforcing those laws. Weak enforcement can take the form of administrative delays which in effect discriminate against foreign and national litigants. Ineffective laws invariably affect the economy of a nation and hence, the extant laws which ought to be accorded its due rights and privileges has not been given priority as the mechanism adopted for such has not been properly equipped.

## **1.2. Statement of the Problem**

Trademark protection law is an aspect of intellectual property which is in need of urgent reforms. The laws on trademark protection in Nigeria is still deficient in areas such as service marks, get-up and has not given due recognition to other types of trademark infringement such as counterfeit of domain names, dilution and parallel importation. The NTMA 1965 has

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<sup>44</sup> Maskus, K.E. 2000. *Intellectual Property Rights in the Global Economy*. Institute for International Economics, California, 47

<sup>45</sup> Darlin, D. 1989. Where Trademarks Are Up for Grabs: U.S. Products Widely Copied in South Korea, Wall St. J., Dec. 5, at B1, col. 3

<sup>46</sup> Article 27, Universal Declaration of Human Rights 1948. Retrieved from World Intellectual Property Organisation(WIPO) Publication No. 450 (E ), ibid

not been amended to take cognisance of the modern trend in trade mark protection and ordinarily, marks that ought to have been accorded due recognition, such as service marks, shapes, packaging, etc., are not included in the Act. Such gaps must however be addressed as they are relevant to the trade mark law system and its economic development despite being obligated by international agreement to do so.

### **1.3. Aim and Objectives of the Study**

An overall aim of this research work is to determine whether the protection of trademark law in Nigeria is adequate.

The specific objectives of the study are to:

- 1) examine the historical origins of trademarks and the concept of trademarks in Nigeria;
- 2) consider the law regulating trademark in Nigeria;
- 3) analyse the comparative assessment of trademark law in Nigeria and the United Kingdom and the relevant international instruments and Nigeria's compliance with them;
- 4) examine the extant laws on other categories of trademark infringement; and
- 5) appraise how Trademark law in Nigeria could be further strengthened

It is of great essence to note that the functions and benefits make the law of trademark a very important instrument to any nation and the utility of the law rests on how effectively the objectives are actualized in a modern society.

### **1.4. Research Questions**

The following research questions were raised:

1. What are the precise origins of trademark and its concept in Nigeria?
2. What are the laws regulating trademark in Nigeria?
3. To what extent has the Nigerian Trademarks law been effective in the protection of trademark?
4. What are the similarities and differences of the trademark laws in Nigeria and the United Kingdom?
5. What are the gaps in the laws regulating trademark in Nigeria?
6. What is the extent of Nigeria's compliance with international instruments on trademark?
7. In what ways can the Nigerian law on trademarks be improved upon?

### **1.5. Research Methodology**

The methodologies adopted for this study are the doctrinal and comparative approach. It compares the Trade Mark Act of Nigeria with that of the United Kingdom. The United Kingdom was selected because Nigeria was once a British colony and has legislative connection with the United Kingdom. Hence, the NTMA 1965 is a replica of the UKTMA 1938.

The theoretical framework for this study is sited within the sociological jurisprudence school and the economic analysis of law. Doctrinal and comparative legal research methodologies were adopted. The primary sources used included the Constitution of the Federal Republic of Nigeria 1999(As amended), Merchandise Marks Act, 1916, NTMA 1965, Economic and Financial Crimes Commission Act 2004; the UKTMA 1938 and 1994, Paris Convention for the protection of Industrial Property 1963, Trade-Related Aspects of Intellectual Property Rights (TRIPs) 1995, Universal Declaration of Human Rights 1948. Case laws from Nigeria and United Kingdom were used. Secondary sources included legal books, articles in law journals and online materials. Unstructured interviews were conducted with accidentally selected intellectual property practitioners and experts in Abuja, Ibadan, Ilishan-Remo and Lagos; and randomly selected petty traders and shop keepers in Ibadan were also interviewed. This study is majorly qualitative which forms the basis of this work. Secondary sources includes, textbooks, journal articles and online materials were used to enrich the research work.

Unstructured interviews, were conducted with selected intellectual property practitioners, and members of the public in Abuja, Ibadan, Ilishan-Remo, and Lagos via telephone conversations, e-mails, and other mediums. An interactive session was also held at Babcock University, Ilishan-Remo where the researcher had the opportunity of interacting with scholars on trademarks law. Interactive sessions were held with seven (7) Intellectual Property practitioners while In-depth interviews were done with selected members of the public within Ibadan to determine whether there was an appreciation or knowledge of trademarks. Information obtained from these sources was subjected to content, descriptive and comparative analysis.

### **1.6. Justification of the Study**

This study on trademarks provides a unique and in-depth literature on the recent area of research in Nigeria. Trademarks are recognized as identification factors which are used in distinguishing the source of one product from the other.<sup>47</sup> In *Hanover Star Milling Co. v. Metcalf*,<sup>48</sup> the Court upheld the function of the law on trade mark as being able to identify the origin or ownership because of the mark attached on the body of the product.<sup>49</sup>

In Nigeria, there is the need for trademarks to be protected in order to deter infringement occurrences. For a trademark to be recognised, it must be affixed on products as it would be difficult for the product to be easily identified without the symbol representing such a product. Once a trademark has been identified, and in order for the owner to retain consistent quality, there will be the greater need to protect the trademark. Without legal protection, it would be difficult for the user of a mark to appropriate the full value that the mark represents.

A trademark confers no monopoly in any way but is merely a convenient means for facilitating the protection of one's good-will in trade by placing a distinguishing mark or symbol, or a commercial signature, upon the merchandise or the package in which it is sold. A trademark, then, is a "distinguishing" mark, a way of identifying the good. The mark serves no other function and enjoys no legal existence independent of the goodwill that it symbolizes.<sup>50</sup>

This study on trademark protection provides additional information on the relatively novel area of research in Nigeria. This study therefore offers additional information to discuss the unique nature of the importance of adequate protection of trademark laws in Nigeria. This study will therefore be of immense benefit to academia, legal practitioners, scholars and to other members of the general public.

### **1.7. Scope of the Study**

This study dealt with the challenges of trademark protection law in Nigeria. It compared the UKTMA 1994<sup>51</sup> with the NTMA 1965<sup>52</sup>. The essence of comparison is as a result of the colonization of Nigeria by the British and hence, Nigeria's legislative laws on trademark are similar to that of the repealed UKTMA 1938.

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<sup>47</sup> See Kitchin, D., et.al.2005. *Kelly's Law of Trademarks and Trade names*; (London: Sweet and Maxwell), p.9; Groves, P.J. 1997. *Intellectual Property Law*. Cavendish Publishing Limited, London, p.512.

<sup>48</sup> (1916) 240 U.S. 403

<sup>49</sup> See Groves, *ibid*.

<sup>50</sup> Carter, S. L. 1990. The Trouble with Trademark. *Faculty Scholarship Series*. Paper 2242. Retrieved September 10, 2013 from [http://digitalcommons.law.yale.edu/fss\\_papers/2242](http://digitalcommons.law.yale.edu/fss_papers/2242)

<sup>51</sup> The UKTMA 1994 is the national law for the protection of Trade Mark Law in the United Kingdom

<sup>52</sup> The NTMA 1965 is the substantive law on trade marks for the Federal Republic of Nigeria



### **1.8 Expected outcomes of this study**

The expected outcomes are to:

- a. state the trademark law as it is today
- b. identify gaps in the law
- c. suggest improvements to the law
- d. raise public awareness with regard to the economic and commercial values of a good trademark law so as to sensitize the legislature, judiciary and policy makers of the urgent need to modernize Nigerian Trademark Law.

This study is therefore expected to make suggestions and recommendations for the policy makers and legislature on trademark protection, whilst at the same time, taking into account the challenges currently facing trademark law protection in Nigeria, and whether Nigeria has been able to overcome these challenges. Hence, this study will contribute to knowledge and fill the existing lacunae in the literature of trademark protection in Nigeria which would invariably aid in the economic development of the country.

### **1.9. Limitation of the Study**

Initially, a major challenge to the study was that textbooks or journals written by most Nigerian authors who are experts in trademark publish such articles abroad and hence, not within reach. This the researcher knows because there was a large section of legal books by Nigerian authors at the Queen Mary University, London, United Kingdom. Therefore, a significant number of the available literature used in this study was foreign-based which were easily accessible. Nevertheless, the available information and data found by the researcher were made use of judiciously in presenting an informed policy framework that would be of immense benefit to the generality of Nigeria.

### **1.10. Definition of Terms**

Intellectual property is a vast and complex term and there has been confusion in relation to its other aspects but it is categorically divided into industrial property and copyright.<sup>53</sup> Industrial property are patents, registered designs and trademarks as they relate with industry and

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<sup>53</sup> World Intellectual Property Organisation (WIPO) Handbook, Policy, Law and Use. 2004. Geneva. Second Edition. WIPO Publication. No. 489(E). Retrieved October 7, 2013 from <http://www.wipo.int/about-ip/en/iprml>

commerce.<sup>54</sup> This is important at this stage to compare all other types of intellectual property with trademarks. One of the reasons is that at times, trademarks may overlap with other types of intellectual property but are nevertheless distinct from each other. They include:

### **1.10.1 Copyright**

Copyright is defined as a bundle of legal prerogatives granted by national legislatures that includes the right to make copies, to produce derivative works, to distribute protected works, as well as the right to display or to perform them.<sup>55</sup> The difference between copyright and trademark is that while both offer intellectual property protection, they protect different types of assets. Copyright protects literary and artistic works, such as books and videos and a trademark on the other hand, protects items that help define a company brand, such as a logo.<sup>56</sup>

It is common for trademarks and copyright to overlap. This happens frequently in books, websites, CD, etc. On these products, trademark protects the brand or logo of the company or publisher while copyright protects the text, music and other original content.<sup>57</sup>

### **1.10.2 Trademark**

The definition given by the World Intellectual Property Organization (WIPO) states that trademark is a distinct sign to identify the goods offered by a manufacturer to the public.<sup>58</sup>

A trademark should be differentiated from a trade name. A trade name identifies and distinguishes an enterprise and its business activities from those of other enterprises.<sup>59</sup> The difference between them is that while a trademark distinguishes the goods and services of a particular manufacturer, a trade name identifies the entire enterprise without necessarily any reference to its goods or services.<sup>60</sup>

### **1.10.3 Patents**

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<sup>54</sup> Peter, J.G. 1997. Source Book on Intellectual Property Law. Cavendish Publishing, London, p.3

<sup>55</sup> Raskind, L.J. 1998. "Copyright" in Newman (ed.) The New Palgrave Dictionary of Economics and the Law

<sup>56</sup> Differences between Copyright and Trademark. Retrieved September 20, 2013 from [smallbusiness.chron.com/differences-between-copyright-trademark-3218.html](http://smallbusiness.chron.com/differences-between-copyright-trademark-3218.html)

<sup>57</sup> Ibid.

<sup>58</sup> WIPO Handbook, op.cit.

<sup>59</sup> Shyllon, F. 2003, op.cit. 8

<sup>60</sup> Ibid. at p.8

A patent is usually a grant made by the relevant government authorities within a country to protect new inventions or improvements thereon that are considered to have improved the way(s) the earlier inventions were made or used.<sup>61</sup> This is issued upon application in several countries by the relevant constituted bodies and just like a trademark, it can be exploited by manufacturing or it can be sold without the permission of the owner. A patent is protected within a time frame of twenty years.<sup>62</sup>

Under the patent law, the innovation need not be new or original but it must be an improvement over the prior art such that one with ordinary skill in that art could not have considered the invention obvious. That is, the new and old innovation must not be too obvious as to be noticeable.<sup>63</sup>

Under the patent law, the innovation need not be new or original but it must be an improvement over the prior art such that one with ordinary skill in that art could not have considered the invention obvious. That is, the new and old innovation must not be too obvious as to be noticeable.<sup>64</sup>

There are generally three types of patents which are not limited to the following: utility, plant, and design.

- a. Utility patents cover those who invent new — or develop a new and useful improvement on — processes and machines, as well as those who discover new compositions of matter. Another name for utility patent is “patent for invention”. This includes things like machines, an original series of steps for making something, and synthesized molecules and chemicals.<sup>65</sup>
- b. Plant patents are designated for those who discover or invent, and reproduce a new variety of plant. For instance, where a new type of “rose” flower is reproduced and is

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<sup>61</sup> Patentability under the Nigerian Patents and Designs Act (PDA). Retrieved September 21, 2017 from <https://www.templars-law.com/wp../Patentability-Under-the-Nigerian-Patent-Act.pdf>

<sup>62</sup> WIPO Handbook, op.cit.

<sup>63</sup> Leaffer, M.A. 1991. Protecting United States Intellectual Property Abroad: Toward a New Multilateralism. Faculty Publications Paper 610. Retrieved June 10, 2014 from <http://www.repositorylaw.indiana.edu/facpub/610/>

<sup>64</sup> Ibid.

<sup>65</sup> Utility Patents. Retrieved August 10, 2013 from <http://www.investopedia.com/terms/a/utility-patent/>

different from what was in existence, that is, it is different in that the flower is thornless or has a different colour, then a plant patent will be granted.<sup>66</sup>

- c. Design patents are reserved for creators of new ornamental designs for functional items. This could include the design of a piece of furniture or a water bottle.<sup>67</sup>

Nigeria, however, does not grant patents in respect of plants, animal varieties, or discoveries of a scientific nature unlike what obtains in the United States, Kenya and South Africa.<sup>68</sup> The Patents and Designs Act<sup>69</sup> does not define an “invention” but sets out conditions under which an invention will be deemed patentable.<sup>70</sup>

A patent has property rights which can be sold, bought or licensed by the owner which must include instructions on the workings of the machinery and it is only effective in the country in which it was registered.<sup>71</sup> A patent has similarities with trademarks and they overlap considerably and just as inventions are protected by patents, so are they also protected by trademarks. Therefore, the duty to exercise and use is linked to patent and trademark rights. Even though patent overlaps with trademarks and can be part of the same product, they each offer different types of legal protection.<sup>72</sup> For instance, a T-shirt with a silkscreen print on it could be covered by trademarks, copyright and patent all at the same time. Trademark protects the logo on the shirt while the silkscreen printed is protected by copyright. The fabric that the shirt is made of if it is a new invention and original type of micro-fiber or textile could be protected by a patent.<sup>73</sup> However, it is not similar in that while protection for a patent lasts for a period of twenty years, for a registered trade mark, it may last longer. It may be perpetual, subject to use and renewal fees and is granted to prevent the public from being confused, while the purpose of design patents is to encourage inventors to develop novel, ornamental designs.<sup>74</sup>

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<sup>66</sup> Plant Patents. Retrieved August 10, 2013 from <https://www.nolo.com/legal-encyclopedia/plant-patents/>

<sup>67</sup> LegalZoom. Definition of a Design Patent. Retrieved August 10, 2013 from <https://www.legalzoom.com/knowledge/patent/topic/patents-definition/>

<sup>68</sup> Patents. Retrieved September 12, 2013 from <https://nlipw.com/some-basic-facts-about-patents/>

<sup>69</sup> Patents and Designs Act, Cap. P2, Laws of the Federation 2004

<sup>70</sup> Section 1(1) Patents and Designs Act, Cap. P2, Laws of the Federation 2004

<sup>71</sup> What is the difference between Copyright, Trademark and Patents? Retrieved April 15, 2014 from [copyrightalliance.org/ca\\_faq\\_post/difference-copyright-patent-trademark/](http://copyrightalliance.org/ca_faq_post/difference-copyright-patent-trademark/)

<sup>72</sup> Kaster, V. 2010. The Overlap of Trademarks, Copyright and Patents. Retrieved August 12, 2013 from <https://iplegalfreebies.wordpress.com/2010/10/07/>

<sup>73</sup> Kaster, V. 2010. The Overlap of Trademarks, Copyright and Patents. Retrieved August 12, 2013 from <https://iplegalfreebies.wordpress.com/2010/10/07/>

<sup>74</sup> Shyllon, F., op. cit at page 14

Trademark protection is not extended to designs that are merely ornamental and are not indicators of source. For example, *in re Owens-Corning Fiberglas Corp.*<sup>75</sup>, a key issue was whether the color, pink, for fiberglass insulation was merely ornamental, or whether it was an indicator of source. Under the Nigerian law, it was held in the case of *Michael Oredolapo v. Lutfallah Bouari*, the claimant, a registered proprietor, had parcels of fabrics, which consisted of a puffed bird and the word, “*banku Leiyenwu*” and other markings, and such trade mark was registered in Nigeria in respect of artificial silk brocade. At the trial, it was discovered that the Plaintiff had ordered artificial silk brocade to be made in England according to a design furnished by him which consisted of a puffed bird. The Defendant admitted selling brocade embodying a design registered in England by the manufacturers from whom he had purchased the brocade and that there was no infringement on the trademark. In the present case, it was held that the Design embodied in the brocade was not the use of a mark within the meaning of the definition, and the Plaintiff’s claim should have been dismissed.<sup>76</sup>

The electronic commerce (otherwise known as e-commerce) revolution has underscored the need to protect IP assets in cyberspace, such as the appearance of computer screen displays and web pages. Designs, such as computer icons, are now commonly protected in various forms through both design patents and trademarks.<sup>77</sup> For example, Sun Microsystems has the coffee cup symbol for its JAVA® product registered as a trademark, and also has a design patent (where the coffee cup is combined with the words “JAVA WORKSHOP”). Thus, a combination of design patent and trademark protection may be the most effective way to protect your trademarks, trade dress and designs in cyberspace.<sup>78</sup>

#### **1.10.4 Service marks**

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<sup>75</sup> 774 F.2d 1116 (Fed. Cir. 1985).

<sup>76</sup> [1917-1976] 1, I.P.L.R. at 74

<sup>77</sup> Katz, R.S., Minsker, H.H., and Maurer, E.S. 2014. Trademarks Design: Combining Design Patent and Trademarks to Protect your Intellectual Property. Retrieved September 5, 2013 from <https://bannerwitcoff.com/AIPLA...>

<sup>78</sup> Katz, R.S., Minsker, H.H., and Maurer, E.S. 2014. Trademarks Design: Combining Design Patent and Trademarks to Protect your Intellectual Property. Retrieved September 5, 2013 from <https://bannerwitcoff.com/AIPLA...>

Another component of trademark is service mark which is essentially the same as trademark but, applies to services rather than products.<sup>79</sup> It is used to identify different services of various business enterprises even if the proprietor of the services is unknown.<sup>80</sup> As a result of the competitive nature of trade, consumers come in contact with different types of goods and services which enables them to make informed choice about the goods that they want to purchase. Such services include insurance companies, car rental, firms, airlines, etc., and they basically have features similar to trademarks.<sup>81</sup> It is to be noted that the use of trademarks under the NTMA, is in relation to goods and it does not cover service marks used by service organisations to distinguish their services from those of other persons.<sup>82</sup>

### 1.10.5 Get-up/Trade dress

Get-up seems to be recognized only under passing off in Nigeria and it is majorly found in the Law of Tort. This includes copying the packaging of the plaintiff to be similar to that of the defendant in a manner that is likely to confuse the public. Therefore, it includes the general appearance, package, label, or design of the product.<sup>83</sup> Get-up is however not recognized under the NTMA and hence, there is no legislative protection for it. Hence, deceit would occur when a registered mark is imitated by an individual or company in relation to the goods or services which has acquired a distinctive reputation in the market and is known as belonging to a product by such individual or company only.<sup>84</sup> In *U.K. Tobacco Co. v. Carreras Ltd.*,<sup>85</sup> the defendants were marketing cigarettes called “Barrister”, and the packet showed a white man wearing a barrister’s wig and gown. It was similar to that of the plaintiff’s product which was called “Band Master” on which the packet of cigarettes also included a man in a band master’s uniform.

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<sup>79</sup> What is the difference between a Copyright and Trademark? Retrieved April 5, 2014 from [www.wisegeek.com/what-is-the-difference-between-a-copyright-trademark...](http://www.wisegeek.com/what-is-the-difference-between-a-copyright-trademark...)

<sup>80</sup> The differences between trademark, service mark. Retrieved August 30, 2014 from [www.vegastrademarkattorney.com/.../what-are-the-differences-between-trademark...](http://www.vegastrademarkattorney.com/.../what-are-the-differences-between-trademark...)

<sup>81</sup> World Intellectual Property Organization (WIPO) Handbook, Policy, Law and Use (2004) Geneva. Second Edition, WIPO Publication, No. 489(E). Retrieved October 7, 2013 from <http://www.wipo.int/about-ip/en/iprml>

<sup>82</sup> Oyewumi, A. 2015. *Nigerian Law of Intellectual Property*. University of Lagos Press and Bookshop Ltd., at p. 236. See the case of *Akesa (Nig.) Ltd. v. Union Bank of Nig. Ltd.* Unreported suit No. FHC/L/95/81

<sup>83</sup> Malemi, E. 2013. *Law of Tort*. Revised Edition. Princeton Publishing, at p. 638

<sup>84</sup> Mondaq T & A Legal. 2018. Nigeria: An appraisal of Passing off Actions under Nigerian Law. Retrieved October 16, 2018 from [www.mondaq.com>Nigeria>Trademark](http://www.mondaq.com>Nigeria>Trademark)

<sup>85</sup> (1931) 16 NLR 1. See also *De Facto Works Ltd. v. Odumotun Trading Co. Ltd.* (1959) LLR 33

The external packaging of a person's product in Nigeria is known as get-up and another name is for it is trade dress. Trade dress is what is used in the United States of America to describe product packaging. Trade dress refers to the visual appearance of a product that may include features such as size, shape, packaging, colour or combination of colours and this is considered the overall get-up of the product.<sup>86</sup> The law focuses on the idea that the source of a product can be identified by the product's brand name, slogan, etc. However, there are also situations where a product has such a distinctive design or packaging, that the design/packaging itself acts as a source indicator. This distinctive "look and feel" of the product is known as trade dress and this is protected under the same trademark laws applicable to a brand name or slogan. For example, the shape and design of the original glass Coca-Cola bottle is so well known and recognized that it has become protectable trade dress. Coca-Cola could therefore prevent other soda manufacturers from distributing their colas in a similar bottle on the basis that there would be a likelihood of confusion.<sup>87</sup> In ascertaining the likelihood of confusion, it is not to be assumed that the two similar products would be placed together but the information of the product which is left on the minds of the consumer will suffice.<sup>88</sup> However, if the identical marks are indeed placed together, the test will be adopting the features of the ear and the eyes to arrive at a conclusion on the consumer's capability to remember all that had been seen.<sup>89</sup>

The major difference between the protective nature of trade dress and other types of trademarks is that, to be protected, trade dress must have secondary meaning and cannot be distinctive inherently.<sup>90</sup> Where a consumer cannot easily identify and make an informed choice of the kinds of goods he desires, then, it can be said that a sign has not passed the 'distinctive' test. For example, the word "Apple device for phones or computers" is not capable of being registered for apple fruit that can be eaten but it is highly recognized that such goods are from a particular trade source and are distinctive in their own class.<sup>91</sup> When a mark is not distinctive inherently, it can only acquire distinctiveness through the development of secondary meaning. Secondary meaning shows that the mark has some meaning to the

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<sup>86</sup> Trade Dress Protection under Trademark Regime: An Analysis. Retrieved September 21, 2017 from <http://www.ficpi.org/news/trade-dress-protexion-under/>

<sup>87</sup> Ibid.

<sup>88</sup> The likelihood of Confusion. Retrieved April 5, 2014 from [www.quizlaw.com/trademarks/how\\_is\\_likelihood\\_of\\_confusion.php](http://www.quizlaw.com/trademarks/how_is_likelihood_of_confusion.php)

<sup>89</sup> See *British American Tobacco & Anor. V. Int'l Tobacco & 2 Ors* [2003-2007] 5 I.P.L.R. 285

<sup>90</sup> What is trade dress? Retrieved April 5, 2014 from [www.quizlaw.com/trademarks/what\\_is\\_trade\\_dress.php](http://www.quizlaw.com/trademarks/what_is_trade_dress.php)

<sup>91</sup> WIPO Handbook, op.cit

public beyond the obvious meaning of the terms or images of the mark itself. In other words, if the primary significance of the mark in the consuming public's mind has become the source of the goods or services, rather than the product itself, it has acquired secondary meaning.<sup>92</sup>

### **1.11. Structure of the Study**

To effectively answer the above questions, the thesis was structured into six chapters and is organised as follows:

Chapter One- Introduction- This chapter presents the thesis in perspective. It gives a background into the theme of the research work, which is on trademark protection. The statement of problem being addressed and the importance for trademarks to be protected. The regulatory framework of trademarks in Nigeria and that of the United Kingdom was discussed. The chapter also lays out the aim and objectives of the research, the research questions, the justification and the methodological approach as was adopted and utilised in the research.

Chapter Two addressed the relevant literature and conceptual framework of trademarks. The chapter draws from scholarly intellectual works of literature on the origins of trademark from the United Kingdom and the reception of trademarks from the United Kingdom into Nigeria. The socio-economic and political premise for the evolution of trademarks with special focus on the historical development of trademarks in Nigeria and how trademarks have existed long before the colonisation of Nigeria. The chapter also discusses the differences between passing off and trademarks in Nigeria and its comparison with the United Kingdom. It goes further to discuss the types of marks that can be registered and the types which are not capable of being registered.

Chapter Three discussed the theoretical framework and international instruments on trademarks. It discussed the theories underlying trade mark protection and the need to bear in mind such theories when protecting trademarks. The chapter further discussed international conventions and its importance to international trade.

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<sup>92</sup> What is secondary meaning? Retrieved April 5, 2014 from [www.quizlaw.com/trademarks/what\\_is\\_Secondary\\_meaning.php](http://www.quizlaw.com/trademarks/what_is_Secondary_meaning.php)



Chapter Four is devoted to the infringement of trademarks and its remedies. A detailed and comparative review of other categories of trademark infringement was discussed. This chapter discussed civil and criminal proceeding in relation to trademark infringement. The scope of the United Kingdom trademark infringement was brought to light as the frontier of infringement has been extended unlike Nigeria, where infringement has to do with the resemblance of similar marks.

Chapter five discussed the limitations of trademark protection in Nigeria. Therefore, the obsolescence of the NTMA 1965, the non-inclusion of service marks, non-recognition of packaging, administration of trade marks in Nigeria, the non-domestication of international conventions and trademark counterfeiting was discussed extensively. Unstructured interviews were conducted with randomly selected intellectual property practitioners and shop keepers.

The questions of the unstructured interviews with the interviewees are:

1. What are the major challenges of trademark protection and administration in Nigeria?
2. What does the concept of trademark entail to the common man in Nigeria?
3. Should the Trademark Act of 1965 be repealed?
4. How best can Nigeria protect its marks from the likelihood of deception?
5. The Trademarks Act does not recognize packaging and presentation of a trademark. What do you consider to be the implication of this situation?
6. Is Nigeria fulfilling her obligations under the international agreements to which she is a party?
7. Do you think Nigerian judges take into account best practices when deciding cases on trademark protection?
8. Do you think there is enough public awareness or education for the protection of trademarks in Nigeria?
9. At what level does the illiterate know of trademarks rights in Nigeria?

Chapter 6 is the summary, conclusion and recommendation respectively. It consists of specific recommendations/proposals for the reforms of the Nigerian laws on trademarks on the basis of its findings on issues of adequacy in terms of its content and scope. It is hopeful that the arguments in the thesis and the outlined recommendations would serve as a guide to the relevant stakeholders in the protection of trademarks in Nigeria for the benefit of the society at large.

## CHAPTER TWO

### LITERATURE REVIEW AND CONCEPTUAL FRAMEWORK

Trademarks has been analysed by different scholars and there have been a number of general studies on the economics of intellectual property rights. The existing literature on trademarks tilt toward the importance and the need for its protection in order to aid economic development. One of the underlying principles of trademark protection is to assure consumers that what they are about to purchase is the same as they have purchased earlier.<sup>93</sup>

#### 2.1. Literature Review

Lunney argued that trademark protection heightens marketplace efficiency which allows consumers to connect information to precise product[s] more accurately and helps to express more accurately their preferences and tastes for the varying mix of product features, quality, and prices each finds desirable.<sup>94</sup>

Landes and Posner view trademarks as enhancing economic growth and opined that the principal benefit of the protection of trademark is its ability to decrease consumer search costs and that the more appreciable a mark is, the greater the motivation on the part of the producer to increase the level of quality goods that are produced.<sup>95</sup> Trademark could also be generic and this would occur when a mark is so common that if it were to enter the everyday English language, it would become the most efficient way to describe the product, which would make the mark lose its legal protection.<sup>96</sup> The resultant effect is that the now generic name outweighs the mark owner's right to legal protection of the mark.<sup>97</sup> It is pertinent to note that a trademark<sup>98</sup> having property rights exists to protect the public from consumer fraud, lower consumer search costs and not to benefit only the owners directly.

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<sup>93</sup> Landes, W. and Posner, R. 2003. *The Economics Structure of Intellectual Property Law* (Cambridge, Mass. And London, England: The Belknap Press of Harvard University Press)

<sup>94</sup> Lunney, G.S. Jr. 1999. Trademark Monopolies, 48 *EMORY L.J.* 367, 417

<sup>95</sup> Landes, W. & Posner, R.A. 1987. Trademark Law: An Economic Perspective, 30 *Journal of Law & Economics.* 265, 268-70

<sup>96</sup> Carter, S.L. 1993. Does it Matter Whether Intellectual Property is Property? 68 *Chi-Kent. L. Rev.* 715, 722. Landes, W.M. & Posner, R.A., *ibid.*

<sup>97</sup> Landes, W.M. & Posner, R.A., *ibid.* at p. 265, 271-73

<sup>98</sup> *Ibid.* at p. 269

Carter<sup>99</sup> stated that where goods are not marked by a symbol or a logo, purchasers would not be able to ascertain the quality that the product represents. Moreover, the more valuable the mark, the greater the incentive for the producer to maintain the level of quality that creates the incentive and lowers the cost of search.<sup>100</sup>

Drescher<sup>101</sup> stated that trademarks serve as ways of identifying products through names or signs for the consuming public to appreciate and remember when buying such products.

Dreyfuss examined trademarks as being new and a recent development in that its status is not real but imagined even though it has always been in existence as far back as the early ages.<sup>102</sup>

Litman<sup>103</sup> examined trademarks in its mythical status and that it helps to provide consumers with an identity. For example, Coca-Cola is more than a product and has a reputation for quality; it is an image and a way of life which is instituted through the presentation, marketing, advertising, and packaging as well as the production of the products. Bently and Sherman opined that consumers have fore-knowledge in buying products affixed with a mark, and when purchasing a product bearing a mark, they buy an ‘experience envelope’ so that the next time, they want to buy the same goods, it would be easy to identify amidst all other goods offered up for sale.<sup>104</sup>

Maskus<sup>105</sup> further stated that the rationale behind trademarks is to protect rights to use a particular distinctive mark or name to identify a product, service or company as such marks are of material value in distributing goods and services.

Hernandez<sup>106</sup> opined that trademarks should integrate considerations of trade dress which would include layout, décor and features which are obviously characteristic with the product.

Economides<sup>107</sup> stated that the purpose of trademark law is that it is largely economic and market-oriented which has played an important role in industrialization and commerce.

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<sup>99</sup> Carter, S.L. 1990. The Trouble with Trademarks. Faculty Scholarship Series. Paper 2242. Retrieved January 14, 2014 from [http://digitalcommons.law.yale.edu/fss\\_papers/2242](http://digitalcommons.law.yale.edu/fss_papers/2242)

<sup>100</sup> Ibid. at p. 265, 268-70

<sup>101</sup> Drescher, T. 1992. The Transformation and Evolution of Trademarks- From Signals to Symbols to Myth. 82 *Trademark Rep.* 301

<sup>102</sup> Dreyfuss, R. 1990. Expressive Genericity: Trademarks as Language in the Pepsi Generation. 65 *Notre Dam L.rev* 397-424

<sup>103</sup> Litman, J. 1999. Breakfast with Batman: The Public Interest in the Advertising Age. 108 *Yale LJ.* 1717

<sup>104</sup> Bently, L. and Sherman, B. 2014. *Intellectual Property.* 4<sup>th</sup> Edition. Oxford University Press, 810

<sup>105</sup> Maskus, K.E. 2000. *Intellectual Property Rights in the Global Economy.* Institute for International Economics, Washington D.C.

<sup>106</sup> Hernandez, R. 2004. Businesses depend on Trade Mark Laws for Protection. *The Business Journal*, p. 21

Barnes<sup>108</sup> stated that consumers benefit because they can rely on familiar marks to locate satisfactory goods and services and that trademarks have the characteristic of public goods.

Consumers play a major part in differentiating and making choices between goods available for sale as this motivates owners of trademark in maintaining and thereby, improving the quality of the goods offered up for sale which would, meet the high expectation of consumers. Thus, manufacturers are rewarded because of the consistent quality goods that are produced and this aids economic growth and creates wealth for the owner.<sup>109</sup>

Groves<sup>110</sup> stated that in identifying where the product originated from, it goes far beyond knowing only the owner and the source of the good on which it is used but that where it is able to distinguish the undertakings of one person from those of other undertakings, then, it can be said to have served the function of trade mark. With the advent of trade between countries and border margins, there is the need for the owner of a mark to protect his goods because when this is not done, consumers will be baffled as to where the product originated from. Therefore, the role of trademark is to ascertain a product as suitable to be purchased by the society.<sup>111</sup>

Lemley<sup>112</sup> opined that trademark should be attributed to property which has intrinsic value of its own and serves as a form of identification. It was further stated that the final element if a mark is famous, is that its owner can license its use to others without conveying its goodwill and other assets.<sup>113</sup> An example is where sports fans wear shirts with their team logos. The team in question does not make shirts or any other products bearing the team logos but instead, the team licensed the use of the mark to a clothes manufacturer who is not affiliated with the team.<sup>114</sup>

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<sup>107</sup> Economides, N. S. 1988. The Economics of Trademarks, 78 *Trademark Rep.* 523

<sup>108</sup> Barnes, D.W. 2006. A New Economics of Trademarks. North Western Journal of Technology and Intellectual Property. Prop.22. Retrieved March 22, 2015 from <http://schorlycommons.law.northwestern.edu/njtip/vol5/iss/1/2>

<sup>109</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. 2004. Geneva. 2<sup>nd</sup> Edition. WIPO Publication. No. 489 (E). Retrieved October 7, 2013 from <http://www.wipo.int/about-ip/en/iprml>

<sup>110</sup> Groves, P.J. 1997. *Intellectual Property Law*. (London: Cavendish Publishing Limited), 512-513. Adewopo, A.A. & Oguamanam, C. 1999. The Nigerian Trademark Regime and the Challenges of Economic Development. *International Journal Review of Industrial Property and Copyright Law*. Volume 30, Issue II, 632-653

<sup>111</sup> Groves, P.J., *ibid.*, at p. 515

<sup>112</sup> Lemley, M.A. 1999. The Modern Lanham Act and the Death of Common Sense, 108 Yale L.J. 1687, 1688

<sup>113</sup> Lemley, M.A., *ibid.* at 1687, 1688

<sup>114</sup> Moss, M. 2005. Trademark “Coexistence” Agreements: Legitimate Contracts or Tools of Consumer Deception 18 Loy. Consumer L. Rev. 197. Retrieved March 21, 2015 from <http://lawcommons.luc.edu/lclr/vol18/iss2/4>

Cohen opined that trademarks should be regarded as property rights and be accorded due legal protection as large companies such as Microsoft, Coca-Cola, would invest large sums of money into strengthening and promoting their marks.<sup>115</sup> Furthermore, by granting ownership rights over trademarks, it encourages investment in product quality and prevents consumer deception.

Moss<sup>116</sup> argued that trademarks are not property and that trademark protection exists to benefit the public despite the fact that owners reap considerable profits from using them. He further argued that the following arguments support the case on why trademarks should not be labelled as property. These arguments are that:

1. Trademarks return to the public domain if not used;
2. Trademark owners may not license a trademark without the accompanying product;
3. Trademark protection applies only if the mark is attached to the product;
4. If a mark becomes generic, it falls into the public domain;
5. There is no incentive to create more trademarks;
6. Trademarks do not always belong to the first user; and
7. Entering into coexistence agreements may diminish the distinctiveness of a mark and allow third parties to use similar marks.<sup>117</sup>

However, it is opined by the researcher, that trademarks should be viewed as property and exist to protect consumers from harm. Hence, Moss's argument that trademarks should not be seen as property is not viable as the owner of the trademark would have put in creativity in producing the mark.

To reiterate this, Uloko<sup>118</sup> stated that trademark is a valuable property and the owner of the trademark should be alert in taking legal action against an interloper who uses the trademark without the consent of the owner.

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<sup>115</sup> Cohen, F.S. 1935. Transcendental Nonsense and the Functional Approach, 35 Colum. L. Rev. 809, 815

<sup>116</sup> Moss, M. *ibid.*

<sup>117</sup> Moss, M. *ibid.*

<sup>118</sup> Uloko, G. 2010. *Modern Approach to Intellectual Property Laws in Nigeria*. Princeton Publishing, 66

Carter provided that the protection of trademark applies only if the mark is attached to a product. In other words, a company that invents a beautiful mark will not receive legal protection for it unless the mark identifies some product or service. If a trademark is not utilised within a specific time, it is said to be abandoned whereby it returns to the public domain and others may begin using it but it will still be protected under trademark laws.<sup>119</sup>

McCarthy stated that the entire purpose behind trademark protection is to allow consumers to identify the source of a product by recognizing the mark affixed on the product. Where a mark exists independently from a product, it does not serve to protect the public from product confusion.<sup>120</sup> That is, the product and the goods must go together and must therefore co-exist.

Babafemi<sup>121</sup> examined trademarks as being distinctive and that it must be protected in order to enjoy legal protection.

Llewelyn et.al<sup>122</sup> stated that even though, trademarks are competitive and there are different goods on sale for the populace, the owner has the upper hand to use his mark to distinguish their products from other enterprises.

Shyllon<sup>123</sup> referred to trademarks as being brand names which are used by the producer to categorize their products and that any word or symbol can be used by a manufacturer to distinguish his or her products. Sodipo<sup>124</sup> stated that trademarks are regarded as symbols of identity which is able to identify goods or services from those produced by other persons or enterprise for business endeavours.

Adewopo<sup>125</sup> opined that trademark has the most immediate and popular market appeal due to the visibility by which products are easily identified and marketed and that trademarks owes much of its value and importance to the dynamics of the marketplace which places

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<sup>119</sup> Carter, S.L. 1993. Does it Matter Whether Intellectual Property is Property? *68 Chi-Kent. L. Rev.* at p. 720

<sup>120</sup> McCarthy, J.T. op.cit. at 2, 18:25

<sup>121</sup> Babafemi, F.O. 2006. *Intellectual Property: The Law and Practice of Copyright, Trade Marks, Patents and Industrial Designs in Nigeria*, at p. 177

<sup>122</sup> Cornish, W.R. and Llewelyn, D. 2007. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (6th Edition) Sweet & Maxwell, London at p. 603

<sup>123</sup> Shyllon, F. 2003. *Intellectual Property Law in Nigeria. Studies in Industrial Property and Copyright Law*. Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich. Volume 21 at p. 183

<sup>124</sup> Sodipo, B. 1997. Piracy and Counterfeiting: GATT, TRIPS and Developing Countries, 40. Retrieved October 14, 2014 from <https://searchworks.stanford.edu/view/3502650>

<sup>125</sup> Adewopo, A. 2015. *Intellectual Property Rights in Nigeria*. Nigerian Institute of Advanced Legal Studies at p. 22

exceptional recognition of the products and services and how they are presented to consumers.

Millot<sup>126</sup> opined that trademarks constitute one of the most important assets of firms and it enables consumers to differentiate between competitive products and possibly to develop loyalty towards one preferred trademark.

Oyewunmi,<sup>127</sup> stated that a function of trademark is the ability to differentiate between the goods or services of one proprietor from those of all other goods in the course of trade. Trademarks has been further stated to serve as useful tools of identification and been able to distinguish between varieties of products in the market place.

Armand<sup>128</sup> stated that when goods have been trademarked, it carries with it a warranty that the consumer is able to differentiate from the products of a known manufacturer from that of another manufacturer.

Schechter<sup>129</sup> opined that trademark owners should be protected and that consumers should also be protected as the signs or symbols affixed to goods serves as a promise of a certain quality. It can be deduced that Schechter believed that both the trademark owner and the consumer had a great impact on the macro-economy as the mark sells the goods. The advantage being that the commercial regulation of trademarks maximizes goods through the encouragement of quality products whilst at the same time, decreasing consumer search costs and reinvigorates the economic sector.<sup>130</sup>

Considerable research carried out by foreign-based authors indicate that a trademark carries with it an identification mode which is used in the purchase of goods and/or services. Local-based authors discuss trademark in relation to goods alone. The literature on trademark in Nigeria has not been comparatively analysed nor has there been an intensive comparative study of trademark law which is the focus of the current research. In achieving this, the study will discuss the challenges facing trademark protection law in Nigeria, the adequacy of the

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<sup>126</sup> Millot, V. 2009. Trademarks as an Indicator of Product and Marketing Innovations. Retrieved November 17, 2016 from <http://www.oecd.org/sti/working-papers>

<sup>127</sup> Oyewunmi, A.O. 2015. *Nigerian Law of Intellectual Property*. University of Lagos Press and Bookshop Ltd., 231

<sup>128</sup> Armand, R. and Norman, H. 1994. *Blackstone's Guide to the Trademarks Act*. London: Blackstone Press Ltd., 15

<sup>129</sup> Schechter, F.L. 1927. Rational Basis of Trademark Protection, 40 *Harv. L. Rev.* 813. Schechter is regarded as the fore-father of trademark laws

<sup>130</sup> Schechter, F.L., op.cit. at p. 819

current law and whether it measures against global best practices and prescribed international standards. It is the opinion of the researcher that trademarks has gone far beyond the identification of products as the modern trend is e-commerce and the incidents of the internet has made trademarks even more important. Hence, trademarks should be seen as property which should be adequately protected against interlopers or infringers. The thesis will be of immense benefit to Nigerian stakeholders who are at the helm of economic affairs, the academia, policy makers and the legislature, and will further be a significant contribution to comparative legal studies.

## 2.2. Conceptual framework of trademarks

Industrial property and copyright are the two categories of intellectual property.<sup>131</sup> Examples of industrial property are patents, registered designs and trademarks as they relate with industry and commerce.<sup>132</sup>

A trademark is a word, phrase, symbol or other indicator that identifies the source or sponsorship of goods or services.<sup>133</sup> If an individual, business, or other organization uses a trademark to sell or promote its goods or services, such an individual would have the right to exclude other people in profiting from the reputational value and when it is not curbed, it would harm the business of the original trademark owner.<sup>134</sup> For instance, owners of famous trademarks like “Windows” or “Google” have the right to intercept infringers from using their business logo which is similar in the course of trade.<sup>135</sup> Trademarks are very fundamental to the promotion of trade and economic development especially in countries where trademark laws are regularly updated to reflect modern trends in products or services identification.<sup>136</sup>

Trademark cannot be ignored or set aside as it relates to the origin of the product and the ability of consumers to be able to distinguish one good from the other whilst at the same time,

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<sup>131</sup> WIPO Handbook, op.cit. Retrieved October 7, 2013 from <http://www.wipo.int/about-ip/en/iprml>

<sup>132</sup> Groves, P. J. 1997. *Source Book on Intellectual Property Law*. Carvendish Publishing, London, at p. 3

<sup>133</sup> Shyllon, F., op.cit., 184

<sup>134</sup> Ibid. at p. 184

<sup>135</sup> Ibid., at p.184-185

<sup>136</sup> Olugbenga, O.A. and Suliyat, O.O. 2014-2015. The Trademark Acts of Nigeria and the United Kingdom: A Comparative Examination. *NIALS Journal of Intellectual Property [NJIP]*, at.63



guaranteeing quality and a strong instrument of advertisement.<sup>137</sup> The owners of trademark create goods which are distinctive in their own class through designs or trade dress on which the mark is attached.<sup>138</sup> A mark is distinctive<sup>139</sup> when goods put together are able to be distinguished from products that have no connection whatsoever with the product of the original trademark owner. In resolving if a trade mark can be distinguished from all other goods, the Registrar must be able to note the degree to which the mark is characteristically unique and also, whether the trade mark use is indeed capable of being distinguished, especially if two similar goods are placed together. The criteria for a mark to be registrable is under Parts A and B of the trade mark register to which access is easily obtained.<sup>140</sup>

Where a mark is devoid of any distinctive feature, it will not be registrable under Part A or Part B of the Register and so, such trademarks are not capable of being distinguished from one person's goods or services to that of another's products.<sup>141</sup> Therefore, a mark can only be registered in Nigeria under Parts A or B of the NTMA,<sup>142</sup> if it contains the particulars of the organisation such as business name of the company, the individual and the firm representing the company in any specified manner;<sup>143</sup> the signature of the applicant or a representative on the issued document; a document with the prospective invented word or words;<sup>144</sup> the inventive word or words must have no direct reference to any character or to a geographical name or surname;<sup>145</sup> and it can be any other distinctive mark or mark which can be registered.<sup>146</sup>

The common feature with the above indicates that a mark must be distinctive, on which trademark law is centered on. For instance, in relation to the fourth point, it is recognized in practically all countries that geographical indications cannot be registered as trademarks. Geographical indications include names of states, provinces and other sub-divisions of states, towns and villages, rivers, mountains, etc.<sup>147</sup> Geographical indication of origin can also be

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<sup>137</sup> Cornish, W. and Llewelyn, D. 2007. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*. (6<sup>th</sup> Edition) Sweet & Maxwell, London at p. 603

<sup>138</sup> Ibid. at p. 687

<sup>139</sup> Section 2, NTMA, Cap. T13, Laws of the Federation 2004

<sup>140</sup> Ibid.

<sup>141</sup> Verkey, E. 2015. *Intellectual Property*. Eastern Book Company, at p. 156

<sup>142</sup> Sections 9 and 10, NTMA, *ibid.*

<sup>143</sup> Ibid.

<sup>144</sup> *Aristoc Ltd. v. Rysta Ltd.* (1945) A.C. 68. An invented word will not be eligible for registration unless it is used in connection of trade. Verkey, E. 2015, *ibid.* at p. 157

<sup>145</sup> *Bubble-Up International Limited v. Seven-Up Company Ltd.* (1971) U.I.L.R. 154

<sup>146</sup> Section 9 (1), NTMA, *ibid.*

<sup>147</sup> Examples of such geographical indications include Olumo Rock in Ogun State, Aso Rock in Niger State

known as geographical designations. It identifies 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.<sup>148</sup> There is also no legislative provision under the NTMA.

An essential feature of a trademark therefore, is that it must be distinctive before it can be registered but it must always be when dealing with such goods in the course of trade.<sup>149</sup> Trademarks can only be advertised through goods and services and not otherwise and hence, the reasons for updating trademark protection laws.<sup>150</sup> Trademarks are the brand names used by the manufacturers to identify their products. The general concept is that a trade mark is not descriptive of the product but it is associated with its manufacturers.<sup>151</sup> A trade mark can also be registered if it is exceptional, in that it is different and is capable of being distinguished in the course of trade, from the goods or services of individuals who are not members of such association but the application must be registrable and shall be in the prescribed manner, which must be so specifically stated. Hence, where a mark is said to be distinctive, it must not be the same but it must be characteristically different from that which is already on the register.<sup>152</sup>

### **2.3. Rationale for protecting Trademarks**

A trademark is protected not only to avoid consumer confusion, but also to provide firms with an adequate return on investments made to create and maintain strong brands.<sup>153</sup> In *Dyktrade Ltd. v. Omnia Nig. Ltd.*,<sup>154</sup> it was held that when a mark has been registered, it entitles the owner to use the trademark exclusively and also, would have a right to sue for passing off when the defendant uses such goods that are inconsistent with that of the plaintiff.

The primary purpose of the trademark laws is to prevent unfair competition by applying a test of consumer confusion and providing rights and remedies to the owner of the trademark. The

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<sup>148</sup> Article 22(1) TRIPs 1994

<sup>149</sup> Section 9 (2), NTMA, Cap. T13, Laws of the Federation 2004

<sup>150</sup> Olugbenga, O.A., et al., op.cit at p. 64

<sup>151</sup> Shyllon, F. at p. 183

<sup>152</sup> Verkey, E., op.cit at p. 154

<sup>153</sup> Bottero, N., Mangani, A. and Ricolfi, M. 2007. The Extended Protection of "Strong" Trademarks. *II Intellectual Property L. Rev.* 265. Retrieved March 31, 2015 from <http://scholarship.law.marquette.edu/jplr/vol11/iss2/1>

<sup>154</sup> [1997-2003] 4, I.P.L.R. p.266, 267

test for consumer confusion is to ensure that the consumer is confident when buying a product or service bearing a particular trademark and the product or service is delivered.<sup>155</sup> The consumer relies on a standard of quality established by the association of the trademark in the marketplace with the owners' product or service.<sup>156</sup>

The rationale for the protection of trademarks is that the owner has spent time and money in presenting a service or product to the consumer, the owner then should be able to protect this investment by being allowed to prevent others from using the trademark and profiting from the owner's investment. Therefore, the value of the trademark is determined by the strength, or goodwill, of the association between the trademark and its source, and it is the consumer who determines this value.<sup>157</sup> Trademarks are unusual because the reputation of a product can reach a remote foreign market long before the owner of the mark for the product has begun or even had any opportunity to actually market in the foreign land.<sup>158</sup> This usually arises as a result of parallel imports and this is usually known as gray market goods. They are branded goods that are imported into a market and sold there without the consent of the owner of trademark in that particular market.<sup>159</sup> The disadvantage of this is that owners and manufacturers do not have proper control over what the parallel importer does with the brand and product.<sup>160</sup> Hence, the need and reason for ensuring that trademarks are adequately protected.

In relation to trademarks, there are three separate and distinct interests which are protected by trademarks.<sup>161</sup> Firstly, trademarks become a guarantee of a particular standard of quality which would enable consumers to identify the product of a specific manufacturer or distributor.<sup>162</sup> Secondly, protection of trademarks safeguards the trademark owner and it

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<sup>155</sup> IOWA State University. Trademark Licensing Office. Trademark Legal Basics. Retrieved July 22, 2016 from [www.trademark.iastate.edu/basic](http://www.trademark.iastate.edu/basic)

<sup>156</sup> Ibid.

<sup>157</sup> Ibid.

<sup>158</sup> Scheter, R.E. 1997. The Case for Limited Extraterritorial Reach of the Lanhan Act, *37 Va J. Int'l.* 619, 628

<sup>159</sup> International Trademark Association (INTA). Parallel Imports/Gray Market. Retrieved October 16, 2018 from [www.inta.org/advocacy/pages/Paral...](http://www.inta.org/advocacy/pages/Paral...)

<sup>160</sup> KISCH IP. 2017. Is parallel importation lawful in South Africa? Retrieved October 16, 2018 from [www.kisch-ip.co.za/parallel-importation...](http://www.kisch-ip.co.za/parallel-importation...)

<sup>161</sup> Krumholtz, J.E. 1986. The United States Customs Services Approach to the Gray Market: Does it infringe on the purposes of Trade Mark Protection. *Journal of Comparative Business and Capital Market Law.* Vol. 8, 101-121. North-Holland

<sup>162</sup> Ibid.

represents the goodwill generated by the trademark owner.<sup>163</sup> The effect of this protection is that it protects the mark holder (that is, the owner of a trademark) from the sale of another's product as the holder's own (that is, another person passing off the products of the trademark owner).

