

TRADEMARK INFRINGEMENT: SUING FOR 'PASSING-OFF' IN NIGERIAN COURTS

INTRODUCTION

In Nigeria, the whole regime of Intellectual Property (IP) and the protection of Intellectual Property Rights (IPRs) is defined and regulated by several statutes and regulations. These include the Copyright Act,¹ the Patents and Designs Act², and the Trade Marks Act,³ among others. These legislative instruments provide for ways of protecting trade marks and other IPRs through the courts by a melange of remedies for any infringement on guaranteed rights. These remedies include different types of injunctions, suit for damages, inspections and delivery, among others.

This edition of **TEMPLARS IP Newsletter** deals with the issue of 'Suing for Passing-Off' in Nigerian Courts. This is an issue that has

generated so much controversy both within the judicial system and the academia in Nigeria.⁴ The major diverging point for most part seems to be whether the Federal High Court could be the proper and exclusive locus to adjudicate issues relating to 'passing-off', especially when the mark to be protected has not been registered under the Trade Marks Act. Several litigants have had odysseys through the court system in Nigeria from the High Courts to the Supreme Court on this issue, and in the process, the tort of 'passing-off' has received some elaborate mention.

1. Putting 'Passing-Off in Context'

In Nigeria, a cause of action in 'passing-off' forms part of the several aspects of the Common Law and the doctrines of Equity

¹ *Cap C 28 Laws of the Federation of Nigeria 2004.*

² *Cap P2 Laws of the Federation of Nigeria 2004.*

³ *Cap T13 Laws of the Federation of Nigeria 2004.*

⁴ See the discussions of Hon. Justice A.O. Faji on 'Passing-Off' Jurisdiction of State v. Federal High Court for Unregistered Trade Mark' (Workshop on the Adjudication of Intellectual Property Rights: Substance and Procedure by International Guidelines) Abuja, Nigeria, January 30 to February 1 2008.

that were received from England into the Colony of Lagos.⁵ This was done under the reception legislation, that is, Ordinance No. 3 of 1863 effective from the 4th of March 1863.⁶ This effectively introduced the British legal system into the Colony and was a lead-up to the establishment of the first Supreme Court for the Colony in 1863 that exercised civil and criminal jurisdiction.⁷

In sum, ‘passing-off’ is a cause of action that is primarily founded in tort⁸ and is historically rooted in common law.⁹ It is a cause of action that has undergone dramatic changes over the years but still potent in protecting the entrenched rights in areas to which it relates.¹⁰ In Nigeria, as elsewhere, the major purpose underlying the tort of ‘passing-off’ is the protection of an established trade goodwill already acquired by a trade mark or trade name. It presupposes therefore, that such goodwill must be established by the party alleging infringement.¹¹ It is doubtful

whether anticipated goodwill could be protected by actions in ‘passing-off’ since that could amount to protecting speculative rights that might not ultimately materialize.

The crucial point to note is that it is not easy to specifically delineate or define what constitutes ‘goodwill’ in general for purposes of suing for ‘passing-off’.¹² The existence or otherwise of a cause of action in ‘passing-off’ and the existence of an established ‘goodwill’ would then have to be decided by the court in each particular case.¹³ In the case of *IRC v. Muller Margarine*¹⁴ the House of Lords, in part, described ‘goodwill’ in relation to ‘passing-off’, as ‘*the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.*’

While the establishment of ‘goodwill’ by the claimant is a key element in succeeding in an action for ‘passing-off’, it is important to note that the existence of that ‘goodwill’ alone, without more, does not in itself fulfil the other ingredients of the tort. In *Reckitt and Coleman Products v. Borden*,¹⁵ the House of Lords adopted the ‘Trinity Test’ in establishing the ingredients of ‘passing-off’, and explained same as follow:

⁵ See A.O. Obilade, *The Nigerian Legal System* (1979) 18.

⁶ Ibid.

⁷ Ibid. The Supreme Court was established under the *Supreme Court Ordinance No. 11 of 1863*.

