



AN ANALYSIS OF STATUTORY PROVISIONS AND CASE LAW FOR TRADE MARKS REGISTRATION UNDER THE NIGERIA TRADE MARKS ACT

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ABSTRACT

The legal implication of trade mark registration is to have exclusive right to use the mark, and if need be, assign the mark to another person for use. The objective of registration of trade mark is to promote association between the mark and the users by the members of the public. The aim of this paper is to analyze the statutory provisions and case law for trade mark registration in Nigeria. In doing this, the article highlights the relevant organ(s) in charge of the administration of trade mark and the advantages of trade mark registration. To understand these advantages, the article itemizes the benefits attached to the registered proprietor on the one hand and the consumers on the other hand. For the purpose of exposition of the intricacies involved in trade mark registration, this study relies heavily on case law on trademark disputes, which illustrates the points being addressed. In conclusion, the paper lists the shortcoming of the extant law on trademark registration in Nigeria; this is followed with suggestions to help the relevant authorities take steps for the review of trade mark law in Nigeria.

Key Words: Statutory, Case Law, Trademark, Registration, Nigeria

INTRODUCTION

Trade mark is a branch of Intellectual Property. The term “Intellectual Property” as the name indicates is property emanating from the human intellect, mind or through human ingenuity and invention. Intellectual property therefore represents the human ideas and innovation which has been translated into information or technical know-how that are of a commercial, scientific and proprietary value. The law recognizes these values and attaches some rights to the owners of such property. Intellectual property generally comprises of copyright, patents, industrial designs, trade marks, know-how, trade secret, service marks and internet generated domain name.¹

Intellectual property right covers several fields of human endeavours; these fields have been adopted and recognized by the World Intellectual Property Organization (WIPO).² However, the nature of intellectual creations determined its categorization.

Due to the economic value of intellectual property, the law confers some rights to the owner of trade mark against unauthorized use by other people. For instance, there is a corresponding legal sanction against such unauthorized use. The aim of this paper is to analyse the statutory provisions in place in Nigeria for trademarks registration, the procedures for registration and the rights and privileges attached to proprietor of registered trade mark. For the purpose of legal exposition, copious references are made to other jurisdictions that have similar laws with Nigeria in the area of trade marks regime. The paper examines the legal effects of trademark registration; judicial authorities are copiously cited to bring into fore trade mark disputes resolution by courts. In conclusion, this paper highlights the inadequacies of the extant law on trade marks registration in Nigeria.

MEANING OF TRADE MARKS

Trade marks is defined under the Trade Marks³ as:

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¹ Ayo Oriola, “Anton Pillar Order as a Remedy for Copyright Infringement: A Marital Law in Disguise” July 1999, Vol. 3, No. 3, *Modern Practice Journal of Finance and Investment*, p. 507; David I. Bainbridge, *Intellectual Property* (4th edn, Financial Times Pitman Publishing, England, 1999) p. 3

² WIPO is an important organ of United Nation Organisation overseeing Intellectual Property matter, the Organisation came into being on April 17, 1996, WD/INF/127.

³ See section 67 of the Trade Marks Act, Cap T 13, Laws of Federation of Nigeria, 2004.

“Except in relation to a Certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that persons, and means, in relation to a Certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act”

The Trade Marks Act⁴ similarly describes ‘mark’ to include ‘a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof’. Trade mark could then be described as the sign which distinguishes particular goods or services of one undertaking from the goods or services of other undertakings. A trade mark is invariably a badge or sign, which indicates the source or origin of the goods or services in respect of which it is used. The primary function of trade marks is to indicate origin, however, mark also performs other functions and these include ‘quality assurance’. To explain a little further; the quality function of a trade mark is that the trade mark offers a guarantee to the consumer that the goods or services is of the same quality as the one the consumer has become accustomed to. Trade mark also performs “investment and advertising” functions. In this connection, it relates to the “cachet” or “aura” which the consumer associates with the mark usually as a result of the way the proprietor has used and promoted the mark and its goods or services.⁵

Furthermore, there is ‘descriptive functions’, for examples, some of the most powerful trade marks are those which indicate origin and also contain an allusion to some characteristic of the goods or services. The economic function of trade mark in the modern economy is dictated by the sheer size of the market. This has become indispensable in a market dominated by mass production and the proliferation of comparable or competing products. Thus, in an economy, where most goods and services come from competing enterprises, trade mark owners typically use their marks to distinguish their products and services from other on offer. Their hope is that this will trigger off an association in consumers’ minds between origin and good value.⁶