In every jurisdiction worldwide, there are two required standard procedures which must be followed before a trademark can be registered.<sup>164</sup> The first requirement is the ability of the trademark to distinguish one product from the other, that is, it must be distinctive.<sup>165</sup> Secondly, is that there is the possibility that a trade mark may be harmful if its character is misleading or if there is a violation of public order or morality.<sup>166</sup> This therefore, becomes an intangible asset entitling the trademark to legal protection from acts that injure its value.<sup>167</sup> Thirdly and finally, trademark protection promotes free competition identification and demand creation.<sup>168</sup> This awareness enables purchasers to distinguish between the goods of competing producers and to be able to make an informed choice based on the differences in quality between competitively produced or marketed articles.<sup>169</sup> Such consumer awareness encourages producers and distributors to develop better products in order to maintain their position in a highly competitive market economy. Trademarks thereby, are ways to attract the public and consumers to choose and to be able to distinguish different goods and services in marketing arenas. The economic value of trademarks in attracting customers requires that firms manage and protect them comparably to other assets.<sup>170</sup>

Another way to view trademark is under industrial property rights. Industrial property rights could be compared with ownership rights. A feature similar to both ownership rights and industrial property rights is that they are exclusive rights that preclude third parties from using an intangible object without permission.<sup>171</sup>

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<sup>163</sup> See McCarthy, J. 1984. Trademarks and Unfair Competition. 4<sup>th</sup> Edition. 2:7-8

<sup>164</sup> Shyllon, F., op.cit. at p. 187

<sup>165</sup> Ibid. at p. 187

<sup>166</sup> Ibid. at p. 187

<sup>167</sup> Bell & Howell, 548 F. Supp. At 1069

<sup>168</sup> Handler, M. 1958. Trademarks-Assets or Liabilities? *48 Trade-Mark Rep.* 661, 676

<sup>169</sup> Handler, M., op.cit. at p. 576

<sup>170</sup> Landes, W.M. and Posner, R.A., op.cit. at p. 265, 274-75

<sup>171</sup> Kaplow, L. and Shavell, S. 1996. Property Rules Versus Liability Rules: An economic Analysis, *109 HARV. L. REV.* 713, 716. See also Lehman, M. 1985. The Theory of Property Rights and the Protection of Intellectual and Industrial Property, *16 International Rev. Indus. Prop. & Copyright L.* 525, 526-27

A trademark is an intangible asset that represents the investments made in the building of a brand. When a business is sold for example, or companies merge, the question of brand evaluation becomes an important issue.<sup>172</sup> It provides business people with a remedy against unfair practices of competitors, which aim at causing confusion in consumers' minds by leading them to believe that they are acquiring such goods or services of the legitimate owner of the trademark, whereas they are in fact acquiring an imitated product, which may be of lesser quality. The legitimate owner may thereby suffer from loss of potential customers, as well as harm to his own reputation.<sup>173</sup>

Trademark law as with all aspects of law has economic underpinnings. It has been noted by the law and economics expert that there are several economic issues embedded in trademark protection.<sup>174</sup> Firstly, it has been observed by Posner that once consumers become familiar with the products of various manufacturers, they begin to associate the trademark with the quality of the product.<sup>175</sup> The consumer would therefore spend considerable time and money if trademark protection did not exist. Therefore, trademark protection reduces significantly consumer search costs since consumers do not have to spend time investigating the attributes of a particular brand because the trademark is a shorthand way of signifying the consistency of quality.<sup>176</sup> Secondly, there is the incentive for manufacturers to improve the quality of their products which has served as indicators of source for hundreds of years for consumers.<sup>177</sup> A trade mark can be viewed as a signature whereby this undertaking accepts commercial responsibility for the marked products and even as a guarantee to consumers concerning their overall quality.<sup>178</sup> A trade mark does not give consumers a legal guarantee about the quality or any other characteristic of the marked products apart from their trade origin. It merely signifies the likelihood that marked products will be and remain consistent with each other and should match consumers' expectations based on this likelihood. This likelihood is only guaranteed by the strength of the owner's commercial interest in ensuring that these expectations are at least met if not exceeded.<sup>179</sup>

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<sup>172</sup> Ibid.

<sup>173</sup> Ibid.

<sup>174</sup> Landes, W.M. and Posner, R.A., op.cit. 269

<sup>175</sup> Ibid.

<sup>176</sup> Ibid.

<sup>177</sup> See Trademark Act of 1946 § 45, 15 U.S.C. § 1127 (1997) [hereinafter Lanham Act]

<sup>178</sup> (2009) ETMR 987 at [58]

<sup>179</sup> Griffiths, A. 2011. *An Economic Perspective on Trade Mark Law*. New Horizons in Intellectual Property. Edward Elgar Publishing: Cheltenham

Trademarks have become even more fundamental in the various commercial lives due to the basic changes taking place in the intensely competitive international markets in consumer goods.<sup>180</sup> The primary reasons why trademark exists is majorly to enhance decisions of consumers in choosing appropriate goods known to them and to motivate manufacturers to produce quality goods which should be known by consumers before they buy anything.<sup>181</sup>

In the standard literature of law and economics, trademark law is presented as an incentive for business enterprises to invest in the quality of the goods and services with which marks are used and as a remedy to specific market failures.<sup>182</sup> Thus, it is argued that if it were impossible for consumers and for the public-at-large to identify the source of goods, then every business would have an incentive to supply goods at a quality lower than the average prevailing in the industry because the profits generated by the individual transaction would, in fact, be garnered by the individual business entering into it, while the reputational costs derived from the public's disappointment with the quality of goods would be externalized to the entire industry.<sup>183</sup>

#### **2.4. Overview of the evolution of trademarks**

Historically, the origin of trademark dates as far back as four thousand years ago when craftsmen from China, India and Persia used either their signatures or symbols to identify their products.<sup>184</sup> Roman pottery-makers used more than a hundred different marks to distinguish their work, the most famous being the Fortis mark, which was imitated by many on counterfeit goods.<sup>185</sup> These craftsmen are believed to have used marks for several purposes, including as an advertisement for the makers of the products, as proof that the products belonged to a particular merchant in the event of an ownership dispute, and as a guarantee of quality.<sup>186</sup> Merchants therefore, used marks to demonstrate ownership of

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<sup>180</sup> Leaffer, M.A. 1998. The New World of International Trademark Law. Retrieved March 15, 2015 from <http://scholarship.law.marquette.edu/iplr/vol2/iss1/1>

<sup>181</sup> Economides, N.S. 1998. "Trademarks" in Newman (ed.) The New Palgrave Dictionary of Economics and the Law (Peter Newman ed.) Retrieved September 13, 2013 from <https://papers.ssrn.com/Sol3/papers.cfm?abstract=61148>

<sup>182</sup> Landes, W.L. and Posner, R.A. 2003. The Economic Structure of Intellectual Property Law 167-68

<sup>183</sup> Landes, W.L. and Posner, R.A. 1987. Trademark Law: An Economic Perspective, 30 *Journal of Law & Economics*. 265, 266-68

<sup>184</sup> Idris K. 2003. Intellectual Property: A Power Tool for Economic Growth. WIPO Publication, Issue 88

<sup>185</sup> Harris, W.V. 1980. Roman Terracotta Lamps: The Organization of an Industry. The *Journal of Roman Studies*, Vol. 70, pp. 126-145. Retrieved July 28, 2014 from <http://www.jstor.org/stable/299559>

<sup>186</sup> Idris, K, ibid at pg. 150

physical goods, much in the way that ranchers use cattle brands to identify their cattle.<sup>187</sup> The essence of using marks is to indicate ownership of goods which were important for owners of trademark whose goods moved in transit, as those marks often allowed owners to claim goods that were lost in transit.<sup>188</sup> At that time, goods were marked before shipping, so that if there was a shipwreck, any surviving merchandise could be identified and retrieved.<sup>189</sup> The identification of goods also extended to animals and thereby, the owners of livestock such as cattle, used red-hot iron which was uniquely shaped and this left a clear inscription on the skin of the animals.<sup>190</sup>

#### 2.4.1. The evolution of trademarks in England

In England on the other hand, marks have been used to identify the source of goods since about the sixteenth century and have since sought for protection of trademarks. It surfaced, centuries ago, as a guardian of traders known as the “guild” used “marks,” or symbols, to indicate the source of their wares and who wished to prevent competitors from using the same mark to deceive customers into buying the wrong product. Over time, trademark law grew to accommodate changes in the nature of commerce and the norms of marketing and advertising. The law now protects a broad array of devices—including shapes, colors, sounds, and smells—against use not only by competitors but also by sellers of even peripherally related products.<sup>191</sup> However, because there was no specific law for the protection of trade mark at that time, there were certain persons referred to as the ‘guild’, who ensured that any goods produced were of excellent quality and was beneficial to the society. Hence, the quality of goods expected from the ‘guild’ gave the citizenry a slight assurance of the products sold in the market area.<sup>192</sup>

The first reported case squarely involving the protection of trademarks by an English common law court was the case of *Sykes v. Sykes*.<sup>193</sup> During that era, there were demands for

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<sup>187</sup> Schechter, F.J. 1925. The Historical Foundations of the Law Relating to Trade-Marks

<sup>188</sup> McKenna, M.P. 2007. The Normative Foundations of Trade Mark Law. *Notre Dame Law Review*. Vol. 82:5

<sup>189</sup> Mollerup, P. 1997. *Marks of Excellence: The History and Taxonomy of Trademarks*. Phaidon Press Inc., United Kingdom

<sup>190</sup> Ryder, R.T. 1974. The History and Development of Trademark Law. Retrieved September 10, 2013 from <http://www.iip.or.jp/e/e/.../ono/ch2.pdf> at p.1

<sup>191</sup> Lemley, M.A. *Grounding Trademark Law through Trademark Use*. Stanford Law School Research Paper No. 961470 Stanford Public Law and Legal Theory Working Paper Series. Retrieved December 15, 2013 from <http://ssrn.com/abstract=961470>

<sup>192</sup> Mollerup, P. 1997. *Marks of Excellence: The History and Taxonomy of Trademarks*. Phaidon Press Inc., United Kingdom

<sup>193</sup> (1824) K.B. 107 Eng. Rep. 834

legal protection against the rampant imitation of marks by third parties. The courts of equity took the lead because plaintiffs wanted injunctions as it was felt that this would solve the means of a trader claiming what did not belong to him. The courts intervened when one trader represented to the public that he was selling the goods and carrying on the business of another as if it were his own.

There was an increase of public agitation in 1850 about the extent to which food, drugs and other commodities were sold in an adulterated state. This was mixed with the complaints of established competitors that they were being undercut by such practices; by cheap imports that did not declare what they were and by the false imitation of brands, marks and names.<sup>194</sup> There were important commercial interests that wanted Britain to adopt a system of registering trademarks modeled after the French Law of 1857.<sup>195</sup> Their concerns were however, domestic. During that era, the test for infringement was not easy as the owner had to prove his title by establishing goodwill and that the goods were in circulation and well-known by consumers. To succeed, the owner had to show reputational value in the goods offered for sale. Litigation was therefore expensive and there was uncertainty as to the outcome of legal proceedings.<sup>196</sup> A problem in that century was that there was no register for trademarks and hence, the passing off action. The passing-off action, though useful, depended on proving in each case that the plaintiff had a trade reputation with the public. However, if there was a register, the issue could be reduced to the question: was the defendant imitating the mark in a manner liable to deceive? With the advent of trade across different country borders, international trade caused the demand for trademarks registration to rise. Prussian and American counterfeiters were said to be passing off their own “Manchester” textiles and “Sheffield” cutlery in various parts of the world. The hope of stopping foreign imitations of British marks seemed to lie in also establishing a register. Mutual protection of foreigners’ marks in Britain could then be offered as a *quid pro quo*, that is, giving something for the other.<sup>197</sup> Hence, there was clamour for change in the trademark system in Britain.

The Merchandise Marks Act was enacted in 1862 to provide legal protection for criminal acts in relation to trademarks and it continued in force but the problem with the Act was that it

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<sup>194</sup> Cornish, W.R. and Llewelyn, D. 2007. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (6<sup>th</sup> Edition) Sweet & Maxwell, London, at p. 607

<sup>195</sup> See *Beier* (1975) 6 I.I.C. 285 at 294-298

<sup>196</sup> Bainbridge, D. I. 2012. *Intellectual Property* (9<sup>th</sup> Edition) Pearson Education Limited, England, at p. 690

<sup>197</sup> Cornish, W.R. and Llewelyn, D. 2007. *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (6<sup>th</sup> Edition) Sweet & Maxwell, London at p. 608



was unenforceable and patchy.<sup>198</sup> It was later revised in 1887 and this continued in force till 1968 when the Trade Description Act was endorsed but the overall view at that time, was its inconsistent provisions which made it quite unpopular.

However, in order to make trademark law safer, the Trade Marks Act was enacted in 1875 and later amended in 1876 and 1877, which was incorporated into the Patents, Designs and Trade Marks Act of 1883. A trademark register was finally incorporated in the 1875 Act and this was successful judging from the registration of marks in that era.<sup>199</sup>

After the enactment of the Trade Marks Registration Act of 1875, and in order to ensure that trade mark law is adequately protected, other legislative bodies came into being such as the Trade Marks Act of 1905, and 1919 respectively. The trade mark laws in Britain kept on amending their laws over and over again as new types of marks to be registered cropped up. So, there was the need for the previous statutes to be continuously reviewed. After the 1919 Act, the Trade Marks (Amendment) Act, 1937 was also established. Thereafter, the UKTMA 1938 was enacted but what happened was that the 1905, 1919 and 1937 statutes were combined together so that there will not be different trade mark laws at the same time. The challenges with the 1938 Act was that the drafting was extremely difficult and it attracted judicial criticism on a number of occasions which did not make its provisions easily adapted. The problem was further compounded because of its peculiar reference to previous statutes and it was also, considered the worst drafted legislation in the history of Britain.<sup>200</sup> The 1938 Act was reviewed to cater for the evolving trends of trade mark and this was later enacted into the UKTMA 1994, which was validated on October 31, 1994. The newly enacted law brought about a well-needed change to the trade mark system in Britain, and europeanised the trade mark law in the U.K., giving effect to a Harmonization Directive (1989) and Regulation (1994), establishing a community-wide trade mark system.<sup>201</sup> The UKTMA 1994 according to Bainbridge, brought a welcome change which had been long over-due to the trade mark system as the UKTMA 1938 was labelled as cumbersome and difficult to apply<sup>202</sup>. Hence, the interests of traders was secured when launching a new product.

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<sup>198</sup> *Holmes v. Pipers* [1914] 1 K.B. 57; *Coke v. Pipers*, referred to in *Vine Products v. Mackenzie* [1969] R. P.C. 1 at 18-19

<sup>199</sup> Bainbridge, D. I., op.cit. at p. 690

<sup>200</sup> Ibid. at pp. 690-693

<sup>201</sup> Shyllon, F., op.cit. at page 191

<sup>202</sup> Bainbridge, D.I., ibid., at p. 692

The Protocol to the Madrid Agreement,<sup>203</sup> is a global system which protects owners of trademark to obtain protection in several countries by a single application of which UK is a member.<sup>204</sup> The Madrid system for the International Registration of Marks is governed by the Madrid Agreement, which was enacted in 1891 and also, the Protocol relating to that Agreement in 1989. The advantage of the system is that it is possible to protect a mark in many countries by obtaining an international registration that has effect in each of the designated contracting parties.<sup>205</sup> It is also a member country to the Paris Convention, which is the oldest to have ever existed.<sup>206</sup> It is simply a centralized filing mechanism, a one –stop approach to obtain wide trademark protection in export country markets.<sup>207</sup> This agreement allows an applicant who has registered a mark in his home or business country to deposit an international registration with the Bureau of the WIPO.<sup>208</sup> The mark will then be registered in the other member states that are designated unless a state raises an objection under its national law within twelve months. It would indeed give foreigners who have quick and easy access to property rights at home, presumptive access to British protection, while the British manufacturers would be left to face thorough and deliberate examination by their own Registry before they could take advantage of the arrangement.<sup>209</sup>

Therefore, with the advent of industrial revolution, to identify that a product came from a particular manufacturer, such goods were noticeably marked to indicate ownership.<sup>210</sup> Goods were advertised on the basis that they were distinctive which attracted consumers into buying such products. Hence, the public would be knowledgeable when goods or services are advertised which would enable them make an informed choice and choose between different kinds of items. Thus, where a product is excellently advertised, the populace would be interested in its purchase.<sup>211</sup> It is pertinent to note that an important tool of a trademark which cannot be relegated is its marketing strategy which aids in its advertising skills and the

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<sup>203</sup> This was enacted in 1989 and is otherwise, referred to as the Protocol to the Madrid Agreement. It was adopted in the UK and finally, came into force by 1996. See Bainbridge, D.I., op.cit. at p. 855. Retrieved June 25, 2013 from Primary Sources: [www.cfr.org/Intellectualproperty](http://www.cfr.org/Intellectualproperty)

<sup>204</sup> Ibid.

<sup>205</sup> World Intellectual Property Organisation (WIPO). Protocol relating to the Madrid Agreement Concerning the International Registration of Marks. Retrieved October 12, 2018 from [www.wipo.int/treaties/madrid](http://www.wipo.int/treaties/madrid)

<sup>206</sup> Ibid.

<sup>207</sup> Retrieved September 10, 2014 from <http://iponz.govt.nz/.../WIPO%20INTRODUCING%20MADRID%20NZ%2020>

<sup>208</sup> Bainbridge, D.I., op.cit. at p. 820

<sup>209</sup> Cornish, W.R. and Llewelyn, D., op.cit. See the Mathys Report, Cmnd. 5601, 1974, Section 32

<sup>210</sup> Pattishell, B. 1952. Trade Marks and the Monopoly Phobia 42 *TM Rep.* 588, 590-1

<sup>211</sup> Brown, R. 1948. Advertising and the Public Interest: The Legal Protection of Trade Symbols. 57 *Yale LJ* 1165, 1189

passing of information to consumers that such a mark exists and that the public should be aware of it. Hence, trademark functions as transforming from signals to symbols.<sup>212</sup>

Traders were able to advertise their good by referring to such marks and in turn, the public, who are the purchasers in this instance, relied on the signs which they are used to and have identified as being of good quality.<sup>213</sup> Consumers, as a result of familiarity with the goods on display, soon realized that some marks signified a certain standard of quality.<sup>214</sup>

Where a court has acknowledged that a sign could represent an indicator of source, another trader using the same mark without the permission of the real owner, is guilty of committing fraud.<sup>215</sup> The Chancery Court, as far back as the early nineteenth century, protected the reputation of the trader especially if the right of the owner had been infringed upon and this was done by bringing an action for passing off. Passing off is still available today and it requires a trader to establish that there had been a misrepresentation that deceived consumers and was therefore, concerned with the concept of confusion.<sup>216</sup> By the beginning of the twentieth century, the role that trademark played changed from being indicators of origin to which consumers could easily identify in the market place to becoming assets which were valuable in their own rights.<sup>217</sup>

#### **2.4.2 The evolution of trademarks in Nigeria**

In Nigeria, it is interesting to note that the idea of a trade mark as a means by which one's products are distinguished from those of others was known to the local community before colonization.<sup>218</sup> It was used to identify both agricultural implements and local industrial products. Many works of art in brass, bronze, gold, clay, wood and calabash had characteristics which were and are still used to identify their origin, that is, that part of the country where they were made or crafted. For instance, bronzes from Ife had their own characteristic naturalistic features; a work of art from the Nok region often had two holes

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<sup>212</sup> Drescher, T. 1992. *The Transformation and Evolution of Trademarks: From Signals to Symbols to Myth*. 82 *TM Rep.* 301

<sup>213</sup> Diamond, S. 1975. "The Historical Development of Trademarks" 65 *TM Rep.* 265, 281

<sup>214</sup> Bentley, L. and Sherman B. 2014. *Intellectual Property Law*. Fourth Edition. Oxford University Press, at p. 811

<sup>215</sup> *Ibid.* at p.811

<sup>216</sup> *Ibid.* at p. 811

<sup>217</sup> *Eastman Photographs Material Co. v. John Griffith Cycle Corp.* (1898) 15 RPC 105.

<sup>218</sup> Shyllon, F., *op.cit.* at p. 192

made in the head.<sup>219</sup> Therefore, what the marks did was to indicate the source of products and identify their manufacturers. It is unlikely whether there was any registration system or any remedy for infringements of rights at that time.<sup>220</sup>

Nigeria as a colony of Britain had its first indigenous legislation on Trademark in 1900 which was applicable to the then Protectorate of Southern Nigeria. This Act was thereafter repealed by the Trade Marks Ordinance of 1910 and its jurisdiction was limited to Southern Nigeria.<sup>221</sup> As a result of the amalgamation of the Northern and Southern Protectorates, the Trade Marks Ordinance (No 20) of 1914 was enacted and this was applicable also, to the whole country. This was followed by the Trademark Ordinances of 1920, 1923 and 1926.<sup>222</sup> In 1958, a consolidating Trademarks Ordinance described as an ordinance to consolidate and amend the law relating to trademarks was enacted.<sup>223</sup> Nigeria gained her independence in 1960 and five years later however, the Trade Marks Act, 1965 was promulgated. The Ordinance provided for proprietors or trademarks registered under 1900 proclamation in Southern Protectorate who wanted their trademarks to be applicable to the entire country and to the registrar of trademarks for re-registration.<sup>224</sup> The law for governing trade mark in Nigeria is the NTMA 1965 and it is based to a large extent on the UKTMA 1938.<sup>225</sup>

## 2.5. Administration of Trade Marks

There are two (2) principal officers charged with the administration and control of trade mark and they are Minister for Trade and Industry and a Registrar.<sup>226</sup> In discharging his duties, the Registrar acts under the control and direction of the Minister.<sup>227</sup> The Minister has responsibilities in the discharge of his duties and may make regulations relating to the administration of trade marks in Nigeria.<sup>228</sup> Some of the regulations include mostly administrative duties that deal with the effective management of trademark law in Nigeria

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<sup>219</sup> Sodipo, B. 1997. Piracy and Counterfeiting: GATT, TRIPS and Developing Countries, 40. Retrieved October 14, 2014 from <https://searchworks.stanford.edu/view/3502650>

<sup>220</sup> Shyllon, F., op.cit. at p. 192

<sup>221</sup> Oyewunmi, A.O., op.cit. at p. 234

<sup>222</sup> Ibid. at p. 234

<sup>223</sup> Cap. 199, Laws of the Federation and Lagos, 1958. Oyewunmi, A.O., op.cit. at p. 234

<sup>224</sup> Mukhtar. N. 2013. Nature and Scope of Intellectual Property Law: An appraisal of Concepts, Issues and Prospects for Developing Economies. *Journal of Politics and Law (Canadian Centre of Science and Education)*, Vol.6, No. 2

<sup>225</sup> NTMA, Cap T13, Laws of the Federation 2004

<sup>226</sup> Section 1(1), NTMA, ibid.

<sup>227</sup> Section 1(2) of the NTMA, ibid.

<sup>228</sup> Section 45(1) of the NTMA, ibid.

while the Registrar's duties include the registration of a trademark,<sup>229</sup> or removing a trademark from the register if there is evidence that there had been no genuine use of the trade mark or the removal could be on the instruction of the applicant. The applicant may apply to the constituted authorities as the case may be.<sup>230</sup> In addition, the Registrar could be in charge of renewing registration of trademark or otherwise if such registration were to lapse.<sup>231</sup>

Other duties of the Registrar include the power and duty to hear certain persons.<sup>232</sup> The Registrar has the administrative duties of awarding costs as are necessary and to instruct the parties on the fees to be paid and in what order he may consider reasonable, and such order will be enforced as if judgment had been given. In the running of the trade mark office, the Registrar, has to give comprehensive details to the Minister on any matter pertaining to trade mark and when such information has been deciphered by the Minister, the document will thereafter be presented to the National Assembly which consists of a Senate and a House of Representatives for reading and adoption.<sup>233</sup> The National Assembly, is the body which is equipped with the responsibility of making laws in Nigeria.

In *The Procter and Gamble Ltd. v. Global Soap and Detergent Industries Ltd.*,<sup>234</sup> the Appellant was the proprietor of "Flash" under class 47 in respect of soaps and detergents which had been duly registered and in use. The Respondent also applied for a similar mark in class 3 in respect of the same goods. Upon advertisement of the application in the Trade Marks Journal by the respondent, the appellant filed a Notice of Opposition and this led to the registration being refused by the Registrar because goods that are similar would not be registered under the NTMA. The Respondent thereafter filed an application to the Registrar to remove the appellant's trade mark from the register because it had not been used within the time stipulated by law, and this led to the institution of proceedings by the opposition, which led a counter-statement to be instituted against the opposition. However, at the close of hearing, the Registrar decided in favour of the Respondent. The appellant, being dissatisfied, filed an appeal. It was held in this case that it is trite law that lack of bona fide intention to use the mark on registration is an ingredient for removal of such a mark and this can be

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<sup>229</sup> Section 23, NTMA, Cap. T13, *ibid.*

<sup>230</sup> Section 56, NTMA, *ibid.*

<sup>231</sup> Section 27, NTMA, *ibid.*

<sup>232</sup> Section 46, NTMA, *ibid.*

<sup>233</sup> Sections 47 and 48, NTMA, *ibid.*

<sup>234</sup> [1977-1989] 2 I.P.L.R. (Federal High Court) at p. 459

inferred from non-use. In this case, the appellant had not used the mark for any business venture and it was presumed that there was no intention to use it in the first place.

A question that may arise is whether a generic name is registrable. For instance, in *Smithkline Beecham Plc. v. Farmex Ltd.*,<sup>235</sup> the Plaintiff was the registered owner of the trade mark, “Milk of Magnesia” which it acquired from Sterling Products Plc. The Plaintiff asserted that her successor in title has been using the mark on their product, “Phillips Milk of Magnesia” for more than forty (40) years in Nigeria and that their product was well publicised. The Defendant, on the other hand, is a company manufacturing pharmaceutical products, one of which was “Dr. Meyer Milk of Magnesia” and was based in Ota, Ogun state, Nigeria. The Plaintiff alleged that its mark, ‘Milk of Magnesia’ was being infringed upon by the defendant, who was producing a similar mark to that of the original owner. The Defendant contended that he was the authorised user of the trade mark “Dr. Meyers” which was being used on all its pharmaceutical products. They also claimed that the name, “Milk of Magnesia”, is a generic name which the Plaintiff erroneously registered as a trade name and hence, cannot claim exclusive ownership to the use of the name. The Plaintiff’s claim was brought about to restrain the Defendant from infringing its trademark. However, it was held by the Court that the Plaintiff could not claim exclusive ownership of the name “Milk of Magnesia” because milk of Magnesia was a generic or common or scientific name used freely in the medical and pharmaceutical world. Therefore, any reputation or goodwill the Plaintiff might purport to have acquired over the years or purported to be acquiring is not as a result of the words “Milk of Magnesia” but because of its brand name, “Phillips” which is the name the Plaintiff is selling and not the generic name, ‘Milk of Magnesia’ which any other pharmaceutical company can use. Finally, it was held that the Plaintiff cannot honestly claim that the adoption of the brand name, “Dr. Meyers Milk of Magnesia” has infringed its brand name, “Phillips Milk of Magnesia”. The brand names, “Phillips” and “Dr. Meyers” are distinguishable enough to differentiate the product of the Plaintiff from that of the Defendant. That is, generic names are when names are used generally for common products, such as detergent is used for Omo, Ariel, Sunlight, etc.

Under the NTMA, for a trade mark to fall within the requirements of being registrable and having capacity, it must be in Parts A and B of the Register.<sup>236</sup> In applying for registration

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<sup>235</sup> [1997-2003] 4, I.P.L.R. p. 416

<sup>236</sup> Sections 9 and 10, NTMA, Cap. T13, Laws of the Federation 2004

under Parts A and B of the register, any such person who wishes to do so, must first of all, apply to the Registrar in the prescribed manner, so as to be certain that the mark can be registered, or that it is easily differentiated from other products and that it is not similar to those already on the register.<sup>237</sup> In addition, in practice, Parts A and B is not strictly adhered to and it is suggested that the two parts should be merged together and become one part. The Registrar is however not bound by any information given by the applicant but nevertheless, saves the applicant's time, trouble and expense by endorsing such application. In instances where the Registrar accepts and then objects to the application, the applicant has the option of withdrawing from the case and the filing fees which he had initially paid would be given back to him but it must be within three months as stipulated by the law. This will be done after the Registrar must have given reasons why the trade mark was not capable of being registered and why it was unlikely to distinguish itself amongst all other goods.<sup>238</sup>

Another requirement is that any person may apply to the Registrar to search for goods which are classified and to ensure that the mark is indeed on the register. The date of the search and any such request pertaining to the enquiry would be executed by the Registrar and the applicant would be informed of the outcome thereafter.<sup>239</sup> Such search will only be conducted where the applicant has shown the intention that the Registrar should investigate and find out whether any mark looks like the proposed mark on the Register; as too much similarity of the goods might lead to consumer confusion.<sup>240</sup> The Registrar may after the search, either accept the application and come to the conclusion that it is distinctive enough to be registered or it may be refused because of its non-distinctiveness. It is pertinent to note that an application may be accepted subject to such conditions as may be required and after the requirements has been met, and the Registrar may later accept it totally but it is only after the conditions have been dealt with.<sup>241</sup>

## **2.6. Scope of Trade Mark**

The objective of trademark law is to permit an enterprise to obtain the right to use, share, licence or assign a mark by registering its trademarks. A trademark is considered in terms of

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<sup>237</sup> Section 17(1) of the NTMA, Cap. T13, Laws of the Federation 2004

<sup>238</sup> Section 17(2) of the NTMA, Cap. T13, Laws of the Federation 2004

<sup>239</sup> Regulation 118, Trade Mark Regulation, 1966

<sup>240</sup> Regulation 33, Trade Marks Regulations, 1966

<sup>241</sup> *Kolex Mercantile Import Company v. Alliance International Nigeria Limited* (1980) F.H.C.R.137

being an exclusionary right which is a right of the proprietor of the mark to exclude others from using the same mark. This in other words, is referred to as a negative right.<sup>242</sup> This negative right is evident under the NTMA where a registered trademark gives the proprietor the exclusive right to use the mark in relation to the goods.<sup>243</sup>

It is not every mark which can be registered under the Nigerian law and they include:

- a) The kinds of signs which may be registered as trade marks
- b) The products, for which registered marks may be used, and
- c) The categories of marks which the law protects.<sup>244</sup>

### **2.6.1. Signs that can be registered**

The property right that is vested in a trademark is of immense value to the owner who “is entitled to the protection which the highest powers of the courts can afford”.<sup>245</sup> The safeguarding of this right protects the consuming public from deceit, raises fair competition and fortifies the advantages of reputation and goodwill by precluding their diversion from those who have created them to those who have not.”<sup>246</sup>

A trademark has been defined as a mark that is able to distinguish the goods of one undertaking from those of other undertakings and this consists of but not limited to signs, which can be visually seen and touched and this is in line with international provisions, such as designs, words, packaging, etc.<sup>247</sup>

Under previous trademark laws in the United Kingdom, for instance, the UKTMA 1938 is similar to the NTMA 1965, which is the substantive law of trademarks in Nigeria today.<sup>248</sup> The meaning of trade mark under NTMA is not clear and neither is it descriptive of the signs which can be registered. Also, the types of signs, which ought to be so stated are not and hence, it would be difficult to know the marks which can be validly registered. The only

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<sup>242</sup> Intellectual Property Magazine. 2014. The Right to use a trademark. Retrieved October 16, 2018 from <https://www.intellectualpropertymagazine.com>>...

<sup>243</sup> Section 5(1), NTMA, Laws of the Federation 2004

<sup>244</sup> Shyllon, F.O., op.cit at page 184

<sup>245</sup> *Scandinavia Belting Co. 257 F. at 941.*

<sup>246</sup> S. Rep. No. 1333. 79th Cong., 2d Sess. 4. *Reprinted in* 1946 U.S. Code Cong. & Serv. 1274. 1275 [hereinafter cited as Senate Comm. on Patents]

<sup>247</sup> Section 1(1) UKTMA, Cap. 26, 1994

<sup>248</sup> Section 68, UKTMA Cap. 22, 1938



information as to the type of sign which is deemed to be registered is that, a mark must be distinctive and where it is devoid of distinctiveness, it would not be so registered.<sup>249</sup> In comparison, the UKTMA 1994 provides for the different kinds of signs which can be registered and are capable of graphic representation.<sup>250</sup> Examples of visible signs which may be registered include the following:<sup>251</sup>

1. Existing words, such as “Triumph for automobiles, Apple for computers;
2. Names such Ford, Peugeot and Kellogg’s cornflakes
3. Slogans: “We try harder” for a car rental agency or Milo, “the food drink of future champions”
4. Devices: the star for Mercedes Benz automobiles, the flying lady for Rolls Royce automobiles or the lion for Peugeot automobiles
5. Letters: GM, VW, IBM, and FIAT; and
6. Words such as Coca-Cola, Bigi, Kodak, Xerox<sup>252</sup>

The list is not limited to the above. In other jurisdictions, the shapes of goods or their containers such as bottles, wrappers, envelopes, packaging and similar three-dimensional signs are considered trademarks which are capable of being registered.<sup>253</sup> In the United Kingdom, a mark would not fall within the registrability if the trade origin is not known. Signs which are registrable in the UK include colours, smell marks, olfactory marks, shape marks and they must be graphically represented and the goods must be distinguished from those of other undertakings.<sup>254</sup> By identifying the product and its manufacturer, trademarks become a guarantee of a particular standard of quality and enable consumers to identify the product of a specific manufacturer or distributor.<sup>255</sup>

In Nigeria, the trade mark inventory is divided in Part A and Part B of the Register, and it contains the records of all registered trademarks with the appellations and addresses of proprietors, entry of dates on which the applications were made, and generally, all

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<sup>249</sup> Section 9 and 10, NTMA, Cap. T13, Laws of the Federation 2004

<sup>250</sup> In the case of *Re Clark*, 17 USPQ 2d. 1238 (1990), the first smell registration was granted in respect of embroidery yarn for a high impact fresh flora fragrance in the USA. In addition, Australia registered the first scent on 2 January 1997. See Hall. 1997 First ever smell Trade Mark Registered in Australia, 10 Australian Intellectual Property Law Bulletin 2. Cited in O’Connor, 12 I.P.J. (1998) 300, n.95

<sup>251</sup> Shyllon, F. op.cit. at pp 184-185

<sup>252</sup> Ibid. at p. 185

<sup>253</sup> Ibid.

<sup>254</sup> Bainbridge, D.I. op.cit. at p.703-712

<sup>255</sup> See Senate Comm. on Patents. *supra* note 21. at 1274

information of the registered users, notifications of designation in any manner as may be prescribed.<sup>256</sup> However, Part A consists of information on the applicant(s) and it consists of names of companies, individuals, firms, or corporations which must be in a specific manner; the signature of the applicant(s) or representatives; the invented word(s) that has indirect reference to the quality of the goods, and should not be a geographical name or a surname, but it could be any other distinctive mark. It is pertinent to state that certification marks are not part of the above procedural aspects.<sup>257</sup> It is important to know that a trade mark will only be registrable where there is evidence of its distinctiveness, which is an essential element in every registration.<sup>258</sup> There must be a connection in the course of trade between the proprietor and a person in which there is no existing connection but it must be according to the trade mark which is to be registered. It is pertinent to note that such mark proposed to be registered must be subject to limitations within the extent of its use when registering.<sup>259</sup> Under Part B of the register however, a mark can only be registered in respect of which it is capable of distinguishing the goods of the proprietor in the course of trade from a person who is not in any way, connected to the owner's business.<sup>260</sup> In other words, a trademark that is to be registered must be able to differentiate the goods of one undertaking from those of all other undertakings and it must be distinctive in a class of its own.<sup>261</sup>

To claim ownership and to have the right and control to use the products in a specific locality, marks were affixed to identify manufacturers.<sup>262</sup> The law of trademarks was formalized with the process of registration which gave exclusivity to a trader to deal in goods using a symbol or mark of some sort to distinguish his goods from similar goods sold by other traders. Hence, the grant of a trade mark and the ability to use it cannot be transferred and it is only a limited right of user that can be granted via a licence.<sup>263</sup>

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<sup>256</sup> Section 2(2), NTMA, Cap. T13, Laws of the Federation 2004

<sup>257</sup> Section 9(1), NTMA, *ibid.*

<sup>258</sup> *Ibid.*

<sup>259</sup> Section 9(3) (a)-(b), NTMA, *ibid.*

<sup>260</sup> Section 10(1), NTMA, *ibid.*

<sup>261</sup> Section 10 (2), NTMA, *ibid.*

<sup>262</sup> Bently, L. and Sherman, B. 2014. *Intellectual Property*, 4<sup>th</sup> Edition. Oxford University Press, 809

<sup>263</sup> Verkey, E. 2015. *Intellectual Property*. Eastern Book Company Publishing (P) Ltd., 154. See *Ramdev Food Products (P) Ltd. v. Arvindbhai Patel* (2006) 8 SCC 726

A registered mark is protected under the NTMA while a mark not duly registered, falls under the law of tort relating to passing off. However, notwithstanding the distinctiveness of a mark, registration will not be automatically granted.<sup>264</sup>

Under the NTMA<sup>265</sup>, the words, “used or proposed to be used” and “its connection in the course of trade” is utilized. There is no Nigerian case on the concise definitions of the aforementioned terms. In *Aristoc Ltd. v. Rysta Ltd.*,<sup>266</sup> an English case, the respondents had applied to register a mark consisting of the word ‘Rysta’ in respect of stockings. The appellants had opposed its registration because they too, were the manufacturers and dealers in women’s stockings. The name of their enterprise, was ‘Aristoc’ which they registered in 1923 and thereafter, gained popularity by selling silk stockings throughout the United Kingdom to the value of about four million pounds sterling. The respondents, on the other hand, at the date of their application for a trade mark had neither made nor sold any stockings. They were however, the owners of an undisclosed process for effecting invisible repairs to ladies’ stockings. They called this process, ‘Rysta’. The appellants opposed the registration of the ‘Rysta’ mark because it was capable of misleading the public and that it was not possible for such a mark to be registered. The Court, in its judgement held that the repair of stockings by the respondent did not specify that there was any connection in the course of trade between the appellant and the respondent under the UKTMA 1938. Hence, it was affirmed that the trade by itself was not to make ladies’ stocking but it was to repair and stitch any defects and that there was no correlation between the businesses of the parties.<sup>267</sup>

### **2.6.2. Application of products to trade mark protection**

What is protected as a trademark usually differs from country to country but notwithstanding, the owner of a trademark has statutory monopoly in the mark for the goods or services covered by its registration.<sup>268</sup>

In earlier times, trademarks applied only to marks in relation to goods. However, with the advent of globalization and the development of multinational enterprises offering standardized airline, hotel, tourist and restaurant services, trademark in some countries has

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<sup>264</sup> Babafemi, F.O., op.cit. at p. 177

<sup>265</sup> Section 67, NTMA Cap. T13, Laws of the Federation 2004

<sup>266</sup> (1945) A.C. 68; (1945) 62 R.P. C. 565

<sup>267</sup> UKTMA, Chapter 22, 1938

<sup>268</sup> Hart, S. and Murphy, J. 1998. *Brands, The New Wealthy Creators* : Palgrave of Law and Economics

been extended to marks used with such services. This protection is accomplished either by specific reference to service marks or by expanding the definition of the trade mark to include services.<sup>269</sup>

### **2.6.3. Marks that can be protected**

There are categories of marks which are capable of being protected and hence, it is not every mark that can be protected as a trademark. The categories of marks that are protected under the Law of Trade Marks in Nigeria and United Kingdom include:

#### **2.6.3.1. Collective and Certification marks**

Trademark serves in identifying source origins of individual manufacturers' enterprises and its capability in distinguishing between goods or services of one undertaking from those of other several undertakings whilst at the same time, ensuring that the owner's products are adequately protected against infringers. Hence, it is the mark on the product that will enable consumers to know what they want to buy at all times.

A collective mark may be used in certain initiatives, which is by members of the organization that retains the mark.<sup>270</sup> A certification mark on the other hand, may be used by individuals that comply with the rules and regulations that are already laid down by the members of the organization. Thus, the members of a collective mark constitute a club whilst in respect of certification marks, the "open shop" would apply.<sup>271</sup> A certification mark does not belong to the producer or trader, but it applies to an authority which is independently certified and its goal is to ensure that goods that are being used fall under requirements or standards which are established.<sup>272</sup>

The general idea behind certification marks is that it is not limited to any membership but the proprietor or organization must be able to comply with certain required standards so as to ensure the products as being authentic.<sup>273</sup> An example includes certification marks such as "Woolmark" which certifies that the goods on which it is used are made of 100% wool and

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<sup>269</sup> This is included in section 2(xi) of the Model Law for English Speaking African Countries on Trade Marks, published by WIPO in 1979

<sup>270</sup> Shyllon, F., op.cit at p. 185

<sup>271</sup> Ibid.

<sup>272</sup> Oyewunmi, A.O. op.cit. at p. 270

<sup>273</sup> Certification Mark (WIPO). Retrieved March 12, 2015 from [www.wipo.int/sme/en/ip\\_business/...marks/certification\\_marks.htm](http://www.wipo.int/sme/en/ip_business/...marks/certification_marks.htm)

not otherwise.<sup>274</sup> Hence, certification marks are not only to distinguish goods or services of one undertaking from those of other undertakings but it is to ensure that each member conforms to the standards of the organization in relation to the material, safety or quality of its products.<sup>275</sup>

Collective marks are usually defined as visible signs that distinguish where such mark originated from, the substance of the product, how the product is made or other characteristics peculiar to it.<sup>276</sup> It is a mark owned and used by different business entities or individual producers who are members of a collective body, which includes, group or association of producers, manufacturers or traders. The members of the group have exclusive rights to use the mark and may use it either alone or in addition to their individual trademarks.<sup>277</sup> The owner may be in Sole Corporation in which there are members or it could be a public cooperation or an institutional organization.<sup>278</sup>

The marks protected in Nigeria are restrictive in scope as the Act only protects trademark or trade name, certification marks, and defensive registration<sup>279</sup> of well-known marks. The NTMA however, does not protect service marks, collective marks, and distinctive shapes of goods or sensory marks which are part of the essential features of most trademark laws.<sup>280</sup> Certification marks were in existence prior to the 1994 Act in the UK but collective marks were newly introduced into the UKTMA 1994.<sup>281</sup> Therefore, in Nigeria, there is only recognition of certification marks which reiterates its replica under the 1938 Act.<sup>282</sup>

### **2.6.3.2. Association trademarks**

When the owner of a mark seeks to register dissimilar goods or services, which are similar in description but vary in terms of: (i) record of the goods in relation to which they are respectively used or proposed to be used, (ii) records of quantity, in relation to its value, quality or names of places; or (iii) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or it could be; (iv) colour; provided that

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<sup>274</sup> Ibid.

<sup>275</sup> Bainbridge, D.I., op.cit. at p. 753

<sup>276</sup> Shyllon, F., op.cit. at p. 185

<sup>277</sup> Oyewunmi, A.O., op.cit. at p. 271

<sup>278</sup> Shyllon, F., ibid. at p. 185

<sup>279</sup> Section 32(2), NTMA, Cap. T13, Laws of the Federation of Nigeria 2004

<sup>280</sup> Ibid.

<sup>281</sup> Section 49, UKTMA Cap. 26, 1994

<sup>282</sup> UKTMA, Cap. 22, 1938. Section 43, NTMA, ibid.

such mark can be distinctively registered as a series in a single registration and this can be referred to as associated trade mark.<sup>283</sup> Such marks occur when a proprietor registers variants of a trademark that normally would not be separately registered by separate proprietors.<sup>284</sup> It is pertinent to note that all such marks will be registered in a single application as a series. Associated trademarks can be assigned and transmissible only as an entire part and not independently but they will for all other purposes be thought to have been registered as trademarks which are independent of each other.<sup>285</sup>

### **2.6.3.3. Separate trademarks**

Where there is a claim by the proprietor to the exclusive use of any part of the trade, an application ought to be made to the Registrar to record the entirety of the brand and any such component as a distinct trade mark.<sup>286</sup> Every such distinct trade mark must suit the initial conditions necessary for such marks as long as it can be shown that the proprietor is authorized to the use of the mark.<sup>287</sup> The proprietor must therefore be entitled to use the mark in the course of trade as the use of one is equivalent to use of another in other cases.<sup>288</sup>

### **2.7. Marks that are non-Registrable**

Marks that are not capable of being registered are at the discretion of the Registrar to accept or refuse as registration will not be automatically granted even though the mark may be distinctive or is capable of its distinctiveness. The power of the registrar was illustrated in *Nabisco Inc. v. Allied Biscuits Co. Ltd.*<sup>289</sup> The respondent, Allied Biscuits Co. Ltd., in June 1977 registered “Ritz” after the necessary investigation at the trade mark registry. The Appellant with the trade name, ‘Nabisco Inc.’, filed an application to register “Ritz” as a trademark. The application of the Appellant was advertised in the Trade Marks Journal at the instance of the Appellant (that is, Nabisco Inc.). When the Respondent noticed the advertisement, it commenced opposition proceedings against the appellant. After hearing had been concluded, the Registrar refused to register the device “Ritz”, as the Appellant’s mark. However, the appellant petitioned to the Federal High Court and it was allowed. The

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<sup>283</sup> Section 25, NTMA, Cap. T13, Laws of the Federation 2004

<sup>284</sup> Shyllon, F., *ibid* at p. 186

<sup>285</sup> Section 28, NTMA, *ibid*.

<sup>286</sup> See Sections 24(1), (2) and 36, NTMA, *ibid*.

<sup>287</sup> Section 36 (2), NTMA, *ibid*.

<sup>288</sup> Section 36(1), NTMA, *ibid*.

<sup>289</sup> (1997-2003) 4 I.P.L.R. pg.209

Respondent's recourse to the Court of Appeal was also permitted. The Appeal Court thereafter set aside the decision of the Federal High Court and restored the judgment of the Registrar of Trade marks. It was held that the Registrar has discretionary powers under the NTMA to either accept or reject an application if it does not fall within the requirements for registering trademarks.<sup>290</sup> Hence, for a trade mark to be registered, it must be distinctive and able to differentiate between the goods of one undertaking from those of other undertakings in the course of trade so that confusion would be minimized. Examples of such marks are:

### **2.7.1. Deceptive or Scandalous Marks**

It is unlawful for a person when registering a trade mark to use a mark which is apt to mislead or to be the basis of misconception or is contrary to law or where it is of any scandalous nature.<sup>291</sup> Marks that are likely to hurt or injure religious feelings, or contain immoral matter, or words that are blasphemous or obscene, cannot be registered as trademarks.<sup>292</sup> For instance, the UK Trade Mark Registry will not register any kind of soap, perfumery which would affect a class or section of people or any goods if it has a religious undertone such as naming the product, "Jesus".<sup>293</sup>

### **2.7.2. Names of Chemical Substances**

Under the NTMA, there is a restriction to registering the names of chemical substances. Hence, an assertion that is usually used to refer to single chemical element or compound or single chemical compound, though distinguished from a mixture will not be registered as a trade mark especially if it is for a chemical substance or preparation.<sup>294</sup> Where there is a false entry, or where information is entered in the register without sufficient cause, the Registrar has the right to rectify the register, by deciding whether to expunge the information or

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<sup>290</sup> Section 1, NTMA, Cap. T13, Laws of the Federation 2004

<sup>291</sup> Babafemi, J. 2007. *Intellectual Property: The Law and Practice of Copyright, Trade Marks, patents and Industrial Designs in Nigeria*. Justinian Books Limited, at p.186. See also Section 11, NTMA, ibid.

<sup>292</sup> Verkey, E. op.cit at p. 167

<sup>293</sup> Ibid. at p. 167

<sup>294</sup> Section 12(1), NTMA, Cap. T13, Laws of the Federation 2004

otherwise from the Register. A neutral person, that is not linked to the proprietor, in any such way, can also allege a false entry in the Register.<sup>295</sup>

### 2.7.3. Identical and Trade Marks resemblance

Goods, that are identical as to its similarity and description shall not be registered if it is already on the Register and belongs to another proprietor.<sup>296</sup> Hence, a trade mark will not be registered in respect of goods that are (a) similar, or (b) the outer character of the goods are alike, and that they very much look like other products and that such goods would likely mislead consumers into thinking otherwise.<sup>297</sup> Therefore, a trade mark sought to be registered, must not be alike or be akin to the trade mark of another proprietor. In other words, each trade mark that is registered must be distinctive in its own class and any goods which tend to be similar to other goods will not be registered under any trade mark law unless otherwise accepted by the Registrar.<sup>298</sup> However, there are exceptional cases where the Registrar would allow certain trade mark registrations that are the same or compactly look like each other but they must be subject to such stipulations as the trade mark official or the Court might think fit to do.<sup>299</sup> Therefore, the Registrar reserves the right to refuse an application for trade mark which does not fall under the requirements for its being registered and this can be done only after the matter has been settled by the Registrar himself or by the court on an appeal from the Registrar.<sup>300</sup> A trade mark could therefore be expunged from the register where there is the evidence that there is in existence an identical trade mark which is likely to deceive consumers. In *Hondret & Company Limited v. Registrar of Trademarks*,<sup>301</sup> the claimant registered “Rosefresh Air-Freshner” in 1974. The Respondent, the Registrar in this case refused to register the trademark on the ground that the mark conflicts with an earlier application by Murray, Clark & Jones Ltd.; and a ruling was delivered confirming his refusal. The applicant, being dissatisfied with this decision, filed a Notice of Motion appealing against the refusal of the Registrar and thereafter, sought for an order that the Registrar should proceed with the registration of the mark. It was held in this case that

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<sup>295</sup> Section 38, NTMA, *ibid.*

<sup>296</sup> Section 13(1), NTMA, Laws of the Federation 2004

<sup>297</sup> Section 13(1) NTMA, *ibid.*

<sup>298</sup> Section 13(1) NTMA, *ibid.*

<sup>299</sup> Section 13(2) NTMA, *ibid.*

<sup>300</sup> Section 13(3), NTMA, *ibid.*

<sup>301</sup> [1977-1989] 2,I.P.L.R. page 116, 113



Section 13(1)<sup>302</sup> is only applicable where the Mark sought to be registered conflicts with an existing registered trade mark and where the application to register both marks are still pending in the courts.<sup>303</sup>

Furthermore, in *American Cyanamid v. Vitality Pharmaceuticals*,<sup>304</sup> the Supreme Court held that where a trade mark is registered, the owner or a registered user, cannot as a matter of fact, interfere with a mark that is already in existence and has been in use before the registration of his own trade mark even if such mark is the same and impossible to tell apart.

