

THE NIGERIAN JURIDICAL REVIEW

Vol. 11

(2013)

Articles	Pages
Criminal Law: What Remedy for the Consumer of Hospitality Services? ~ <i>Etefia E. Ekanem</i>	1
Protection of Consumers of Transportation Services under the Motor Vehicles (Third Party Insurance) Act in Nigeria ~ <i>Ebele L. Okiche</i>	19
Appraisal of the Jurisdictional Regime of the National Industrial Court Of Nigeria ~ <i>Anthony Nwazuoke & Chinedu Igwe</i>	39
Online Contracts in Nigeria: An Overview ~ <i>Edwin O. Ezike</i>	53
Jurisdiction in Actions for Infringement of Trade Marks and Passing-Off in Nigeria ~ <i>Chukwunweke. A. Ogbuabor & Sylvester N. Anya</i>	83
Is Environmental Protection Implicit in Planning Law? ~ <i>Emmanuel Onyeabor & Helen U. Agu</i>	115
Mortgage of Land as Security under the Land Use Act 1978 ~ <i>Dorothy E. Nelson</i>	137
Striking a Balance Between International Trade, Sustainable Development and Human Rights ~ <i>Damian U. Ajah & Chukwunweike A. Ogbuabor</i>	163



FACULTY OF LAW
UNIVERSITY OF NIGERIA, ENUGU CAMPUS

EDITORIAL COMMITTEE

General Editor

Professor Boniface O. Okere, Docteur d'Universite de Paris

Assistant Editor

Professor George. O. S. Amadi, LL.B, LL.M., Ph.D., B.L

Statute and Case Note Editor

Professor Ifeoma P. Enemo, LL.B., LL.M., Ph.D., B.L

Secretary

Dr. Edith Nwosu, LL.B., LL.M., Ph.D., B.L

Book Review Editor

Dr. Chukwunweike A. Ogbuabor, LL.B., LL.M., Ph.D., B.L

Book Review Editor

John F. Olorunfemi, LL.B., LL.M., B.L

Distribution Coordinator

Damian U. Ajah, LL.B., LL.M., B.L

NIGERIAN JURIDICAL REVIEW

VOLUME 11 (2013)

To be cited as: **(2013) 11 Nig. J. R.**

ISSN: 0189 - 4315

© Faculty of Law, University of Nigeria, Enugu Campus

CONTRIBUTIONS

The Journal welcomes articles in any area or related subjects for publishing considerations. Articles and correspondence should be forwarded to:

The General Editor,
Nigerian Juridical Review, Faculty of Law,
University of Nigeria, Enugu Campus, Enugu, Nigeria.
nigeriajuridical@unn.edu.ng, nigeriajuridical@yahoo.com

PUBLISHED BY
Faculty of Law, University of Nigeria,
Enugu Campus

PRINTED BY:
Sylva Prints, Enugu & Abuja
+234-08063978826; +234-08181610325
onyekasyivanus@yahoo.com; sylvanusonyekachi@gmail.com

JURISDICTION IN ACTIONS FOR INFRINGEMENT OF TRADE MARKS AND PASSING-OFF IN NIGERIA* ♦**ABSTRACT**

It is ordinarily thought, if not taken for granted, that original jurisdiction over trademarks and passing-off vests in the Federal High Court, to the exclusion of all other courts in Nigeria. Relevant statutory provisions¹ obviously support the exclusive jurisdiction of the Federal High Court on the subject. However, recent decisions from the apex court have not shown any consistency; and the questions are: are the statutory provisions governing this area of the law not clear enough to guide the court? How can these varying decisions of the Supreme Court be harmonized to ensure uniform development of judicial precedent in the legal system? The paper recommends that jurisdiction in passing-off should vest exclusively in the Federal High Court. Splitting jurisdiction between the Federal and the State High Courts leads to confusion, difficulty, high cost of litigation and multiplicity of actions with the concomitant uncertainty of judicial precedent in the legal system.

1. Introduction

Jurisdiction is the life wire of any court proceeding. Any action without jurisdiction no matter how well conducted must

* Chukwunweike Anukenyi Ogbuabor, Ph.D., BL, Senior Lecturer, Department of International Law and Jurisprudence, Faculty of Law, University of Nigeria, E-mail: chukwunweike.ogbuabor@unn.edu.ng or chukwunweikeogbuabor@gmail.com.

* Sylvester Ndubuisi Anya, Ph.D. candidate, LL.M., BL, Lecturer, Department of International Law and Jurisprudence, Faculty of Law, UNN. E-mail: sylvester.anya@unn.edu.ng or anyasyvester@yahoo.com.

¹ Example, s. 251(1)(f) of the Constitution of the Federal Republic of Nigeria 1999 (CFRN) as amended, s. 7(1)(f) of the Federal High Court Act Cap F12 *Laws of the Federation of Nigeria (LFN)*, 2004, and s. 3 of the Trade Marks Act Cap. T13 *LFN*, 2004.

eventually come to a nullity.² Jurisdiction is the authority of a court to decide a case. Jurisdiction is fundamental to the exercise of the judicial power vested in a court. Jurisdiction is the key that opens a court house for adjudication when it is present but locks it and bars the entrance of litigants when it is absent. Concomitantly, certainty of the court with jurisdiction over a particular matter is of fundamental importance to the litigating public. Parties who go to court presumably do so because they do not have any other option and they want their matter to be disposed off as quickly as possible. When controversy over which court has jurisdiction over a particular subject-matter takes the centre stage, the possibility of parties incurring unnecessary expenses and getting frustrated with the judicial system heightens. Loss of confidence in the judicial system can lead to a collapse of the system. It is as a result of this that the judgments of the Supreme Court should embody firm, unequivocal, time-tested and enduring principles of law especially as it relates to jurisdiction of courts for lower courts to follow. A situation where there is continued doubt over which court has jurisdiction in actions for infringement of trademarks and passing-off in Nigeria does not augur well both for the litigants, the economy and the general legal system.

Trademark and passing-off are two areas of the law that usually go hand in hand. They are like Siamese twins that can hardly be separated. With respect to the issue of jurisdiction, there has for some time now been controversy over which court has jurisdiction over these matters especially as it pertains to passing-off and aspects of trade mark. The result has been a splitting of jurisdiction over a matter(s) which ought not to be split. In *Patkun Industries Ltd. v Niger Shoes Ltd.*, the Supreme Court held that the Federal High Court has jurisdiction in both trademarks and passing-off stemming from infringement of trademarks, whether registered or unregistered.³ Fifteen years later, the same Supreme Court

² See *Funduk Engineering v McArthur* [1993] 4 NWLR (Pt. 392) 640 at 651.

³ [1988] 5 NWLR (Pt. 93) 138 SC. See particularly the judgment of Uwais JSC (as he then was) at pp. 158-159.

held in *Ayman Enterprises Ltd. v Akuma Industries Ltd.*,⁴ that the Federal High Court has jurisdiction over passing-off claims arising from infringement of a trademark only if the trademark allegedly infringed was registered, otherwise the High Court of a State will have jurisdiction. Yet again, the Court took a different approach in *Omnia (Nig.) v Dyktrade Ltd.*,⁵ where it held that the Federal High Court has exclusive jurisdiction in claim for passing-off whether the claim arises from the infringement of a registered or unregistered trade mark. *Patkum* was not referred to at all.

