A Review of Commentaries and Analysis on Nigeria's Trade Marks Act By Mark Mordi

By:

John Onyido

February 11, 2022

The author has carefully identified a vacuum in trademark law and practice in Nigeria and has admirably undertaken the herculean task of filling that gap by bringing to bear a solid 25-years of active and diligent practice in the field. Whilst the availability of local texts on the subject are few and far between, none has attempted to provide a practical guide to trademark law as practiced either before the registry or before the federal high courts. Mark Mordi's book is likely to be well-received and appreciated by practitioners, the lawyers employed at the Trade Marks registry, scholars, researchers, and judges alike both for the comprehensive treatment of the subject and the erudite rendering of the issues. A review of the intimidating 526 page tome will readily impress on the reader the remarkable industry and intellectual exertion expended in putting it together.

Trademark protection has been justified based on preventing consumer deception, ensuring commercial morality, and shielding the trademark proprietor's business goodwill from misappropriation. However, the formalistic conception of trademark protection appears to have been superseded by a functional justification premised on pragmatic economic analysis espoused by the Chicago School. The importance of trademarks and trade names and the diverse roles they play in business dealings and especially in the modern information era were aptly captured by Judge Easterbrook in ***Scandia Down Corp. v. Euroquilt, Inc.***, 772 F.2d 1423 (7th Cir. 1985), cert. denied, 475 U.S. 1147 1986 when he reasoned that:

> Trademarks help consumers to select goods. By identifying the source of the goods, they convey valuable information to consumers at lower costs. Easily identified trademarks reduce costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market. A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality.

The author captures the same thinking at p. 25 of the book, where he states:

> In the current economic climate where intellectual property is being increasingly deployed through branding of products and the use of trade names to create market awareness and recognition for commercial success, the prompt registration of the intellectual property subsumed in a mark is expedient for any business or corporate body in order to protect its goodwill, market recognition, ensure priority over rival or similar marks and to be accorded the protection guaranteed under the TMA.

In modern terms trademarks must take cognisance of consumer needs beyond the protection of proprietary rights. It should reflect popular culture, market dynamics, competitive choices and economic efficiencies. *"Brands may give us a positive inking as to a proprietor or a premier provenance, but modern trademarks are equally or more likely to convey, among a multitude of other messages, personality, purpose, performance, preparation, properties, price,*

position and panache…”. Achieving these aspirations requires a more than average understanding of the rudiments of trademark law by practitioners who support their clients with their legal expertise and an appreciation of the substantive and procedural aspects of trademark maintenance and prosecution in varied arenas. *Commentaries and Analysis on Nigeria’s Trade Marks Act* has been meticulously penned to address the respective needs of practitioners (whether representing trademark applicants, proprietors of existing registrations or interested third-parties), agency staff or judicial officers. The author accomplishes this by identifying the corresponding responsibilities of each player as enshrined in the **Trade Marks Act** and the regulations in clear and lucid language.

The local statute is tailored substantially to conform with the **English Trade Marks Act 1938** and in the process of elucidating on the sometimes obscure provisions of the Act, the author has perceptively channelled the decisions of English Courts interpreting in the process the relevant provisions, which the reader will find most helpful. The author has also done the yeoman’s job of identifying and analysing relevant foreign decisions from Europe, the United States, Canada, and Australia expatiating on judicial decisions in other common law jurisdictions scattered in difficult to access law reports like the Report of Patent Cases (RPC) and the Fleet Street Reports (FSR) not readily available to most local practitioners. On a more subtle and inconspicuous level, the author remarkably draws out the fluid interconnectedness of the provisions of the Act likely to be unveiled to a seasoned practitioner but not readily apparent to the occasional dilettante.

In addressing the provisions of the Act relative to agency staff and practice, the author distils salient provisions that highlight the duties and responsibilities of the Trade Mark Registrar and the registry, to those who carry on business before that agency. While a number of these duties and responsibilities are obvious on their face, some of these could be and are mostly glossed over by practitioners who may not pay attention to them and more disturbingly, neither does the registry comply with these obligations. As examples, the registry has a duty to notify trademark proprietors of the impending renewal of their marks in good time before such renewals fall due under section 23. The registry is expected to carry out a thorough search of the registry’s database prior to issuing acceptance letters to applicants, and while this responsibility is usually

carried out for the most part, it is anything but thoroughly and effectively done – a situation not unconnected with the absence of a comprehensive digital database of all registered marks.

The impact of this shortcoming is that trademark applications that should not have been accepted for registration find their way through the maze, leaving the task to the opposition stage to hopefully capture and resolve. Other instances include the provisions on limitations as to colour under section 16 and the fact that the registry does not make allowances for the registration of trademarks as a series as anticipated pursuant to section 25. The fact that the anticipated proceedings arising from the application of section 41 rarely ever occurs and neither does the registrar award costs in deserving cases even though he enjoys this power under section 47 of the TMA are still additional instances in the book.

The practitioner will find very useful and informative commentaries in the book dealing with the opposition process under section 20, the onus of proof and powers of the registrar to extend time as well as other avenues, beyond the opposition process, to rectify the register. Similar commentaries addressing the rationale for the introduction of some provisions in the Act like sections 24 on associated and resembling marks, in contrast to section 32 on defensive registration of well-known marks; the provisions on non-use under section 31 and the recordation of registered user agreements under sections 33 and 34 of the Act will surely come in handy. The book provides very valuable guide on the registrability of proposed trademarks that could introduce some consistency to the registry practice if implemented.

