

**A JURIDICAL REVIEW OF TRADE MARKS INFRINGEMENT, DEFENCES AND REMEDIES  
UNDER THE NIGERIAN LEGAL SYSTEM\***

**Abstract**

Trade mark infringement is the colourable imitation of ones registered trade mark by another in such a way that the marks used is identical or closely resembles that of the proprietor in the of trade mark is vested in the proprietor or registered user and the court that has jurisdiction is the Federal High Court. However there are defences available to the defendant in an action for trade marks infringement, such as, bona fide use, vested rights, non registration, prior use and non use. There are also remedies that may be granted by the court to the proprietor for infringing on his product, such as damages, injunction, account of profit, delivery up of possession, Anton Pillar order and rectification of the register. The review of statutes, case laws, text books, journals and internet materials show that cases of trade mark infringement abound, some of which may be intentional or unintentional and the courts have constantly frowned at them. It is important and necessary that there should be public enlightenment on registration and non registration of trade marks and their implications. The Trade Marks Act should be amended to included provisions for remedies for infringement and using trade mark for services too like in order jurisdictions.

**Keywords:** Juridical review, Infringement, Proprietor, Trade marks, Defences, Remedies.

**1. Introduction**

The advancement of industrialization and technology necessitated the protection of trade marks and trade names to avoid fake products imitating the marks of genuine products. The consumer and the proprietor of registered trade mark are the main crux of protection under the trade marks Law. The principal objective of this protection is to make sure that no one reaps from where he did not sow by confusing the consumers, hence, the need for effective Laws to combat this confusion to consumers and deprivation of benefits of proprietors. This is the Trade Marks Act. This Act protects the infringement of trade marks in Nigeria, so that no one who is not the proprietor or registered user, uses a mark identical or closely resembles it to deceive or cause confusion in the cause of trade in the same class of goods. Consequently, this paper examines infringement of trade marks, available defences and remedies under the Nigerian Law.

**2. Meaning of Trade Mark**

Trade mark as one of the important subjects of intellectual property has a diverse and familiar feature in both industrial and commercial markets. It has long been used by manufacturers and traders to identify their goods and distinguish them from goods made and sold by others. In the words of Curzon<sup>1</sup> trade mark is 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 registered user to use the mark whether with or without any indication of the identity of that person. The Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS) provides that a trade mark is any sign or any combination of signs, capable of distinguishing the goods or services of one from those of other undertakings.<sup>2</sup> Furthermore, the Trade Marks Act<sup>3</sup> provides that 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 registered user to use the mark, whether with or without any indication of the identity of that person, and means in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of the Act. See also *Procter and Gamble Co v Global Soap and Co Ltd & Anor*<sup>4</sup>.

In effect, trade mark in Nigeria is a printed or visual representation used only for trade and not services, unlike the USA and Uk where they are used for both trade and services.

**3. Rights Conferred Upon the Proprietor of a Trade Mark**

Subject to the provisions of Sections 7 and 8 of this Act, the registration of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods, shall if valid, give or be deemed to have given to that person the exclusive right to the use of that trade mark in relation to those goods.<sup>5</sup>

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<sup>1</sup> L B Curzon (ed), *Dictionary of Law* (3rd ed.), Pitman Publishing, London, 1988.

<sup>2</sup> Article 15(1).

<sup>3</sup> Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria (LFN) 2004, s. 67(1).

<sup>4</sup> [2013] 1NWLR (pt 1336) 461.

<sup>5</sup> Trade Marks Act, *op cit*, s. 5(1).

The import of the above statutory provision is that registration is a *prima facie* evidence of use, this however simplifies an infringement action. The case of *Dyktrade Ltd v. Omnia Nig. Ltd*<sup>6</sup> is illustrative, where the Supreme Court held that the rights conferred by the registration of a trade mark on the proprietor is the exclusive use and right to sue for infringement<sup>7</sup>. The registered owner or proprietor, need not give evidence of use in any law suit, all he merely does is to produce the certificate of registration. The case of *Crysterlight Overseas Agency Ltd v Yugolex Drugs Co Ltd*<sup>8</sup> is instructive, wherein the court held that the registered owner of a registered trade mark need not give evidence of use and reputation, that all he is required by law is to present the certificate of registration to the court.

