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Has the Controversy on the Jurisdiction of Federal High Court over Unregistered Trade Marks Matters Finally Been Resolved?

M.J. Umaru*
Bridget Anigbogu**
Halima Doma***

Abstract

The uncanny characteristics of unregistered trade marks (TM) and its enforceability in Nigerian courts leave a wild imagination as to its legal protection and the appropriate court to seek redress and enforcement. Not only is the status of unregistered TM shaky, there is also the question as to which court can enforce same. Thus, the coordinate adjudicatory powers of the Federal High Court and the State High Court have been put to test in this instance. A joint reading of the Nigerian Constitution and the Trade Marks Act seem to have robbed the Federal High Court of its exclusive or unilateral original jurisdiction to hear and determine TM cases in general. Yet, these statutory provisions enjoin divergent judicial pronouncements for and against the courts in issue. This paper reviewed the statutory provisions on trademarks and passing off as well as the Supreme Court decisions on the issue with a view to determining whether the apex court has overruled itself in its earlier decisions, now generally conferring exclusive jurisdiction on Federal High Court, in respect of all matters relating to trademarks and passing off particularly for non registered TM. The paper concluded that the latest pronouncement of the Supreme Court on the issue was predicated on the subsisting and applicable law then as well as the peculiar facts of the case and, therefore, not a clear departure from its earlier position on unregistered trademarks.

Key words: Unregistered, Trademarks, Passing off, Jurisdiction, Nigeria.

1. Introduction

* Professor of Law, Faculty of Law, BAZE University, Abuja. Email: mjumar09@gmail.com.

**PhD, Senior Lecturer, Faculty of Law, BAZE University, Abuja. Email: bridget.anigbogu@yahoo.com.

*** PhD, Senior Lecturer, Faculty of Law, BAZE University, Abuja. Email: halimsi@yahoo.com.

That the Federal High Court's exclusive jurisdiction to entertain any matter in respect of registered trade mark has never been in doubt, the same cannot be said of matters arising from unregistered trademarks. There have been a lot of arguments for and against the Federal High Court's jurisdiction over matters or disputes arising from unregistered trade mark. This is notwithstanding the constitutional and other statutory provisions and judicial pronouncements by the apex court on the same issue. This is as a result of mainly the apex court's interpretation of section 3 of Trade Marks Act and what some consider as irreconcilable provisions of section 3 of the Act and section 251(1) of the Constitution of the Federal Republic of Nigeria, 1999.

The aim of this paper, therefore, is to discuss the relevant constitutional and other statutory provisions and some of the Supreme Court decisions on the issue, with a view to determining whether the two provisions are really irreconcilable as well as whether the jurisdiction of the Federal High Court is elastic enough to cover matters arising from unregistered trade mark, against the backdrop of the Supreme Court decision in the case of *Omnia Nigeria Ltd v Dyke Trade Ltd*.¹ But before discussing the statutory provisions, it is considered necessary to state briefly what is meant by the key terms 'unregistered trademarks', 'passing off' and 'jurisdiction' so as to appreciate the discussion, by those who are not conversant with the terms.

2. Unregistered Trade Mark/Passing Off

Unregistered trademarks are those marks that have not been registered and therefore, not on the register at the Trade Marks Registry.² For the fact that these marks are not on the register does not make them less a trademark, this is because the law does not make registration of a trade mark mandatory and the choice as to whether to or not to register a trade mark is therefore entirely left to the owner of the trade mark to make. However, where a trade mark is unregistered, such a trade mark is usually regulated in Nigeria by the common law. Unregistered trade mark attracts some measure of protection by way of an action for passing off, which is now, as we will see later in this paper, preserved under section 3 of the Trade Marks Act. When

¹ (2007) 15 NWLR (Pt.1058) 576.

² Section 67(1) which is the interpretation section of the Nigerian Trademarks Act, defines registered trademarks as marks actually on the register.

there is a breach of the rights conferred on an unregistered trade mark owner, he may not be able to sue and collect damages for infringement, to prevent infringement of his unregistered trade mark or recover attorney's fees, but he may sue for passing off.³ And obtain remedies. This means that he cannot take any precautionary steps to prevent the breach of his right but to wait until his right in respect of the trade mark is actually violated before he can swing into action.