The objectives of this paper are to ascertain the nature, cause and extent of the conflict in these judgments of the court; to determine whether the perceived conflict is real or merely imaginary; and ultimately to find ways of harmonising the judgments to ensure uniform development of judicial precedent in the legal system. Attempt is made to identify a common string running through the decisions and use same as a guide to ascertain the trend and direction of the development of the law. The paper is divided into five parts. Part 1 is the introduction. Part 2 is an examination of the nature of trademarks and passing-off and the nexus between them. Part 3 is an overview of statutes guiding the subject matter. Part 4 critiques the judicial attitude to trademarks and passing-off in Nigeria. Part 5 concludes the paper.

2. Nature of Passing-off and Trade Marks

Passing-off is generally a common law tort. The wrong of passing-off is committed when a man sells or offers his goods or services for sale as though they are the goods of another. It is an actionable wrong whereby a person presents his goods or services as those of another in such a way as to cause the goods or services to be taken as those of that other person. In *Patkun Industries Ltd. v Niger Shoes Manufacturing Co. Ltd.*,⁶ Wali JSC observed rightly that the law of passing-off is founded on the

⁴ [2003] 12 NWLR (Pt. 836) 22 SC.

⁵ [2007] 15 NWLR (Pt. 1058) 576 SC.

⁶ [1988] 5 NWLR (Pt. 93) 138 SC at 162.

ordinary expression 'pass-off.' According to His Lordship, when it is said that something is passed-off as something else, it means no more than saying that the thing is falsely represented as something else.⁷ Section 3 of the Trade Marks Act⁸ employs the ordinary language expression and describes passing-off as 'rights of action against any person for passing off *goods* as the goods of another person'. In *Perry v Truefitt*,⁹ the basic underlying principle of a passing-off action is stated to be that 'a man is not to sell his own *goods* under the pretence that they are the goods of another man'. Another summation of passing-off is given by Lord Halsbury in *Reddaway v Banhan*,¹⁰ where he stated that: 'nobody has the right to represent his *goods* as the goods of somebody else'. When it had to determine what constitutes passing-off in *International Tobacco (Nig.) Ltd. v British American Tobacco (Nig.) Ltd.*,¹¹ the Court of Appeal stated that:

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 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 recollections of the one he likes to go by, he may not accept the other in mistake for it.¹²

Thus, passing-off connotes a misrepresentation of the goodwill in both goods and services, resulting in damage. The judicial or statutory definitions or descriptions of passing-off, which make it look as if this head of action protects only good and not

⁷ *Ibid.*, paras. F-G.

⁸ Cap. T13 LFN, 2004, s. 3.

⁹ [1842] 6 Beav. 66.

¹⁰ [1896] AC 199 HL.

¹¹ [2009] 6 NWLR (Pt.1138) 577 CA.

¹² *Ibid.*, p. 646, paras. E-G. See also *United Kingdom Tobacco Co. Ltd. v Carreras* [1931] 16 NRL 1, where the same constitution of the tort of passing-off was given.

services, are hopelessly incorrect. Passing-off properly connotes the complex concept of goodwill, misrepresentation and damage thereby suffered by the person whose goodwill is misrepresented. For instance, Mr. A manufactures bottled water in a 50cl plastic bottle of a specified shape and size with blue and white label and calls it 'Aqua Rafa'. Aqua Rafa has sold for years and gathered customers thereby acquiring goodwill. Subsequently, Mr. B begins to manufacture and sell bottled water of the same size, shape, colour of label and trade name. Mr. B is said in the circumstances to misrepresent the goodwill of Mr. A and if Mr. A suffers any damage as a result, he can sue Mr. B for passing-off.

Notwithstanding that passing-off is generally a common law cause of action, in Nigeria, in relation to trade marks, passing-off is not only of common law origin but also has a statutory basis. According to the court in *Patkun Industries Ltd. v Niger Shoes Manufacturing Co. Ltd.*, "the common law 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 1965."¹³ (sic) Passing-off action in Nigeria is thus a common law action preserved by section 3 of the Trade Marks Act. It is normally appropriate for the protection of unregistered trademarks or marks whose validity is questioned.

Trade mark, on the other hand, is the commercial signature of a manufacturer or trader with which his goods and services are identified and which distinguishes them from the goods and services of others. According to section 67 of the Trade Marks Act:

Trade mark means, 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

¹³ Note 5 above, per Karibi-Whyte at p. 152. See also Nnamani JSC at p. 157.

registered user to use the mark, whether with or without any indication of the identity of that person. . . .

This definition appears clumsy and fraught with a lot of complication. It can be criticized for being restrictive. The Supreme Court in *Ferodo Ltd. v Ibeto Industries Ltd.*,¹⁴ chose to ignore the complicating opening and closing clauses of the definition and stated that trade mark simply means '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 a proprietor or a registered user to use the mark'.¹⁵ *Black's Law Dictionary*¹⁶ gives a working definition of trade mark as:

A word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others. The main purpose of a trade mark is to designate the source of goods or services. In effect, the trade mark is the commercial substitute for one's signature.

Trade mark gives an indication to the intending purchaser as to the manufacturer and quality of the goods to be sold, to indicate by their appearance the trade source or trade hands through which they have reached the market. It is a distinctive picture which indicates to a purchaser of goods or services the means of getting the same article in the future. Once a trade mark is validly registered, it gives the proprietor the exclusive right to use the mark in marketing or selling his goods. If, without his consent, anyone else uses an identical mark or one so nearly resembling it as to be likely to deceive or cause confusion, the registered proprietor will be entitled to sue for infringement of trade mark.

From a cursory look at passing-off and action for infringement of trade mark, one gets the impression that they are the same. After all, they similarly protect intellectual and

¹⁴ [2004] 5 NWLR (Pt. 366) 317 SC.

¹⁵ *Ibid.*

¹⁶ B. A. Garner, *Black's Law Dictionary* (8th edn.,) (USA: Thomson West Publishing Co., 2004), p. 1530.

industrial property and prevent or punish a particular type of deception of the public.¹⁷ The signs and symbols that can be registered as trade marks, to wit: words, letters and numerals, devices, combination of any of the listed, coloured marks, three-dimensional signs, audible signs (sound marks), olfactory marks (smell marks) *etc.*, are the same that can constitute the get-up of goods or services protected by passing-off. A manufacturer or seller can register his name¹⁸ or a garnishing or alteration of his name¹⁹ as trade mark; the same can be the subject of protection of passing-off. Trade mark, just like passing-off, prohibits one using the name of another without authorisation in manufacturing or trade,²⁰ especially when the two persons are in the same line of business.²¹ Distinctiveness of the name or mark protected is the hallmark of both passing-off and infringement of trade mark. Goodwill, misrepresentation and damage forms the fulcrum of passing-off and these are more or less the essential elements of an action for trade mark infringement. The similarity is so much so that the same set of facts can give rise to action for infringement of trade mark as well as passing-off and the plaintiff can lay the claims alternatively. This state of affairs ordinarily suggests that the same court should have jurisdiction over trade mark and passing-off matters, but the Supreme Court has fallen short of reaching this conclusion.