#### **2.7.4. Coat of arms**

As a fundamental rule in Nigeria, it is a punishable offence where a person uses the Coat of Arms or any symbol nearly resembling it on a trade mark which is apt to mislead the public into assuming that the person using such, has the permission to do so.<sup>305</sup> The populace is therefore not allowed to use the national flag of Nigeria or any insignia so closely resembling it on a trade mark which will be fraudulently misleading. Also, words, such as, President or Governor or any mark likely to deceive persons to think that the applicant is connected to the President or Governor is an offence and unacceptable.<sup>306</sup> Hence, any such emblem which resembles the Coat of Arms of Nigeria or the Arms of the State, as the case may be, and used in connection with any trade, business, in any manner, is unlawful, especially if done without the prerequisite permission from the appropriate authorities. Therefore, where this occurs, it leads to a fraudulent misrepresentation of the fact that such persons were not authorized to use the emblem of the Federal Republic of Nigeria or that of a State in the first place and will be guilty of an offense and liable to be punished accordingly.<sup>307</sup> It shows from the provision under the NTMA, that using what belongs to the Federal or State government is illegal, but the penalty for such a grievous offence is too lenient under the NTMA, to deter fraudulent persons as the fine so stipulated is a miserly amount of forty naira.<sup>308</sup>

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<sup>302</sup> Section 13(1) NTMA, *ibid.*

<sup>303</sup> *Hondret & Company Limited v. Registrar of Trademarks*, *ibid.*

<sup>304</sup> (1991) 2 N.W.L.R. 15

<sup>305</sup> Section 62, NTMA, *ibid.*

<sup>306</sup> Regulation 18, Trade Mark Regulations 1967

<sup>307</sup> Section 62 (2)-(3) NTMA, *ibid.*

<sup>308</sup> Section 62, NTMA, *ibid.*

Pertaining to the UKTMA, it is a punishable offense where a person uses an emblem or any sign resembling the Royal Arms or any of the royal flags or a representation of the Royal Crown or any members of the family of Her Majesty, the Queen, or any colour imitation in words, calligraphies or apparatuses or devices, which is probable to mislead persons to think that the applicant has royal patronage with the Royal family.<sup>309</sup> A trade mark will thereby not be registered if any of the signs stated above is attached on a product. However, a person will only be authorized where it can be ascertained by the Registrar that the prerequisite permission had been given by or on behalf of Her Royal Majesty, the Queen or by other member(s) of the Royal family or its representatives.<sup>310</sup> In addition, it would amount to fraudulent misrepresentation where the national flag of the United Kingdom, known as the Union Jack or the flags of England, Wales, Scotland, Northern Ireland or the Isle of Man are used on products to signify a trade mark. The Registrar will therefore not register a trade mark if its use would be misleading and grossly offensive to the citizenry.<sup>311</sup>

It is pertinent to state that the use of a geographical indication as a trademark gives the impression that the product or service is originating from the country, region or place to which the geographical indication relates. In the first instance, the product or service in fact originates from the said country, region or place. This is referred to as an appellation of origin and is constituted by the denomination of a country, region, or specific place that serves to designate a product originating from a particular place as coming from that specific geographical area. It thereby serves to identify the source or origin of the products or services for which they are used.<sup>312</sup> Hence, they convey important and useful information to consumers on the geographical origin of goods and services and indirectly, their inherent quality and characteristics.<sup>313</sup> Therefore, to allow the geographic indication to serve as a trademark would mean that other enterprises operating from those areas will not be able to use the indication for a competing product or service. This would confer an unjustified monopoly upon the enterprise. Secondly, where the product or service does not originate from the said country, region or place, the trademark would be misleading.<sup>314</sup>

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<sup>309</sup> Section 4, UKTMA, Cap. 26, 1994

<sup>310</sup> Section 4, UKTMA, Cap. 26, 1994

<sup>311</sup> Section 4, UKTMA, Cap.26, 1994

<sup>312</sup> Shyllon, F., op.cit. at p. 9

<sup>313</sup> Ibid. at p. 10

<sup>314</sup> Shyllon, F., op.cit. at p. 196

A word does not become a geographical name merely because some place in some place bears that name. In the case of *Ligget and Myers Tobacco Company v. Registrar of Trade Marks*,<sup>315</sup> the word. “Chesterfield” was not capable of being registered because it was a geographical name. On appeal to the High Court of Lagos, it was held that in the absence of special circumstances, the word to some degree, be interpreted in accordance with its general popular meaning. The applicant may discharge the onus on him by showing that the word is not a geographical name in its ordinary signification by indicating that it also has a dictionary meaning and may thereby, rely on it. It was therefore summarized by the learned court that “Chesterfield” was not a geographical name and indeed has a meaning in the dictionary.<sup>316</sup>

## **2.8. Process of Registration in Nigeria**

For a mark to be registered, it is important that the prerequisite requirements must be followed and must have passed the authenticity test. As a rule, any person who is keen on registering a mark needs to correspond with the Registrar in a written format provided for in the prescribed form of his intention to do so and such must fall either under Part A or Part B of the Register, and not outside of it and it will be determined whether or not, it is indeed registrable and capable of being distinguishable.<sup>317</sup> This application may be brought either by the proprietor himself or his counsel or by a duly accredited agent.<sup>318</sup>

Apart from the proprietor of a mark, there are other classes of persons who are also vested with the power to register trademarks as long as it is used when trading. Such persons include registered users, assignees or corporate bodies. A distinction is made between registering a trademark and a user under the Act<sup>319</sup> and it provides that another person who is not the proprietor can be identified as a registered user but such person must deal with the goods in relation for which has been so registered.<sup>320</sup> The proprietor must however give consent to the registered user to make use of such trade mark in the course of business. In other words, the use of the goods must be tantamount to the trade and must not be separated and should for the time being be regarded as a user of the trade mark provided that where a person is a

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<sup>315</sup> (1969) 1 ALR Comm. 421

<sup>316</sup> Ibid.

<sup>317</sup> This provision is provided for under Section 18(1) NTMA, Cap. T13, Laws of the Federation 2004

<sup>318</sup> See the case of *Ducross S.A. v. Silas Ind. & Trading Co. Ltd.* [2003-2007] 5 I.P.L.R.28

<sup>319</sup> Section 33, NTMA, *ibid.*

<sup>320</sup> Section 33, NTMA, *ibid.*

registered user thereof, he must be subject to restrictions which are conditional upon the use of the mark.<sup>321</sup> That is, the use must be within the accepted preconditions or limitations set by the law and not outside of it.<sup>322</sup> The Act,<sup>323</sup> further provides that a trademark could be assignable and transmissible when it is registered as long as it is in connection with the business goodwill and thus, an application must be made to the registrar to register the title.<sup>324</sup> In *A.B. Chami &Co. Ltd. v. W.J. Bush & Co. Ltd.*,<sup>325</sup> the court held that in the event of an assignment of a registered trade mark, the proof of assignment must be accompanied with an application to the Registrar so that the certificate of assignment will be issued to the applicant. That is, anything that happens to the trade mark should be brought to the notice of the Registrar.

In *Beecham Group Plc v. General Nutrition Ltd.*,<sup>326</sup> the appellant was the owner of the “Extravite” trade mark under Class 3 in respect of Chemical substances prepared for use in medicine and pharmacy. The Respondent also applied for a comparable product named, “Extravite” within Class 5 but under a different head, referred to as Pharmaceutical preparation and substance. The Appellant thereafter, filed an opposition notice claiming that the respondent’s mark was confusingly similar, both phonetically and visually and that they are also of the same description. It was however upheld that a registered owner and the user of a trade mark are quite independent of one another. A person that has an interest in the subject matter can also bring an action and it is not only left to the proprietor to do so. Where the registration is being contradicted by another person, the Registrar must be informed in writing and such information in relation to the conflict must be so stated.<sup>327</sup> The Registrar will thereafter, listen to the two sides and the case will be determined and concluded.<sup>328</sup> All that registration implies is that the trade mark is protected whereas non-registration leaves the proprietor of the trade mark to his remedy at common law.<sup>329</sup>

In *Zeneca Limited & Ors v. Jagal Pharmaceutical Limited*,<sup>330</sup> it was held that registration of a trade mark entitles the proprietor to sue or institute an action in any case of infringement.

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<sup>321</sup> Section 33(2) (a)(b), NTMA, *ibid.*

<sup>322</sup> Section 33(2) (a) (b), NTMA, *ibid.*

<sup>323</sup> That is, the NTMA, *ibid.*

<sup>324</sup> Sections 26(1), 29, 30 and 35, NTMA, *ibid.*

<sup>325</sup> (1996) F.H.C./K 784

<sup>326</sup> (1990-1997) 3, I.P.L.R. p. 395

<sup>327</sup> Section 20, NTMA, *ibid.*

<sup>328</sup> Section 20, NTMA, *ibid.*

<sup>329</sup> Non-registration of Trade Mark falls under passing-off which originated from common law

<sup>330</sup> (2003-2007) 5, I.P.L.R. p.409

Registration entitles the proprietor to the sole exclusive use of the mark and also the right to sue for passing off if the goods of the owner were being infringed upon by a person who does not have any right to the use of such a mark. The NTMA therefore, serves as a guide as to the application and procedure for registering a trade mark.<sup>331</sup>

Similarly, in *Beijing Cotec Tech. Corporation & Anor v. Greenlife Pharm Ltd & 5 Ors*,<sup>332</sup> the 1<sup>st</sup> Plaintiff is a registered proprietor in respect of a drug called, “COTECXIN DIHYDROARTEMISININ” while the 2<sup>nd</sup> plaintiff is the sole marketer and licensee of the 1<sup>st</sup> Plaintiff in Nigeria. The Plaintiffs obtained the approval for the sale of its anti-malaria drugs based on its Patent, “DIHYDROARTEMISININ” from the National Agency for Food Drugs Administration and Control (NAFDAC) in the year 2000. In July 2000, the Plaintiffs discovered a drug known as “ALAXIN” which has the active ingredient and compound, “DIHYDROARTEMISININ” in Nigeria and a complaint was made to NAFDAC and the agency promised to take necessary action. On July 21, 2003, the Vanguard newspapers reported that the 1<sup>st</sup>-5<sup>th</sup> Defendants were launching their anti-malaria drug which had the same component and ingredient with that of the Plaintiff. The plaintiffs thereby filed for an order of injunction restraining the defendants from infringing the plaintiff’s patent. It was further held in this case that when a mark is registered, the proprietor has the right to sue or institute an action for an infringement when an interloper tries to use what does not belong to him.

A request to search for classified goods can be made to the registrar by persons to ascertain whether any similar goods exist and where a duplicate of such mark is presented to the registrar, the search would be made accordingly.<sup>333</sup> The essence of the search is to ensure that there is no likelihood of confusion and that such mark is not identical with or closely resembling any mark already on the register.<sup>334</sup> In *Re Application by Pioneer Biscuit Company*,<sup>335</sup> the applicant, a Ghanaian Company and proprietor of “Pibisco” sought to register a mark in Nigeria. The proposed mark and that of the respondent was similar. A complaint by the respondent was that ‘Bisco’ and ‘Pibisco’ looked alike and that another person would be confused and believe that the appellant and respondent were in the business

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<sup>331</sup> Babafemi, F.O., op.cit. at p. 205

<sup>332</sup> (2003-2007) 5, I.P.L.R. p.100

<sup>333</sup> See the case of *Dyktrade Limited v. Omnia Nigeria Limited* (1997-2003) 4 I.P.L.R., at p.263.

<sup>334</sup> Regulation 33, Trade Marks Regulation, 1967. See *Ferris George v. John Walkden* [1917-1976] 1, I.P.L.R. p. 28

<sup>335</sup> [1917-1976] 1 I.P.L.R. (High Court of Lagos)

together. The applicant contended that they had been selling biscuit under the “*Pibisco*” mark since 1960 upon which they instructed their former solicitors to apply for registration only to discover that he did not carry out their instructions as specified. This non registration was discovered in 1963 when they instructed their present solicitors to apply for registration and thus, the discrepancy was brought to light. Thereby, the Applicant instituted an action for an Order directing the Registrar to proceed with the registration of the trade mark notwithstanding the pending suit. The words, “*Bisco*” and “*Pibisco*” were held to likely deceive or mislead since they were so phonetically connected to the average Nigerian person despite the prior registration of the trade mark. If there are further complaints, the affected person can apply to the Registrar in the prescribed manner as provided for under the Act.<sup>336</sup>

A mark will not be registered where it conflicts with another mark in that the logo or symbol, as the case may be, closely resembles the mark that is already on the Register. Where there is similarity between the goods, there may be confusion even though they are in the same class of goods. There are however exceptional cases where a mark is similar to an already existing mark and this would be registered regardless of its peculiarity. If this were to arise, the Registrar might go ahead to register but it would be subject to such conditions, amendments, disclaimer, modifications or limitations as he may deem fit.<sup>337</sup> In *Ducross S.A. v. Silas Industries and Trading Company Ltd.*,<sup>338</sup> it was held that an owner can only trade in the goods or services for which is registered and has gained reputation within an unlimited duration of period. It is to be noted that such goods must not be contrary to public policy but must adhere strictly to it been registrable.

Another instance is the effect of prior application for registration of Trade Mark. In *Intel Corporation v. Dunsayo Investment & Anor.*,<sup>339</sup> the Plaintiff, a company incorporated in 1968 under the Laws of the United States of America, was into the production of microprocessor chips consisting of hardware and software components. The Plaintiff claimed that since 1969 and at all material times to this action, it is the bona fide owner and proprietor of the trade mark, “Intel” and the beneficiary of the goodwill associated with the worldwide proprietary use of the name. The Plaintiff in June 1998, by virtue of its increased activities in Africa and

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<sup>336</sup> Section 20, NTMA, *ibid*.

<sup>337</sup> *Ferris George v. John Walkden*, [1917-1976] 1, I.P.L.R. 17. *Kollex Mercantile Import Company v. Alliance International Nigeria Limited* (1980) F.H.C.R.137. See Section 18(2) NTMA, Cap. T13, Laws of the Federation 2004

<sup>338</sup> (2003-2007) 5, I.P.L.R. p. 43

<sup>339</sup> [2003-2007] 5 I.P.L.R. 297

especially in the Nigerian market sought protection in Nigeria by filing applications for three of its key marks, that is, “INTEL”, “INTEL INSIDE and Design” and “PENTIUM”. However, in the process of registration of the said trademarks, the Plaintiff discovered that a prior registration of its mark, “INTEL” had been obtained in the name of the 1<sup>st</sup> Defendant and registered as No. 52322 in class 9 on 30 January, 1991 without the Plaintiff’s prior authorisation and or consent.

The registration of the trade mark, “INTEL”, by the Plaintiff was rejected by the 2<sup>nd</sup> Defendant (who is the Registrar of Trade Marks) because of the fact that the 1<sup>st</sup> Defendant had effected the registration of the said Mark, “INTEL” under Class 9 with Registration No. 52322. The Plaintiff therefore sought for an order that the said mark, “INTEL”, which was a product of the 1<sup>st</sup> Defendant was falsely entered in the Trade Mark Register and that it ought not be so included as it constituted fraud and that it should be so rectified. It was held that the effect of a valid registration on trade mark is to give the proprietor the statutory right to use the mark exclusively when trading.<sup>340</sup> It was further held that the 1<sup>st</sup> Defendant is entitled to its Trade Mark, “INTEL” being the first to have it registered in Nigeria and that the Registrar can decide to register such marks even if they are similar but such acceptance would be subject to restrictions, if there are any, as may be imposed.<sup>341</sup>

In addition to proprietors having the right to register trademarks in Nigeria, accreditation agencies are also allowed to register trademarks. Accreditation is a mandatory process for law firms, stakeholders and potential registrants that may wish to act as agents.<sup>342</sup> Accreditation therefore, helps to identify a legal practitioner or agent in the area of Industrial Property Registrations.<sup>343</sup> The accreditation agencies are regarded as being agents of the Registry. An accredited agency gives an edge over the attorneys and stakeholders that are not accredited. Therefore, being such an agent has the following benefits though not limited to:

1. Having access to the online services
2. The ability to file from any location in Nigeria
3. Being able to make payment at any designated bank; and
4. Online payment.<sup>344</sup>

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<sup>340</sup> Section 5(1) NTMA, Cap.T13, Laws of the Federation 2004

<sup>341</sup> Section 13(2) NTMA, *ibid*.

<sup>342</sup> Trademark Registration in Nigeria (all Your Questions Answered in a Simple Way) - Business- Nairaland. Retrieved September 6, 2013 from [www.nairaland.com/154450/trademark-registration-nigeria-all-questions](http://www.nairaland.com/154450/trademark-registration-nigeria-all-questions)

<sup>343</sup> *Ibid*.

<sup>344</sup> Trademarks, Patents and Designs Registry, Commercial Law Department/ Federal Ministry of Trade and Investment. Retrieved September 6, 2013 from [www.iponigeria.com/site/a86f6?main=a14fe&sidemenu=a14fe](http://www.iponigeria.com/site/a86f6?main=a14fe&sidemenu=a14fe)

To curb the hassles of manual processing of applications, electronic payment and filing was introduced and this can be done through the local intellectual property agents.<sup>345</sup>

## **2.9. Procedure of non-registration of trade mark**

Where a trademark will not be registered, there are different procedures which must be followed by the Registrar and which will be discussed below:

### **2.9.1.1. Acceptability or refusal of the trade mark registration**

Where the registration of a mark is refused by the Registrar, the applicant must be informed in writing the reasons why such application was refused. Where the acceptance is based on conditions, the applicant must be brought abreast and the Registrar would have to state the reasons how he arrived at such decisions. It must however be noted that the decision of the Registrar on the application is based on the facts as presented before him and not by any other means.<sup>346</sup> In cases where the applicant is not satisfied with the decision of the Court, he may appeal. The Court may hear the appeal if there is any need to do so. The Registrar has the discretion to decide, whether or not, such application should be accepted and if so, it must adhere to due process and be in the prescribed form.<sup>347</sup> The special leave of Court might be necessary to hear the applicant and the Registrar on an appeal which would be determined whether or not, such will be accepted, subject to conditions or as the case may be.<sup>348</sup> In the advent that new grounds are included in the application without the knowledge of the party affected, such matter can be abandoned without paying any cost as to the notice in any prescribed manner.<sup>349</sup> That is to state that, documents pleaded must be the same and should not be different from what has been filed without the special order of the Court.<sup>350</sup> If there are any mistakes on the Register, it is only the authorized persons that have the right to effect such changes. Such changes may therefore, be amended by the Registrar or the Court, or it could even be by the applicant, who is given special permission to amend the application, as the case may be.<sup>351</sup>

### **2.9.1.2. Identical Trade Mark**

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<sup>345</sup> Ibid.

<sup>346</sup> Section 18 (4) NTMA, Laws of the Federation 2004

<sup>347</sup> Section 18 (5) NTMA, *ibid.*

<sup>348</sup> Section 18(6) NTMA, Laws of the Federation 2004

<sup>349</sup> *Ibid.*

<sup>350</sup> Section 18(6), NTMA, *ibid.*

<sup>351</sup> Section 18(7) NTMA, *ibid.*



A mark may be refused on the ground that it is identical with a trade mark and already on the register but belonging to a different proprietor.<sup>352</sup> In *Fuji Trading Company v. Registrar of Trade Marks*,<sup>353</sup> the Registrar refused to register a mark submitted by the appellant company because it closely resembled a registered trade mark relating to the goods of the same description. The Registrar was of the view that the resemblance in style in which the letter ‘R’ was portrayed was crucial to the case at hand. The Lagos High Court held that the Registrar had properly exercised his discretion in distinguishing the style of letter ‘R’.

Similarly, in *G. Gottschalk & Co. Ltd. v. Spruce Manufacturing Co. Ltd.*,<sup>354</sup> the appellants were the registered proprietors of a trade mark which they have applied for years to textile piece goods manufactured for sale in Nigeria. The appellant’s trade mark is a hand. The respondents also manufactured piece goods for sale in Nigeria and their trade mark also has a hand as the principal feature. In each case, the trademarks had other features which were different. The appellants sought by this action an injunction to restrain the respondents from continuing to infringe their trademarks and claimed damages. The trial judge dismissed the action as he held that the difference between the two marks was clearly apparent. The Supreme Court further held that the distinctive and characteristic feature of both marks was the hand, and the respondents’ adoption of the symbol of the hand which was the principal feature of their mark was calculated to mislead purchasers. The appeal was allowed and an injunction was granted.

### **2.9.1.3. Refusal to Register by the Registrar**

The Registrar can refuse to register any application made by different persons if such goods are similar or closely resemble goods to existing earlier marks on the register. Such applications will continue to be refused until the rights of the parties have been decided by the court or approved by the Registrar in any given circumstance.<sup>355</sup> In *Kai IT Battery Factory v. Registrar of Trademarks*,<sup>356</sup> the Applicant applied to the Registrar for registration of its mark consisting of “Three Tigers” and device but it was refused because it looked like an existing trade mark which consisted of “Three Cats”. The Registrar’s opinion was that the resemblance was too close and hence, it had the mark of deception. To determine whether

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<sup>352</sup> Section 13(1) NTMA, *ibid.*

<sup>353</sup> (1960) L.L.R. 50

<sup>354</sup> (1956) 1 F.S.C. 42, Volume 1

<sup>355</sup> Section 13(3) NTMA, *op.cit.*

<sup>356</sup> [1917-1976] 1, I.P.L.R. 179

there has been an opposition, the Court will consider whether the new mark is closely identical to the existing one as to mislead the average man.<sup>357</sup> The Court gave judgment that Section 25 did not apply and held that the registration of the “Three Tigers” should proceed, despite the prior registration of the “Three Cats.”

#### **2.9.1.4.Disclaimer for purposes of Registration**

There may be instances whereby a trade mark may not be registered if a part or fraction of it cannot be registered separately by the proprietor or it comprises of substance which is familiar to the trade or it could include a mark that is not distinctive to the mark in any way.<sup>358</sup> Hence, a criteria for the registration of a trade mark is that it must be distinctive.<sup>359</sup> Where this arises, the Registrar or the Court, would determine on its own merit if it will be better to include the trade mark on the Register subject to the following reasons:

- (a) That the proprietor should state categorically that such mark will not be partially or totally used when trading and the Court must ensure that the owner has complied in not using the mark. In other words, the owner will be estopped from using a mark to which he is not entitled to use whether exclusively or otherwise; or
- (b) That the proprietor shall make other renunciation as the Court may consider expedient for the purposes of his ownership rights when registering.<sup>360</sup>

Thereby, it is apt to state that the right of the proprietor to enjoy his mark will not be affected unless there is a disclaimer in the registration of the said mark. Such will only arise if the above issues were to arise. Thus, where a proprietor has a registered mark in the register, a disclaimer will not affect any rights except where such disclaimer has been made in the initial stages of registering the trade mark by the proprietor.<sup>361</sup>

#### **2.9.1.5.Publication on Notice of Application**

An entry will be made by the Registrar in the Trade Mark Journal when all the requirements necessary for the registration of a mark has been duly established.<sup>362</sup> The information will be made known to the public so that if there are complaints, such will be brought to the attention

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<sup>357</sup> Section 25, NTMA, Laws of the Federation 2004

<sup>358</sup> Section 15, NTMA, *ibid.*

<sup>359</sup> Section 9, NTMA, *ibid.*

<sup>360</sup> Section 15, NTMA, Laws of the Federation 2004

<sup>361</sup> Section 15, NTMA, *ibid.*

<sup>362</sup> Sections 19(1) and 63 NTMA, *ibid.*

of the Trade Mark Office.<sup>363</sup> Where notice of the application has been made known to the public, and the mark is finally accepted, the Registrar may publish in the Journal once again but in this case, he is not really bound to do so.<sup>364</sup> It will however be the duty of the Registrar to insert a notice in the Gazette stating the scheduled dates in which such publications would feature in the Trade Mark Journals.<sup>365</sup> Hence, all accepted registrations of trademarks are to be published only in the Trade Marks Journal and not in any other medium like the newspapers or the official gazette but it is vital to state that they must fall under Part A or Part B of the register.<sup>366</sup>

Where the Trade Marks Journal is printed but not published, the application would be considered obsolete and unusable. So, the Court makes provision for this and states that where publications are deemed to be unusable, they should be discarded and fresh notices made available as soon as possible.<sup>367</sup>

#### **2.9.1.6. Opposition to Registration**

Where a trade mark has been accepted and published in the Trade Mark Journal, any person who has any complaint can give notice of his intention to oppose the application within two (2) months to the Registrar.<sup>368</sup> A person who has been given the right to file, must state such in writing and should also include a declaration and the reasons why he/she is opposing the application.<sup>369</sup>

Thereafter, the duplicate of the opposition notice will be sent to the applicant and within one month of its receipt, a reply should be sent to counter-act what had been initially stated by the person challenging the application. The counter-statement will include the justifications on which the application would be relied upon but where no grounds are stated, it will be treated as having been cancelled and the case would end there.<sup>370</sup> In other words, an opposition to

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<sup>363</sup> Sections 19(1) and 63, NTMA, *ibid.*

<sup>364</sup> Section 19 (3), NTMA, *ibid.*

<sup>365</sup> Section 19(1) NTMA, *ibid.*

<sup>366</sup> Shyllon, F. 2003. *Intellectual Property in Nigeria. Studies in Industrial Property and Copyright Law.* Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich. Volume 21

<sup>367</sup> Section 19, NTMA, *ibid.*

<sup>368</sup> Section 20(1) NTMA, *op.cit.*

<sup>369</sup> *Beecham v. General Nutrition* (Unreported) case FHC/L/IA/90

<sup>370</sup> Section 20 (3), NTMA, Laws of the Federation 2004

registration, will be said to have been abandoned where the applicant does not proceed with the matter.<sup>371</sup>

After the applicant has submitted the necessary documentation to the Registrar, a photocopy would be sent to the persons opposing, and there shall be a hearing of the parties, if expedient, to determine whether or not, such a registration is deemed to be approved or whether it ought not be allowed to go any further.<sup>372</sup> It is pertinent to note that any person that is opposing the application and the individual who is applying for the registration of the trade mark may be entreated by the Registrar to put down some form of collateral which will be used to secure any payment to the Court if either party loses. However, where there is no guarantee as to the payment of costs provided by either party, then, it is deemed that the application has been discarded and therefore, the suit will end there and all matters stopped.<sup>373</sup>

Where there is a request by the party to a suit to appeal on the matter, or if it is by an order of the Court, any other information which is crucial and beneficial to the case may be brought forward for further assessment by the Court.<sup>374</sup> Any further facts therefore, apart from the initial one brought by the applicant has to be done only with the leave of Court and not otherwise.<sup>375</sup> Where the Court is satisfied upon the hearing of the application, it would go ahead and allow the recommended but proposed trade mark to be so registered. However, as a prerequisite for a mark being registered, it may be modified but whatever change is made on it, will not affect any substance as to its uniqueness. Once accepted, it will be published in the Journal, and advertised to the public so that if there are irregularities as to the use of such mark(s), the person or persons affected, may proceed to the Trade Mark Office.<sup>376</sup> The Court may also require in this instance that an appellant should put down money, property to act as a bond so that if the plaintiff loses, the security would be used to secure payment of Court costs. Where the plaintiff does not pay, or does not make any appearance, then, the case will be treated as having been set aside and the proceedings will not go on as planned.<sup>377</sup>

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<sup>371</sup> Section 20(3) NTMA, *ibid.*

<sup>372</sup> Sections 20(4) and 21(1) NTMA, *ibid.*

<sup>373</sup> Section 20(5) NTMA, *ibid.*

<sup>374</sup> Section 21(3) NTMA, *op.cit.*

<sup>375</sup> Section 21(4) NTMA, *ibid.*

<sup>376</sup> Section 21(5), NTMA, Laws of the Federation 2004

<sup>377</sup> Section 21(6) NTMA, *ibid.*

*Phillip Morris v. Brown & Williamson & Anor.*,<sup>378</sup> is an appeal against the decision of the Registrar. The Appeal was lodged by Phillip Morris Incorporated, who raised opposition to the registration of “Choice Ultra Lights” presented by the Respondents for registration, Brown & Williamson Tobacco Corporation (Export) Limited. The Respondents made an application to the Registrar of Trade Marks on 8 January, 1980 to register “Choice Ultra Lights” in Class 34 in their name. The Mark was accepted and published in the Trade Marks Journal. The Appellant, that is, Phillip Morris Incorporated, filed a Notice of Opposition. Arguments were heard for and against the registrations with each argument supported by a Statutory Declaration by the Registrar and judgment given. The opposition was rejected and the appellant appealed.<sup>379</sup>

It was held by the Court that the immunity referred to by the Registrar is that once a trade mark is registered, the same name cannot be registered for another person even if it is in the same category as the initial mark. Where the Registrar is of the view that such similar marks would not confuse or deceive either by the nature of the goods, he has the discretion therefore, to accept the later application and register it under any conditions or limitations that will be considered justifiable. Also, where two marks are merely descriptive and there is no likelihood of deception, the Registrar is legally entitled to register the second mark. The Act therefore permits the Registrar to allow two proprietors to register the same mark in relation to an article with which both proprietors are connected in the course of trade.<sup>380</sup>

In *Ferris George v. John Walkden*,<sup>381</sup> the Applicant sought to register a device of a Ram as a Trade Mark in classes 33 and 48 of the International Classification of Goods adopted under national laws of member countries. Class 33 comprised yarns of wool, worsted or hair while Class 48 comprised of perfumery, that is, toilet items, toothpaste, hair items and perfumed soap. The Opponents owned a Ram device mark registered in other classes apart from Classes 33 and 48. The Opponents objected to the registration on the ground that the Mark is similar to their registered trade mark and it was held that where a trade mark is the same with that of another mark, there is the possibility that consumers will be misled into thinking that it is the goods of the original proprietor. A trade mark will therefore not be registered if there is similarity between goods of the same category even if such items are in the prescribed class

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<sup>378</sup> [1977-1989] 2, I.P.L.R. 215

<sup>379</sup> Ibid. at p. 215

<sup>380</sup> Section 64, NTMA, Cap. T13, Laws of the Federation 2004.

<sup>381</sup> [1917-1976] 1, I.P.L.R. 16-28

or classes. However, where a similar mark, is sought to be registered in respect of goods of different description, it may be registered. Therefore, the opponents had registered in Class 38, a Mark for goods manufactured from India rubber *orgutta percha* and the Applicants sought to register in Class 40, a similar mark for boots and shoes made wholly or partly of India rubber and also in the same class for India rubber footwear.<sup>382</sup>

Under the Trade Mark Law, there is a duty on the applicant to prove intention to avoid deception. In *Azonobi v. Arthur Buchting (Nig.) Ltd.*,<sup>383</sup> the Plaintiff, a shoe dealer and the registered proprietor of a trade mark known as “SAC” was registered in 1962. Prior to the registration in 1962, the Plaintiff had been buying SAC shoes through the United Trading Co. which ordered these shoes directly from the manufacturers, *Societe Anonyme des Chaussares*, a shoe manufacturing company in France. The word “SAC” represents the first letters of each of the words which make up the name of the manufacturers and to the Plaintiff’s knowledge is also the registered trade mark of the French company in France. The Defendant on the instructions of its principal ordered a shipment of 180 pairs of SAC shoes from Liberia and sold same to several persons including one of the Plaintiff’s customers. The Plaintiff thereby instituted an action against the Defendant claiming damages for infringement, injunction and passing off. A salient test that must be passed is that for a mark to be registered, it must depict uniqueness and the ability to distinguish the product of one person from those of other persons that are selling within the same category of goods so that confusion will be minimised.

## **2.10. The Trade Marks Register in Nigeria**

The trade marks register in Nigeria has various components which include:

Rectification and Correction of the Register

Removal from the Register for Non-use

Removal from the Register for Non-Compliance

### **2.10.1. Rectification and Correction of the Register**

This is provided for under the Trade Marks Act. Rectification includes expunging, varying, striking out, or otherwise altering the entry in the register. In *Wholesale Colonial Trading*

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<sup>382</sup> Ibid.

<sup>383</sup> [1917-1976] 1, I.P.L.R. 142

*Company v. Ikorodu Trading Company*,<sup>384</sup> the plaintiff, Wholesale Trading Company sued the defendants, the Ikorodu Trading Company in connection with the plaintiff's registered mark, "Oridara" in regard to razor blades bearing the word, "Orida" sold by the defendants. The defendant's sued the appellants claiming that Oridara be expunged from the Register as not being registrable. The two suits were consolidated and judgment was that Oridara be expunged. It was agreed that the marks were so similar as to make the consumers confused. The court further stated that prior to Oridara, and for many years, there was a wide user of Orida signifying razor blades. The court however concluded that in the view of similarity of the two marks, "Oridara" would be calculated to deceive.<sup>385</sup>

In *Procter and Gamble Ltd. v. Global Soap and Detergent Industries Ltd.*<sup>386</sup> the court held that the application for rectifying the Register must be accompanied by a statement setting out the nature of the applicant's interest, the facts upon which he has based his case, and the relief which he seeks on the issue at hand.<sup>387</sup> In *Messrs. Societe Anonymede DeVente v. Amodu & Anor.*,<sup>388</sup> the Applicants in this case applied to register their trade mark in respect of footwear wherein the Registrar of Trade Marks refused their application based on the fact that there was an existing mark similar to the goods that is being proposed to be registered. An appeal was brought before the Court because of the Applicant's dissatisfaction with the decision of the Registrar.<sup>389</sup> The Registrar objected to the jurisdiction on the ground that the application brought by the applicant was wrongly brought under Section 42(1). Upon determination, it was held that the Court has jurisdiction to entertain the application of an aggrieved person whether or not any entry was wrongfully imputed in the register. The section therefore enables the Court to decide any question necessary for rectification of the register.<sup>390</sup>

### **2.10.2. Removal from the Register for Non-Use**

The Registrar or the Court has the discretionary power to remove a registered trade mark from the register for non-use at the request of any person concerned if it can be established that it was registered without any real intention for the mark to be used and that it had not

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<sup>384</sup> (1944) 10 W.A.C.A. 67

<sup>385</sup> (1944) 10 W.A.C.A. 67

<sup>386</sup> [1977-1989] 2, I.P.L.R. 472

<sup>387</sup> See Section 42(1) and (2) NTMA, op.cit.

<sup>388</sup> [1917-1976] 1 I.P.L.R. 117

<sup>389</sup> Section 42(1), NTMA, ibid.

<sup>390</sup> Section 42(1), NTMA, op.cit.

been used one month before the application date or not using the mark during the continuous period of five years when the trade mark registration was applied for.<sup>391</sup> In *Bethlehem Knitting Factory v. Registrar of Trade Marks*,<sup>392</sup> the court held that there was evidence that the mark had not been used ever since it was registered in 1966. For that reason, the mark was expunged from the Trade Mark Register because it was obvious that the owner had not used the mark and also that, there was no genuine intention for the use of the mark in the first place.<sup>393</sup> Another case which was expunged for non-use is *John Batt & Co. v. Dunnet & Anor.*,<sup>394</sup> whereby the mark was removed from the register because it had not been in use for seventeen years. Where however, a long period of non-use is interrupted by some form of use on the proprietor's or licensee's part, such use must be *bona fide*, that is, the proprietor must have the real intention to use the mark.<sup>395</sup>

In *Zeneca Ltd. & Ors v. Jagal Pharma Ltd.*,<sup>396</sup> the Respondent claimed a declaration that they had been the lawful user of the mark, "Tetmosol" in Nigeria at all material times and as such, sought an Order to remove the mark, Tetmosol, from the Register for lack of bona fide use by the 1<sup>st</sup> Defendant. In reaction to the claim, the Defendants/Appellants filed a joint Statement of Defence and Counter-claim against the Plaintiff/Respondent. The relief sought by the counter-claim was for an injunction to restrain the plaintiff from infringing the 1<sup>st</sup> defendant's registered trade mark. The learned judge granted all the reliefs in the Statement of Claim and dismissed the Counter-Claim of the Appellants. The Appellants, who were the defendants at the lower court were aggrieved and appealed. On appeal, it was held that the lower court was wrong when it removed the trade mark, 'Tetmosol' from the register and rectified same in favour of the Respondent. It was further held however, that an appellant cannot raise a point or issue that was not raised or canvassed by the trial court without the appeal of the Appeal Court.<sup>397</sup> It was held by the court that evidence must be adduced when a trade mark is being removed from the Register. The burden is on the person who must show that at the time such an application was made, there was no intention of its use by the Respondent in relation to the goods for which the registration was made. Hence, the fact that a proprietor has not used the mark for 5 years which is the time required by the law in such cases must be supported by

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<sup>391</sup> *In Procter and Gamble v. Global Soap* (1989) F.H.C.L.R. 357

<sup>392</sup> (1983) F.H.C.L.R. 181

<sup>393</sup> Section 31, NTMA, *ibid.*

<sup>394</sup> [1899] A.C. 428

<sup>395</sup> Oyewunmi, A.O., *Op.cit.* at p. 260

<sup>396</sup> [2003-2007] 5 I.P.L.R., p. 385

<sup>397</sup> [2003-2007] 5 I.P.L.R., p. 412



vital evidence.<sup>398</sup> However, for the 5 years to have lapsed, there must be evidence that it was continuous. Hence, there must not be a break, it must be uninterrupted, then, can it can be said that the person did not have any intention to use the mark for any business venture whatsoever.<sup>399</sup> A mark so removed from the register for non-use would result in zero application for registration of the mark and would not be accepted for one year following the date of removal.<sup>400</sup>

### **2.10.3. Removal from the Register for Non-Compliance**

The Registrar has the discretionary power to issue statutory notice to the proprietor so that the renewal fees may be paid and it is issued at a date not less than one month and not more than two months before the registration of the previous payment expires. Where no renewal fees has been paid, it is the duty of the Registrar to notify the proprietor of the impending expiration. The Registrar would issue a second statutory notice if the owner of the mark, defaults in his renewal payment and this should not be less than 14 days but it is expected that it must not extend more than one month before the expiration of the registration. Where the registration has expired, the Registrar must advertise the mark for non-renewal in the *Trade Marks Journal*. If the renewal fee is however received within the one month statutory notice, after the advertisement, the mark may be renewed. The Registrar reserves the right to remove a mark from the register after a month has lapsed due to the non-payment of renewal fees and the time starts to count from the date in which the last registration came to an end.<sup>401</sup> There must be a record of such removal and the reasons why it was so removed, must be entered into the register by the Registrar. The next step is that after the removal from the register, the proprietor can, upon payment of such renewal fees, apply for the mark to be restored on the register.<sup>402</sup>

A trade mark registration is valid for 7 years and renewable from time to time for a further period of 14 years. To apply for renewal therefore, it must be done three months before registration expires or the last renewal as the case may be.<sup>403</sup>

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<sup>398</sup> Section 31 (2) NTMA, op.cit.

<sup>399</sup> Section 31 (2) (b) NTMA, ibid.

<sup>400</sup> Section 31, NTMA, ibid.

<sup>401</sup> Shyllon, F. 2003. *Intellectual Property in Nigeria. Studies in Industrial Property and Copyright Law*. Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich. Volume 21, p. 207

<sup>402</sup> Ibid.

<sup>403</sup> Section 23, NTMA, Cap. T13, Laws of the Federation, 2004

## **2.11. Process of Registration in United Kingdom**

The owner of a trade mark under the United Kingdom is the person who registers it.<sup>404</sup> However, a potential problem that arises under UK law is the exploitation of a trade mark when the mark is owned by two or more parties. It may be exploited in different ways such as by assignment, licenses, mortgages, operation of law, testacy or through bankruptcy.<sup>405</sup>

Where therefore, a registered trademark is granted to two or more people jointly, each of the co-owners will be entitled to an equal undivided share in the trade mark registration.<sup>406</sup> In other words, each owner will be entitled to do as he likes the trade mark and need not ask for the permission of the other co-owners to use the trade mark, any act which could amount to an infringement of the registered mark.<sup>407</sup> Notwithstanding, the power of the co-proprietor is limited because the consent of the other co-owners should be taken into consideration because without the consent of the other co-owner or owners as the case may be, the joint owner would not be able to license the other co-owners to use the trade mark.<sup>408</sup>

An essential requirement that a sign must satisfy in order to be validly registered (or if it is already registered) in the United Kingdom is to ensure that it conforms to the definition under the UKTMA.<sup>409</sup> Registration procedure in the UK is very strict. For instance, if a mark is incorrectly registered, the registration of the mark may be declared invalid under section 47 (1).<sup>410</sup> Failure to comply with the requirements in registering the mark is that the sign will fall under absolute ground for refusal under the Act.<sup>411</sup> Hence, for all trade mark prerequisites, there must be in existence, a sign, which must be capable of being characterized vividly and also, able to distinguish the goods or services of one undertaking from those of other undertakings as illustrated under the UKTMA.

### **2.11.1. Evidence of a sign**

Under the UKTMA, for a trademark to be registered, it is essential to show that the mark consists of a 'sign'. The UKTMA provides a list, though not conclusive, of the marks which

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<sup>404</sup> Bently, L. and Sherman, B., op.cit at p. 1096

<sup>405</sup> Section 24(1) UKTMA, Cap. 26, 1994

<sup>406</sup> Section 23, UKTMA, Cap. 26, 1994

<sup>407</sup> Section 23(3), UKTMA, ibid.

<sup>408</sup> Section 23(4) UKTMA, ibid.

<sup>409</sup> Section 1(1) UKTMA, ibid.

<sup>410</sup> Section 47 (1) UKTMA, Cap. 26, 1994

<sup>411</sup> Section 3 (1) (a) UKTMA, ibid.

can be registered and may be protected as trademarks.<sup>412</sup> A sign, under the UK law, has a broad connotation but this is not without limits. The Court of Justice (which has the same equivalent with the Supreme Court in Nigeria) has indicated in two cases that a sign will be refused if it is not for the purposes of trade mark law. In *Heidelberger Bauchemie*, the Court held that colour is considered a property or characteristic of a thing and that in order to prevent trade mark law from being used by one trader to obtain an unfair advantage over other traders, an applicant for a colour mark must establish that visually, it is seen as a ‘sign’.<sup>413</sup>

In *Dyson Ltd. v. Registrar of Trade Marks*,<sup>414</sup> there was an attempt to register as a trade mark, a transparent collection bin on a vacuum cleaner. The Court of Justice held in this case that it was mere property of the product and the protection of anything so unspecific would provide an unfair advantage to the trader who registered it, simply because he would be able to prevent other manufacturers from selling vacuum cleaners with transparent collection bins. The application was further held not related to the concept of ‘sign’. The Court on the issue of defining what the concept of a ‘sign’ entailed, reversed earlier cases on the attempt to register combination of colours. For instance, in *Nestle v. Cadbury*,<sup>415</sup> the court reversed the decision of the UK Trade Marks Registry and held that Cadbury’s application for the purple colour which was the predominant colour applied to the whole visible surface of the packaging of goods and it should not have been accepted because it referred to a ‘multitude of permutations, presentations and combinations of the subject matter of the registrations’. Also, another reversal came about in the case of *Spear v. Zynga*,<sup>416</sup> where the Court invalidated the registration of a three-dimensional ivory-coloured tile on the top surface and held that it potentially covered many signs. In other words, the sign must be distinctive and must relate to the packaged product itself.

### **2.11.2. Graphical representation**

The test for registration is that there must first of all, be a sign, which should be capable of being represented graphically and thirdly, the ability to be able to distinguish one undertaking from those of other undertakings.<sup>417</sup> The above-mentioned criteria must be carried out before

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<sup>412</sup> Section 1, UKTMA, *ibid*. See Bently, L. and Sherman, B., *op.cit* at p. 913

<sup>413</sup> Case C-49/02 [2004] ECR I-6129

<sup>414</sup> C-321/03 [2007] ECR I-687

<sup>415</sup> [2013] EWCA Civ. 1174, reversing [2012] EWHC 2637 (Ch.)

<sup>416</sup> [2013] EWCA Civ. 1175, [32], reversing [2012] EWHC 3345 (Ch.)

<sup>417</sup> Section 1, UKTMA, Cap. 26, 1994

a trade mark can indeed be registered. After all the requirements have been met, the applications will thereto be submitted to the Registrar for further processing.<sup>418</sup> Where the Registrar is satisfied, and there is no infringement of an existing earlier mark, the next step is the advertisement in the Trade Marks Journal. The importance therefore for advertising in the journal is to ensure that there is the non-existence of earlier marks which may lead to an opponent bringing an action against registering the mark. Advertising saves the time and expenses, or other unidentified factors which may arise as a result of marks being duplicated. Hence, the advantage of this journal is to educate the public of the marks that can be registered, and to ensure that it does not conflict with any other existing mark and also that, interested parties would not embark upon a difficult and expensive exercise to know the status of the mark that ought to be registered.<sup>419</sup>

### **2.11.3. Capacity to Distinguish**

The UKTMA provides that a sign must be differentiated from the goods or services of another.<sup>420</sup>

The core essence of trademark is that goods or services must be distinguished from one undertaking to other undertakings and even though the source of the product is unknown, the function will still be carried out as long as the public is able to distinguish between different goods that have been offered for sale. That is, the consumer might not know who the manufacturer is but they will be able to identify or associate the goods or services as that of a particular manufacturer.

Registering trade marks in the United Kingdom confers on the proprietor certain exclusive rights to use a particular sign in relation to specified commercial activities.<sup>421</sup> Traders are enabled to protect their marks through registration before they are displayed for purchase in the market place.<sup>422</sup> There are many advantages of registering a trade mark and an important reason is the fact that it confers on the owner, the assured right to use the product in a specified region. Hence, to ensure that there is no duplicity of marks, there is a trade mark register which serves as a mode of information to the public, and at the same time, assists in

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<sup>418</sup> Section 32(1) UKTMA, *ibid.*

<sup>419</sup> Bainbridge, D. *op.cit.* at pp. 705-706

<sup>420</sup> Section 1(1), UKTMA, Cap. 26, 1994

<sup>421</sup> Bently L. and Sherman, B. *op.cit.* at p.925

<sup>422</sup> *Ibid.* at p.925.

procuring evidence.<sup>423</sup> In the filing of applications for registering a mark, the proprietor can use attorneys that are specialized in that field for the processing.<sup>424</sup>

## **2.12. Procedure for registration**

The Comptroller-General, otherwise known as the Registrar is charged with the duty of registering industrial property rights in the UK.<sup>425</sup> In order to fall within the requirements above, the process for registration of a trade mark is divided into four steps. They include filing of the application, examination, publication (observation, opposition), and registration.<sup>426</sup>

### **2.12.1. Filing of the application**

Under UKTMA, any person or a legal entity can apply for the registration of a trade mark. The following information must be given to the Registrar before further steps can be taken. The first is that the applicant must indicate an interest to register a mark;<sup>427</sup> then, the personal details of the registrant should be indicated on the application form.<sup>428</sup> A detailed statement of such goods or services that is to be registered should be so stated.<sup>429</sup> It is to be noted that the mark that seeks to be registered must also be represented;<sup>430</sup> and finally, the applicant should declare that there is a bona fide intention for the mark to be used and that indeed, the mark will be used for the purposes for which it is registered in the first instance.<sup>431</sup>

Under this head, a filing of the application is sub-divided into sections and they are grouped into Statement or Specification in relation to the goods or services; Classification; Representation of the sign(s), which consists of the shape and appearance of products, colour, smell, sound, tastes, etc.

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<sup>423</sup> Ibid. at p. 887. This is under Section 63(3) (a) UKTMA, Cap. 26, 1994. See Burrell, R., "Trade Mark Bureaucracies", in Dinwoodie, G. and Janis, M. (eds), 2008. *Trademark Law and Theory: A Handbook of Contemporary Research*, ch. 4.

<sup>424</sup> Ibid.

<sup>425</sup> Section 62, UKTMA, *ibid.*

<sup>426</sup> Bainbridge, D.I. 2012. *Intellectual Property*. *Op.cit.* at p. 701

<sup>427</sup> This is provided for under Section 32(2)(a) UKTMA, Cap. 26, 1994

<sup>428</sup> Section 32(b), UKTMA, *ibid.*

<sup>429</sup> Section 32(2) (c) UKTMA, *ibid.*

<sup>430</sup> Section 32(2) (d), UKTMA, *ibid.*

<sup>431</sup> Section 32 (3), UKTMA, *ibid.*

### 2.12.2. Statement or Specification of the goods or services

In a trade mark application, the list of goods and services that protection is being sought for, must be detailed so that they can be adequately classified into the required class under the Nice Agreement.<sup>432</sup> In *CIPA v. Registrar of Trade Marks (IP Translator)*,<sup>433</sup> the Court of Justice indicated that the specification must be formulated with sufficient clarity and precision to enable the relevant competent authorities and economic operators to be able to determine, on the basis alone, the extent of protection sought or conferred. The idea behind the specification is that it must not be broad but must be confined to the goods or services for which the registrant can demonstrate actual use.<sup>434</sup>

In addition, in *Postkantoor*,<sup>435</sup> the Court further stated that the national registries may not accept marks subject to the condition that they do not possess a particular characteristic, such as allowing “Penguin” for books (other than books about penguins). This was said to be because third parties would not be aware of the condition and might refrain from selling goods under the mark. The distinction appears not to be one between defining categories positively or negatively but between characteristics and subcategories.<sup>436</sup> A subcategory is defined by an indication to the description or a suggestion to the purpose, or function of the commodities, which could either be goods or services whilst a characteristic pertains to some specific quality or feature that can be present or not without altering the nature or its purpose.<sup>437</sup> A specification for luxury shoes or shoes other than luxury shoes would be impermissible as referring to style or quality.<sup>438</sup> However, children’s shoes would be allowed, because children’s shoes identifies features of size, that is, nature, purpose, and function and dress shoes would also be permitted for similar reasons.

### 2.12.3. Classification

Goods and services are classified for the purposes of registration of trade mark under the Nice Agreement according to a prescribed system, which member countries adhere to.<sup>439</sup> There are thirty-four recognized classes of goods and also, eleven classes of services, which

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<sup>432</sup> Bently, L., and Sherman, B., op.cit. at p. 890

<sup>433</sup> Case C-307/10 (19 June 2012) (ECJ, Grand Chamber), (49), [64]

<sup>434</sup> Ibid.

<sup>435</sup> (Case C-363/99) [2004] ECR I-1619

<sup>436</sup> Ibid.

<sup>437</sup> *Omega Engineering Inc. v. Omega SA* [2012] EWHC 3440 (Ch.) (Arnold J)

<sup>438</sup> *Croom’s Trade Mark Application* [2005] RPC(2) 23

<sup>439</sup> See Section 34, UKTMA, Chapter 26, 1994

are independent of each other but are adapted to by the United Kingdom.<sup>440</sup> An applicant has to be precise and needs to name all the goods and services from the onset for the purpose of the registration because amendment is only allowed to clarify or narrow the specification.<sup>441</sup> In registering, it is permissible for an application to relate to a number of classes and hence, the purpose of classification process is simply to facilitate searching for earlier competing marks.<sup>442</sup> The applicant will often have to specify the goods or services within a class for which registration is sought.<sup>443</sup>

The Registrar therefore has the final power to decide the class for which particular goods or services are to be changed but not to change the class number. The class number can only be changed when there is an obvious mistake.<sup>444</sup>

#### **2.12.4. Representation of the sign**

Before an application is accepted, the trade mark applicant is required to provide a representation of the sign and must ensure that the representation is adequate. The representation of registration means that rather than depositing an actual sample of the mark, applicants are required to deposit a representation of the mark.<sup>445</sup> This has a number of functions. The first function is to define the scope of the trade mark's owner's rights and delineate with a degree of precision what sign is exactly protected. A second function is in respect of advertising to the public that the applicant is seeking registration and this will be published in the *Trade Marks Journal*.<sup>446</sup> This helps to ensure that third parties, who may wish to register a mark, are able to ascertain the scope of existing marks and to be able to determine whether a fresh application is able to conflict with earlier marks.<sup>447</sup> A third and related function of graphic representation<sup>448</sup> is to make the bureaucratic dealing with the sign which ensures that its classification and comparison with other signs is more manageable. Despite the fact that each function demands different things, and for a graphic representation to be adequate, all the three goals must be adhered to. In *Ralf Sieckmann*,<sup>449</sup> it was held by the

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<sup>440</sup> Cornish, W. and Llewelyn, D., op. cit. at pp. 679-680

<sup>441</sup> Section 39(2) UKTMA, *ibid.*

<sup>442</sup> *Cal-U-Test Trade Mark* [1967] FSR 39, 44. Cornish, W. and Llewelyn, D., *ibid.* at pp. 679-680

<sup>443</sup> Cornish, W. and Llewelyn, D., *ibid.* at p. 679

<sup>444</sup> *Ibid.*

<sup>445</sup> Bently, L. and Sherman, B. op.cit. at p. 892

<sup>446</sup> This is similar with that of Nigeria that also publishes those who have registered in the Trade Marks Journal

<sup>447</sup> Bently, L. and Sherman, B., op.cit at p. 892

<sup>448</sup> *Ibid.*

<sup>449</sup> Case C-273/00 [2002] ECR I-11737 (ECJ) 888. Bently, L. and Sherman, B. *ibid.* at pg. 893

Court of Justice that a graphic representation is one that utilises images, lines or characters and that for a trade mark to be genuinely identified enough to be registered, it must not be deceptive but should be clear, easily accessible, unambiguous, durable, intelligent, and objective.<sup>450</sup> The question as to its objectivity of whether a mark is to be registered, would be difficult to determine if it does not fall within the above stated criteria. It was therefore held in *Libertel Groep BV v. Benelux Merkenbureau*,<sup>451</sup> that a representation was accessible and intelligible if it did not require excessive efforts to be taken for the public to understand it.<sup>452</sup> A number of techniques are used by applicants in representing their works graphically. These include words and images such as line drawings and photographs. It has however been observed that graphic representations can be difficult especially where it has to do with sounds, shapes, colours, smells, etc. This will be discussed below:

#### **2.12.5. Shape and appearance of products**

In identifying a mark, it would be necessary to include design drawings or photographs and with the growth of design variations as major keys to marketing success, the desire to protect them as trademarks has been strengthened. It is pertinent to note that all shapes must satisfy the general test of distinctiveness, under which inherent objections are balanced against evidence of use as an indication of origin. In other words, shapes, such as colour, patterning or smell, is not inherently distinctive as a mark but whatever form it takes, it will usually require considerable evidence of use before it can be registered.<sup>453</sup>

#### **2.12.6. Colours**

Prior to the current trademark legislation of trademark in the United Kingdom, colours were not registrable because technology was not advanced to enable colour marks to be reprinted in the Trade Mark Journal.<sup>454</sup> In *LibertelGroep BV v. Benelux-Merkenbureau*,<sup>455</sup> the applicant had sought to register the colour orange for telephone books in Class 9 and telecommunication services in Classes 35-38. While the Court accepted that simple colours could be represented graphically, it stated that an assessment was required in light of the facts of the case and the mode of representation proposed by the applicant as to whether the seven

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<sup>450</sup> This description is known as the *Sieckmann* Criteria

<sup>451</sup> Case C-104/01 [2003] ECR I-3793, [AG71]

<sup>452</sup> Bently, L and Sherman, B., *ibid.* at p. 893

<sup>453</sup> Cornish, W. and Llewelyn, D., *op.cit.*, at p.707. This means that the shape of whatever form must be in use before it is registered.