Further, the Supreme Court in *Alliance International Ltd v Saam kolo Intl Enterprises Ltd*<sup>9</sup> reiterated that a person who has registered a name or sign as a trade mark has a proprietary right over the use of that name in that class in which it is registered. Consequently, registration is *prima facie* evidence of title to a particular trademark and entitles the proprietor to institute action for infringement to protect its breach. In *Morison Industries Plc v. CPL Industries Ltd*<sup>10</sup> the court stated that Section 5 of the Trade Marks Act, 2004 provides protection to a registered proprietor of a trade mark, whose registration is valid and subsisting, with exclusive right to use the trademark in marketing and selling of his goods. Hence a registered trademark prohibits any other person from using the same mark or a mark so similar to it as to likely deceive or cause confusion to the user/consumer of the goods of the proprietor. The objective of this protective provisions is to ensure that no one other than the registered proprietor of a trade mark uses a mark either identical or so nearly resembling it as to likely deceive or cause confusion in the course of trade relating to the goods of the proprietor. See also *Virgin Enterprises Ltd v Richday Beverages (Nig.) Ltd*<sup>11</sup>.

Registration is also a *conditio sine qua non* to an action for infringement. Thus, the Trade Marks Act<sup>12</sup> provides that no person can institute an action to prevent or recover damages etc. for the infringement of an unregistered trade mark, rather he can only bring an action for passing-off. For the rights of persons whose marks are registered in Part B, the Act provides thus:

Except as provided by subsection (2) of this section, the registration of a person in Part B of the register as proprietor of a trade mark in respect of any goods, shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and section 5(2) to (4) of this Act shall apply in relation to a trade mark registered in Part B accordingly.<sup>13</sup>

The above provision presupposes that the rights conferred by registration in Part A and Part B are virtually the same. In addition, in any action for infringement of the right to the use of a trade mark, given by such registration as aforesaid in Part B of the register, no injunction or other relief shall be granted to the plaintiff, if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to lead to the belief in a connection in the course of trade between the goods and some person entitled either as proprietor or as a registered user to use the trade mark.<sup>14</sup>

#### **4. Rights of a Registered User**

A registered user is a person who is for the time being registered as such under section 34 of this Act.<sup>15</sup> This registration is done by the proprietor and the proposed registered user applying in writing to the registrar in the prescribed manner and providing the basic requirement as provided under section 34. Then, the Registrar after due consideration registers the proposed user as a registered user.<sup>16</sup> A registered user does not enjoy the same rights as the proprietor of the trade mark. Hence, the Act provides that nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to use thereof.<sup>17</sup> The registered user permitted use of a trade mark is deemed to be the use by the proprietor. Hence, the Act provides that the permitted use of a trade mark shall be deemed –

- (a) to be use by the proprietor thereof; and

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<sup>6</sup> (2000) LPELR – 977(SC)

<sup>7</sup> *Ibid*

<sup>8</sup>(1998) FHCL 390

<sup>9</sup> (2022) LPELR – 57984 (SC)

<sup>10</sup> (2021) LPELR-52981(CA) Pp. 27-31

<sup>11</sup> (2009) LPELR-8187 (CA)

<sup>12</sup> *Op cit*, s. 3.

<sup>13</sup> *Ibid*, s. 6(1).

<sup>14</sup> *Ibid*, s. 6(2).

<sup>15</sup> *Ibid*, s. 67(1).

<sup>16</sup> *Ibid*, s. 34.

<sup>17</sup> *Ibid*, s. 33(5).