Notwithstanding the close affinity between trade mark and passing-off, the two heads of action have strong

¹⁷ The parallel and coterminous lines of passing-off and infringement action have been identified elsewhere. See S. N. Anya, 'Aligning the Parallel and Coterminous Lines of Passing-off and Infringement Action', vol. II (2012) *Journal of Nigerian & Comparative Law*, pp. 13 – 16.

¹⁸ See *Parker-Knell Ltd. v Knell International Ltd.* [1962] KPC p. 2.

¹⁹ See *Short's Ltd. v. Short* [1911] 31 RPC p. 294.

²⁰ See *British Medical Association (BMA) v Marsh* [1931] 49 RPC 565.

²¹ *Ibid.* See also *McCulloch v Lewis A. May Product Distributors* [1947] 2 All ER p. 845. Contrast *British Legion v British Legion Club (Street) Ltd.* [1931] 18 RPC 555, where the court held that use of another's name is prohibited between persons not in the same line of business if the conduct of the defendant is nevertheless capable of jeopardising the reputation and business of the plaintiff.

distinctions, which, as we shall soon see, have been at the root of attempts to vest different courts with jurisdiction over each of them. Passing-off has common law origin whereas trade mark is purely a creation of statute—the Trade Marks Act. This distinction is also true of the law of India. In *Kaviral Pundit Durga Dutt Sharma v Navaratha Pharmaceutical Laboratories*,²² the Supreme Court of India examined this distinction between passing-off and trade mark infringement thus:

While an action for passing-off is a common law remedy being in substance an action for deceit, that is, passing-off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to use of the trade mark of the plaintiff. This is not essential in an action for passing-off, but is a *sine qua non* in the case of action for infringement.

The above represents the law as it stands in India, which seems to differ only subtly from the position in Nigeria. Section 3 of the Trade Marks Act incorporates passing-off; it provides that:

No person shall be entitled to institute any proceeding to prevent, or recover damages for, the infringement of an unregistered trade mark; *but nothing in this Act shall be taken to affect right of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.*²³

This very important and often-cited provision plays two roles in the jurisprudence of intellectual property in Nigeria. First, it provides that only registered trade mark can be the subject matter of action for infringement. And secondly, it gives statutory backing for the right of action against any person for passing-offs. The role of section 3 can be compared with that of the proverbial good parent, who flogs a child with his right hand and consoles it with the left. The first limb of the section

²² [1995] All India Report SC 980 at p. 990.

²³ Emphasis added.

bars passing-off from the protection of infringement action; but the second limb brings passing-off back into the fold of rights enforceable by the statute. Now that section 3 of the Trade Mark Act has entrenched passing-off in a statute, is it still absolutely right to say, as it is in India, that passing-off is a common law tort in Nigeria and to use that as a ground to distinguish it from trade mark? Or, are there now two aspects of passing-off: one having origin at common law and the other a creation of statute, with the two being in conflict? Where a statutory provision is in conflict or differs from common law, the common law yields to the statute. But a statutory right may be conferred in addition to, and not in derogation of a common law right.²⁴ This is exactly what section 3 of the Trade Marks Act has done. In addition to the common law right of action, the statute has in this section conferred an additional statutory right of action by preserving the common law right of action for passing-off. In *Patkun Industries Ltd. v Niger Shoes Ltd.*,²⁵ Karibi-White JSC, determining whether passing-off is a common law action or arises from statute, had this to say:

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 tort of passing-off in respect of other matters still exists, but in respect of trade marks. In this country, the right of action for passing-off relating to the infringement of registered trade mark is statutory and can be found only in section 3 of the Trade Marks Act.²⁶(sic)

This ratio is correct for a situation where it is claimed that a registered trade mark is being infringed, for then, the action for passing-off arising from the infringement of a registered trade mark will be founded on the Trade Marks Act. But when the name or mark being infringed is not registered, the ratio of Karibi-Whyte JSC is of no assistance. Thus, the strongest distinction between passing-off and trade mark appears to be

²⁴ See *National Assistance Board v Wilkinson* [1952] 2 QB 648.

²⁵ [1988] 5 NWLR (Pt. 93) 138 SC.

²⁶ *Ibid.*, p. 16-52, paras. G-H.

the fact of registration. If the trade name or get-up is registered, it vests a right enforceable by action for infringement of trade mark. If it is not registered, it only vests a right of action in passing-off. What then is the exact effect of registration?

The concept of registration is at the centre of the confusion surrounding the issue of court with jurisdiction in trade marks and passing-off. Registration simply means the requirement or act of the owner of a trade mark registering same with the Registrar of Trade Marks in the register of trade marks. Registration is necessitated by the fact that the right protected by trade mark does not accrue automatically to any person who manufactures goods, offers services, or trades with a mark. Unlike copyright that vests automatically, trade marks must be registered before the right protected by law can accrue.

Section 3 of the Trade Marks Act makes it compulsory for anyone who wishes to have the protection of the trade marks law to register his mark. Only a registered trade mark can be the subject of an infringement action. If the owner of a trade mark fails to register it, he will only be entitled to bring action and seek remedies under the tort of passing-off. Thus, registration or non-registration clearly distinguishes trade marks from passing-off, in the sense that it determines the specific cause of action the plaintiff will have in each circumstance. Ibrahim Tanko Muhammad JSC summed up the effect of registration in the case of *Omnia (Nig.) Ltd. v Dyktrade Ltd.*,²⁷ thus:

A trade mark, when registered, will entitle the proprietor to sue or institute an action for any infringement of the trade mark. Registration entitles the proprietor to the exclusive use of the trade mark and also a right to sue for passing-off the goods of the proprietor.²⁸

Inherent in this view is the fact that there are now two types of passing-off, indeed three, one relating to registered trade

²⁷ [2007] 15 NWLR (Pt. 1058) 576 SC.

²⁸ *Ibid.*, pp. 622-623, paras. G-H.

mark, another relating to unregistered trade mark, and yet another relating to common law tort of passing-off in respect of other matters. This is an unavoidable result of entrenching passing-off in section 3 of the Trade Marks Act. It speaks to a rather fine distinction which exists between infringement of a registered trade mark *per se* and passing-off as a separate cause of action. Where there has been full registration of a trade mark, the tort of passing-off that involves imitation of a trade or brand name seldom occurs without infringement of the right given by the trade mark registration taking place also.²⁹

This subtle distinction between trade mark and passing-off resulting from registration was extended by the Supreme Court in *Ayman Enterprises Ltd. v Akuma Industries Ltd.*³⁰ In this case the Court held that the Federal High Court has jurisdiction in cases involving registered trade marks whereas, the High Court of a State has jurisdiction where the trade mark involved is unregistered. In Part 4 of this paper, the role of registration in creating confusion over court with jurisdiction in passing-off and trade mark is criticized. For the moment, one needs the assistance of relevant statutes in this area of law as a guide to further ascertain the rationale for vesting jurisdiction on these heads of action.

