journals.unizik.edu.ng/index-php/jcpl ISSN: 2736-0342
NNAMDI AZIKIWE UNIVERSITY, AWKA
JOURNAL OF COMMERCIAL AND PROPERTY LAW

Towards Effective Enforcement Mechanism of Trademark Rights Infringement in Nigeria

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Abstract

One of the vital ways in which the development of the Nigerian economy can be achieved is through the instrumentality of trademark as a component of intellectual property (IP). There are comprehensive legislations for the protection of trademark but that cannot be true of effective enforcement mechanism of trademark in the event of infringement in Nigeria. Therefore, this work is aimed at examining the enforcement of trademark rights infringement in Nigeria. The key objective of the study was to ascertain the extent to which the available enforcement mechanisms have dissuaded the infringement of trademark rights in Nigeria. This paper adopted doctrinal research methodology approach. The main sources of information and data collection for this study were the relevant statutes, case laws, textbooks, articles and the internet. The article found that trademark infringement has caused unprecedented economic haemorrhage, underdeveloped potentials, hindered capacity for job creation and poverty in Nigeria as the available trademark enforcement mechanisms appear not to have adequately deterred trademark infringers. The work recommended inter alia, for legislative intervention, strong judicial system and inter-agency synergy to curb the trademark infringement menace in Nigeria.

Keywords: Trademarks, Passing-off, Protection, Infringement, Enforcement.

1. Introduction

Intellectual Property (IP) is an umbrella term for a set of intangible assets or assets that are not physical in nature. The concept of IP relates to the fact that certain products of human intellects should be afforded the same protective rights that apply to physical property, which are called tangible assets[1]. IP are broadly divided into two branches, namely industrial property and copyright. While copyright is concerned with literally, musical and artistic creation, industrial property covers rights in patents, trademarks, industrial designs, utility models, plants and animal varieties[2]. IP rights are basically exclusive rights granted by statute to the proprietors thereof. These legal rights can be infringed upon when the same rights granted to the proprietors are exploited by a third party without a lawful consent and authorisation. There are also protections and enforcement of IP rights under the common law[3].

There is a positive correlation between economic prosperity and protection of IP rights. Unfortunately, Nigeria, over the years, has become a target destination and transit for counterfeit

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[1]Will Kenton, 'Intellectual Property' <https://www.investopedia.com/terms/i/intellectualproperty.asp> accessed 4 February 2021

[2]Femi Olubanwo and OluwatobaOguntuase, 'Strengthening Intellectual Rights and Protection in Nigeria' <https://www.mondaq.com/nigeria/trademark/788714/strengthening-intellectual-property-rights-and-protection-in-nigeria> accessed 4 February 2021

[3]For instance, the tort of passing-off under trademarks.

and pirated goods[4] and other IP infringement owing largely to weak IP protection regime and enforcement mechanisms. This article examines the enforcement mechanisms a trademark right holder may employ under the statute and common law for effective protection of trademarks rights in Nigeria. Therefore, the paper is divided into seven parts. Part one is the introduction. Part two examines the concept of trademark. Parts three and four focus on trademarks protection and infringement respectively, while part five explores the mechanisms for enforcement of trademarks and remedies thereof; jurisdiction of court in trademark infringement matters in Nigeria follows progressively in part six. The last part concludes and makes a case for an enhanced enforcement mechanism for trademarks protection in Nigeria by way of recommendations.

2. Trademark Overview

Trademarks protects distinctive words, logos, slogans, specific colours and in some countries, sounds or other manners of identifying products or services.[5] The term "trademark" can be used to distinguish goods (including services or goods related to the provision of services) of one business from those of others.[6] This means trademark distinguishes the proprietor's goods and services from those of others. As to what constitute trademark, Article 15 of the TRIPS Agreement[7] provides that:

> Any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting trademarks, such signs in particular words including personal names, letters, numerals, figurative elements and combination of colours as well as any combination of such signs shall be eligible for registration as trademark.

In line with the provisions of Article 15, TRIPS Agreement, trademark may consist of words (including personal names), a logo, or combination of both. A mark also consists of figurative elements, letters, numerals or the shape of goods or their packaging. Statutorily, Section 67 of the Nigerian Trade Marks Act,[8] defined trademark thus:

> Trademark means, except in relation to a certification trademark, 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 person, and means, in

[4]See 'Impact of Intellectual Property Infringement on Businesses and the Nigerian Economy' <https://www.mondaq.com/nigeria/economy-analysis/883550/impact-of-intellectual-property-infringement-on-businesses-and-the-nigerian-economy> accessed 5 February 2021

[5] See 'Why you Badly need to protect the Intellectual Property of Your Start up' <https://www.mondaq.com/nigeria/trademark/901604/why-you-badly-need-to-protect-the-intellectual-property-of-your-startup> accessed 5 February, 2021

[6]JiSeonYoo, 'Requirement of Trademarks Registration and Examination Practice' being a paper presented at WIPO-KIPO Training Course on Trademark Law and Examination held in Daejon, Republic of Korean, from November 11 – 15, 2019

[7]The Agreement on Trade Related Aspect of Intellectual Property Rights. It is an international legal agreement between all member nations of the World Trade Organization (WTO), Nigeria inclusive.