- (b) not to be used by a person other than the proprietor.<sup>18</sup>

However, subject to any agreement subsisting between the parties, a registered user of trade mark will be entitled to call upon the proprietor to take proceedings to prevent an infringement and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user can institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.<sup>19</sup> Nevertheless, where a proprietor has been added as a defendant, he will not be liable for any cost unless he enters an appearance and takes part in the proceedings.<sup>20</sup>

### **5. Jurisdiction of Court**

The Federal High Court has jurisdiction to hear matters pertaining to and relating to trade marks, as the Constitution of the Federal Republic of Nigeria, thus provides:

Notwithstanding, anything to the contrary contained in this Constitution and in addition to such other jurisdiction as may be conferred upon 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 – any federal enactment relating to copyrights, patents, trade marks, passing-off and industrial designs.<sup>21</sup>

Jurisdictional issues have often times arisen for determination in the courts on trade marks, but the most important of them all is the issue of unregistered trade mark. Indeed in instances like this, the courts have always been consistent in holding that they lack jurisdiction. This jurisdictional issue came up for full consideration before the Supreme Court in *Patkun Industries Ltd v Niger Shoes Manufacturing Co Ltd*,<sup>22</sup> and this Apex Court of Nigeria held, *inter alia*, that:

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

In *Society Bic SA v Chargin Industries Ltd & Anor*<sup>23</sup> the court held that an action for infringement of trade mark before the Federal High Court cannot be founded on an unregistered trade mark. Suffice it to state that the statutory provision of section 3 of the Trade Marks Acts, 1965, which is presently the same section 3 Trade Marks Act, 2004, and several decided cases establish that though the Federal High Court cannot exercise jurisdiction over unregistered trade marks, it can exercise jurisdiction in an action for the infringement of registered trade mark and passing off of a registered trade mark.

### **6. Infringement of Trade Marks**

Infringement of trade marks consist of the unauthorized use or colourable imitation of a trade mark on substituted goods of the same class as those for which the mark was appropriated. It occurs when there is a deliberate or even chance occurrence by a person to make his own products similar to the products of another in respect of which a mark has been appropriated in such an extent that intending customers would readily confuse one product for the other. The case of *Ferodo Ltd v Ibeto Ind Ltd*<sup>24</sup> is illuminating. In this case the appellant sued the respondent claiming the infringement of their trade mark by way of graphic representation of their product contained in a packet being marketed as 'FERODO.' They sought for an injunction and damages. The respondent denied the allegation stating that its packet marked 'UNION SUPA' is distinctly different from the appellant's trade mark, 'FERODO.' The trial court held that the respondent's trade mark does not resemble the appellant's.

On appeal however, the Court of Appeal dismissing the appeal held that:

- (a) infringement of trade mark consists of unauthorised use or colourable imitation of a trade mark on substituted goods of the same class as those for which the mark has been appropriated.
- (b) Infringement of a trade mark occurs when there is a deliberate or even chance occurrence by the defendant to make its own product almost similar to the plaintiff's product to such an extent that intending customers would readily confuse one product for the other. In that case, the deception or chance occurrence would have done damage to the business of the party.

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<sup>18</sup> *Ibid*, s. 33(3).

<sup>19</sup> *Ibid*, s. 33(4).

<sup>20</sup> *Ibid*

<sup>21</sup> The Constitution of the Federal Republic of Nigeria 1999 (as amended) s. 251(1)(f).

<sup>22</sup> [1988] 5 NWLR (pt. 93 ) 138; *Savannah Bank Ltd v. Pan Atlantic* [1987] NWLR (pt. 49) 212.

<sup>23</sup> (1997) FHCL 727.

<sup>24</sup> [1999] 2 NWLR (pt. 592) 510.

The Supreme Court stated that:

1. In deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like. Evidence is admissible to show which of the features shown in the register in this case are essential and which are inessential so as to be unimportant in deciding questions of infringement.
2. It is not all the features that are contained in the mark that are important for the purposes of the infringement of the trade mark. Not all the components are to be considered as forming part of the trademark. The resemblance giving rise to infringement must lie in the basic idea of the mark.

In *AAH Pharmaceuticals v Vantagemax*<sup>25</sup>, the claimant was the proprietor of the trade mark 'Vantage' for operating incentive schemes'. The defendant operated a loyalty card scheme under the words 'Vantage Rewards'. The Court held that the marks were identical because the word 'Reward' was merely descriptive of the services offered.

Notably, infringement in its wider sense includes both statutory infringement and infringement under the common law of passing off.