3. Overview of the Statutory Frameworks for Trade Marks and Passing-off in Nigeria

Having reviewed the nature of passing-off and trade mark, the purpose of this part of the paper is to give an overview of the statutory provisions governing jurisdiction over these heads of action. Quite a number of statutes in Nigeria have provisions for the court with jurisdiction over action for infringement of trade marks and passing-off. The provisions appear to be sufficiently clear and should have been able to guide the courts in the country in developing uniform principle on the subject

²⁹ See *IRC International Ltd. v Jena Trading Co.* [1976] 2 Federal Revenue Court Report (FRCR) pp. 349-350, per Omo-Eboh J.

³⁰ *Supra.*

matter. But this has not been the case. A review of these statutory provisions at this stage will provide foundation for a critical analysis and full appraisal of the judgments of the Supreme Court undertaken in Part 4 of this paper.

The first relevant statutory guide on the subject is section 215(1) (f) of the Constitution of the Federal Republic of Nigeria (CFRN) 1999 as amended, (hereafter called “the 1999 Constitution”) which provides thus:

- (1) 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 causes and matters –
 - (f) (arising from) any Federal enactment relating to copyright, patent, designs, *trade marks and passing-off*³¹

Section 251(1)(f) of the 1999 Constitution succeeded section 230(1)(f) of the repealed Constitution of the Federal Republic of Nigeria 1979 (hereafter called “the 1979 Constitution”). In 1993, the then Federal Military Government amended section 230(1)(f) of 1979 Constitution by Decree No. 107 of 1993, which stated that:

- 230(1) 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 *or a Decree*,³² the Federal High Court shall have and exercise jurisdiction to the exclusion of any other court in civil causes and matters arising from:
 - (f) any Federal enactment relating to copyright, patents, design, *trade marks and passing-off*³³

³¹ Emphasis added.

³² Emphasis added.

³³ Emphasis added.

The only amendment made by Decree No. 107 of 1993 on this constitutional provision is the addition of the phrase 'or a Decree' after 'the National Assembly'. The import of the amendment is that the then Federal Military Government could, by a decree, add to the list of items within the jurisdiction of the Federal High Court stated in the provision. There would not have been need to state and review this provision here in addition to section 251(1)(f) of the 1999 Constitution but for the fact that section 230(1)(f) of the 1979 Constitution as amended by Decree No. 107 of 1993 was specifically applied in *Ayman Enterprises Ltd. v Akuma Industries Ltd.*³⁴ Section 230(1)(f) of the 1979 Constitution as amended by Decree No. 107 of 1993 and the effect of its application in *Ayman* is appraised in Part 4 of this paper on the divergent judgments of the Supreme Court on jurisdiction. It suffices now to say that comments made here below on section 251(1)(f) of the 1999 Constitution apply equally to Decree No. 107 of 1993.

This provision of the Constitution clearly vests the Federal High Court with exclusive jurisdiction over trade marks and passing-off. The provision makes no dichotomy between registered and unregistered trade marks. It does not say that action for passing-off shall be in the Federal High Court only when it pertains to a registered trade mark and to the High Court of a State when it concerns unregistered trade mark. The provision takes effect notwithstanding anything to the contrary contained in the Constitution. The clause 'and in addition to such other jurisdiction as may be conferred upon it by Act of the National Assembly' can serve to add to the exclusive jurisdiction of the Federal High Court in trade marks and passing-off, not subtract from it. Thus, statutes like the Trade Marks Act and the Federal High Court Act cannot subtract or remove anything from the exclusive jurisdiction of the Federal High Court in trade marks and passing-off granted by the Constitution. If they do, their provisions ought to be declared inconsistent with the provisions of the Constitution;

³⁴ *Supra* note 4 above.

the Constitution shall prevail, and the provisions of these other laws shall to the extent of the inconsistency be void.³⁵ This conclusion derives from section 1(1) of the 1999 Constitution, on the supremacy of the Constitution. Unfortunately, the courts, deciding cases on jurisdiction in trade marks and passing-off have not thought in the line of the supremacy of the Constitution on the issue.

Section 272(1) of the 1999 Constitution has also been instrumental in shaping the judgments of courts regarding court with jurisdiction in trade marks and passing-off. The section which is on the general jurisdiction of the High Court of a State, states that:

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

The effect of this provision is that any matter not included in section 251(1) of the 1999 Constitution for the jurisdiction of the Federal High Court shall fall within the general jurisdiction of the High Court of a State. Hence, those who argue that the Federal High Court does not have jurisdiction in action for passing-off based on unregistered trade mark readily rely on section 272 of the 1999 Constitution to “award” jurisdiction in such matter to the High Court of a State.

The courts have considered provisions of other statutes as key to determining the issue of jurisdiction. One of such statutes, which the courts have strenuously construed in this regard, is the Federal High Court Act,³⁶ originally enacted as the Federal Revenue Court Act of 1973. Section 7(1) (f) of the Federal High Court Act provides that the Federal High Court

³⁵ See s. 1 (3) of the 1999 Constitution as amended.

³⁶ Cap F12 *LFN*, 2004.

shall to the exclusion of any other court have original jurisdiction to try civil causes and matters arising from:

Any Federal enactment relating to copyright, patent, designs, *trade marks and passing-off*, industrial designs and merchandise marks, business names, commercial and industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards.³⁷

This provision and that of section 251(1)(f) of the 1999 Constitution reviewed above are couched in such a way that suggests they are intended to vest jurisdiction in all types of intellectual property in the Federal High Court, to the exclusion of all other courts. The manner in which *trade marks and passing-off* are listed, always linked together with the conjunctive 'and' even as the two appear in the middle of the list, suggests that the draftsman deemed them to be the same or inseparable items within the jurisdiction of the Federal High Court. If the courts had taken this clue, perhaps they would have been warned against splitting jurisdiction in trade marks and passing-off into separate courts for any reason whatsoever.

Those who are minded to argue that passing-off is essentially a common law action and should not come within the jurisdiction of the Federal High Court should appreciate the provisions of section 7(3) of the Federal High Court Act, which says that:

Where jurisdiction is conferred upon the Court..., such jurisdiction shall be construed to include jurisdiction to hear and determine all issues relating to, *arising from or ancillary to* such subject matter.

It is illogical, in the face of this provision, to say that a passing-off action based on an unregistered trade mark should not lie before the Federal High Court. For, even when the trade mark is not registered, the passing-off action relates to a trade mark all the same. Registration or non-registration should not derogate from the fact that the passing-off action arises from

³⁷ Emphasis added.

and is ancillary to the subject matter of trade marks, and thus brings passing-off within the jurisdiction of the Federal High Court, by the operation of section 7(3) of the Federal High Court Act.

Section 7(1) (f) of the Federal High Court Act quoted and discussed above is as it stands now. It is an amendment of the original text of the Federal Revenue Court Act of 1973. The text of the corresponding section 7(1) (c) (ii) of the 1973 Act reads:

- 7(1) The Federal Revenue Court shall have and exercise jurisdiction in civil causes and matters:
- (c) arising from:
 - (ii) any enactment relating to copyright, patents, designs, *trade marks* and merchandise marks.

