International Journal of Innovative Development and Policy Studies 7(3):44-54, July-Sept., 2019
© SEAHI PUBLICATIONS, 2019 www.seahipaj.org ISSN: 2467- 8465

Jurisdiction Over Trade Mark Matters In Nigeria: The Unsettled Question Of Passing Off*

[1]MVC OZIOKO PhD & [2]Ikenga K.E.ORAEGBUNAM, PhD

[1]Senior Lecturer, Department of International Law and Jurisprudence, Nnamdi Azikiwe University, Awka, Nigeria
[2]Reader and Head, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, Nigeria

ABSTRACT
Jurisdiction indeed is the cornerstone of every judicial adjudication. It is the authority of a court to decide matters before it or take cognizance of matters presented in a formal way for its decision. It has also been referred to as the dignity which a court has to do justice in a cause or complaint before it or the limit imposed upon the power of a validly constituted court to hear and determine issues with reference to the subject matter, the parties and the relief sought[1]. The limit or extent of jurisdiction of courts and other adjudicatory bodies in Nigeria is defined by the Constitution and other statutes. However, the bare words of the law do not, often time, lay to rest questions about jurisdiction. In this respect, this paper examined the raging controversy regarding the jurisdiction of courts over matters relating to the civil wrong of passing off. The work found that the decisions in a preponderance of judicial authorities on the subject were based on a misconstruction of the relevant statutory provisions particularly Section 251(1) (f) of the Constitution of the Federal Republic of Nigeria 1999 (as amended) and Section 3 of the Trade Marks Act. The work recommends that a proper construction or interpretation of the relevant laws should be adopted which will re-affirm the jurisdiction of State High Courts in Passing Off matters as opposed to the Federal High Court. The work also recommends the amendment of the relevant legislations to eliminate the identified confusion and controversy.
Keywords: Jurisdiction, Trade Mark, Passing Off, Nigeria

1. INTRODUCTION

There is no gain saying the fact that the law of trade marks both in Britain and in Nigeria owes its origin from the early recognition of the common right of action in passing off. As Lord Kingsdown laid down in the *Leartther Cloth Co. v. The American Cloth Co*[2].

> The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord Langdale in the case of Perry v. Truefitt (1843) 6 Bear. 66) be allowed to use names, marks, letters or rather indicia, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.

***MVC OZIOKO, PhD, LLM, BL,** Senior Lecturer, Department of International Law and Jurisprudence, Nnamdi Azikiwe University, Awka, Nigeria. Phone Number: +2348039464374; and
***Ikenga K.E.ORAEGBUNAM, PhD (Law), PhD (Phil.), PhD (Rel. & Soc.), MEd, BL,** Reader and Head, Department of International Law and Jurisprudence, Faculty of Law, Nnamdi Azikiwe University, Awka, Nigeria. E-mail: ik.oraegbunam@unizik.edu.ng. Phone Number: +2348034711211.
[1] See the dictum of Ngwuta JSC in *Society Bic S.A. v. Charzin Industries Ltd. (2014)* All FWLR (pt. 739)
[2] (1865) 11 H.L. Cas 538. See also W. Cornish; *Cases And Materials on Intellectual property* (5th edn, London, Sweet & Maxwell 2006) P. 469

Previously, before the establishment of the Federal High Court, it was safely assumed in Nigeria that passing off, being a common law right, was within the adjudicatory jurisdiction of the state High Courts. This was still the case notwithstanding the provisions of Section 3 of the Trade Marks Act 1965 which acknowledged the existence of the right of action in passing off outside the right of action for infringement of registered trade marks created under the Act.

But the establishment of the Federal High Court (as the then Federal Revenue Court) in 1973,[3] with the attendant issue of exclusivity of jurisdiction seemed to have upset the apple cart. The issue of jurisdiction over trade marks matters was not a problem with earlier trade mark legislations, since there were no alternative High Courts at the time. For instance, under the Trade Marks Ordinance of 1914 any matter 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.[4] This was a straight-forward provision that presented no problems for potential litigants or the legal system at the time.

Today, institution of actions in Nigerian courts for the infringement of trade marks particularly unregistered trade marks, is confronted with the thorny issue of determining the appropriate court that has jurisdiction therefore, as between State High Courts and the Federal High Court. This issue which has dragged on for many decades and through the full hierarchy of courts, is what this paper seeks to examine with a view to finding a lasting solution to the problem.