<sup>454</sup> Bently, L. and Sherman, B., *op.cit* at p. 895

<sup>455</sup> Case C-104/01 [2003] ECR I-3793



*Sieckmann* criteria<sup>456</sup> would be met. The Court held that a mere sample of a colour would not satisfy those requirements because the exact shade of colour on paper cannot be protected from the effects of the passage of time. The Court further held that a verbal description would also not normally satisfy the conditions but that it was necessary to decide whether a given description was satisfactory on the particular facts.

In *Heidelberger v. Bauchemies*,<sup>457</sup> the Court of Justice addressed the related issue of the graphic representation of two colours. The reference has to do with an application to register blue and yellow for different goods, such as, adhesives, solvents, paints, the application indicating that the colours would be used in every possible way. The Court further held that in the case of a sign consisting of two or more colours, designated in the abstract and without contours, a graphic representation would be sufficiently clear and precise only if the application specified that the colours would be arranged systematically by associating the colours to be used in a predetermined and uniform way.<sup>458</sup> Where on the other hand, there is mere unification of two or more colours, without shape or contours, or a reference to two or more colours in every conceivable form did not exhibit the qualities of precision and uniformity.<sup>459</sup> For colour to be registered therefore in the UK, it must be for the purposes of trademark law and it must be seen as a sign and must follow the *sieckmann* criteria.<sup>460</sup>

#### **2.12.7. Smells**

As mentioned earlier, it has been held in the Court of Justice that ‘smell’ will not be graphically represented by a verbal description because it will not be clear, precise or sufficiently objective.<sup>461</sup>

#### **2.12.8. Sounds**

In *Shield Mark BV v. Joost Kist*,<sup>462</sup> the Court considered the application of the graphic requirement in relation to sounds. The case concerned had to do with two marks: the first nine notes of the melody for Beethoven’s ‘Für Elise’ and the crowing of a cock, both for

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<sup>456</sup> The *Sieckmann* criteria states that the graphic representation must be clear, precise, easily accessible, intelligible, durable and objective

<sup>457</sup> Case C-49/02 [2004] ECR I-6129

<sup>458</sup> *Ibid.*

<sup>459</sup> See UK IPO. 2007. Graphical Representation. PAN 2/07, citing CTM No. 2177566

<sup>460</sup> Bently, L. and Sherman, B., *op.cit.* at p. 892

<sup>461</sup> *Ralf Sieckmann* Case C-273/00 [2002] ECR I-11737 (ECJ) 888

<sup>462</sup> C-283/01 [2003] ECR I-14313

advice and services in the field of intellectual property and marketing. It was however held that mere verbal description of sounds lacked clarity and precision.<sup>463</sup>

### **2.12.9. Tastes**

It was held by the Court in the instance the smells was not capable of being registrable. Recently, this has been held to be capable of being registered.

In addition to the procedure for registration in the UK, such an application for registration must contain a declaration that the mark is being used or that there is a real intention to use the mark.<sup>464</sup> This declaration is to warn the applicant that the register is to confer rights only on persons who genuinely intend to use the particular mark in trade and it is not to be used for mischievous applications by getting in the way of opponents thereby blocking registrations and neither is it to be used by non-existent persons or applications or ghost registrations.<sup>465</sup> Under the UK law, it is possible to save costs by registering a series of marks in a single registration all at the same time and hence, the application should include a separate representation of each mark in the series.<sup>466</sup>

### **2.12.10. Examination**

The Registrar conducts a search after the filing process has been completed. The Registrar upon examination of the application has to ensure that the proposed mark satisfies various requirements set out in the Act.<sup>467</sup> Where the Registrar upon examination finds the application faulty, the applicant is expected to respond to the objection. If the applicant fails to do so, the application will be refused.<sup>468</sup> If there are no valid objections to the application by the Registrar, it will be accepted as long as it satisfies the requirements set out in the Act.<sup>469</sup>

### **2.12.11. Publication, Observations and Opposition**

An application accepted by the Registrar is published in the *Trade Marks Journal*.<sup>470</sup> The Registrar is prohibited from issuing details prior to publication.<sup>471</sup> Third parties are given an

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<sup>463</sup> Bently, L. and Sherman, B., op.cit. at p. 895

<sup>464</sup> Section 32(3) UKTMA 1994, op.cit.

<sup>465</sup> See *Origins v. Origin Clothing* [1995] FSR 280 per Jacob J.

<sup>466</sup> Section 41, UKTMA, ibid.

<sup>467</sup> Bently, L. and Sherman, B., op.cit. at p. 898

<sup>468</sup> Ibid.

<sup>469</sup> DTI 1990. Reform of Trade Marks Law (Cm. 1203) [3.11].

<sup>470</sup> Section 38, UKTMA 1994, op.cit.

opportunity to comment on the application three (3) months following publication. This will take the form of observations on or oppositions to the application. Any observations made by the third-party may prompt the Registry to reconsider the status of the applicant's registration. On the other hand, a proprietor of an earlier mark or right may also formally oppose the registration.<sup>472</sup> The opposition must however be done within three (3) months of the publication and must include the ground for opposition. The rationale behind this is that once the opposition is made, it sets in play a procedural process that is structured to encourage the parties to reach an amicable settlement. Where the parties do not settle amicably, this may lead to a hearing and a determination by the Registrar. In updating the UKTMA, a fast-track opposition procedure was introduced in 2013 to aid quick searches.<sup>473</sup>

An applicant may wish to modify the application during the process of registration which had been filed at the trade mark office. This occurs when there are third-party observations and oppositions or whether there are other changes in other circumstances as regards the trade mark.

The application may be changed by amendment, division, merger, or disclaimer.<sup>474</sup> Thus, an applicant may at any time withdraw such application or restrict the goods or services covered by the application.<sup>475</sup> It is important to note that the corrections in question are limited only to the personal biodata of the applicant and not as to changing the materials facts.<sup>476</sup>

### **2.13. Service Marks Protection in United Kingdom**

These are signs which are used in connection with the provision of services and are registrable as a result of the Trade Marks (Amendment) Act of 1984 in the United Kingdom. Service marks are treated similarly as trademarks and it enables providers of professional, financial, commercial, or personal services to obtain the same statutory protection for their goodwill as is also given to the manufacturers and sellers of goods.<sup>477</sup> In other words, service marks and trademarks are protected alike but each serves its own purpose.

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<sup>471</sup> Section 67(2) UKTMA, *ibid.*

<sup>472</sup> *Ibid.*

<sup>473</sup> Trade Mark (Fast Track Opposition) Amendment Rules 2013 (SI 2013/2235).

<sup>474</sup> Section 37(3) UKTMA 1994, *op.cit.*

<sup>475</sup> Section 39, UKTMA, *ibid.*

<sup>476</sup> Section 39(2) UKTMA, *ibid.*

<sup>477</sup> Bently, L. and Sherman, B., *op.cit* at p.926

In summary, this chapter discussed the processes of registration in Nigeria and United Kingdom. There are however similarities and differences between Nigeria and the United Kingdom. Some of the similarities are that there is a registrar who is responsible for the administration of trademarks; existence of a Trade Marks Journal which is used so as not to confuse earlier registered marks with present marks. It is to be noted that UK trademark office is well-defined and organized. The difference could relate to the fact that the NTMA does not recognize sounds, smell, scent, etc while the UKTMA gives recognition to such rights and privileges.

#### **2.14. Passing off and Trademarks**

The trademark regime consists of a dual system of protection where duly registered marks exist and are protected alongside unregistered marks. Passing off and trademarks are sometimes interchangeably used as they have common roots and are in some respect, similar and closely related.<sup>478</sup> Passing off has been likened to a common law version of trade mark law and they share a common background in the United Kingdom.<sup>479</sup> In the United Kingdom, the law recognises two categories of passing off and they are classic and extended passing off. Classic passing off occurs when a trader's goods or services are being misrepresented as those of other traders. A typical example as used by Bainbridge is where a trader unconnected with a supermarket chain with the name of "Lotus", selling various foods, drinks and clothing, opens a shop selling food produce under the name "Lotus Foods".<sup>480</sup> In the above scenario therefore, especially in classic passing off, consumers are fooled because of the defendant's misrepresentation, into thinking the defendant is the plaintiff (or is in some way connected to him) or into thinking the defendant's goods or services are those of the plaintiff.<sup>481</sup>

Extended passing off on the other hand, applies where goodwill exists in the descriptive, generic and that particular goods or products has achieved a significance such that the persons know the goods or product to have some sort of quality or character. An important feature of extended passing off is that it applies to a group of traders making the product concerned. Examples of such products are Swiss chocolate, champagne. Where someone sells

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<sup>478</sup> Shyllon, F. 2003. op.cit at p. 231. See also Bainbridge, D.I., op.cit. at p. 858

<sup>479</sup> Bainbridge, D.I., op.cit. at p.688

<sup>480</sup> Ibid.

<sup>481</sup> Ibid.

Andre champagne or chocolate under the name “Swiss Chalet”, they are guilty of passing off.<sup>482</sup> Where a trader sells as whisky a drink which has not been produced in the usual way, it is said to be passing off. Whisky is a drink that is protected by extended passing off.<sup>483</sup>

Common features that exists between extended and classic passing off is the evidence of goodwill, misrepresentation, potential or actual damage to the plaintiff’s business caused by the defendant’s alleged wrongdoings. This irreparable harm must be so stated by the plaintiff in that the defendant needs to be checked in order to stop the infringing acts. Hence, a distinction between the two forms of passing off is that for the classic passing off, the damage incurred will be a loss of business, such as where the defendant has sidetracked some of the plaintiff’s business to himself. On the other hand, in extended passing off, damage is more likely to result in the plaintiff’s goodwill in the name which will occur even if consumers are not taken in by the misrepresentation.<sup>484</sup>

Where goods or services are being passed off, as though belonging to another person, the consumers are the ones that suffer more because of the confusion which would occur in trying to ascertain whose product it is especially if they are so similar that it is difficult to tell apart. When this happens, the established trader, who is the owner, will suffer a shortfall in business because the false trader has managed, though deceptively, to steal the business clout and also, to sell inferior goods but under the name of the first trader. The damage done, will be drastically far-reaching in that the trader stands to lose his goodwill and reputation for cheap inferior goods put on the market by the infringer and this will have over-whelming effects on the business of the owner.<sup>485</sup> In *Perry v. Truefitt*,<sup>486</sup> the learned judge reiterated the fact that where a person passed off the goods of another as his own, will be held liable for infringement. It was further stated that it would be deception where similar marks, names, words, figures, letters, and so forth, are used while trading as consumers would be misled and think that the defendant’s business is linked with that of the plaintiff.

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<sup>482</sup> Ibid.

<sup>483</sup> Bainbridge, D.I, op.cit. at p. 861. See also *The Scotch Whisky Association v. Glen Kella Distillers Ltd.* [1997] ETMR 470

<sup>484</sup> Bainbridge, D.I, op.cit. at p. 861

<sup>485</sup> Ibid. at p. 859

<sup>486</sup> *Perry v. Truefitt* (1842) 6 Beav. 66, 49 ER 749. See the cases of *Leather Cloth Co. v. American Leather Cloth Co. Ltd.* (1865) 11 H.L. Cas. 523 at p. 538; *De Facto Works Ltd. v. Odumotun Trading Co.* [1959] L.L.R. 33 at p. 39. See Bently, L. and Sherman, B., op.cit. at p. 826

The two factors considered in a passing off action is the preservation of business goodwill and at the same time, ensuring that consumers are protected from being deceived.<sup>487</sup> In *Plix Products Ltd. v. Frank M Winstone (Merchants)*<sup>488</sup>, the plaintiff in conjunction with the Kiwifruit Authority in New Zealand sold approved designs of kiwi pocket fruits. It was held that a cause of action in passing off depended on whether such act had damaged the plaintiff's reputation and not that the purchasers might confuse the two products together.

Goodwill is generally, not easy to assess but where the defendant has passed off the goods of the plaintiff, as his own, the date at which the complaint is made and when the trial commences, will serve as the benchmark in this instance. The essence of this is to protect the business of the plaintiff especially if it is just growing.<sup>489</sup>

In *Diageo North America Inc. v. Intercontinental Brands (ICB) Ltd.*,<sup>490</sup> the plaintiff made Smirnoff vodka and the defendant brought out a new drink called 'Vodkat.' It was not vodka but was a mixture of vodka and neutral fermented alcohol having alcoholic volume strength of 22% (percent) compared with vodka which had a volume of 37.5% (percent). The judge held that vodka referred to a distinct class of goods and it was recognized for its distinct taste and that it had acquired a reputation in England. The use of the word 'Vodkat' was therefore calculated to deceive a substantial number of the general public who might have concluded that it was a weaker version of vodka. There was damage in terms of both lost sales and the continued use of 'Vodkat', without differentiating it from vodka was likely to erode the distinctiveness of the word vodka.

As a result of the industrial revolution and the growth in means of transport, trade in goods extended beyond the borders of local knowledge, so that traders began to attach signs and symbols to goods in order to indicate their origins and therefore, passing off became important to protect those signs.<sup>491</sup> Passing off is the selling of goods or services which entails the defendant using the products of the plaintiff and misleading the public into assuming that they are associated in one form or the other with the same business, which would lead to confusion on the part of the consumers.<sup>492</sup>

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<sup>487</sup> *Ibid.*, at p.859

<sup>488</sup> [1986] FSR 63

<sup>489</sup> Bainbridge, D.I. at p. 860

<sup>490</sup> [2011] RPC 2

<sup>491</sup> Colston, C., *Principles of Intellectual Property Law*, op.cit. at p. 310

<sup>492</sup> Bainbridge, D.I., op.cit at p. 858

Trademarks, can fall into the category of being unregistered and unregistrable and hence, a passing off may be the only available remedy. That is, if a trade mark action fails, passing off action may succeed on the same evidence, if the registration is invalid.<sup>493</sup> The action that falls under passing off include unregistered marks, of whatever dimension, that are similar to the plaintiff's goods but which, nevertheless, mislead consumers into thinking otherwise. Hence, traders are protected against unfair competition which consists of acquiring goods by means of false or misleading devices, already achieved by rival traders.<sup>494</sup> The passing off action allows trader A to prevent competitor B from passing their goods off as if they were A's.<sup>495</sup>

The similarity between registered trademarks and passing off is that they both protect indications of trade registration but there are however, important distinctions between them. They include the following:

1. It is the property right in the trade mark itself which is protected by registration, while passing off protects a trader's goodwill.
2. A trade mark may be registered before any use is made of it, whereas it is implicit in the nature of goodwill that trade under the 'mark' must have already established a reputation in the buying public's mind. Therefore, in a passing off action, the existence of reputation must be proved to the court, rather than the fact of registration.<sup>496</sup>
3. Passing off could be brought in respect of an unregistered mark which has not been registered through inaction on the part of the owner of the mark whilst a mark that is registered is termed as a trademark.<sup>497</sup>
4. A trade mark has immediate protection once it has been registered but under passing off the onus is on the person to prove that goodwill and reputation has been acquired over a period of time.<sup>498</sup>

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<sup>493</sup> Shyllon, F. op.cit. at p. 232

<sup>494</sup> Kodlinye, G. and Aluko, O. 1999. *The Nigerian Law of Torts*. Spectrum Books Limited, at p. 221

<sup>495</sup> Bently, L. and Sherman B., op.cit. at p. 826

<sup>496</sup> Colston, C., op.cit., at p. 309

<sup>497</sup> Bainbridge, D. I. op.cit. at p. 858-860

<sup>498</sup> See the case of *Hart v. Relentless Records Ltd.* [2003] FSR B36

5. Under passing off, there is no express use nor is the mention of a trade name required<sup>499</sup> but trademark law requires some use of the mark.

It is however important to ascertain what goodwill entails. For a plaintiff to succeed in an action for passing off, there must be goodwill associated with reputation which the plaintiff must acquire in relation to the trade, name or style. Reputation on the other hand, comes through consistent use.<sup>500</sup> In the case of *Boots Company Limited v. United Niger Imports*,<sup>501</sup> the plaintiffs, an English company engaged in the business of manufacture and sale of pharmaceuticals throughout the world and marketed their products in Nigeria through their sole agents, “the Boots Co. (Nig.) Ltd.” The plaintiff’s products distributed through their Nigerian agents were the codeine compressed tablets known as ‘Boots Compound Tablets BP’ which was well known as “Beecodeen.” The plaintiffs alleged that the defendants were marketing their codeine with the letter “B” which is distinctive of the plaintiff’s product. They contended that by the use of said letter, there could be a likely incidence of confusion between the plaintiff’s and defendant’s codeine tablets. The defendant on the other hand, denied the allegations and stated that they were the representatives of overseas manufacturers and have been importing analgesic tablets with the “Roman B” embossed on their products since 1954.

Where there is the evidence of goodwill and reputation in a particular area, it is possible for a trader to succeed in a passing off trial. On the other hand, where the above is not present, the trader would find it difficult to be successful if such an action were to arise. An important aspect however, which should not be ignored is the fact that goodwill may be acquired within a short period before such products have been made available for display on the market arena. Hence, the determination of the case would depend on surrounding facts of the case but the bench mark may be based on the level of commercial activities and advertising in that particular region.<sup>502</sup> The case of *Stannard v. Reay*,<sup>503</sup> affirmed the fact that a limited period may be enough to establish goodwill. It was held that three weeks was sufficient time to build up the necessary reputation for a mobile fish and chips vendor in the United Kingdom. It can

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<sup>499</sup> The scope of passing off is different from country to country. In the United Kingdom for instance, the Trade Marks Act is unaffected by passing off while in Nigeria, it is incorporated in the Trade Marks Act

<sup>500</sup> This comes about when the mark has been used over a substantial period of time and there is no interruption in a business at any time. Where there is a long break, this might be insufficient to revive any residual action and the plaintiff might not be able to raise any issues pertaining to its goodwill

<sup>501</sup> [1977-1989] 2 I.P.L.R. at page 77

<sup>502</sup> Bainbridge, D.I., op.cit. at p.865

<sup>503</sup> [1967] RPC 589, 835



therefore be seen from the above cases that the purpose of passing off is to protect the reputational goodwill of traders.

In the case of *Ayman Enterprises Limited v. Akuma Industries Limited & 3 Ors.*,<sup>504</sup> it was held that it is the Federal High Court that has jurisdiction to entertain passing off actions arising from any Federal enactment. The jurisdiction of the Federal High Court to deal with actions on passing off depends on the registration of trademarks.<sup>505</sup> Where on the other hand, the trade mark is unregistered, then the cause of action for passing-off is in common law for tort and action can be brought in a State High Court.<sup>506</sup> On the general principle, the common law tort of passing-off goods as those of another, still exists generally but not in respect of infringement of registered trademarks. The emphasis is that the Federal High Court requires that the trade mark allegedly infringed must be registered. In *Dyktrade Ltd. v. Omnia Nigeria Ltd.*,<sup>507</sup> the appellant was the plaintiff in the Federal High Court. The claim against the defendant was for an injunction to restrain the defendant from infringing the mark of the plaintiff, referred to as 'Super Rocket'. The defendant was also prevented from passing off the goods of the plaintiff as if there was a connection between them.

In the case of *Nigeria Distilleries Ltd. v. Rufson Distilleries & 2 Ors.*,<sup>508</sup> the plaintiff is the registered proprietor of the Trade Mark "Seaman Schnapps" and "Seamen Schnapps" was used by the defendant. The trademark was alike both in writing which was capable of confusing the public to believe that it is the plaintiff's product that they are buying. It was however held in this case that a passing off case can be instituted in the Federal High Court for the infringement of any registered or unregistered trade mark.<sup>509</sup> It was held by the court that there was an infringement of the registered mark of the plaintiff by the defendants.

In *Exxon Corporation v. Exxon Nominees Industrial Ltd.*,<sup>510</sup> it was held that the difference between passing-off per se and breach of trade mark is that the former is a common law right which has been violated while the latter is a statutory right being breached. It was further

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<sup>504</sup> (2003-2007) 5 I.P.L.

<sup>505</sup> Section 3, NTMA, op.cit. and Section 251(1)(f) of the Constitution of the Federal Republic of Nigeria, 1999 (As amended)

<sup>506</sup> Section 272(1) of the Constitution of the Federal Republic of Nigeria, 1999 (As amended)

<sup>507</sup> [1997-2003] 4 I.P.L.R. 200

<sup>508</sup> (1997-2003) 4 I.P.L.R. 231

<sup>509</sup> Section 3, NTMA, ibid.

<sup>510</sup> [1977-1989] 2 I.P.L.R. 432.

stated that the statutory right has incorporated the common law right and that the breach of trade mark may be called a violation of statutory passing off.

In *Multimalt Limited v. Premier Breweries Limited*,<sup>511</sup> the Plaintiff, a limited liability company registered in Nigeria carries on its business at Berth I, Tin-Can Island port, Apapa, Lagos as bulk malt and grains handling Company. The Plaintiff also imports and sells to breweries malts and brewing products. The Plaintiff's business relates to brewing therefore it is mostly connected with breweries in Nigeria. The Plaintiff has been doing this business since 1975 when it started installation of its handling equipment for bulk malt drink in 1975. The Plaintiff knew the 1<sup>st</sup> Defendant with whom it has been in contract since 1985. The 1<sup>st</sup> Defendant is a brewing industry which produces alcoholic and non-alcoholic beverages. The Plaintiff sued the Defendants because of the use of its name "Multimalt" on product of non-alcoholic beverages produced and bottled by the 1<sup>st</sup> Defendant. The Plaintiff became aware of the use of its name through commercial advertisements made by the Defendant particularly on its 1990 calendar which was circulated in Nigeria.<sup>512</sup> The Plaintiff in the above case could not maintain an action for passing off since it does not manufacture or produce any goods.

Passing off, as afore-mentioned, occurs in the course of trade in relation to goods and/or in services. An actionable offence may arise where an individual's products are being used without the owner's consent which creates confusion in that respect.<sup>513</sup> An example is where an industrious company with a banking department was precluded from operating as a moneylender by its rules and regulations binding it. 'Harrods' was the name of the company of the claimant. The defendant, on his own, established a money lending company under the name of 'R Harrod Ltd.' The court held that the similar names was bound to confuse the public into thinking that the two organisations were the same and that the defendant was acting fraudulently in order to cash in on the business of the plaintiff. An injunction was therefore granted to stop the continued use of the name by the defendant.<sup>514</sup>

Similarly, in *British Medical Association v. Marsh*<sup>515</sup> the plaintiff had a non-profit unincorporated association that manufactured analyses of quack medicines that had no

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<sup>511</sup> (1997-2003) 4 I.P.L.R. p. 22

<sup>512</sup> Ibid.

<sup>513</sup> Bainbridge, D.I., op.cit at p.873

<sup>514</sup> (1924) 41 RPC 74

<sup>515</sup> (1931) 48 RPC 565

medical content but were nevertheless sold at high prices. The defendant thereafter, passed off the analyses as his own and started selling them in the same pharmaceutical store that the plaintiff was also using to sell its products. It was therefore held that since the analyses were similar, it had the potential of confusing members into thinking that the defendant's activities were approved and connected in some way with the association of the plaintiff.

Passing off possesses goodwill and this is equally entitled to legal protection.<sup>516</sup> There may be harm where names of popular individuals are used without their permission and this could be a cause of action but the success would depend on the circumstances of each case. For instance, in *McCullogh v. Lewis A. May Ltd.*,<sup>517</sup> the plaintiff was a popular television children personality known as Uncle Mac but he had physical disabilities. Without the permission of the plaintiff, the defendant sold cereal bearing 'Uncle Mac'. The Court, held that the facts as they were presented, could not give rise to a passing off action because the plaintiff was a broadcaster while the defendant was a marketer and so, they do not have the same occupation.

Regardless, an action in defamation may arise especially where a name has been used without the permission of the owner in order to promote through advertising, such product or service. It was stated in the case of *Tolley v. JS Fry & Sons Ltd.*,<sup>518</sup> that where the face of the claimant was printed on chocolate wrappers, without the necessary consent, it was held to be defamatory.

The jurisdiction to hear passing off cases lies in the first instance to the Federal High Court. The relief which is granted under passing off is the same as in other intellectual property infringement actions. In *Chemiron International v. Runmax Laboratories*,<sup>519</sup> an interlocutory injunction was granted thereby, restraining all defendants from passing off red capsules, which belonged to the plaintiff as their own.

In *Soul Publications Limited v. Sweet Hearts Publications Limited*,<sup>520</sup> the Plaintiff, a Limited Liability Company was into publication of Magazines was sued for infringement and passing-off of any Magazine or publication not published by the Plaintiff. The Plaintiff's contention is

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<sup>516</sup> *British Diabetic Association v. Diabetic Society* [1996] FSR 1. *Burge v. Haycock* [2002] RPC 20

<sup>517</sup> (1948) 65 RPC 58

<sup>518</sup> [1931] AC 333

<sup>519</sup> Unreported case FHC/L/CS/1258/96

<sup>520</sup> [1997-2003] 4, I.P.L.R. 14

that there are strong similarities between its “Hearts” Magazine and the Defendant’s new Publication “Sweet Hearts” the particulars of which include their appearances which are the same in that “Sweet Hearts” magazine was made to resemble the “Hearts” magazine.

The Plaintiff by an ex-parte Application obtained an order restraining the Defendant/Applicant from effecting any publication or marketing any magazine under the name “Hearts” or “Sweet Hearts”. It was held in this case that the rights as to infringement accrue on registration which neither of the parties herein has a claim to, whereas, rights of passing-off accrue to one who can show good will and reputation upon the use of the Mark.

It was further held in the above case that a statutory right to sue for passing-off of an unregistered Trade Mark is conferred on a person in addition to the common law tort of passing-off in respect of other matters not covered by the Act.<sup>521</sup>

In *Goodlife Electronics v. Austec Obison Investment Ltd.*,<sup>522</sup> the Plaintiff registered the Trade Mark, “Goodlife” as a Trade Mark at the Trade Marks Registry, Abuja in Class 9, where the necessary document were issued. The document issued were: Acceptance Form, Acknowledgement Forms and payment receipts. Subsequently, the Plaintiff noticed that there was flagrant flouting of his “Goodlife” brand of shoes which were not his products in the Lagos market. A survey was conducted and same was found in the Defendant’s shops. The Plaintiff alleged that the Defendant’s continued infringement of its trade mark resulted in loss of sales, patronage, reputation and goodwill which could not be readily quantified in monetary terms. The registration of trade mark entitles the proprietor to institute an action in Court if an infringement were to occur and also, the right to sue for passing-off if the goods are being used in a way that is inconsistent with the rights of the owner.<sup>523</sup> It was further held that the Federal High Court has no jurisdiction for passing-off claims arising from infringement of a mark which has not been registered as in the instant case but it is only available where such mark has been so registered under the NTMA.<sup>524</sup>

In *Nigerian Distillers Limited v. Rufson Distilleries*,<sup>525</sup> the Plaintiff’s trade mark, “Seaman Schnapps” conflicted with the defendant’s “Seamens Schnapps.” It was noted that the words,

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<sup>521</sup> Section 3, NTMA, op.cit.

<sup>522</sup> [1997-2003] 4 I.P.L.R. 476

<sup>523</sup> Section 22(2) of the NTMA, Cap. T13, Laws of the Federation 2004.

<sup>524</sup> *Nigerian Distillers Limited v. Rufson Distilleries* (1997-2003) 4, I.P.L.R. p. 11. See also Section 3, NTMA, Laws of the Federation 2004

<sup>525</sup> Ibid.

Seaman Schnapps and “Seaman Schnapps” looked alike and that it was capable of confusing the public to believe that it is the product of the plaintiff that they are buying. The Court thereby, held that where there is a similarity between the goods of the plaintiff and that of the defendant, it would definitely lead to misconception to the buying public.

Therefore, remedies and reliefs under passing off are the same as in other intellectual property infringement actions.<sup>526</sup> The remedies that are obtained in order to restrain the defendant from performing infringement acts in the UK are injunctions, damages, delivery up, or it could be a declaration by which the infringer would promise not to do the acts complained of and this could be achieved by way of judgement in a Court that has jurisdiction.<sup>527</sup>

Other cases of passing off include situations where someone publishes information which is untrue and damages a trader’s reputation in the process,<sup>528</sup> and this is done whereby the plaintiff has gained goodwill and unjustifiable statements are made on its goods being of poor quality and counterfeit.<sup>529</sup> As a remedy under passing off, the plaintiff will be entitled to an injunction and other reliefs against the defendant from continuing the wrong. In addition, damages for any loss of business that might have accrued and to an account of the profits may be sought.<sup>530</sup>

In *Perry v. Truefitt*,<sup>531</sup> the fundamental rule as stated by the learned judge is that where goods are sold under the pretense of an established trader, it is deemed to be passing off and such a person would be liable to have committed a false misrepresentation.

For passing off to be proved, the plaintiff will be entitled to an injunction restraining the defendant from continuing the wrong, to damages for any loss that has accrued and to an account of the profits made by the defendant in consequence of the tort.<sup>532</sup> In addition, it is to

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<sup>526</sup> *Beecham v. Farco Drugs* unreported case FHC/L/CS/1224/98; *Wellcome v. Ranbaxy* (1993) F.H.C.L.R. 353

<sup>527</sup> Bainbridge, D.I., op.cit at p. 904

<sup>528</sup> Jacob, R., Kitchin, D., Mellor, J., and Meade, R. 2005. *Kerly's Law of Trade Marks and Trade Names* (13<sup>th</sup> Edition) Sweet & Maxwell, London

<sup>529</sup> Bainbridge, D.I., op.cit at p.905.

<sup>530</sup> *Spalding v. Gamage* (1918) 35 R.P.C. 101

<sup>531</sup> (1842) 6 Beav. 66, 49 ER 749. See the cases of *Leather Cloth Co. v. American Leather Cloth Co. Ltd.* (1865) 11 H.L. Cas. 523 at p. 538; *De Facto Works Ltd. v. Odumotun Trading Co.* [1959] L.L.R. 33 at p. 39. See Bently, L. and Sherman, B., op.cit. at p. 826

<sup>532</sup> *Spalding v. Gamage* (1918) 35 R.P.C. 101

be noted that as a result of the false misrepresentation of the defendant, the plaintiff, through the Court can recover for loss to the reputational value of his business.<sup>533</sup>

To adequately discuss the concept of passing off, it is of great importance to first discuss the elements of the passing off action. Therefore, three elements have been identified as the essential criteria in order to succeed in a passing off action. They are:

1. The reputation of the trader which has been acquired over time and not the mark itself<sup>534</sup>
2. Misrepresentation of the known reputation is prohibited.<sup>535</sup>
3. The defendant's activities for a period must have caused damage to the plaintiff's goodwill

The passing off action was first developed to meet a classic case of *Reddaway v. Banham*.<sup>536</sup> In that case, Lord Halsbury held that no-one has the right to represent his goods as the goods of another person as it could lead to a misconception among purchasers. However, to succeed in a passing off action, there are factors which needs to be proved by the plaintiff. A plaintiff must be able to show business goodwill to the product or service in order to bring a successful action.<sup>537</sup> It is what leads customers to return to the same business or to buy the same brand.<sup>538</sup> Therefore, the owner of the goodwill has a property right that can be protected by an action in passing off for marks that are not registered.

Hence, it would be difficult to separate goodwill and reputation as they are connected and thereby, go hand in hand. So, where the defendant is trying to pass off the goods of the plaintiff as his own, all that is needed to do is to prove the above mentioned elements for a successful action.<sup>539</sup> Passing off is of particular, concerned with signs or badges that are understood as indicating that a product or service emanates from a known and particular trade source. That is, it has a lot with the name, symbol, or logo that has been employed by a trader and thus has become known and which is associated with the business. Examples of where names have been linked to businesses include, "Marks & Spencer," "Nike," and "Coca-Cola,"

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<sup>533</sup> Ibid.

<sup>534</sup> *Reddaway v. Banham* [1896] A.C. 199

<sup>535</sup> *Spalding v. Gamage*, *ibid.*

<sup>536</sup> *Reddaway v. Banham*, *ibid.*

<sup>537</sup> Bently, L. and Sherman, B. *op.cit.* 830

<sup>538</sup> In *IRC v. Muller & Co.'s Margarine* [1901] AC 217, 224 per Lord Macnaghten. See Bently, L. and Sherman, B., *ibid* at p.829

<sup>539</sup> Bainbridge, D.I. *op.cit.* at p. 858

etc.<sup>540</sup> In addition to this, goodwill is also associated or linked with packaging, trade dress of products, and advertising style.<sup>541</sup>

In *Erven Warnink Besloten Vennootschap v. J Townend & Sons (Hull) Ltd.*,<sup>542</sup> the plaintiffs, were producers of a popular liqueur called “Advocaat.” The liqueur was of high quality made from the best quality products. The defendant, produced a liqueur drink, known as “Keeling’s Old English Advocaat” which was made from inferior products and was less expensive than the drink of the plaintiff. The defendant’s product was also well-known because it was affordable and this attracted the market of the plaintiff extensively. Though, it could not be proved that the consumers’ mistook the defendant’s drink for that of the plaintiff, it was held that the associated reputation which has been gained over time should nevertheless, be protected against infringers from the use of which time and energy had been spent creating it. Hence, there was a misrepresentation on the part of the defendant in using a name similar and confusing the public into thinking that the goods were that of the plaintiff. The defendant ought to have chosen another name for its product and should not have committed fraud by passing off the goods of another person as his own. An injunction was therefore granted in this instance to restrain the party infringing from using such similar name.

Lord Diplock further stated in the above case that there are five (5) features which must be present in an action of passing off. However, it is important to state that before the five features can suffice, it must be in the course of trade. Secondly, it must be a misrepresentation, that is, the defendant must have infringed before the cause of action arose. Where there is no action, then, there cannot be a passing off action. Thirdly, this must be addressed to consumers who are able to distinguish the products of their own manufacturer from all other manufacturers. Fourthly, the action must attempt to injure the other party by destroying the reputational value of the plaintiff’s business; and fifthly, it must cause irreparable damage to the business of the plaintiff.<sup>543</sup>

To further reiterate this, the features of passing off was also pronounced by Lord Oliver, in *Reckitt and Colman (Products) Ltd. v. Borden Inc.*<sup>544</sup> Thus, where the goodwill of the

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<sup>540</sup> Bently, L. and Sherman, B., op.cit., at p.829

<sup>541</sup> Ibid.

<sup>542</sup> [1979] AC 731

<sup>543</sup> *Erven Warnink Vennootschap v. J Townend & Sons (Hull) Ltd.* [1979] AC 731

<sup>544</sup> [1990] RPC 341 (HL). See generally, Bently, L. and Sherman, B., op.cit. at pp. 827-828

trademark owner is damaged and leads to confusion, passing off will be actionable at the instance of the interloper.

### 2.14.1. Goodwill

Goodwill is regarded as a magnet which leads customers to return to the same business or to buy the same brand.<sup>545</sup> When consumers are purchasing goods, they are able to identify the mark affixed on the product despite the fact that the owner of the product is unknown but the public is aware that a particular product is of higher quality than all other products offered up for sale.<sup>546</sup>

Furthermore, goodwill is a form of property that is transmissible by assignment, on death, or by operation of law. There are no formalities laid down for assignment of goodwill *inter vivos*. A pertinent point which is relatively settled is that goodwill cannot be separated from the business to which it is attached.<sup>547</sup>

Under passing off, where a trader attempts to take undue advantage of another person's goods without the owner's permission, this will be deemed to be passing off and thus, actionable against the guilty person, the defendant. In understanding the scope of passing off, two reasons, though not conclusive, of why another trader would try to pass off his goods as though belonging to another, is that there may be confusion if the goods displayed are similar in size and quantity or where the infringer includes a material which is widely recognized with the goods of the plaintiff and hence, the public might be confused in this regard. The business of the original trader, who had established his business will suffer irreversible damage because consumers will stop believing in the standard initially set by the owner and hence, there will be a shortfall in sales, which could lead to shutting down the business. The owner would lose his reputation and his workers would be out of employment.<sup>548</sup> Goodwill could take different forms such as in descriptive words, packaging, get-up and trade dress, and advertising style.<sup>549</sup>

The different forms of goodwill will be discussed below:

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<sup>545</sup> Bently, L. and Sherman, B., *ibid.* at p.829

<sup>546</sup> *United Biscuits (UK) Ltd. v. Asda Stores Ltd.* [1997] RPC 513

<sup>547</sup> See *Barnsley Brewery Co. v. RBNB* [1997] FSR 462, 469

<sup>548</sup> Bainbridge, D. I., *op.cit* at p. 859

<sup>549</sup> In *Spalding & Bros v. AW Gamage Ltd.* (1915) 84 LJ Ch. 449



### 2.14.2. Descriptive words

Where goods or services have been in use for particular periods by a trader, goodwill arises and consumers will be able to distinguish one undertaking from those of other undertakings. Hence, such big companies such as “NIKE” or “MARLBORO” are known names and developed through use by customers who are able to identify ‘NIKE’ from PUMA and know that NIKE is of a particular standard. Goodwill may also be associated with words that are capable of being understood as descriptive of the goods themselves.<sup>550</sup> The concept of goodwill had been recognized as a form of legal property and has been expressed as the benefit and advantage of the good name, reputation and connection of a business and is said to be the attractive force which brings in custom.<sup>551</sup> Therefore, passing off is considered as protecting intangible property and it is the only common law economic tort based on strict liability.<sup>552</sup>

For a trader to show that they have goodwill in a descriptive word, the trader needs to demonstrate that the words have acquired a secondary meaning not only of the goods or services of that description, but specifically of the goods or services of which they are the source.<sup>553</sup> Therefore, goods must be distinctive of one source. For example, where two publishers are competing to launch magazines with a title such as “Leisure News”, it is unlikely that either will be able to bring a passing off action until the magazine has been in the marketplace for a sufficient period of time to build up a public association between the name and a particular source.<sup>554</sup>

In proving secondary meaning, the claimant would have to submit evidence of things such as the length of use and the amount of money that has been spent on advertisement.<sup>555</sup> It has also been noted that it will be easier and better that in finding that a name is distinctive and protected where a trader has used the name separately rather than in conjunction with another sign that designates source.<sup>556</sup> Also, similar principles apply to geographic words and personal names. In general, the adoption of a geographic term or a personal name will not

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<sup>550</sup> See Bently, L. and Sherman, B., op.cit. at p. 829-830

<sup>551</sup> *Inland Revenue Commissioners v. Muller* [1901] A.C. 217 at 223

<sup>552</sup> Shyllon, F. op.cit. at p. 232

<sup>553</sup> See *Peter Waterman v. CBS* [1993] EMLR 27

<sup>554</sup> *Marcus Publishing v. Leisure News* [1990] RPC 576, 584. See Bently, L. and Sherman, B., op.cit. at p. 830

<sup>555</sup> *Chivers v. Chivers* (1900) 17 RPC 420, 430. See Bently, L. and Sherman, B., ibid. at p. 831

<sup>556</sup> *Mcain v. County Fair* [1981] RPC 64. See Bently, L. and Sherman, B., ibid. at p. 831

prevent another trader from using the same designation. In certain circumstances, secondary meaning can attach to such signs. For example in *Montgomery v. Thompson*<sup>557</sup> the claimant had sold beer for more than 100 years which had become widely known as Stone Ale. The defendant, who recently established a brewery in Stone, was prevented from using the term Stone to describe its beer.<sup>558</sup> A distinctive feature in relation to goodwill is that the association must be in the mind of the general public; for example, the term “Swiss Chocolate” means only chocolate made in Switzerland and can be understood as being of a particular quality.<sup>559</sup>

It is pertinent to note that words, once they are distinctive may later lose their ability to indicate source. In such a case, the passing off action will no longer be available. An example is “Linoleum”, which is the name used for a floor covering made of solidified oil. The court in this case refused to prevent competitors using this term because it had become generic. Therefore, it became a common name associated with the floor covering without indicating the source of the manufacturer.<sup>560</sup>

### **2.14.3. Packaging, get-up and trade dress**

In relation to goodwill, a person may acquire goodwill from the packaging or get-up of the product.<sup>561</sup> In *Reckitt v. Colman*,<sup>562</sup> the claimant had sold lemon juice in plastic containers that resembled a lemon in size, shape and colour. It was held, that if the defendant should continue to use plastic lemons that were similar to that of the plaintiff, the defendant will be passing their juice off as that of the plaintiff. The reason is not far-fetched because the plaintiff had succeeded on persuading the general public that lemon juice sold in plastic containers had been manufactured by them. It however made no difference that the plaintiff’s juice was labeled “Jif” and that of the defendant’s “Realemon” simply because the belief is that consumers do not notice labels before purchasing products.<sup>563</sup>

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<sup>557</sup> [1891] AC 217

<sup>558</sup> See *My Kinda Town v. Soll* (1983) RPC 407

<sup>559</sup> *Chocosuisse v. Cadbury* [1999] RPC 826, 832

<sup>560</sup> *Linoleum Manufacturing Co. v. Nairn* (1878) 7 Ch. D 8344, 836. In other words, a product could become generic due to long use. See generally, Bently, L. and Sherman, B., op.cit. at p. 831-832

<sup>561</sup> Evans, J. 1968. Passing Off and the Problem of Product Simulation. 31 *MLR* 642

<sup>562</sup> [1990] RPC 341, 406

<sup>563</sup> *Ibid.* at p. 341, 406

Therefore, the protection that passing off provides over trade dress, packaging or trade dress is of particular importance where consumers identify products by their external features rather than by words. This will probably be the case when goods are sold to people who are illiterates or where goods are sold in foreign language and little or no attention is paid to the words.<sup>564</sup>

For the plaintiff to prove that there has been passing off on his products, he must be able to prove that the public recognizes that the get-up is distinctive of the plaintiff's goods and services. In *Ayman Enterprises v. Akuma Industries*,<sup>565</sup> it was held by the learned judge that the rights of passing off accrue to one who can show goodwill or reputation linked to his mark. Also, in the case of *Labinal v. OCE Filter Manufacturing Industry*,<sup>566</sup> an order of injunction was sought to restrain the defendant's "OCE" oil filters recommended for Peugeot cars as oil filters of the plaintiff. The court held that the defendant's product was identical and similar to that of the packaging of the plaintiff and that there would be an element of confusion to consumers who are accustomed to the packaging of the plaintiff.

Similarly, in *CPL Industries Ltd. v. Glaxo Smithkline Consumer Nigeria Plc & Smithkline Beecham Plc.*,<sup>567</sup> the plaintiffs' case against the defendants is that the defendants who manufacture for sale, analgesic preparations called 'Panadol' and Panadol Extra adopted a design, trademark and packaging similar to those adopted for the plaintiffs' "Conphamol Analgesic"; and that the defendant had infringed upon the plaintiff's trademark. The defendants denied infringing the plaintiff's registered trademark and contended that they had been in prior use of the trade mark, which is the subject matter since 1981, when the plaintiff registered its Conphamol Device. They further contended the design of the Plaintiff's Conphamol and the Eclipse device trade mark was an imitation of Panadol and Eclipse device of the defendants. The defendants thus counter-claimed and sought a declaration that the plaintiff was not entitled to register the Eclipse device shown on the packet of Conphamol products as its trade mark. An order was therefore sought to remove the plaintiff's mark from the Trade Mark Register. It was however held that the onus is on the plaintiff to show that its goods had been passed off by the defendant and that the item imitated or copied had become distinctive of his goods in the eyes of the buying public; that by the adoption of that item, the

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<sup>564</sup> Ibid.

<sup>565</sup> (unreported) FHC/L.CS/674/96

<sup>566</sup> Unreported case FHC/L/33/90

<sup>567</sup> (2008-2011) 6 I.P.L.R. 243

buying public are deceived into “that the goods of the defendant are the goods of the plaintiff, that the goods are similar and that he has suffered or will suffer damage thereby.”<sup>568</sup>

#### 2.14.4. Advertising style

Establishing goodwill can also be established from a trader’s association with techniques or slogans that can be used for advertising. A defendant will therefore be liable for passing off where techniques or slogans similar to that of the plaintiff are used. In *Cadbury Schweppes v. Pub Squash*,<sup>569</sup> the plaintiff produced a lemon-flavoured soft drink called “Solo”. The plaintiff as part of the marketing campaign in Australia launched a series of television advertisements which showed rugged heavily built men (masculine) drinking “Solo”. The defendant promoted its own lemon-flavoured drink with a similar campaign. It was however held in this case that while the Privy Council recognizes the fact that passing off may protect a claimant’s advertising campaign, it seems that the claimant will have difficulties in demonstrating that the public associates a specific style of advertising with a particular source.

In showing that the plaintiff has goodwill, he must be able to show that he is engaged in some form of business or commercial activity. The courts have on several occasions rejected a claimant’s claim to passing off because of lack of business status. To succeed in an action of passing off therefore, it is necessary for the claimant to be a trader. Examples of someone engaged in business are recognized authors, artistes, performers, and charities. In principle, the owner of goodwill is the business that generates goodwill and courts have recognized that a group of traders may also share goodwill in identifying features such as ‘Swiss Chocolate, etc.’<sup>570</sup>

In the United Kingdom, once it has been proved that a claimant is engaged in a trade activity, there is a question of whether goodwill has been established and how to sustain a passing off action. Traders have experienced problems in establishing goodwill in three instances and they are:

1. Pre-trading goodwill

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<sup>568</sup> *CPL Industries Ltd. v. Glaxo Smithkline Consumer Nigeria Plc & Smithkline Beecham Plc.* (2008-2011) 6 I.P.L.R. 243

<sup>569</sup> [1981] RPC 429

<sup>570</sup> Bently, L. and Sherman, B., op.cit. at p. 834

2. Post-trading goodwill
3. Where the trader is situated in foreign land

#### **2.14.4.1. Pre-trading goodwill**

In relation to goodwill, the business is attached to the goodwill of the enterprise and can therefore, never exist independently of each other. The question that may arise is at which point can it be said that a person has goodwill in relation to a commercial business? Another question is whether there is any way in which a trader who is about to launch a business, and who has spent time and money on advertising and marketing, can prevent a competitor from taking advantage of their pre-launch activity.<sup>571</sup>

In answer to the questions above, the traditional position is that before a passing off action can be brought, trading must have commenced in a dimension. For instance, in *Maxwell v. Hogg*,<sup>572</sup> the claimant, Maxwell, proposed to launch a magazine called “Belgravia” in October 1866. He advertised the forthcoming launch of “Belgravia” in a magazine that was run by Hogg. On September 25, 1866, Hogg issued a magazine called “Belgravia”. The court however held that Maxwell could not restrain Hogg from using the same name. The reason given by the court was because a declaration of intention to use a name did not secure any protection.<sup>573</sup>

However, in contrast, cases abound where claimants have successfully gained interim relief prior to the launch of their products. For instance, in *Allen v. Brown Watson*,<sup>574</sup> the publisher of a book entitled “*My Life and Loves by Frank Harris*,” which had been widely advertised prior to publication, was granted an interim injunction against the defendant, who proposed to publish an abridged version also called “*My Life and Loves by Frank Harris*”<sup>575</sup>

Furthermore, in cases where there is no pre-launch goodwill and such goods or services are placed on the market after extensive preparatory publicity, goodwill may very well be generated after a short time.<sup>576</sup> Under pre-goodwill, the law takes into cognizance the fact that different businesses have different relationships with their customers. It has therefore

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<sup>571</sup> Ibid. at p. 835

<sup>572</sup> (1867) LR 2 Ch. App 307

<sup>573</sup> *Maxwell v. Hogg*, *ibid.*

<sup>574</sup> *Allen v. Brown Watson* (1965) RPC 191. In *BBC v. Talbot Motor Co. Ltd.* [1981] FSR 228

<sup>575</sup> *Maxwell v. Hogg*, *ibid.*

<sup>576</sup> *My Kinda Bones v. Dr. Pepper’s Stove Co.* [1984] FSR 289

been held by the English Court of Appeal that before a service is launched, a business may be able to generate goodwill through publicity and advertising.<sup>577</sup> In *Starbucks v. BSB*,<sup>578</sup> the claimant sought to prevent the defendant from using the sign, “NOW TV” for its internet broadcast service. The Court of Appeal, rejecting the claim, held thus,

It was insufficient for a passing off action for *NOW TV* simply to be planned. It was necessary either to have or promote and publicise or advertise a customer base here in order to establish goodwill protectable by law. The preparations did not establish goodwill in the sense of acquiring a protectable exclusive right created by the attraction of custom in this country<sup>579</sup>

#### **2.14.4.2. Post-trading goodwill**

It has mentioned in several cases that goodwill cannot exist by itself and that it must be directly linked to a commercial business activity. Where a business ceases to trade, the goodwill withers away.<sup>580</sup> However, whether goodwill continues to exist depends on two issues: firstly, whether the public retains relevant associations between the sign and a particular trader; and secondly, whether there is evidence of an intention to resume the business. It has also been stated that the law recognizes that where businesses have ceased, the name and reputation of trader might still remain in the minds of the public.<sup>581</sup> If there is nationwide familiarity with a trade mark, the reputation may remain for many decades.<sup>582</sup> The trader must intend to resume business. When there is an assignment of goodwill to a third party by the trader, this is an intention not to resume business.<sup>583</sup> Therefore, the intention to resume business may be evident from the trader’s acts or may be inferred from the fact that trading was brought to an end by outside forces.<sup>584</sup>

#### **2.14.4.3. Trade in foreign land**

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<sup>577</sup> Bainbridge, D., op.cit at p.837

<sup>578</sup> *Starbucks v. BSB* [2013] EWCA Civ 1465

<sup>579</sup> Ibid.

<sup>580</sup> *Commissioners of Inland Revenue v. Muller & Co.’s Margarine* [1901] AC 217, 224

<sup>581</sup> Bently, L. and Sherman, B., op.cit. at p. 837

<sup>582</sup> In *Jules Rimet Cup Ltd. v. Football Association Ltd.* [2007] EWHC 2376 (Ch), [2008] FSR 10, the Football Association retained goodwill in the mascot device from 1966 World Cup despite 40 years of inactivity.

<sup>583</sup> *Star Industrial Co. Ltd. v. Yap Kwee Kor* [1976] FSR 256 (PC)

<sup>584</sup> *A. Levey v. Henderson Kenton (Holdings)* [1974] RPC 617

Where a business located in a foreign country acquires an international reputation, this may lead the foreign trader to set up business in the United Kingdom.<sup>585</sup> In such a case, the UK-based business will normally have goodwill. In other situations, the foreign business may merely have an agent in the UK, or may only respond to orders taken directly from customers in that particular country. However, the question is whether a foreign trader can rely on passing off to protect their interests in the United Kingdom. The law in determining and answering the above distinguishes between three situations. The situations are evidence of business activity, no business activity but customers, and lastly, mere reputation.<sup>586</sup>

#### **2.14.4.4. Evidence of business activity**

Under the law, there must be evidence of some sort of business activity. If the claimant can demonstrate a trading link with the UK or some other country, they will normally succeed in establishing goodwill.<sup>587</sup> There is no need therefore to have a registered business in the UK once the court notices that the trader has sufficient goodwill in the UK.<sup>588</sup>

#### **2.14.4.5. Non-evidence of business activity, but existence of customers**

In *Bernadin v. Pavilion*,<sup>589</sup> known as the Crazy Horse case, the claimant was proprietor of the Crazy Horse Saloon in Paris. The defendant opened a place of the same name in London. The learned judge refused to grant an interlocutory injunction to restrain the defendant from using “Crazy Horse Saloon” name in London. While the claimant had distributed leaflets in England advertising the saloon, there was no evidence that there were English customers of the Paris saloon. It was further held that,

[A] trader cannot acquire goodwill in this country without some sort of user in this country. His user may take many forms and in certain cases very slight activities have been held to suffice...I do not think that the mere sending into this country by a foreign trader of advertisements advertising his establishment

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<sup>585</sup> Bently, L. and Sherman, B., op.cit at p.838

<sup>586</sup> Ibid. at p. 838

<sup>587</sup> Ibid. at p.838

<sup>588</sup> *Sheraton Corporation v. Sheraton Motels* [1964] RPC 202

<sup>589</sup> [1967] RPC 581

abroad could fairly be treated as a user in this country<sup>590</sup>

The essence of goodwill is the ability to attract customers and potential customers to do business with the owner of the goodwill. It has been affirmed that there is goodwill where a business has customers in England. In *Hotel Cipriani SRL v. Cipriani (Grosvenor Street)*,<sup>591</sup> the claimant operated a hotel in Venice under “Hotel Cipriani”. “Cipriani” was the name of the Italian family that operated the hotel. The defendant, another member of the Cipriani family, opened a bar in Grosvenor Square, London, called “Bar Cipriani”. The defendant, on being sued stated that there was goodwill in England as a consequence of the bar that was operated in Venice. It was however held in this case that the defendant should desist from using the same words as the claimant and that the operation of the bar in Venice did not confer concurrent goodwill on the defendants.<sup>592</sup>

#### **2.14.4.6. Mere reputation**

The question of whether a foreign trader has goodwill in the United Kingdom arises where the claimant merely has a reputation but no customers as such in the United Kingdom. The general belief is that it is necessary for a foreign trader to have customers in the UK so as to establish goodwill; and it would seem reasonable to assume that where a foreign trader merely has a reputation in the United Kingdom, they would not be able to prove that they had the goodwill necessary to sustain a passing off action.<sup>593</sup> However, it has been observed that where a foreign trader has reputation in the UK, there will be the existence of goodwill. In *Maxim’s v. Dye*,<sup>594</sup> it was held that the claimants did have sufficient goodwill to bring a passing off action in the above case. It has been held in several case laws in the United Kingdom that for a foreign trader to establish goodwill there must be the existence of customers in that particular region.<sup>595</sup>

#### **2.14.4.7. Misrepresentation**

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<sup>590</sup> Ibid.

