

**EXAMINING TRADE MARKS INFRINGEMENT IN NIGERIA\***

**Abstract**

Trade mark infringement is becoming increasingly common due to multiple factors like the weakness of enforcement system, lack of sensitization, advent of digital platforms and other factors. Trade mark infringement is the unauthorized use of a trade mark in a way that deceives the public or confuses the public into believing that the mark is the same with the registered trade mark. The aim of this study is to examine what constitutes trade mark infringement in Nigeria by examining the provisions of the Trade Marks Act that provides for trade mark infringement and also case laws. The Trade Marks Act Cap T13 2004 is the principal legislation for trade marks protection in Nigeria. The methodology of the study is the doctrinal and analytical approach. It examined Section 5 of the Trade marks Act and also some cases. It found that for a trade mark proprietor to succeed in a trade mark infringement case, the mark must be registered which confers the right to action for infringement, the use of the mark was without his consent, it is likely to cause confusion and must be in relation to goods for which the mark was registered. It recommended a wider scope where infringement would cover not only goods but also services and also include goods which are not in relation to goods for which the mark was registered.

**Keywords:** Trade Marks, Infringement, Remedies, Nigeria

**Introduction**

Trade mark is one of the forms of intellectual property protected in Nigeria. It is a mark used in relation to goods and services to distinguish the origin or source of the goods and services. Trade mark infringement occurs whereby a registered mark is used without the consent of the trade mark owner or proprietor of the mark in the course of trade and the use must be in a manner likely to cause confusion, deception or mistake between the original mark and the mark used. An action for infringement can only be brought by the proprietor of a registered trade mark. Unregistered trade mark can only bring an action for passing off.<sup>1</sup>

**2. Nature and Scope of Trade mark Infringement in Nigeria**

Section 5(2) of the Act states that ‘without prejudice to the generality of the right to use a trademark, the marks shall be deemed to be infringed by any person who not being the proprietor of the trade mark, uses a mark identical to it or so nearly resembling it as it is likely to deceive or cause confusion in course of trade in relation to any goods in respect of which it was registered.’ By the above section, for a mark to constitute any infringement, there are three major elements. They are:

**Use by any person not being the proprietor of a trade mark:**

Where a person who is not the proprietor of a trade mark or does not have the consent of the proprietor of a trade mark uses a mark that is identical to the registered trade mark, it shall amount to an infringement. This buttresses that registration of a trade mark entitles the proprietor to sue or institute an action for any infringement of such mark or to prevent unauthorized use of the mark.<sup>2</sup> In *British American Tobacco (Nig.) Ltd & Anor v International Tobacco Company Ltd*,<sup>3</sup> it was held that an infringement of trade mark would arise where a person, not being the owner or a registered user, makes use of a mark which is identical or closely resembles an existing trade mark. Registration of a trade mark entitles the proprietor to sue or institute an action for any infringement of such mark or to prevent unauthorized use of the mark.<sup>4</sup> In *EBS Ltd v Evans Medical Plc & 4 Ors*,<sup>5</sup> the plaintiff alleged that the defendants infringed its registered trademark used on its pharmaceutical products. It was held that the plaintiff in an action for infringement must establish that he has a proprietary right over the trade mark or that he is a registered user and entitled to use and in addition he must prove that the defendants have acted or threatened to act in such a way as to infringe on his right conferred on him after the registration of the mark under the Act. The mark complained about must be identical with or confusingly similar to the registered mark.<sup>6</sup>

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<sup>1</sup> Trade Marks Act, Cap T13 LFN 2004, Section 3

<sup>2</sup> *Dyktrade Ltd v OmniaNigeria Ltd* (1997-2003)4 IPLR 250

<sup>3</sup> (2003-2007)5 IPLR p 285, 280, 272

<sup>4</sup> *Dyktrade Ltd v OmniaNigeria Ltd* (1997-2003)4 IPLR 250

<sup>5</sup> (2003-2007) 5 IPLR 106

<sup>6</sup> Trade Marks Act, section 13 (1)

**Use of an identical or closely resembling trade mark and likely to cause confusion:**

The likelihood of confusion is the central focus of any trade mark infringement claim in Nigeria and it exists when consumers view the mark as similar and that the product or service it represents is associated with the source of a different product or service. The issue therefore is whether the person who sees or has seen the proposed trademark will confuse it with the existing trademark as to create confusion and be deceived that the proposed trademark is the same as the existing one.<sup>7</sup> In *Nigeria Distillers Ltd v Gybo and Sons & Anor*,<sup>8</sup> it was held that the question which is crucial in determining whether or not a name is so similar as to constitute an infringement of plaintiff's trademark, 'Bacchus' is whether the person who sees the word 'Cacchus' in the absence of the plaintiff's mark, 'Bacchus' would be deceived as to conclude that the defendant's mark is similar to that of the plaintiff. In the case of *Ferodo Limited v Ibeto Industries Ltd*,<sup>9</sup> the test for determining infringement which are factors considered by the Court before the action for infringement of trademark can succeed are as follows:<sup>10</sup>