[8]Cap T13 Laws of the Federation of Nigeria (2004) hereinafter referred to as "TMA".

> relation to a certification mark, a mark registered or deemed to have been registered under section 43 of this Act.

The definition of trademark as enshrined under the TMA, with greatest respect, apart from its verbose nature, appears fraught with complications and of limited value to the proper appreciation of the concept of trademark. However, the Supreme Court in the case of *Ferodo Ltd v Ibeto Industries Ltd*,[9] by way of amelioration of the verbosity associated with the TMA definition of trademarks, chose to ignore the intricate opening and closing clauses and stated that trade mark simply means "mark used or proposed to be used in relation to goods for the purpose of indicating so as to indicate a connection in the course of trade between the goods and some persons having the right either as a proprietor or a registered user to use the mark."

The phrase 'used or proposed to be used' and 'connection in the course of trade' as appeared in the TMA's definition of trademark needs further elucidation. The former implies that the actual use of a mark is not a precondition before the mark can be accepted for registration. In other words, the Registrar of Trademark can accept and register a trademark if it has either been used before application for registration or there is a plan to use it after registration in future. The Latter, on the other, means that the proposed mark must be registered for trade-related purposes. Thus, in *Imperial Group Limited v Philip Morris & Co Ltd*,[10]the court held that the phrase "indicate a connection in the course of trade implied that there was an intention of the trade mark user to make a profit and to establish trading good will. Therefore, where a mark is proposed for registration with the intention of using if for religious or non-commercial purpose, it will not be registered even if it meets other requirements for registration.

Trademarks are usually registered to protect marketing tools such as brand names, logos, or company slogans, among others, from third-party use or plagiarism[11]. And for a designation or other identifiers to function as a trademark, it must be distinctive or must have acquired distinctiveness in relation to goods or services in the course of trade[12] because it is the distinctive picture which indicates to the purchaser of goods or service the means of getting the same article in future.[13] With regards to distinctiveness of trademark, the TMA[14] provides that:

> For the purpose of this section, "distinctive" means adapted, in relation to goods in respect of which trademark is registered or proposed to be registered to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trademark is registered or proposed to be registered subject to limitation, in relation to use within the extent of the registration.

[9](2004) 5 NWLR (Pt 366) 317
[10](1982) FSR 72
[11]Marc Gras, 'How to Protect and Structure an Intellectual Property Business' <https://flagtheory.com/ip-intellectual-property-business/> accessed 30 January 2021
[12]John C. Onyido, 'Nigeria: Trademarks Comparative Guide'<https://www.mondaq.com/nigeria/intellectual-property/788900/tradenarks-comparative-guide> accessed 30 January2021
[13]Isaac Ogbah, Understanding Trademark Law in Nigeria (Legal Jurisprudence Limited 2019) 184
[14]Section 9(2)

Whereas the explanation offered by section 9(2) TMA as to the meaning of distinctiveness appears complex, the Supreme Court Per Niki Tobi JSC (as he then was) in the case of *Ferodo Ltd v Ibeto Industries Ltd*[15] stated that 'once the trade mark, by frequent use, it has acquired a notoriety in the trade to the common knowledge and easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness ...'

Whether a mark is distinctive or not, upon application for registration, the Registrar of Trademarks does not only possess the discretion to refuse marks that mislead or tends to cause confusion to the public, the TMA disallow some marks to function as trade mark such as deceptive or scandalous marks[16], identical or resembling trademarks[17] names of chemical substances[18], and the Coat of Arms of Nigeria or a State or other emblem of authority.[19] However, once a trademark is validly registered, it gives the proprietor the exclusive right to use the mark in marketing or selling of goods. If without the proprietor's consent, anyone else uses an identical mark or one nearly resembling it as to be likely to deceive or cause confusion, the registered proprietor will be entitled to sue for infringement of the trademarks.[20]To acquire a status of a trademark proprietor, the person must, in relation to the trademark, is the owner, importer, exported, shipper or any other person for the time being possessed of or beneficially interested in the goods to which the trademark is applied[21].