2. Meaning of Trade Mark/Passing Off

Section 67 the Nigerian Trade Marks Act[5] in its defines trademark to mean

> …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 the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trademark, a mark registered or deemed to have been registered under section 43 of this Act".

A trade mark in a nutshell is a distinctive mark of authenticity through which the product of a particular manufacturer may be distinguished from those of others by word, name, symbol, device etc[6]. Trade mark is no doubt important both to the proprietors and the public. This is evident, on the one hand, from the fact that it acts as a means of identifying the goods of a particular trader and, on the other hand, that it is a means of preventing the grievous deceit of the public by the sale of defective goods. In Nigeria, as elsewhere, the right to a trade mark is acquired through registration as opposed to the right of action in passing off which is based on an established trade goodwill or reputation already acquired by a trade mark or trade name or symbol without necessarily being registered.

Passing off on the other hand is a tortuous wrong which arises from the wrongful representation of one's goods and services as the goods and services of another. In H.P. Bulmer Ltd. vs. J. Bollinger SA[7] Buckley L.J. succinctly described it in the following words;

> A man who engages in commercial activities may acquire a valuable reputation in respect of the goods in which he deals or of services which he performs or of his business as an entity. The law regards such a reputation as an incorporeal piece of property, the intensity of which the owner is entitled to protect.

[3] See the Federal High Court Act cap F12LFN 2004.
[4] See Section 2 of the Trade Marks Ordinance 1914 Cap 199 Laws of the Federation 1958
[5] See Section 67 of the Trade Marks Act, Cap T 13, Laws of Federation of Nigeria (LFN), 2004
[6] See the dictum of Rhodes –Vivour JSC in Society *BIC S.A. vs. C harzin Industries Ltd. (supra)*
[7] (1978) RPC 79 at 93. See also D. Bainbridge; *Intellectual property* (4th edn, Essex: FT Pitman Publishing 1999) P. 598

Passing off therefore is a common law right which protects the right to goodwill or reputation associated with a particular name or mark used in the course of a trade. The owner of the goodwill is said to have a property right which is protectable by an action in passing off.

3. Jurisdiction over Trade Mark Matters

Registered Trade Marks

Section 3 of the Trade Marks Act provides as follows:

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

The above provision, as clear as it may appear, stands at the root of the controversy addressed in this work. It is pertinent to highlight at this juncture that Section 67 of the Act "court" as referred to under the Act means the Federal High Court. It is also worthy of note that the Registrar of Trade Marks is vested with certain jurisdictional powers over certain trade mark matters including powers to award costs[8].

From the text of section 3 of the Act quoted supra and other available statutory and case law on the subject, it is not in doubt that the Federal High Court is imbued with exclusive jurisdiction with respect to actions for infringement of registered trade marks. Indeed, Section 7(i) (c) (ii) of the original text of the Federal High Court (formerly Federal Revenue Court) Act 1973 provided that the then Federal Revenue Court shall have and exercise jurisdiction in civil causes and matters arising from any enactment relating to copyright, patents, designs, trade marks and merchandise marks[9]. This provision was later amended by the Federal High Court (Amendment) Decree No. 60 of the 1991 which provided that the Federal High Court shall, to the exclusion of any other court, have original jurisdiction to try civil causes and matters connected with or pertaining to "any Federal enactment of common law relating to copyright, patents, designs, trade marks and passing-off, industrial designs…"

The exclusive jurisdiction of the Federal High Court to try trade mark matters was subsequently constitutionally re-affirmed first by the provisions of Section 230(1) of the 1979 constitution of the Federal Republic of Nigeria as amended by Decree 107 of 1993 and later the extant provisions of Section 251 (1) (f) of the 1999 Constitution (as amended).

Passing Off

Whilst the issue of the exclusive jurisdiction of the Federal High Court to entertain matters relating to registered trade marks is, as noted earlier, beyond argument, the same conclusion cannot be reached with respect to passing off. In this respect available case law shows that different and varying interpretations have been ascribed by different courts to the provisions of Section 3 of the Trade Marks Act quoted earlier, vis-à-vis other relevant provisions of other enactments on the subject. The two major controversial postulations which emanate from the said interpretations are summarized hereunder as follows:

(a) That the Federal High Court has exclusive jurisdiction to entertain passing off actions arising from registered trade marks.

(b) That the Federal High Court has jurisdiction (exclusive or otherwise) to entertain passing off actions emanating from even unregistered trade marks.

It is obvious that the above postulations completely violate the earlier assumption that passing off actions being rooted in the common law of tort, only the State High Court has jurisdiction to entertain same.