In the United Kingdom, the Trade Mark (Amendment) Act⁷ recognises ‘service marks’. This was also reflected in the 1994 Act.⁸ The provisions in these Acts are *impari materia* with Article 4 of the European Community Trade Marks Regulation. It should be noted that apart from recognizing services marks, the United Kingdom Act also permit shapes of goods to be registrable. All these are not so in Nigeria under the present statutory dispensation.⁹ The law which presently governs the trade mark administration and procedure in Nigeria is the Trade Marks Act of 1988 as amended.¹⁰

RATIONALE FOR TRADE MARKS REGISTRATION

The foundation upon which the law relating to trade marks registration evolved is to prevent the deception of the public by offering goods as possessing some connection with a particular trade, which in fact it does not. It is therefore a fundamental principle of law that an Applicant, who wants to register his trade mark must show that it is clearly distinguishable from other marks in the market. The rationale for this is to avoid public deception and to avoid the mark from being mistakenly taken as the marks of rival traders.¹¹ Premised on the foregoing, one essential criteria qualifying a trade marks registration is that it should be ‘distinctive’.¹²

The proper test to determine when a mark has become *public juris* is whether its use has ceased to deceive the public as to the maker of the article. Another factor qualifying a trade mark for registration is that, it must be ‘original’. The ‘origin theory’ is aptly captured in the definition given to marks in section 67 (1) of the Nigeria

⁴ *Ibid.*

⁵ See David Kitchin et al. *Kerly’s Law of Trade Marks and Trade Name*, (14th edn, Sweet & Maxwell, London, 2005) p. 10.

⁶ W. R. Cornish, *Intellectual Property*, (3rd edn. Sweet and Maxwell, London 1996) p. 515; See also S A. Fagbemi, “Intellectual Property: The Legal Remedies for Infringement of Trade Mark and Common Law Tort of Passing Off”. (2009) Vol. 4, Nos. 1 & 2, *International Journal of Law and Contemporary Studies* pp. 31-54

⁷ 1914

⁸ See Section 1 of the United Kingdom Trade Marks Act, 1994.

⁹ See the case of *Coca-Cola Trade Mark*. (1986) *RPC 421 (HL)*. Where the English court refused to register shape of goods as trademark

¹⁰ The Trade Marks Act, 1988 has been incorporated into the Laws of the Federation of Nigeria 2004 as Chapter T13.

¹¹ Mena Ajakpovi, “Intellectual Property Rights in an Electronic Environment: Nigerian Perspective” July/October, 2005, Vol. 9, Nos. 2-3-4, *Modern Practice Journal of Finance and Investment Law*, p. 641.

¹² See the case of *Singer Manufacturing Co., Ltd. v. Loog [1880] 18 Ch. D. 395 at 412.*

Trade Marks Act. However, the theory admits exceptions under the English Law. For instance, where the goods in question, emanates from several legitimate producers, who are producing goods with different tastes, composition or qualities for sale under the mark in different territories, the theory will not apply. This is called under the English law an “exhaustion theory”. Exhaustion theory is the parallel sale of differing goods under one mark.¹³

TRADE MARKS REGISTRATION

It is not compulsory to register a trade mark before it is used. The common law, offers some forms of protection to a proprietor of an unregistered trade marks. Hence, where the marks or services have conferred on the owner considerable goodwill or reputation, the owner can enforce his right under the common law tort of passing off.¹⁴ See the case of *Ferodo Ltd. v. Ibeto Ind. Ltd.*¹⁵ In that case, the Supreme Court held as follows:

“A trade mark, if registered, gives its proprietor the exclusive right to use the trade mark in marketing or selling his goods. And without his consent, if anyone else uses an identical mark; or any mark so nearly resembling it as to likely deceive or cause confusion between his own goods and the proprietor’s goods, will entitle the proprietor to sue for infringement of the trademark, or to sue in action for passing- off or both”