Passing off is an unfair competition by misrepresentation aimed at causing confusion or deception in the course of trade. It is the act or an instance of falsely representing one's own product as that of another in an attempt to deceive potential buyers.⁴ In other words, it is an actionable tort which occurs where a trader, in order to deceive consumers of his class of goods, presents his goods in such a way as to suggest that the said goods come from a more established and more patronized manufacturer or trader (or any other trader, for that matter), with a view to swaying the customers into believing that the said goods are produced by the latter person or manufacturer. In the case of *Ogunlende v Babayenu*,⁵ the plaintiff carried on business as civil engineering contractors and plumbers under the name of 'Mercury Builders'. The court granted an injunction restraining the defendant from conducting a similar business under the name of Mercury Builders Nigeria Ltd, since the defendant's company name is calculated to deceive due to its similarity with the name of the plaintiff. This case illustrates an element of passing off which is a calculated attempt to deceive unsuspecting public into believing that the business is the same as that of the plaintiff. In like manner, in the case of *U.K. Tobacco Co, Ltd v Carreras Ltd*,⁶ the defendants marketed cigarette called 'Barrister' in packets on which appeared a white man in a barrister's wig and gown. The court held the defendants liable for actionable imitation of the get-up of the plaintiff's cigarette called 'bandmaster' whose packet featured a white man in band master's uniform. Also, in *Defacto Works Ltd v Odumotun Trading Co Ltd*,⁷ the defendants were held liable in passing off. They sold bread wrapped in yellow and brown paper with the name 'Odus' written in large scroll letters in chocolate colour, this being an imitation of the get-up

³ See section 3 of the Trade Marks Act.

⁴ Garner B.A., *Black's Law Dictionary* (Dallas, West Thomson Law Press Inc, 2009) p.1233.

⁵ (1971) 1 U.I.L.R. 417

⁶ (1931) 16 N.L.J

⁷ (1959) L.L.R. 33

of the plaintiff's bread, which for sometime previously had been wrapped in yellow and brown paper with the name 'Defacto' written in large chocolate coloured scroll letters. The calculated attempt to deceive and the misrepresentation of the plaintiffs' goods and get-ups by the defendants in the above cases illustrate what passing off entails. The defendants' motive obviously, is to benefit from the goodwill or reputation of the plaintiffs without consent and to their detriments.

This Common law tort of Passing Off is usually made of three basic elements: misrepresentation; reaping the goodwill/reputation of a competitor without his consent; and damaging the reputation of the competitor, more often than not, with inferior product. Notwithstanding that passing off is generally a common law cause of action in Nigeria in relation to trademarks, passing off is not only common law origin, but it also has a statutory basis. Consequent upon its statutory basis, passing off is generally provided for by section 3 of the Trade Marks Act, which will be discussed shortly. However, it is to be noted that while the right to institute an action to prevent or to recover damages for infringement is exclusive to a registered trade mark, the right of action for passing off is not limited to unregistered trade mark. This is because the right is also available to owners of registered trade mark to prevent passing off of the packaging or get-up of a product, which are often unregistered features of registered trademarks. The case of *Trebor Nigeria Ltd v Associated Industries Ltd*⁸ is illustrative of what this right entails. In this case, the plaintiff sued for both infringement of its registered trade mark and also for passing off. The action for infringement failed because the registered features of the plaintiff's mark (the word 'trebor' and the picture of a lion) were held not to be infringed by the defendant's use of the word 'minta' and elephant picture on its own peppermints. These were held to be quite distinctive. However, even though these individually registered features of the plaintiff's trade mark were not infringed, the court found that the defendant imitated the unregistered overall appearance – presentation and packaging or get up-of the plaintiff's product in a manner likely to cause confusion. Consequently, plaintiff's action for passing off succeeded.

3. Jurisdiction, its Conferment and Importance

⁸ (1971) 1 All NLR.468, (1976) 1 IPLR.299.

The expression 'jurisdiction' has been defined as the authority of a court to:

...decide matters that are litigated before it or take cognizance of matters presented in a formal way for its decision. The limits of this authority are imposed by the statute...under which the court is constituted and may be rescinded or restricted by similar means. If no restriction is imposed the jurisdiction is said to be unlimited. The limitation may be either as to kind and nature of the actions and the matters of which the particular court has cognizance or as to the area of which jurisdiction extends or it may partake of both these characteristics.⁹

Jurisdiction may be simply defined as the official authority or power to make legal decisions and judgments in respect of specified subject matters. Jurisdiction is the practical authority granted to a legal body or court to administer justice within a defined field of responsibility in relation to subject matter, nature of action or the parties involved in a matter brought before the court to adjudicate upon. Jurisdiction is the foundation upon which the totality of judicial process stands. It is the source and origin of adjudication and without it, the entire process of adjudication will collapse. It is therefore the *sine qua non* of adjudication. On the importance of the issue of jurisdiction to adjudication, the Supreme Court stated thus:

...the issue of jurisdiction of a court to try a suit is a fundamental and threshold one, this is because if a court has no jurisdiction to determine the subject matter ...the proceedings thereof are and remain a nullity, however well conducted and the judgement brilliantly written and eloquently delivered.¹⁰

On where jurisdiction of court is derived, the Supreme Court held in the case of *Felix Onuorah v Kaduna Refining & Petrochemical Co. Ltd*¹¹ that "It is not the rules of court that vest jurisdiction in a court. Rather, it is the statute creating a court, it is the...Constitution that is applicable in determining the ambit of the jurisdiction of the...court."