A trademark registered is valid and remains on the register of trademark for seven years from the date of registration and the registration may be renewed for additional period of fourteen years.[22] An application for renewal is expected to be made not less than three months before the expiration of the last registration of the trademark[23].

3. Trademark Rights Protection

Trademark owners should diligently protect their trademarks from infringement and other misuses that may harm the owner's goodwill and business reputation[24]. Trademark rights may arise both through use and through registration. The owner of an unregistered trademark can acquire goodwill or brand reputation through the use of a distinctive mark. However, unless a trademark is registered in Nigeria, the owner shall not be entitled to institute any proceedings to prevent, or recover damages for infringement.[25] Simply put, trademarks enjoy legal recognition by virtue of their registration as trademarks pursuant to the provision of the TMA. Legal

[15](2004) 5 NWLR(Pt 866) 317-82
[16]Section 11(a)-(b) TMA
[17]*ibid*Section 13(1)
[18]IbidSection 12(1)
[19]Section 62
[20]Ogbah, n13
[21]See *Dyktrade Limited v Omnia Nigeria Limited* (2000) FWLR (Pt. 11) 1784 SC Per BelgoreJSC
[22]TMA, Section 23
[23]Section 66, Nigerian Trade Marks Regulations 1967
[24]Marc Gras, n11
[25]Onyido, n12

recognition is also enjoyed when trademarks are used in the course of trade though may not be registered.[26] Thus, the TMA[27] provides that:

> No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trademark, but nothing in this Act shall be taken to affect rights of action against any person for passing off goods of another person or the remedies in respect thereof.

From the wordings of section 3 TMA, a registered trademark enjoys both legal recognition and legal protection. On its part, an unregistered trademark enjoys only legal recognition and its proprietor can maintain an action for passing off available under the common law. In addition to the exclusive right conferred on the owner under the TMA,[28] registration of trademark has other benefits and rights conferred on the owner: the registered proprietor, in a suit relating to the trademark, may not necessarily adduce evidence of use and reputation of the trademark, it suffices when he produces the certificate of registration.[29] Secondly, evidence of registration is a condition precedent to an action of infringement. Therefore, if a mark is unregistered, its proprietor cannot bring an action for an infringement.[30] Similarly, a registered trademark confers the right to assignment and transmission on its proprietor in return for fees, royalties and other payments as envisaged by the provision of the TMA.[31] A registered trademark also affords the proprietor to bequeath the trademark in a will; and to acquire incontestable status after a seven-year period under section 14(1) of the TMA.

As can be seen from the analysis, trademark protection is based on the premise that the protection of distinctive marks to distinguish proprietor's goods and services from other proprietors goods and services, and shield the public from deception and confusion. Therefore, a proprietor of a registered trademark has a positive right to use the mark exclusively and a negative right to prevent others from using the same mark without authorisation. Registration of trademark further serves as constructive notice to the public and as a prima facie evidence of the ownership and validity of the trademark.

4. Trademark Infringement

Trademark infringement is the unauthorised use of a trademark or service mark on or in connection with goods and/or services in a manner that is likely to cause confusion, deception, or mistake about the source of goods and/or service.[32] It is a statutory tort arising by virtue of registration of the trademark in issue at a national trademark registry.[33] Registration of Trademark is carried out by the Nigerian Trademark Registry domiciled in the Commercial Law

[26]Ogbu Blessing Ekpere, 'Protectable Trademarks in Nigeria and the Scope of the Protection: A Rejoinder' <https://thenigerialawyer.com/protectable-trademmarks-in-nigeria-and- the-scope-of-their-protection-a-rejoinder> accessed 26 January 2021

[27] Section 3

[28] See sections 5 and 6 TMA

[29]See *Crysterlight Overseas Agency Ltd v Yugoles Drugs Co Ltd* (1998) FHCL 390

[30]See Section 3 TMA

[31] See section 26

[32]See 'About Trademark Infringement' <https://www.uspto.gov/page/about-trademark-infringement> accessed 6 February 2021

[33]See WIPO Intellectual Property Handbook (WIPO Publication 489(E) 2004) 227

Department, Federal Ministry of Industry, Trade and Investment, Abuja, Nigeria. For trademark to be registered in Nigeria, it must satisfy specific conditions imposed by statute and enforced by the Trademark Registry. Registration entails consideration of such topics as distinctiveness of the proposed mark, whether it is an invented word, whether it has any direct reference to the character or quality of the goods in respect of which registration is sought, whether it has a geographical signification, among others[34].