However, before a trade mark enjoys legal protection under the Trade Marks Act, it must be registered. It is the registration of trade mark that confers on the owner/proprietor an exclusive right to use the mark and he can sue for its infringement by unauthorized user. However, the mark must actually be registered at the date of commencement of the action as it is not enough that registration has been applied for but not yet granted. Thus, where a defendant proves that he had been using his mark continuously for some period before the registration of the trade mark by the proprietor, his right to use the mark may override that of later registered proprietor. This was the position of the Nigeria Supreme Court in the case of *American Cynamid Co. v. Vitality Pharmacy Ltd.*¹⁶ in that case, Honourable Justice Karibi-Whyte JSC (as he then was) while explaining the purport of section 7 of the Trade Marks Act said as follows:

“The words of the above provision seem to me clear and unambiguous. The section protects trademarks, which are identical with, or nearly resembling that of a proprietor, or a registered user of a registered trade mark, where such trade mark has been in continuous use by another or his predecessor-in-title, previous to the date of the registration of the new trade mark. The protection covers both prior use of the trade mark or the registration of the trade mark in the name of the proprietor or predecessor-in-title”.

It is important to note that there is a different between registration of trade mark and use of trade mark. The different between the two relates to the burden and standard of proof in the event of action for infringement. For instance, while anybody may bring an application to oppose registration of trade mark, the use of trade mark does not depend on the validity of its registration but on the evidence of continuous and extensive use of the mark. Again, the effect of registration of trade mark is to give it statutory protection, meanwhile, the right of the User of unregistered trade mark lies only under the common law tort of passing-off.

Premised on the above, it is submitted that one may be a user of trade mark and not the proprietor of the same trade mark. It is equally clear that common law confers vary rights on the proprietor or user of unregistered trade mark. However, the advantages to be derived from registration of trade mark far outweigh that of unregistered users. Some of these advantages include the following among others:

(a). Prevention of infringement of a trade mark is easier, less time consuming and less costly in cases where a trade mark is registered;¹⁷

¹³ See the case of *Champagne Heldsieul et Gemopolo S.A v. Buxton* (1930) 1 Ch. 33

¹⁴ See section 3 of the Trade Marks Act, Cap T 13, LFN. 2004, which expressly forbid institution of action for the infringement of an unregistered trade marks. See generally S A. Fagbemi “A Critical Examination of Legal Remedies for the Tort of Passing Off and Unfair Competition under Nigeria Law”. (2011) Vol. 6, *University of Ibadan Journal of Private and Business Law*, pp. 68-95

¹⁵ (2004) NWLR (Pt. 866) 317 at 347 Paras. D-G. See also *Patkun Industry Ltd. v. Niger Shoes Manufacturing Co. Ltd* (1988) NWLR) 138

¹⁶ 34 NIPJD [1991] SC/ (1991) 2 SCNJ 42. See section 7 of the Trade Marks Act.

¹⁷ *American Cynamid Coy.v. Vitality Pharmaceutical Ltd* (supra).

- (b). In the event of infringement, damages may be claimed from the infringer. In the case of *CPL Industries Limited v. Morrison Industries Plc.*¹⁸ it was held that *mere proof of infringement entitles the plaintiff to damages.* ;
- (c). Acquisition of right through registration is generally much quicker than building up the required common law repute, and goodwill, through use;
- (d). Registration allows for the effective appointment and control of licenses and franchises;
- (e). Registered trade marks are relatively easy to assign to third parties;¹⁹
- (f). Registered trade marks can serve as security for loan in that they may be bonded; and
- (g). Trade marks registration can be of assistance in having the mark registered in another countries.²⁰

PROCEDURES FOR REGISTRATION OF TRADE MARKS

For the purpose of registration of trade mark in Nigeria, a Registrar of Trade Mark is appointed with an office in the Federal Capital Territory, Abuja.²¹ The Registrar of trade mark generally acts under the direction of the Honourable Minister of Trade and Tourism. The Registrar also has an official seal, which are officially and judicially noticed.²²

The duties of a Registrar of trade mark among others include maintenance of trade mark register and to examine application for the registration of trade mark.²³ By virtue of section 19 (1) of the Act, when an application for registration of a trade mark has been accepted by the Registrar, he shall publish the notice in the Trade Mark Journal. Anybody who wishes to oppose the application shall within two months from the date of the publication do so. Where there is no opposition to the application, or where the opposition had been resolved in favour of the Applicant, the Registrar shall register the mark and issue to the Applicant a certificate of registration thereof. Such certificate is *prima facie* evidence of registration and afforded the proprietor all the rights and privileges under the Act. These rights and privileges cannot be realized on just presentation of application for registration.