[8] See generally sections 47, 49-53 and 57 of the Act

[9] See *Ayman Enterprises Ltd. vs. Akuma Industries Ltd*. (2003) 13 NWLR (pt. 826) 22. *Patrun Industries Ltd. vs. NIgershoes Manufacturing Co. Ltd.* (1988) 5 NWLR (pt. 93 138

To properly address the above issue, it is necessary to examine the relevant decisions vis-à-vis the relevant statutory provisions. Thus in the case of *Alhaji M.T. Elebute & Anor v. Dr. Olugbenga Ogunkua*[10], the plaintiff had brought an application before the Federal High Court for an interim injunction to restrain the defendant from using or claiming the plaintiffs' unregistered trade mark or the proprietorship of it until the final determination of the suit. The court in refusing the application referred to Section 3 of the Trade Marks Act and held that a person can only institute proceedings to prevent or recover damages for the infringement of a trade mark if the trade mark is registered. Where the trade mark is not registered, his remedy only lies in an action for passing off. Similarly, in the case of *Societe Bic S.A. v. Chargin Industries Limited and Anor*[11], the court held that an action for infringement of a trade mark before the Federal High Court cannot be founded on an unregistered trade mark. The issue however took a new turn with the decision of the Supreme Court in the case of *Patkun Industries Limited v. Niger Shoes Manufacturing Co. Ltd*[12]. in this case the respondents claimed against the appellant and two others at the Federal High Court for a declaration that the appellant and the other defendants are not entitled to infringe their registered trade mark and pass-off goods not of the respondents' manufacture or merchandise as and for goods or the respondents' manufacture and merchandise and or enabling others to do such an act. The defendants/appellants in their statement of defence denied passing off the goods as those of the respondents. It was also averred, *inter alia*, that at the hearing they would contend that the Federal High Court has no jurisdiction to entertain the suit and that it should be struck out. The point was subsequently taken as a preliminary issue pursuant to an application filed in that respect by the appellant. The Federal High Court ruled that it had jurisdiction to hear the suit and dismissed the application. The appellant's appeal to the Court of Appeal was also dismissed.

On further appeal to the Supreme Court, it was contended, *inter alia*, on behalf of the appellants that the action for infringement of a registered trade mark was one cause of action and 'passing-off' was also another different cause of action. They further contended that the Federal High Court had no jurisdiction in an action founded in 'passing-off' since the action for infringement of a registered trade mark was a creation of statute, that is, section 3 of the Trade Marks Act, 1965 and 'passing-off' action was a common law cause of action, not created by statute but by common law. The appellants further submitted that having regard to section 7(i) (c) (ii) of the Federal High Court Act, 1973, a joinder of infringement of registered trade mark and passing off was not possible. In other words, although the Federal High Court had jurisdiction in respect of actions for infringement of registered trade mark, it had no jurisdiction in respect of 'passing off' action.

The Supreme Court in unanimously dismissing the appeal held as follows:

(1) That the true intendment and purpose of section 3 of the Trade Marks Act 1965 are that –
   a. no person shall sue for the infringement of an unregistered trade mark.
   b. any person can sue for "passing off" or an unregistered trade mark
   c. any person can sue for infringement or passing off of a registered trade mark.

(2) That where a statutory provision is in conflict with, or differs from common law, the common law gives way to the statute. A statutory right may be conferred in addition to a common law right where there is no conflict. In the instant case, in addition to the right of action conferred on the owner of a registered trade mark, section 3 of the Trade marks

[10] (1990) F.H.C. 201. Cited in F.O. Babafemi, *Intellectual Property Law. The Law And Practice of Copyright, Trade Marks, Patents And Industrial designs in Nigeria* (Ibadan, Justinian Books Ltd., 2007) P. 207

[11] (1997) F.H.C.L. 727. See also *Crysterlight Overseas Agency Limited v. Yugolex Drugs Co. Ltd. & Anor (*1998) F.H.C./L 390 *and Alowonle v. Bello & Anor* (1972) 1 ALL N.L.R. (pt. 1) 41.