In Nigeria, registration of trademark is available in respect of goods and services and there exist two categories of Trademark – those falling under part A[35] and part B[36] of the Register, in respect of which different consideration arise. In addition to its distinctiveness, for a trade mark to be registered in part A of the register, it must consist of at least one of these essential particulars: the name of a company, individual or firm, represented in a special or particular manner, the signature of the applicant for registration or some predecessors in his business, and invented word or invented words, 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, and any other distinctive mark.[37] Marks that can acquire distinctiveness through use under section 10 of the TMA are registered in Part B. The implication of section 10 TMA is that Part B mark does not have to be distinctive at the point of registration. All that is necessary is that the mark should be capable of becoming distinctive in use[38]. Thus, registrability under part B is hinged on the capability of the mark to distinguish the product in respect of which it is ought to be registered.[39]

For an action to constitute an infringement, it must be established inter alia, that the person infringing the trademark is not authorized to use the mark, the infringing trademark is either similar or identical or deceptively similar to the already registered trademark; the infringing trademark must be used in the course or trade in which the registered proprietor or user is already engaged,[40] the mark sought to be registered must not when compared with what is already registered, deceive the public or cause confusion.[41]Per Ademola CJN (as he then was) stated the position of the law as it relates to likelihood of confusion and public deception that:

> The question is not whether if a person is looking at the two trade mark side by side there would be a possibility of confusion, the question is whether the person who sees the proposed trademark in the absence of the other trademark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection.[42]

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[34]*Ibid*
[35] See section 9 TMA
[36] See *ibid* section 10
[37]*ibid* section 9(1)
[38]*ibid*Section 10(2)
[39]IfeyinwaUfondo, 'Trademark Examination and Searches in Nigeria' being a paper presented at the International Trademark Association (INTA) organized training for Trademarks Practitioners held at Sheraton Hotel, Abuja from 19th-20th February, 2020
[40]Ogbah, n13, 141
[41]See *Alban Pharmacy Ltd v Sterling Product International Incorporated* (1968) ALL NLR 112
[42]*Ibid*

The inference that could be drawn from the Supreme Court judgement under consideration is, in the determination of likelihood of confusion between two marks in dispute, it is apposite to compare the marks visibly and phonetically. Whereas the general position of the law is that a trademark which is not registered cannot be infringed and the trademark owner cannot bring infringement proceedings before the court, the TMA[43] makes provision for an exception and recognises the common law right of the trademark owner to take action and enforce unregistered trademark rights known as passing off action.

Passing off action arises when an unregistered trademark is used by a person who is not the proprietor of the said trademark in relation to the goods or services of the trademark owner.[44] Passing off is primarily founded in tort and historically rooted in Common Law. The major purpose underlying the tort of passing off is the protection of an established trade goodwill already acquired by a trade mark or a trade name[45] and prevention of misrepresentation in the course of trade to the public that there is some sort of association between the business of trademark owner and an infringer. Therefore, according to Lord Halsbury[46]," nobody has the right to represent his goods as the goods of somebody else."

In Nigeria, in determining what constitutes the tort of passing off, the Court of Appeal[47] stated thus:

> The tort of passing-off consists of the making of some false representation to the public, or to a third person(s) which is likely to induce them to believe that the goods and services of another are those of the plaintiff. This misrepresentation may be done by imitating appearances of the Plaintiff's goods or by use of the plaintiff's trade name or mark. The applicable test is not whether a customer can distinguish the two marks when placed side by side, but whether when he has only his own recollection of the one he likes to go by, he may accept the other in mistake of it.

The significance of the court's pronouncement under reference is that a misrepresentation calculated to injure another person in his trade or business so that customers are likely to be led into confusion and buy the defendants goods in the belief that they are the plaintiff's goods may provide the basis for passing off action. And where the alleged act of infringement is calculated to deceive the members of the public, it is not a mandatory requirement for the plaintiff to prove that the act has actually deceived the public. Thus, in *Nigeria Chemists Limited v Nigeria Chemist*,[48] Palmer J, was of the view that "the danger which can reasonably be foreseen in the present case, namely that the people will be misled into thinking that Nigeria Chemists are a branch of, or in some ways connected with, Niger Chemist – is a confusion which leads to deception."