⁹*Halsbury's Laws of England*, 2nd ed., Vol.8, p.531, para 1176. See also *H.R.H. Obol Inah & Ors v Okosi* (2002) 23 WRN 78.

¹⁰*A.G. Federation v A.G. Anambra State* (2017)

¹¹(2005) 6 NWLR (Pt.921) 393 at 405.

Under the 1999 Constitution, jurisdictional issues can be divided into three – original,¹² exclusive¹³ and appellate,¹⁴ among the various levels of courts.¹⁵ Of relevance for our purpose here is the second one – exclusive jurisdiction, which makes the court the only competent body to adjudicate on a set of specified subject matters to the exclusion of all other courts.

3.1 Conferment of Exclusive Jurisdiction on Federal High Court

From the foregoing, it is obvious that the issue of jurisdiction is radically fundamental, a threshold issue and a condition precedent for a court's power to adjudicate, decide or take cognizance of the case presented before it.¹⁶ However, in determining the exclusive nature and scope of the jurisdiction conferred on the Federal High Court in respect of trademarks and passing off, it is imperative to consider the relevant laws in this regard.

Firstly, section 3 of the Trade Marks Act provides for passing off and this provision does not confine the passing off to only registered trademarks, neither does it donate jurisdiction to State High Court or any other court for that matter to entertain and determine passing off matters in respect of unregistered trademarks.¹⁷ Section 3 provides 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 of another person or the remedies in respect thereof.

¹² See for instance section 232 of the Constitution that confers original jurisdiction in respect of certain subject matters; section 239 which confers original jurisdiction on the Court of Appeal in respect of some subject matters; etc.

¹³ See for example section 251(1) of the Constitution that confers on the the Federal High Court exclusive jurisdiction in respect of some specific subject matters, etc.

¹⁴ See for instance section 233(1) of the Constitution that confers exclusive appellate jurisdiction on the Supreme Court to hear and determine appeals from the Court of Appeal; and section 240 which confers exclusive appellate jurisdiction on the Court of Appeal to hear and determine appeals from all superior courts of record including a court marshal or other tribunals, etc.

¹⁵ Mowoe, K.M., *Constitutional Law in Nigeria*, Lagos: Malthouse Press Ltd, 2008, p.200.

¹⁶ See *Eyo v Out* (2010) 1 WRN 107 at 124-5; *WAEC v Adeyanju* (2008) 35 WRN 1 or (2008) NWLR (Pt.1092) 270; and *Lufthansa v Odiase* (2006) 7 NWLR (Pt.976) 34.

¹⁷ See section 67(1) of the Trade Marks Act which interprets the term 'court' referred to in various provisions (such as sections 18, 21, 27, 38-42, etc) of the Act to mean Federal High Court.

The above provision can be divided into two parts for ease of comprehension. While the first part prohibits the institution of any action for the infringement of any unregistered trade mark, the second part preserves the right of action against any person for passing off goods as the goods of another. In respect of passing off, no reference is made to unregistered trade mark. In other words, while an owner of unregistered trade mark is clearly excluded from right of action for infringement and damages, his right of action for passing off is preserved or protected by the provision. It is therefore safe, in our humble opinion, to conclude that the provision for passing off in the Trade Marks Act is a general one, covering passing off in respect of both registered and unregistered trade marks. The implication of this is that the tort of passing off has now been generally codified by section 3 of the Act and it can no longer be regarded as a subject of common law, which regulated the tort of passing off prior to its codification. This codification was 'partially' recognised and endorsed by the Supreme Court in the case of *Patkun Industries Ltd v Niger Shoes Manufacturing Co. Ltd*,¹⁸ where it rightly held thus:

Section 3 of the Trademarks Act...thus gives a right of passing off. The right of action is derived from the...Act, and not common law. 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.

However, the same Court concluded wrongly, with due respect, that the codification was only in respect of registered trade mark, and that passing off arising from unregistered trade mark should be taken care of by the common law. On the jurisdiction of State High Court to entertain passing off for the breach of a trade mark that is unregistered, the Supreme Court held in the case of *Ayman Enterprises Ltd v Akuma Industries Ltd & Ors*,¹⁹ as follows:

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 provision of section 272 subsection (1) of the 1999 Constitution...

¹⁸ (1988) 5 NWLR (Pt.93) 188

¹⁹ (2003) 44 WRN 44.