It is to be noted that this earlier (now repealed) provision did not include 'passing-off' in the jurisdiction of the Federal Revenue Court and it did not say 'arising from any Federal enactment relating to' Therefore, cases decided between 1973 when the original Act was enacted and 26 August 1993, when the amended version took effect, might correctly have been to the effect that the Federal High Court lacked jurisdiction in action for passing-off.³⁸

In spite of the amendment to section 7 of the Federal High Court Act, the reference to "any enactment' or 'any Federal enactment' 'relating to', remains a reference to the Trade Marks Act, especially section 3, which has not been amended, and which provides that no person shall be entitled to institute any proceeding to prevent or to recover damage for, the infringement of an unregistered trade mark; *but nothing in this Act shall be taken to affect rights of action*

³⁸ S.7 of the Federal Revenue Court Act 1973 was amended by the Federal High Court (Amendment) Decree, No. 60 of 1991. Though the Decree was promulgated on 30 December 1991, it was suspended two days later by the Federal High Court (Amendment) Decree No. 16 of 1992, promulgated on 1 January 1992. Subsequently, on 25 August 1993, by Statutory Instrument No. 9 of 1993, 26 August 1993 was appointed as the date on which the Federal High Court (Amendment) Decree 1991 shall come into force.

*against any person for passing-off goods as the goods of another person or the remedies in respect thereof.*³⁹ This provision, which the courts invoke in almost every case on jurisdiction, surprisingly does not deal with jurisdiction. Rather, it deals with cause of action. Its application is to the effect that when a mark is registered, cause of action will accrue for infringement of trade mark; but when a mark is not registered, cause of action will accrue for passing-off. The true intendment and purpose of section 3 of the Trade Marks Act are that: no person shall sue for infringement of an unregistered trade mark; any person can sue for passing-off of an unregistered trade mark; and any person can sue for infringement and passing-off for a registered trade mark. Now, answer is provided, using judicial decisions, to the question: What effect does section 3 have on the constitution of cause of action and court with jurisdiction over passing-off and trade mark?

4. Judicial Attitude to Trade Marks and Passing-off

Registration is at the root of the divergence in judgments of the Supreme Court on the court with jurisdiction over passing-off and action for trade mark infringement. Three lines of authority are discernible; and it is to these three lines of authority that we turn to.

(a) The Federal High Court has Jurisdiction in Action for Passing-off Arising Out of Registered Trade Mark

In *Patkun Industries Ltd. v Niger Shoes Ltd.*,⁴⁰ the Supreme Court held that the Federal High Court has jurisdiction in action for passing-off of registered trade mark. In this case, the respondent, in November 1979 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 on his registered trade mark 'NISHMACO' and pass-off goods not of the respondent's manufacture or merchandise as

³⁹ Emphasis added.

⁴⁰ *Ibid.*

and for goods of the respondent's manufacture and merchandise and/or enabling others to do such act. The respondent also sought an injunction restraining the appellant from passing-off the goods and an account of the profits made by the appellant by reason of his having carried out the said act of infringement and passing-off or alternatively an enquiry as to damages. The defendants in their statement of defence denied passing-off the goods as those of the respondent. It was also averred, among other things, that at the hearing, the defendants would contend that the Federal High Court had no jurisdiction to entertain the suit and that it should be struck out. This 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 appeal to the Court of Appeal was also dismissed.

On further appeal to the Supreme Court, it was contended among other things, on behalf of the appellant that since action for infringement of registered trade mark is one cause of action and passing-off is a different cause of action and whereas the former is created by statute, namely section 3 of the Trade Marks Act, and passing-off is a common law cause of action not created by statute and does not arise from any enactment but common law, the Federal High Court has no jurisdiction in action founded on passing-off. The appellant further submitted that having regard to section 7(1)(c) (ii) of the Federal High Court Act, 1973, a joinder of infringement of registered trade mark and passing-off is not possible because although the Federal High Court has jurisdiction in respect of action for infringement of trade marks, it has none in respect of passing-off actions. Thus, the issue that arose for the determination of the Supreme Court was:

Whether the Federal High Court has jurisdiction to entertain a passing-off action when joined with an action for the infringement of registered trade mark?

In resolving this issue the Supreme Court considered section 7(1)(c)(ii) of the Federal High Court Act, 1973 and section 3 of

the Trade Marks Act. The lead judgment of the Court with which the other justices agreed resolved the issue in favour of the respondent, holding that the Federal High Court has jurisdiction to entertain a passing-off action when joined with an action for the infringement of registered trade mark. The court took the view that where a common law right has been enacted into statutory provisions, 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 the court:

A passing-off action arising from the infringement of plaintiff's registered trade mark..., its common law origin notwithstanding, is clearly within the jurisdiction of the court as a civil cause or matter arising from any enactment relating to trade marks ... as provided under section 7(1)(c)(ii) of the Federal High Court Act No. 13 of 1973. In this case it is section 3 of the Trade Mark Act.⁴¹

It concludes that on the whole analysis, the Federal High Court has jurisdiction in respect of an action for passing-off arising from infringement of plaintiff's registered trade mark since the passing-off and the infringement of the plaintiff's registered trade marks are matters from the same transaction which can conveniently be included in the writ of summons and can be tried together.⁴² Uwais JSC in his contribution to the judgment further held that the Federal High Court has jurisdiction in respect of passing-off arising out of unregistered trade mark even though no action can be brought in respect of the infringement of the unregistered trade mark itself.⁴³

This decision is emboldening in light of the fact that it was based on section 7(1)(c)(ii) of the Federal High Court Act 1973 which did not include passing-off in the list of matters over which the Federal High Court has jurisdiction. The court construed the phrase 'arising from' as having emphasis on the expression of legislative intention. Paragraph (c) under which sub-paragraph (ii) (trade marks) is, opens with the expression

⁴¹ *Ibid.*, p. 154, paras. B-C., per Karibi-Whyte JSC.

⁴² *Ibid.*, pp. 158-159, paras. G-B.

⁴³ *Ibid.*, pp. 158-159.

'arising from' and specifically relates to 'any enactment relating to'. Something arises from another when it is traceable to that other thing from which it is said to arise. Thus, where a cause of action is said to arise from any enactment, it means such cause of action derives from such enactment. Jurisdiction of the Federal High Court in registered trade marks is express and beyond doubt. Problem arises only when action in passing-off is joined with an action for the infringement of a registered trade mark. And the court in *Patkun* solved this problem by deriving from a combined reading of section 7(1)(c)(ii) of the Federal High Court Act 1973 and section 3 of the Trade Marks Act the principles that passing-off is an action arising from registered trade marks, so the Federal High Court should also have jurisdiction.

In other words, from the wording of the proviso to section 3 of the Trade Marks Act, read together with section 7(1)(c)(ii) of the Federal High Court Act, No. 13 of 1973, a statutory right of action for passing-off is provided. What is involved, at least as it relates to trade marks, is not the common law action of passing-off, but a statutory right of action. And in this case the Federal High Court will have jurisdiction.

The decision in *Patkun* is clear and devoid of contradiction. Once the trade mark in issue is registered, *Patkun* vests jurisdiction in the Federal High Court whether the action is one of infringement or passing-off or both. The Supreme Court did not apply the existing section 230(1) (f) of the 1979 Constitution in *Patkun*. If it did, it would still have come to the same conclusion, since that constitutional provision expressly includes passing-off as an item within the jurisdiction of the Federal High Court.