1. The marks do not need to be identical before infringement can occur, rather there must be a similarity so great as to create a likelihood of confusion to a reasonable man.
2. The Court will consider how widely known and recognized the plaintiff's infringed mark is? And what strength does the plaintiff's mark carry?
3. There must be evidence that the defendant's mark caused confusion
4. The location of the business of the plaintiff and the defendant and how careful consumers might be when considering both businesses. Is a consumer in the marketplace likely to be confused by similar marks?
5. The Court will consider the commercial value of the infringed mark and how it is likely to affect the brand of the plaintiff.
6. The Court will also consider the intention of the defendant because the defendant could intentionally copy the plaintiff's mark to divert their business. The Court will consider if the defendant was aware of the mark before infringing on it.

Also, the Supreme Court in *Bell Sons & Co v Aka & Anor*<sup>11</sup> held that audio and visual comparison of the original mark and the infringing mark must be taken together before a conclusion is reached as to whether an infringement has in fact occurred.

**In relation to goods for which the mark is registered:**

The mark must be in relation to goods for which the mark is registered. If the registered mark is for drugs and the infringing mark is for detergent, it would not amount to infringement. Also, in relation to goods means that trade mark infringement covers only goods and not services. The Business Facilitation (Miscellaneous Provision) Act, 2022 by its paragraph 69 of the Schedule to the Act defined trade mark to include services. This follows that the Trade marks Act should be amended to incorporate the new development especially as it relates to its provision on infringement.

**3. Remedies for Trade Mark Infringement**

It is a principle of law that where there is a right, there is a remedy. It has been established that a proprietor or owner of a trade mark who has registered the trade mark has an exclusive right to use the mark to the exclusion of others, thus has a right to stop another from unauthorized use of the trademark and can bring an action for infringement of the registered trade mark. There are remedies available to the proprietor and they are aimed at preventing further infringement of the rights of a registered trade mark owner or proprietor and to compensate injured party arising from the infringement. There are various remedies available to the registered trade mark owner or proprietor which are not limited to legal action and they include:

**Cancellation and Expunging of Trade Mark**

Where the infringing trade mark has already been registered, the proprietor of the trade mark may make a formal application to the Registrar of Trade marks or to the Federal High Court for the cancellation of the trademark and the application is required to be supported by evidence of the proprietor's trademark which should precede the trademark it seeks to cancel.<sup>12</sup> Section 38 of the Trade Marks Act makes provision for the expunging of trademark from the register. Though it is for instances where an entry has been omitted or made without

<sup>7</sup>*Alban Pharmacy Ltd v Sterling Products Int Inc* (1968) All NLR 300

<sup>8</sup> (1997-2003) 4 IPLR 464

<sup>9</sup> (2004) 5 NWLR Pt 866 P 317

<sup>10</sup>O J Jegede, 'Trademark Infringement in Nigeria and Legal Remedies' 2020 <<https://www.mondaq.com/nigeria/trademark/1006792/trademark-infringement-in-nigeria-and-legal-remedies>>

<sup>11</sup> (1972) 1 All NLR (pt1) p 33

<sup>12</sup><<http://blackwoodstone.com/trademark-infringement-in-nigeria-legal-remedies>> Accessed November 2023

sufficient cause or wrongly remarked or made in error, it may not pass for an express provision for remedy for infringement. However, the Court in interpreting the section in the case of *Bethlehem Knitting Factory Ltd v Registrar of Trademarks*,<sup>13</sup> held that, any application brought under section 38 for expunging a registered trade mark must allege that the mark offends against the provisions of section 14 in that the registration was obtained by fraud, or the trademark offends against the provisions of section 11 of the Act or that there is non-use of the trademark in accordance with the provisions of section 31 of the Act.

### **Cease and Desist Notification**

The proprietor whose trade mark is being infringed, may send a cease and desist letter to the infringer with a description of the trademark that is being infringed and a warning to cease and desist from further infringing acts over the registered trade mark or face legal action.