To enable Registrar of trade mark to administer trade mark registration, the register of trade mark is divided into two parts namely: Part A and B. The register is opened to the public for inspection. In the performance of his duties, the Registrar has a wide discretionary power to determine which part of the trade mark's register should a mark be registered, he also has to determine any question arising therefrom.²⁴ For instance, the likelihood of the deception of two seemingly similar trade marks. The Registrar's judgment in these issues can hardly be questioned once they are exercised in the best interest of smooth administration of trade mark regime.

In order to determine the appropriate part in which a trade mark is to be registered, the following issues must be considered.

REGISTRABLE MARKS

Under the Nigeria Trade Mark Act, any 'mark' can be registered as a trade mark either under part A or B of the trade mark register. In the case of registration under part A of the register, the mark must contain or consist of at least one of the following essential particulars:

- (i). The name of a company, individual or firm represented in a special or particular manner;
- (ii). The Signature of the applicant or some predecessor in his business;
- (iii). An invented word or words;
- (iv). A word or words having no direct reference to the character or quality of the goods, and not being, according to its ordinary signification, a geographical name or a surname;

See the case of *Ligget and Myers Tobacco Coy. v. Registrar of Trade marks*,²⁵ in that case, the bone of contention is whether the trade mark "CHESTERFIELD" is not a geographical name in its ordinary signification? The court in granting the application held thus:

"The phrase 'geographical name' in the absence of special circumstances must be interpreted in accordance, in some degree, with the general and popular meaning of the

¹⁸ Unreported Case Suit No FHC (2006-12-20).

¹⁹ Section 35 of the Act.

²⁰ Bowman Gilfillan Inc Trade Marks- Frequently asked Questions, 1999.

²¹ Section 1 of the Act.

²² Section 1 (2) and (4) of the Act. See also section 122 of Evidence Act, 2011

²³ Section 2 of the Act.

²⁴ Section 4 of the Act.

²⁵ (1969) ALL NLR 540.

words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it."²⁶

(v). Any other distinctive mark.²⁷

Conversely, for a trade mark to be registrable in part B of the register, it must have distinguishing feature in relation to the goods in which it is proposed to be registered *vis-à-vis* any subsisting mark.

NON-REGISTRABLE TRADE MARK

The inclusion of identification features in the very definition of a trade mark is significant to its historic basis that the law's purpose is to protect marks as, in a broad sense, indicators of origin. In Britain and under the Trade Mark Act of 1938, which is *impairi material* with the Nigeria Trade Marks Act, there was certain niggardness over what could be a trade mark in relation, for instance, to slogans, get-up and colouration.²⁸

In *Coca-cola Trade Marks Application*,²⁹ the House of Lord refused to treat the shape of the "Coca-cola" bottle as a trade mark for non-alcoholic beverages in Class 32. However, great liberation is now to be expected, but still subject to the governing consideration of distinctiveness. Thus, *In Smith Kline v. French Trade Mark's Application*,³⁰ the House of Lords allowed the registration of a colour combination added to a drug capsule as trade identification.

In view of the foregoing, a mark proposed to be registered must satisfy the consideration of distinctiveness.³¹ For instance, the following trademarks are not registrable under the Nigeria Trade Marks Act.

i. Deceptive or Scandalous Marks

Where the use of the mark is likely to deceive or cause confusion or otherwise not likely to be protected in the Court of justice, as in where it is scandalous, such mark(s) would be refused registration. In determining whether a mark is 'likely to deceive' or 'scandalous in nature', the Nigerian Courts have always taken into account the intelligence and education of the consumers. Accordingly, Butler L.J in the case of *United Kingdom Tobacco Co., v. Carreras Ltd*,³² observed as follows:

"It is a well established principle, not only in this country, that the likelihood of deception varies with the intelligence and education of the consumer and that a trade marks or get-up which might not confused a literate or educated person could quite easily confuse an illiterate or uneducated one, in the instant case, it was significant that the plaintiff's 'Band Master Cigarettes were popular amongst all classes in Nigeria, and were known among the illiterate class simply as "Oloyinbo". There was therefore a strong likelihood that illiterate or uneducated persons might confuse, the defendant's "Barrister" Cigarettes, which also carried a picture of a white man, albeit in a different garb with the plaintiff's products"