[43]Section 3
[44]Ogbah, n13, 152
[45]See 'Trademark infringement: Suing for Passing-off in Nigeria Courts' <https://www.templars-law.com/trademark-infringement-suing-passing-off-nigeria-courts/> accessed 25 January 2021
[46]See *Reddaway v Banhan* (1896) AC 199 HL
[47]See *International Tobacco (Nig) Ltd v British America Tobacco (Nig) Ltd* (2009(6 NWLR (Pt 1138) 577
[48](1961) ANLR 180

To succeed in action for passing-off, the claimants among other things, must prove that they possess a reputation of goodwill in their goods, name, and marks; there has been a misrepresentation by the defendants which has led to confusion, and this misrepresentation has caused damage to claimant's reputation or goodwill in the claimant's goods, name and market.[49]In spite of the fact that passing off is a common law cause of action, in Nigeria, passing off also has a statutory basis. This position was given judicial imprimatur in *Pakun Industries Ltd v Nigeria Shoes Manufacturing Co Ltd*[50] where the Supreme Court stated that "in this country, the right of action of passing-off relating to infringement of trademark is statutory and can be found in Section 3 of the Trademark Act, 1965." Notwithstanding the statutory recognition of both trademark and passing off action in Nigeria, there is a glaring distinction between the two concepts. Whereas in passing-off, it is essential that the plaintiff should by evidence prove reputation and other essential elements, this is not necessary for the purpose of proving trade mark infringement. Once a trademark is registered, the registered proprietor may proceed against infringers without the uncertainty and expenses of having each time to prove his actual trading reputation.

For the purpose of the infringement of a trademark, it is not all the features contained in the mark that are important. Not all the components are to be considered as forming part of the trademark. The resemblance giving rise to infringement must lie in the basic idea of the mark.[51]In *Ferado v Ibeto*[52], the Supreme Court held that the basic idea of mark includes any inscription on it and the entire background.

In all, civil action lies in practically all cases of infringement of a trademark. The proprietor of a trademark can bring an action to prevent the registration of a mark similar to or resembling his own registered mark by another person. He can also institute an action if the mark which infringes his own mark has already been registered. Indeed, where the two marks resemble or nearly resemble each other as to be likely to deceive or cause confusion, the proprietor of a trademark is likely to succeed in an action for infringement.[53]

5. Enforcement of Trademark Rights in Nigeria

Accessible, sufficient and adequate arrangement for the protection of rights are crucial in any worthwhile IP system. It is not possible for the right-owners to enforce their rights effectively in a world where expanding technologies have facilitated infringements of protected rights to hitherto unprecedented extent.[54] Trade marks proprietors must evolve measures to take action against infringers in order to prevent further infringement and recover losses incurred from any actual infringement.

Failure to sufficiently protect and enforce trademark can have financial consequences for the business and more importantly for the health of their customers. Similarly, proprietors that do not

[49] See*Reckitt & Colman Product Ltd v Borden Inc* (1990) 1 ALL ER 873
[50](1998)5 NWLR (Pt93)138 SC @162
[51]See *Procter and Gamble Company v Global Soap and Detergent Ind Ltd &Anor* (2013) 2NWLR (Pt1336) 461
[52](2014) 5 NWLR (Pt 866) 317 SC
[53]F. O. Babafemi, Intellectual Property: The Law and Practice of Copyright, Trademark, Patents and Industrial Design in Nigeria (Justinian Books 2007) 233
[54]WIPO, n33, 207

adequately enforce their mark face significant loss of value of a particular brand.[55] From a marketing perspective, once a brand loses its visibility, position and goodwill, the ultimate result is lost market share. From a legal perspective, the failure to protect trademarks and police them against clear infringement diminishes or weakens such rights and assets. Systematic failure to enforce essentially gifts competitors the ability to misappropriate the selling power and consumer reach previously enjoyed by the brand exclusively.[56] In addition, failure to take prompt enforcement action can seriously undermine the value of a trademark. Aside from cases of actual confusion, where customers mistakenly buy the products of proprietor's competitors, the proprietor's trademark may become generic, where consumers use the trademark as a purely descriptive term for the goods or services in question.

The ensuing discourse highlighted the consequences of failure to protect and enforce trademarks infringement. Therefore, proprietor must seek to improve the protection and enforcement strategies in order to maximise return on investment. A proprietor that wishes to enforce its trademark rights must act quickly and aggressively in order to maintain the integrity of the brand.[57] In Nigeria, where a trademark rights has been infringed upon, the proprietor may exercise several available options to enforce his rights. Some of the available options are hereunder examined:

a. Action Before the Trademark Registry

The Nigerian Trademarks Registry has quasi-judicial function in trademarks administration in Nigeria and provides a forum for procedures for contesting trademark rights. These procedures are often referred to as opposition procedures. When an application for registration of trademark has been accepted in the Trademark Registry, the Law[58] requires the Registrar of Trademark to cause notice of application to be published in the Trademark Journal. As soon as he Trademark Journal is advertised by the Registrar, a proprietor of trademark can file for opposition within sixty days[59] of the publication in the trademark journal against the registration of a similar or identical mark which is likely to cause confusion. This entails filing of relevant documents by the applicant and the opponent, including notice of opposition, counter-statement and statutory declaration. The matter is determined at the hearing before the Registrar after consideration of relevant evidence.[60]However, the decision of the Registrar in this regard is subject to appeal by an aggrieved party to the Federal High Court[61].