### **Civil Remedies**

Remedies available to the proprietor under civil action include:

**Damages:** It is the monetary compensation that is claimed by a person or awarded by a Court in a civil action to a person that is injured or suffered loss because of wrongful conduct of another party.<sup>14</sup> There are general damages which arise as a result of the defendants wrongful act while special damages are referred to as incidental losses arising from the defendant's wrongful act, they are referred to as out of pocket expenses. In *Sol Pharm Ltd & Anor v Susano Pharm Ltd*,<sup>15</sup> the first plaintiff, a pharmaceutical company and registered proprietor of a trademark used on its antibacterial drug known as STAN-DS marketed by the second plaintiff. The plaintiffs contended that the defendant introduced into the market, a product known as STAR-DS and has been passing off same as the plaintiff's product, STAN-DS. The Court held that the defendant's mark is calculated to deceive and capable of deceiving consumers, the court restrained in perpetuity the defendant from further infringing the plaintiff's trademark and a general damage of Two million naira was awarded. The Court further stated that in any infringement case, for a plaintiff to claim special damages, he must produce evidence as to loss suffered as a result of the defendant's passing off his goods.

**Injunction:** An injunction is granted by the Court against the defendants to restrain him from continuing with the infringing act. In *Ayman Enterprises v Akuma Industries*,<sup>16</sup> the Court granted an injunction restraining the defendants from selling or distributing their products which were similar in names, logo and get up.

**Delivery Up:** Where the Court grants this remedy, it is required that the defendant delivers the infringing goods up for destruction. In *Beecham Group Limited v EsdeeFood Products Nigeria Limited*,<sup>17</sup> where the plaintiff/respondents were the registered proprietors of the trademark 'Lucozade' and sued the defendants/appellants who offered for sale a non-alcoholic beverage under the trademark 'Glucos-Aid', the Court found that 'Glucos-Aid' is confusing in sound to 'Lucozade' and would likely mislead the public. The Court restrained the defendant and further held that the defendants should deliver upon oath for destruction all the goods, cartons, wrappers, blocks, discs or stamps bearing any mark or get up that would be in breach of the injunction granted.

**Account of Profit:** It is an equitable remedy that entitles the plaintiff to the profit the defendant made from the unauthorized use of the trademark which may exceed the damage which the plaintiff suffered.

**Anton Pillar Order:** It is an injunctive relief made by an ex parte application to enable access into the defendant's premises for the purpose of taking possession of the infringed products.<sup>18</sup> In *Mars Incorporated v Nutra Foods Limited*,<sup>19</sup> the court held that Anton Pillar order is an exceptional remedy which must be granted with due circumspection, and it requires the exhibit of utmost good faith by the applicant. Also it has been stated the order should only be granted if there is grave danger of the properties being smuggled away or vital evidence being destroyed.<sup>20</sup>

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<sup>13</sup> (1983) FHCLR 181

<sup>14</sup> <[www.hosseinilaw.com/types-of-damages-in-civil-litigation](http://www.hosseinilaw.com/types-of-damages-in-civil-litigation)> Accessed November 2023

<sup>15</sup> (2003-2007) 5 IPLR 413

<sup>16</sup> Unreported case FHC/L/CS/674/96

<sup>17</sup> (1981) FHC/L 177

<sup>18</sup> O J Jegede, *art cit.*

<sup>19</sup> (1997-2003)4 IPLR p200

<sup>20</sup> *British American Tobacco Nig. Ltd v International Tobacco* (2003-2007)5 IPLR p293, 294

**Impoundment:** This is the seizure and retention of the infringing goods by the Court. Where the registered proprietor is aware of a likely infringement on its mark, he can apply to the Court to grant an order for a search and cease where the premises of the infringer is searched without notice and all infringing goods found seized or impounded by the Court.

### **Remedies or Liability under Criminal Proceedings**

**Merchandise Marks Act:** The Merchandise Marks Act prohibits and criminalizes the forgery of registered trade mark by unauthorized persons.<sup>21</sup> Anyone found guilty of the offence shall be liable for imprisonment for a term of two years or to a fine or both if convicted by the Federal High Court but if it is summary conviction under the Magistrate Court such shall be liable to imprisonment for a term of six months or to a fine of One hundred Naira or forfeiture of article, instrument, chattel, or thing by means the offence was committed.<sup>22</sup> The punishment prescribed by the Act is too low and cannot deter offenders and need as a matter of urgency be amended.

**Trade Marks Act:** Where a false entry has been made in the trade mark register and the person is aware of the fact that the contents are not true, the person shall be liable to an imprisonment of seven years or for a fine not exceeding two hundred Naira.<sup>23</sup> A person that makes a misrepresentation as to claim that an unregistered mark is registered will also be convicted of this offence and shall be liable for imprisonment or fine.<sup>24</sup> This is not an infringement against the rights of the trade mark owner but an offence of fraud and misrepresentation.