With respect to the court that would have jurisdiction where the trade mark in issue is not registered, *Patkun* offered limited assistance. In *Patkun*, Uwais JSC (as he then was) had held as follows:

It is not in doubt that the federal high court has jurisdiction to hear cases of alleged infringement of registered trade marks by virtue of the provisions of section 3 of the 1965 Act

read together with the provisions of section 7 (1) (c) (ii) of the Federal Revenue Court Act, 1973. It is also not in dispute that there cannot be an action for the infringement of an unregistered trade mark by virtue of the provisions of section 3 of the 1965 Act. However, where the infringement of the unregistered trade mark leads to the tort of passing-off, the 1965 Act allows an action to be brought in respect of the passing-off. The flaw in the argument on behalf of the appellant that the federal High Court lacks jurisdiction in passing-off actions can be seen in the fact that first, section 71cii of the 1973 Act which vests jurisdiction in the Federal High Court, does not distinguish between the infringement of registered trade mark and unregistered trade mark. It simply talks of “enactment on trade marks.” So that infringement of registered trade mark and unregistered trade mark could have been the subject of suit in the Federal High Court. But the limitation provided by the 1965 Act is that no action for the infringement of unregistered trade mark can be brought except an action for passing-off which stems from such infringement. Secondly, the 1965 Act does not state which court is vested with jurisdiction to entertain cases of passing-off.

The import of the above passage is that the Federal High Court has jurisdiction in passing-off arising out of unregistered trade mark even though the court has no jurisdiction in the case of infringement of unregistered trade mark. The judgment of Uwais JSC went further than the lead judgment of Karibi-Whyte JSC. The above passage means no more than that the Federal High Court has jurisdiction to entertain cases of passing-off arising out of unregistered trade mark, especially in the light of the fact that the 1965 Act did not state which court is vested with jurisdiction to entertain cases of passing-off. None of the justices who sat on *Patkun* disagreed with Uwais on the above judgment. The problem with the dicta from Uwais JSC is that the issue of court with jurisdiction for passing-off arising out of unregistered trade mark did not directly arise for decision in *Patkun*. Thus, it is arguable whether that piece of holding is an obiter or not. Assistance on this issue can only be sought from the cases that came

subsequently to the Supreme Court, in which the Supreme Court extended the *Patkun* ratio.

(b) The Federal High Court has Jurisdiction in Action for Passing-off Arising out of a Registered Trade Mark and a High Court of a State for Passing-off Arising out of Unregistered Trade Mark

Fifteen years after *Patkun* was decided, the Supreme Court had another opportunity to advance the law in *Ayman Enterprises Ltd. v Akuma Industries Ltd.*⁴⁴ In the latter case, the plaintiff, owner of an unregistered trade mark 'New Queens', sued the defendant, owner of another unregistered trade mark 'Original Queens', in the Federal High Court, Lagos. Both parties were engaged in the trade or business of selling or offering for sale wigs and hair attachments. The plaintiff claimed, in the main, orders of injunction and damages for passing-off his trade mark, which was not yet registered. The lone issue in the appeal before the Supreme Court was:

Whether the Federal High Court has jurisdiction to entertain the appellant's claim for damages for passing-off of an unregistered trade mark?

To determine this issue, the Court considered section 230(1)(f) of the 1979 Constitution as amended by Decree No. 107 of 1993, section 7(1)(c)(ii) of the Federal High Court Act, 1973⁴⁵ and section 3 of the Trade Marks Act. The court found that by the provision of section 230(1)(f) of the 1979 Constitution as amended by Decree No. 107 of 1993, the Federal High Court alone has exclusive jurisdiction to entertain all civil causes and matters arising from Federal enactment relating to any of the matters mentioned in the section,⁴⁶ which includes trade marks and passing-off. This finding is tantamount to saying

⁴⁴ *Ibid.*

⁴⁵ It was wrong for the court to base its decision on this provision which had been repealed and amended by the new text of s. 7(1)(f) of the Federal High Court Act No. 60 of 1991.

⁴⁶ *Ayman, supra*, per Kalgo, JSC, p. 45, para. B.

that the Federal High Court has jurisdiction in passing-off whether or not the trade mark involved is registered. But the court stopped short of saying so.

The Court wrongly applied section 7(1) (c) (ii) of the Federal High Court Act of 1973 instead of the new section 7(1)(f) of the Federal High Court (Amendment) Decree No. 60 of 1991 then applicable. It found that the section reaffirms 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 noted that the section did not include passing-off and it did not say 'arising from any Federal enactment relating to'. The Court also found that in respect of the general jurisdiction in passing-off; the provision in section 230(1)(f) of the 1979 Constitution prevailed so that after 1993, the Federal High Court has jurisdiction to entertain passing-off actions arising from any Federal enactment.⁴⁷ With this finding the Supreme Court once again came close to but fell short of holding that the Federal High Court had jurisdiction in action for passing-off based on infringement of trade mark whether registered or not. Of course, one is not surprised at this, since the Supreme Court applied the wrong law⁴⁸ it was bound to come to a wrong decision.

The Court finally found that all the references in both the Constitution and the Federal High Court Act to 'any Federal enactment' were to section 3 of the Trade Marks Act.⁴⁹ The Court considered the section and found that it is divided into two distinct parts. The first part prohibits the institution of any action for the infringement of an unregistered trade mark. The second part preserves the right of action against any person for passing-off goods as the goods of another. The court held it to be trite that a plaintiff in an action for passing-off founded

⁴⁷ *Ayman, supra*, p. 45, paras. E-K.

⁴⁸ The Court wrongly applied section 7(1) (c) (ii) of the Federal High Court Act of 1973 instead of the new section 7(1)(f) of the Federal High Court (Amendment) Decree No. 60 of 1991 then applicable. It also applied s. 3 of the Trade Marks Act (which is basically a provision on right of action) as though it was a jurisdiction vesting provision.

⁴⁹ Quoted above,

on a trade mark must prove that the trade mark is registered. Otherwise, section 3 will not be applicable.

The Court referred to its previous judgment in *Patkun*.⁵⁰ It found that the total effect of the judgment in *Patkun* is that the Federal High Court will only have jurisdiction to entertain an action for passing-off arising from an infringement of a registered trade mark and the action must have arisen in relation to a Federal enactment.⁵¹ The court distinguished *Patkun* from *Ayman* on the ground that while the trade mark in issue in *Patkun* was registered, the one in *Ayman* was unregistered 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. Kalgo, JSC, who read the lead judgment in *Ayman*, put it thus:

In the instant case, the passing-off right of action did not arise from the infringement of any Federal enactment and so may only be a common law right. Therefore, the Federal High Court would not have any jurisdiction under section 230(1)(f) of the 1979 Constitution or section 7(1)(c)(ii) of the Federal High Court Act 1973 to entertain the passing-off action instituted by the appellant in the instant case The Court of Appeal was wrong when it said in the leading judgment that 'the Federal High Court is eminently competent to adjudicate on the matter "....The trial Federal High Court has no jurisdiction to entertain this case.⁵²

In other words, 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; if it is not registered, action can only be brought for the tort of passing-off in the High Court of a State. In *Ayman Ent Ltd v Akuma Ind. Ltd*, the Supreme Court clearly limited the jurisdiction of the Federal High Court on passing-off claims to claims where the trade mark allegedly infringed is registered. This judgment impliedly overruled the judgment of Uwais JSC

⁵⁰ *Ayman, supra*, p. 45, para. F.