### **Statutory Infringement**

A trade mark is infringed statutorily, if a person not being the proprietor or registered user of a mark uses a mark identical with it or so nearly resembles it as to be likely to confuse, in the course of trade, in relation to any goods or class of goods in respect of which the mark is registered.<sup>26</sup> It is not necessary for the infringer to have any wrongful intent in order to be liable for infringement of trade mark.<sup>27</sup> It is enough that having regards to the circumstances of the case, there is a high probability of confusion.<sup>28</sup> Suffice it to state, however, that for a mark to constitute an infringement of another, the court has to be satisfied not merely that there is a possibility of confusion but that there is a tangible danger of confusion and the resemblance must be so deceptive as to easily capture the attention of the customer.<sup>29</sup> The case of *Beecham Group Ltd v Essdee Food Products (Nig) Ltd*,<sup>30</sup> is instructive wherein the Court of Appeal in affirming the decision of the trial court held, *inter alia*, that 'glucos-aid' in sound is confusing to 'lucozade' and it will understandably mislead the public.

The Nigerian courts have in several instances stated what the plaintiff needs to prove in an action for trade marks infringement. In *P&G Co v. Global Soap & Detergent Industries Ltd & Ors*<sup>31</sup> the court of Appeal Per OGUNWUMIJU, J.C.A held thus;

I must say here that the issue of trade mark protection has been the subject of several Supreme Court cases. Thus in *Ayman Enterprises Ltd v. Akuma Industries* (2003) 6 SCNJ 307, the Supreme Court set out what the plaintiff needs to prove to establish an action for infringement of a trade mark. The Plaintiff must establish his title either as proprietor or as a registered user entitled to sue. He must then prove that the defendant has acted or threatens to act in a way as to infringe the right conferred upon him by the registration of the trade mark under the Act.

The learned Justice stated further that evidently, the subsequent trade mark regardless of the suffix 'Automatic' (which had been disclaimed) is identical with the Appellant's 'Ariel'. The specific products which both trade marks relate to in the factual circumstance are detergents. The trade mark or name used by both proprietors is the word 'Ariel' which prefix all other descriptions or get up by the parties. Whether it is 'Ariel Devise' or 'Ariel Automatic' the prefix Ariel is the key name or key mark. Indeed that was the point made by the Supreme Court in *Ferodo v Ibeta* to the effect that 'Ferodo' is the trade mark and other suffix or get up names imitated by the competition is not an infringement of the name 'Ferodo'. In this case, it is therefore apparent that both parties use the principal name Ariel to market their products. Apart from the word Ariel all other descriptions are irrelevant. Therefore in my humble view, use of the word 'Ariel' by both marketers is a recipe to create confusion in the mind of the average consumer, the different packaging etc notwithstanding. This is more as they both advertise the same products. The Appellant's trade mark is not only well-known internationally, it has also been the subject of prior legal registration under the Trade Marks Act in Nigeria. That the Trade mark Ariel associated with the appellant should enjoy the protection of the Courts.

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<sup>25</sup> (2002) EWHC 520 ch

<sup>26</sup> Trade Marks Act, *op cit*, s. 5(2).

<sup>27</sup> *Re Egg Product Ltd Application* (1920) 39 RPC 115.

<sup>28</sup> *Ferodo Ltd v Ibeta Ind Ltd*, *Supra*

<sup>29</sup> *PZ v Chami, Supra; Bell Sons & Co v Aka*, *Supra*

<sup>30</sup> 1985] 3 NWLR (pt. 11) 112.

<sup>31</sup> (2012) LPELR-8014(CA)

The proprietor of a registered trade mark can sue for infringement of the trade mark or passing off or both and has the burden to prove his entitlement to the exclusive use of that trade mark. In *Morison Industries Plc v. CPL Industries Ltd*<sup>32</sup> Per Aliyu J.C.A the Court of Appeal held that: ‘A trade mark if registered will give the proprietor the exclusive right to use the trade mark in marketing or selling his goods. And without his consent if anyone else uses an identical mark or one mark so nearly resembling it as to be likely to deceive or cause confusion, will entitle the proprietor to sue for infringement of the trade mark, or to sue for passing off or both, see *Ferodo Ltd v. Ibeta Ind. Ltd* Musdapher, J.S.C (supra)’.