**Trade Marks Malpractice (Miscellaneous Offences) Act:** The Act criminalizes the labeling, packaging, sale or advertisement of a product in a manner that is likely to mislead as to its quality or brand name.<sup>25</sup> Any person convicted is liable on conviction to a fine of not less than Fifty Thousand Naira only.<sup>26</sup>

**Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act:** The Act prohibits the sale and distribution of counterfeit and adulterated drug or processed food and any person convicted under the Act shall be liable to a fine not exceeding five hundred thousand Naira or imprisonment for a term of not less than two years or to both.<sup>27</sup> Any person who uses an existing trademark to sell counterfeit or adulterated drugs or processed foods is liable under this Act.

**Cybercrime (Prohibition, Prevention, Etc) Act:** The Act prohibits a person from unauthorized use of the registered name, trademark or domain name.<sup>28</sup> Upon conviction under the Act the person shall be liable to a term of not more than two years or a fine of not more than five million or both.

### **Administrative Remedies from Relevant Government Agencies**

A proprietor of a registered trade mark may make a formal application to relevant government agencies seeking withdrawal, cancellation, seizure depending on the nature of infringement. Some of these relevant agencies are:

**Trade Marks Registry:** The proprietor of the trade mark may file a notice of opposition at the trade marks Registry, challenging the application for the registration of an infringing trade mark.<sup>29</sup> The Registrar of trade mark would decide whether the registration would be permitted after hearing evidence of both parties.<sup>30</sup>

**Corporate Affairs Commission (CAC):** The proprietor may make a formal application to the Commission to prohibit the registration of a name of company or partnership that violates an existing trade mark unless the consent of the owner has been obtained.<sup>31</sup> The Commission is empowered to require the change of a name that conflicts with an existing trade mark.<sup>32</sup> If the proprietor can show that the name infringes on his trade mark, the commission may cancel the name.

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<sup>21</sup> Merchandise Marks Act, Cap M10 Laws of the Federation of Nigeria (LFN) 2004, section 4

<sup>22</sup> Merchandise Marks Act, section 3(3)(a)(b)

<sup>23</sup> Trade Marks Act, section 60

<sup>24</sup> Trade Marks Act, section 61

<sup>25</sup> Trade Marks Malpractice Act, Cap T12 Laws of the Federation of Nigeria 2004, section 1(1) (a)

<sup>26</sup> Trade Marks Malpractice Act, S 1(1)(h)

<sup>27</sup> Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous) Act, Cap C34 LFN 2004, section 3(1)

<sup>28</sup> Cybercrime (Prohibition and Prevention) Act 2015, section 25

<sup>29</sup> <<http://blackwoodstone.com/trademark-infringement-in-nigeria-legal-remedies>>

<sup>30</sup> Trade Marks Act, section 20 (4)

<sup>31</sup> Companies and Allied Matters Act (CAMA) 2020, section 852 (1)

<sup>32</sup> CAMA 2020, section 30 (4)

**Nigerian Customs Service:** The trade mark owner or proprietor may seek to prevent the import and export of infringing products and to achieve this can make a formal application to the Intellectual Property Rights Unit of the Nigerian Customs Service. The Unit may seize or impound the infringing products or prevent the importation or exportation of same but this would be effective by collaboration with the trade mark proprietor of the infringed trademark.

**Federal Competition and Consumer Protection Commission (FCCPC):** The Commission is empowered under the Federal Competition and Consumer Protection Act to enter with warrant to search and seize products of counterfeiting and trade mark infringement.<sup>33</sup> The proprietor may formally report the activities of an infringer to the Commission.

#### **4. Conclusion and Recommendations**

Trade marks infringement is a crucial aspect of trade mark protection. Registration of a trade mark confers some rights to the proprietor of the mark and one of which to use the mark to the exclusion of others therefore entitled to bring an action of infringement against anyone who uses the mark without his consent. The Provision of the Trade marks Act clearly states conditions for a trade mark infringement and this includes that the proprietor must have registered his mark, the infringing mark was used without consent and the mark is identical or resembling the registered mark and it is likely to cause confusion or deception and the mark is in relation to goods for which the trade mark was registered. It does not cover services. Where there is a right, there is also a remedy. The proprietor is entitled to civil remedies, remedies under criminal proceedings and administrative remedies. There is need for amendment of the Trade Marks Act. Trade mark infringement should be widened in scope to include goods that are not in relation to goods for which the mark was registered. And also to include services. Again, trade marks infringement in Nigeria should cover cases of dilution of a famous mark. There is also urgent need for separate court different from the federal High Court to handle intellectual property matters for faster expedition of cases.

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<sup>33</sup> Federal Competition and Consumer Protection Act 2018, section 27 (1)