A scandalous trade mark according to Regan Smith is one which "its use would be shocking to the sense of propriety, would give offense to the conscience or moral feelings, or would call out condemnation".³³ The test whether a trade mark is scandalous involves a two-part examinations. One, it is determined in the context of the market place and two, whether it relates only to the goods described in [the] application for registration. In other words, the basic rule as to whether a mark is scandalous is to weigh the public reaction to the mark. The onus is

²⁶ Article 22 of TRIPS Agreement defines geographical indications as 'indications which identify a good as originating in the territory of a member, or a region or locality in that territory. Where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin'.

²⁷ Section 9 (1) Of the Act.

²⁸ Cornish W.R. *op cit*, p 582.

²⁹ [1986] ARC 421

³⁰ [1976] ARC 511.

³¹ See the case of *Boots Company Limited v. United Niger Imports (Chemicals and Industry) Ltd (supra)*; *Ferodo Ltd. v. Ibeto Industries Ltd. (supra)*; Professor Michael Blakeney, *Trade Related Aspect of Intellectual Property Rights: A Concise Guide to the TRIPS Agreement*, (London: Sweet & Maxwell, 1996) p. 53. See also Article 15.1 of the TRIPS Agreement, Article 6, Section B. 2 of the Paris Convention

³² [1936] 16 NLR 1. See Kodilinye Gilbert, *Nigerian Law of Torts* (Ibadan: Spectrum Law Publishing, 1992) p. 221; Ese Malemi, *Law of Tort* (Ikeja: Princeton Publishing Company) p. 493-494

³³ Regan Smith, "Trade Marks Law and Free Speech Protection for Scandalous and Disparaging Marks." (Summer 2007) Vol. 42, No 2. *Harvard Civil Rights-Civil Liberties Law Review*, p. 459

therefore on the Applicant to show that the mark has deceived, or is capable of misleading the public as to the source/origin of the goods offer for sale.

Over the years, some marks which have been held to be similar as to confuse the Nigerian public are:

- (i). The word “Censrina” and “Castoria”,³⁴ “Peacock and peak” and “Three Castles and Old Castle”
- (ii). Two marks where the prominent features in each was the “land”, although there were other difference.³⁵

ii. Name of Chemical Substances

Section 12 (1) of the Act, provide as follows:

“...no word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation; and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 14 of this Act, be treated for the purposes of section 38 of this Act as being an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the case may requires”.

The provision of section 12 (1) of the Act is therefore qualified by sections 14 and 38 of the Act. For instance, section 14 deals with conclusive validity of trade mark after seven years of its registration unless the registration is obtained by fraud. Section 38 on the other hand, confers on any person who alleges that there had been wrong entry of trade marks in the register, to apply either to the court or to the Registrar of the trade mark for the rectification or expunging of the marks from the register.

iii. Identical and Resembling Trade Marks

Section 13 of the Act forbids the registration as trade mark identical or resembling marks belonging to different proprietors and already in the register in respect of the same goods or description of goods. Note however that section 13 (1) of the Trade Mark is applicable where the mark sought to be registered is identical with existing registered trade mark and not where application to register both marks are pending. For instance, where there are competing applications for the registration of marks, the first in time takes precedents.

It should be noted that ‘mere contemplation to use mark as oppose to an intention to use a mark is not sufficient for application to register. The proviso to the stipulation in section 13 can be found in subsections (2) and (3) in respect of honest concurrent use, or where an applicant claims special circumstance to the satisfaction of the court or Registrar as the case may be.³⁶

In infringement action, the question whether one mark is likely to cause confusion with another, is a matter for the judge alone to decide, however, he cannot abdicate the decision to witness before him. Furthermore, in doing so, the judge must be guided by the evidence placed before him and not merely on an inspection of the objects (marks).

iv. Restraint of Use of Arms of Nigeria or of a State

Apart from the above non-registrable marks, section 62 of the Act, expressly prohibits the use of Arms of Nigeria or the Arms of a state, in connection with any trade, business or profession of any person without prior authorization of the appropriate authority. The use of such Arms of government is criminal and the offender shall, on summary conviction be liable to a fine not exceeding forty naira. The appropriate authority here is the President of Nigeria or Governor of a State in the case of Arms of Nigeria and Arms of any State respectively.³⁷

The above provision is similar to what obtain in the United State of America under section 2 of the Lanham Act,³⁸ which provides *inter alia* that: ‘No trademark may be refused registration unless it “consist of or comprises immoral, deceptive, or scandalous matters or matter which may disparage or falsely suggests a connection with persons, living or dead, institution, beliefs, or national symbols, or bring them into contempt, or disrepute’.