But we submit with humility that more often than not the get-ups or features of a registered trade mark that are passed off are not registered features of the trade mark. If this is so, where does the difference lie to constitute the dichotomy between registered and unregistered trade marks when it comes to passing off? Passing off is passing off and it cannot be split into two so as to confer jurisdiction on two different courts – Federal High Court in respect of passing off arising from a registered trade mark, and the State High Court in respect of passing off arising from unregistered trademark. The only difference is that an owner of unregistered trade mark is excluded, by the provision of section 3 from instituting any proceeding to prevent or to recover damages for infringement but nothing stops him from claiming for passing off. Section 3 has also not in any way limit the jurisdiction of the Federal High Court to only passing off matters arising from registered trade marks, neither can the provision be construed, by any stretch of imagination, to confer jurisdiction on State High Court in cases of passing off arising from unregistered trade marks. As a matter of fact, section 3 of the Act confers no jurisdiction on any court – Federal or State High Court.

Furthermore, the Trade Marks Act has made references to the word ‘court’ in its various provisions,²⁰ which word has been interpreted by section 67 of the same Act to mean Federal High Court, on which jurisdiction is conferred on matters arising from the enactment. This interpretation makes no mention of registered or unregistered trademarks, neither is State High Court mentioned therein.

Secondly, trade mark is item 43 on the Exclusive Legislative List contained in the Second Schedule to the Constitution. This means that it is only the National Assembly that can make laws in respect of the subject matter and by implication it is only Federal High Court that has jurisdiction over all matters (passing off inclusive) arising from the subject matter.

Thirdly, section 251(1)(f) of the Constitution specifically confer exclusive jurisdiction in respect of trademarks and passing off generally on the Federal High Court without any reference to either registered or unregistered trademarks. It provides that notwithstanding anything to the

²⁰ See for instance, sections 18, 21 27, 38-42, etc of the Act.

contrary contained in the Constitution and in addition to such other jurisdictions as may be conferred upon it by an Act of National Assembly, 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, designs, **trade marks and passing off**, industrial designs and merchandise marks, business names and commercial industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards. (Emphasis supplied)

Section 7(1)(f) of the Federal High Court Act²¹ also confers identical jurisdiction and more on the Federal High Court, without any reference to either registered or unregistered trade mark. To ensure the exclusivity of the jurisdiction conferred on the Federal High Court in respect of the subject matters (trade mark and passing off inclusive), section 7(3) of the Act provides thus:

(3) Where jurisdiction is conferred upon the Court under subsection (1), (2)... of this section, such jurisdiction shall be construed to include jurisdiction to hear and determine all issues relating to, arising from or ancillary to the subject matter.

Infringement of trade mark and passing off are like two sides of a coin. The coin is the trade mark, the subject matter. Passing off is inseparable from trade mark, it arises from trade mark, irrespective of the status of the trade mark. Subsection (3) of section 7 of the Act has made it abundantly clear that passing off cannot be split into two for whatever reason, so as to share the exclusive jurisdiction of the Federal High Court with a State High Court over same. Consequently, this provision of the Act has clearly demonstrated that the Federal High Court has exclusive jurisdiction to hear and determine all issues relating to, arising from or ancillary to trade mark, registered or unregistered. And this obviously includes passing off arising from unregistered trade mark.

²¹ Cap.F12, Laws of the Federation of Nigeria LFN, 2010.

In order to leave no one in doubt as to the intendment, nature and scope of the exclusive jurisdiction vested in the Federal High Court by section 7, subsection (5) of the same section goes further to specifically and clearly provide thus:

Notwithstanding anything to the contrary contained in any other enactment or rule of law, any power conferred on a State High Court or any other court of similar jurisdiction to hear and determine any civil matter or proceedings shall not extend to any matter in respect of which jurisdiction is conferred on the Court (that is Federal High Court) under the provisions of this section.

From the foregoing provisions, it is clearly instructive that the constitutional and legislative intendment is to confer exclusive jurisdiction on the Federal High Court in respect of all intellectual property matters, without any discrimination.²² This notwithstanding, the Federal High Court was denied jurisdiction by the Supreme Court in the case of *Ayman* (supra) which arose from passing off relating to unregistered trade mark. In this case, the appellant as plaintiff at the Federal High Court, Lagos, sued the defendants/respondents. The plaintiff claimed *inter alia*, a perpetual injunction restraining the defendants, their servants, assigns or privies or otherwise howsoever, from passing off its product as that of the plaintiff.

Before the commencement of the trial of the substantive suit, there was an appeal against the ruling of the trial court by the defendants in respect of Anton Pillar application. The Court of Appeal upheld the ruling of the trial court. There was a further appeal to the Supreme Court by the defendant/appellant challenging the jurisdiction of the Federal High Court to entertain the substantive suit in the first place. It was common ground in this case that the appellant's trade mark was unregistered. Unanimously allowing the appeal, the Supreme Court held, *inter alia*, on the 'incompetence' of the Federal High Court over passing off right of action under the common law thus:

²²Oyewunmi, A.O., *Nigerian Law of Intellectual Property*, Lagos: University of Lagos Press & Bookshop Ltd., 2015, p.299.

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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...to entertain the passing off action instituted by the appellant in the instant case...I therefore find the Court of Appeal was wrong when it said that “the Federal High Court is eminently competent to adjudicate on the matter.”