⁵¹ *Ibid.*, p. 49, paras. G-H.

⁵² *Ibid.*, p. 50, paras. B-E.

(as he then was) in *Patkum Ind. Ltd v Niger Shoes Ltd*. In the later judgment in *Ayman Ent. Ltd v Akuma Ind. Ltd*, Uwais CJN made a volte face and held as follows:

It seems to me that jurisdiction of the Federal High Court to deal with actions on passing-off depends on the registration of trade marks as provided by section 3 of the Trade Marks Act, Cap. 436 and section 230 sub-section (1) (f) of the 1979 Constitution. Where trade mark is unregistered, as in the present case, then the cause of action for passing-off is in common law for tort and action can now be brought in a State High Court in view of the provisions of section 272 sub-section (1) of the 1999 Constitution.

No reason was given by the learned CJN for the change of opinion. The decision in *Ayman* no doubt went farther than *Patkum*. However, both can be reconciled on the basis that *Patkum* was decided in 1988 under the 1979 Constitution at a time when the Federal High Court and State High Courts shared concurrent jurisdiction.⁵³ So, the Supreme Court was careful to vest the Federal High Court with “jurisdiction” (not exclusive jurisdiction) to entertain cases of passing-off arising from unregistered trade marks. When the Federal Government enacted Decree No. 107 of 1993, and consequently amended the Constitution to vest exclusive jurisdiction on the Federal High Court on the matters mentioned thereof including trade marks and passing-off, it became pertinent to streamline the jurisdiction in respect of passing-off actions arising from registered and unregistered trade marks. While the former vested exclusive jurisdiction in the Federal High Court, the latter now vested in the State High Court. Even then, one would have thought that by vesting exclusive jurisdiction in the Federal High Court on trade marks and passing-off, His Lordship would have been emboldened to pursue the course he established in *Patkum*. It is unfortunate that His Lordship

⁵³ See Ifeoma Enemo, “Savannah Bank of Nigeria Ltd v Pan Atlantic Shipping, etc,” *The Nigerian Juridical Review*, Vol. 4, (1989-90) 156-159 at 158.

allowed the opportunity to slip by and it had to take the intervention of their Lordships in *Omnia* to set the law aright.

With this judgment of the Supreme Court, *Ayman* marked itself as the first in the line of cases distorting the simple and straightforward principles of law governing courts with jurisdiction in trade marks and passing-off. The first blunder of the court in *Ayman* is that it applied the wrong law—section 7(1)(c)(ii) of the Federal High Court Act of 1973 instead of the applicable section 7(1)(f) of the Federal High Court (Amendment) Decree No. 60 of 1991—in the case. The difference between the two provisions is that section 7(1)(c)(ii) excluded passing-off from the list of items in which the Federal High Court has jurisdiction, whereas section 7(1)(f) now included it. If the court had applied the correct law, its decision would definitely have been the opposite.

Another flaw in the judgment in *Ayman* was the reading of jurisdiction into section 3 of the Trade Marks Act, which is fundamentally a principle of cause of action.⁵⁴ The court misapplied the effect of non-registration and arrived at a bizarre conclusion not contemplated by the section. It extended the decision in *Patkun* beyond its ambits and held that the High Court of a State has jurisdiction in passing-off action founded on unregistered trade mark—a point that was never made in *Patkun*. Is *Ayman* the law in Nigeria as it stands today? Or, has the Supreme Court in a subsequent case retracted or further delineated the ambits of its decision in *Ayman*? The paper turns to the last case in the series.

⁵⁴ This trend was initiated in *Patkun*. See the judgment of Nnamani JSC in *Patkun* at p. 159 where his Lordship held that s. 3 of the Trade Marks Act read together with s. 7(1) (c) (ii) of the Federal High Court Act of 1973 gave a statutory right of action for passing-off and “this to my mind is sufficient to dispose of the matter of jurisdiction.”

(c). *The Federal High Court has Jurisdiction in Action for Passing-off Arising out of or relating to Trade Mark whether registered or unregistered*

Four years after *Ayman* was decided, the Supreme Court saw the need to harmonise its decisions on this subject and did so in the case of *Omnia (Nig.) Ltd. v Dyktrade Ltd.*⁵⁵ In this case, sometime in 1989, the respondent initiated a trading venture with an Italian company to manufacture grinding stones for the washing of terrazzo floors. The respondents adopted the trade mark 'Super Rocket' for the grinding stones which it registered in Nigeria with effect from 10 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 goodwill in the trade. In December 1992, the appellant imported consignments of grinding stones branded 'Super Rocket' and distributed and sold them. The appellant again imported another set of grinding stones branded 'Super Rocket' but the respondent claimed that the use of 'Super Rocket' infringed its registered trade mark and that the appellant was guilty of passing-off its grinding stones as and for the respondent's products, and that consequently the respondent's sales declined and it suffered loss and damage. The respondent therefore sued the appellant at the Federal High Court, Lagos and claimed injunction and damages.

It should be noted that the respondent's application for registration of the 'Super Rocket' was still pending when it first sued the appellant. Its application for interlocutory injunction was refused by the Supreme Court in *Dyktrade v. Omnia*,⁵⁶ on the ground that an injunction to restrain the infringement of a trade mark could not be granted when the trade mark claimed has not yet been registered. However, during the pendency of

⁵⁵ [2007]15 NWLR (Pt. 1058) 576 SC.

⁵⁶ [2000] 12 NWLR (Pt. 680) 1.

Omnia v Dyktrade,⁵⁷ the trade mark in issue was fully registered. One of the issues before the Supreme Court for determination was:

Whether the Court of Appeal was right in holding that the Federal High Court had jurisdiction to entertain a claim upon an *unregistered* trade mark?

To resolve the issue, the Court considered the provisions of section 251(1)(f) of the 1999 Constitution, section 7(1)(f) of the Federal High Court Act and section 3 of the Trade Marks Act. The Court found that section 251(1)(f) thereof confers on the Federal High Court jurisdiction to hear and determine not only matters stipulated in subsection (f) but that the court can exercise other jurisdiction as may be conferred upon it by an Act of the National Assembly.

The Court avoided the mistake it made in *Ayman*—applying section 7(1)(c)(ii) of the Federal High Court Act 1973 when same had been repealed. Rather, the Court in *Omnia* applied the correct provision, that is section 7(1)(f) of the Federal High Court (Amendment) Act No. 60 of 1991. This later provision specifically listed passing-off as one of the subject matters within the jurisdiction of the Federal High Court. So the court arrived at the correct judgment that the Federal High Court has jurisdiction in passing-off.