⁸ Details as to the nature and content of the law of torts are beyond the scope of this newsletter. However, for such discussions, see Margaret Brazier et al (eds) *Clerk and Lindsell on Torts* (15th ed 1981).

⁹ See David Kitchen et al, (eds) *Kerly’s Law of Trade Marks and Trade Names* (14th ed) 2005.

¹⁰ Ibid.

¹¹ Ibid.

¹² Ibid.

¹³ Ibid at 431.

¹⁴ (1901) AC 217, 223 et seq

¹⁵ (1990) 1AER 873.

i. the claimant (that is the person alleging a breach of his right) must establish the goodwill or reputation attaching to the goods or service in question and the identifying 'get up' under which the goods and services are offered to consumers;

ii. the claimant must also establish that there has been a misrepresentation by the defendant which has caused or has the potential of causing the members of the public to believe that goods or service emanate from the Claimant;

iii. finally, the claimant must demonstrate that he has suffered or is *really likely* to suffer losses by the reason of the defendant's misrepresentation as to the source of defendant's goods or services, which seems to suggest that they emanate from the claimant.¹⁶

It is to note that acts of infringement that could ground an action in 'passing-off' might relate to the misuse of trade names, trade marks or the design 'get-up' of the goods or business in question. For instance, in the case of *Niger Chemists Limited v. Nigeria Chemists*¹⁷, the plaintiff sold drugs as Chemists in Onitsha, Eastern Nigeria and the defendant opened shop on the same street and started the same line of business of

dispensing drugs. On being sued, the court granted an injunction against the defendant on the basis that their use of the name Nigeria Chemists was intended to deceive the members of the public to believe that they had a relationship of some sort with Niger Chemists.

In the pre-independence case of *U.K. Tobacco Co. Ltd v. Carreras Ltd*¹⁸ the matter involved potential deception both in the product name and the 'get-up'. In the case, the plaintiff marketed a popular cigarette known as 'Bandmaster' which has a white man in a bandmaster's uniform on its pack. Subsequently, the defendant started to import and market another brand of cigarette known as 'Barrister' which also had a white man in a barrister's uniform on its pack. An action for 'passing off' by the plaintiff succeeded and the defendant was restrained from importing and marketing the Barrister brand. This was especially due to the fact that among the local population (in Lagos, Nigeria) at the time the Bandmaster cigarette was called 'Cigarette Oloyinbo,' in essence, 'the Cigarette that had a white man on it.' It is clear that this could be applied to both brands of cigarettes.

It is imperative to note that in every situation where an infringement has been alleged by a party, all the ingredients of passing-off already

¹⁶ See *Kerly's on Trademarks* above n at 431.

¹⁷ (1961) ANLR 180.

¹⁸ (1931) 16 N.L.R. 1.

identified above are to be construed conjunctively and not otherwise. In essence, for a person to be held liable in an action for passing-off, all the enunciated ingredients of the tort must exist at the same time within the particular circumstance(s) giving rise to the alleged infringement. However, it is also important to note that where the alleged act of infringement is adjudged to be calculated to deceive the members of the public, it is not required of the plaintiff to prove that the act has actually deceived some people.¹⁹ It is enough that under the circumstance(s), there was a possibility that potential consumers would be confused or deceived. In the *Niger Chemists Case*, Palmer J, quoting Lord Cozens Hardy MR in *Ewing v. Buttercup* (1917) 2 Ch 1 held:

'I know of no authority, and I can see no principle, which withholds us from preventing injury to the plaintiff in his business as a trader by a confusion which will lead people to conclude that the defendants are really connected in some way with the plaintiff or are carrying on a branch of the plaintiff's business.'²⁰

His Lordship then concluded:

'That is the danger which can reasonably be foreseen in the present case, namely that people will be misled into thinking that Nigeria Chemists are a branch of, or in some way connected with, Niger