<sup>591</sup> [2008] EWHC 3032. See generally, Bently, L. and Sherman, B., op.cit. at p. 840-841

<sup>592</sup> Ibid.

<sup>593</sup> Bently, L. and Sherman, B., op.cit at p. 841

<sup>594</sup> *Maxim’s v. Dye* [1978]2 All ER 55

<sup>595</sup> Bently, L. and Sherman, B., ibid. at p. 842-844



Misrepresentation occurs when the goods or services of the claimant are similar to that of the defendant. For a cause of action to arise therefore, it will be sufficient if it can be shown that there is a link between the claimant's business and that of the defendant and not necessarily to state that the defendant's business is indeed that of the claimant.<sup>596</sup> Thus, the burden on the claimant is to prove that the defendant is guilty of passing off in the course of trade and that there is a connection between the business of the claimant and that of the defendant which would likely harm the property rights of the goods that the claimant is producing. The claimant has both the right to use and to have the product protected against people who might want to steal it and pass it off as their own.<sup>597</sup>

Hence, the bench mark for ascertaining whether there has been misrepresentation lies on the fact of proving whether the claimant's goods are similar to that of the defendant in trade. In *Spalding v. Gamage*,<sup>598</sup> the learned judge, Lord Parker stated that it would not be possible to enumerate all the possible ways in which a person may make the false representation relied upon but nevertheless, it has been held that as long as the representation confuses the public, how the matter came about is inconsequential.

In determining whether there is a misrepresentation, the court would examine the defendant's actions and the effect that these will have upon the public rather than the state of the defendant's mind.<sup>599</sup> There is no need for the misrepresentation to be conscious, deliberate, intentional, or fraudulent in order to succeed in a passing off action.<sup>600</sup> In other words, whether the misrepresentation is conscious or intentional is irrelevant and therefore, what the court examines is whether the defendant's actions or representations generates the requisite confusion in the mind of the public.<sup>601</sup> A misrepresentation is actionable even where it is unintentional or where it can be explained on legitimate grounds. For example, if a person trades under their own name, they might be considered as passing off their goods as those of the claimant.<sup>602</sup> In *Parker Knoll v. Knoll International*,<sup>603</sup> the defendant, Hans Knoll, established a furniture manufacturing business that was called "Knoll International". Another firm of furniture manufacturers, which was established by the defendant's uncle, was called,

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<sup>596</sup> Bainbridge, D. I. 2012. *Intellectual Property*. Ninth Edition. Pearson Education Limited, at p. 861-864

<sup>597</sup> See the case of *Premier Luggage and Bags Ltd. v. Premier Company(UK) Ltd.* [2003] FSR 5

<sup>598</sup> (1915) 32 RPC 273, 284

<sup>599</sup> Bently, L. and Sherman, B., op.cit. at p. 849

<sup>600</sup> Ibid.

<sup>601</sup> Ibid. at p. 849

<sup>602</sup> Ibid at p. 849. See also Kodilinye, G. 1975. "Passing off and the Use of Personal Names" 26 *NILQ* 177

<sup>603</sup> [1962] RPC 265

“Parker Knoll”. The House of Lords had a contrary opinion and denied that a person was entitled to use their own name to indicate that their goods are the goods of another. An injunction was granted in the above case but it has been held that there is no defence where a person uses their own name or uses a nickname.<sup>604</sup>

Words or actions may also constitute misrepresentation and these may be oral or written.<sup>605</sup> When it is oral or written, the misrepresentation occurs where the defendant makes a statement that is linked either explicitly or implicitly to the claimant.<sup>606</sup> On the other hand, there may be misrepresentation where the action of the defendant is implied.<sup>607</sup> An example is where the defendant manufactures goods which resembles that of the claimant. It could be where a customer requests a trader to supply a particular person’s goods but the trader instead supplies the customers with their own goods and this is referred to as actionable misrepresentation.<sup>608</sup>

A misrepresentation can also be where the defendant places their goods closely to that of the claimant and they are visually related. In *Associated Press v. Insert Media*,<sup>609</sup> the court held that by inserting advertisements inside the claimant’s newspaper after the paper had been delivered to newsagents; the defendants passed the inserts off as if they were that of the claimant’s. On the other hand, another situation where the action of a defendant may give rise to an actionable misrepresentation is in the adoption of domain names used in the internet. Where domain names are registered without the consent of the organization that owns the goodwill in the names is considered actionable consideration. In *British Telecommunications Plc v. One in a Million Ltd*,<sup>610</sup> the defendant registered the names of organizations without their consent. The defendant’s aim was either to sell the names they had registered to the owners of the goodwill (by using the blocking effect of the registration to negotiate for a better price),<sup>611</sup> or sell them to other people (unconnected to the organizations, such as, collectors). It was further held that the placing on a register of a

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<sup>604</sup> Bently, L. and Sherman, B., *ibid.* at p. 849.

<sup>605</sup> *Ibid.* at p. 850

<sup>606</sup> [1993] FSR 641. See Stone. R. 1996. “Titles, Character Names and Catch Phrases in the Film and Television Industry: Protection under the Law of Passing off” 7 *Ent. L. Rev* 263

<sup>607</sup> Bently, L. and Sherman, B., *op.cit.* at p. 850

<sup>608</sup> *Bovril v. Bodega Co. Ltd.* (1916) 33 RPC 153

<sup>609</sup> [1991] FSR 380

<sup>610</sup> [1998] 4 All ER 476

<sup>611</sup> There have been cases where domain names are registered without the consent of big organizations. For instance, the defendants in a decided case offered to sell the domain name, ‘burgerking.co.uk’ to Burger King for £25,000. See generally, Bently, L. and Sherman, B., *op.cit.* at p. 850

distinctive name such as 'Marks and Spencer' makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name.<sup>612</sup>

Thus, the defendant's actions could give rise to a misrepresentation especially where the goods or services advertised by them indicate a false connection with the products of the claimant and so, consumers would believe that the defendant is an employee or marketer so as to have the right to use the mark of the claimant in the course of trade. That is, the defendant uses a word or name that the public would feel is similar to that of the business of the claimant. The behavior of the defendant, could therefore give rise to the suggestion that goods or services are similar to those of the claimant. That is, it is when the goods or services are up for sale, that the defendant could suggest that there is a connection between the business of the claimant and that of his.<sup>613</sup> In *Kimberly Clark v. Fort Sterling*,<sup>614</sup> as part of the defendant's campaign to promote the 'Nouvelle' toilet roll, the defendant offered to propitiate customers who had bought 'Nouvelle' but were dissatisfied with it, by replacing 'Nouvelle' with 'Andrex' toilet paper. The claimant, who owned the goodwill in 'Andrex' objected and the Court held the offer to be a misrepresentation because it was likely to lead purchasers into thinking that 'Nouvelle' was a product from 'Andrex'; or that 'Andrex' was in some way behind the promotion of the defendants.

A misrepresentation could also arise where a defendant makes a representation that the quality of goods which the claimant professes about his goods are not true. In *Spalding v. Gamage*, the claimant, manufactured and sold balls, brought a passing off action against the defendants, who had obtained some of the claimant's old disused stock and sold them as if they were new and improved balls.<sup>615</sup> Under passing off action, there is also what is referred to as parallel import of goods. Parallel import of goods is when a trader places goods of one quality on a foreign market under a particular sign and goods of a different quality on the UK market under the same sign. The trader may therefore be able to use passing off to prevent goods marketed abroad from being imported into the United Kingdom.<sup>616</sup> Where goods are exported originally to the United Kingdom and it was later discovered that the goods were

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<sup>612</sup> [1998] 4 All ER 476 at 497

<sup>613</sup> Bently, L. and Sherman, B., op.cit at pg. 852

<sup>614</sup> *Kimberly Clark v. Fort Sterling* [1997] FSR 877

<sup>615</sup> (1915) 32 RPC 273

<sup>616</sup> Bently, L. and Sherman, B., Op.cit. at p. 852

moved from the UK to Spain without the owner's permission, it can be said that this form of parallel importing is illegal.<sup>617</sup> Parallel imports are referred to as grey goods and it has been affirmed by the Court of Appeal in the United Kingdom that grey goods can constitute a criminal offence under the UKTMA.<sup>618</sup>

#### **2.14.5. Damage**

There must be the existence of damage and this serves as the final element which the plaintiff must prove in order to succeed in an action of passing off.<sup>619</sup>

##### **2.14.5.1. Likely Damage**

The likelihood of damage could create confusion between the goods of the claimant and that of the defendant whilst selling the same products or services.<sup>620</sup> This could occur in the following instances:

##### **2.14.5.2. Goods or business not the same**

This occurs when goods or services even though not the same, can raise the issue of trade marks. In *Walter v. Ashton*,<sup>621</sup> the defendant, who had been responsible for a successful sales campaign to sell 'Daily Express' bicycles with the co-operation of that newspaper launched a new campaign to sell 'The Times.' It was held in this case that there must be the existence of a tangible probability of injury to the claimant's property. Another form of probable injury is where the plaintiff sold rubber gloves called Marigold and the defendant had begun to use the mark on toilet tissues. The plaintiff secured an interim injunction against the defendant from using such mark upon similar goods.<sup>622</sup>

##### **2.14.5.3. Not trading in the same geographical area**

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<sup>617</sup> The Complexities of Parallel Importing- The Balance of Small Businesses. Retrieved October 16, 2018 from <http://www.thebalancesmb.com>what-i...>

<sup>618</sup> Section 92, UKTMA, Cap. 26, 1994.

<sup>619</sup> Ibid. at p. 873

<sup>620</sup> Cornish, W. and Llewelyn, D., op.cit. at p. 648

<sup>621</sup> [1902] 2 CH. 282

<sup>622</sup> *LRC v. Lilla Edets* [1973] R.P.C. 560. Other examples are where for instance, the defendant uses 'Lego' on plastic gardening equipment which is likely to be associated with the well-known 'Lego' toys. See therefore, the case of *Lego System v. Lego M. Lemelstrich* [1983] F.S.R. 155

Where the plaintiff establishes a business reputation in one place, and the defendant, on the other hand, sets up a similar business in another place, suggests that the plaintiff has opened a new outlet in that locality. In *Brestian v. Try*,<sup>623</sup> the plaintiff had hairdressers' shops in London and in major parts of Europe and the defendant was restrained from using the same name for hairdressing in that area. Jenkins, L.J. held that damage might ensue because there is the probability that customers might go to the defendant instead of the plaintiff. It was held that the plaintiff's credit and reputation might be endangered where there is the likelihood of confusion.

Another example is where a business called 'Chelsea Man' with shops in three cities was held entitled to a country-wide injunction preventing the opening of 'Chelsea Girl' outlets, because of its intention to extend business beyond these places.<sup>624</sup>

#### **2.14.6. Passing off in Nigeria**

Passing off is when goods or services of the claimant are sold in such a manner that the public would infer that the defendant's goods are similar to that of the claimant and this could lead to the public being misled. The rationale behind the law is designed to protect traders against that form of unfair competition which consists in acquiring for oneself, by means of false or misleading devices, the benefit of the reputation already achieved by rival traders.<sup>625</sup>

Passing off may arise under the different categories:

##### **a. Marketing a Product as that of the Plaintiff**

Passing off is actionable where the defendant sells merchandise with a direct statement that the goods are manufactured by the plaintiff, when in fact they are not. For example, it would be passing off for X, a manufacturer of tyres to advertise and sell his tyres as Dunlop or Michelin tyres, since this would be an obvious attempt to profit from the goodwill and reputation established by rival businesses. It is therefore actionable for a book publisher to

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<sup>623</sup> [1958] R.P.C. 161, CA

<sup>624</sup> See the case of *Chelsea Man v. Chelsea Girl* [1987] R. P.C. 189, CA

<sup>625</sup> Salmond op.cit. para. 149

advertise and sell a book of poems with the name “Lord Byron” on the title page when in actual fact, the famous poet had nothing to do with its authorship.<sup>626</sup>

### **b. Closely related products**

When products are closely related under a name that resembles that of the plaintiff and the defendant, the public would be mistakenly misled into thinking that the businesses of both the defendant and claimant are similar in colour, shape or even quantity.<sup>627</sup> An example is in *Hendriks v. Montagu*, where the Universal Life Assurance Society were granted an injunction restraining the defendant’s company, which was incorporated from carrying on subsequently business under the name, Universe Life Assurance Association. It was held by James L.J.<sup>628</sup> that there are similarities between Universal and Universe and was likely to mislead the public.

Similarly, in the famous case of *Niger Chemist v. Nigerian Chemists*,<sup>629</sup> the plaintiffs owned ‘Niger Chemists’ and had carried on business as chemists for several years. They had several branches in Onitsha and other towns in what was then Eastern Nigeria. The defendants later founded a firm carrying on the same type of business in Onitsha under the name, ‘Nigeria Chemists.’ The plaintiffs contended that the defendant’s use of a name similar to their own was actionable passing-off, and thereby, sought for an injunction to restrain the defendant for further use. It was held by Palmer J., who granted the injunction on the basis that the use of the name ‘Nigeria Chemists’ was calculated to deceive persons who know of and intend to deal with Niger Chemists and that there was likely to be a grave risk of confusion and deception.<sup>630</sup>

In *Ogunlende v. Babayemi*,<sup>631</sup> the plaintiffs carried on business as civil engineering contractors and plumbers under the name, “Mercury Builders”. The learned judge granted an injunction restraining the defendant from establishing a similar business under the name,

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<sup>626</sup> *Byron v. Johnston* (1816) 35 E.R. 851. Kodilinye, G. and Aluko, O. 1999. *The Nigerian Law of Torts*. Revised Edition. Spectrum Books, at p. 221

<sup>627</sup> Kodilinye, G. and Aluko, O., *ibid.* at p. 221

<sup>628</sup> *Hendriks v. Montagu*, *op.cit.* at p.457

<sup>629</sup> [1961] All N.L.R. 171

<sup>630</sup> *Ibid.* p. 173

<sup>631</sup> (1971) 1 U.I.L.R. 417

“Mercury Builders (Nigeria) Ltd.,” since the name of the defendant’s company is calculated to deceive due to its similarity with the name of the plaintiff association.<sup>632</sup>

**c. Marketing goods under a Trade name already appropriated for goods of that kind by the plaintiff, or under a name so similar to the plaintiff’s Trade name as to be mistaken for it**

A trade name is when goods are sold or made by a certain person and which by established usage has become known to the public as indication that those goods are the goods of that person. Therefore, names, that is, purely descriptive names, which merely indicate the nature of the goods sold and not that they are the merchandise of any particular person, for example, stout, vacuum cleaner, cellular textiles are not protected unless the plaintiff can prove that the descriptive name in question has acquired a secondary meaning so exclusively associated with the plaintiff’s own product that its use by the defendant is calculated to deceive purchasers.<sup>633</sup>

**d. Marketing goods with the trade mark of the plaintiff or with any deceptive imitation of such mark**

A trade mark is any mark capable of being distinguished from other marks. Therefore, Trade Marks receive protection not only under the law of passing off but if registered, under the Trade Marks Act.<sup>634</sup>

**e. Imitating the get-up or appearance of the plaintiff’s goods**

An action of passing off would arise where the defendant uses, adopts, copies the trade name or get-up of the plaintiff’s business goods or services, which particularly identifies those goods as the merchandise of the plaintiff. Hence, the defendant will therefore, be liable for passing off, if in marketing or advertising his goods, he imitates such appearance or get-up in a manner likely to confuse the public.

In *Trebor v. Associated Industries*,<sup>635</sup> it was held that the issue of the likelihood of deception in a passing off action is not to be decided on a deliberate and careful comparison but on the

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<sup>632</sup> Ibid. at p. 419. See generally, Kodilinye, G. and Aluko, O., op.cit. at p. 223

<sup>633</sup> *Reddaway v. Banham* [1896] A.C. 199

<sup>634</sup> Kodilinye, G. and Aluko, O., op.cit at p. 224

<sup>635</sup> (1972) N.C.L.R. 471.

much vaguer impression a casual observer would get and not necessarily putting the get-ups together to ascertain the similarities.

In the case of *De Facto Works v. Odumotun*,<sup>636</sup> the plaintiffs had been bakers for several years and had used coloured wrappers for their business and the name, 'De Facto' had been their trade name. The defendants, who were also bakers and distributors of wrapped bread, had used grease-proof papers with green letters without any coloured backgrounds. They thereafter changed the colour of their product to that similar to that of the plaintiffs' but with 'ODUS' in large scroll letters in chocolate colour. The plaintiffs instituted an action against the defendants for injunction, damages, account of profits and delivery up for destruction of the offending wrappers. It was held in this case by Coker J. that the essence of passing off action was the element of the likelihood of confusion or of deception to the consumers and such may be brought by the layout of colours even though the design details are not identical or similar.<sup>637</sup>

Notwithstanding, in the flux of life, it is impossible to state the ways in which a trader could pass off his goods as those of a rival one but the general principle is that the purchasers should not be induced to believe that the goods they are buying were manufactured by another person.<sup>638</sup> The test is therefore not whether a customer can distinguish the two marks when they are placed side by side but whether he has an idea of the product he likes and is accustomed to and that he may not accept the other product in mistake for it. In the above case therefore, the judge granted an injunction restraining the defendants from passing off their bread as that of the plaintiffs and thereafter awarded damages.

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<sup>636</sup> (1959) L.L.R. 33

<sup>637</sup> See Shyllon, F. op.cit. at p.234

<sup>638</sup> Ibid.



## **CHAPTER THREE**

### **THEORETICAL FRAMEWORK AND INTERNATIONAL INSTRUMENTS ON THE PROTECTION OF TRADEMARKS**

At the international level, there are different conventions/treaties that have been put in place for the protection of trademarks and these conventions are for checking accountability in countries that have ratified them.

However, this chapter will start with the jurisprudential schools and the theories that advocate for the justification of protecting trademarks.

#### **3.1. Theoretical Framework**

There are several jurisprudential schools that provide the theoretical framework for legal matters and such schools of thought have different proponents and legal scholars affiliated with each school. The School of thought include Natural Law, Sociological Jurisprudence and the Sociology of Law, Historical and Anthropological Jurisprudence, Economic Analysis of the Law, etc.<sup>639</sup>

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<sup>639</sup> Lloyd, L. and Freeman, M.D.A. 1985. Introduction to Jurisprudence. London: Stevens and Sons Ltd.

Two schools of thought appear to have particular bearing on this thesis and are apt. They are the Sociological Jurisprudence and the Sociology of Law and the Economic Analysis of the Law.

### 3.1.1. Sociological School

A characteristic feature of twentieth-century jurisprudence has been the development of sociological approaches to law<sup>640</sup> and how law is concerned with the society.<sup>641</sup> In the nineteenth century, the focus of attention shifted from individual rights towards social duties, and carried with it, an emphasis on the function of law in the existence of the community.<sup>642</sup> The theorists in this school assert that the law is a means of achieving certain sociological goals and that the purpose of law is to shape social behavior.<sup>643</sup> Comte<sup>644</sup> defined sociology as the science of social order and progress and its distinctive feature is its capacity for improvement and development if guided by proper scientific principles.<sup>645</sup> The proponents of this school include Jhering, Eugen Ehrlich, Roscoe Pound, Max Weber, Durkheim, etc.

Jhering, placed emphasis on the function of law as an instrument for serving the needs of human society. In society, there is an inevitable conflict between the social interests of man and each individual's selfish interests. In order to reconcile this conflict, the state employs both the method of reward, by enabling economic wants to be satisfied, and the method of coercion.<sup>646</sup> He further recognized law as that form of coercion which is structured by the state and the means of achieving an end, namely social control.<sup>647</sup> He further stated that law does not exist for the individual as an end in himself but serves his interest with the good of society which forms part of human conduct.<sup>648</sup> Law is therefore, a part of human conduct which is the only instrument used for serving the needs of society.<sup>649</sup>

Ehrlich was primarily concerned with expounding the social basis of law.<sup>650</sup> Ehrlich stresses that the real source of law is the activities and needs of the people, who evolve various

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<sup>640</sup> Ibid. at p.548

<sup>641</sup> Dias, R.W.M. 2013. *Jurisprudence*. Fifth Edition. LexisNexis, at p. 420

<sup>642</sup> Ibid., at p. 420

<sup>643</sup> Schools of Thought. Retrieved March 3, 2017 from <http://forum.hyeclub.com/showthread.php/2048-school...>

<sup>644</sup> Comte is the founder of the Sociological approach 1798-1857

<sup>645</sup> Dias, R.W.M. 2013. *Jurisprudence*. Fifth Edition. LexisNexis, at p. 550

<sup>646</sup> Lloyd, L. and Freeman, M.D.A., op.cit. at p. 553

<sup>647</sup> Ibid., at p. 553, 554

<sup>648</sup> Ibid.

<sup>649</sup> Ibid.

<sup>650</sup> Lloyd,L. and Freeman, M.D.A., ibid. at p. 562

patterns of conduct, e.g., morality, social custom, group practice, such as business or professional practices, etc, to order life in the community generally.<sup>651</sup> Certain parts of these patterns of conduct are written down eventually in the form of legislation or case law.<sup>652</sup> Written law is seen as a record of pre-existing law operating in society. Therefore, when social practices, norms and standards change, the idea is that law changes to conform with the new modes as it relates to society.<sup>653</sup>

Furthermore, Ehrlich saw law as growing from the people rather than being imposed on them from above by an Austinian sovereign. Formal law is viewed as being a mere fraction of the corpus of the living law of his community and his task was to study the rest of the living law whilst ensuring that the formal law keeps abreast with the way in which people conduct their affairs.<sup>654</sup> Living law according to Ehrlich is described as underlying the formal rules of the legal system<sup>655</sup> and it means the law operating effectively among the people.<sup>656</sup> Examples of living law include in Nigeria, the customary laws of polygamy and bride-price and this should be contrasted with the formal laws, some of which are outdated and continue merely to adorn the pages of statute books but are not relevant to the socio-economic life of the people.<sup>657</sup>

Sociological jurisprudence, according to Pound, should ensure that the making, interpretation and application of laws take account of social facts. In achieving this, there should be a factual study of the social effects of legal administration, social investigations as preliminaries to legislation; a constant study of the means for making laws more effective.<sup>658</sup> Pound further opined that it was not enough to make a law but there must be purpose for which it is made. Law should therefore be used for the purpose of making the society better and that if law is used in this regard, it becomes a form of social engineering and law develops its own postulate. Also, since society is not static and keeps changing, the law must change to the evolving circumstances.<sup>659</sup>

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<sup>651</sup> Adaramola, F. 2008. *Jurisprudence*. Fourth Edition. LexisNexis at p.263

<sup>652</sup> Ibid. at p. 263

<sup>653</sup> Ibid. at p.263

<sup>654</sup> Adaramola, F. 2008. *Jurisprudence*. Fourth Edition. LexisNexis at p.263

<sup>655</sup> Lloyd, L. and Freeman, M.D.A., op.cit. at p. 562

<sup>656</sup> Adaramola, F., ibid. at p. 263

<sup>657</sup> Ibid. at p. 263

<sup>658</sup> Ibid. 430

<sup>659</sup> Lloyd, L. and Freeman, M.D.A. 1985. *Introduction to Jurisprudence*. London: Stevens and Sons Ltd. 570

### 3.1.2. Economic Analysis of the Law

This section falls under recent approaches in jurisprudence and it states that economics has a strong impact on the study of the Law. Within the general orientation of economic analysis of law, the most influential current has been that of Richard Posner and his disciplines. They have postulated that in making new laws, judges should aim at creating those rules of law which will tend to maximize economic efficiency in the society.<sup>660</sup>

### 3.2. Theoretical models of Trademarks

In relation to the theoretical models of which trademark is based, the current foundations of existing trademark systems employ a utilitarian and economic model for the justification of trademarks.<sup>661</sup> There are four theories as propounded by Naser for the justification of trademarks and they are the Labour theory, Personhood theory, utilitarian and economic theory, and the Social-Planning theory. However, the most favoured and accepted of these theories by theorists are the Utilitarian, Economic and Social-Planning theories.<sup>662</sup>

#### 3.2.1. Utilitarian and economic Theory

Utilitarianism in relation to intellectual property law is an assessment of the consequences of maximizing the benefits to society as a whole, rather than prioritizing individual benefits. In relation to trademark law, utilitarianism justifies legal protection because in protecting trademarks, it maximizes the benefits to society and reduces search costs associated with the purchase of products by consumers.<sup>663</sup> Such protection provides brand owners with incentives to improve the quality of their trademarked products.<sup>664</sup> McCarthy stated that without trademark protection, the end result would be a race to produce inferior products, rather than competition to produce better products.<sup>665</sup> Thus, trademark protection provides

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<sup>660</sup> Elegido, J.M. 2006. *Jurisprudence*. Spectrum Books Limited, at p. 117

<sup>661</sup> Naser, M. A. 2007. Rethinking the Foundations of Trademarks. *Buffalo Intellectual Property*. Volume 5, No.1, at p. 2

<sup>662</sup> Fisher, W. 2001. Theories of Intellectual Property, in *New Essays in the Legal and Political Theory of Property* 168 in (Stephen R. Munzer ed., 2001). Hughes, J. 1988. The Philosophy of Intellectual Property, 77 *Geo. L.J.* 287, 330; Locke, J. *Two Treatises of Government* 287-88 (Peter Laslett ed., 2d ed. 1967).

<sup>663</sup> Beebe, B. 2005. The Semiotic Analysis of Trademark Law, 51 *UCLA CLA. L. Rev.* 621, 623. See also Landes, W. M. and Posner, R.A. 1988. The Economics of Trademark Law 78 *Trademark Rep.* 267, 271

<sup>664</sup> Meiners, R.E. and Staaf, R.J. 1990. Patents, Copyrights and Trademarks: Property or Monopoly. 13 *Harv. J.L. & Pub. Pol'y* 911, 931

<sup>665</sup> McCarthy, J.H. 2008. McCarthy on Trademarks and Unfair Competition § 2:4 (citing to The Craswell Report 7 (1979) (FTC Policy Planning Issues Paper: Trademarks, Consumer Information and Barriers to Competition, FRC Office of Policy Planning)).

incentives to owners to invest in their trademark not only by improving the quality of the underlying product but also in other ways such as advertising.<sup>666</sup>

A number of scholars<sup>667</sup> adhere to the utilitarian theory to justify trademarks and intellectual property systems. For instance, Peter Menell, argues that utilitarianism is the principal theory to be applied to such works and systems.<sup>668</sup> He asserts that trademarks particularly, are justifiable upon utilitarian terms. In his words: "trademark law is principally concerned with ensuring that consumers are not misled in the marketplace and hence is particularly amenable to economic analysis."<sup>669</sup>

Utilitarian theorists start their argument by studying the benefits and advantages of protecting intellectual creations and trademarks as the basis for justifying their protection and existence. They emphasize the fact that the economic role such creations play is the grounds for the existence of systems protecting them. They provide that trademarks should be accorded protection on the basis that such protection shall result in the maximizing of wealth. The main idea is that more protection and enforcement of trademark legislations will lead to reducing wealth to its optimal levels, "[t]hus, wealth is optimized, or at least increased, by granting" trademark monopolies.<sup>670</sup>

The first and most considered benefit of trademarks is that brand names reduce consumers' search costs.<sup>671</sup> The rationale is that trademarks "facilitate and enhance consumer decisions,"<sup>672</sup> in choosing the product they wish to consume. Consumers will be able to identify the product bearing the mark and distinguish it from amongst other products of the same class of goods.<sup>673</sup> Customers, in future would be able to recognize the good they require without being obliged to differentiate between the products and trying to stipulate which product identifies and fulfils their needs and preferences. For example, a consumer who

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<sup>666</sup> Landes, W. M. and Posner, R.A. 1988. The Economics of Trademark Law. *78 Trademark Rep.* 271-272

<sup>667</sup> Such scholars include William Landes, Richard Posner, Peter Menell, Nicholas Economides, WR Cornish, Jennifer Phillips and others.

<sup>668</sup> Menell, P.S. 1989. Intellectual Property: General Theories in Encyclopedia of Law and Economics: Volume II, 129, 156-163. Retrieved August 13, 2014 from <http://levine.sscnet.ucla.edu/archive/ittheory.pdf>

<sup>669</sup> Ibid at 129, 156-163

<sup>670</sup> Kinsella, N.S. 2001. Against Intellectual Property, *15 J. Libertarian Stud.* 11. Retrieved December 2, 2016 from [http://www.mises.org/journals/jls/15\\_2/15\\_2\\_1.pdf/](http://www.mises.org/journals/jls/15_2/15_2_1.pdf/)

<sup>671</sup> Landes, W.M. and Posner, R.A. 1988. The Economics of Trademark Law, *78 Trademark Rep.* 267, 270. See also Carter, S.L. 1989-1990. The Trouble with Trademark, *99 Yale L.J.* 759, 762

<sup>672</sup> Economides, N.S. 1988. The Economics of Trademarks, *78 Trademark Rep.* 523, 526.

<sup>673</sup> Carter, S.L. *ibid.* at 762

wishes to purchase Nescafe coffee in particular, not any other brand, will be able to distinguish Nescafe from a quick look over the trademark affixed on it. Without the affixed trademark, to predict which bottle contains the Nescafe coffee would be difficult.<sup>674</sup> Trademarks are thereby symbolic and are used by a producer "to identify goods and distinguish them from those manufactured and sold by others."<sup>675</sup>

From the utilitarian perspective, it is believed that producers depend on repeated purchases by their regular customers as trademarks serve to facilitate the identification of a product. This is because a trademark "is easier to recognise and remember; and it is often easier to physically mark on the goods themselves rather than provide the producer's full name and address and this is because consumers do not usually know or recall the full name and address of the producer but will definitely recall the mark itself."<sup>676</sup>

Another benefit of trademarks from this theory's perspective, is that it plays "an unusual ancillary social benefit," according to which, "[a]n entirely different benefit of trademark protection derives from the incentives that such protection creates to invest resources which is the invention of new words."<sup>677</sup> Trademarks enrich the language and improve it in the following ways; first, trademarks increase the stock of words used in everyday life by inventing totally new words that were not used before which would result in "economizing on communication and information costs."<sup>678</sup> In addition, trademarks encourage firms to invest in developing new words or symbols, by "eliminating the risk that competitors will free-ride upon such investments."<sup>679</sup> However, it was noted by the theorists that a disadvantage of trademarks is that it could turn into generic words used by people to identify a whole class of goods and represent the name of a category of products rather than identifying a certain product produced by a certain firm.<sup>680</sup>

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<sup>674</sup> Landes and Posner, op.cit., at 270

<sup>675</sup> Economides, N.S. *ibid.* at 524.

<sup>676</sup> Higgins, D.M. and James, T.J. 1973-1992. The Economic Importance of Trade Marks in the UK. A Preliminary Investigation, 4 (1996). Retrieved from Amin Naser, M., Op.cit at p. 26

<sup>677</sup> Landes, W.M. and Posner, R.A. op.cit. at p. 272

<sup>678</sup> *Ibid.* at 273. Examples are words such Viju, (that is, Viju Milk as a drink), De-Rica (that is, tomato paste) and so on

<sup>679</sup> Menell, P.S. 1989. Intellectual Property: General Theories in Encyclopaedia of Law and Economics: Volume II, 129, 156-163

<sup>680</sup> Jacoby, J. 2001. The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution, *91 Trademark Rep.* 1013, 1031. See Higgins, D.M. and James, T.J. 1996. The Economic Importance of Trade Marks in the UK (1973-1992) A Preliminary Investigation, 4

The theorists also argue that the primary justifications for trademark law is to facilitate and enhance consumer decisions and to create incentives for firms to produce products of desirable qualities even when these are not observable before purchase.<sup>681</sup> If trademarks were not affixed to products, that is, if trademark system did not exist or if those systems did exist but trademarks are not sufficiently protected, then producers would not have the incentive to produce high quality products and would not improve their goods or services. The reason for trademark protection is not far-fetched as consumers will not be able to distinguish between the desired products and will not choose the product they require.<sup>682</sup> Further, if a number of guarantees were not provided, producers of intellectual creations will be reluctant to produce intellectual property and imitators will particularly, free-ride such works without bearing any costs. The result of non-protection is that the possibility would reduce the incentive for a successful firm to mark its goods and would thereby raise consumer search costs.<sup>683</sup> In other words, if someone has products or services of high and superior quality, he or she will be deterred from putting its products or services in the market because the lack of trademark protection will make him/her unable to inform consumers of the qualities of such products or services.<sup>684</sup>

The utilitarian theorists further argue that the economic justification of trademarks does not recognize the rights of the trademark proprietor alone but that it tries to draw a balance between the trademark owner's economic rights and the interests of the consuming public.<sup>685</sup>

The claim of the theorists is the impact such protection will have on the trademark owner's right which would result in the benefit and good for the society as a whole and for others. The claim by the theorists is that, subject to economic terms, the impact of the protection of a trademark owner's rights would result in the benefit and good for the society as a whole and for others; otherwise trademarks protection should not exist. This is because "[the key concept of the economic theory of property rights is that of externality. An externality is an economic situation in which an individual's pursuit of his self-interest has spill-over effects

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<sup>681</sup> Moore, A. D. 2003. Intellectual property, Innovation, and Social Progress: The Case Against Incentive Based Arguments, *26 Hamline L. Rev.* 601, 607

<sup>682</sup> Landes, W.M. and Posner, R.A. *ibid.*, 272

<sup>683</sup> *Ibid.* at 611

<sup>684</sup> Cornish, W.R. and Phillips, J. 1982. The Economic Function of Trade Marks: An Analysis with Special Reference to Developing Countries, *13 Int'l Rev. Indus. Prop. Copyright L.* 41, 46

<sup>685</sup> Zenner, L. *ibid.* at 57

on the utility or welfare of others."<sup>686</sup> The purpose of externality under the law of trade mark is to protect that which has been created by a person so that unauthorized persons would not have the right to use the product without the permission or consent of the owner.

Landes and Posner suggest a model based on economic premises for the justification of trademarks. They define the "full price" of a good or service which is the money price of the good or service plus "the search costs incurred by the buyer in obtaining information about the relevant attributes of the good" or service. According to them, the more a trademark reduces consumers' search costs through providing more information, the more a producer may raise the price of his/her product without exceeding the "full price" which the customer is willing to pay for the good or service. They argue that "[t]he more resources the firm spends developing and promoting its mark, the stronger will its mark be and the lower the consumer search costs so that the firm will be able to charge a higher price."<sup>687</sup>

Products have some features which are unobservable, that is, it has been argued by Economides that trademarks simply play the economic role of assisting consumers to identify those features. However, it has been noted that such identification cannot be achieved without trademarks and the absence of trademark systems will be that consumers have the choice with other identical goods and the resultant effect is the confusion in purchasing products.<sup>688</sup> Economides further argues that in the absence of trademarks "the consumer will only by chance pick the one with the desirable unobservable qualities."<sup>689</sup> Economides concludes that a number of aspects participate in the success of trademarks. Firstly, is the ability of consumers to memorize and recall the trademark, and secondly, the inability of other rivals to use similar or identical trademarks, shall all ensure the efficiency of trademark systems.<sup>690</sup> It was further argued that the economic background legitimizes and presupposes the existence of trademarks.

Several scholars have however argued against Utilitarian theory. It is believed that the theory is artificial and it creates more problems when justifying trademarks. The inadequacies in this theory are manifold, starting from the wealth maximization, incentive and quality products

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<sup>686</sup> Spector, H.M. 1989. An Outline of a Theory Justifying Intellectual and Industrial Property Rights, *11 Eur. Intell. Prop. Rev.* 271.

<sup>687</sup> Landes, W.M. and Posner, R.A., *op.cit.* 277

<sup>688</sup> Economides, N.S., *op.cit.* at 526

<sup>689</sup> *Ibid.*

<sup>690</sup> *Ibid.*



arguments, etc. The artificialness of the utilitarian argument derives from the fact that one could not bring economic and utility terms into legal theory. A theory that justifies trademarks should find a real ground to legitimize the existence of trademarks rights, and to seek justice in granting the rights and imposing obligations amongst the parties in a trademark formula. For example, the presumption that trademarks protection shall provide incentive to producers is subject to economic and market considerations, but not a ground to justify why trademarks should exist. On the other hand, it has been argued that economic rationales are artificial in the context of the justification and theory of trademarks and that legal theory should not be based upon economic considerations.<sup>691</sup>

It has also been argued by scholars that trademark ought to be protected adequately, in any legal system as it aids economic development and where there is economic growth, there will be the determination to produce quality goods. Hence, “trademark protection encourages the development of branding and distinctive products and if there is no protection, business enterprises might lack the incentive to produce quality goods, and putting a limit to commercial transaction. The theorists state that one should not use the fact of reducing consumer search cost to conclude that this reduction creates incentives to producers but this theory has however been challenged by other scholars in that the utilitarian theory is not able to justify any link between consumer search costs and the incentive to produce more quality goods.<sup>692</sup>

Therefore, in lowering the search cost of the products, consumers are able to make an informed choice of what they want to purchase and this is the basis justifying the need for the protection of trademarks. That is, the purpose of trademark law is not only to provide the incentive for the producer to manufacture better goods but protecting such marks would allow consumers to know what they want to purchase and making the right decision with the different products offered up for sale. Hence, the consumer will therefore, be able to distinguish the goods of the producer he knows from the one, that he does not know at all.<sup>693</sup>

The challenge with this theory however is based on that fact that there is no time limit for the protection of trade marks. This could however, create a monopoly because of the non-

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<sup>691</sup> Naser, M. A., *op.cit.* at p. 34

<sup>692</sup> Zemer, L., *op.cit.* at 58; See also Landes and Posner, *op.cit.* at 279

<sup>693</sup> Moffat, V.R. 2004. Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection, 19 *BERKELEY TECH.* 1474, 1488-89

stipulated limitations granted to the owner of a trade mark and the result could be that there will be total control over such marks which could be harmful to other competitors.<sup>694</sup>

The utilitarian and economic theory has been rated by scholars as not being an exhaustive theoretical framework upon which trademark system could be justified. It was further discussed that the theory is founded on economic characteristics which is extremely incompatible with legal theory but that the aspect which is beneficial in the protection of trademarks is the reduction of consumer search cost.<sup>695</sup> However, if this ground is taken solely, the result will be the maximization of the trademark owner's rights, which would be extreme. This would lead to monopoly and unfair competition among other proprietors that are in the same class of goods or services, whilst ignoring the rights of the public to have a say in such matters. It is pertinent to note that in relating to trade marks, the producer/manufacturer of such goods and the consumers are part and parcel of the system of trade marks.<sup>696</sup> Hence, the theory is felt to have failed because of its inability to create an equilibrium between the rights of the trade mark owner and also, the rights of the populace, which is vital for justifying the overall system of trade marks.<sup>697</sup>

### **3.2.2. Labour-based Theory**

John Locke's *Two Treatises of Government*, is a text that was written almost three centuries ago and it discusses property rights.<sup>698</sup> Locke's opinions was on tangible property and there was never any notion to cover industrial property rights, such as trademarks.<sup>699</sup> In describing nature, Locke believed that God was the Supreme Being and that God had given the inheritance of the earth to the children of man.<sup>700</sup> Locke further argued that since Man is the owner of himself, and can work by tilling and cultivating the land, then, he can enjoy the fruits of his labour and what he earns at the end of the day, will be his own to keep and nurture and this would be regarded as his property.<sup>701</sup>

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<sup>694</sup> Naser, M. A., op.cit. at p. 35

<sup>695</sup> Naser, M. A. 2007. Rethinking the Foundations of Trademarks. *Buffalo Intellectual Property Law Journal*, Vol. 5, No. 1, at p.5

<sup>696</sup> Ibid. at p. 35

<sup>697</sup> Ibid. at p.35

<sup>698</sup> Vaughn, K.I. 1978. John Locke and the Labour theory of Value. *Journal of Libertarian Studies*, Vol. 2, No. 4, pp. 311-326

<sup>699</sup> Drahos, P. 1996. A Philosophy of Intellectual Property. Volume 6 of Applied legal philosophy, Dartmouth series in applied legal philosophy, at p. 47. See also Shiffrin, S.V. 2001. Lockean Arguments for Private Intellectual Property, in *New Essays in the Legal and Political Theory of Property* (Stephen Munzer ed., 2001)

<sup>701</sup> Locke *ibid*, at 308.

Locke states that in so far as man improves or cultivates his environment, there will be entitlement to the fruits of his labour. In Locke's common and primitive state, he discusses objects which are sufficient in satisfying the needs of everybody and that there are enough unclaimed goods for labourers to enjoy the fruits of their hard work without infringing upon goods that have been appropriated by someone else."<sup>702</sup> Locke believed in the world that nothing should be wasted and that every person who is able to work, should be entitled to his property and should not take any other person's property as his own.

Locke's theory is subject to a number of restrictions and conditions; these are known as the "no harm principle."<sup>703</sup> The "no harm principle" consists of two conditions which are referred to as "the enough and good condition" and "the non-waste condition".<sup>704</sup> Locke explains that a man is entitled to private property as long as there is enough and as good left to others. In Locke's words: "[n]or was the appropriation of any parcel of Land, by improving it, any prejudice to any other Man, since there was still enough, and as good left; and more than the yet unprovided could use."<sup>705</sup> Locke's theory is however bound with criticisms as it is considered not applicable to trademarks but it is appropriate when justifying copyright or patent.<sup>706</sup>

Under the non-waste condition however, some commentators regard the non-waste condition "as an ugly step- sister of the enough and as good condition,"<sup>707</sup> while others have questioned the need of this condition in the presence of the "enough and as good" condition.<sup>708</sup> For Locke, "[n]o one was entitled to more than was necessary for [his/her] maintenance because the excess would spoil before it could be consumed".<sup>709</sup> He considered this as an offence "against the common law of nature."<sup>710</sup> Hence, no person should appropriate more than the amount he/she could use.

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<sup>702</sup> Hughes, J. 1988. The Philosophy of Intellectual Property, *77 Geo. L.J.* 287, 290

<sup>703</sup> Zemer, L. 2006. On the Value of Copyright Theory *I INTELL. PROP.Q.* 55, 56

<sup>704</sup> Locke, *ibid.* at p. 305-06.

<sup>705</sup> Locke, *ibid.* at p. 209

<sup>706</sup> Port, K.L. 1995. The "Unnatural" Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary? *85 TRADEMARK REP.* 562

<sup>707</sup> Hughes, J., *ibid.* at p.325

<sup>708</sup> Nozick, R. 1974. Anarchy, State and Utopia. Retrieved from Naser, A.M. 2009. *Revisiting the Philosophical Foundations of Trademarks in the US and UK.* Retrieved November 17, 2016 from <https://books.google.com.ng/books?isbn=1443818291>

<sup>709</sup> Byrne, D.M. 1999. Locke, Property, and Progressive Taxes, *78 Neb. L. Rev.* u700, 706

<sup>710</sup> Locke, *op.cit.* at p.313

Locke demonstrates this limitation by stating that what is used by man, should not be wasted and that everything that a man has, is owned by God and hence, in as much as a man can labour and fix a property, then, there should be no wastage.<sup>711</sup> He further stated that for the requirement of property, there is the need for man to work so that he can enjoy the fruits of his labour. In addition, he believed strongly that man should not take the property of another and make it as his own.<sup>712</sup> Where the goods of others are taken, it would worsen the situation of others in that their reputation will be irreparably harmed by the appropriation of their goods and as such, this is prohibited.<sup>713</sup>

This has however been set as not being practical by several scholars. It has been stated that if this condition, is applied to trademarks, this means that not using the mark is a waste, according to Locke's non-waste limitation. Thus, one shall not be able to appropriate a mark if one is not intending to use it. Although trademarks are not literally perishable and could not be spoiled, not using a mark is indeed true waste. The trademark owner shall have monopoly rights over his/her mark, and if it is not used then this is waste because others could have made use of it.<sup>714</sup>

As afore-mentioned, in relation to the labour theory, its applicability to trademarks is of crucial importance because he starts by emphasising on the need in justifying that nobody is entitled to any right if labour is not mixed with property or objects from the commons. Locke's theory in relation to commons has been met with criticisms as 'commons' has no meaning under trademark systems and that it refers to objects rather than to intangible property of which trademark is premised upon. Trademark is not premised on objects and hence, its inapplicability to the protection of marks.<sup>715</sup>

It has also been argued that the Locke's theory does not suffice under trademarks because the production of trademarks does not include any kind of labour and that the mere act of choosing a name from the common of words or symbols and affixing it to goods or services does not include labour and also that trademarks are examples of things that are made effortlessly.<sup>716</sup>

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<sup>711</sup> Ibid. at p. 308

<sup>712</sup> Hughes, J. op.cit at p. 287, 290

<sup>713</sup> Hamilton, W.H. 1932. Property According to Locke, *41 Yale L.J.* 864. 867

<sup>714</sup> Naser, M. A., op.cit.

<sup>715</sup> Wilf, S. 1999. Who Authors Trademarks? *17 CARDoZO ARTS & ENT. L.J.* 1, 30

<sup>716</sup> Nozick, op.cit. at 175.

In addition, the best analogy of the argument that trademarks lack labour in their creation is in the words of the United States Supreme Court, which stated that, “trademarks do not depend upon novelty, invention, or genius and laborious thought; and that trademarks are simply founded on priority of appropriation.”<sup>717</sup>

A contrary argument under this theory is that there is no labour involved in the creation of a mark as against the extent of rights and entitlements but that it would be apt to state that the creation of such marks does include some form of mental labour.<sup>718</sup> In the course of trade, after a mark has been registered, proprietor(s) have the right to protect such marks against third parties that might want to infringe on the goods or services of the owner. Hence, such proprietors are protected under trade mark statutes over a limited period. Hence, the arguments on this theory is that it cannot justify trade mark, being an intangible property and there is no mental labour, which is said to be sufficient enough to grant property rights.<sup>719</sup>

### **3.2.3. Personhood Theory**

This is otherwise known as Hegel’s Theory and it ignores the role that consumers play in the public realm but rather focuses on the individual’s role in affixing a mark on the product in the society. Even though, the personhood theory is not directly applicable to trademarks, it applies to other intellectual property rights such as patents and copyrights.<sup>720</sup>

The inapplicability of this is that the public does not have a role to play under personhood theory but considers the owner as being the only one that has proprietary rights over the product.<sup>721</sup> The theory also does not attribute the relationship between the producer and the consumer as being relevant by its failure to attribute that the public contributes to the creation of the trademark.<sup>722</sup>

### **3.2.4. Social Planning Theory**

"Social planning theory" was invented by Professor William Fisher as a way to congeal various ideas proposing that intellectual property rights "can and should be shaped so as to help foster the achievement of a just and attractive culture."<sup>723</sup> This is regarded as the newest

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<sup>717</sup>Port, K.L. 1992-1993. Foreword: Symposium on Intellectual Property Law Theory, *Chi-Kent L. Rev.* 585, 594 (citing *The Trademark Cases*, 100 U.S. 82 (1879))

<sup>718</sup>Naser, A.M., *op.cit* at p. 16

<sup>719</sup>*Ibid.*

<sup>720</sup>Palmer, T.G. 1990. Are Patents and Copyrights Morally Justified? The Philosophy of Property Rights and Ideal Objects. 13 *HARV. J.L. and Pub. POL’Y* 817, 837

<sup>721</sup>Naser, M.A., *op.cit.* at p. 23

<sup>722</sup>*Ibid.* at p. 24

<sup>723</sup>Fisher, W.M. II 1998. Property and Contract on the Internet, 73 *Chi-Kent L. Rev.* 1214-1215

theory and it is not common like the other theoretical approaches,<sup>724</sup> and it is not widely applied to trademarks as it is to copyrights or patents.<sup>725</sup> One reason could be the commercial aspect of trademarks, which does not lend itself as easily to a dialogue of most of the social planning theory concepts. While trademarks have become important symbols in daily life, extending beyond the underlying products, there may still remain a bias towards viewing trademarks as having nothing more to add to society than mere symbols used to purchase products. While several components of social planning theory have existed as long, or perhaps longer, than the other theories, as applied to intellectual property, it is acknowledged that social planning theory as a whole is less developed and less recognized.<sup>726</sup> This theory has been propounded as having sound foundation in that it creates a fair balance between the rights of the owner and that of the populace.<sup>727</sup>

With the advent of technology, media and social networks, trademark serves as an instrument of advertising and this creates positive implications for the society.<sup>728</sup> With this, the owners of trademarks are able to project the ideas of their mark in the minds of the public.<sup>729</sup> This theory therefore, focuses on the reaction of the consuming public and whether this reaction has any effect on the basis and justification of trademark systems.<sup>730</sup>

The foundation on which Social-Planning theory stands is that it recognizes the rights of the proprietor of the trademark owner and that of the public and attempts to strike a balance between the two parties in that the public has a role to play in the creation of trademarks.<sup>731</sup> The framework for the justification of trademark is premised on the economic-social planning theory. It has been reiterated that trademarks are not only important in reducing consumers' search costs and helping consumers to choose the products they need but the social-planning theory is based on the premise that trademarks protect social interests in the freedom of speech and at the same time, promoting expressive activities.<sup>732</sup> The procedure at which a product is recognised by the public has several stages which must be adhered to until the

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<sup>724</sup>Ibid. at p. 1214

<sup>725</sup> Aoki, K. 2007. Distributive and Syncretic Motives in Intellectual Property Law (with Special Reference to Coercion, Agency, and Development), 40 *U.C. Davis L. Rev.* 717

<sup>726</sup> Fisher, W.M., op.cit. at p. 173

<sup>727</sup> Ibid.

<sup>728</sup> Naser, .M. A., op.cit. at p. 36,37

<sup>729</sup> Ibid. at p. 37

<sup>730</sup> Ibid. at p. 37

<sup>731</sup> Ibid. at p. 37, 46

<sup>732</sup> Coombe, R.J. 1998. The Cultural Life of Intellectual Property 42

public recognises the value of the trademark.<sup>733</sup> The owner of the trademark therefore has the right to use its products and ensure that the trademark is registered, by excluding others from using that same mark.<sup>734</sup>

The Social-Planning theory therefore regulates the rights of the trademark owner with that of the public and this is achieved by linking the rights of the owner and the public. This would lead to both parties basing their rights on economic terms.<sup>735</sup> The best theory for justifying the protection of trademarks tilts towards the economic- social planning which has been propounded to lead to better clarity of the connection between the trademark owner and the consuming public. It states that trademarks are not only important in reducing consumer search costs but that it also helps the consumers to choose the products they desire between all products offered up for sale.<sup>736</sup> The theorists recognise the fact that there are stages which ought to be achieved in the formulation of trademarks: the first stage is that the owner of the trademark would create new word which would be affixed to products and then, puts up such product for sale amongst other products which had also been offered for sale. The second process is that after the public has gone through all the products in the market, it would be able to recognise that a product is better through advertisement and then, the public would recognise such products amongst all other products which has been offered for sale. This process is the most important because of the recognition which had been given to the product by the public. Hence, be that as it may, the public has a role to play when the products of the owner are offered up for sale as this will determine the success of the product.<sup>737</sup>

In the expansive world of goods and services, trademark should be protected globally, for their main functions as source and origin identifiers. However, as the principle of territoriality states, the owner's protection is confined to the territory in which the trademark was registered. In addition, this theory further states that other traders would be allowed to use similar goods so long as their use does not create confusion in the mind of consumers as to the source and origin of the products; and that anyone who passes off a good as his own, would be regarded as an infringer.<sup>738</sup>

### **3.3. International Instruments on Trade Marks**

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<sup>733</sup> Naser, M. A., *ibid.* at p. 37

<sup>734</sup> *Ibid.* at p. 46

<sup>735</sup> *Ibid.* at p. 47

<sup>736</sup> Coombe, R.J. 1998. *The Cultural Life of Intellectual Property*, 42

<sup>737</sup> Naser, M.A., *op.cit.* at p. 46

<sup>738</sup> *Ibid.* at p. 46

In early times, it was only possible to receive protection of trademarks at the national level. However, as a result of industrialization, it became necessary to create protection for industrial property rights on the international level also.<sup>739</sup> The non-existence of a uniform international legal protection for trademark meant that if an enterprise used a sign as a trademark which was protected under national law and thereafter, entered the market in another country, there was the risk that its trademark would not be protected under the national law of that particular country. Hence, the need for an international protection of trademarks arose because of the fear that the free exchange of goods and services could be severely hampered.<sup>740</sup>

Trade marks, though governed essentially by domestic law, are quite to an extent subject to international law. This cannot be avoided as marked goods are traded across international boundaries.<sup>741</sup> Hence, countries in order to protect their marks have signed on agreements facilitating the protection of trade marks. Such conventions include the Paris Convention 1883. TRIPs Agreement 1994, Nice Agreement 1957.<sup>742</sup> Other treaties include Vienna Agreement Establishing the International Classification of the Figurative Elements of Marks 1973; the Madrid Protocol on the International Registration of Trademarks 1989; and the Trademark Law Treaty 1994.<sup>743</sup> However, Nigeria is a member only to the Paris Convention and TRIPs and therefore, this study will elaborate extensively on these conventions.