In continuation it stated that, the Plaintiff in an action for trade marks infringement such as this case, has the burden of proving its entitlement to the exclusive use of a registered trade mark or design that has a distinctive character and that the defendant infringed on that right by copying same on the infringing product. That it is the tenets of Sections 4 to 7 of the Trade Marks Act, which means that the plaintiff must plead facts and lead evidence to establish that the defendant used identical or similar mark in relation to his (plaintiff's) goods registered under the trade mark in issue in such a manner that there is likelihood of deceit or confusion. See also section 5(2) of the Trade Marks Act. Consequently, the plaintiff must prove that the defendant used identical or similar signs on his goods in such a way that he took unfair advantage of the plaintiff's acquired and established market reputation to the detriment of the distinctive character of its trade mark, especially if one product is seen in the absence of the other, and not necessarily side by side. The resemblance that will give rise to infringement of trade mark will lie on the basic idea of the mark that distinguishes it with other products.

### **7. Infringement Under the Common Law of Passing Off**

Some authors and jurists are of the view that the modern law of trade marks is an extension of the common law concept of passing off. Passing off is conducting one's business in such a way as to mislead the public into thinking that one's goods or services are those of another. The commonest form of passing off is marketing goods with a design, packaging or trade name that is very similar to that of someone else's goods. It is not necessary to prove an intention to deceive, innocent passing off is actionable.<sup>33</sup>

The right to an action for passing off was originally based on the common law of fraud, but equity extends the remedy to cases where there was no intention to deceive at all.<sup>34</sup> Passing off occurs whenever one person so emulates the appearance, name, get-up or other identificatory feature of another's business or trade that the public might be confused and believe that his goods or business are those of the other person. It is not necessary to show an intention to deceive.<sup>35</sup> Specifically, this protection may be said to be afforded to an established trade reputation occurring first in time as against subsequent time. The rationale behind this presumably is that a business reputation is a form of property which can be appropriated.

In *Erven Warnink Besloten Vennootschap v J Townend & Sons Ltd*<sup>36</sup> otherwise known as the *Advocate case*, Lord Diplock identified five elements which must be established in a passing off action, and they are-

- (a) a misrepresentation;
- (b) made by a trader in the course of business;
- (c) to prospective customers or ultimate consumers;
- (d) which is calculated to injure the goodwill or business of another; or
- (e) which causes actual damage to that other.

Nevertheless, in practice, some of these elements may be dispensed with depending on the peculiar fact of each particular case.

### **8. Defences to an Action for Infringement of Trade Marks**

#### **Part B: Defence or Fair Use**

It shall be a defence to an action for an alleged infringement of trade mark registered under Part B of the register to prove that the defendant's use of the mark said to be identical or similar to the plaintiff's mark is not likely to deceive or cause confusion to unsuspected customers or to lead to the belief in a connection in the course of trade between the goods and some person entitled either as proprietor or as registered user to use the trade mark.<sup>37</sup>

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<sup>32</sup> (2021) LPELR-52981(CA) Pp. 27-31

<sup>33</sup> E A Martin and J Law, *op cit*, 385.

<sup>34</sup> *Singer Machine v Wilson* [1877] 3 AC 391.

<sup>35</sup> *Spalding v Gamage* (1915) 84 LJCH 449.

<sup>36</sup> [1979] AC 731 or [1979] 2 ALL ER 927.

<sup>37</sup> Trade Marks Act, *op cit*, s. 6(2).