We submit with the greatest respect that the Trade Marks Act (a Federal enactment) provides in its section 3 for trade marks infringement specifically for only registered trade marks. The same section 3 also provides for passing off generally without any reference to either registered or unregistered trade marks and thereby codifying the tort of passing off in respect of both registered and unregistered trade marks and clearing what was perceived as irreconcilable between the two provisions – sections 3 of the Trade Marks Act and section 251(1)(f) of the Constitution. To the Supreme Court, as demonstrated in the above quotation, the codified passing off is not applicable to unregistered trade marks. But it is our humble opinion that if the legislature intended to confine the application of the passing off provided for by section 3 to only registered trade marks, it would have expressly excluded unregistered trade marks just as it did in respect of infringement. Consequently, we humbly disagree with the Supreme Court’s conclusion that “...the passing off right of action did not arise from any federal enactment... Therefore the Federal High Court would not have any jurisdiction...to entertain the passing off action...” We therefore wish, with respect, to align ourselves with the decision of the Court of Appeal in the case to the effect that “the Federal High Court is eminently competent to adjudicate on the matter.” The essence of conferring exclusive jurisdiction on the Federal High Court by section 251(1)(f) of the Constitution in respect of trade marks and passing off is to make the Court the only arbiter of such matters or the court of first instance as far as the subject matters are concerned.

It may be argued that the Trade Marks Act was meant to protect only registered trade marks and that unregistered trade mark was mentioned only in passing in section 3. But the fallacy of this argument is that there is nothing in the entire Act that points to that effect but rather to the

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contrary. Apart from section 3 of the Trade Marks Act which provides for or has codified passing off generally, some other provisions of the Act confer some rights on proprietors or owners of unregistered trademarks. For instance, sections 7 and 8 which preserve the rights of non-interference in a pre-existing unregistered trade mark in continuous use by its owner prior to the registration of a similar or even an identical trade mark. The provisions preserve the right of the owner of an unregistered trade mark to continue to use the trade mark, notwithstanding the fact that someone else has now registered an identical trade mark. Section 26(3) of the Act dealing with assignment/transmission of trademarks also provides for its application to unregistered trademarks, etc.

On the issue of what was perceived as irreconcilable provisions of section 3 of the Trade Marks Act and section 251(1)(f) of the Constitution, it is our humble view that, the failure to accept that passing off had generally been codified by section 3 of the Act to cover both registered and unregistered trade marks was what made some to believe that the two provisions were irreconcilable (as illustrated in the earlier decisions of the Supreme Court), whereas a careful perusal of the two will disclose that there is no discordance between them. But since the tort of passing off has now been codified by the Trade Marks Act to cover both registered and unregistered trade marks, passing off in respect of unregistered trade mark now arises from a Federal enactment as envisaged by section 251(1)(f) of the Constitution and clearly demonstrating that there is nothing irreconcilable between the provision of section 3 of the Trade Marks Act and that of section 251(1)(f) of the Constitution.

From the foregoing, it may be concluded that the earlier decisions of the Supreme Court confining the jurisdiction of the Federal High Court to passing off in respect of registered trade marks only, respectfully, we submit were made per *incuriam*. Arising from the misconception that the tort of passing off relating to unregistered trade marks did not arise from any Federal enactment and is therefore still under the common law, whereas all the statutory provisions discussed above point to the contrary.

Having perused the relevant laws, it is obvious from all indications that, the Federal High Court is vested with exclusive jurisdiction to entertain and determine civil causes and matters arising

from trademarks and passing off, irrespective of whether or not the passing off claim is in relation to a registered trade mark, even though the pronouncements of the apex court are not in accord with this position.

3.2 Jurisdiction of State High Court

The State High Court derives its jurisdiction from the Constitution and the State Law establishing it. Section 272(1) of the Constitution provides thus:

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 proceedings involving or relating to any penalty, forfeiture, punishment or other liability in respect of an offence committed by any person.

The State Laws provide similar jurisdiction in addition to vesting the State High Court with supervisory and appellate jurisdiction. For an instance, section 13 of the Kaduna State High Court Law provides for the general jurisdiction of the Court thus:

- (1) The High Court shall be a superior court of record, and in addition to any other jurisdiction conferred by the Constitution, this Law or any other written law shall, within the limits and subject as in the Constitution and this Law mentioned.
- (2) The jurisdiction conferred upon the High Court by the provisions of this Law²³ and of any other written law²⁴ shall be exercised subject always to the limitations imposed by the Constitution.

²³ See sections 14 – 25 thereof for the specific subjects included in the jurisdiction of the High Court, none of which includes registered or unregistered trade marks or passing off. Neither is there any other law conferring such jurisdiction on the Court in respect of unregistered trade mark or passing off.