The Paris Convention and TRIPs both include general principles for the protection of intellectual property rights and provide specific trademark rules. These general principles deal with the substance and procedure of protection and apply to all industrial property rights.<sup>744</sup> In the world today and in order to keep up with the economic trends and challenges globally, Nigeria signed to various international conventions for the rapid development and appreciation of intellectual property, brand names and quality products as an intangible

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<sup>739</sup> Gausmann, C. 2005. Protection of Trademarks under International Law. Faculty of Law, University of Lund. Retrieved August 13, 2013 from <https://lup.lub.lu.se>

<sup>740</sup> Gausmann, C. *ibid.*

<sup>741</sup> Shyllon, F., *op.cit.* at p. 227

<sup>742</sup> Nice Convention concerning the International Classification of Goods and Services for the Purposes of the Registration of Trade Marks, June 14, 1957, last revised at Geneva October 2, 1979, 23 U.S.T. 1336, 550 U.N.T.S. 45

<sup>743</sup> Shyllon, F., *ibid.* at p. 227

<sup>744</sup> Schmidt-Szalewski, J. 1989. The International Protection of Trademarks after the TRIPs Agreement. *Duke Journal of Comparative and International Law*. Vol. 9: 189



business asset.<sup>745</sup> Nigeria signed the Paris Convention and the TRIPs in 1963 and 1995 respectively.

### 3.3.1. Paris Convention of 1883

The Paris Convention is the oldest international treaty and relates to intellectual property of which countries such as Nigeria, Canada, the United States and United Kingdom are its members. As at the time of writing this study, there were 172 member countries under the Paris Convention.<sup>746</sup> It therefore provides the relevant procedural provisions stating that each member state must establish a special industrial property service and a central office for the communication to the public of patents, utility models, industrial designs, trademarks but each member state's industrial property service must publish an official periodical sheet.<sup>747</sup>

In relation to industrial property, what is applicable to member countries under the Paris Convention are the principles of national treatment and independence of rights which are to be strictly adhered to.<sup>748</sup> A member state may not however, subject foreigners benefiting from such Convention to higher industrial property protection standards than those applicable to its own citizens.<sup>749</sup> It is therefore not necessary to justify that a trademark has been registered in the country of origin prior to registering it in another member state.<sup>750</sup> For instance, if a citizen or corporation of Singapore wishes to obtain an industrial property right in France, where both countries are Paris Convention member states, the Singapore national will obtain the right under the same conditions as a French citizen or corporation and the same would apply to a Nigerian citizen also.<sup>751</sup>

The principle of national treatment provides that a member state may refuse industrial property rights protection to citizens or corporations of states that are non-members of the Paris Convention.<sup>752</sup> A non-member state may therefore be subject to stricter conditions than those applicable to its own nationals.<sup>753</sup> The national treatment principle was the first

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<sup>745</sup> Ibid.

<sup>746</sup> Mostert, F.W. 2004. Famous and Well-Known Marks: An International Analysis. Published by International Trademark Association (2<sup>nd</sup> Edition) 1-29:1-30

<sup>747</sup> Article 12, Paris Convention 1883

<sup>748</sup> Schmidt-Szalewski, J., op.cit. at pp. 193-194. See Shyllon, F. 2003. *Intellectual Property Law in Nigeria*. Published by Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, at p. 227

<sup>749</sup> Article 2(1) of the Paris Convention, *ibid.*

<sup>750</sup> Article 6(2) of Paris Convention, *ibid.*

<sup>751</sup> Schmidt-Szalewski, J. , *ibid.*, Vol. 9: 189

<sup>752</sup> *Ibid.* at p. 194

<sup>753</sup> *Ibid.*

elementary and efficient rule aimed at facilitating the international protection of industrial property rights.<sup>754</sup> This principle, asserted in 1883, has now been introduced into TRIPS and applies between all TRIPS member states.<sup>755</sup> The independence of trade marks principle states that a mark duly registered in a country of the union shall be regarded as set apart from the marks registered in other countries of the Union, including the country of origin. Hence, when a mark has been registered, it would not affect any decision taken with respect to similar registrations for the same marks in all other countries automatically.<sup>756</sup>

The Convention also obliges a member country to cancel registration and to prohibit the use of a trade mark that is liable to create confusion especially with another mark that is originally well-known in that other member country.<sup>757</sup> Therefore, a trade mark may have been used in a country in the sense that goods bearing that mark must have been sold there, yet it may be well-known in the country due to publicity in that country for advertising to other countries.<sup>758</sup>

Under the Paris Union, service marks do not have to be registered but member states have an obligation to do so.<sup>759</sup> A member country therefore, may comply with the provision not only by introducing special legislation for protecting service marks, but also by granting such protection through other means, for instance, in its laws against unfair competition.<sup>760</sup>

Under the United Kingdom (UK) law, traders on a local level may protect their marks on a transnational basis.<sup>761</sup> The UK is a party to international conventions for the protection of trade marks such as WIPO, the Paris Convention, and more recently, the WTO TRIPs Agreement.<sup>762</sup> The main aim or advantage of international registration is that instead of trade mark holders having to file a series of applications in each of the jurisdictions in which they would like to protect, they are able to obtain protection in a range of jurisdictions with a single application.<sup>763</sup>

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<sup>754</sup> Reichman, J.H. 1989. Intellectual Property in International Trade: Opportunities and Risks of a GATT Connection. *Vand. J. Transnat'l L.*, 22

<sup>755</sup> Article 3, TRIPs 1995

<sup>756</sup> *Ibid.*

<sup>757</sup> Article 6bis, Paris Convention, *op.cit.*

<sup>758</sup> *Exxon v. Exxon Nominees* (1989) F.H.C.R. 1

<sup>759</sup> Article 6sexies, Paris Convention, *ibid.*

<sup>760</sup> Article 6sexies, *ibid.*

<sup>761</sup> Bainbridge, D. *Op.cit* at p. 820

<sup>762</sup> *Ibid.* at p. 821

<sup>763</sup> *Ibid.* at p. 907

### **3.3.2. Madrid Agreement**

Under the Madrid Agreement<sup>764</sup> it is possible to register a trade mark at the national level and then to apply to have the mark recognized by the WIPO in Geneva as an international registration. However, the United Kingdom and Nigeria are not parties to this agreement.<sup>765</sup> Under the Madrid Agreement, registration lasts for 20 years and is renewable for further 20-year periods.<sup>766</sup>

### **3.3.3. Madrid Protocol**

The Madrid Protocol<sup>767</sup> was established so as to provide an alternative mechanism to the Madrid Agreement for the international filing of marks. There are more countries that have signed under this protocol and it is considered a success in this regard. The United Kingdom became a party to the above protocol and became operational on 1 April 1996. Nigeria is not a party to the above Protocol. Registration under the Protocol lasts for ten years with the possibility of being renewed for further ten-year periods.<sup>768</sup>

### **3.3.4. WTO Trade-Related Aspects of Intellectual Property Rights (TRIPs)**

WTO TRIPs agreement is considered the most complete international treaty in intellectual property in recent times<sup>769</sup> and is referred to as the most ambitious and far reaching agreement on the protection of intellectual property.<sup>770</sup> TRIPs provides the minimal rules of protection for all intellectual property rights including patents, unpatented know-how, trademarks, industrial designs and models, semi-conductor chips, geographical names,

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<sup>764</sup> Madrid Agreement Concerning the International Registration of Trade Marks of 14 April, 1891 and entered into force on 15 July 1892. It has been revised on a number of occasions and the last time at Stockholm on 14 July, 1967

<sup>765</sup> Ibid.

<sup>766</sup> Kaufman, I. 1990. Madrid Agreement: Will Reform Proposals Attract More Members? EIPR 407. See Bainbridge, D. op.cit at p. 908

<sup>767</sup> Protocol Relating to the Madrid Agreement Concerning the international Registration of Marks which was signed at Madrid on 28 June 1989

<sup>768</sup> Articles 6(1) and 7(1), Madrid Protocol 1989

<sup>769</sup> This is an international instrument which is included in the 1994 Marrakesh Convention that created the World Trade Organization (WTO) and entered into force in 1995. See further, WTO TRIPs Agreement, enacted April 15, 1994, Marrakesh Agreement Establishing the World Trade Organization [hereinafter WTO Agreement], Annex 1C, Legal Instruments-Results of the Uruguay Round, Vol. 31, 33 I.L.M. 81 (1994)

<sup>770</sup> Shyllon, F., op.cit. at p. 21

copyrights, and other related rights.<sup>771</sup> TRIPS is also the first international treaty to introduce a system of sanctions against members who do not enforce the minimum protection of intellectual property rights.<sup>772</sup>

It stipulates certain principles governing international intellectual property protection. One of such principles is that of national treatment and it provides that any advantage, privilege or immunity adduced by a member to a national of any other country shall be accorded unconditionally to the nationals of all other member countries.<sup>773</sup>

Under TRIPs, distinctiveness is the basis for the protection of trademarks and members have the discretion to stipulate, as a condition of registration that signs be visually perceptible. Members also under this agreement, are not obliged to provide for registrability of sound and smell marks. Where a mark has been duly registered, the owner of the mark is vested with the exclusive right to prevent others from using that same mark as it could result in confusion.<sup>774</sup> It further protects well-known marks and signs used in relation to services.<sup>775</sup>

Articles 15- 21 of the TRIPs Agreement lay down provisions that deal with the rules for protection of trademarks.<sup>776</sup> These provisions deal with the conditions and content of the protection by stating principles which member states must enforce.<sup>777</sup>

Article 15 (1)<sup>778</sup> establishes a uniform definition of a trademark that was absent from the provisions of the Paris Convention and it includes all signs and combination of signs that are capable of distinguishing one product from the other. Under the TRIPs agreement, distinctiveness is the sole substantive condition for the protection of a trademark. That is, signs must not only be distinctive but must be capable of goods or services, being distinguishable from one undertaking to those of all other undertakings. Hence, the marks

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<sup>771</sup> Article 1(2) & pt. II, TRIPS Agreement 1995

<sup>772</sup> Reichman, J.H. 1995. Universal Minimum Standards of Intellectual Property Protection under the TRIPS Component of the WTO Agreement, 29 *INT'L LAW*. 345, 347

<sup>773</sup> Article 4, TRIPs Agreement, *ibid.*

<sup>774</sup> Oyewunmi, A. *op.cit.* at p. 325

<sup>775</sup> *Ibid.* at p. 325

<sup>776</sup> Heald, P.J. 1996. Trademarks and Geographical Indications: Exploring the Contours of the TRIPS Agreement, 29 *VAND. J. TRANSNAT'L L.* 635, 637-43; See also Schwab, B.W. 1994. The New Era in Trademark Treaties and Multinational Agreements, in *Global Trademark and Copyright* 169, 173-79

<sup>777</sup> Reichman, J.H., *ibid.* at p. 345, 362-63; See also Otten, A. and Wager, H. 1996. Compliance with TRIPS: The Emerging World View, 29 *Vand J. Transnat'l* 391, 394, 399-400

<sup>778</sup> Article 15 (1), TRIPs Agreement 1995

that do not have any distinctive or distinguishing character cannot be registered under TRIPs.<sup>779</sup>

Under TRIPs, member states may exclude from protection signs that cannot be perceived visually such as sound marks and it does not specifically exclude three dimensional marks but the question is to determine whether such a form distinguishes the product or service it is meant to identify.<sup>780</sup>

A mark can therefore, be refused on grounds of lack of distinctiveness and it is permissible only to the extent that the grounds do not conflict with the provisions of the Paris Convention.<sup>781</sup> Registration would be denied where a mark infringes on the prior rights of third parties,<sup>782</sup> or where the mark is devoid of any distinctive features or if it wholly includes graphic terms,<sup>783</sup> and is contrary with recognised public policy or if the mark is immoral and generally offends the public.<sup>784</sup>

Registration may be dependent on use but actual use cannot constitute a condition for the filing of the application under the TRIPs Agreement.<sup>785</sup> Despite the provision under Article 6sexies, which provides that service marks do not have to be registered but member states have an obligation to protect service marks and that the nature of a product or a service applied for, would not stop it from being so registered.<sup>786</sup>

Article 15(5) of TRIPs only provides for the obligation to publish the trademark either before or immediately after registration and to allow suitable opportunity for an opposing party to apply for cancellation of the registration and while an opposition procedure may be provided, it is not required.<sup>787</sup>

Under Article 16, TRIPs recognises the established nature of the right of the trademark holder. The registered owner thereby, has the exclusive right to use the trademark for designation of such goods or services listed in the registration.<sup>788</sup> Hence, the trademark

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<sup>779</sup> Article 15 (1), TRIPs Agreement 1995

<sup>780</sup> Ibid

<sup>781</sup> Article 15(2), *ibid*

<sup>782</sup> Article 6*quinquies*(B)(1), Paris Convention 1883

<sup>783</sup> Article 6*quinquies* (B) (2), *ibid*

<sup>784</sup> Article 6*quinquies* (B) (3), *ibid*.

<sup>785</sup> Article 15 (3), TRIPs Agreement, *ibid*.

<sup>786</sup> Article 6sexies, Paris Convention 1883 and Article 15 (4), TRIPs Agreement, 1995

<sup>787</sup> Article 15 (5), TRIPs Agreement 1995

<sup>788</sup> Article 16(1), Paris Convention 1883

owner, otherwise known as the right-holder may forbid third parties from using the mark but may also authorise its use when it has to do with assignees and licensees, as long as it is with the consent of the proprietor of the mark. In both respects, TRIPs provides for more detailed rules than what is contained in the Paris Convention.<sup>789</sup>

The rationale behind the need for registration is that it allows the proprietor to have the right, within a stated statutory period, to prevent certain persons, who are third parties from using goods or services that are similar or closely resemble each other in the course of trade. During the term of protection (a minimum of seven years that may be renewed indefinitely),<sup>790</sup> the owner of a trademark enjoys the right, which is exclusive, to prevent unauthorised persons from using, in the course of trade, similar signs for goods or services. The presumption of misconception arises where identical signs are used for such products or services amongst the general public which would invariably result in a likelihood of confusion.<sup>791</sup>

Article 16<sup>792</sup> makes provision for the protection of well-known marks which takes into account knowledge of the trademark in the relevant sector of the public and including knowledge which has been obtained through promotion of the trademark. In other words, a mark may be protected even if it is not yet recognised by the general public and it can be so recognised through use of the trade mark.

### **3.3.5. Regional Frameworks for Intellectual Property Protection in Africa**

There are two regional intellectual property systems and they include the African Regional Intellectual Property Organisation (ARIPO) and the African Intellectual Property Organisation (OAPI). Nigeria is not a member of the organisations but it has observer status at ARIPO.<sup>793</sup>

#### **3.3.5.1. The African Intellectual Property Organisation (OAPI)**

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<sup>789</sup> Ibid.

<sup>790</sup> Article 18, TRIPs Agreement, 1995

<sup>791</sup> Article 16, Paris Convention 1883

<sup>792</sup> Article 16, Paris Convention 1883

<sup>793</sup> Oyewunmi, A.O., *ibid.*, 331

These consists of twelve (12) African countries that speak French and established under the Libreville Agreement of 1962, which later became the Bangui Agreement.<sup>794</sup> The Libreville Agreement provides for a uniform system of protection for industrial property such as registration of trademarks, patent and designs. The OAPI was named after the French *Organisation Africain de la Propriete Intellectuelle*, and entered into force on 8 February 1982.<sup>795</sup> The members that have come together under the umbrella of OAPI are seventeen countries.<sup>796</sup>

### **3.3.5.2. The African Regional Industrial Property Organisation (ARIPO)**

The Agreement entered into force on 15 February 1978 and it consists of English-speaking African people. Membership in ARIPO is open to all member states of the African Union.<sup>797</sup> Nigeria is not a member but has an observer status in the organisation.<sup>798</sup>

### **3.3.6. Nice Classification**

This was established by the Agreement concluded at the Nice Diplomatic Conference, on June 15, 1957, and was revised at Stockholm, in 1967, and at Geneva, in 1977 and it is for the purpose of ensuring that goods or services, which are not contrary to public policy, can be registered as trademarks.<sup>799</sup>

Member countries constitute a Special Union within its framework.<sup>800</sup> Each of the countries is obliged to apply the Nice Classification in connection with the registration of marks, either as the principal classification or as a subsidiary classification and this is mandatory at the national and international levels. Upon submission, there must be documents and publications beneficial to trade mark and should also include numbers of such classes which such products belong for easy referencing.<sup>801</sup>

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<sup>794</sup> Ibid.

<sup>795</sup> Shyllon, F., *ibid.* at p. 24

<sup>796</sup> Oyewunmi, A.O., *op.cit.*, at p. 333. The members are Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Cote d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo

<sup>797</sup> Ibid., at p.331

<sup>798</sup> Oyewunmi, A.O., *op.cit.*, 331. Member states include Botswana, Ghana, Zambia, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sierra Leone, Somalia, Sudan, Sao Tome and Principle, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe

<sup>799</sup> World Intellectual Property Organization. 2001. International Classification of Goods and Services For the Purposes of the Registration of Marks. WIPO Publication No. 500.2 (E). Retrieved September 28, 2017 from <http://www.wipo.int/export/sites/www/classifications/>

<sup>800</sup> Ibid.

<sup>801</sup> MITEA Law. International Trademark Registration. Retrieved September 10, 2017 from <http://mitevalaw.com/services/international-trademarks/>

Countries that are not members are allowed to use such classifications for registering trade marks in their own country and Nigeria falls into this category.<sup>802</sup> The NTMA does not include service marks in its definition of what constitutes a trademark for registration purposes.<sup>803</sup> In its trademark practice however, Nigeria makes use of the Nice Classification despite the fact that the country has no provisions for the registration of service marks, and neither is it a member.<sup>804</sup>

### **3.4. International Instruments on Trademarks in Nigeria**

The international instruments were signed to facilitate the international protection of industrial property rights. Nigeria domesticated the provision under the Paris Convention and TRIPs but has not ratified either provisions of the convention under its laws, which is the NTMA.

Consequently, the categories of people such as corporations, legal practitioners, or individuals, can apply in the registration of a trade mark in the place where it was indeed registered and can also be effected in other countries apart from the original country. It is pertinent to note that registration must first be done in the home country of the applicant before any other such application in Convention countries and the registration will start operating from the same date of the application in the Convention country. The clause however under this provision is that the request for registration will not apply if the time limit of 6 months is not followed in that other country. The essence of the time limit is just to ensure that the applicant follows due process in the application of the proposed trade mark that is to be registered. Be that as it may, the law is not accountable if any form of infringement were to occur before the actual date that the trade mark is to be registered and the proprietor in this case, will not be able to claim any compensations. Therefore, for any claimant to enjoy any rights whatsoever, the dictates of the law must be followed and adhered to.<sup>805</sup>

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<sup>802</sup> See Mordi, M. 2011. Towards Trademark Law Reform in Nigeria: A Practitioner's Note in *NIALS Journal of Intellectual Property*, Nigeria 193 at 204.

<sup>803</sup> Section 67, Trade Marks Act, *ibid*.

<sup>804</sup> *Ibid*. Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, Nice Agreement (1957), revised at Stockholm (1967), and at Geneva (1977), and amended in 1979 (Nice Union). Retrieved October 15, 2014 from <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/nice.pdf>.

<sup>805</sup> Section 44, NTMA, *op.cit*.



The NTMA further provides the criteria in which an applicant may ensure that a trade mark is protected. In other words, the proprietor can register in only one of the countries that is a party to the Convention and it will be as if he registered in all other countries. Hence, the essence of the treaty is to ensure a one-stop application that ensures protection at all levels.<sup>806</sup> Where there is an agreement between two or more convention countries, it would be proportionate as if that application had been made in any other convention country apart from the original country. It further provides that an application is said to have been made and deemed appropriate where the person registering a trade mark in a Convention country has conformed to the laws of the land. This provision maintains its priority right in relation to member countries of any of the international treaty.<sup>807</sup>

It should be noted that a Convention country is one that has agreed to adhere to its rules as laid down in the treaty. However, a country can only be regarded as such where the President has made an order as to whether a country should or should not be so stated.<sup>808</sup> It is however uncertain whether there is in existence any order so made by the President as to whether the Conventions should be included in the domestic law. It is also not clear why there should be such an order by the President and to what effect would it have on the Paris Convention and TRIPs. It is very essential to note that before any law is adopted into Nigeria, it must go through the necessary readings in the National Assembly before it can be domesticated.<sup>809</sup>

On the other hand, the UK provides for international instruments, such as the Paris Convention, WTO TRIPs Agreement, and the Madrid Protocol and this is included under the UKTMA for the protection of trademarks.<sup>810</sup> Under this law, there is no provision stating that the parliament must first make a declaration before it is enacted in the UKTMA. The essence for the protection of marks, on an international scale is to ensure that the incidences of infringement are reduced because if this is not put in place, counterfeit goods will run parallel to original goods and this would create a friction between the two as consumers will be confused as to the authenticity of such products.

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<sup>806</sup> Section 44 (4), NTMA, *ibid.*

<sup>807</sup> Section 44(5) NTMA, *op.cit.*

<sup>808</sup> Section 44(5), NTMA, *ibid.*

<sup>809</sup> Section 12, Constitution of the Federal Republic of Nigeria, 1999 (As Amended)

<sup>810</sup> Sections 53 -55, UKTMA, Cap. 26, 1994

## **CHAPTER FOUR**

### **INFRINGEMENT OF TRADEMARKS, TRADE DRESS AND REMEDIES**

This chapter will discuss trademark infringement in Nigeria and United Kingdom. The study will examine other categories of trademark infringement which are non-existent under the Trade Marks Act in Nigeria.

#### **4.1. Infringement of Trademarks in Nigeria**

An infringement of trademark occurs when an identical or similar mark, which is known but used on a different package is put on display amongst people who are aware of the trade mark but may be confused, when the original and fake goods are put side by side. There is the mistaken belief on the part of the populace that the similarities between the marks are so alike, and that they belong to same trader.<sup>811</sup> In *Oladipo & Tinuola v. Thawardas*,<sup>812</sup> the Plaintiffs were the registered proprietors of a mosquito coil trade mark and they instituted an action against the Defendant for infringement of their mark. The Plaintiffs' contention is that the Defendant imported and sold some quantities of mosquito coils in boxes which carry the device of an elephant's head, and which said symbol, is an essential feature of their trade

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<sup>811</sup> Intellectual Property Office. Infringement: What is trade mark infringement? Retrieved Jan. 1, 2015 from [www.wipo.int](http://www.wipo.int)

<sup>812</sup> [1917-1976] 1, I.P.L.R., 196, 198

mark as shown in boxes which carry the device of an elephant's head. This symbol is used in marketing their product and also advertised in the newspapers/posters. It was alleged that the defendant's mark was similar to that of the plaintiffs and it was apt to mislead consumers into thinking that the goods of the claimant look like that of the respondent. Hence, it could lead to a misconception of surrounding facts in relation to the goods of the plaintiff and the defendant. It was however held that it is the duty of the court to determine likelihood of deception based on any factual situations. The question whether one mark is likely to cause confusion with another, is a matter for the learned judge to decide and he cannot abdicate the decision to witnesses before him in an infringement action. In doing this, he must be guided by the evidence placed before him and not merely on an inspection of the marks. In the inspection, the two sides must provide satisfactory evidence in the determination of the case.

It was further held in the above case, that there was no evidence before the Court that the essential feature of the Plaintiff's Mark which was an elephant's head, is widely known in Nigeria or that its adoption by the Defendant on the said products which was sold by him was calculated to mislead the general public. The court held that there is the need for satisfactory evidence and in the absence of adequate and satisfactory evidence, an order of non-suit is accordingly entered.<sup>813</sup> On the other hand, where the registered mark has a significant reputation, infringement may also arise from the use of the same or a similar mark which, although may not cause confusion, damages or takes undue and unfair advantage of the reputation of the registered mark. This may arise occasionally from the use of the same or similar mark for goods or services which are dissimilar to those covered by the registration of the registered mark.<sup>814</sup>

Section 13,<sup>815</sup> provides that where a mark is sought to be registered, it should not be similar to another mark that has already been registered and recorded in the Trade Mark Register. It is however, not in all cases, that a mark which is similar would not be registered. It is the duty of the Registrar to declare whether or not, a mark to be registered is indeed valid even though the goods resemble each other. Hence, it is at the discretion of the Registrar or by an Order of

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<sup>813</sup> *Oladipo & Tinuola v. Thawardas* [1917-1976] 1 I.P.L.R. at p. 190, 191

<sup>814</sup> *Ibid.*

<sup>815</sup> Section 13, NTMA, Cap. T13, Laws of the Federation 2004

the Court that this will suffice.<sup>816</sup> This means that a trade mark should be capable of distinguishing goods or service of one undertaking from those of other undertakings.

Trademark infringement occurs whereby a registered mark is used without the consent of the trademark owner and such use must be in connection with goods or services but its use must be in a manner which is likely to cause confusion, deception, or mistake about the originating source of the goods and/or services.<sup>817</sup> Trademark infringement is usually related either to the senior user or the junior user. The senior user is the owner of the trademark while the junior user is the interloper. A trademark infringement is the unauthorised use of a product by another person, who is considered the junior user and this infringement misleads the consumer to believing that the junior user's product is manufactured by the senior user, thereby devaluing the worth of the senior user's mark.<sup>818</sup>

In the United States, to establish a violation of the Lanham Act,<sup>819</sup> the Court considers the following before the case can be determined. It could therefore be premised for either a registered mark,<sup>820</sup> or an unregistered mark,<sup>821</sup> or where the plaintiff has to establish that it has a valid and legally protectable mark; or that the use of the mark by the defendant would likely amount to confusion in the identification between such goods or services.<sup>822</sup> A standard which the court uses in analysing infringement cases is viewed as the "linchpin" of trademark infringement tests. Hence, the test measures the "likelihood that a number of prudent purchasers are likely to be misled, or indeed simply confused, as to its origin or otherwise of the goods. In assessing the public's likelihood of confusion, the courts have developed a multi-factor test that considers: the strength of the mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers.<sup>823</sup> The essence of this test is to ensure that both sides are treated fairly in the determination of each

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<sup>816</sup> Section 13(2) (3), NTMA, *ibid*.

<sup>817</sup> United States Patent, Trademark Office (USPTO). Trademark Infringement. Retrieved February 1, 2016 from [www.uspto.gov/page/about-trademark-infringement](http://www.uspto.gov/page/about-trademark-infringement)

<sup>818</sup> Examples could be the unauthorised use of the Nike swoosh on sportswear, see *Nike Inc. v. "Just Did It" Enters.*, 6 F.3d 1225, 1232-33 (7th Cir. 1993); or using the trademark Ms. Dior of Flatbush for a dry cleaning business, see *Christian Dior, S.A.R.L. v. Miss Dior of Flatbush, Inc.*, 173 U.S.P.Q. 416, 417 (E.D.N.Y. 1972)

<sup>819</sup> The Lanham Act is the Federal Law for all the states in the United States of America

<sup>820</sup> This provision is contained under 15 U.S.C. Sections 1114, Lanham Act of 1946

<sup>821</sup> This is under 15 U.S.C. Sections 1125(a) of the Lanham Act, 1946

<sup>822</sup> Legal Information Institute (LII). Trademark Infringement. Retrieved February 1, 2016 from [https://www.law.cornell.edu/wex/trademark\\_infringement](https://www.law.cornell.edu/wex/trademark_infringement)

<sup>823</sup> *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

case. Therefore, the test focuses primarily on consumer confusion and a trademark owner who is unable to demonstrate such confusion may not prevent the unauthorised use and subsequent weakening of a mark through an infringement action.<sup>824</sup>

In the landmark case of *Patkum Industries Ltd. v. Niger Shoes*,<sup>825</sup> the Plaintiff, a registered proprietor of trade mark described as “NISHMACO” and registered as No. 17229 in Nigeria in respect of shoes, slippers (Foot wears) and all goods included in the Class. The Plaintiff alleged that the Defendant sold, distributed, and imported goods in particular, Slippers, not of the Plaintiff’s manufacture but for goods of the Plaintiff’s manufacture and said acts constitute an infringement of their Trade Mark, namely “NISHMACO” and passing off same thereof. The Plaintiff prayed for an injunction restraining the Defendant and those claiming under him from passing off his goods as their own. It was held that the Federal High Court has jurisdiction to hear cases of alleged infringement of registered marks that are not immoral under the NTMA.<sup>826</sup>

In *Dyktrade Ltd. v. Omnia Nigeria Ltd.*,<sup>827</sup> the Court held that registration of a trademark will entitle the proprietor to sue or institute an action for any infringement of such mark. In *Bell Sons & Co. v. Godwin Aka & Anor.*,<sup>828</sup> the Appellant is the registered proprietor of a Trade Mark Exhibit AMF 1 registered in Class 3 of the Register in respect of castor oil and other pharmaceutical products on 19 April, 1958. The Respondent sought to register Exhibit AMF 2 in the same class and in respect of castor oil. The Appellant filed a Notice of Opposition before the Registrar of Trade Marks. The grounds for the objection/opposition is that the Mark sought to be registered by the Respondents is in all material respects identical to the Appellant’s mark and clearly intended to or calculated to deceive and is not entitled to registration as a trade mark. The Respondents as Applicants applied to the High Court for an order that notwithstanding the opposition, the registration be proceeded with by the Registrar of Trade Marks. It was held that the ears as well as the eyes have to be employed with reference to the comparison between the two marks. Also, whether a Mark is potentially capable of being so mistaken for another one is a question of fact to be decided after a comparison of the two products. The law of Trade Marks is aimed at the subtle as well as to

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<sup>824</sup> McCabe, K.B. 2000. Dilution-by-Blurring: A Theory Caught in the Shadow of Trademark Infringement, 68 *Fordham L. Rev.* 1827. Retrieved October 4, 2016 from <http://ir.lawnet.fordham.edu/flr/vol68/iss5/13>

<sup>825</sup> [1977-1992] 2, I.P.L.R. 373

<sup>826</sup> Section 3, NTMA, Laws of the Federation 2004

<sup>827</sup> [1997-2003] 4, I.P.L.R. 250

<sup>828</sup> *Bell Sons & Co v. Godwin Aka & Anor* [1917-1976] 1, I.P.L.R., p.287

the obvious infraction of it and both the ears and eyes must be together in the exercise of comparison.<sup>829</sup>

The likelihood of confusion is the central focus of any trademark infringement claim in Nigeria and it exists when consumers view the mark as similar and that the product or service it represents is associated with the source of a different product or service. In determining this, the courts would apply two different standards to directly competing goods as opposed to non-competing goods. Where therefore, the alleged infringer and the trademark owner deal with such goods or services, which are deemed to be competitive and similar, they will be compared side by side to determine whether consumers would be confused when they come into contact with such goods. On the other hand, where the goods in question are completely unrelated, confusion is unlikely and infringement will generally not be found.<sup>830</sup>

In *Nigeria Distillers Ltd. v. Gybo and Sons & Anor*,<sup>831</sup> it was held that the question which is crucial in determining whether or not a name is so similar as to constitute an infringement of the plaintiff's trade mark, "Bacchus" is whether the person who sees the word, "Cacchus" in the absence of the Plaintiff's mark, "Bacchus" would be deceived as to conclude that the defendant's mark is similar to that of the plaintiff. The mark to be registered must not, when compared with what is already registered, deceive the public or cause confusion.<sup>832</sup>

In *British American Tobacco (Nig.) Ltd. & Anor v. International Tobacco Company Ltd.*,<sup>833</sup> it was held that an infringement of trade mark would arise where a person, not being the owner, or a registered user, makes use of a mark which is identical or closely resembles an existing trade mark. The use of such mark is likely to cause confusion amongst consumers, who would believe that there is a connection between the two parties in the course of trade.<sup>834</sup>

Therefore, in determining whether two Trade Marks are identical or of close resemblance as to create confusion, two senses of the human being are employed. These are senses of ear and the eyes to arrive at a conclusion on the average memory arising from the general recollection. In the exercise of comparison, it is wrong to take the two Trade Marks side by side to determine whether they are identical or some close resemblance exists. The issue

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<sup>829</sup> Ibid., at 289

<sup>830</sup> Legal Information Institute (LII). Trademark Infringement. Retrieved February 1, 2016 from [https://www.law.cornell.edu/wex/trademark\\_infringement](https://www.law.cornell.edu/wex/trademark_infringement)

<sup>831</sup> [1997-2003] 4, I.P.L.R. 464

<sup>832</sup> *Alban Pharmacy Ltd. v. Sterling Products International Ltd.* (1968) 1 all N.L.R. 300

<sup>833</sup> (2003-2007) 5, I.P.L.R. p. 285, 280, 272

<sup>834</sup> Section 5(2) NTMA, Cap. T13, Laws of the Federation 2004

therefore is whether the person who sees or has seen the proposed Trade Mark will confuse it with the existing Trade Mark, as to create confusion and be deceived that the proposed Trade Mark is the same as the existing one.<sup>835</sup>

In relation to infringement of Trade Mark, there is a duty on the Court to consider any essential features in deciding whether two marks are confusingly similar as the mark alone must be considered and separated from the associated features or get-up. Evidence is however tendered, to show which of the features in the Register of Trade Marks are essential. However, for the purpose of deciding whether there has been an infringement or not, is to determine whether or not there is resemblance between the two trademarks as to give rise to infringement by one of the Trade Marks.<sup>836</sup> In *Ferodo Ltd. & Anor v. Ibeto Ind. Ltd.*,<sup>837</sup> the Appellants instituted an action against the Defendant on allegation of continued infringement of their Trade Mark by way of use of graphic representation of its products which is similar to the products of the Appellant. It was held that an action for infringement will lie where a competitor uses registered Trade Mark in connection with the proprietor's goods for the purpose of competing them with his own goods in the same class. It was held that the onus is on the applicant to satisfy the Registrar that the application of trade mark would not lead to confusion.

*In the Matter of an Application No. 3332 BV*,<sup>838</sup> it was held that in considering the possibility of deception, the Court must take into consideration the entirely different conditions prevailing from one country to another especially where the great bulk of the population are literate and are used to seeing, and distinguishing details of pictures.<sup>839</sup> It was further held in the instant case that it is of doubt whether the ordinary illiterate African is capable of recognizing and distinguishing products of one person from another person.

In determining the infringement test, it must first of all, be distinct and it follows that there must be three kinds of distinctiveness. The first kind is characterized by the fact that the sign selected to serve as a trade mark is distinctive as such, and this is classified as inherent distinctiveness.” A trade mark is generally understood to be inherently distinctive if it is fanciful. The second kind relates to a trade mark which is not distinctive as such but has acquired distinctiveness through use. The third kind is a trade mark that has lost its

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<sup>835</sup> See the case of *Alban Pharmacy Ltd. v. Sterling Products Int. Inc.* (1968) All NLR 300

<sup>836</sup> (2003-2007) 5, I.P.L.R. at p. 251

<sup>837</sup> [2003-2007] 5, I.P.L.R. 136

<sup>838</sup> [1917-1976] 1, I.P.L.R. 30,31

<sup>839</sup> *Ibid.* at p.31

distinctiveness because it has become a designation of the product for which it was adopted.<sup>840</sup> In addition, the element of distinctiveness is predicated on the length of time in which the mark has been used. However, what constitutes long or extensive use is a question of fact which will have to be determined in the light of the surrounding and factual circumstances of each case. Distinctiveness connotes that once the trade mark, by frequent use, has acquired a notoriety in the trade to the common knowledge with easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness.<sup>841</sup>

Trade mark's registration is meant to protect the proprietor or assignee in the exclusive use of the trade mark in connection with its goods. Therefore, infringement can occur, whereby an identical mark which closely resembles the original mark is used adversely to the interest of the owner and persons coming into contact with it, may be confused into thinking that it belongs to the infringer.<sup>842</sup> Any invasion of right is therefore actionable if this were to arise. An infringement of an unregistered mark or trade name may also be actionable as a passing off.<sup>843</sup> An action for infringement will therefore lie where a competitor uses registered Trade Mark in connection with the proprietor's goods for the purpose of competing them with his own goods in the same class.<sup>844</sup> The classic case of *Rodgers and Sons v. Rodgers & Company*,<sup>845</sup> brought to light the need why a trade mark ought to be registered in the first instance. The learned judge, Romer J. stated thus, "[No] man is entitled to carry on his business in such a way as to represent that it is the business of another, or is in any way connected with the business of another." Thus, every person is entitled to have business relationships but it must be within lawful boundaries.

A clear case of trade mark infringement is when the protected trade mark is being used by another organization for the same products or services as those for which the owner uses his. In *J.T. Federal Electric Industries v. Sonnet Nigeria*,<sup>846</sup> the defendants imported similar energy distribution boards into Nigeria from England, bearing the same trade mark, "H.K. Federal Electric" and designated as the plaintiff's "H.K. Federal Electric." The principal

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<sup>840</sup> *British American Tobacco & Anor v. International Tobacco Company Ltd.* (2003-2007) 5, I.P.L.R. at p. 251, 252

<sup>841</sup> Per Niki Tobi JSC in *Ferodo Ltd. & Anor v. Ibeto Ind. Ltd.* [2003-2007] 5, I.P.L.R. at page 139, 140

<sup>842</sup> Section 5(2) NTMA, Cap. T13, Laws of the Federation 2004

<sup>843</sup> Shyllon, F., op.cit., at p. 212

<sup>844</sup> See the case of *Bismag Ltd. v. Amblins (Chemists) Ltd.* (1940) Ch. 667. *Ferodo Ltd. & Anor. v. Ibeto Ind. Ltd.* [2003-2007] 5 I.P.L.R. 136

<sup>845</sup> [1914] 41 R.P.C. 277 at 291

<sup>846</sup> (Unreported case) FHC/L/CS/278/95



feature of the mark in each case was the hand. The defendant's unregistered "H.K. Federal Electric" had the same packaging and get-up as the registered one. The court had no difficulty in granting an Anton Piller order and an interim injunction restraining the defendants from manufacturing, producing, further importing, selling or distributing the purported H.K. distribution board.

In *G.B. Ollivant & Co. Ltd. v. John Christian*,<sup>847</sup> the Plaintiffs were the registered proprietor of a trade mark popularly known among the natives and referred to as the "Horseman" Trade Mark which they had been using on their cotton piece goods for many years. The Plaintiffs contended that the Defendant marketed cotton piece goods with a mark consisting of a device which is a colourable imitation of their own registered trade mark which consists of a horse bearing a rider armed with a spear directed as an animal. An order of injunction was brought against the defendants to stop them from using the products of the plaintiffs as their own. It was held in this case that 'use' by the Defendant constituted an infringement of the registered mark of the Plaintiff. Hence, the injunction curbed the actions of the Defendant from dealing or selling cotton goods bearing the mark and the remedy entitled to the plaintiff is an order of delivery up of the said goods that may be in the possession of the defendant, which have on them, the mark complained of.

When determining whether goods create confusion and whether they are similar, it is better to look at them from three levels: visible, audible, or a pronunciation in the country's language where the trade mark is to be protected.<sup>848</sup> Therefore, the following are some of the marks which have given rise to similar goods calculated to deceive or at the same time, deceive or confuse the Nigerian public:

1. Casorina held to be similar to "Castoria"<sup>849</sup>
2. Glucos-Aid held to be similar to "Lucozade"<sup>850</sup>
3. Peacock milk held likely to be confused with "Peak" milk<sup>851</sup>
4. Pikin held to be similar to "Piccan"<sup>852</sup>
5. Bubble-up held to be similar and confused with "Seven-up"<sup>853</sup>

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<sup>847</sup> [1917-1976] 1 I.P.L.R. 10

<sup>848</sup> Shyllon, F., op.cit. at p. 212, 213

<sup>849</sup> See *Alban Pharmacy v. Sterling Products (1968) 1 All N.L.R. 300; 1968 N.C.L.R. 151*

<sup>850</sup> *Beecham v. Esdee Food Products (1985) N.W.L.R. 112*

<sup>851</sup> *In re Marketing and Shipping Enterprises (1971) 2 N.C.L.R. 81*

<sup>852</sup> See *G.B. Ollivant v. Coker (Unreported Case) HK/145/61. High Court of Western Nigeria*

<sup>853</sup> *Bubble-up International v. Seven-up (1971) 1 U.I.L.R. 154*

6. Dosex held to be similar to “Durex”<sup>854</sup>
7. Bandmaster cigarettes depicting a picture of a white man in a band master’s uniform, held to be similar to “Barrister’s cigarettes” with the picture of a white man in a barrister’s robe<sup>855</sup>
8. Sweet Hearts held to be similar to “Hearts”<sup>856</sup>

A consumer could be confused when goods or services displayed for sale, are similar to that of which they are sure of and can categorically state the origin of that product rather than the one whose source is unknown. It has also been recognized that where there are similar goods in the same product, it is likely to cause confusion in the consumer’s mind. Thus, the trade mark owner has a right to prevent such use.<sup>857</sup> In *Seven-Up Co. & Anor v. Warri Bottling Co.*,<sup>858</sup> the 1<sup>st</sup> Plaintiff, Seven-Up company owned a lot of trade marks for soft drinks and usually entered into franchise agreements with independent business companies or individuals around the world. The Company owned three registered trademarks in Nigeria namely: “Seven-Up”, “7 Up”, and “Up”. The registration of their trade marks in Nigeria was in respect of soft drinks and mineral water in Class 44. In 1960, the 1<sup>st</sup> Plaintiff gave the franchise of the three Marks to the 2<sup>nd</sup> Plaintiff and the 2<sup>nd</sup> Plaintiff had been manufacturing and marketing soft drinks in Nigeria under the names of the three trademarks, all combined on each product produced by them. The Plaintiff in 1982 saw an advertisement in the newspaper which was sponsored by the Defendant and observed the similarity of the two products. They alleged that such similarity might cause confusion in the market. They thereby sought relief from the Court to stop the Defendant from using “Thumb Up” on any soft drink because of the confusion that would be created in their customers. The Defendant therein admitted putting up the said advertisement with the intention to manufacture soft drinks to be known by the said name, which is the plaintiff’s trade mark. The burden of proving infringement rests on the person alleging as it must be shown that the defendant used a mark which looked a lot like that of the plaintiff in the course of trade and that it must be so alike that consumers would be misled to thinking otherwise in relation to the goods or services on display.<sup>859</sup>

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<sup>854</sup> *L.R.C. International v. Jena Trading Company* (1976) 1 ALR Comm. 335

<sup>855</sup> *United Kingdom Tobacco v. Carreras* (1931) 16 N.L.R. 1

<sup>856</sup> *Soul Publications v. Sweet Hearts Publications*, unreported case FHC/L/CS/370/97

<sup>857</sup> Shyllon, F., op.cit. at p. 214

<sup>858</sup> [1977-1989] 2 I.P.L.R., 188

<sup>859</sup> *Seven-Up Co. & Anor v. Warri Bottling Co.* [1977-1989] 2 I.P.L.R., 188-190

Parker<sup>860</sup> discusses infringement in terms of words and states that they must be judged by their look and feel and also, take the nature and the kind of customer who would likely buy the goods into consideration. Once the element of confusion sets in, then, there is an infringement on the part of the defendant who must have attempted to steal the influence and trade of the plaintiff.

In *Nigeria Distillers Limited v. Gybo and Sons and Anor.*<sup>861</sup> the Plaintiff manufactures alcoholic and non-alcoholic drinks among are which are Seamans Schnapps, Bacchus Tonic wine, Regal Gin, Lords Gin and other drinks. The Plaintiff is the registered Proprietor of Bacchus Tonic wine Trade Mark. The Plaintiff noticed the presence of Cacchus Tonic Wine in the Market in 1994 when a customer brought the wine into the Plaintiff's office. The Plaintiff alleged the Defendant's product, Cacchus Tonic Wine was similar to the word, "Bacchus" in pronunciation and in appearance and as a result, many customers mistakenly pick Cacchus instead of Bacchus. It is pertinent to note that the proprietor of trade mark has the right to use the mark however he pleases as long as it is registered, which is Bacchus Tonic wine and Device.<sup>862</sup> It was therefore held that the use of the word, "Cacchus" constitute an infringement of the Plaintiff's Mark. What the courts have also noted is in determining whether the name is so similar as to constitute an infringement of the Plaintiff's mark, Bacchus. In addition, whether a person who sees the word, "Cacchus" would be likely deceived as to think that "Cacchus" is the same as Bacchus.

In *G.B. Ollivant v. Coker*,<sup>863</sup> it was held by Madarikan J. that the name "Pikin" closely resembled "Piccan" which was calculated to deceive consumers into thinking that the defendant's baby mixture was the same as that of the plaintiff and that the defendant was in partnership with the plaintiff's business. Hence, the defendant had thereby infringed the plaintiff's registered trade mark.

In *Alban Pharmacy v. Stirling Products*,<sup>864</sup> the appellants were proprietors of the trade mark "Castoria", which was registered for goods in Class C and its purpose was a laxative for

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<sup>860</sup> Per Parker J. in *The Pianolist Case*, 23 R.P.C. 777

<sup>861</sup> (1997-2003) 4, I.P.L.R. at page 473

<sup>862</sup> See Section 5(1) NTMA, Cap. T13, Laws of the Federation 2004

<sup>863</sup> *G.B. Ollivant v. Coker*, unreported but cited in L.R.C. *International* (n. 133, at 349 per Omo-Eboh, J.)

<sup>864</sup> (1968) 1 All N.L.R. 300; (1968) N.C.L.R. 151

children. The respondents used the word, “Casorina” as a trade mark for children’s’ laxative and applied to register it in the same class. In an action to restrain the respondents, the High Court, after comparing both words, ordered that registration should proceed. On appeal however, the Supreme Court held that the new word which was to be registered was so similar as to create confusion in the mind of the consumer. It was held by Ademola C.J.N. that the words “Castoria and Casorina” were too similar and closely resembled each other that it was possible to deceive the public. He further held that the end of the word “Casorina”, that is, “rina”, in itself is not free from causing confusion with “ria” in “Casoria”. The respondents were therefore disallowed from registering the said mark.

Depending on the circumstances of each matter, the Court has to determine if there is an infringement of a mark and whether it is calculated to deceive. In *P.Z. v. Chami*,<sup>865</sup> the two competing marks were an elephant pulling fruits from a palm tree with its trunk and a caparisoned elephant with two palm trees on each side of it with a rider in a howdah on its back. The appellants objected on the ground that the marks were identical and that the respondent’s mark was likely to deceive or confuse. The objection was rejected in the High Court and the appellants later applied to the Supreme Court. The Supreme Court rejected the appeal stating that the said competing marks were not similar in that the two devices were dissimilar.<sup>866</sup>

The Court therefore, in an action on a trade mark infringement, the question whether the defendant’s trade mark is likely to deceive or confuse is a matter on which the judge alone must decide. The judge in deciding this issue must be guided by the evidence brought by the parties and he cannot abdicate his decision to witnesses.<sup>867</sup> For every infringement of trade mark, evidence should be produced to show that consumers are or could be deceived.<sup>868</sup> Where however, both marks are the subject of pending applications, there is no exclusive right to protect.<sup>869</sup>

The case of *W.B. MacIver & Co. Ltd. v. Compagnie Francaise De L’Afrique Occidentale*,<sup>870</sup> was based on an appeal that arose because of the registration of a mark by a French company.

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<sup>865</sup> (1971) 2 N.C.L.R. 376

<sup>866</sup> *Ibid.*

<sup>867</sup> *Oladipupo v. Thwardas* (1970) 2 ALR. Comm. 179 at 184. Shyllon, F., op.cit. at p. 219

<sup>868</sup> *Ibid.*

<sup>869</sup> *Ibid.*

<sup>870</sup> [1917-1976] 1, I.P.L.R. p. 6

The mark sought to be registered was in relation to class of goods No. 47, and is in the form of a cask being coopered by three (3) coopers. The Opponents/Appellants have already registered a trade mark in the same class No. 47 and the said Mark is also in the form of a cask being rolled along the ground by one man. The learned judge in the court found that there was no resemblance between the two Trade Marks as would be calculated to deceive and accordingly allowed the Respondents/Applicants to have their mark registered. The Appellants, dissatisfied with the decision appealed to a high court. The issues in contention with the above case is whether there was resemblance between the two Trade Marks as would be calculated to deceive or likelihood of confusing the two mark. The court however held that on determination of infringement, to the illiterate, there is no other feature connected with this particular Class of goods which this mark is intended to represent, and whether the cask or puncheon is being rolled by one man, or being coopered by three men, no difference is discernible by the illiterate native.<sup>871</sup> In this case, the Appeal was allowed and the original motion that the registration of Trade Mark No. 1703 be preceded with the Registrar, was refused.

A Certificate of Registration is given to the proprietor once the mark has been registered in relation to the goods or services and this is useful especially if a trade mark infringement were to occur.<sup>872</sup> In *Crysterlight Overseas v. Yugolex Drugs & Anor.*,<sup>873</sup> the plaintiff is a pharmaceutical Company which is involved in importation and distribution of pharmaceutical products. They alleged that they are the registered owners of many trademarks and one of it is “Mycetamol” used in marketing their pharmaceutical product called “Mycetamol Tablets,” a brand of paracetamol tablets. The plaintiff contended that by the virtue of the agreement between its Company and the 2<sup>nd</sup> Defendant, the Plaintiff is the exclusive agent in Nigeria in respect of marketing and promotion of pharmaceutical products in Nigeria under the Plaintiff’s trade name, “Mycetamol”. The plaintiff alleged that the 2<sup>nd</sup> defendant used its said Trade mark on product supplied to the 1<sup>st</sup> defendant and that such act constitutes an infringement of its Trade Mark. It was held and made known that once a mark has been registered, the Registrar would issue the necessary documents, which is the Certificate to the owner of such trade mark, and it will be used once there is an infringement.

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<sup>871</sup> Ibid.