**Vested Rights:** A person or his predecessor in title who has been in continuous use of a trade mark before the registration or use of such trade mark or an identical trade mark by another has a right of prior use against that other, which cannot be restricted by an action for infringement. Hence, the Act<sup>38</sup> provides that;

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods to which that person or a predecessor in title or his has continuously used that trade mark from a date previous to –

- (a) the use of the first mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or
- (b) the registration of the first mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his.<sup>39</sup>

The *American Cyanamid Co v Vitality Pharmaceuticals Ltd*<sup>40</sup> is also illuminating on the issue of vested rights as a defence for trade marks infringement. Further, the Act stipulates that the proprietor of the subsequent trade mark, even if registered is not entitled to object to the prior proprietor or user's trade mark being put on the register.<sup>41</sup> In the case of honest concurrent use or other special circumstances which in the opinion of the Court or Registrar, make it proper so to do, the Court or the Registrar may permit the registration of trade marks that are identical or nearly resemble each other in respect of same goods or description of goods by more than one proprietor.<sup>42</sup> *P&G Co v. Global Soap & Detergent Industries Ltd & Ors (supra)* is illuminating.

**Bona Fide Use:** A person is also entitled to make bona fide use of his name or that of his place of business or those of his predecessor in title or a bona fide description of the character or quality of his goods not being a description that would be likely to be taken as importing any such reference as mentioned in sections 5(2)(b) or 43(4)(b) of this Act.<sup>43</sup> In addition to the above, the defendant can escape liability by proving that the plaintiff has no valid title to the trade mark or that the registration is not valid and therefore liable to be expunged or that his acts do not constitute an infringement as defined under the Act.<sup>44</sup>

**Difference in essential features:** the difference between the infringed trade mark and the trade mark in dispute is so distinct in its essential features that it is not likely to cause confusion<sup>45</sup>.

**Non-use:** the allegedly infringing trade mark has not been in use and has not been used. Section 31 of the Trade Marks Act provides that a registered trade mark may be taken off the register in respect of any goods in respect of which it is registered on an application made by any person concerned to the Court or, at the option of the applicant and subject to Section 56 of this Act, to the Registrar, on either of the grounds set out in Section 31(2) thus:

- (a) That the trade mark was registered without bona fide intention on the part of the proprietor to be used in for trade relation to those goods by him, and that there have been no bonafide use of the trade mark in relation to those goods by any proprietor one month before the date of the application; or
- (b) That up to the date one month before the date of the application, a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and has not been used in relation to those goods by any proprietor. In support of the above provisions the court reiterated them in *P&G Co v. Global Soap & Detergent Industries Ltd & Ors(supra)*

## **9. Remedies for Trade mark Infringement**

The available remedies for trade marks infringement include; damages, account of profits, delivery-up of infringing articles, injunction, Anton-pillar order and rectification of the register.

### **(a) Damages**

This is compensation on the loss suffered resulting from infringement of registered trade mark or passing off of unregistered trade mark. However, for damages to be awarded the plaintiff must prove that harm was caused by infringement that led to the consumer/buyer's confusion and deception. It is trite Law that he who asserts proves.<sup>46</sup> Damages can be general, special, exemplary or punitive and nominal.

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<sup>38</sup> *Ibid*, s. 7.

<sup>39</sup> *Ibid*

<sup>40</sup> [1991] 2 NWLR (pt. 171) 15.

<sup>41</sup> Trade Marks Act, *op cit* ss. 7 and 13(2).

<sup>42</sup> *Ibid*, s. 13(2).

<sup>43</sup> *Ibid*, s. 8; *Niger Chemist Ltd. v. Nigerian Chemist* (1961) 1 ALL NLR 171.

<sup>44</sup> Trade Marks Act, *Ibid*, ss. 8 and 38.

<sup>45</sup> O.J. Jegede & W. Idiaru, 'Trademarks infringement in Nigeria an overview', <http://practicallawthomsonreuters.com>, accessed on 10/8/2022

<sup>46</sup> Section 131 of the Evidence Act 2011(as amended)

### **General Damages**

Are those which naturally flow from the defendant's conduct and its quantum need not be pleaded or proved as it is generally presumed by Law. The dictum of E.A. Agim JSC in *Alliance Intl Ltd V. Saam Kolo Intl Enterprises Ltd*<sup>47</sup> is illuminating wherein the Supreme Court held that general damages is where the claim is simply for damages, it is a claim for monetary compensation for all the loss or injury suffered. Such general claim for damages clearly is a claim for general damages as it is not specific or exact as to the particular loss to be compensated or the quantum of the loss. Here, the court awarded three million Naira in favour of the Respondent against the Appellant for infringing on the Respondent's trade mark. Also in *Morison Industries Plc v. CPL Industries Ltd*<sup>48</sup> the court decided thus:

The law is firmly settled that general damages arise from an inference and a presumption of the law to flow directly as the consequences of the wrongful act complained of and proved. In that regard, it comprises of the sum of money that the court decides the person wronged is entitled to receive as compensation from the wrong doer. See *Ya'u v Dikwa* (supra), *Cameroon Airlines v Otutuizu* (2011) LPELR- 827 (SC) and *Usman & Anor. v Emene Oil Nig. Ltd* (2014) LPELR-2313 (CA) among others.

### **Special Damages**

They are damages that must be specifically pleaded and proved. The Supreme Court cases of *Uwa v ITC*<sup>49</sup>, *AG Oyo State v Fairlakes Hotel*<sup>50</sup> *UBA Plc v IBTL Industries Ltd*<sup>51</sup> are illuminating. In *Alliance Intl Ltd V. Saam Kolo Intl Enterprises Ltd* per E.A. Agim JSC, the Supreme Court stated that the law is settled by an unending line of decisions of this Court that a claim for loss of a specific amount as profit or earning is in the class of claim for special damages. This court noted that the special damage claimed by the Plaintiff Respondent is N2.5m.

### **Nominal Damages**

Nominal damages are damages awarded to a plaintiff who has suffered a legal wrong, but cannot show that he suffered actual damages or no evidence is given to the extent of damages.

### **Punitive or Exemplary Damages**

Punitive damages are damages intended to punish the defendant and deter him from infringement, it is not meant only to compensate the Plaintiff.

### **(b) Injunction**

This is another remedy available to the proprietor of a registered trade mark or user, wherein the proprietor can seek injunctive reliefs restraining the infringing and unauthorized use or sale of the trade mark items.<sup>52</sup> Simply put, an injunction mandates or forbids the doing of a specific act. In *Adedeji v Eso*<sup>53</sup> the court opines that:

An injunctive order is an equitable relief. Whether to grant or refuse a relief for an injunction depends on the circumstances of each case. In its simplest meaning, an injunction mandates or forbids the doing of a specified act and the whole essence of the remedy is to ensure that justice is done to parties in a law suit.

Importantly, injunctions restrain the defendant from continuous infringement of the trade mark. Injunctions can be interim, interlocutory or perpetual. Interim injunction is a temporary measure which is usually granted only in cases of urgency requiring immediate relief. It is made pending the date of the hearing and determination of a motion on notice or until a named date. It is usually applied for, by the concerned party to the suit by motion *ex parte*.<sup>54</sup> Interlocutory injunction is usually granted pending the final determination of the suit on the merit This is done to preserve the *res* or subject matter of the suit, because if it is not granted by the court, the *res* may be destroyed and nothing to be determined by the court in the substantive suit. It is often times used and very effective in trade mark infringement proceedings. In *Dykrade Ltd v Omnia Nig Ltd* (supra) the Supreme Court enunciated that the purpose of interlocutory injunction is to protect the Plaintiff against injury by violation of his right for which he could not be adequately compensated in damages where the action is resolved in his favour at the end of the trial. While Perpetual or permanent injunction is a final remedy aimed at ensuring the infringer never interferes with or infringes the trade mark again.

The grant of the above named injunctions are at the discretion of the court based on:

- whether there is a threat or likelihood that the infringement will continue;

<sup>47</sup> (2022) LPELR – 57984 (SC)

<sup>48</sup> (2021) LPELR-52981(CA) Pp. 46

<sup>49</sup>(1988) 12SC( PT2) 102 at 122-123.