²⁴ No any other law has vested the High Court with any specific jurisdiction to entertain any matter or passing off arising from any trade mark.

There is nothing in the above constitutional provision and the provisions of the State Law appropriating any part of the jurisdiction of Federal High Court to add to that of the State High Court. On the contrary, section 272(1) and section 13(2) of the State High Court Law subject the State High Court jurisdiction to that conferred on Federal High Court by section 251. This is obviously meant to keep at bay or exclude the State High Court from all the subject matters (inclusive of trade marks and passing off generally) enumerated in section 251 of the Constitution. Further more, subsection (3) of section 272 goes one more step to vest Federal High Court with additional jurisdiction rather than sharing its jurisdiction in respect of trade marks and passing off with the State High Court. Section 272(3) provides as follows:

Subject to the provision of section 251 and other provisions of this Constitution, the Federal High Court shall have jurisdiction to hear and determine the question as to whether the term of office of a member of the House of Assembly of a State, a Governor or Deputy Governor has ceased or become vacant.

As a matter of fact, aside from the pronouncements of the apex Court, there is neither any constitutional nor other statutory provision that confers any jurisdiction on the State High Court to hear and determine any matter relating to, arising from or ancillary to trade mark. State High Courts, like all other superior courts of record, are creatures of the Constitution and other statutes from where they derive their jurisdiction. They cannot, therefore assume jurisdiction without an enabling statute as jurisdiction cannot be implied; there must be a statute on which to anchor it. To divest the Federal High Court of its exclusive jurisdiction conferred on it by the Constitution in respect of trade mark and passing off, in favour of State High Court, there must be very clear and unambiguous statutory provisions permitting it, as illustrated by the case of *Military Governor of Ondo State v Adewunmi*,²⁵ where the Supreme Court held thus:

I agree that ordinarily a constitutional amendment is a very serious affair, and when it is intended to divest a court from jurisdiction which has been given to it by the Constitution, it is a more serious affair still. It must be by express and

²⁵ (1988) 3 NWLR (Pt.82) 280 at 295, per Nnaemeka-Agu, JSC.

unambiguous words, and by a competent amendment of the Constitution...For as a general principle, even where there is a statute purporting to oust the jurisdiction of a court, the language of any such statute will be jealously watched by the courts.

The jurisdiction conferred on the State High Court by section 272(1) of the Constitution may appear to be unlimited but it is subject to section 251 of the same Constitution which confer exclusive jurisdiction on the Federal High Court in respect of trade mark and passing off. To that extent, therefore, the jurisdiction of the State High Court is limited.

All the foregoing boils down to one inescapable conclusion and that is that the State High Court is vested with no jurisdiction to hear and determine any issue or dispute arising from registered or unregistered trademarks, passing off or any other species of intellectual property whatsoever.

3.3The Decision in Dyketrade v Omnia (2000) 12 NWLR (Pt.680) 1

The earlier decisions of the Supreme Court were anchored on the narrow interpretation of section 3 of the Trade Marks Act, with due respect, on the misconception that the codification of passing off in the said section 3 of the Act was not elastic enough to accommodate passing off arising from unregistered trade mark, as such passing off does not arise from a federal enactment. This position of the Supreme Court, in our humble view, has not changed, in spite of its later decision in the case in view to the effect that the Federal High Court has exclusive jurisdiction over trademarks matters, inclusive of passing off, whether or not the claim is based on the infringement of a registered or unregistered trade mark. It is the view in some quarters that the Supreme Court decision in *Omnia's* amounts to overruling itself in its earlier decisions and thereby conferring exclusive jurisdiction on Federal High Court in respect of any trade mark or passing off matters arising from registered or unregistered trade mark. This they concluded to be "... a welcome development which helps to avoid absurdity and hardship by ensuring the realisation of what may be reasonably interpreted as the constitutional and legislative intendment to confer on the Federal High Court jurisdiction in respect of all intellectual property-related

matters.”²⁶ Even though this is the correct position of the law from what we have discussed so far, it is our humble opinion that the Supreme Court has not clearly departed from its earlier position on the issue of the competent court that has jurisdiction in respect of passing off arising from unregistered trade mark. This is because going by the facts and history of *Omnia*’s case, the apex Court decision was based on the peculiar facts of the case and the subsisting relevant law then. In order to appreciate this position, we will presently state briefly the facts/history of the case as well as the subsisting relevant law when the purported acts of infringement and passing off took place and on which the decision of the court was based.