Opposition procedures become imperative because even with the most vigorous examination system in place at the Trademark Registry, the system cannot, in all honesty, guarantee hundred percent that the rights which it grants are valid – there is always a possibility that prior right has

[55] See 'Protecting and Enforcing Trademarks s' <https://www.financialworldwide.com/forum-protecting-and-enforcing-trademarks#.YA7d3a908w4> accessed 25 January 2021
[56]Ibid
[57]Bolanle Olowu and others, 'Protecting and Enforcing Trademarks and Copyrights'<http://www.nigerianlawguru.com/article/intellectualpropertyLAW/Nigeria.htm> accessed 26 January 2021
[58] See section 19(1) TMA
[59]See *ibid* section 20(1)
[60]See*ibid* section 20(4)
[61] See*ibid* section 21(1)

been overlooked or a specification misunderstood which makes it likely that the rights might be granted in conflict with earlier rights. Therefore, the system should be able to make provision for the owner of earlier rights to object to a potential infringing mark at some stage hence the need for opposition procedures.

Furthermore, after the registration of trademark, an aggrieved proprietor of earlier trademark in the register can apply to the Trademark Registry for removal of the subsequent registered mark from the register or to seek its modification.[62] The Application must be supported by documents showing ownership of the trademark in Nigeria that precede the offending registration/application. If the Registrar finds in favour of the true owner, he may unilaterally withdraw the acceptance or cancel the certificate already issued to the infringer. Where necessary, the Registrar may permit the contending parties to make representations at a hearing before decision is made in that respect.

b. Cease and Desist Letter

A proprietor can enforce its trademark rights by writing a cease and desist letter to dissuade the infringer from using and/or proceeding with registration of the mark. It is used to curb infringement at any early stage and to threaten further legal action if infringement continues.

Cease and desist letter should contain sufficient evidence of rights to the mark such as evidence of use and acquisition of goodwill which predates use by the putative infringer.[63] This is usually the first step taken before commencing an action for passing off/infringement and this could also cause the competing proprietor to withdraw his application at the registry and save the owner of the senior trademark the aggravation, time and expense of having to prosecute a lawsuit.[64]

c. Criminal Action

Serious criminal offences of counterfeiting and piracy may arise in the course of business thus constitute to trademark infringement. A trader may knowingly manufacture, distribute or sell goods marked with a trademark where the marking has been done without the permission of the owner or where the goods have been illicitly copied.[65] Trademarks right-owners themselves may become aware of distributors or retailers trading in counterfeit goods and bring the trade to the attention of the police authorities. Again, action against counterfeit goods may be taken at port of entry of imports. Custom authorities may impound consignment of counterfeit goods in this regards and criminal action can be taken against the importer.

These criminal acts, under consideration, are not just infringement of trademark proprietors' rights but also have hazardous effect on consumers especially if the mark relates to food and drugs items. To this end, law enforcement agencies such as the Police, the Standard Organization of Nigeria (SON), the National Agency for Food and Drug Administration and Control (NAFDAC) and the Nigerian Customs Services are empowered by enabling laws to among other

[62]See *ibid* section 39
[63]Yetunde Okojie and Bisola Scott 'Recommended ways to Protect Pending Trademarks in Nigeria' <https://www.mondaq.com/nigeria/trademark/740682/recommended-ways-to-protect-pending-trademarks-in-nigeria> accessed 27 January 2021
[64]Ibid
[65]See WIPO, n33, 210

disciplinary measures, effect the arrest of trademark infringers and prosecute them according to the law of the land.

d. Civil Court Action

Despite efforts to resolve trademark dispute through the instrumentality of alternative dispute resolution (ADR) mechanism, circumstance may arise where a right owner may be compelled to approach the civil court and take action against an infringer in order to protect his market, present or future. In court, the argument of the trademark proprietor would be anchored on the scope of the registration and whether the allegedly infringing mark is confusingly similar to the earlier mark as to deceive the members of the public or customers.

In an action for trademark infringement, the trademark proprietor may as a plaintiff through his solicitors, file a writ to be served on the alleged infringer, the defendant specifying the nature of the alleged infringement and the remedy sought. The defendant will acknowledge the writ and give notice of his intention to defend by way of Memorandum of Appearance.[66] If he does not, the plaintiff may be entitled to final or interlocutory ruling upon proof of service of Court Process on the defendant.[67] If the defendant enters defence, and the issue is not settled out of court or dealt with summarily, pleadings will be exchanged, on the one hand stating the plaintiff material facts of the claim and the other hand, the defendant's defences or counterclaim.[68] Document are tendered at the hearing, witnesses are called and cross-examined by the parties in dispute.