<sup>50</sup> (1989) 12SCN3 1 at 22

<sup>51</sup> (2006)19NWLR p.61

<sup>52</sup>O.J. Jegede, 'Trade Mark Infringement in Nigeria and Legal Remedies', <http://www.mondaq.com>, accessed 10/8/2022

<sup>53</sup>(2011) LPELR-8884(CA) Pp. 20

<sup>54</sup> O. J. Jegede and W. Idiaru, 'Trademarks infringement in Nigeria an overview', <http://practicallawthomsonreuters.com>, accessed on 10/8/2022

- whether the claimant has suffered irreparable damage as a result of the infringement;
- how the injunction will affect both the claimant and the defendant;
- if it is in the interest of justice to grant the injunction.<sup>55</sup>

**(c) Delivery up of Possession or Destruction of Infringing goods**

The court on the application of the Plaintiff may order for the delivery up or destruction of the infringing goods, if it deems it fit.

**(d) Anton Pillar order**

This is an order by the court for the inspection and seizure of the infringing products. The Plaintiff is permitted in appropriate cases accompanied by police officers, to enter upon and inspect the defendant's premises and seize products bearing the infringing marks. The case of *Ferodo Limited v Unibros Stores*<sup>56</sup> is illuminating wherein the court ordered that the defendants should permit persons and a police officer to inspect, detain and preserve any moveable property within the premises. Plaintiff's solicitor is to inspect all documents under the control of the defendants relating to the said matter and stop subsequent and continuous infringement.

**(e) Account of Profits**

The successful Plaintiff in an infringement action is entitled to claim an account of profit made by the defendant, which profit derives from the infringement. The object of the remedy is to stripe the defendant of his improperly made profit.<sup>57</sup>

**(f) Rectification of the Register**

Rectification of the trade marks register is the expungation or varying of the entries in the register. Hence the Trade Marks Act provides that the entries in the register of trade marks may be expunged or varied by the Court or the Registrar in the event of any omission from the register or that an entry has been made in the register without sufficient cause or that an entry wrongly remains in the register or that any error or defect exists in any entry on the register.<sup>58</sup> Generally, rectification of the register also includes the removal of registration in Part A of the register to Part B<sup>59</sup>

The Court of Appeal in *P&G Co v Global Soap & Detergent Industries Ltd & Ors* (Supra) held that Section 38 (1)(c) of the Trade marks Act provides that any person concerned who alleged that any entry wrongly remains on the register, may apply to the Court or and subject to Section 56 of the Act, to the Registrar, and the tribunal after due deliberation may make such order for expunging or varying the entry as the tribunal thinks fit.

**10. Conclusion and Recommendations**

Infringement of trade marks in Nigeria abound, which may be intentional or unintentional. This infringement occurs when a mark is identical or closely resembles the mark of registered proprietor. The Trade Marks Act in its provisions tries to protect the proprietor and reduce unauthorized use of registered trade mark by another. It is only the proprietor or registered user of a registered trade mark that can sue for infringement of trade marks. The Nigerian Courts have from time to time frowned at this infringement in a plethora of their decisions, making sure that the proprietors benefits economically from the fruit of their labour and preventing goal getters from stealing others intellectual property. Unfortunately, the Act<sup>60</sup> did not in its provisions provide specifically for remedies available for infringement of trade marks and passing off of ones goods. However there are defences available in an action for infringement.

To reduce the spate and possibly eradicate trade marks infringement in Nigeria, the following recommendations are made:

1. There should be public enlightenment headed by the Registrar of trade marks on the importance of registration of ones trade mark and the implications of registration and non-registration.
2. There should also be public enlightenment on the consequences of trade mark infringement.
3. The Registrar of Trade marks should consider any application for registration of trade marks with due diligence to avoid making wrong entries into the register without sufficient cause that will warrant removal on application by another. He should scrutinize the register for already enter mark which is identical or closely resembling the new mark to be registered.
4. The Trade Marks Act 2004 should be amended to specifically provide for civil and criminal remedies for infringement. There should be stringent punishment as criminal remedy to deter infringers. This amendment should include using trade mark for services.

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<sup>55</sup> *Ibid*

<sup>56</sup> (1999) 2 NWLR 509.

<sup>57</sup> A.O. Oyewunmi, *Nigerian Law of Intellectual Property*, University of Lagos Press and Bookshop Ltd. 2015.p.110

<sup>58</sup>Trade Marks Act, s. 38(1)

<sup>59</sup> *Ibid*, s. 38(5)

<sup>60</sup> Trade Marsks Act *op cit*