[12] (1988) 5 N.W.L.R . 138. *See also Savannah bank Limited v. Pan Atlantic* (1987) N.W.L.R (pt. 49) 212*; Ishekwere v. Ogunbode* (1976) F.H.C.L.R 64*; National Assistance Board v. Wilkinson* (1952) 2 Q.B 648*; IMI/Air Chartering Nigeria Limited v. IMNL International Messenger Limited* (1979) 5 F.R.C.L.R 113 *Samuelson v. Producers Distributing Company Limited* (1932) 1 Ch. 201 *Gafai v. U.A.C Ltd.* (1961) All N.L.R 785*; Edlit Limited v. Elias Kwaham Ltd.* (1966) N.M.L.R 289*; Fadiora v. Gbadebo* (1978) 3 S.C 219; *Odjewedje v. Echanokpe* (1936) 1 N.W.L.R. (pt. 52) 633*; Ejiofodomi v. Okonkwo* (1982) 11 S.C. 74 at 116. B.O. Babafemi, *op cit* P. 268-272

Act 1965 confers an additional right of action by preserving the right of action of 'passing off' in respect of such goods.

(3) That where a common law right has been enacted into a statutory provision, it is to the statutory provision so made that resort must be had for such rights and not to the common law. In the words of karibi Whyte J.S.C (as he then was)[13].

> "It is not correct to assume that a right of action enacted into a statutory provision is ineffective merely because it has its origin in the common law. This is not so. The common law of tort of passing off in respect of other matters still exists, but in respect of trade marks in this country the right of action of passing off relating to the infringement of registered trade marks is statutory and can be found only in section 3 of the Trade Marks Act, 1955".

That a "passing-off" action arising from the infringement of plaintiff's registered trade mark (its common law origin notwithstanding) was clearly within the jurisdiction of the Federal High Court.

(4) That Order 11 rule 6 of the Federal High Court Civil Procedure Rules 1976 allowed joinder of several causes of action in the same suit, if both can be conveniently tried or disposed off together.

(5) That two distinct claims arising from the same transaction can be included at the time of the issue of the writ in one writ of summons. In the instant case the infringement of trade mark and the passing off of the goods of the plaintiff as that of the defendant arose from the same transaction. They can therefore be tried together.

Uwais J.S.C (as he then was) also had this to say[14]

> Thirdly, if the same facts, as in the present case, give rise to both infringement of a registered trade mark and passing off, should two different suits be instituted in two different courts? That is, infringement of trade mark in Federal High Court and passing off in the State High Court? I think this dichotomy will not only lead to unnecessary multiplicity of cases and expenses but may lead to the plaintiff losing one of the two causes in the process. For where the Federal High Court hears and determines cases pertaining to the infringement of registered trade mark first before the plaintiff sues for passing off in a State High Court, a demurrer or plea in the State High Court that the action thereat is res judicata or the plaintiff is stopped from suing by reason of the earlier decision of the Federal High Court in the infringement case is likely to succeed, since the facts or transaction giving rise to both the infringement of the registered trade mark and the passing off are the same….moreover, it is against public policy that there should be multiplicity of actions arising from the same facts or transaction….

What emerged from the decision of the Supreme Court in the above case is that there are two types of passing off actions i.e. one which arises from a registered trade mark and the other which arises from an unregistered trade mark.

[13] *Ibid* at P. 152

[14] *Ibid* at P. 159

The decision of the Supreme Court in the *Patkun Industries case* was followed and applied by the Federal high Court in the case of *A.B. Chami & Co. Ltd. v. W.J. Bush and Co. Ltd*[15], where the Presiding Judge referred to the said decision and stated that the Supreme Court in that case identified two types of passing off, one type which arises from infringement of a registered trade mark and another type which stipulates that the plaintiff is marketing some goods and that the defendant is passing off his own goods as and for the goods marketed by the plaintiff.

The court specifically held as follows[16]

> The plaintiff in the instant case is claiming the second type of passing off. A plaintiff may fail to make out a case of infringement of a trade mark because he cannot prove its registration, or that its registration extends to the goods or to all the goods in question or because the registration is invalid and may yet show that by imitating the mark or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff… In the instant case the plaintiff has failed to prove the registration of ABARAIDADI & Device and so the question is whether it has proved that the defendant has done what is calculated to pass off its goods as those of the plaintiff. In doing so the plaintiff does not need to establish that it is a corporate body. Though where trade mark action fails, passing off action may still succeed on the same evidence.