At the stage of judgement delivery, several remedies are available to the court to grant to the trademark proprietor to redress the harm done to him by an infringer or to stop the impending harm to be done to him. In addition to injunctions,[69] restraining the alleged infringer, the defendant, from continuing with the infringement, the court may also award damages in respect of the infringement, namely compensation for sales and market lost as a result of the infringing activity. Damages presumed as the natural consequences of the defendant's action. Thus, proof of actual or special damages is not absolutely necessary.[70] As alternative to damages, the trademark proprietor can be awarded an account of profits.[71] In this way, all the profits derived by the defendants as a result of the infringement may be surrendered to the trademark proprietor. An order requiring the defendant to deliver up[72] to the trademark proprietor, or to destroy any products or articles incorporating the trademark can also be made. In order words, the infringement articles may be destroyed, forfeited or converted for the plaintiff's use by the court order.

[66]See Order 7, Federal High Court (Civil Procedure) Rule 2019
[67]See *ibid* Order 8
[68]See *ibid*Order 13
[69]See *Ferodo Limited v Unibros Stores* (1992) 2 NWLR 509
[70]Nkem Itayi, 'Enforcing Intellectual/property rights in Nigerian courts' <https://www.researthgate.net/publication/324763377-enforcing intellectual-property-rights-in-nigerian-courts> accessed 29 January 2021
[71]*Potton Ltd V Yorkdose Ltd* (1990) FSR II
[72]*Se Beecham Group Limited V Esdee foods products (Nigeria) Ltd* (1980) FHCL 177 @ 188

However, for the trademark proprietor to be entitled to the aforementioned remedies in court, he must prove that he owns a valid mark, that he has priority, and that the infringer's mark is likely to cause confusion in the minds of the consumers about the source or sponsorship of the goods or services. Similarly, an act of infringement that could ground an action in passing-off might relate to the misuse of trade names, trademarks or the design 'getup' of the goods or business in question.[73]

6. Trademark Enforcement and Court Jurisdiction

Jurisdiction is the authority of a court to decide a matter instituted before it by litigants. Jurisdiction is fundamental to the exercise of judicial power vested in a court and action without jurisdiction, no matter how well conducted must eventually come to nullity.[74] Under the Nigerian legislation, the functions of the court are critical to resolving trademark issues and the subject matter jurisdiction to hear IP cases is exclusively given to the Federal High Court by the constitution.[75] The Constitution is supreme and its provision binds all persons and authorities throughout the country and any law that is inconsistent with the provisions of the constitution shall be void to the extent of such inconsistency with the provisions of the constitution.[76]Thus, section 251(1) (F) of the Constitution provides that:

> Notwithstanding anything to the contrary contained in this Constitution and in addition to such other jurisdiction as may be conferred upon it by an act of the National Assembly, the Federal High Court shall have and exercise jurisdiction to the exclusion of any other court in civil cause and matters…(arising from) any Federal enactment relating to copyright, patent, design, trademarks and passing off…

Form the above provision of the constitution, it is apparent that any civil matter anchored on trademark and passing-off can only be commenced at the Federal High Court. The provision makes no dichotomy between registered and unregistered trademark in Nigeria and this position stands notwithstanding anything to the contrary contained in the constitution. Similarly, section 7(1) of the Federal High Court Act[77] provides that the Federal High Court shall to the exclusion of any other court have original jurisdiction to try civil cases arising from "any Federal enactment relating to copyright, patent, designs, trademarks and passing-off…" In addition, section 3 of the TMA empowers a trademark owner to institute action against any person for passing off and the TMA specifically defined court to mean the Federal High Court.[78] The litany of legislations cited above appear to have vested exclusive jurisdiction on the Federal High Court on matters relating to infringement and passing off of trademarks.