Chemists. It is a confusion which leads to deception.'²¹

In considering whether a 'passing-off' infringement has occurred, the intention or the mental state of the alleged infringer is absolutely immaterial. It is also immaterial whether the false representation as to goods or services was made expressly, impliedly, or by the use of imitation of a mark, trade name or 'get-up' with which the goods of another are associated in the mind of the public.²² Once the element of misrepresentation that has the potential to deceive intending consumers as to the origin of particular goods or services has been established, such a situation is actionable at the instance of the right owner to the goods or services being 'passed off.' In such a situation, it is usually left to the courts to determine whether any particular circumstance(s) falls within the prohibited degree of unauthorized semblance, and therefore capable of deceiving or creating confusion in the minds of potential consumers. For instance, in the case of *Trebor Nigeria Limited v. Associated Industries Limited*²³, an action was held to lie in 'passing-off' where the defendant packaged and marketed its good to resemble those of the plaintiff.

¹⁹ See the Niger Chemist's case above at p. 173.

²⁰ Ibid.

²¹ Ibid.

²² See *Spading v. Gamage* (1915) 84 L.J. 449 cited in *Clerk and Lindsell* above n 6 at 1377fn.

²³ (1972) NNLR 60.

The above discussions are pretty straight-forward. However, when it comes to actual act of instituting actions in Nigerian courts for 'passing off,' there has been the thorny issue of the appropriate court (between State High Courts and the Federal High Court) that has jurisdiction over such matters. This is especially so when the alleged breach and cause of action emanate from an unregistered trade mark(s). The issue has dragged on for years through the full hierarchy of courts despite the fact that lately, the relevant laws appear clear and concise in this respect. The issue is dealt with in detail below.

2. The Issue of Exclusive Jurisdiction in 'Passing-Off' Cases

One issue that has agitated informed discourses on 'passing-off' in recent decades has been whether the Federal High Court or the State High Courts could assume exclusive or concurrent jurisdiction in 'passing-off' cases, and if so, under what circumstances? Ordinarily, this should be a straight forward issue to resolve if recourse is had to the enabling constitutional and other statutory provisions. However, events over the years in Nigerian courts have shown that the issue has proved more knotty than has been contemplated. It is not clear why the case of 'passing-

off' adjudication has generated more controversy than other aspects of breaches that could occur with respect to infringement of trade marks, trade names or allied rights. One suggestion could be the dichotomy that has been created between the breach of a registered and an unregistered trade mark in terms of the remedies for any breach amounting to 'passing-off'. Another suggestion could be because 'passing-off' can be categorized as a 'lazy man's option' in enforcing trade marks-related rights. This is because it is only when a mark has not been registered that the issue of 'passing off' arises as a common law remedy. If such a mark be registered, the issue becomes that of an infringement of a registered mark simpliciter and the cause of action in 'passing-off' then has statutory favour under the Trade Marks Act.

In Nigeria, over the years, the courts have grappled with the issue of the exercise of exclusive or concurrent jurisdiction by the Federal and State High Courts in cases involving 'passing-off,' emanating from the breach of unregistered trade marks. However, this seems to a relatively recent phenomenon but has taken-up reasonable man hours from the courts ranging from the High Courts to the Supreme Court. This is largely attributable to the establishment of the Federal High

Court (as the then Federal Revenue Court) in 1973.²⁴ The problem of exclusive jurisdiction or otherwise was not a problem with earlier trade mark legislation, since there were no alternate High Courts at the time. For instance, under the *Trade Marks Ordinance* of 1914 any judicial determination relating to the registration or infringement of trade marks was to be determined by the 'High Court having jurisdiction in the part of the Federation in which the office of the Registrar is situate.'²⁵ This is a straight-forward provision that presented no problems for potential litigators or the court system at the time. As noted above, this was the situation until the creation of the Federal High Court.

i. State v. Federal High Court (Jurisdiction)

The extant trade mark legislation in Nigeria is the *Trade Mark Act* of 1965, (revised into the Laws of Federation of Nigeria 2004). This is virtually a verbatim adaptation of the English *Trade Marks Act* of 1938. Under the Nigerian legislation, the functions of the courts are pivotal in resolving trade mark issues and section 67 of the Act defines 'court' as the Federal High Court. In simple terms, this would seem to suggest that under the Act any case

that has to go to court must be adjudicated at the Federal High Court and no where else. But in practical terms and having regard to the provisions of the Nigerian Constitution, The issue is more complicated.