<sup>872</sup> *Obikings Investment v. Moses Industries*, unreported case FHC/L/CS/51/96

<sup>873</sup> [1997-2003] 4 I.P.L.R. 178

The owner of a trademark, otherwise referred to as a proprietor, have *locus standi* to sue. Likewise, proprietors, who are foreigners also have *locus standi* but may have to post a bank bond or security for costs.<sup>874</sup> The exclusivity right takes effect from the date of registration which is invariably, the date of filing.<sup>875</sup> The trade mark proprietor, is thereby entitled to the remedies and reliefs if any infringement were to occur.<sup>876</sup>

The burden is on the Plaintiff to prove an infringement of a trade mark which is registered so as to have a cause of action. In *Gbadamosi & Anor. V. J.T. Chanrai & Anor.*,<sup>877</sup> the Plaintiffs are the original registered proprietors of a Trade Mark known as “Cock Device Brand Mosquito Coil” ‘Orire Goodluck’. The Plaintiffs alleged that the Defendants infringed their Trade Mark by selling Cock Brand Mosquito Coils with the Cock Device on the label between 1972 and 1074 June at Lagos. The Plaintiffs’ contention is that the 1<sup>st</sup> Defendant Company is wrongfully selling the Mosquito coils under a name similar and in packets similar to that of the Plaintiffs and so closely resembling as to mislead the public into the belief that they are purchasing the Plaintiffs’ goods. An action was thereby instituted against the Defendant claiming damages and injunction to restrain the Defendants by themselves or their Agents from selling or offering for sale ‘Cock Brand Mosquito Coil’ not belonging to the Plaintiffs. The onus to prove that there had been an infringement is on the plaintiff and he need not prove any other thing except that the trade mark complies with all the rules of its registration. On appeal to the court, the plaintiff sought an order to restrain the defendant from infringing its registered trade mark. However, the Plaintiff in any case, must ascertain that indeed, there is an infringement and the award of damages need not arise.<sup>878</sup>

Other instances of infringement could be whether there is the possibility of the applicant’s trade mark being confused with that of the Respondent or whether the Applicant’s use of their founders’ name constitute innocent and honest user. In *Montres Buler Societe Anonyme v. Bulova Watch Company Ltd.*,<sup>879</sup> the Applicant sought to register in Nigeria its trade mark consisting of a design incorporating the family name of its founder “Buler”. The Respondent objected to the registration on the ground that the Applicants are trying to trade on their

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<sup>874</sup> *Tawa Petroleum Products v. Owner of M.V. Sea Winner* (1980) F.H.C.R. 101

<sup>875</sup> Colston, C. 1999. Principles of Intellectual Property Law. Cavendish Publishing Ltd., London

<sup>876</sup> Section 14, UKTMA, 1994

<sup>877</sup> [1917-1976] 1 I.P.L.R. 428

<sup>878</sup> *Gbadamosi & Anor v. J.T. Chanrai & Anor* [1917-1976] 1 I.P.L.R. 428

<sup>879</sup> [1917-1976] 1 I.P.L.R. 172

goodwill because the said trade mark closely resembles its own registered Mark, “*Bohuva*”. The Applicant contended that prior to the application for registration, they had used the said Mark in other countries without objection and confusion to the public for thirteen (13) years. The Respondent, on the other hand, had not used their Mark in Nigeria for a considerable period. The Applicant thereby instituted an action seeking for an order of Court to know whether such the application was indeed published in the Journal.<sup>880</sup> In addition, if a trader honestly and in good faith uses his own name, which he knows to be similar to an existing trade mark, an aggrieved rival trader cannot sue for infringement and his remedy lies in passing-off. The law makes a distinction between an innocent and honest user and states in the above case that the applicant’s use of their founder’s name constitutes an innocent and honest user. In essence therefore, the reasons for such protection is that the trademark has gained a certain reputation and is particularly well-known or that it is a famous trademark.<sup>881</sup> The Court concluded that the application succeeds and ordered the Registrar to proceed with the registration notwithstanding the Respondent’s opposition to the mark.

Furthermore, Lord Tomlin in the House of Lords case of *Re Alexander Pirie & Sons Ltd. Application*,<sup>882</sup> reiterated the need for trade mark to be registered and where the owner’s mark is challenged, there will be evidence of its registration in the register. Where there is the knowledge that the opponent’s mark has been registered, the applicant can ask the court to remove the trade mark from the register and hence, prove a better title. Therefore, where a mark is being infringed, the knowledge should come within the purview of the plaintiff that indeed someone is trying to use a mark which is similar to that of his own.

An infringement of a registered trade mark could occur where it is passed off as the goods of another person and the question borders on who has the right to sue in such an instance. In *EBS Ltd. v. Evans Medical Plc & 4 Ors.*,<sup>883</sup> the Plaintiff alleged that the Defendants infringed its registered trademarks used on its pharmaceutical products. The Plaintiff also asserted that its drugs were being adulterated by the Defendants and that the Defendants are passing off their goods as that of the Plaintiff. The Plaintiff brought an injunction restraining all the Defendants from infringing the Plaintiff’s registered Trade Mark, passing off and an Anton

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<sup>880</sup> Section 19(1), NTMA, Cap. T13, Laws of the Federation 2004

<sup>881</sup> Section 19, NTMA, op.cit.

<sup>882</sup> [1933] All E.R. Rep. at 962; [1933] R.P.C. at 159

<sup>883</sup> [2003-2007] 5 I.P.L.R. 106

Piller Order to enable the Plaintiff get evidence which would be used at the trial. It was held that the Plaintiff, in order to succeed had to prove proprietary rights over the trade mark and that the defendant had acted in a manner that infringed the right conferred on him by using a mark which does not belong to him in any way. Therefore, the plaintiff must be able to establish that he is the registered user entitled to sue by producing a Certificate of Registration which is in accordance with the requirements as stated under the Trade Marks Act.<sup>884</sup>

It was stated by Karibi-Whyte, JSC in *Patkum Industries Ltd. v. Niger Shoes Manufacturing Company Ltd.*,<sup>885</sup> that, “The Federal High Court has jurisdiction in respect of an action for passing-off arising from infringement of the Plaintiff’s registered Trade Marks.<sup>886</sup> The jurisdiction of the Federal High Court is set out under the Constitution of the Federal Republic of Nigeria.<sup>887</sup> Where there is no evidence that a mark has been registered under the NTMA or where the Applicant has not established his title as proprietor, the Court in this case lacks jurisdiction to grant any reliefs sought by the parties.<sup>888</sup>

#### **4.2. Remedies for the infringement of trademarks**

Under Trademarks, once there is an infringement, there are several remedies open to the proprietor of the mark in Nigeria. They include damages, injunction, Anton Piller Order, Mareva Injunction, Delivery Up and Account of Profits. The plaintiff may therefore bring any of the above remedies when there is an infringement. In addition, in any infringement case, the court has a duty to consider only essential features. In deciding whether two marks are confusingly similar therefore, the marks alone must be considered which is usually separated from associated features or get up.<sup>889</sup>

There are two types of action in the occurrence of trademark infringement and they include civil and criminal proceedings.

##### **4.2.1. Civil Proceedings**

##### **4.2.2. Damages**

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<sup>884</sup> Section 3, NTMA, Cap. T13, Laws of the Federation 2004

<sup>885</sup> (1988) 5 NWLR (Pt.93) 138

<sup>886</sup> Ibid. at pg. 108

<sup>887</sup> This is contained under Section 251 (1) (f) of the Constitution of the Federal Republic of Nigeria, 1999 (As amended). Section 7, Federal High Court Rules 2013

<sup>888</sup> *Patkum’s case*, ibid. (1988) 5 NWLR (Pt.93) 138

<sup>889</sup> See the case of *Lever Bros. Ltd. v. Sunnwhite Products Ltd.* (1949) 66 RPC 84



Damages are monetary awards. In its legal sense, “damages” refers to monetary compensation that is claimed by a person or awarded by a court in a civil action to a person who has been injured or suffered loss because of the wrongful conduct of another party.<sup>890</sup> There are different types of damages which are available to a plaintiff. There are General or Special Damages. General damages are damages that arise directly and inevitably from a breach of contract.<sup>891</sup> General damages are as a result of the defendant’s wrongful action.<sup>892</sup> Special damages on the other hand, financially compensate the injured person for losses suffered due to the defendant’s actions. Special damages are referred to as out-of-pocket expenses that can be determined by adding together all the plaintiff’s quantifiable financial losses.<sup>893</sup>

In *Sol Pharm. Ltd. & Anor. v. Susano Pharm. Ltd.*,<sup>894</sup> the first plaintiff, a pharmaceutical Company and registered proprietor of a Trade Mark used on its antibacterial drug known as STAN-DS marketed by the second plaintiff. The Plaintiffs contended that the Defendant introduced into the market, a product known as STAR-DS and has been passing off same as the plaintiff’s product, STAN-DS. The Plaintiffs further contended that the Defendant’s product is not original as it is not registered with NAFDAC and is not capable of being registered because of its very close resemblance to STAN-DS. The Plaintiff further stated that as a result of the infringement of its Trade mark and passing-off by the Defendant, it has affected their goodwill and reputation and has created confusion as people could not easily determine the differences because of the similarity in pronunciation, packaging and get-up of the two products. The plaintiffs therefore, instituted the suit seeking for a declaration and an injunction restraining the Defendant from passing off goods not of the plaintiff’s manufacture and merchandise and from selling or offering for sale, the fake STAR-DS. The plaintiffs also claimed for account, damages and delivery for destruction. It was held by the court that the packaging and get-up of the two products in color and size of package bear a striking resemblance and as such, the Defendant’s STAR-DS is calculated to deceive and is capable of deceiving a consumer/purchaser intending to buy the Plaintiff’s STAN-DS because the

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<sup>890</sup> Hosseini Law Firm. Types of Damages in Civil Litigation. Retrieved March 1, 2016 from [www.hosseinilaw.com/types-of-damaged-in-civil-litigation](http://www.hosseinilaw.com/types-of-damaged-in-civil-litigation)

<sup>891</sup> Legal Information Institute. General Damages. Retrieved March 1, 2016 from [https://www.law.cornell.edu/wex/general\\_damages](https://www.law.cornell.edu/wex/general_damages)

<sup>892</sup> AllLaw. Special and General Damages in your Personal Injury Case. Retrieved March 1, 2016 from [www.alllaw.com/articles/nolo/personal-injury/special-general-damages.html](http://www.alllaw.com/articles/nolo/personal-injury/special-general-damages.html)

<sup>893</sup> Ibid.

<sup>894</sup> [2003-2007] 5 I.P.L.R. 413

words were similar. The court in its ruling stated, that the defendant is restrained in perpetuity from further infringing the plaintiff's trade mark and passing-off 'STAN-DS' as its own. It is pertinent to note that in any infringement cases, for the plaintiff to claim special damages, he must produce evidence as to loss suffered as a result of the defendant passing-off his goods.<sup>895</sup> The Plaintiffs having proved infringement of their goods were entitled to general damages of Two Million Naira (2M).<sup>896</sup>

In *EBS Ltd. v. Evans Medical Plc. & 4 Ors.*,<sup>897</sup> the plaintiff alleged in this case that the defendants infringed its registered Trade Marks used on its pharmaceutical products. The plaintiff further asserts that its drugs are being adulterated by the Defendants and that the Defendants are passing off their goods as that of the Plaintiff. It was held that it is trite law that the Plaintiff in an action for infringement must establish that he has a proprietary right over the Trade Mark or that he is a registered user and he is entitled to use. In addition to this, he must then prove that the Defendants have acted or threatened to act in such a way as to infringe on his right conferred on him after the registration of the mark under the Act.

In a trade mark infringement case, there are circumstances when further damages will be awarded. In the case of *The Singer Company v. Pius Asuzu*,<sup>898</sup> the Plaintiffs, a manufacturing company engaged in the manufacture of different kinds of machinery including singer sewing machines, were the proprietors of the Registered Trade Marks known as "Bird in Flight machine Transfer No. 475" and the word, 'Nigersew'. The Defendant is a trader who also deals in sewing machines and has been buying Singer sewing machines from the Plaintiff. He thereafter placed orders for sewing machines with the Trade Marks "Bird in Flight" and "Niger". In 1962, the Defendant applied to register the said Trade Mark but the application was rejected as a result of the opposition by the Plaintiffs. He continued to place orders without any notification of acceptance from the Registrar and sold same at a lower price which in turn resulted in loss to the Plaintiff. The Plaintiff thereby, sought an injunction, £20,000 as damages for the infringement and passing off. While the case was in court, the defendant made an admission that he used the plaintiff's trade mark because he had applied several times to have his mark registered but there was no reply from the Registrar. There

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<sup>895</sup> *Sol Pharm. Ltd. & Anor. v. Susano Pharm. Ltd.*, *ibid.*

<sup>896</sup> *Ibid.*

<sup>897</sup> [2003-2007] 5 I.P.L.R. 106

<sup>898</sup> [1917-1976]1, I.P.L.R., P.161

was no reply from the Registrar because it was obvious from looking at the records that the trade mark of the plaintiffs was the same as that of the defendant and hence, it cannot be registered. It was held by the court that at common law, mere proof of an infringement entitles the Plaintiff only to nominal damages and that in circumstances where the conduct of the Defendant resulted in loss of the Plaintiff's trade goodwill or reputation, further damages may be awarded against the Defendant. The sales of the inferior sewing machines at an extremely low price by the Defendant impaired the Plaintiff's reputation and hence, sales will drop and consumer would think that the defendant is associated with the plaintiff. Therefore, the plaintiff will be entitled to an award of damages.

Therefore, in an infringement action, the plaintiff has to prove damages suffered as he will only be entitled to nominal damages. Nominal damages are awards issued by a court where the financial loss cannot be pinpointed but an injurious legal wrong was done to the plaintiff.<sup>899</sup> In *Sannir v. Metmore Manufacturing*,<sup>900</sup> the Supreme Court held that in an infringement action, the plaintiff is entitled to nominal damages unless it can be proved that there was some form of damages suffered by his person. In the absence of evidence therefore, the court will not delve in the world of presumptions.<sup>901</sup>

#### **4.2.3. Injunction**

An Injunction is when there is a form of restraint against the defendant. In *Eurieldums Merchandise v. Unique Times*,<sup>902</sup> the applicants were the registered owners of the trade mark "Eternal" fans which they imported; while the respondents also imported fans bearing the same mark. Until the respondent started importing, the applicants had the sole right over the products as agents of the manufacturers. The Court held that the applicants as registered owners had a right to protect its Mark. It further held that the balance of convenience was on the side of the applicants. The Court therefore ordered that the respondents should be restrained from importing fans with "Eternal" labels on them.

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<sup>899</sup> Free Advice. What are Nominal damages? Retrieved February 29, 2016 from [law.freeadvice.com/litigation/law/...](http://law.freeadvice.com/litigation/law/...)

<sup>900</sup> (1956) S.C.N.L.R. 330

<sup>901</sup> Ibid.

<sup>902</sup> Unreported, FHC/L/CS/444/93

In *Ayman Enterprises v. Akuma Industries*,<sup>903</sup> the court held that since the plaintiffs could not be adequately compensated by an award of damages but an injunction would be granted, restraining the defendants from selling or distributing their products which were similar in names, logos and get-up.

Another form of injunction is known as Class Injunction, which is also referred to as Class Actions. It is an indisputable fact that Nigeria is flooded with counterfeit goods ranging from copies of designer wrist watches, clothes and shoes to life-saving pharmaceutical products.<sup>904</sup> Where the proprietor of a trade mark finds a product which infringes his intellectual property on sale in numerous retail outlets and on the other hand, he is unable to identify the source from which the retailers obtain their supply, the proprietor will only be able to deal with this infringing problem by instituting an action which will affect all persons who are dealing in the infringed product. The proprietor would thereafter, obtain leave of court to sue a number of persons dealing in the infringing product for themselves and as representatives of all others dealing in the product.<sup>905</sup>

In *Solignum v. Ayinla*,<sup>906</sup> the Plaintiff, a manufacturer of *SOLIGNUM*, a wood preservative, found early in 1992 that people were selling inferior products in poor quality re-used containers bearing paper labels marked *SOLIGNUM*. Many of these products bore no indication as to their manufacturer, or bore the names of companies that did not exist according to searches at the Companies Registry. The products were of extremely low quality, both in terms of packaging and contents. The products were sold for a fraction of the price of the genuine product and had a significant impact on sales of the genuine *SOLIGNUM*. The Plaintiff's contention was not just to retrieve lost sales but equally important to save its mark which was in danger of falling into generic use. The Plaintiff surveyed the wood preservation markets in Lagos and found that a significant number of counterfeits were manufactured by a company called "Ril Olats Commercial Enterprises". This company was not listed on the Companies Register and on this evidence, the plaintiff applied for an Anton Piller Order against the companies dealing in counterfeit goods.<sup>907</sup> The trial judge granted the Anton Piller order and the class injunction, and widening the class to

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<sup>903</sup> Unreported case FHC/L/CS/674/96

<sup>904</sup> Shyllon, F. op.cit. at p. 223

<sup>905</sup> Ogunkeye, O. 2002. *Nigeria: Anton Piller, Class Actions and Injunction in Nigeria*. Retrieved March 10, 2016 from [www.mondaq.com/Nigeria/x/153](http://www.mondaq.com/Nigeria/x/153)

<sup>906</sup> (1993) F.H.C.L.R. 233

<sup>907</sup> Ibid.

cover all those dealing in *SOLIGNUM* not made by the Plaintiff's enterprise. The defendants on their part, promptly settled with the plaintiff and the interim class injunction was final. Thereafter, the terms of the injunction were advertised extensively in two major Nigerian daily newspapers where traders were warned that a breach of the terms of the order would lead to contempt proceedings against them.<sup>908</sup>

Similarly, in *United Distillers v. Towuro-lara Trading Stores*,<sup>909</sup> class injunction was granted against those selling and offering for sale, WHITE HORSE Whisky. It is pertinent to note that since the case of *Solignum v. Ayinla*, is a landmark case which is regularly resorted to and especially by multinationals that have the wherewithal to pursue counterfeiters.

#### 4.2.4. Anton Piller Order

The Anton Piller Order is a judicially created device whereby a plaintiff in some cases is allowed to take an infringer by surprise whilst at the same time, ensuring that vital evidence and information required for enforcing the plaintiff's rights are not destroyed.<sup>910</sup> It is an order which can be given ex parte<sup>911</sup> for inspection, photographing and delivery up of infringing materials in the possession or control of the unauthorized third party.<sup>912</sup> It requires certain persons to enter the premises of the defendant to search for documents and movable articles as are specified in the court order, and to permit such documents or articles to be taken away.<sup>913</sup>

The first Anton Piller order made in Nigeria was made in *Ferodo Limited v. Unibros Stores*<sup>914</sup> which was decided based on *Anton Piller KG v. Manufacturing Processes Ltd.*<sup>915</sup> In this case, the defendants, an English company and their two directors, were the United Kingdom agents of the plaintiffs, German manufacturers of frequency converters for computers. The plaintiff claimed that the defendants were in secret communication with other German manufacturers and were giving them confidential information about the plaintiff's power units and details of a new converter, the disclosure of which could be damaging to the

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<sup>908</sup> *Solignum v. Ayinla*, *ibid.*

<sup>909</sup> Unreported case FHC/L/CS/1124/94

<sup>910</sup> Shyllon, F, *op.cit* at page 114

<sup>911</sup> USLegal. Ex Parte Law & Legal Definition. Retrieved March 10, 2016 from [definitions.uslegal.com](http://definitions.uslegal.com)>....>

<sup>912</sup> Babafemi, F.O., *op.cit.* at p.

<sup>913</sup> Ogunkeye, O. 2002. Nigeria: Anton Piller Order, Class Actions and Injunctions in Nigeria. Retrieved March 10, from [www.mondaq.com/Nigeria/x/153](http://www.mondaq.com/Nigeria/x/153)

<sup>914</sup> (1980) Fleet Street Report 489

<sup>915</sup> (1976) 1 All ER 779 (CA)

plaintiffs. In order to prevent the disposal by the defendants of documents in their possession relating to the plaintiffs' machines or designs, the plaintiffs applied ex parte for an interim injunction for infringing their copyrights and disclosing confidential information and for an order of permission to enter the defendants' premises to inspect all such documents. This order is carried out where the plaintiffs have a strong prima facie case, that if the vital documents are not retrieved from the defendants, there will be irreparable damage on the business of the plaintiffs and if this was not effected, and it would defeat the ends of justice before an application could be made. The court therefore had inherent jurisdiction to do justice as occasion demands and to order the defendants to "permit" plaintiffs' representatives to enter defendants' premises to inspect and remove such materials which were detrimental to the plaintiffs'.

In *Mars Incorporated v. Nutra Foods Limited*,<sup>916</sup> the Registrar of Patents and Designs on 24 June, 1990, issued the Defendant a Certificate of Registration in the Design "M&K Milk Chocolate Package". The Registrar of Trade Marks also registered into their proprietorship a Trade Mark in a confectionery item whose name includes the use of the letter. The product is called "M & K Mohammed & Khalil". In September 1990, the defendant applied to the Registrar of Trade Marks for a Trade Mark in their "M & K Chocolates". The Plaintiff became aware of this development between 31 August, 1990 and 16 May, 1994. The Plaintiff applied to the court for an Order of Injunction restraining the Defendant from infringing the Plaintiff's registered Mark together with an Anton Piller Order against the offending goods and materials. It was held by the court that relief by way of Anton Piller Order is an exceptional remedy which must be granted with due circumspection, like all equitable remedies, and it requires the exhibit of utmost good faith by the Applicant.

It has been stated that the Anton Piller Order should only be granted if there is grave danger of the properties being smuggled away or of vital evidence being destroyed. In *British American Tobacco (Nig.) Ltd. v. International Tobacco*,<sup>917</sup> it was held that the essence of Anton Piller Order is to prevent the Defendant from destroying the property in his possession before an Application on Notice is made and hence, the rationale of the ex parte nature of application and the Hearing in Camera. The court may issue an order upon such terms as it deems fit whereby there is authorization for the Applicant to enter the house or premises at

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<sup>916</sup> [1997-2003] 4, I.P.L.R. , p.240

<sup>917</sup> (2003-2007) 5, I.P.L.R., p. 293,294

any reasonable time, either during the day or at night by a Police Officer not below the rank of an Assistant Superintendent of Police who carries out the following functions:

1. Seize, detain and preserve any such or contrivance; and
2. Inspect all or any document in the custody or under the control of the Defendant relating to the action.

Similarly, in *Jay Laboratories v. James L. Ayidu*,<sup>918</sup> the Plaintiff/Applicant, a manufacturer and owner of hair preparations and comestics under Trade Mark, “Rainbow” had been using the said Mark for many years all over Nigeria. The Trade Mark was said to have been registered by the Ministry of Trade and a Certificate issued in respect thereof. The Applicant noticed a slump in the sales of its products and further alleged that the reduction of its sales was caused by the introduction of the Defendant’s product manufactured and marketed by the Defendant under the brand name “Princesheen” which said products are strikingly similar to that of the Applicant. The Plaintiff/Applicant by an ex-parte Motion is praying the court for an order, restraining the Defendant from further infringing its registered Trade Mark. The Defendant is alleged to have passed off the *PRINCESHEEN* Curl Activator for the Plaintiff’s *RAINBOW* Curl Activator. An Anton Piller Order is also sought against the Defendant in this respect. The Court having the statutory power to make the order of injunction permitted the applicant to enter into the defendant’s premises for the purpose of inspecting and taking possession of all goods relating to the infringed goods and bringing them to the court for custody. The essence of this exercise is to prevent the infringed property from being smuggled away vital evidence being destroyed.<sup>919</sup>

#### **4.2.5. Delivery Up**

Delivery Up is a remedy usually granted by the courts. Where this remedy is granted, the infringing goods will be ordered to be delivered up to the defendant so as to be destroyed. In *Beecham Group Limited v. Esdee Food Products Nigeria Limited*,<sup>920</sup> where it was held that the defendants should deliver upon oath for destruction all the goods, cartons, wrappers, blocks, discs or stamps bearing any mark or get up that would be in breach of the injunction which had been granted.

#### **4.2.6. Account of Profits**

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<sup>918</sup> [1990-1997] 3, I.P.L.R., p. 94

<sup>919</sup> Ibid.

<sup>920</sup> (1981) F.H.C/L. 177

A successful plaintiff has the option to elect for an account of profits rather than damages. It is an equitable remedy, incidental to the right to an injunction. It will entitle the plaintiff to the profit the defendant has made from the infringement which may exceed the damage which the plaintiff suffered.<sup>921</sup>

### **4.3.Criminal Proceedings**

The statutes for the prosecution of trademarks are provided under the Trade Marks Act,<sup>922</sup> Merchandise Marks Act,<sup>923</sup> or under the Counterfeit and Fake Drugs Act<sup>924</sup> in relation to pharmaceutical drugs. The focus will however be on the Merchandise Marks Act.<sup>925</sup>

#### **4.3.1. Merchandise Marks Act**

Where a false entry has been made in the Trade Mark Register, and the person is aware of the fact that the contents are not true, will be liable to an imprisonment of seven (7) years or for a fine, that is not more than N200.<sup>926</sup> A person that also makes a misrepresentation as to claim that an unregistered mark is registered, when it is not, will also be convicted of this offence. Hence, such person shall be liable to either imprisonment or fine, depending on the magnitude of the offence.<sup>927</sup>

In any prosecution for a trade mark forgery, the burden of proving that the proprietor has acquiescence to the forgery, lies on the defendant. A person convicted of such an offence is liable to be imprisoned for two (2) years, or to a fine.<sup>928</sup> Hence, the Act provides that a person accused of forging trademark is a person who, without permission uses the trademark of the proprietor that is calculated to deceive other people or a person who falsifies any genuine mark, whether by alteration, effacement, or otherwise.<sup>929</sup>

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<sup>921</sup> Shyllon, F., Op.cit at page 109

<sup>922</sup> NTMA 1965, op.cit.

<sup>923</sup> Merchandise Marks Act, Cap. M10, Laws of the Federation 2004

<sup>924</sup> Counterfeit and Fake Drugs Act 1988

<sup>925</sup> Merchandise Marks Act, ibid.

<sup>926</sup> Section 60, NTMA, ibid.

<sup>927</sup> Section 61, ibid.

<sup>928</sup> Section 3(3) Merchandise Marks Act, Cap. M10, Laws of the Federation 2004

<sup>929</sup> Section 4, Merchandise Marks Act, ibid.



In this instance, the burden of proof lies on the defendant, who in this case, is the accused. A person convicted of such an offence under the Act is liable to being imprisoned for two years, or a fine or both before the High Court.<sup>930</sup> Once the cause of action has been proved by the relevant parties, such persons would be tried in Court. It is however pertinent to note the Merchandise Act is archaic as it does not adequately provide for the modern trend of counterfeiting. Hence, the Act is severely limited by two main factors. The factors are:

1. The low deterrent value of the punishment prescribed for the offences and the inability of the police to effectively prosecute the highly technical offences which are non-indictable and are within the purview of the police prosecutor. The fines need to be upgraded so that there will be a high deterrent factor in counterfeit goods.<sup>931</sup>
2. Another current problem for companies suffering from counterfeiting is that while the offences under the Act are satisfactory, they do not sufficiently address vendors, in addition to manufacturers.<sup>932</sup>

An amendment is necessary under the Trade Marks Act. The reason is that where the Copyright Act provides that it is permissible for both criminal and civil actions to be taken simultaneously in respect of the same copyright infringement, there is no such provision under the Trade Marks Act or Merchandise Marks Act in Nigeria.<sup>933</sup> The UKTMA makes provision for criminal sanctions and it states that where a person falsely represents a mark that is registered or makes untrue representation, which is false and fraudulent, will be guilty of an offence and tried accordingly.<sup>934</sup>

#### **4.4.INFRINGEMENT OF TRADE MARKS IN THE UNITED KINGDOM**

In a trade mark infringement, proceedings are normally brought by the owner of the mark but it is also possible for an action to be brought by an exclusive licensee.<sup>935</sup> Where the licensees are however not entitled to bring proceedings in their own right, they can call on the proprietor to take proceedings on their behalf.<sup>936</sup> It is pertinent to note that before an action can be brought before the court, the trade mark must be registered. Therefore, the rights of the proprietor are enforceable against third parties with regard to acts done after the date of

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<sup>930</sup> Section 3(3) Merchandise Marks Act, *ibid*.

<sup>931</sup> Shyllon, F., *op.cit.* at p. 225

<sup>932</sup> Ogunkeye, O. 1991 *Managing Intellectual Property* 42, 44-45; Adams, "Fighting Counterfeiting in Nigeria- We Can Win" in Sodipo and Fagbemi, 132, 136.

<sup>933</sup> Shyllon, F. *op.cit* at p. 226

<sup>934</sup> Sections 95 and 99, UKTMA 1994

<sup>935</sup> This is under Sections 23(5) and 31, UKTMA 1994

<sup>936</sup> Section 30, UKTMA, 1994

registration (which is the date of filing).<sup>937</sup> The rights continue for ten (10) years from registration and may be renewed for further ten-year periods possibly indefinite.<sup>938</sup>

There is no requirement for knowledge, intention, or derivation on the part of the defendant as regards infringement cases in the United Kingdom. The reason is that trade mark infringement is strict and monopoly is absolute. The trade mark owner need not show damage and is able to commence an action for infringement even though the mark has not been used. However, it must be shown that the defendant used the mark in the course of trade.<sup>939</sup> In determining whether there is trade mark infringement, it is necessary to compare the registered mark with the alleged infringing sign with a degree of care. The circumstances in which a mark may be infringed are in terms of marks which are identical with goods and services or closely resembling such goods,<sup>940</sup> which includes the likelihood of association, with the earlier registered mark,<sup>941</sup> and such association could give rise to confusion with the marks and lead to the public being misled.<sup>942</sup>

When a registered trade mark has been in use for a long time, in the United Kingdom for instance, it is said to have gained some form of popularity among its specified consumers who are used to the product. Where therefore, the plaintiff's known mark is used in a way by the infringer, which is the defendant in this case, it would destroy the essence or the uniqueness of the mark. Therefore, the United Kingdom looks at similar or closely resembling products which could take undue advantage of the plaintiff's trademark and ensures that the proper penalties are laid down if an action for infringement arises.<sup>943</sup>

The above has almost the same characteristics with the Nigerian counterpart but the difference is that trade mark is only in relation to goods. A registered trade mark can therefore be infringed if the goods or services are identical or closely resemble an earlier registered trade mark which could lead the consumers to confusion. Hence, where a person takes undue advantage of the status and reputation of a trade mark by selling products illegally bearing the name or logo of another person, and misleading consumers into thinking

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<sup>937</sup> Section 9(3), UKTMA, *ibid.*

<sup>938</sup> Sections 42 and 43, UKTMA, *ibid.*

<sup>939</sup> *Ibid.*

<sup>940</sup> Section 10(1)- (3) UKTMA, *ibid.*

<sup>941</sup> Section 10(2) (a), UKTMA, *ibid.*

<sup>942</sup> Section 10 (2) (b), UKTMA, *ibid.*

<sup>943</sup> Section 10 (3), UKTMA, *ibid.*

otherwise, such will be termed an infringement on the guilty persons.<sup>944</sup> However, it is pertinent to note that the concept of trademark is only in relation to goods in Nigeria.

The test to know whether there is an infringement, is to identify the scope of the proprietor's right in the trade mark and this can be done where there evidence of a Certificate of Registration issued by the Registrar. Thereafter, the court will ascertain the defendant's mark by assessing its liability to the specific use of the mark, that is, whether or not, it has used it in the course of trade and to what extent it has been used. To establish infringement, the mark must be used in the course of trade and the relevant territory in which the mark must be sold should not be ignored and finally, the importance of the function of the mark.<sup>945</sup>

#### **4.4.1. Requirements in the determination of the scope of infringement**

##### **4.4.1.1. The Claimant's Trade Mark**

The trade mark register is a way to assess whether or not a proposed mark is conflicting with an earlier registered trade mark.<sup>946</sup> Where registration is more than five (5) years, the specification of goods and services may need to be reformulated. Under the UK law, it is common for an alleged infringer to challenge the scope of the registration, especially if it is more than five years old, through a counter-claim for revocation for non-use.<sup>947</sup> In evaluating infringement therefore, the court may be concerned with how the mark has been used. In *Specsavers International Healthcare Ltd. v. Asda Stores Ltd.*,<sup>948</sup> the claimant's mark comprised two intersecting oval shapes and had been registered in black, which, under, the prevailing conventions was assumed to confer rights irrespective of the colour in which the shape is used by the defendant. The mark, nevertheless, had been used primarily in a particular shade of green. The Court held the 'colour' was relevant and further held that the particular shade of green would likely create confusion.<sup>949</sup>

##### **4.4.1.2. The Defendant's Sign**

When a person infringes a registered trade mark, it is necessary to compare the 'original' registered sign with the 'fake' sign used by the defendant. The question as to what constitutes

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<sup>944</sup> Bently, L. and Sherman, B., op.cit. at p. 1039

<sup>945</sup> Ibid. at p. 1039

<sup>946</sup> Bently, L. and Sherman, B., ibid. at p.1039

<sup>947</sup> Ibid. at p. 1039

<sup>948</sup> [2013] Case C-252/12

<sup>949</sup> Ibid.

the defendant's sign is of vital importance when considering whether or not the goods and services are identical or not. Furthermore, the UK provision states that if the marks and goods or services are identical, then a defendant will be considered to have infringed irrespective of any confusion.<sup>950</sup> In *LTJ Diffusion case*,<sup>951</sup> the owners of a figurative mark including the word, "Arthur" in handwritten form for clothes brought infringement proceedings against a company selling children's clothing under the name, "*Arthur Et Felicie*."

#### 4.4.2. Types of use

The UKTMA provides a non-exhaustive list of situations where a person uses a sign in the course of trade.<sup>952</sup> Instances where an infringer affixes the sign to the goods or to the packaging has been said to be the most common form of trademark infringement.<sup>953</sup> This would occur for example, when a counterfeiter were to place scented liquid in bottles to which have been attached the 'Chanel Label.' In *Frisdranken Industrie Winters BV v. Red Bull GmbH*,<sup>954</sup> the defendant, a Dutch company, filled cans on behalf of Smart Drinks, a firm based in the British Virgin Islands. Smart Drinks supplied the drink extract, as well as the empty cans and lids (which bore marks that were said to infringe the claimant's trade marks). After filling the cans with the made-up drink, the defendant placed the filled cans at the disposal of Smart Drinks, which then exported them to countries outside the Benelux region. The Dutch appellate court had held that filling the cans was akin to affixing a mark to the goods, reasoning that in relation to a liquid, a sign cannot be affixed in any other way than by placing it in packaging that already bears the sign. The Dutch Supreme Court referred that issue to the Court of Justice. It was further held in this case that a party such as the defendant was not using the mark because it merely executes a technical part of the production process of the final product without having any interest in the external presentation of the cans and in particular, in the signs thereon.<sup>955</sup> It was held in the above case that there were no infringing acts on the plaintiff's goods. Therefore, in *Trebor v. Football Association*,<sup>956</sup> there was an infringement action involving the Football Association's "three lions' logo." The action arose when a sweet manufacturer, 'Trebor', included photographs of footballers in packets of

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<sup>950</sup> This is contained under Section 10(1) UKTMA, Cap. 26, 1994

<sup>951</sup> Case C-291/100 [2003] ECR I-02799

<sup>952</sup> Section 10(4) UKTMA, Cap. 26, 1994

<sup>953</sup> *Ibid.*

<sup>954</sup> Case C-119/10 [2011] ECR I-13179, [2012] ETMR (16) 340 (ECJ, First Chamber)

<sup>955</sup> *Ibid.*

<sup>956</sup> [1997] FSR 211

sweets that it sold. The Football Association argued that, because some of the footballers were wearing the English team strip, which had the ‘three lions’ logo attached to it, this amounted to an infringement of its mark. Dismissing this action, it was held that Trebor was not really using the logo in any real sense of the word. Thus, Infringement could take place in different forms. A person could be liable for using a material which had initially gained recognition among consumers and the infringer now uses the same material by putting his own mark and consumers would believe that it is the product of the plaintiff. The plaintiff’s trade mark will be harmed in so many ways and would invariably affect the business venture of the claimant. Hence, where a mark is deliberately used on material meant for labelling or packaging of goods, and the colour is the same, or it is exploited on business paper or when goods or services are advertised in a way to mislead consumers, such a person could be accused of infringement.<sup>957</sup>

A person can be said to use a sign where goods are offered or exposed for sale, or puts them on the market and stock them for these purposes under the sign, or offer or supply services under the sign. This simply suggests that although a sign may not be physically attached to the goods in question, a sign may nonetheless still be “used” where it is placed in proximity to, or is connected with the goods.<sup>958</sup> A sign is also used when there are imports and exports of goods under the sign. The importance of this provision is that a trade mark owner can prevent the importing of goods that bear the mark into the United Kingdom. This right can sometimes be used even where those goods have been marketed elsewhere with the trade mark owner’s consent. Therefore, the end result is that a trade mark owner is empowered through this right to divide up markets on a territorial basis, and set prices differently for each territory.<sup>959</sup> On the other hand, while a person need not have title to the goods to be treated as an importer but merely transporting a product bearing a trade mark through a territory (especially where the destination is somewhere else) is said not to be an infringing act.<sup>960</sup>

A sign can also be used on business papers<sup>961</sup> or in advertising.<sup>962</sup> In relation to business papers, the court has to determine whether such uses are in relation to goods or merely to the

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<sup>957</sup> Bently, L. and Sherman, B., op.cit.at 1044, 1045. See also Section 10(5), UKTMA, 1994

<sup>958</sup> Ibid. at p.1044, 1045

<sup>959</sup> Ibid. at pg.1045

<sup>960</sup> Section 10 (4) (c) UKTMA,1994

<sup>961</sup> See the case of *Broad v. Graham* (No. 2) [1969] RPC 295, 298. Section 10(4), UKTMA, ibid.

<sup>962</sup> Section 10 (4) (d) UKTMA, ibid.

packaging.<sup>963</sup> Use in advertising includes a wide range of promotional activity, such as advertisement at the cinema, on television, on billboards, and in magazines; another respect is that advertising also consists of comparative advertising.<sup>964</sup> In *O2 Holdings Ltd. v. Hutchison 3G UK Ltd.*, the Hutchison 3G Ltd. (H3G), in 2004, ran a television advertisement comparing the cost of its pay-as-you-go service with that of O2. The advert featured moving images of bubbles, together with visual and spoken references to the O2 name. O2 thereafter sued H3G, alleging trade mark infringement. O2 alleged infringement under the Trade Marks Act where it was held by the court that it is an infringement to use an identical or similar service in such a way as to give rise to a likelihood of confusion.<sup>965</sup> Use therefore, of a third party's Trade Marks to generate advertising has been held to amount to use, even where the trade mark is typed into a search engine by a third party and the advertisement appears in a set of the search results designated 'sponsored links'.<sup>966</sup>

It has been further held that use on publicly accessible websites counts as "use" under that Trade Marks Act.<sup>967</sup> It should be noted that "use" simply implies that the third party uses the sign in its own commercial communication.<sup>968</sup> It was held that the act of a search engine provider in suggesting the mark as a keyword and generating the adverts in response to the key words is not guilty of using the mark.<sup>969</sup> In other words, where an internet market service provider, such as eBay or Jumia, which provides a service that allows its customers to offer goods for sale under signs that may correspond to trade marks, does not itself 'use' those signs.<sup>970</sup>

An infringement will only occur when the sign is used in the course of trade in a manner that is inconsistent with the owner of the mark.<sup>971</sup> To reiterate the fact that any sign that is infringed is in the course of trade, the Court of Justice in *Arsenal v. Reed*, stated that a sign is used in the course of trade where it is used 'in the context of commercial activity with a view to economic advantage and not as a private matter'.

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<sup>963</sup> Bently, L. and Sherman, B., op.cit. at p.

<sup>964</sup> See generally, Bainbridge, D.I., op.cit. at p. 777-778, 791-796

<sup>965</sup> *O2 Holdings Ltd. v. Hutchison 3G UK Ltd.*, Case C-533/06 [2008] ECR I-4231 (ECJ, First Chamber), [32]-[36]. See also Miskolczi-Bodnar, P. 2004. Definition of Comparative Advertising. European Integration Studies, Miskolc, Volume 3, No.1, pp.24-44. Retrieved May 12, 2016 from [www.uni-miskolc.hu/uni/res/kozlemanyek/2004/Definition.doc](http://www.uni-miskolc.hu/uni/res/kozlemanyek/2004/Definition.doc)

<sup>966</sup> *O2 Holdings Ltd. v. Hutchison 3G UK Ltd.*, Case C-533/06 [2008] ECR I-4231 (ECJ, First Chamber), [32]-[36].

<sup>967</sup> Section 10(4) UKTMA, Cap. 26, 1994

<sup>968</sup> *Louis Vuitton v. Google*, Case C-236/08 [2010] ECR I-2417, [56]

<sup>969</sup> *Ibid.*

<sup>970</sup> *L'Oreal SA v. eBay International AG*, Case C-324/09 [2011], ECR I-6011, [102]

<sup>971</sup> Under Section 103(1) UKTMA, *ibid.*

To sustain an action of a British trade mark, the act must take place in the United Kingdom and it must be in respect of the goods for which there is an infringement in the course of trade.<sup>972</sup> Problems may arise however, where foreign sites are easily assessed by consumers from the United Kingdom; and the Court of Justice has indicated that mere accessibility is insufficient to constitute use of a mark in a particular territory and that the assessment of whether such use exists depends on whether consumers are targeted in that particular territory.<sup>973</sup> In an infringement, the defendant must have used a sign in relation to goods and services covered by the claimant's rights (that is, which is identical, similar to, or dissimilar to the claimant's goods).<sup>974</sup>

The general consensus on the concept of 'use' is whether there is an infringement and whether the use affects or is liable to affect the functions of the trade mark particularly its essential function of guaranteeing to consumers the origin of the goods.<sup>975</sup> The 'origin' function has been described as the guaranteeing of goods or services bearing a registered mark having been placed on the market with the authority of the proprietor and thus, third parties' use affects the value of trademarks.<sup>976</sup>

#### **4.5. Other categories of Trademark Infringement**

Nigeria, under infringement, only recognizes identical or similar products resembling each other. The non-recognition of current trends on trademarks would lead to unrecognized cases of infringement. As a result of industrialization and globalization due to commerce and industry, there are other categories of trademark infringement which Nigeria ought to make legislative provision for, under the Trade Marks Act. Other categories of trademark infringement include trade dress, counterfeit of domain names, dilution and parallel importation.

##### **4.5.1. Get-Up/Trade dress**

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<sup>972</sup> Section 9(1), UKTMA, op.cit.

<sup>973</sup> *L'Oreal SA v. eBay International AG*, Case C-324/09 [2011] ECR I-6011, [66]

<sup>974</sup> Ibid.

<sup>975</sup> *Arsenal v. Reed*, op.cit.

<sup>976</sup> *Hoffman-La Roche v. Centrafarm*, Case C\_102/77 [1978] ECR I-1139

Trade dress is an important asset and it is generally described as the total overall impression which is created by a package design or label or the décor of a business.<sup>977</sup> It is the total image of a product or business which is reflected in features such as size, shape, colour or colour combinations, designs of a label, texture, graphics or sales techniques.<sup>978</sup> Thus, it can occur when one company uses a trade dress similar to another person to cause a likelihood of confusion in a buyer's mind. This however is not recognized under the NTMA which could invariably lead to endless cases of unrecognized infringement .

#### **4.5.2. Counterfeit of domain names**

Trademark counterfeiting in any economy constitutes a potential problem which is serious and as a result of counterfeits, consumers are vulnerable to such activities of the perpetrators.<sup>979</sup> Counterfeits disparage the reputation of genuine goods because such goods are of poor quality and as a result of this, it affects the business goodwill of the original owners.<sup>980</sup> Consumers, therefore, may come to the conclusion that the poor quality goods are those of the original owner and even if they notice the genuine product, there will be that confusion that it is the previously poor quality products and hence, no purchase will be made.<sup>981</sup>

The problem of counterfeiting has been linked to such countries such as Nigeria, Taiwan, South Korea, Colombia, etc and it has been stated that such countries have been named the worst counterfeiting offenders.<sup>982</sup>

The internet helps people to search online for information in the educational sector, fashion sector or any other online businesses and this is achieved by domain names which assists in directing users to different websites. The more people view a particular business-online firm, the more popularity the website gets and also, the more profitable it will be in creating more jobs.<sup>983</sup>

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<sup>977</sup> Shyllon, F. op.cit. at p. 194

<sup>978</sup> Reese, J.W. 1994. Defining the Elements of Trade Dress Infringement under Section 43(A) of the Lanham Act. Retrieved February 10, 2018 from <http://www.tplj.org/wp-content/uploads/Volumes/...>

<sup>979</sup> Jennings, J. 1989. Trademark Counterfeiting: An Unpunished Crime. 80 J. Crim. L and Criminology, 805

<sup>980</sup> Ibid.

<sup>981</sup> Ibid.

<sup>982</sup> Ibid.

<sup>983</sup> XuanThao, N.N. 2001. Cyber Property and Judicial Dissonance: The Trouble with Domain Name Classification. Geo. Mason L. Rev. 183 at 184



Counterfeit of domain names may lead to a trademark infringement when the defendant is dealing in goods online similar to the plaintiff, a registered owner, in relation to the mark or logo itself, or the packaging and service marks.

Where trademarks are not adequately protected, this may lead to deception on the defendant, who is profiting from the business endeavor of the plaintiff. However, the question under this head is, to what extent can the internet be protected. What must be noted is the fact that the counterfeit of domain names must relate to the trademark.<sup>984</sup> There have been notable cases under counterfeit of domain names. An individual's business name can be used in such a way as to infringe its name. So, consumers will be defrauded and cheated where they feel that it is the website they are comfortable with whilst not realizing that the infringer is out to deceive innocent buyers or business partners. One of such is the case of *Shell International Petroleum Co. v. Allen Jones*,<sup>985</sup> where the Shell website was tampered with. The hacker was able to copy the website of 'Shell' as its own and thereby, deceived people into thinking otherwise.<sup>986</sup>

A consequence of counterfeit of domain names is cybersquatting. This is a phenomenon recognized in *Panavision International L.P. v. Toepfen*<sup>987</sup> as an actionable type of dilution claim separate from tarnishment and blurring. Cybersquatting occurs when someone, other than the owner, hijacks and registers a trademark as a domain name for use on the internet with the intention of ransoming the Internet site back to the senior user for a price.<sup>988</sup> This is usually done in bad faith by intentionally registering domain names that is well known to other people and taking it as that of the junior user, who in this case, is the interloper.<sup>989</sup> Hence, customers will be confused when the site that is not known by them, comes up and shows a blank page or a site that is unrelated with that of the owner.<sup>990</sup>

### 4.5.3. Dilution

Dilution is an infringement under trademark law which can occur when a person uses a well-known name which would inadvertently destroy the uniqueness and originality of that

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<sup>984</sup> Bainbridge, D.I., op.cit. at p. 797

<sup>985</sup> *Shell International Petroleum Co. v. Allen Jones*, See Oyewunmi, A.O., op.cit. at p. 347, footnote 44, Chapter 24

<sup>986</sup> Oyewunmi, A.O., op.cit. at p. 347

<sup>987</sup> 141 F.3d 1316 (9th Cir. 1998).

<sup>988</sup> See McCarthy, § 24:69.1, at 24-121.

<sup>989</sup> Oyewunmi, A.O., op.cit. at p. 348

<sup>990</sup> Golinveaux, J. 1999. What's in a Domain Name: Is "Cybersquatting" Trademark Dilution?, 33 *U.S.F. L. Rev.* 641, 643

particular mark. This would affect the value of the product in currency especially if the reputation of the mark was extended across a diverse range of products.<sup>991</sup> It is to be noted that under the Trademark Act in Nigeria, the term, ‘infringement’ is not defined unlike the Trademark law in the United Kingdom where infringement and infringement materials are well-defined.<sup>992</sup> Infringement by dilution is not recognized under the Trade Marks Act in Nigeria while it is recognized under the Trade Marks Act in the United Kingdom.<sup>993</sup> A trademark infringement occurs where a protected trademark is used in connection with entirely different products or services. For instance, if the trademark “Coca-Cola” is used by a manufacturer of blue jeans and such use gives the impression that this product draws on the reputation of “Coca-Cola” as a drink for dynamic young people, interests of the “Coca-Cola” company would be at stake.<sup>994</sup>

Traditionally, under the doctrine of dilution, there are two types. The two types are dilution by blurring and dilution by tarnishment. The multiple uses of the same mark on different products is likely to dilute the distinctive quality of the mark which would make it difficult for consumers to recall the original product. To illustrate, suppose a firm names its soap "Tiffany Soap;" a car company names its new car "The Tiffany;" a restaurant opens under the name

"Tiffany;" and so on. These uses of the TIFFANY mark may not confuse anyone about a possible connection with the jewellery company, but they could clutter the signal sent by the mark and make it more difficult for consumers to link it to Tiffany jewellery or so the blurring theory supposes.

That is, Dilution by blurring occurs when a mark is used by a different manufacturer in an unrelated line of business. For example, the trademark ‘Xerox’ (this is the known name of photocopier machines) would be diluted if it were by a manufacturer of chairs. This thereby prevents consumers from identifying a trademark with a particular good or collection of goods and the end result being that the effectiveness of a trademark is diminished..

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<sup>991</sup> Shyllon, F. op.cit at pp. 241-242. Though cases abound in Nigeria of dilution, there is the need to have a well-defined Federal Law for Trademark Dilution Act. See the case of *Nigeria Distillers Limited v. Gybo and Sons and Anor*, ibid.

<sup>992</sup> Sections 16-18, UKTMA, Cap. 26, 1994

<sup>993</sup> Section 10(3) UKTMA, ibid.

<sup>994</sup> Shyllon, F., op.cit at p.240, 241

Dilution by tarnishment occurs where the trademark is used by a different seller in unrelated goods of lower quality than those of the trademark holder. Tarnishment covers cases where the defendant uses a similar mark in a way that severely clashes with the meanings that consumers associate with the plaintiff's mark.<sup>995</sup> This therefore does not allow the information about the quality level of the trade marked good or collection of goods to be correctly inferred. In essence, dilution interferes with the proper economic function of trade marks.<sup>996</sup>

#### 4.5.4. Parallel Importation

Another form of trademark infringement is referred to as parallel importation. Parallel importation refers to a situation where the owner of the trademark has not given its consent to import its trademarked goods to a certain area.<sup>997</sup> Currently, in Nigeria, no statutory prohibition on parallel importation exists. Parallel importers operate outside the distribution network set up by the manufacturer or his or her authorized distributor. Parallel imports are not fake or counterfeit goods<sup>998</sup> but they occur when products are imported cheaply without the owner's consent having a trademark or other intellectual property in the goods, thereby aiming to compete with the owner's own products which had originally been marketed abroad at a lower price.<sup>999</sup>

The United Kingdom infringement categories is wider than what is found in Nigeria. A deficiency in the Trade Marks Act of Nigeria is that it does not define infringement or infringing materials in the statute. This is unlike the United Kingdom where infringement and infringing materials are defined. In addition, infringement in Nigeria is still related to closely resembling goods likely to cause confusion or deception.<sup>1000</sup>

In order to ensure that Nigeria moves in modern times, the categories of trademark infringement which might occur other than identical or similar marks should be addressed.