Babafemi[17] however opines that the court in the above case wrongly interpreted the statutory provision contained in section 3 of the Trade Marks Act by suggesting that passing off action can be maintained at the Federal High Court in respect of an unregistered trade mark. According to him, the Federal High Court can only assume jurisdiction over a passing-off claim arising from infringement of a trade mark if the trade mark allegedly infringed has been registered. In his view, the right of action of passing off under section 3 is statutory and is derived from that Act and not the Common Law. He further referred to the case of *the Wellcome Foundation Limited and anor. v. Ranbaxy Montrari Nigeria Limited*[18] decided earlier where the Federal High Court held that though the plaintiffs could not bring an action for the infringement of an unregistered trade mark, they would succeed in the common law tort of passing off. Relying on Section 3 of Trade Marks Act 1965 the court in that earlier casehad held that[19];

> It is common cause between the parties that neither ACTIFED nor ACTID is a duly registered trade mark, although both parties have applied for registration. That being so the plaintiffs cannot base their claim on registration under the statute…. Be that as it may, there is no doubt whatsoever that the plaintiffs are the owners of the unregistered trade mark ACTIFED. Their right of suit for the tort of passing-off is preserved by section 3 of the said Act.…

According to Babafemi,[20] the court, having found that the trade marks were not registered, should not have considered the issue of passing off maintaining that the Federal High Court can only entertain the action of passing-off if the trade mark in question is registered. Otherwise, the parties must have recourse

[15] (1996) F.H.C/K 784
[16] Ibid at P. 805
[17] B.O. Babafemi, Op. cit P. 275
[18] (1993) F.H.C.L 353
[19] (1993) F.H.C.L. R 368
[20] *Op cit,* p.277

only to the State High Court. To further strengthen his argument, he referred further to the case of *Exxon Corporation v. Exxon Nominees Industries*[21] in which the Federal High Court exercised jurisdiction in an action for passing off involving a registered trade mark on the ground that the statutory right "has embraced or incorporated the common law right", thus a breach of trade mark in the circumstance may be called a violation of statutory passing off within the jurisdiction of the Federal High Court.

The subsequent decision of the Supreme Court in *Ayman Enterprises Limited v. Akuma Industries Limited and Ors*[22] with regard to the issue, whether the Federal High Court has jurisdiction to entertain an action for damages for passing off of an unregistered trade mark even caused more ripples. In that case, the Appellant filed both a motion *ex parte* and a motion on notice for Anton-Piller injunction in addition to claim for damages for passing off against the respondent. On 1 July, 1996, the trial court granted the exparte application and adjourned the suit to 25 July, 1996 for the hearing of the motion on notice. The appellant subsequently executed the ex parte injunction on the respondents.

Thereafter on 12 July, 1996, the respondents filed a motion on notice praying the trial court to set aside, discharge or vacate all the orders made ex parte against them by that court. The trial court then ordered that the two applications by the parties be consolidated and were heard together. After taking argument from counsel to the parties, the trial court refused the respondents application to set aside the ex parte order earlier granted and granted the appellant's motion on notice for Anton-piller injunction. The respondents were dissatisfied with the ruling of the trial court and they appealed to the Court of Appeal. The Court of Appeal allowed the appeal and set aside the ruling of the trial court, but nevertheless held that the trial court had jurisdiction to entertain the suit.

The Appellant was dissatisfied with the decision of the Court of Appeal and it appealed to the Supreme Court, while the respondents cross-appealed on the aspect of the decision of the Court of Appeal that the trial court had jurisdiction to entertain the claim. Since the lone issue raised by the respondents in the cross-appeal is one of jurisdiction, the Supreme Court decided to determine the said issue first.

In resolving the cross-appeal, the Supreme Court considered the following relevant statutory provisions, ie Section 230(1) (f) of, the Constitution of the Federal Republic of Nigeria, 1979 as amended by Decree No. 107 of 1993, Section 7(1) (c) (ii) of the Federal High Court Act, 1973 and Section 3 of the Trade Marks Act.

The Supreme Court in unanimously allowing the cross-appeal, held accordingly as follows:

1. That by virtue of Section 230(1) (f) of the Constitution of the Federal Republic of Nigeria, 1979 as amended by Decree No. 107 of 1993, the Federal High Court has exercise jurisdiction in civil causes and matters arising from any Federal enactment relating to copyright, patents, designs and merchandise marks, business names and commercial industrial monopolies, combines and trusts, standard of goods and commodities and industrial standards.
2. That for the Federal High Court to have jurisdiction over a passing-off claim arising from infringement of a trade mark, the trade mark allegedly infringed must have been registered. This is because the right of action of passing-off under Section 3 of the Trade Marks Act is statutory and is derived from that Act and not the common law.
3. That for the Federal High Court to have jurisdiction to entertain an action for passing-off arising from an infringement of a registered trade mark, the action must have arisen in relation to a Federal enactment and the Trade Marks Act of 1965 is such a Federal enactment.
4. That in the instant case, although there was an allegation of infringement of a trade mark, the trade mark was not registered, and so the passing-off claim, even if there was such passing-off did not and could not have arisen from a registered trade-mark. In other words, the passing-off right of action did not arise from the infringement of any Federal enactment and so could only be a common law right. Therefore, the Federal High Court did not have jurisdiction.