In *Omnia*’s case, the plaintiff adopted the trade mark “SUPER ROCKET” which is registered in Nigeria under No.51136 class 19 with effect from 10th October 1991. The plaintiff inscribed the name ‘SUPER ROCKET’ on all the grinding stones and had made an in-road into the market and had a reputation and good will in the trade mark. In December 1992, the defendant imported consignment of grinding stones branded “SUPER ROCKET” and sold them. It again imported another set of the same brand of grinding stones. Then in March 1993, the plaintiff filed a suit against the defendant at the Federal High Court claiming, amongst others, the following reliefs:

- (1) an injunction to restrain the defendant or its privies from infringing, passing off, importing or selling grinding stones for washing terrazzo floors under the trade mark “SUPER ROCKET”;
- (2) delivery up for destruction of all the grinding stones bearing the offending mark (“SUPER ROCKET”) in possession, custody or control of the defendant;
- (3) damages of N1,000,000.00 or an account of profit; and
- (4) costs.

At the same time, the plaintiff applied for and was granted an Anton Pillar order (an order for inspection and seizure of the offending grinding stones to be kept in the court’s custody until the trial is concluded) against the defendant. The defendant applied to the trial court for the setting

²⁶ See for instance, Oyewunmi, A.O., *Nigerian Law of Intellectual Property*, Lagos: University of Lagos Press and Bookshop Ltd, 2015, p.299.

aside of the order but his application was refused. He appealed against the ruling to the Court of Appeal and finally the matter went to the Supreme Court which set aside the order.²⁷

Back to the trial court for the substantive suit and on plaintiff's application, the court on 5th May, 1997 granted an order setting down the suit for mention and consequently ordered for pleadings to be filed.

On being served with the plaintiff's statement of claim, rather than file the statement of defence, the defendant filed a motion on notice seeking an order striking out some paragraphs of the plaintiff's statement of claim dated 3rd June, 1997; an order striking out the statement of claim/entire claim of the plaintiff; and an order dismissing the entire suit with cost against the plaintiff. He sought the reliefs on the ground that the averments in the said paragraphs containing the particulars of registration and pleading the certificate of registration obtained after the filing of the suit, contradicted the particulars of claim in the writ of summons, in which the claims were based on application for registration of the trade mark and not on a registered trade mark contained in the statement of claim. The application was argued and dismissed. The defendant went on appeal to the Court of Appeal, which dismissed same. The defendant proceeded to the Supreme Court. The Supreme Court also dismissed the appeal and ordered the trial Federal High Court to hear and determine the substantive suit on its merit.

It is to be noted that section 7(1) of the Federal High Court Act was amended by Decree No 60, 1991²⁸ to the following effect that:

- 7(1) The court shall to the exclusion of any other court have original jurisdiction to try civil cause and matters connected with or pertaining to –
- (f) any Federal enactment **or common law** relating to copyright, patents, designs, trade marks and passing off, industrial designs...(emphasis supplied)

²⁷ See *Dyketrade v Omnia* (2000) 12 NWLR (Pt.680) 1.

²⁸ See Federal High Court (Amendment) Decree No.60, 1991.

The foregoing provision was the subsisting law as at the time the purported acts of infringement and passing off occurred, conferring on the Federal High Court jurisdiction over common law matters arising from either registered or unregistered trade mark and passing off. We submit therefore that besides deciding *Omnia*'s case on the basis of its peculiar facts, this is one other reason why the Supreme Court made the statement to the effect that the Federal High Court had jurisdiction to hear and determine the case. The above provision would have conferred on the Federal High Court additional jurisdiction envisaged by section 251(1) of the present Constitution, but the common law jurisdiction is neither in the extant Federal High Court Act nor in the Constitution.

It is to be noted also that the facts of earlier cases are not in all fours with those of *Omnia*'s case even though we admit that the conclusion of the Supreme Court in *Omnia*'s case is not only sound but it ought also to represent the correct position of the law as it is now. Besides, being the correct position of the law, the concluding statement of the Supreme Court in its decision in *Omnia*'s case, which some have interpreted to be a shift by the Supreme Court from its earlier position, cannot be divorced from the peculiar facts of *Omnia*'s case. It is, therefore, our humble view that the case of *Omnia* was decided according to its peculiar facts and circumstances, and not based on the position of current relevant law as we have canvassed earlier.

In *Ayman*'s case (supra) for instance, there was no dispute as to the non-registration of the trade mark in issue. But in *Omnia*'s case, assuming (without conceding) that the passing off in section 3 of the Act applies only to registered trademarks, there was also no registration but the application for registration had been filed at the time of filing the action at the Federal High Court. However, the process of registration of the trade mark was completed and the certificate of registration issued before pleadings were ordered. The date of registration was, as the law provides,²⁹ backdated to the date of the application, 10th October, 1991, which predated the date of commencement of the action, 2nd March, 1993. When the statement of claim was filed containing the particulars of the registration and the certificate of registration pleaded, the defendant did not file a statement of defence but a notice of preliminary objection, raising the

²⁹ See section 22(2) of the Trade Marks Act.

issue of jurisdiction. Consequently, the Supreme Court held that even if the claim was based on the infringement of an unregistered trade mark, as at the time statement of claim was filed the trade mark had already been registered, conferring jurisdiction on the Federal High Court. On jurisdiction acquired after an action has already been filed, the Supreme Court referred to the case of *Adani & Anor v Igwe* (1957) 1 NSCC 84, where it was held thus:

Assuming that when pleadings were closed, the then Supreme Court had jurisdiction to try the action, it is clear that when the case came up for trial before the High Court..., that court was invested with jurisdiction to try it. What is the court to do in such case? Is it to decline jurisdiction merely because it had no jurisdiction when the case started and thus put the parties to the expenses of beginning all over again? In my view, this would not be only unreasonable, but wrong in law. I have always understood the position to be that so long as a court acquires jurisdiction before delivering judgment, its decision cannot be attacked on the ground of want of jurisdiction...