³⁴ *Alban Pharmacy v. Stirling Products Int’l* (1968) 9 ALL NLR 300

³⁵ *Gottshark v. Spruce* (1936) 1 FSC 42.

³⁶ See *Ferodo v. Ibeta* (supra) at Pages 124-125; see also *Montres Buler Societe Anonyme v. Bulova Watch Company Limited LLC*, 03/17/2011.

³⁷ Section 62 (3) of the Act.

³⁸ Section 15 U.S.C.S 1051-1052 (Lexis Nexis) 2007.

THE LEGAL EFFECTS OF REGISTRATION OF TRADE MARKS

Registration of a trade mark confers on the registered proprietor the exclusive right to use the mark in relation to his goods or services.³⁹ The status also confers on the registered proprietor the legal capacity to institute legal action for its infringement by an unauthorized user. Accordingly, section 3 of the Trade mark Act provides *inter alia* that: ‘No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.....’

The above provision is however subject to the right of an unregistered user to bring action for the tort of passing off with all its attendant conditionalities under the common law; for instance, the plaintiff in an action for the common law passing off must *prima facie* establish that:

- (a). he enjoys sufficient goodwill in relation to the goods in question from members of the public,
- (b). the defendant act in misrepresenting the goods or mark to the public is capable of misleading or likely to mislead the public into believing that the goods or services are authorized by the plaintiff, and
- (c). the defendant acts will lead to actual or likely damage to him.⁴⁰

The above requirements are not necessary in the case of registered trade mark; what is essential is proof of registration of the mark by the proprietor of the trade mark. Furthermore, registration of a trade mark also confers a personal proprietary right on the proprietor than the right conferred by passing-off.⁴¹

Under the Trade Marks Act, a proprietor of registered trade mark has the right to either use the trade marks personally or assigns it to another person. Similarly, a registered trade mark is capable of being transmitted to beneficiary on the demise of the proprietor.⁴² Furthermore, the Trade Mark Act also confers right in varying degrees on the registered user to bring an action for any infringement of registered trade mark, provided he had called upon the proprietor to do so and he has defaulted after two months of such request.⁴³

The right of the proprietor takes effect from the date of the filing of the application for registration.⁴⁴ However, infringement proceeding cannot be commenced before the date on which the trade mark is in fact registered.⁴⁵

Under the English law, only acts committed in the United Kingdom can amount to an infringement of the proprietor’s exclusive right.⁴⁶ Conversely, it seems that a proprietor of trade mark in Nigeria can bring action for act of infringement committed in foreign country. The support for this view is captured in the wording of section 5 (2) of the Nigeria Trade Mark Act which provides thus:

*“Without prejudice to the generality of the right to the use of a trade mark given by such registration as aforesaid, that right shall be deemed to be infringed by **any person**⁴⁷ who, not being the proprietor of the trade mark or a registered user thereof, using it by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either:-*

- (a). as being use as a trade mark, or
- (b). in a case in which the use is used upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade”

From the foregoing, the emphasis on “any person” in the above provision is to show that the provision of section 5 of the Act is binding on any person irrespective of their national identity, thus, if a non-Nigeria citizen infringes on a trade mark registered under the Act, the Applicant can bring action in Nigeria for such infringement leaving in

³⁹ Mena Ajakpovi, “The Internet Intellectual Property Rights and Legal Framework for E-Commerce in Nigeria”, Jan/April, 2004, Vol. 8, Nos 1-2, *Modern Journal of Finance and Investment Law*, p. 166

⁴⁰ See *Reckitt & Colman Product Ltd v. Borden Inc & Ors (1990) RPC 341*.

⁴¹ *Seven-Up Company & Other v. Warri Bottling Company (1984) F.H.C.L. R 13*.