Uwais C.J.N. (as he then was)[23] at pages 50-51, succinctly stated thus;

[21] (1989) F.H.C.L.R. 1
[22] (2003) 13 N.W.L.R. (Pt 836) 22
[23] Ibid, p. 50-51

> It seems to me that the jurisdiction of the Federal High Court to deal with actions on passing-off depends on the registration of trade mark as provided by Section 3 of the Trade Marks Act, cap 436 and section 230 subsection (1) (f) of the 1999 Constitution – See Patkun Industries Limited v. Niger Shoes Manufacturing Co. Ltd. (1988) 5 NWLR (pt. 93) 138. Where the trade mark is unregistered as in the present case, then the cause of action for passing-off is in common law of tort and action can now be brought in a State High Court in view of the provisions of Section 272 subsection (1) of the 1999 constitution which provides:-
> 272-(1) Subject to the provisions of Section 251 and other provisions of this constitution, the High Court of a State shall have jurisdiction to hear and determine any civil proceeding in which the existence or extent of a legal right, power, duty, liability, privilege, interest, obligation or claim is in issue…"
> For these and the further reasons contained in the judgment of my learned brother, Kalgo, JSC, I too find that the Federal High Court lacked the jurisdiction to try the Plaintiff/Appellant's case.

It is obvious from the above account that the Supreme Court in the *Ayman Enterprises case* not only re-affirmed its earlier stance in the *Patkun Industries case* concerning the jurisdiction of the Federal High Court to entertain Passing-off actions based on registered trade marks but also extended the frontiers by holding that such jurisdiction is exclusive.

As if this did not stir enough controversy, the apex court followed suit with another thunder bolt in the case of *Omma Nigeria Ltd. vs. Dyktrade Limited*[24]. In that case the Respondent had sometime in 1989 initiated a trading venture with an Italian company to manufacture grinding stones for the washing of terrazzo floors. The Respondent adopted the trade mark "Super Rocket" for the grinding stones which it registered in Nigeria under No. 51136 in Class 19 with effect from 10th October, 1991 and the trade mark was inscribed on all the grinding stones ordered and supplied to the Respondent. The Respondent had in the course of the trading venture sold substantial quantities of "Super Rocket" grinding stones all over Nigeria and had acquired substantial reputation and good will in the trade mark. In December 1992, the Appellant imported consignments of grinding stones branded "Super Rocket" and distributed and sold them. Subsequent importation of the product by the Appellant was met with an Anton Pillar order by the Respondent which then sued the Appellant at the Federal High Court, Lagos claiming, *inter alia*, an injunction restraining the Appellant from infringing the said trade mark of the Respondent and passing off or causing, enabling or assisting others to pass off the said grinding stones of the Respondent.

The Appellant in response filed a motion on notice seeking to strike out the suit on the ground, *inter alia*, that the Respondent had no *locus standi* and its claim disclosed no reasonable cause of action.

It is pertinent to note that at the time the Respondent filed the suit, its application for registration of the trade mark "Super Rocket" was still pending and its earlier application for interlocutory injunction was refused by the Supreme Court per the earlier reported case of *Dyktrade vs. Omnia*[25] on the ground that an injunction to restrain the infringement of a trade mark could not be granted when the trade mark had not yet been registered. But by the time the Respondent filed its statement of claim in the instant suit the trade mark had been registered. The Federal High Court dismissed the Appellant's application and its appeal to the Court of Appeal was also dismissed.

On further appeal to the Supreme Court, the apex court considered the provisions of section 251(1) (f) of the 1999 constitution (as amended) and section 3 of the Trade Marks Act[26] and held that by virtue thereof, the Federal High Court was conferred with *exclusive jurisdiction* in matters relating to any Federal enactment on Copyright, Patent, designs, trade marks and passing off etc. Secondly, that section 3 of the Trade Marks Act qualifies as the Federal enactment referred to in Section 251 (1) (f) of the Constitution.