However, in Nigeria, over the years, the litigants have been faced with a dilemma over issues of the exercise of exclusive or concurrent jurisdiction by the Federal and State High Courts in cases involving passing-off of unregistered trademarks in view of the inconsistent decisions of the

[73] See *UK Tobacco Co Ltd V Carrelas Ltd* (1931) 16 NLR 1
[74] See *Funduk Engineering V McArthu*r (1993) 4 NWlR (Pt 329) 640@651
[75] The Constitution of the Federal Republic of Nigeria 1999 (as amended)
[76]*Ibid*, section 1
[77] Cap F12 Laws of the Federation of Nigeria (LFN), 2004
[78] See section 67 TMA

Nigerian Supreme Court. Thus, in *Patkun Industries Ltd v Niger shoe manufacturing Co Ltd*,[79] the Supreme Court held that the Federal High Court has jurisdiction in action for passing-off of registered trademark. It was the view of the apex court that where a common law right has been enacted into statutory provisions, it is the statutory provisions so made that resort must be had for such rights and not the common law. In other words, the Supreme Court decision in Patkun's case is anchored on the provision of section 3TMA which allows a trademark owner to enforce his rights against any persons for passing-off his goods.

While it is clear that the Federal High Court has jurisdiction to entertain an action for passing off of registered trademark, the court in Patkum's case appears to be silent on the issue regarding which court has jurisdiction to entertain a passing off case of an unregistered trademark. The Supreme Court had the opportunity to remedy the situation in the case of *Ayman Enterprises Ltd v Akuma Industries Ltd*[80] where the subject matter involved alleged passing off an unregistered trade mark. The Supreme Court held that the State High Court possess the jurisdiction to entertain an action for passing off of an unregistered trademark while that of a registered trademark lies with the Federal High Court.

The Supreme Court decision in Ayman's case has been described with respect, as "totally wrong in the face of existing law to provide a dichotomy between registered and unregistered trademark"[81] with regard to court jurisdiction and illogical in the face of section 7(3) of the Federal High Court Act.[82] With profound respect, it is hereby submitted that the Supreme Court's view in Ayman's case contravenes the provisions of section 251(1)(3) of the Constitution and sections 3 and 67 of the TMA. Interestingly, four years after the decision in Ayman's case, the Supreme in *Omnia Nigeria Limited v Dyketrade Limited*[83] held that the Federal High Court has jurisdiction to hear and determine claim for passing off action whether arising from registered or unregistered trademark. Indeed, the Supreme Court has interpreted and stated the correct position of the law as it relates to trademark infringement in Nigeria in Omnia's case. This now take us to the concluding part of the research work.

7. Conclusion

Trademark infringement has been a disservice to the Nigerian State in diverse ways. It has retard Nigeria from attaining its full economic potentials and also detrimental to the health and wellbeing of Nigerians in view of the proliferation of fake and adulterated drugs and foods in Nigerian market. Similarly, trademark rights infringement limits genuine investment by local and foreign investors, hinders job creation, increase poverty among teeming population in Nigeria and loss of revenue to the government. The enforcement provisions contained in the various legislations in Nigeria with regard to trademark infringement are indeed appropriate in the circumstance but more need to be done in this direction.

In view of the reported cases of upsurge infringement of trademark in Nigeria in recent times, and taken into cognizance the imperativeness of protecting the proprietary rights of trademarks

[79] See n50
[80] (2003) 12 NWLR (Pt 836) 22 SC
[81] See Itanyi, n70
[82] See Ogbah, n 13, 189
[83] (2007) 15 NWLR (Pt 1058) 576 SC

owners, the following recommendations are proffered as an effective mechanism for enforcement of trademark infringement rights in Nigeria.

1. The Nigerian Trademark Act should be amended to specifically empower the Trademark Registrar in conjunction with law enforcement agents to enforce, raid, confiscate and deliver to authorities or to destroy counterfeit goods and to take action against those involve in the trademark infringement and prosecute them accordingly.
2. Trademarks and IP systems in general need to be underpinned by a strong judicial system in Nigeria to effectively deal with both civil and criminal Offences, staffed by an adequate number of judges with suitable background experience in IP issues. Trademark and indeed IP disputes are to be death with not only fairly but also expeditiously to serve as deterrent to would be infringers.
3. In view of the conflicting judgement of the apex court in Nigeria with respect to the jurisdiction of court as regard to passing off infringement, a legislative intervention is recommended in order to put the record straight as jurisdiction is the livewire of any court proceedings. This is to forestall contradictions in future as to the jurisdiction of the court for passing off action arising from an unregistered trademark.
4. Trademark right-owner should also act as his own law enforcement agent. He must keep an eye on the industrial and commercial markets in which his processes might be infringed and immediately take steps and remedy apparent infringement on his goods and services.
5. Government through the Trademark Registry, in collaboration with critical stakeholders in the IP industry, should evolve strategies including, but not limited to awareness campaigns to educate the public on the dangers of trademark infringement, and the remedies available to trademarks proprietors when their trademarks are infringed. These strategies will significantly reduce the astronomical rise in trademark infringement cases and by extension, the improvement of Nigerian economy for the good of all.