In the light of the above quotation from the judgement, it will be misleading to cling on to only the statement of the Supreme Court to the effect that the Federal High Court has exclusive jurisdiction over trademarks matters, inclusive of passing off, whether or not the claim is based on the infringement of a registered or unregistered trade mark. The decision of the Supreme Court in *Omnia's* case was therefore premised on the fact that jurisdiction acquired after the commencement of an action but before judgement is given, is a good jurisdiction. Based on the provision of section 22(2) of the Trade Marks Act, the date of registration is the date of application for registration, which in this case, predated the commencement of action at the Federal High Court. Legally, therefore, jurisdiction was already vested in the Federal High Court before the commencement of the action by the plaintiff.

3.4 Implications of the Decision in Omnia's Case

The implications of the current position of the Supreme Court on the exclusive jurisdiction of the Federal High Court in respect of trade marks and passing off in the final analysis include the

facts that: (a) the Supreme Court decision in the case was based on the subsisting law when the cause of action arose as well as the peculiar facts of the case; (b) the codification of passing off in section 3 of the Trade Marks Act is, from the Supreme Court perspective, still restricted to registered trade marks under the current relevant laws; (c) the common law tort of passing off still remains the only remedy available to an owner of unregistered trade mark; (d) the State High Court is the only court that has jurisdiction to entertain matters arising from unregistered trade marks, notwithstanding the provisions of the Constitution, the Federal High Court Act, the State High Court Laws; and (e) the Supreme Court has not overruled itself in its earlier decisions in the cases of *Patkun* (supra) and *Ayman* (supra) and the controversy as to whether or not the Federal High Court has jurisdiction to entertain cases arising from unregistered trade mark is yet to be laid to rest.

From the foregoing, it may be concluded that the earlier decisions of the Supreme Court confining the jurisdiction of the Federal High to passing off in respect of registered trade marks only, we respectfully submit, were made per *incuriam*, arising from the misconception that the tort of passing off relating to unregistered trade marks did not arise from any Federal enactment and was therefore still under the common law, whereas all the constitutional and other statutory provisions discussed above point to the contrary.

Having perused the relevant laws, it is obvious from all indications that, the Federal High Court is vested with exclusive jurisdiction to entertain and determine civil causes and matters arising from trademarks and passing off, irrespective of whether or not the passing off claim is in relation to a registered trade mark, even though the pronouncements of the apex Court in this regard are not in tandem with this view, notwithstanding the decision of the apex Court in *Omnia's* case, the legal and factual bases of which have been discussed earlier in this paper.

4. Conclusion

This paper has discussed the relevant sources of the jurisdiction of the Federal High Court and those of the State High Court to buttress the fact that the Federal High Court is vested with exclusive jurisdiction in relation to all species of intellectual property (inclusive of trade marks

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and passing off generally) and that it was not constitutionally nor legislatively intended that the Federal High Court should have jurisdiction in respect of some, while the State High Court should have jurisdiction in respect of any matter arising from any of the species of intellectual property. In other words, there is no basis, constitutionally or legislatively, to suggest that the Federal High Court is intended to share its jurisdiction relating to trademarks and passing off with the State High Court. The paper also considered brief facts and history of *Omnia's* case and stressed that the case was decided in line with the position of the subsisting law then and even under the current dispensation, in spite of the fact that under the present dispensation, there is no constitutional or statutory provision conferring on the Federal High Court the jurisdiction to entertain common law matters relating to trademarks and passing off. This is understandable because both trade mark and passing off have been codified as we posited earlier. *Omnia's* case was also decided on the basis of its peculiar facts and circumstances. Either way, the Supreme Court did the needful in the case. However, the paper concluded that the decision of the Supreme Court in the case, along with its resultant implications, even though a reflection of the correct position of the law as at today in our view, was not a clear departure from its earlier decisions. Consequently, the Supreme Court has not overruled itself in its earlier decisions and the controversy as to which court has the jurisdiction to entertain matters arising from unregistered trade mark remains unresolved, as long as the Supreme Court continues to give the provision of section 3 of the Trade Marks a narrow interpretation to the effect that it is not elastic enough to accommodate passing off arising from unregistered trademarks.