Book Review: Commentaries and Analysis on Nigeria's Trade Marks Act by Mark Mordi

By:

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The book on commentaries and analysis on Nigeria's Trade Marks Act is refreshing. There are limited literatures on trade marks law in comparison to other areas of intellectual property law in Nigeria. The approach adopted and the structure of the book is reader friendly and simple enough for those in the field and those new to the field to comprehend. Indeed, one of the issues in all areas of intellectual property law is clear understanding of what they entail. The passion or interest the author has for the area is thoroughly reflected in the book. Issues were teased out as commentaries; providing further knowledge on intricate areas of the Trade Marks Act in Nigeria.

The fact that the book is more practical than theoretical is a bonus. It shows the expertise of the author in this area and more of this is expected from the legal practice sector in Nigeria. Clearly, the Act is not perceived as appropriate for this era tagged the digital era, even though it is not expressly mentioned,

however it is the only legislation in existence to tackle trade mark matters, with case law. Thus this book is crucial to the commercial sector in dealing with contemporary issues. The obsoleteness of the Act is dealt with in a manner that does not condemn it, rather proffers its usefulness as the applicable law in the absence of another.

Nigeria’s streets are filled with many products, some of which have no registered trademark and cannot be protected by the Act based on the provision of section 3 of the Trade Marks Act, commented extensively on in chapter 2 of this book. Some products are imitations of other products, however difficulties may arise in bringing an action against the imitators based on the scope of protection in Nigeria which appears restricted in comparison to other countries. All these cripple economic development which is why there is a need for a better trade mark system.

A recent trade marks issue is Rite Foods’ request that NBC be restrained by court from the continued sale and promotion of the energy drink *PREDATOR*, claimed to be similar to their energy drink *FEARLESS* based on the image of the lion on both labels, on February 9, 2021 in Nigeria. The commentaries in a couple of the chapters in the book deals with such contemporary matters. In addition, the review of cases such as *Ferodo Limited & Another v Ibeto Industries Limited* (2005) 4 CLRN 1; [2004] 5 NWLR (Pt. 866) 317, where the author accurately observed that the rule in the case is applicable, if a mark contains more than one component and there is no disclaimer as to the non-distinctive component of the mark, the proprietor of such a mark would have the exclusive right to use the parts that are distinctive features of the mark. The combination of commentaries and reviews of cases are creatively merged and enlightening.

Chapter one - "The Registrar and the Register" covers sections 1 and 2 of the Trade Marks Act. Section 1 is on the status of the registrar and the register. The registrar is in charge of the register and regarded as a juristic person, due to the capacity in certain circumstances to sue or be sued in section 56 of the Trade Marks Act. In addition to the administrative duties of the registrar, there is a quasi-judicial role creating various responsibilities. The register of trade marks is perceived as a public record and indeed it is one, since it is open to public scrutiny upon payment of the required fee.

Chapter 2 – "Effects of Registration and Non-Registration" includes section 3 of the Trade Marks Act, a controversial section on the effects of registration and non-registration in bringing an action of infringement based on passing off. According to the author, ‘at the heart of law of trade marks is a legal protection scheme meant to protect persons who have registered a trade mark which they intend to apply to goods and products going into streams of commerce.’ This statement is a reflection of how crucial section 3 is to trade marks and commerce in Nigeria. Chapter 2 confirms that section 3 does not provide protection for unregistered trade mark subject to the exception in section 7 of the Trade Marks Act.

Nevertheless, it is perceived that section 3 makes available protection in common law for unregistered trade mark based on the tort of passing off. Common law protection of passing off is corroborated in this area with the case of *Patkun Industries v. Niger Shoes Manufacturing Co. Ltd.* (1998) S.C. 189/1987. Even though the proprietor of an unregistered mark cannot benefit from the exclusivity of use of a mark conferred in sections 5, 11, 13 of the Act, however, an action can be brought for tort of passing off, where there is a similarity of marks.

The high of this part of the chapter is the exception to section 3 which appears logical. The example provided is based on ‘a prior registration in Nigeria effected in bad faith…the purported prior registration in Nigeria is open to being impugned and expunged under rectification proceedings in section 38(1) (b) and (c) of the Act’. Thus, it is perfectly possible that a prior registration could lose its registration to an unregistered trade mark. Though this claim is intricate, it is doable in raising a defense for the proprietor of the unregistered trademark.