[24] (2007) 15 NWLR (pt. 1058) 576
[25] (2000) 12 NWLR (pt. 680) 1
[26] Cap 436 LFN 1990

Thirdly, that the Federal High Court has jurisdiction whether or not the claim arises from the infringement of a *registered or unregistered trade mark*[27]. Mukhtah JSC (as she then was) delivering the lead judgment of the court had this to say;

> Section 7(1) above re-affirms the jurisdiction conferred on the Federal High Court in respect of 'any civil causes and matters, arising from any enactment relating to trade marks.' It is to be noted that it did not include "passing off" and it did not say "arising from any Federal Enactment relating to". In respect of the general jurisdiction in passing off, the provision in section 230(1) of the 1979 Constitution prevailed so that after 1993, the Federal High Court had jurisdiction to entertain passing off actions arising from any Federal enactment.
>
> It is also a fact that Section 7 of the Federal High Court Act was amended by the Federal High Court (Amendment) Decree No. 60 of 1991 in the following provisions in as far as it concerns the subject matter in the present suit:
>
> 2 For section 7 of the Principal Act, there shall be substituted the following new section, that is-
>
> 7(1) The court shall to the exclusion of any other court have original jurisdiction to try civil causes and matters connected with or pertaining to-
>
> (f) any Federal enactment of common law relating to copyright, patents, designs, trade marks and passing-off, industrial designs….

With this amendment, the issue of common law, and passing-off was specifically introduced to the provision of section 7 of the Federal High Court Act reproduced in *Ayman's case supra,* and reproduced herein. The Federal enactment in the context of the issue under the Trade mark Act 1985, Cap. 436, Laws of the Federation of Nigeria, 1990, section 3 of which I have already reproduced *supra*.

In spite of the amendment, section 7 of the Federal High Court Act by the introduction and/or additions mentioned above, the Federal enactments still remain the said section 3 of the Trade Marks Act reproduced *supra* and which has not been amended. The fact that the old text of section 7 i.e. the federal Revenue Court was invoked for the purpose of looking for the jurisdiction of the High Court does not derogate from the fact that the enactment referred to and relied upon was the Trade Marks Act. The second part of the provision of section 3, which is another aspect of the provision, is very clear on the passing-off as it includes the right of any person to maintain an action against any passing off of goods as goods of another person, one of the grouse upon which the respondent's claim was predicated; (see paragraph 21 (b) of the statement of claim reproduced above) The Federal High Court therefore has jurisdiction to hear and determine the claim for passing-off, and I subscribe to the learned counsel for the respondent's argument that the said court has jurisdiction whether or not the claim arises from the infringement of a registered or unregistered trade mark.

It is pertinent to observe that although their other Lordships who sat in the above appeal had, in the usual manner, concurred with the lead judgment, none of the said justices lent any express voice to the above exposition nor made any comment at all regarding the interpretation of the said sections of the Constitution, the Federal High Court Act and the Trade Marks Act. The contributing judgment of the other justices in the appeal centered mainly on the fact that the trade mark in issue in the case was already registered by the time of the objection which said registration was duly pleaded in the statement of claim which superseded the writ of summons. It is therefore submitted that the pronouncement of Muktar JSC (as she then was) was with utmost respect, isolated and obiter.

In the more recent case of *Society Bic S.A. vs. Charzin Industries Ltd*[28] the Supreme Court per Rhodes-Vivour JSc merely made a passing remark that Section 230(1) (f) of Decree No. 107 of 1993 or Section 251 (1) (f) of the 1999 Constitution confers jurisdiction on the Federal High Court to hear civil causes and

[27] Italics for emphasis.
[28] (2014) All FWLR (pt. 239) 1212

matters relating to copyright, patent, designs, trade marks and passing off, industrial designs and merchandise marks etc.

4. Critique

It is the opinion of the writer that the decisions of the Supreme Court in the leading cases of *Patkun Industries Ltd., Ayman Enterprises Ltd and Omnia (Nig.) Ltd* as well as other like authorities concerning jurisdiction of the Federal High Court in passing off matters are hard to justify in the light of the clear provisions of the relevant statutes as well as established principles of common. It is submitted with utmost respect that the apex court in each of those leading authorities clearly misconstrued and misinterpreted the wordings of the relevant statutes particularly Section 3 of the Trade Marks Act. For purposes of clarity of argument the said provision of the Act is further reproduced hereunder thus:

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

It is accordingly submitted that to all intents and purposes, the said provision did not do more than affirm the option available to an aggrieved person under the extant common law right of passing off whose right of action may not be protectable under the Trade Marks Act on grounds of non registration. The said provision did not therefore create another type of passing off action known as "statutory passing off" as held by the Supreme Court and the other lower courts earlier referred to[29]. This is more so having regard to the fact that the Trade Marks Act did not make any further provision at all for the essential elements or ingredients of the so-called statutory passing off in like manner as the well established ingredients or elements of passing off under common law[30].