⁴² Section 26 of the Act.

⁴³ Section 33 of the Act.

⁴⁴ Section 22 (2) of the Act.

⁴⁵ *Ibid*.

⁴⁶ Section 9 (1) of the England Trade Mark Act, 1994.

⁴⁷ Emphasis supplied.

this regard, the problem of enforcement of such judgment in foreign country. The enforcement of such judgment may not however pose any problem, particularly, where the trade mark in question enjoys protection under section 44 of the Act. This section gives right to a proprietor of trade marks to apply for protection of his mark in Convention Country.

In an action based on the statutory right conferred by registration of trade mark, the plaintiff must prove his title either as proprietor or as a registered user. This status entitles him to sue and prove that the defendant has acted or threatened to act in such a way as to infringe the right conferred by registration as defined in section 67 of the Trade marks Act. Procedurally, it is the proprietor of a trade mark that can institute action for infringement of trade mark and not the trade mark itself. In the case of *Maersk Line & Anor. v. Addide & Anor*,⁴⁸ the Supreme Court said *inter alia* that ‘a trade mark cannot sue or be sued as it is not a juristic person, it is its proprietor that can sue or be sued’.

The major challenge hitherto existed in an action for the infringement of a trade mark in Nigeria was the issue of court vested with the jurisdiction to entertain action for infringement of trade mark in Nigeria.⁴⁹ Hence, whenever party seeks legal redress in the event of unauthorized use of his mark; he must as threshold issue determines which proper *forum* to institute a legal action. This question has now been laid to rest under section 67 (1) of the Trade Marks Acts, which defines the court to which the Act apply to mean ‘the Federal High Court’. This statutory provision has further received impetus under section 251 (1) of the Federal Republic of Nigeria Constitution, 1999 (as amended), which now conferred on the Federal High Court exclusive jurisdiction to entertain action for the infringement of trade mark and other intellectual properties.⁵⁰

CONCLUSION

The law, practices and procedures for registration of trade mark are provided for in the Nigeria Trade Marks Act. However, on careful examination, one cannot, but conclude, that the provisions fall short of the modern trends and advancement in technology in the fields of trade marks regime. There is no doubt that the practice of trade mark registration is on a daily basis expanding and several innovations have been introduced globally. These innovations amongst others include; registration of services mark, the introduction of exhaustion theory in America, and the emergence of registration of domain name orchestrated by the wide acceptability of internet practice. All these new ideas cannot be found in the Nigeria Trade Marks Act.

Furthermore, Nigeria is signatory to Paris Convention of 1883, but there have been several other International Arrangements and Agreements in the field of intellectual Property relating to trade marks practices. It is sad to note that Nigeria has shown little of no interest in most of these new arrangements and innovations. A good example is the Madrid Protocol.

At the level of case law, there are sizeable numbers of judicial authorities in the field of trade mark registration, however, the absence of new innovations as obtained in advanced jurisdiction has greatly affected judicial activism in Nigeria. In view of the inadequacies of the extant statutory provision on trade mark in Nigeria, it is very imperative to increase seminar and talk shop on trade mark to educate the public on the importance of trade mark registration and its attendant legal implications. This paper had therefore highlighted various statutory provisions on the registration of trade marks in the extant Trade Marks Act. The hope is that this will challenge the relevant authorities to take concrete step to review or amend the present Trade Marks Act to meet the growing trends in international sphere. With this, it is expected that the practice of trade mark will blossom to an acceptable international standard in Nigeria.

⁴⁸ (2002) 11 NWLR (Pt. 778) 317 at 360/(2002) 4 SCNJ. 433.

⁴⁹ See in this connection the case of *Patkum Industries Ltd. v. Niger Shoes Manufacturing Co. Ltd* (1988) 5 NWLR (Pt. 93) 138; *IML, Chartering Nig. Ltd. v. IMNL International Messengers (Nig.) Ltd* (1977-1989) 2 IPLR 80 and *Ayman Enterprises Limited v. Akuma Industries Limited & Others* (2003-2007) 5 IPLR 1 at 25.

⁵⁰ S A. Fagbemi, “Intellectual Property: The Legal Remedies for Infringement of Trade Mark and Common Law Tort of Passing Off”. *op cit*, pp. 48-49.