ii. The Constitutional Provisions

It is incontrovertible that within Nigeria, the Constitution is supreme and its provisions bind all persons and authorities throughout the country.²⁶ Furthermore, any law that is inconsistent with the provisions of the Constitution shall be void to the extent of such inconsistency and the provisions of the Constitution will prevail in such circumstances.²⁷ The implication of the above statements is that the provisions of the *Trade Marks Act* cannot be seen in any way to contradict any constitutional provisions on the same subject, in this instance, on the issue of 'passing-off.'

iii. The 1979 Constitution

a. Federal High Court

Sections 228 to 233 of the 1979 Constitution established the Federal High Court and stipulate its powers and composition. Under section 230 of the Constitution, the

²⁴ See the *Federal High Court Act Cap F12 LFN 2004*.

²⁵ See section 2 of the *Trade Marks Ordinance 1914 Cap 199 Laws of the Federation 1958*.

²⁶ See section 1 of the *Constitution of the Federal Republic of Nigeria 1999*.

²⁷ *Ibid*.

Federal High Court, *subject to the Constitution* and 'in addition to such other jurisdiction as may be conferred upon it by an Act of the National Assembly, has jurisdiction to deal with matters:

- (i) connected with or pertaining to the revenue of the Government of the Federation as may be prescribed by the National Assembly; and
- (ii) in such other matters as may be prescribed as respects which the National Assembly has power to make law.

It is also provided under section 231(1) of the Constitution that the Federal High Court in exercising its original jurisdiction or any other jurisdiction that may be conferred by an Act of the National Assembly shall have all the powers of a State High Court. Furthermore, under section 231(2) of the Constitution, the National Assembly may confer additional powers on the Federal High Court to enable the Court to more effectively exercise its jurisdiction.

The above summarizes the cardinal points on the Federal High Court under the 1979 Constitution.

b. State High Courts

Sections 234 to 239 of the 1979 Constitution established the State

High Courts and stipulate their jurisdiction, composition and powers. Section 236 of the Constitution stipulated what was referred to as 'general jurisdiction', while section 237 stipulated 'jurisdiction as to certain proceedings.' Under the general jurisdiction a State High Court has:

'unlimited jurisdiction to hear and determine any civil proceedings in which the existence of or extent or a legal right, power, duty, liability, privilege, interest, obligation or claim is in issue or to hear and determine any criminal proceedings involving or relating to a penalty, forfeiture, punishment or other liability in respect of an offence committed by a person.'

The provisions of section 237 of the Constitution relating to courts' the 'jurisdiction as to certain proceedings' dealt with the competent courts to handle election petitions under the 1979 Constitution and therefore is of no further relevance to this piece.

The above were the relevant provisions of the 1979 Constitution with respect to the jurisdiction of the High Courts. These provisions will be used for analysis further below.

iv. The 1999 Constitution

a. The Federal High Court

Sections 249 to 254 of the 1999 Constitution establish the Federal High Court and made provisions for its composition and jurisdiction. Specifically, section 251 of the Constitution provides for the jurisdiction of the Court. As against the provisions under the 1979 Constitution, section 251(a) to (r) of the 1999 Constitution itemized the items over which the Court has jurisdiction ranging from the revenue of the Federal Government to companies' taxation, customs, excise and export duties, banks, banking and financial institutions, Companies and Allied Matters Act, admiralty jurisdiction, shipping, diplomatic and consular matters, citizenship, arms, drugs and position among several others. Under section 252 of the Constitution, the Federal High Court in exercising its jurisdiction is to have all the powers of State High Court.