Secondly, the Trade Marks Act did not provide for any remedy for the so called statutory passing off supposedly created by it and indeed in nowhere else in the Act was the word "passing off" mentioned save in the said Section 3. Again, it is settled that jurisdiction and by extension, cause of action, is conferred expressly and not by implication[31]. If the draftsman of the Act intended to create a new cause of action in passing off different from the one established by common law, he would have done so in express terms. It is highly debatable that the framers of the Act intended to create a new cause of action in passing off different from the one existing under common law the proof of which will still be dependent on common law principles and not the provisions of the Act.

To further buttress this contention, reference is made to section 2 of the English Trade Marks Act 1994 sub-section (2) of which is very similar to Section 3 of the Nigeria Trade Marks Act but couched in clearer language.

It provides thus:

> 2 (1) A registered trade mark is property right obtained by the registration of the mark under the Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.
>
> 2. No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such, but nothing in this Act affects the law relating to passing off.

[29] See for instance *Patkun Industries case, Ayman Enterprises Ltd case, EXXON corporation's case* etc

[30] See *Perry vs. Truthfitt* (1843) 6 Beav 66' *Ervin Warnik vs. Townscend* (1979) A.CC 731 *Patkun Ind. Ltd. vs. Nigershoes Ltd. (supra)*

[31] Ansa v. R.T.P.C.N. (2008) All FWLR (Pt. 405) 1681 at 1701; Gov of Ekiti State v. Chairman Ilemeje L.G. (2006) all FWLR (Pt. 341) 1280 at 1294

According to Bambridge[32]

> The law of passing off and trade mark law have common roots and therefore are in many respects similar. Passing off is a tort and can be described as the common law form of trade mark law. The Trade Marks Act 1994 S. 2 (2) makes it clear that the law of passing off is unaffected by the Act. Business goodwill is protected by passing off and whilst this may be associated with a particular name or mark used in the course of trade, this area of law is wider than trade mark law in terms of scope of the marks, signs, materials and other aspects of a trader's get-up that can be protected.

It is therefore submitted that the above observation represents the true position of the law even in Nigeria. It is accordingly opined that it is absurd to say, as held by the Supreme Court in the *Patkun Industries case, Ayman Enterprises case* etc that a different cause of action in passing off of a registered trade mark is created by Section 3 of the Nigerian Act separate from and/or in addition to the right of action for infringement of the registered trade mark. This amounts to undue surplaussage since, as acknowledged by the courts, the same set of facts can give rise to both causes of action. It is also even more absurd and unconceivable to state as held by the Supreme Court in the Omnia Nig. Ltd's case that a right of action in passing off is created under Section 3 for passing off of an unregistered trade mark inspite of the clear words of the same section denying any right of action thereof for infringement of an unregistered trade mark. Such a construction, with utmost respect, amounts to reading into the Act, what is not contained therein.

It is similarly submitted that in the light of all that has been said above, the assertion of the Supreme Court that Section 3 of the Act qualifies as the Federal enactment on passing off within the ambit of section 7(1) (c) (ii) of the Federal High Court Act, section 230 (1) (f) of the 1979 Constitution as amended by Decree No. 107 of 1993 and section 251 (1) (f) of the 1999 Constitution cannot also be justified. The extant Trade Marks Act 1965 is clearly a law specifically dealing with registered trade marks. It is not an enactment relating to passing off and there is no indication therein, express or implied, that it is such. Mere passing reference to passing off in section 3 thereof does not constitute same into a Federal enactment relating to passing off as held by the aforesaid decisions.

5. CONCLUSION

It is obvious from the above analysis that there has been a consistent misconstruction of the relevant statutory laws relating to trade marks in Nigeria vis-à-vis the common law tort of passing off. This has resulted in the courts assuming and exercising jurisdiction outside the intendment of the statute i.e. the Federal High Court usurping the jurisdiction of the state High Court on passing off matter. Given the fundamental nature of the issue of jurisdiction, there is an urgent need for the relevant laws, especially section 3 of the Trade Marks Act, section 251 of the 1999 Constitution and section 7 of the Federal High Court Act to be amended to eliminate the confusion and controversy while the courts, especially the apex court, should in the meantime, give a proper construction of the law at the earliest opportunity.

[32] *Opt. cit* p. 598