Also, the Court in *Omnia* found that the Federal enactment to which references were made in the Constitution and the Federal High Court Act was the Trade Marks Act, specifically section 3. The Court applied section 3 of the Trade Marks Act solely as a principle of cause of action, not jurisdiction. It therefore avoided the mistakes of *Patkun* and *Ayman* which had extended the effect of non-registration to be a vesting of jurisdiction in the High Court of a State. Thus, Aloma Mariam Muktar, JSC (as she then was), who read the lead judgment of the Court in *Omnia*, stated that:

By virtue of section 215(1)(f) of the 1999 Constitution, the Federal High Court is conferred with exclusive jurisdiction in

⁵⁷ See footnote 6.

matters relating to any Federal enactment on copyright, patents, designs, trade marks and passing-off etc. *The Federal High Court therefore has jurisdiction to hear and determine the claims for passing-off. The Federal High Court has jurisdiction whether or not the claim arises from the infringement of a registered or unregistered trade mark.*⁵⁸

With this judgment, the Supreme Court was able, at last, to state the law as it correctly is. The wisdom of the Court was brought to bear in this judgment to fill in the omission and correct the mistakes in its earlier decision in *Ayman* on the subject.

Indeed, the decisions in *Patkun* and *Ayman* were respectively too narrow and incorrect. *Patkun* was a pick and choose approach, whereby the Supreme Court applied the law partially to registered trade marks, leaving the issue of unregistered trade marks open for *Ayman* to make a wrong input. *Ayman* was decided *per incuriam*, as the court applied the wrong text of the Federal High Court Act and came to the wrong conclusion. Both *Patkun* and *Ayman* are not supportable for reading a dichotomy of registered and unregistered trade marks into section 230(1) (f) of the 1979 Constitution and thereby wrongly shoving passing-off of unregistered trade marks out of the jurisdiction of the Federal High Court.

The constitutional provision includes passing-off as one of the matters within the jurisdiction of the Federal High Court. It is without qualification, in the sense that it is not made conditional to the passing-off being in respect of a registered trade mark. It is couched in a general form to be all embracing. That being the case, it cannot really be argued with any seriousness that it did not confer untrammelled jurisdiction on the Federal High Court in passing-off.

Again, the Court in *Patkun* and *Ayman* was wrong to have read section 3 of the Trade Marks Act, which is fundamentally a principle of cause of action, as governing jurisdiction and came to wrong, divergent conclusions. The

⁵⁸ *Omnia (Nig.) Ltd. v Dyktrade Ltd.*, *supra*, pp. 601, para. E; 603-604, paras. H-A; 606, para. B.

Court did really speak out of both sides of the mouth when it held in *Ayman* that only passing-off action based on registered trade mark can lie at the Federal High Court, and held in *Omnia*, that passing-off action can lie at the Federal High Court whether based on registered or unregistered trade mark.

The reason for the equivocation is not clear but it appears that the court wrongly applied the provisions and the wrong application apparently arose from wrong use of language. The use of language by the court is not encouraging. One does not pass off trade marks. One either infringes or does not infringe another's trade mark. On the other hand, one either passes off goods or does not pass off his goods as the goods of another. It is quite possible that this confusion in language has helped considerably in leading to confusion in thought and real conflict in the judgments of the Supreme Court on the subject matter. Its practical effect was to divide one cause of action into two and vest jurisdiction in two different courts with the concomitant difficulty, extra expense and multiplicity of action. It made litigation cumbersome for litigants, lawyers and the court. It is in the light of this that the judgment in *Omnia* is commendable for harmonising the varying decisions to ensure uniform development of judicial precedent in the legal system. These authors hope that the Supreme Court sticks to the ratio in *Omnia* for the courts below to follow.

5. Conclusion

This paper finds that despite the clear provisions of relevant statutes vesting jurisdiction in passing-off and trade mark in the Federal High Court, the Supreme Court has given conflicting decisions on the subject matter. The court appears to misconstrue the effect of registration and on that footing confuse the issue of jurisdiction. However, *Omnia* has at last correctly decided that the Federal High Court, to the exclusion of all other courts, has original jurisdiction in action for infringement of trade mark, and passing-off whether the mark in issue is registered or unregistered.

It is recommended that the Supreme Court should stick to the *Omnia* decision. The splitting of passing-off jurisdiction into Federal High Court for registered and High Court of a state for unregistered trade mark is an invitation to confusion. It is not supported by relevant, applicable statutes. It is better to vest this jurisdiction in one court—the Federal High Court—to the exclusion of other courts. Granted that section 3 of the Trade Marks Act gives two different causes of action for passing-off, one based on registered and the other on unregistered trade mark, the two can still come within the jurisdiction of only the Federal High Court, as they arise from the same transaction. It is trite 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.⁵⁹ The infringement of trade mark and passing-off of goods always naturally arise from the same transaction. They can therefore be tried together in one court.

The Supreme Court has wittingly or unwittingly created a distinction between passing-off relating to trade marks (registered or unregistered) and other kinds of passing-off. While the former would vest in the Federal High Court, the latter would vest in the State High Courts as a common law tort of passing-off. This is the direct consequence of the holding in *Patkum* to the effect that “the common law tort of passing-off in respect of other matters still exist but in respect of trade marks, in this country, the right of action of passing-off relating to the infringement of registered trade mark is statutory and can be found only in section 3 of the Trade Marks Act, 1965.”⁶⁰ This decision has not been overruled. So, it is still extant. The decision in *Omnia* is a welcome decision. A look at all the items in section 251 (1) (f) of the 1999 Constitution as amended shows that the intention of the draftsman must have been that passing-off by whatever name called should vest on the Federal High Court. If the principle of interpretation is *noscitur a sociis*, then, the company of the words kept by “trade marks and passing-off” in section 251 (1) (f) of the Constitution 1999

⁵⁹ See *Edilit Ltd. v Elias Khawam Ltd.* [1966] NMLR 289.

⁶⁰ *Patkum Ind. Ltd v Niger Shoes Ltd*, p. 152.

shows conclusively that the intention was to reserve exclusive jurisdiction to the Federal High Court for passing-off actions irrespective of the nature of the passing-off. *Omnia* has the effect of re-affirming the position taken by Uwais JSC in *Patkum* but which position His Lordship appeared shy of pursuing in *Ayman v Akuma*. However, *Omnia* did not address the question of other kinds of passing-off, i.e. passing-off not arising from infringement of a trade mark. The court would do well to use the earliest possible opportunity to bring in such actions within the purview of the exclusive jurisdiction of the Federal High Court. The reason is that passing-off is passing-off whether it relates to trade marks, design, get-up or any other matter relating to goods. The present distinction between passing-off relating to trade marks and passing-off relating to other matters is manifestly unsupportable. Mukhtar JSC (as he then was) in *Omnia* came close to resolving this question but then, it is yet not clear. According to His Lordship:

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...⁶¹

The dicta by Mukhtar JSC is susceptible to at least two interpretations. First, it could mean that the Federal High Court has jurisdiction in that particular case because passing-off was tied to trade mark. Secondly, it could also mean that the Federal High Court has jurisdiction simpliciter in all cases of passing-off whether founded on trade marks' infringement or not. The apex court needs to resolve this as soon as possible. If business name is a matter within the exclusive jurisdiction of the Federal High Court, there is no reason why passing-off by whatever name called should not be within the exclusive jurisdiction of the Federal High Court.

⁶¹ *Omnia*, pp. 605-606.