For the present discourse, however, the relevant provision of the Constitution is section 251(1)(f) which give the Federal High Court exclusive jurisdiction over 'any Federal enactment relating to copyrights, patents, designs, trade marks and passing off, industrial designs and merchandise marks...' This appears to be a very clear and

precise provision, but as will be seen below, a combination of factors has left Nigerian courts battling to make definitive statements on the import of this and similar statutory provisions.

b. State High Courts

Sections 270 to 274 of the 1999 Constitution establish a High Court for each state of the Federation and provides for the composition and jurisdiction of such courts. Specifically, section 272(1) of the Constitution provides, among other things, that '*subject to the provisions of section 251 and other provisions of the Constitution*, the High Court of a State shall have jurisdiction to hear and determine any civil proceedings...' This in effect replicates *in extenso*, the provisions of the 1979 Constitution on the State High Courts. The only exception is that under the present Constitution, the jurisdiction of the State High Court is subjected to section 251, which establishes the Federal High Court.

3. Analysis of the Issues Involved

In analyzing the issues involved in this piece, it is intended that the discussions are to be divided into two parts. The first part will discuss the issues based on the 1979 Constitution of Nigeria, while the second part of the discussions will be based on the provisions of the 1999 Constitution. This approach will enhance clarity and better understanding of the issues involved.

i. Jurisdiction over ‘Passing-off’ under the 1979 Constitution

It was noted above that section 236 of the 1979 Constitution gave State High Courts powers, subject to the Constitution and all other jurisdiction as may be conferred by law, to exercise unlimited jurisdiction to hear civil and criminal matters. It is conceivable that this provision covers every subject matter that could be placed before the High Court.

In another respect, section 230 of the Constitution conferred on the Federal High Court, subject to the provisions of the Constitution, jurisdiction to principally deal with matters connected with the revenue of the Government of the Federation. Essentially, under the 1979 Constitution, the issue of ‘passing off’ and jurisdiction over matters relating thereto were not specifically mentioned as a subject matter for either of the High Courts.

However, from the above provisions on jurisdiction, it would appear that the powers of the Federal and State High Courts were distinctly delineated under the 1979 Constitution in terms of subject-matter jurisdiction. In the case of *Savannah Bank of Nigeria Limited v. Pan Atlantic Shipping and Transport*

Agencies Limited,²⁸ one of the issues before the court was whether the State High Courts have jurisdiction to entertain admiralty related matters (hitherto reserved for the Federal High Court after the commencement of the 1979 Constitution). In its judgment, the Supreme Court held that sector 230 of the 1979 Constitution which conferred ‘*unlimited jurisdiction*’ on State High Courts had, by implication, obscured the exclusive jurisdiction conferred on Federal High Court in certain matters by the Federal High Court Act in matters that included admiralty and federal revenue. In this case therefore, the Federal and State High Courts would have concurrent jurisdiction in those matters that were ordinarily exclusively reserved for the Federal High Court.

The above decision marked a deviation from and did set aside the earlier decision of the same Court in 1981 in *AIICO v. Ceekay Traders Ltd*²⁹ which held that the Federal High Court had exclusive jurisdiction in relation to other courts in matters connected to admiralty jurisdiction.³⁰ It should be noted that in the above cases, the issue of ‘passing off’ was not directly before the court, as the matters related generally to the

²⁸ (1987) 1 NWLR Pt 49, 212.

²⁹ (1981) 5 S.C. 81.

³⁰ See also *Bronik Motors Ltd and Anor v. Wema Bank Ltd* (1983) 6 SC 158.

ambit of jurisdiction of the different High courts. In the final analysis, it would appear that the final word on the issue was that under the 1979 Constitution, the Federal and State High Courts had concurrent jurisdiction on matters that were purportedly reserved for the Federal High Courts. This was due to the 'unlimited jurisdiction' conferred on State High Courts under section 230 of the Constitution. This implies that in all matters, including those relating to all aspects of intellectual property protection, such as 'passing off' and applications for injunctive reliefs, State High Courts were empowered to exercise jurisdiction.