The jurisdiction of courts on passing off is explored through the cases of *Ayman Enterprises Ltd. v. Akuma Industries Ltd*., where it was held that an action for passing off on an unregistered trade mark cannot be brought to the Federal High Court which has exclusive jurisdiction on intellectual property matters in Nigeria. However, in the case of *Omnia v. Dyktrade* it was held that even though the Federal High Court has exclusive jurisdiction over trade mark infringement actions and passing of actions in respect of registered trade marks, the State High Courts can also entertain passing off actions in respect of

unregistered trade marks. The essence of the classification of goods and the duty of the registrar in section 4 is also examined in this chapter.

Part A and B registration of trade marks is tackled in this chapter as well. There have been comments over the years that this form of registration system should be expunged since it is no longer practiced in the terrain (United Kingdom) it was copied from, years ago. Nevertheless the registration process in both parts is comprehensively explored to show how it operates, since it is the applicable registration process in Nigeria till date. Interestingly it is stated categorically that there appears to be no distinction between the two forms of registration at the Trade Marks Registry. One is curious as to whether it is due to lack of knowledge of the existing distinction or there is indeed no distinction even though the Act states otherwise. The distinction in Part A and B is further explored in chapter 3, in section 9 and section 10.

It is claimed that section 7 allows a prior user of a similar mark (usually unregistered) protection against a proprietor of an identical registered trade mark. Regardless of the fact that it may contradict sections 5 and 6, it is seen as a form of defence, where the unregistered user has been in continuous use of the mark prior to the date of first use of the registered mark or where the unregistered user has been in continuous use of the mark prior to the date of registration of the registered mark. Simply, this provision in section 7 is an exception to the provisions in Section 5. Section 8 provides further exceptions to exclusivity rights.

Commentaries and analysis on sections 9, 10 and 11 dwells in Chapter 3 - "*Essential Qualities that Make Trade Mark Registrable*". Section 9 makes reference to a certification mark (defined in section 43 of the Act). Basically section 9 provides the requirements to qualify for registration in the Act. The concept of distinctiveness is one of the requirements found in subsection (1) (e) and (2), which is the major distinction between Part A and B registration earlier discussed above. Whether this distinction is still necessary has often been debated on by scholars and those in practice. Perhaps the reason why there is no difference at the Trade Marks Registry is the fact that it has become unnecessary to have two registration systems based on distinctiveness. It is worthy of mention that the requirement of distinctiveness does not apply to certification marks. In addition a trade mark that that is associated with a

geographical name, surname or location will not in all cases qualify as registrable, Section 9 on Part A registration is comprehensively explored by the author, as well as section 10 on Part B registration. The other chapters including Chapter 4 ("*Identical and Resembling Trade Marks Not to be Registered*"), Chapter 5 ("*Procedure for Registration of trade Marks and the Conduct of Opposition Proceedings*"), Chapter 6 ("*Associated Marks and Resembling Marks*"), Chapter 7 ("*Assignment and transmission Procedures for Trade Marks*"), Chapter 8 ("*Use and Consequences of Non-Use of trade Marks*"), Chapter 9 ("*Rectification and Correction of the Trade Mark Register*") even though equally as important as the first three chapters are clear regarding procedures which is not necessary to dwell on in this review.

Chapter 10 – "*Certification of Trade Marks*" inquires further into certification marks as the subject of regulation in section 43, identifying its unique feature in administering the use of the mark by others, if they adhere to the standards provided by the proprietor. Section 44 on the other hand provides protection and priority to foreign trade marks in Nigeria. Chapter 12 ("Regulation"), Chapter 13 ("*Powers and Duties of Registrar*"), Chapter 14 ("*Legal Proceedings and Appeals*"), Chapter 15 ("*Evidence*") Chapter 16 ("*Offences, and Restraint of the Use of Arms of Nigeria*"), Chapter 17 ("*Miscellaneous and Supplemental*") are well laid out in the subsequent chapters.

The commentaries and analysis in the book creates the required ease in interpreting the contents of the sections for readers across board, including students, legal practitioners, judges, policy makers and those in academia. I believe the book has done the job it sought to do. The author should be proud of his achievements in this area of intellectual property law. Without a doubt it is well suited for the environment it is written with the simplicity of language and structure.

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