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<sup>995</sup> Klerman, D. 2006. Trademark Dilution, Search Costs, and Naked Licensing, *74 FORDHAM L. REV.* 1759, 1762

<sup>996</sup> Shyllon, F., op.cit. at p. 241

<sup>997</sup> Avgoutis, I. 2012. Parallel Imports and Exhaustion of Trademark Rights: Should steps be taken towards an International Exhaustion Regime? *European Intellectual Property Review*, Vol. 34, No. 2, pp. 108-121

<sup>998</sup> Agaba, O. 2013. The Parallel Importer and the Nigerian Trademark Jurisprudence: A Critical Analysis. *NIALS Journal of Intellectual Property*, Vol.2, No. 1

<sup>999</sup> Shyllon, F., ibid.. at p.255

<sup>1000</sup> Section 13(1) NTMA, Cap. T13, Laws of the Federation 2004



## **CHAPTER FIVE**

### **LIMITATIONS OF TRADEMARK PROTECTION IN NIGERIA**

The rationale behind trademark rights is to encourage trademark owners to maintain consistent quality, and failure to protect trademark rights would allow imitators who know they will not be held responsible for the quality of their products to cut corners and undermine the incentives for mark owners to maintain quality themselves.<sup>1001</sup>

All over the world and in particular, Nigeria, the protection of trademarks is of great importance to its economic development. The current legislation on trademarks is the Trade Marks Act 1965 but there are limitations as well as lapses in relation to the protection of trademarks. Firstly, the law of trademark protects the producer or manufacturer who has spent time and energy on creating the symbol or mark and ensuring the mark is not imitated or passed off as the product of another whilst the latter reaps the benefit of what he did not labour for. The consumer is also protected against buying counterfeit goods whereby, the consumer might be harmed by the activity of the imitator. In essence therefore, the principal benefit of trademark protection is that it lowers consumer search costs.<sup>1002</sup> The disadvantage of goods not being marked is that purchasers would be unable to identify the goods easily and

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<sup>1001</sup> Landes, W.M. and Posner, R.A. 2003. *The Economic Structure of Intellectual Property Law*. Harvard University Press, 168, 179

<sup>1002</sup> Landes, W.M. & Posner, R.A. 1987. *Trademark Law: An Economic Perspective*, 30 *Journal of Law & Economics*. 265, 268-70

the only option would be to test the goods directly since the package is unrecognisable.<sup>1003</sup> Once the value of the mark is attained, the need to maintain the level of quality would be greater for the producer which would lower the cost of search by consumers.<sup>1004</sup> Without legal protection, it would be difficult for the user of a mark to appropriate the full value that the mark represents. A trademark is not a public good, but it nevertheless exhibits non-excludability, for in the absence of legal protection, if a firm of good reputation tried to mark its goods with a symbol to let consumers know them-that is, to lower the costs of search for consumers desiring to purchase the firm's goods-other firms could imitate the symbol and trade on the first firm's reputation. Where goods are imitated therefore, this might reduce the motivation for an organization to successfully mark its goods and consumers would pay more in searching for the desired and preferred product.<sup>1005</sup>

### 5.1.Limitations/Defects of trademark protection law in Nigeria

#### 5.1.1. The obsolescence of the Trade Marks Act 1965

The Trade Marks Act of 1965 does not adequately provide for the modern day Nigeria. This Act is considered archaic. The Trademark Regulation of 1966 was to correct the defects of the 1965 Act but it was not amended. The Trade Marks Act of 1965 is based on the 1938 Act of the United Kingdom which is not in conformity with the statutes and law in Nigeria. The Nigerian Trade Marks Act was passed into law in 1965 and it has remained the same without any amendment. Though over the years, there have been reviews but these reviews have had no impact on the state of the law having not been successfully passed into law. The Act is therefore, archaic as it is still catering for the era in which it was created and the modern era, where Nigeria is at the moment, is not captured in the Trade Marks Act. Therefore, marks which should ordinarily be protected are not accorded such rights or privileges.<sup>1006</sup>

The definition in the Trade Marks Act also does not recognise scents, shapes and the packaging of goods and when compared with the Trade Marks Act in the United

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<sup>1003</sup> Economides, N.S. 1988. The Economics of Trademarks. 78 Trademark Rep. 523, 526

<sup>1004</sup> See Scherer, F. op.cit. at 378

<sup>1005</sup> See Goldman, 1960. Product Differentiation and Advertising: Some Lessons from Soviet Experience, 68 *J. POL. ECON.* 346, 348-51

<sup>1006</sup> Arowolo, A.L. 2012. *Ferodo Limited and Ferodo Nigeria Limited v. Ibeto Industries Limited: Another Critical Review*. Retrieved October 10, 2016 from [www.nials-nigeria.org/journals/Dr%20Ayoyemi%20Lawal%20Arowolo-NJIP%202.pdf](http://www.nials-nigeria.org/journals/Dr%20Ayoyemi%20Lawal%20Arowolo-NJIP%202.pdf) See also Adewopo, A.I. and Oguamanam, C. (1999) The Nigerian Trade Mark Regime and Challenges of Economic Development. *International Review of Industrial Property and Copyright Law* Volume 30, Issue 6, 632-653

Kingdom<sup>1007</sup>, it could be said that it falls short of the provisions provided by TRIPs.<sup>1008</sup> It is to be noted that the NTMA 1965 is a replica of the UKTMA 1938<sup>1009</sup> but the current law (that is, the United Kingdom Trade Marks Act 1994) on trademarks made up for the lapses and the clumsiness associated with the previous Act. The NTMA is described only in relation to goods and not services, which makes it restrictive in scope and administration.<sup>1010</sup> Trademarks under the Trade Marks Act 1938 was also in respect of goods alone. In 1984, the Trade Marks (Amendment) Act was enacted and extended trademarks to service marks but this was considered a bad Act and it was considered worse off like that of the Trade Marks Act 1938.<sup>1011</sup> Therefore, it is pertinent to note that this is the same definition under the UKTMA 1938 but the former Act (of 1938), has since been reviewed. The definition under the NTMA does not give room for other types of marks if “certification marks” are exempted. Hence, it does not work enough clarity as it ought to have done because it does not describe what a mark is and what it should entail unlike the UKTMA.<sup>1012</sup>

#### 5.1.2. The non-inclusion of service marks

There is the non-provision for the registration of service marks in the NTMA. Under Section 67 of the Trade marks Act, there is the non-provision for the registration of service marks in the Trade Marks Act. A trademark under the Act is defined only in relation to use on goods only and not otherwise.

Service marks are considered important business tools which cannot be avoided and it is used by a party to identify and distinguish the services of that party from the services of others and to indicate the source of the services even though the source is not known.<sup>1013</sup> A service mark is essentially the same as a trademark, but applies to services rather than products.<sup>1014</sup> When consumers are faced with different choices of goods or services, there is the need to protect such on a national and international level because the higher, the inventions, the higher also, counterfeits which would harm consumers. There is therefore the need to protect

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<sup>1007</sup> Section 1 (1) UKTMA, Cap. 26, 1994

<sup>1008</sup> Olatunji, A.O., *ibid.* 4. See further, Article 15-21, TRIPs Agreement, *op.cit.*

<sup>1009</sup> UKTMA, Cap. 22, 1938

<sup>1010</sup> Section 67, NTMA, Cap. T13, Laws of the Federation 2004

<sup>1011</sup> Bainbridge, D.I., *op.cit.* at p. 691

<sup>1012</sup> Section 1, UKTMA, Cap. 26, 1994

<sup>1013</sup> The differences between trademark, service mark. Retrieved August 30, 2014 from [www.vegastrademarkattorney.com/.../what-are-the-differences-between-trademark...](http://www.vegastrademarkattorney.com/.../what-are-the-differences-between-trademark...)

<sup>1014</sup> What is the difference between a Copyright and Trademark? Retrieved April 5, 2014 from [www.wisageek.com/what-is-the-difference-between-a-copyright-trademark...](http://www.wisageek.com/what-is-the-difference-between-a-copyright-trademark...)

the public in distinguishing between services such as car rentals, hotels, firms, airlines, etc.<sup>1015</sup>

This creates a gap in the law as foreign proprietors that come into Nigeria might not have the total legal backing of the law in registering their service marks and this might only confer on them dubious form of legal protection.<sup>1016</sup> It is dubious in that the NTMA does not recognise service marks but Nigeria only adopts an observant status in relation to the Nice Classification of goods and services of which it is not a member. Nigeria seems to have fallen short of the provision under the international conventions because members are bound to ensure effective protection against unfair competition.<sup>1017</sup>

### 5.1.3. Non-recognition of shapes and packaging

The UKTMA recognises shapes and packaging as contained in the Act.<sup>1018</sup> In Nigeria on the other hand, there is no legislative recognition of shapes and packaging under the NTMA. Packaging is referred to as trade dress which is a form of intellectual property and this can be registered as a trademark. It is a legal term that refers to the visual appearance and design characteristics of a product which signifies the uniqueness of the product to consumers.<sup>1019</sup> Under the current Trade Mark Act in Nigeria, the shape or the form of presentation or packaging of a product cannot be registered. A proprietor therefore, cannot prevent competitors from copying these elements through an infringement action.<sup>1020</sup> This is in contrast with the UKTMA as trade mark could be a name, word, design, numerals, letters, logo, or the package or shape of products but as long as they are visually distinguishable.<sup>1021</sup> Trade dress is an increasingly important asset as it is described as the total overall impression created by a package design or label or the décor of a business.<sup>1022</sup>

### 5.1.4. Other types of infringement

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<sup>1015</sup> World Intellectual Property Organization (WIPO) Handbook, Policy, Law and Use (2004) Geneva. Second Edition, WIPO Publication, No. 489(E). Retrieved October 7, 2013 from <http://www.wipo.int/about-ip/en/iprml>

<sup>1016</sup> Olatunji, O.A. 2016. Fundamentals of the Nigerian Trade Marks Act. Downloaded from <http://jiplp.oxfordjournals.org/> at University of Witwatersrand.

<sup>1017</sup> Article 6sexies, Paris Convention for the Protection of Industrial Property, 1883

<sup>1018</sup> Section 1, UKTMA, Cap. 26, 1994

<sup>1019</sup> Hawthorn Law. 2015. What is Trade Dress and Why is it important? Retrieved April 15, 2017

<sup>1020</sup> Shyllon, F. op.cit. at p. 194

<sup>1021</sup> Section 1, UKTMA, Cap. 26, 1994

<sup>1022</sup> Shyllon, F., *ibid.* at p. 194



Apart from trade dress and counterfeit of domain names, other categories of trade infringement could arise, such as dilution, cybersquatting and parallel importation. The category of trade mark infringement in Nigeria is totally archaic and at the same time, restrictive when compared with that of the United Kingdom. Trademark infringement in Nigeria is limited to when a person, not being the proprietor or registered user of the mark uses a mark identical to, or closely resembling the registered mark in relation to any goods for which the earlier mark is registered but does not give instances how this can occur.<sup>1023</sup>

The NTMA, has failed to recognise other categories of trademark infringement which is essential to the development of the international trademark system. Also, the Act also ignores the fact that the world has moved from where it is and in its place, some marks have acquired reputation over a long period of time. The United Kingdom's coverage of trademark infringement for instance, is wider and hence, it has been noted that as a result of globalization, other marks have been accorded the relevant recognition. The UKTMA, thereby provides under Section 10, the different instances on how trademark infringement can occur.<sup>1024</sup>

It is also to be noted that there is no provision or special section for the infringement of trademarks in Nigeria. The UKTMA however, provides extensively for how trademark infringement can occur.<sup>1025</sup> Nigeria only refers to infringement under Section 13,<sup>1026</sup> in relation to goods which look alike in one form or the other and provides that where there are similarities between the proposed trade mark to be registered and one, which is already in the Register, such goods will not be registrable as this could create misperception amongst consumers who are likely to purchase such products.

#### **5.1.5. Administration of trademarks in Nigeria**

The Registrar of trademarks who acts under the instruction of the Minister is responsible for the administration of trademark law in Nigeria. The Trademarks, Patents and Design registry regulates the administration of trademarks in Nigeria under the Ministry of Trade, Commerce

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<sup>1023</sup> Section 13(1) NTMA, Cap. T13, Laws of the Federation 2004

<sup>1024</sup> Section 10, UKTMA Cap. 26, 1994

<sup>1025</sup> Sections 16, 17, 18, UKTMA Cap. 26, 1994

<sup>1026</sup> Section 13(1), NTMA, Cap. T13, Laws of the Federation 2004

and Investment. The administration of trademarks is still based in a Ministry unlike what operates in Copyright.<sup>1027</sup>

#### 5.1.6. The non-domestication of International Agreements and Conventions

The non-domestication of these Conventions creates limitations in protecting and ensuring that trademark laws in Nigeria is accepted on an international scale. The Paris Convention adheres to the principle of national treatment whereby corporations or individuals who are citizens or residents in a state, but are member parties' to the Convention shall also enjoy in other countries, apart from where they are resident, the benefits that would be granted to them as if they were in their own country. That is, irrespective of where a person is, and as long as the state is a party to the convention, such a person's industrial property rights would be protected.<sup>1028</sup> In order to determine the basis of uniform legislation in the field of industrial property, the Paris Convention for the Protection of Industrial Property was enacted in 1883 (therefore called: Paris Convention). The Paris Convention contains rules of substantive law which guarantees the right to national treatment in each member country.<sup>1029</sup> That is, if a German national applies for registration in Italy, the German will have to be treated the same way as an Italian national filing for protection will be treated. This rule is one of the basic rules of the system of international protection established under the Paris Convention. Additionally, it also guarantees protection against discrimination in this area. Without that rule, it would sometimes be extremely difficult to obtain adequate protection in foreign countries for industrial property rights.<sup>1030</sup>

Even though Nigeria is a member of the Paris Convention and TRIPs, it seems that it is only effective on paper and its actual provisions are not followed and neither are they enforced or implemented.<sup>1031</sup> It is pertinent to define what a treaty entails. A treaty is an agreement under international law entered by participants in international law, usually sovereign states and international organizations. It may be an international agreement, protocol, covenant,

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<sup>1027</sup> Nwocha, U. Nigerian Intellectual Property: Overview of Development and Practice. Retrieved December 2, 2013 from <http://www.nials-nigeria.org/journals/Uche%20Nwokocha-NJIP%202.pdf>

<sup>1028</sup> Articles 2 and 3, Paris Convention, *ibid*.

<sup>1029</sup> Articles 2 and 3, Paris Convention, *ibid*.

<sup>1030</sup> *Ibid*.

<sup>1031</sup> World Intellectual Property Organisation [WIPO] since April 9, 1995. Retrieved February 12, 2016 from [www.wipo.int/wipolex/en/profile.jsp?code=NG](http://www.wipo.int/wipolex/en/profile.jsp?code=NG) See Mordi, M. 2011. Towards Trademark Law Reform in Nigeria: A Practitioner's Note. *NLALS Journal of Intellectual Property* (NJIP) Maiden Issue.

convention, pact, or exchange of letters, among other terms.<sup>1032</sup> It is therefore apposite to note that a treaty must be domesticated by the National Assembly before it can become law.<sup>1033</sup>

The Agreement on Trade-Related Aspects of Intellectual Property Rights, otherwise known as TRIPs, was brought about by the World Trade Organization. The agreement states that any sign, such as a name, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually noticeable.<sup>1034</sup> The agreement requires also that service marks be protected in the same way as marks distinguishing goods.

In the beginning, it was only possible to receive protection of trade marks at the national level and it was only left to the particular national authorities to determine how far trademark protection could be granted. During the last century, however, it was regarded as necessary to create protection for industrial property rights on an international level as well. The fact that there existed no uniform legal protection but different trademark law in every country meant that if an enterprise used a sign as a trademark which was protected under national law and entered the market in another country it ran the risk that its trademark would not be protected under the national law of that particular country. The originally protected mark could thus be exploited by another enterprise. Accordingly, enterprises respectively foreign trademark owners were rather cautious to enter the international market. For this reason, it was feared that the free exchange of goods and services could be hampered, if no international protection was created.

The afore-mentioned laws have not been reviewed in spite of several international developments that have necessitated convention member countries to update their local laws accordingly. Nigeria, though a treaty member, has fallen short of updating its local laws in consonance and there is a resistance to import the principles of international convention into local usage in order to preserve the supremacy of the country's registrations.<sup>1035</sup>

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<sup>1032</sup> Onibokun, A. 2015. *We need to domesticate our International Treaties*. Retrieved May 2, 2016 from [legalnaija.blogspot.com.ng/2016/01/we-need-to-domesticate-our.html](http://legalnaija.blogspot.com.ng/2016/01/we-need-to-domesticate-our.html)

<sup>1033</sup> Section 12, Constitution of the Federal Republic of Nigeria, 1999 (As amended)

<sup>1034</sup> Article 15, TRIPs Agreement 1995

<sup>1035</sup> Taiwo, L. 2009. *Intellectual Property Law in Nigeria: New Trends and Challenges. Inside the Minds: IP Client Strategies in the Middle East and Africa*. Published by Thomas Reuters/Aspatore

The benefits of Nigeria acceding to the international conventions in relation to trade marks would be enormous. The need for international protection is that foreigners would be assured that their trademarks are satisfactorily safe against infringers, especially if the mark was about to be registered in a developing country. If the country had complied in ensuring that the treaties are aligned into the NTMA, Nigeria would have gone far in protecting trade mark and would be able to compete side by side with other developed countries. Not only that, it will add maximum wealth to the economy and to the developmental growth to Nigeria.

#### **5.1.7. Inadequate appreciation of the role of trademark in trade and commerce**

African countries (of which Nigeria is not excluded) have limited understanding of intellectual property protection systems. The fact that Africa is labeled as consumers of intellectual property and at the mercy of the owners of intellectual property rights has not resolved the situation. Illiteracy is one of the challenges of trademark protection in Nigeria. The public is uneducated on trademark protection in Nigeria and often, 'language' is a hindrance to understanding aspects of Intellectual Property Law. In addition, the peculiar setting of the Nigerian society has a large illiterate population and so, the possibility of deception or confusion is an important and crucial matter.<sup>1036</sup>

## **CHAPTER SIX**

### **SUMMARY, RECOMMENDATIONS AND CONCLUSION**

This chapter presents the summary and recommendations of this study. The conclusion is therefore based on the result of data analysis.

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<sup>1036</sup> Ibid. at p.7

## **6.1. Summary of findings**

This thesis has been able to discuss the importance of trademark protection and why it is necessary for any society to adequately protect its trademark laws in order to aid economic development. The theoretical framework utilised in this study which is the basis for the protection of trademarks focuses on the sociological and the economic analysis of the law approaches and imbibed in the utilitarian-economic and social planning theories.

This study has striven to fulfill the first objective of this research work, which is to examine the historical origins of trademarks and the importance for its protection in Chapter two. This is further complemented with our discussion on the origin and evolution of trademarks and the concept of trademarks in Nigeria. The theoretical framework which underlies the basis for trademark protection was also assessed.

In the discussion of the evolution of trademarks, we drew from scholarly works of literature and related reviews of intellectual property experts with a review to assessing trademark protection. Trademark protection evolved in the United Kingdom as a preventive method to inhibit deceit and to ensure that imitators did not pass off the goods of others as their own. Trademark law evolved in Nigeria as a result of colonisation even though trademarks existed before colonisation.

In furtherance of the second objective, the law regulating trademark in Nigeria was examined, the function of trademarks, its administration was compared with the United Kingdom. A comparative analysis and the prevailing minimum international standard was discussed. The international conventions in relation to industrial property was discussed and this runs through our discussions and assessment of the current laws in chapters two and three respectively.

In furtherance of the fourth objective, the extant laws on other categories of trademark infringement was discussed. The focus of this chapter is to bring out the other categories of trademark infringement which Nigeria should accord recognition. There are other types of trademark infringement and there is no legislative protection for such under the Act. Such categories include trade dress which could evolve into dilution, cybersquatting, counterfeit of domain names and parallel importation. However, these categories are important as they relate to trade and industry.

It was further discovered in this study that there is the need for Nigeria to strengthen its trademark laws. This can be done by updating the current legislation on the protection of trademark in Nigeria. When Nigeria strengthens his trademark law, issues such as counterfeiting or piracy will be adequately controlled. Also, it is to be noted that the use of trademarks in Nigeria began with imported foreign goods to sustain the business interests of early European entrepreneurs and commercial agents and this has not changed as Nigeria continues to depend more on imports with a low level of truly indigenous manufacture.<sup>1037</sup> Nigeria is a nation that is diverse in business and has been able to produce local products for the benefit of its citizenry. Hence, the production of such goods should be promoted so that the need to purchase foreign goods would diminish and instead, quality goods should be produced by notable Nigerian manufacturers. When this is promoted and the awareness of such goods are known, Nigeria would not only build and create wealth for the economy but there will be a reduced propensity for such foreign goods.

The current legislation on trademarks needs to be strengthened as it is in need of an amendment. An observation which should be made here is that the Nigerian Trade Marks Act, 1965, was fashioned after the English Trade Marks Act of 1911 and this later became the 1938 Trade Marks Act. Therefore, the 1965 Trade Marks Act drew extensively and substantially from the 1938 English Trade Marks Act.<sup>1038</sup> The UKTMA 1938 did not provide for service marks and it was because of this anomaly that the United Kingdom amended the 1938 Act to accommodate the registration of service marks. As a result of the inadequacy and complex interpretation, the English Trade Marks Act of 1938 was thereafter repealed because of its ambiguity because it worked hardship on the citizens. Today, service marks are registered in the United Kingdom under its Trade Marks Act of 1994, whilst Nigeria, on the other hand, is still burdened with the 1938 Act which makes no provision for the registration of service marks.

Over the years, Nigeria has developed in the areas of commerce and hence, the increased relevance and importance in ensuring an updated and modern Act to guide the areas of commerce and industry. In addition, the definition of Trade Mark under the Act is vague and can lead to confusion and ambiguity as it is a replica of the UKTMA 1938, which has since

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<sup>1037</sup> Asein, J.O. 1994. Consumer Literacy and Confusing Similarity of Pictorial Trademarks in Nigeria. 84 *Trademark Rep.* 64. Content downloaded February 2, 2015 from HeinOnline <http://heinonline.org>

<sup>1038</sup> Ibid.

been repealed. The definition is limited as it relates only to goods. On the other hand, this can be compared with the current UKTMA 1994 where it provides for goods and services, and in addition, also provides for new trends on trademarks.<sup>1039</sup>

The Trade Marks Act of 1965 should be reviewed as it has become outdated and has remained the same without any amendment. It is still accommodating for the era in which it was created and the modern era where Nigeria is at the moment is not captured in the Act. The need for a review is essential because, society is constantly changing and what is obtainable or applicable today may not be the same in the next few years. Nigeria, though a developing country, has gone way beyond a developed country in scientific and technological developments. The Act should therefore be reviewed and continuously be reviewed and brought up to date so as to effectively provide for new innovations.

For the Trade Marks Act to be reviewed, the starting point is to define the meaning of trademark in Section 1 and not in Section 67 as presently stated in the Act. In comparing with the UKTMA, the definition is well regulated and it captures the meaning within TRIPs and the Paris Convention. The meaning under the NTMA is loaded with pros and cons which makes it abstruse. The need for a review is long over-due and there have been efforts in the past to amend the NTMA. To address the inadequacies of the Act therefore, a Draft Law on Industrial Property Law was proposed but this has not been fruitful as it is still pending and at the draft stage.<sup>1040</sup>

The study also found that under the NTMA, registrable marks are defined only in relation to goods whilst there is no mention of service marks. The essence of a trademark is to enlighten purchasers of goods that those goods are connected with or come from a particular manufacturer. The function of a service mark is similar to that of a trade mark, which identifies the provider of certain services and distinguishes such service provided by others in the industry.<sup>1041</sup> However, while a trade mark relates to products, service marks relate to

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<sup>1039</sup> Section 1, UKTMA, Cap. 26, 1994

<sup>1040</sup> Shyllon, F., op.cit. at p.193

<sup>1041</sup> Kayode, L. 2015. The Growing Necessity for the Protection for Service Marks in Nigeria. Retrieved August 21, 2013 from [www.okayode.com/files/service\\_marks.pdf](http://www.okayode.com/files/service_marks.pdf)

services. In other words, manufacturers, sellers and distributors of products use trademarks while providers of services use service marks.<sup>1042</sup>

In 2007, the Minister of Commerce extended classes of goods from 34-45 and referred to the newly added 11 classes as intangible goods. It is presumed that the newly added classes to the Trade Mark Regulation relate to services and the Minister is purported to have acted under the exercise of his power under the NTMA.<sup>1043</sup> Now, there is no mention of ‘Service marks’ anywhere in the Act. The presumption stems from the fact that trade mark is referred to as tangible goods but can it be said that the ‘intangible goods’ relate to services? That is a question that must be answered by policy makers as there is no clarification under the NTMA. This Regulation is controversial especially among Intellectual Property practitioners and scholars and has been a debate whether the Minister’s action has a sound foundation in law.<sup>1044</sup> This is however, a gap in the law because there is no substantial amendment to the Act as a regulation cannot take the place of an Act. The NTMA 1965, has to therefore, reflect the power of the Minister to regulate goods and services. This is a fundamental flaw in the law which though has been overlooked, should not be allowed to continue as so. The irregularity is that the Minister’s exercise of his power to make regulations is in relation to its administrative part only but there are no substantial changes under the NTMA. It still remains the same and the Draft Bill on Intellectual Property, which ought to have been enacted, has been relegated to the back door. The reason why there should be adequate trademark laws, is so that there will not be the high incidence of inferior goods coming from different countries and flooding the markets in Nigeria. Hence, adequate trademark laws will lead to water-tight protection of citizens and border crimes such as bringing goods that have expired would be curbed. There is the need for Nigeria to encourage its manufacturers so that local goods can be produced. Hence, the government should also assist farmers and agriculturists to produce and sell local products.

For a trade mark to be registrable, it must fall within specified groups as laid down under the law. The Minister here, has the capacity to make<sup>1045</sup> regulations in categorising such goods into respective groups for the registration of trade marks. It is pertinent to note as afore-

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<sup>1042</sup> Ibid. at p. 2

<sup>1043</sup> Olutunji, A.O. and Olopade, O.O. 2014-2015. NIALS Journal of Intellectual Property [NJIP] at p. 67. See Sections 42(1) and 45, NTMA, Laws of the Federation 2004

<sup>1044</sup> Ibid. at p. 68

<sup>1045</sup> Section 45(b), NTMA, Cap. T13, Laws of the Federation 2004



mentioned that this is only in relation to goods. A point which ought to be stated is the fact that there is a difference between goods and services as goods are not services and services are not goods and should be differentiated. The essence of a trade mark is to inform purchasers of goods that those goods are connected with or come from a particular manufacturer. The function of a service mark is similar to that of a trade mark, which identifies the provider of certain services and distinguishes such service provided by others in the industry but the distinguishing factor is that it relates to services to consumers.<sup>1046</sup>

With trends of globalization, the internet world and technology, it is necessary for Nigeria to move from where it is now and be more current as the laws for the registration of trademarks are not up to date and are therefore not adequate for modern day development. Service Marks serve as a tool in business in aiding to build and maintain demand for that service whilst at the same time, enabling the consumer to identify and make decisions upon a recognized service.<sup>1047</sup> Where this is non-existent, it will create problems especially when there is the legislative protection for such.

Service Marks connotes any organization's intellectual property asset which is vital in protecting its right against people who want to procure the reputational assets of the original owner. Hence, in registering a Service mark, the protection which it provides is that it would stop other people from making unauthorized uses of conflicting designs, symbols, words, character, colour, shape or slogan. In other words, service marks are unique to individual businesses. Service Marks are what customers use to identify the trader's services which they can thereby recommend to other persons. The brand or logo is thus the most valuable asset of any organization or enterprise.<sup>1048</sup> The United Kingdom and the United States differentiates between the two functions and when reviewing markings on brochures for services, the 'SM' symbol follows the mark.<sup>1049</sup> Service Marks therefore, serves as a tool in business in aiding to build and maintain demand for that service whilst at the same time, enabling the consumer to identify and make decisions upon a recognized service.<sup>1050</sup>

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<sup>1046</sup> Kayode, L. 2015. The Growing Necessity for the Protection for Service Marks in Nigeria. Retrieved August 21, 2013 from [www.okayode.com/files/service\\_marks.pdf](http://www.okayode.com/files/service_marks.pdf)

<sup>1047</sup> Dalley, G.R.F. Protection of Service Marks in Nigeria- A Necessity. Retrieved September 12, 2015 from [www.grfdalleyandpartners.com/.../Protection%20OF%20Service%20MARKS](http://www.grfdalleyandpartners.com/.../Protection%20OF%20Service%20MARKS)

<sup>1048</sup> Ibid.

<sup>1049</sup> Global Trademark Resources. Fact Sheets Types of Protection. Service Marks. Retrieved August 20, 2016 from [inta.org/TrademarkBasics/Factsheets/Pages/ServiceMarksFactSheet.aspx](http://inta.org/TrademarkBasics/Factsheets/Pages/ServiceMarksFactSheet.aspx)

<sup>1050</sup> Dalley, G.R.F. Protection of Service Marks in Nigeria- A Necessity. Retrieved September 12, 2015 from [www.grfdalleyandpartners.com/.../Protection%20OF%20Service%20MARKS](http://www.grfdalleyandpartners.com/.../Protection%20OF%20Service%20MARKS)

Under the current Trade Mark Act, the shape or the form of presentation or packaging of a product is not recognized in Nigeria. A proprietor therefore, cannot prevent competitors from copying these elements through an infringement action.<sup>1051</sup> This is in contrast with the United Kingdom Act where it protects product packaging, and other types of trade mark which are made use of in business practices.<sup>1052</sup> Trade dress is an increasingly important asset as it is described as the total overall impression created by a package design or label or the décor of a business.<sup>1053</sup> In addition, it could be referred to as the visual appearance of a product, which is used in most cases to signify the source of the product to consumers.<sup>1054</sup> The non-recognition of packaging was brought out in the case of *Ferodo Nigeria Ltd. v. Ibeto Industries Ltd.*,<sup>1055</sup> the plaintiff, a British company and a business enterprise in Nigeria were the owners of the brand “Ferodo” used for selling manufactured brake linings for motor vehicles, sold in cardboard packages and registered as a trade mark. The defendant/respondent is the owner of the brand “Union” for manufacturing and selling brake linings. The plaintiffs/appellants claimed that the packaging under which the defendant/respondent marketed its “Union” brake lining is so similar to the plaintiffs/appellants’ packaging that it constituted an infringement of their trade mark. It was also alleged that the sale of the defendant/respondent’s brake lining also amounted to passing off the products of the plaintiff/appellant’s. It was further alleged that the colour of the business was red, black and white colour combination which closely resembled the Ferodo package design and it was likely to deceive the public if it were to be put up for sale in the market. The plaintiff sought for an injunction to restrain the defendant whether acting by itself, its servants or agents or any of them from the following:

1. Infringing the plaintiff’s trade mark;
2. Passing off or causing or enabling or assisting others to pass off the defendant’s ‘Union’ brake linings as and for the plaintiff’s ‘Ferodo’ brake linings;
3. Selling or offering for sale or supplying brake pads and labels in packages having the distinctive red, black and white design or get up of the plaintiff’s ‘Ferodo’ brake linings.’ The exterior design of the product of the defendant looked too much like that

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<sup>1051</sup> Shyllon, F., op.cit. at p. 194

<sup>1052</sup> Section 1, UKTMA, Cap. 26, 1994

<sup>1053</sup> Shyllon, F., op.cit. at p. 194

<sup>1054</sup> Ibid.

<sup>1055</sup> [2004] 5 NWLR, part 866 at p 317

of the plaintiff that it could mislead consumers into thinking that the respondent was an agent of the plaintiff

The learned trial judge in his judgment found that there was no infringement of trade mark. The plaintiff/appellant appealed. The Court of Appeal abandoned the appeal as it related to the issue of passing off. The appeal was limited to infringement of trade mark. The decision of the trial court was affirmed and the appeal was dismissed. An appeal was made to the Supreme Court. Musdapher J.S.C. (as he then was), delivering the leading judgment of the Supreme Court said in his judgment, that the only recognition was on the word, 'Ferodo' and that the color and geometric designs do not form part of the trademark device.<sup>1056</sup>

Similarly, in *Trebor Nigeria v. Associated Industries*,<sup>1057</sup> the inadequacy of the Act to recognise packaging as a trade mark device was brought to light. The plaintiff in this case sought to restrain the defendants from using a certain wrapping on the defendant's product that was highly identical with that of the plaintiff. Although the court found that the defendants attempted to manufacture and market a product which was similar to that of the plaintiff's product, the plaintiff only succeeded in its passing off claim and not in its trade mark infringement claim.

As a result of the non-recognition of other types of trademark infringement, trade dress as a form of infringement, could lead to dilution, counterfeit of domain names and parallel importation. Hence, the absence of legislative protection on trade dressing or product packaging would therefore result in endless cases of unrecognized infringement in Nigeria. The counterfeiting of trade marks is where a meddler uses the products of the owner as his own and consumers will think that the low quality products indeed emanated from the proprietor.<sup>1058</sup> In the United Kingdom, infringement categories are much wider than what is found in most developing countries like Nigeria where infringement is still limited only to the use of goods that are similar or nearly resemble each other. Also, instances of how such infringement could occur are not stated under the NTMA.<sup>1059</sup>

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<sup>1056</sup> *Ferodo Limited and Ferodo Nigeria Limited v. Ibeto Industries Limited*, Op.cit. at p.350-352

<sup>1057</sup> (1972) N.C.L.R. 471

<sup>1058</sup> Criminal Defense Lawyer. Counterfeiting Trademarks and other Intellectual Property. Retrieved October 10, 2016 from <http://www.criminaldefenselawyer.com>

<sup>1059</sup> Olatunji, A.O. and Olapade, O.S. 2014-2015. The Trademarks Act of Nigeria and the United Kingdom: A Comparative Examination. *NIALS Journal of Intellectual Property* [NJIP] at p. 83. See Section 13(1) NTMA, Cap. T13, Laws of the Federation 2004

It is of great importance to note that the packaging of goods as indicia for distinctiveness has become an essential requirement in trade mark protection and part of commercial practice. Justice may therefore, not be achieved where the determination of the infringement of a trade mark is limited to the similarity of marks described as a word without the graphics or design used on the packaging.<sup>1060</sup> The development of commerce over the past decades accounts for the increased relevance and importance of trademarks; hence, the need for an updated Act. Law as an instrument of social engineering and economic development ought to suit the society in which it functions and hence, the urgent need for an updated Trade Mark Act.<sup>1061</sup>

The study also found that, the courts usually take judicial notice of illiterates in the establishment of likelihood of confusion in trademark infringement as shown in the above case. The case indicates that where there are two similar pictorial representations, an educated European is not likely to be deceived by such products; however, an illiterate African might be deceived by the pictorial representations.<sup>1062</sup> It was held in the case of *Maclver & Co. Ltd. v. C.F.A.O.*, that, local variations should be adhered to, when considering an illiterate population.<sup>1063</sup> Similarly, in *Lagos Stores Ltd. v. Blackstock & Co.*,<sup>1064</sup> the learned judge stated that the question was whether the two labels were so similar as to be likely to be mistaken by “an ordinary native”.

Osborne, C.J. in *John Holt & Co. Ltd. v. J.J.W. Peters & Co. of Hamburg* held that, an illiterate might not appreciate the wordings of a product but the picture or diagram might be better appreciated by the common man.<sup>1065</sup> The Court examined two competing trademarks: one consisting of a dingo dog and the other, a pointer dog with a bird in its mouth. Osborne warned that the standard to be applied should be lower than that obtained in more civilized societies and also, that it would be too much to expect an illiterate native to appreciate the differences in the two competing marks.<sup>1066</sup>

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<sup>1060</sup> Arowolo, A.L. 2012. *Ferodo Limited and Ferodo Nigeria Limited v. Ibeto Industries Limited: Another Critical Review*. Retrieved from NIALS Journal of Intellectual Property [NJIP]

<sup>1061</sup> *Ibid.*

<sup>1062</sup> (1917) 3 N.L.R. 18

<sup>1063</sup> *Ibid.* at 18, 19

<sup>1064</sup> (1901) Unreported

<sup>1065</sup> *Ibid.*

<sup>1066</sup> *Ibid.*

In the study carried, it was of the opinion of some of the legal practitioners that most judges are not trained in Intellectual Property and hence, not knowledgeable in Trade Marks. As a result of the inadequacy of the NTMA, it will be difficult for any learned judge to fully appreciate the need for trade mark protection in Nigeria. In addition, there should be a Handbook on Trade Marks which should serve as a guideline for the judiciary and learned counsels when deciding matters on trademarks.<sup>1067</sup>

Under the NTMA, there are provisions for trans-border trade but since the treaty has not been domesticated into the law, it is yet to be seen how effective this might be. To ensure compliance, Nigeria includes such provisions relating to convention applications and priority rights in the Act. Hence, the international conventions are only convincing in theory but in practice, they are not enforced as the provisions under the Paris Convention and TRIPs, which ought to be included under the Act, are not implemented.<sup>1068</sup>

The importance of these treaties is to ensure that a mark is protected from country to country and where such a trade mark is registered in one country, it is also deemed to have been registered in other countries. The agreement states that any sign(s) which can be seen with the eyes and includes individual appellations, calligraphies, cyphers, letters, numerals, pictures, sculptures and different colour patterns are capable of being registered as a trademark provided they are visually perceptible.<sup>1069</sup> The agreement requires service marks to be protected in the same way as marks distinguishing goods. Thus, as the trademark law and case law stand today, Nigeria is in breach of her commitment because the definition of trademarks fall short of the obligations imposed under the TRIPs Agreement.<sup>1070</sup>

## **6.2.Recommendations**

The importance of trademark should not be ignored by the policy stakeholders and also the citizens. The problem at the heart of trade mark law in Nigeria lies in definitions of important concept which must be addressed. They are essential in that anybody may understand what trademarks are all about. It seems that Nigeria is fond of having half-done laws because as it

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<sup>1067</sup> It is worthy to note that other countries, for instance, United Kingdom and United States have guidelines when deciding trademark cases

<sup>1068</sup> Mordi, M. 2011. Towards Trademark Law Reform in Nigeria: A Practitioner's Note. *NIALS Journal of Intellectual Property* (NJIP) Maiden Issue. Retrieved September 10, 2015 from [www.nials-nigeria.org/journals/Mark%20Nordi.pdf](http://www.nials-nigeria.org/journals/Mark%20Nordi.pdf)

<sup>1069</sup> This is contained in Article 16(1) TRIPs Agreement 1995

<sup>1070</sup> Article 15(1) TRIPs Agreement 1995

is ratifying one, it is taking on another without domesticating any law. Trademark is important in any society and the knowledge to be able to distinguish the goods from other goods and undertakings is very crucial. This is however a major concern in the protection of trademarks in Nigeria. It is important for trademarks to be protected because if no adequate protection exists, there will be the high incidence of piracy, counterfeit of trademarked goods and then, the issue of consumer protection will be at stake.

Therefore, with the literature on trademarks, from comparing the origin of trademarks with the United Kingdom, there is the urgent need for its review and thereby, proposing a way forward for Nigeria through recommendations is essential. Where weaknesses highlighted are corrected in a new legislation, these laws, it is hoped will put trademark law in Nigeria on a better footing.

The following recommendations are proffered:

#### **6.2.1. Review of the Trade Marks Act 1965**

The Trade Marks Act of 1965 should be reviewed. The development of commerce over the past decades accounts for the increased relevance and importance of trademarks; hence, the need for an updated Act. The following aspects should be addressed:

- a. The new law should deal with registration of service marks as there is no provision presently under the Trade Marks Act, Nigeria. Nigeria adopts the Nice Classification of Goods and Services 1957 but is not a member but only adopts an observer status.
- b. There is a fundamental flaw in the Nigerian Trade Mark legislation in relation to trade dress. Trade dress is the outer layer of a product and it is a distinctive element of product identification; and it has become an essential requirement in trade mark protection in relation to commerce and industry. The absence of legislative protection on trade dressing or product packaging would result in endless cases of unrecognized infringement.<sup>1071</sup> Trade dress also leads to other types of trademark infringement such as dilution, parallel importation and counterfeit of domain names.
- c. The Trade Marks Act also, does not define infringement and infringing materials. The provision in the Act,<sup>1072</sup> states that a trade mark cannot be registered if it is in respect of goods that are the same or identical and in the register especially if it belongs to another person. This could invariably mislead consumers into believing that they are

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<sup>1071</sup> For example in *De Facto Works Ltd. v. Odumotun Trading Co. Ltd.* (1959) L.L.R. 1, the court did not recognise the packaging of the bread as a form of infringement

<sup>1072</sup> Section 13(1), NTMA, Cap. T13, Laws of the Federation 2004

purchasing the products of the owner, whereas they are not. Therefore, under the NTMA, this is the only section that discusses “identical goods resembling other goods.” This on the other hand, differs from the United Kingdom. The UKTMA<sup>1073</sup> provides for the different ways there can be an infringement of a registered trade mark, under Section 10.

Any such use that is not otherwise in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use takes unfair advantage of, or is detrimental to the distinctive character of the owner’s trademark without lawful justification.

The UKTMA, on the other hand, makes provision for the definition of infringement and infringing materials.<sup>1074</sup> It should be noted that goods are not services and hence, should not be addressed as though they mean the same thing, but nothing in the NTMA states otherwise.

### **6.2.2. Provision of Counterfeiting under the Trademark Act**

Trademark counterfeiting occurs where services are advertised or presented in ways designed to mislead consumers into believing that the services originate from a legitimate source. Confusion usually arises where an infringer uses a registered mark of the proprietor in a way that consumers would think that there is a close fellowship in the course of trade between the real owner and the otherwise, fake owner.<sup>1075</sup> In order to ensure that Nigeria protects its citizens, there must be a provision in the proposed Act dealing with counterfeiting of trademarked products. Counterfeiting is the practice of manufacturing, importing or exporting, selling or otherwise dealing in goods which are often of inferior quality under a trademark identical to or substantially indistinguishable from a registered trademark without the approval of the registered trademark owner.<sup>1076</sup> Knowing fully well that trade mark falls under civil liabilities, it is suggested that there should be criminal liabilities which would cater for counterfeiting of both physical and online products. Where the defendant knowingly or recklessly causes or attempts to cause serious bodily harm or injury by introducing

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<sup>1073</sup> Section 10 (1)-(6), UKTMA 1994

<sup>1074</sup> Sections 14-18, UKTMA 1994

<sup>1075</sup> Criminal Defense Lawyer. Counterfeiting Trademarks and other Intellectual Property. Retrieved October 10, 2016, from <http://www.criminaldefenselayer.com>

<sup>1076</sup> Fact Sheets Protecting a Trademark. Counterfeiting. Retrieved October 10, 2016, from <http://www.inta.org/TrademarkBasics/Factsheets/Page>

counterfeit trademarked goods into the market, more penalty should be added to the defendant.<sup>1077</sup>

There is the need to review the Merchandise Marks Act of 1916<sup>1078</sup> in order to make substantive provisions for the right of creators and also to provide an efficient enforcement and deterrent system for the protection of those rights. Under the Act, every person who forges any trade mark or falsely applies to goods any trade mark or any mark that is similar to other goods and is able to successfully deceive consumers will be liable to be convicted to six months imprisonment or to a fine of one hundred naira.<sup>1079</sup> Counterfeiting is a grave offence which ought to be severely punished and this can be done by increasing the penalties under the Merchandise Marks Act. The penalties stated under the Merchandise Marks Act is not stringent enough to deter criminals and where there are no laws, it will be difficult to catch criminals who have perfected their acts in counterfeiting. In addition, the NTMA does not include Criminal penalties unlike the UKTMA, where such is included.

### 6.2.3. Technological development

The new form of crime in Nigeria is Cybersquatting and this occurs where individuals, referred to as squatters steal domain names and sell them off in order to make profit on another person's business innovations.<sup>1080</sup>

The relevance of cyberspace protection is that criminals use the internet to steal or use brand image and corporate designs for making money or profit out of the counterfeit products.<sup>1081</sup> Trademarks have played an important role throughout the history of commerce but the Internet's domain name system and the e-commerce that has mushroomed around it have made trademarks more important. Computers connected to the internet and the websites that are located on specific computer servers and domain names therefore assists Internet users to finding particular websites.<sup>1082</sup> The economy in Nigeria is not the same as it used to be as

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<sup>1077</sup> Ibid.

<sup>1078</sup> The Merchandise Marks Act, Cap. M10 Laws of the Federation of Nigeria 2004

<sup>1079</sup> Merchandise Marks Act, Laws of the Federation of Nigeria 2004. Merchandise Marks Act: Offences as to Trademarks and Trade Descriptions. Retrieved December 31, 2016 from <http://npliw.com/merchandise-marks-act-offences>

<sup>1080</sup> Internet Cybersquatting: Definition and Remedies FindLaw. Retrieved September 7, 2016, from <http://smallbusiness.findlaw.com/business-operations/internet-cybersquatting-definition-and-remedies.html>

<sup>1081</sup> Saulawa, M.A. and Marshall, J.B. 2015. The Legal Framework of Cybersquatting in Nigeria. *International Journal of Humanities Social Sciences and Education (IJHSSE)* Volume 2, Issue 4, pp. 1-8. ISSN 2349-0381. Retrieved Sept. 7, 2016 from [www.arcjournals.org>ijhsse>1.pdf](http://www.arcjournals.org>ijhsse>1.pdf)

<sup>1082</sup> Halpern, M. and Mehrotra, A.K. 2000. From International Treaties to Internet Norms: The Evolution of International Trademark Disputes in the Internet Age



more people depend on technological know-how to run their businesses and this could create problems in securing use of such websites. The emergence of technology precludes the traditional settings of transactions, and with the boom in cyberspace transactions, there is the need for regulations to protect cyberspace investments.<sup>1083</sup> The relevance for protecting cyberspace is that it may become porous and easy to access by criminals who are interested in making money where they did not labour. Where there is counterfeiting of the innovations of a trader, it creates a fundamental breach to the internet in relation to intellectual property offences. There is the need for cyberspace to be adequately protected, so that anybody advertising its goods or service online will not be hesitant to promote such items. At it is, there is no specific law for the protection of domain names in Nigeria and the law which ought to have been passed through the National Assembly but it has not been enacted.<sup>1084</sup> In addition, the new law must include trademark, service marks and trade dress.

#### **6.2.4. Domestication of International Treaties into Local laws in Nigeria**

In the registration of a trade mark in a Convention country, any person or his legal representative or assignee can apply for protection. This applicant must first of all show that the trade mark has been registered under the NTMA in priority to other applications in the convention country but in order for it to be effective, it must be made within six months. Where the six months has elapsed and infringement were to arise, the applicant might not be able to recover any compensation that would occur before the exact date when the trade mark was registered in Nigeria. That is, a person can register a trade mark in Nigeria in the first instance, before other registrations in other Convention countries. Therefore, the registration in Nigeria would claim priority right over all other registrations in other countries that are members to such trade mark conventions.<sup>1085</sup>

However, a clause limiting the effect of the Paris Convention or TRIPs in the NTMA is the fact that a Presidential Order is needed which would invariably list the convention countries so that the treaty would have effect. This assertion is however yet to be made simply because the country has not domesticated other international treaties such as Madrid Agreement or its

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<sup>1083</sup> Saulawa, M.A. and Marshall, J.B., *ibid*.

<sup>1084</sup> Saulawa, M.A. and Marshall, J.B. 2015 The Legal Framework of Cybersquatting in Nigeria. *International Journal of Humanities Social Sciences and Education (IJHSSE)* Volume 2, Issue 4, pp. 1-8. ISSN 2349-0381. Retrieved September 7, 2016 from [www.arcjournals.org>ijhsse>1.pdf](http://www.arcjournals.org>ijhsse>1.pdf)

<sup>1085</sup> Section 44, NTMA, Cap. T13, Laws of the Federation, 2004

accompanying Protocol.<sup>1086</sup> Therefore, while the provisions in the United Kingdom will encourage international applications and make registration easier, the Nigerian provisions on the other hand, its Convention applications are still undeveloped. The effect this will have on trade and industry will be negative for Nigeria as business entrepreneurs will prefer to establish in countries where priority rights can be enjoyed and thereby take advantage of a wide coverage system like the Madrid system.<sup>1087</sup>

The problem that lies in the NTMA is under Section 12,<sup>1088</sup> which states that until the National Assembly ratifies an international convention, it cannot be enacted in municipal laws. This creates major challenges as the essence of the international conventions are to regulate trade mark laws in member countries. As a result of this, Nigeria has not fulfilled its international obligation since the TRIPs Agreement came into force in 1995.<sup>1089</sup> For instance, under TRIPs, there is the provision to protect service marks which is not included in the Trade Marks Act.<sup>1090</sup> On the other hand, it is a waste of resources for Nigeria, if after promising (by ratifying but not domesticating) such laws, simply because of the clause under Section 12.<sup>1091</sup> If these conventions had been domesticated in the NTMA as it ought to have been done, it would have served as a guide to ensure compliance and would have put trade mark law in Nigeria on a formidable level.

Therefore, because Nigeria has not domesticated the necessary laws nor reviewed its trade mark laws, developed countries might have a problem with such lax protection and would be hesitant to bring into Nigeria, their technological know-how. The essence of the international conventions is to guide international trade on international frontiers in order to put Nigeria's trademark laws on a better footing and also to serve as guidelines in ensuring that the necessary provisions on the current trends of trademarks are included in the NTMA.

In addition, Nigeria is not a member to the Nice Classification of Goods but it adopts such a treaty. With the experiences of the past, such as the non-domestication of the Paris Convention and TRIPs, it seems that Nigeria is bent on injuring itself on its trade mark laws.

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<sup>1086</sup> Olatunji, A.O., op.cit. at p. 92. See Section 44(5) NTMA, *ibid*.

<sup>1087</sup> Olatunji, A.O., *ibid*. at p.93

<sup>1088</sup> Section 12, Constitution of the Federal Republic of Nigeria, 1999 (As Amended)

<sup>1089</sup> Oloko, T.O. 2016. Legal Implication of the Effect of the TRIPs Agreement on the Trademarks Law in Nigeria. *European Scientific Journal*. Vol. 12, No.10, 140-160. Retrieved March 22, 2017 from [ejournal.org/index.php/esj/article/download/7317/7037](http://ejournal.org/index.php/esj/article/download/7317/7037)

<sup>1090</sup> Article 16(1) of the TRIPs Agreement, 1995

<sup>1091</sup> Section 12, Constitution of the Federal Republic of Nigeria, 1999 (As Amended)

Where a country is not a party to such conventions, the countries establishing the treaty would impose more stringent rules on non-members. The question that begs to be answered is why Nigeria, a former world power of Africa, has not been able to get it right in relation to its trade mark laws which is the driving force behind every business. The Draft Bill on Intellectual Property which ought to have been passed has not been given the due recognition since 1988. If the Bill had been passed, it would have been an all-rounder as the lapses in the current NTMA, would have been addressed. Where Nigeria is able to have a water tight law on trade mark, this will be of immense benefit, both at the national and international levels.

#### **6.2.5. Awareness Campaigns**

There should be awareness campaigns so that the general public would be educated on the concept of trademarks. There is the erroneous impression and a problem where it is believed that registration with the National Agency for Food and Drug Administration and Control (NAFDAC) confers trademark like protection on the parties concerned. This is prevalent usually among local importer of drugs and food products in Nigeria.<sup>1092</sup> There is the assumption that with a NAFDAC registration, a product manufacturer has obtained protection of a trademark. However, a NAFDAC registration does not convert to trademark rights under the law.<sup>1093</sup> There is the need to enlighten and educate retailers and importers of drugs that registration with NAFDAC does not confer a trademark in respect of the product registered with NAFDAC. The awareness on trademarks should however not stop at the level of local manufacturers but should also advance to stakeholders such as the Federal Government and other parastatals involved with policy making. Perhaps the reason why the Draft on Intellectual Property was never passed into law was because there is little or no understanding on the concept of trade marks in Nigeria. Its importance however cannot be over-looked but must be critically addressed in the society we live in and must be given prompt attention.

The Office of Trademarks, Patents and Designs is under the power of the Registrar and the Minister of Trade and Commerce. Even though, a trademark can overlap with a patent or a design or even, a copyright, all the other branches are distinct in their characteristics. Nigeria has to decide what works best for her and it would be apt to suggest that trademarks should be autonomous and stand on its own.

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<sup>1092</sup> Onyeaso, N. 2009. Registration with NAFDAC in Nigeria is no substitute for Trademark Registration. Retrieved January 5, 2017 from <http://www.stillwaterlaw.com/reg.php>

<sup>1093</sup> Ibid.

### **6.2.6. Practice Direction for Judges in relation to Trade Marks**

The absence of a trademark registry that has autonomy has not encouraged the type of training the Nigerian Copyright Commission (NCC) for example has been able to avail Federal High Court Judges in the field of copyright. Nevertheless, there should be some form of training for Federal High Court Judges so that appreciation of trade mark in the society can be brought to light. It is obvious from historical perspective that the courts drive intellectual property in the United States for instance and this drive influences their legislations. Cases are decided in Nigeria as if it is still in 1965. For instance, besides the legislations guiding trademark in the United Kingdom and United States, there is a guide to handling trademark cases in those jurisdictions that is updated on a regular basis. Recourse should be made to the Federal High Court (Civil Procedure) Rules 2013 where it is provided that the Chief Judge has the power to issue practice directions, protocols, directives and guidance towards the realization of speedy, just and effective administration of justice.<sup>1094</sup> It would be of great essence therefore for the existence of Practice Direction for Trademarks in Nigeria which will aid in its effective administration. These Practice Direction for Trademarks will come in handy especially where judges are faced with infringements of service marks or trade dress, this will assist them so that their judgement would be fair on both sides.

### **6.3. Conclusion**

Nigeria, though a developing country, has progressed in terms of technological advancement. Trademark is said to be the most commonly known form of intellectual property but it is inadequately protected in Nigeria. There is the need for Nigeria to adopt and review the current trademark law as service marks, trade dress and counterfeit of domain names are not included in the Trade Marks Act in Nigeria.

Nigeria can benefit from the United Kingdom by adopting a new trademark legislation that is up-to-date to suit new trends in the trademark law. Laws regulating internet infringement should also be included in the Act as a result of e-commerce; the criminal aspect of Trademarks which is contained in the Merchandise Act should be updated to realistic punishment which will deter criminals. In addition, the international conventions of which Nigeria is a party, should be ratified. Nigeria therefore, in an extreme measure of urgency has

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<sup>1094</sup> Order 57, Federal High Court (Civil Procedure) Rules 2013

to reform its trademark law as intellectual property continues to play prominent role in global policy and economic development.

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