ii. Jurisdiction over 'Passing-off' under the 1999 Constitution

The 1999 Constitution of Nigeria made slight but far-reaching changes to the jurisdiction of the Federal High Court and State High Courts. For the Federal High Court, section 251 of the Constitution provides that the Court shall, 'notwithstanding anything contrary contained in this Constitution...' 'have and exercise jurisdiction *to the exclusion of any other court*'³¹ in matters that relates to, among several other things, the revenue of the Government of the Federation, taxation of companies and other bodies subject to Federal taxation, customs and excise duties and

³¹ Emphasis added.

export duties, banks, banking and other financial institutions, **federal enactment relating to patent, designs, trade marks, passing-off**,³² admiralty jurisdiction, arms and ammunition, aviation and air craft safety etc. It is to note that this is the first time that any Constitutional provision in Nigeria has made specific mention of 'passing-off' as a possible cause of action for any of the courts to adjudicate.

The above provisions are complemented by the *Federal High Court Act*. Section 7 of the Act which deals with jurisdiction of the Court provides in subsection 1(f) that the Court shall have exclusive jurisdiction to try, among other things, civil causes and matters relating to 'any federal enactment relating to copyright, patent, designs, trade marks and passing-off...' This is a replication of the provisions of section 251 (1)(f) of the 1999 Constitution of Nigeria that deals with the jurisdiction of the Federal High Court.

To better complete the picture and understand the issues above in relation to 'passing-off', it is necessary to bring in the *Trade Marks Act* 2004. This is the current national legislation that regulates matters relating to the registration and protection of trade marks and allied matters Nigeria. Section 3 of the Act provides that:

³² Emphasis added.

'No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark; *but nothing in this Act shall be taken to affect the rights of action against any person for passing off goods as goods of another person or the remedies in respect thereof.*' (emphasis added).

The objective of the first part of the above provision is quite clear, that is, in preventing any person from instituting an action that a trade mark that has not been registered has been infringed. This is apparently meant to encourage the formal registration of trade marks by their proprietors. This notwithstanding, the second part of the provision suggests that non-registration of any mark does not necessarily imply free access thereto by all and sundry to such marks, but such qualification only applies in cases where 'passing-off' has been alleged. This dichotomy between a breach of registered trade mark simpliciter and the tort of 'passing-off' an unregistered mark was also a feature of the *Trade Mark Ordinance 1958* in Nigeria. However, unlike under the 1958 Ordinance, the subsequent creation of the Federal High Court (formerly Federal Revenue Court) seems to have confused issues in terms of the court(s) to exercise jurisdiction over 'passing-off' claims. However, it is submitted that this

confusion appears unnecessary after 1999, due to the fact that the 1999 Constitution is clear on the powers of the respective High Courts in relation to trade marks related issues. This notwithstanding, there have been series of cases through the Nigerian court system on the very issue of the requisite judicial jurisdiction to adjudicate cases of 'passing-off.' Some of these judicial developments are discussed below.

4. The Issues through Case Law

The case of *Patkun Industries Ltd v. Niger Shoes Ltd*³³ was a pre-1999 decision, but is very relevant to the issues surrounding judicial adjudication of 'passing-off' claims. In this case, on appeal to the Supreme Court, the material facts turned on the interpretation of the proviso to section 3 of the *Trade Marks Act 1965*, which is *in pari materia* to section 3 of the *Trade Marks Act LFN 2004* cited above. The issue was whether that proviso preserved the common law right of action in 'passing-off' as a common law remedy or had converted the remedy to a statutory one under the Act.

In deciding the question, the Supreme Court held, among other things, that:

- Where a statutory provision is in conflict or differ from

³³ (1998) 5 NWLR Pt 93, 138.

common law, the common law gives place to the statute;

- A statutory right may be conferred in addition to and not in derogation of a common law right;
- Section 3 of the *Trade Marks Act, 1965 proprio vigore* thus gives a right of action in 'passing-off'. The right of action is therefore derived from the *Trade Marks Act, 1965* and not from the common law.

It is doubtful whether the last holding above should represent the correct position of the law, even if it was a Supreme Court decision and remains the law until set-aside by the Court itself. This notwithstanding, it is argued here that the common law right of 'passing-off' cannot be regarded as being a statutory right because what the *Trade Marks Act* did had been to affirm the existence of that common law right as it were for unregistered trade marks and not to make it a statutory remedy. Essentially, the Act is saying that even if a person cannot sue for an infringement of an unregistered trade marks, the same person is allowed to sue for 'passing-off', which cannot be affected by the fact of non-registration, it being a common law right.

It has been the misapprehension of the above distinction that has left

several litigants traversing the courts to argue same over the years.

In *Ayman Enterprises Limited v. Akuma Industries Limited*,³⁴ the issue involved the alleged infringement, through 'passing-off', of an unregistered trade mark. At the Supreme Court, the pivotal issue turned on 'whether the Federal High Court should have assumed jurisdiction to adjudicate on a case of damages for 'passing-off of an unregistered trade mark?' In reaching its decision, the Supreme Court held that in other for the Federal High Court to assume jurisdiction over 'passing-off' related infringements, the concerned trade mark(s) must have been registered. In essence, that where the trade mark(s) in issue was not registered, that, *ipso facto*, denies the Federal High Court of jurisdiction. This is a reaffirmation of the decision in Patkun's case noted above.

With respect, the above decision of the Supreme Court is not a correct reading of the relevant statute. Section 3 of the *Trade Marks Act* created a right of action in 'passing-off' for registered trade marks as well as a right to sue for their infringements that do not amount to 'passing-off'. However, the section also preserves the common law right of action in 'passing-off' for trade marks that have not been

³⁴ (2003) 12 NWLR Pt 836, 22.

registered, since unlike the former, they cannot be protected by an action for their infringement simpliciter. It is submitted that this explanation should be the correct position and interpretation of the relevant section of the law.

The Supreme Court finally had the opportunity in the case of *Omnia Nigeria Limited v. Dyke Trade Limited*³⁵ to re-examine the provisions of section 3 of the *Trade Marks Act*. In the operative part of the decision, the Court held, without expressly overruling *Ayman v. Akuma*, that Federal High Court has the jurisdiction to hear and determine cases of 'passing-off', and this, whether arising from registered or unregistered trade marks. It is submitted that this is the correct position of the law as it presently stands in Nigeria.

Conclusion

The decision of the Supreme Court in *Omnia v Dyktrade* is not surprising. What is surprising has been the amount of time and energy already dissipated through the courts to arrive at such a decision, especially after the coming into effect of the 1999 Constitution. The 1999 Constitution effectively ended the dispute as to whether it was the Federal High Court or State High Courts that

have the jurisdiction in trade marks-related or 'passing off' issues. Section 251(1)(f) of the Constitution stipulates expressly that the Federal High Court shall have jurisdiction, *to the exclusion of any other court*, in civil causes and matters relating to 'any federal matters relating to copyright, patent, designs, trade marks and passing off..' Additionally, in conferring jurisdiction on State High Courts, section 272 of the Constitution makes it clear that the jurisdiction of State High Court is *subject to the provisions of section 251...*' That is the section establishing the Federal High Court.

In concluding, the *Trade Marks Act 2004* is a federal enactment that relates to the matters referred to above and therefore falls within the purview of section 251 (1)(f) of the Constitution. This presupposes that matters relating to intellectual property protection generally, trade marks, and specifically to 'passing-off' are exclusively reserved for the Federal High Court. The fact as to whether the cause of action in 'passing-off' arose from a registered or unregistered trade mark, as has been shown above, is, and should be immaterial to conferring jurisdiction.

In the final analysis, it has been established beyond doubt in Nigeria that (i) the Federal High Court has exclusive jurisdiction in

³⁵ (2007) 15 NWLR Pt 1058, 576.

dealing with cases pertaining to the protection or breach of intellectual property rights (IPRs) under the relevant legislation, including trade marks, patents, copyright, designs, etc, and in cases of 'passing-off' arising from any of them; (ii) the Federal High Court also have jurisdiction in cases of 'passing-off' irrespective of whether same arose from registered or unregistered trade marks.