Particularly illuminating is the author's review of the provisions of section 13 on identical and resembling trademarks likely to deceive or cause confusion in the course of trade, as he isolates four (4) standards of review on likelihood of confusion from a careful analysis of important judicial decisions like ***Alban Pharmacy v. Sterling Products*****,** Parle Products (P) Ltd. v. J.P Mysore, Planet Art LLC v. Photobox Ltd., ***Paterson Zochonis & Co. Ltd. v. Chami & Co. Ltd*** and ***Bell Sons & Co v. Godwin Aka & Ors***. These standards according to the author are the general recollection test, the essential features test, the common elements test and the ear and eye (auditory and visual) test, respectively.

With the sometimes conflicting decisions emanating from the federal high court bench and the Trade Marks tribunal, compounded by the less than optimal legal analyses reflected in those decisions, a practice book like the one under review provides our judges and agency staff with useful authorities and clear guidance on the proper interpretation of the provisions of the Act, which will probably result in a clearer and more lucid accumulation of a body of precedential material on the subject.

Although the text sufficiently addresses important provisions of the Trade Marks Act, it has carefully avoided wading fully into some controversial topics like those dealing with the jurisdiction of the federal high courts to entertain passing off actions *simpliciter*, the protection of well-known marks in Nigeria beyond the provisions on defensive registrations, even though the apparent position of the author seems to be that the recognition and enforcement of famous marks is implied.

On a related note, the book provides important commentaries on section 44 of the TMA which captures international arrangements to which Nigeria may be subject and underscores its redundancy since a critical threshold event for the operation of the special regime anticipated by virtue of that provision is lacking. Furthermore, the book alludes to the controversies surrounding the registration of service marks following the 2007 amendment of the Trade Mark Regulations under the powers granted to the registrar by virtue of section 45. Throughout the text, the author makes very useful recommendations either for the amendment of the current statute or for needed adjustments to agency practice to more effectually accomplish the intention of lawmakers and address the exigencies of the times. His recommendations for the creation of a multi-agency virtual database which would be easily accessible to complementary agencies and the adoption of an ADR panel of neutrals to mediate disputes within the context of section 13(3) TMA and indeed an ADR scheme by the Federal High Court within the ambit of section 17 of the Federal High Court Act are the most notable. In furtherance of the author’s resolve to nudge the registry and stakeholders towards needed amendments and reform of applicable laws, he draws the attention of the reader to the opportunity available to the registrar to canvas for law review via the statutory requirements imposed on the registrar by section 48 of the Act.

The intersection of the functions of the federal high courts and the Registrar of Trade Marks can be cause for some angst among practitioners. Accordingly, the author has in significant portions of the book given clear guidelines on when it would be appropriate to seek legal remedies in a court of law rather than before the registry. For instance, in the process of articulating the various grounds under which rectification proceedings may be initiated by interested parties, the author argues forcefully and convincingly that the word 'may' adopted by the lawmakers in section 38(3) of the TMA should be construed as imposing a mandatory duty on the registrar to seek judicial intervention to side step a likely abuse of administrative authority.

The author underscores and situates the task of the Registrar of Trade Marks and the Trade Marks Registry against the wider overarching prescriptions of fundamental legal principles of justice and fairness in exercising quasi-judicial functions, respect for constitutionally guaranteed rights and the adoption of the civil procedure rules of the federal high courts in appropriate instances. The book references the provisions of Order 53 Rules 1-7 of the ***Federal High Court Civil Procedure Rules 2019*** in terms of legal proceedings emanating from the registrar. The original and supervisory powers of the federal high court and the applicable standards of review are carefully scoped out while arguing at the same time that in terms of sections 54, 55 and 56 of the TMA the federal high courts should review matters based on a full re-hearing in preference to merely exercising its supervisory powers. In commenting on the original and supervisory powers of the federal high courts, the book makes the strong argument that the provisions of the TMA relating to opposition proceedings do not conflict with the jurisdiction of the federal high courts under section 251(f) of the 1999 Constitution, citing to the ongoing lawsuit in ***Dyson Technologies Ltd. v. Nulec Industries*** CA/L/300/2014 and the doctrine of exhaustion of administrative remedies.

Although the book could use a more exhaustive indexing, it is remarkable that in comprehensively analysing and assessing the provisions of the Act and drawing important references to caselaw and foreign statutes of persuasive influence, the author to his credit has kept typographical errors and omissions in the text to an unavoidable minimum. The inclusion of flow-charts and diagrams interspersed throughout the book will aid in better assimilation and appreciation of the topics addressed and the important interrelationships

between internal registry processes and the role of the registry and the courts in superintending trademark matters. This publication is highly recommended to any serious practitioner of the subject and to all those who have a part to play in the administration of justice either before the Trade Marks Registry or the Federal High Courts and other superior courts of record in Nigeria.

View online: A Review of Commentaries and Analysis on Nigeria’s Trade Marks Act By Mark Mordi

Provided by Afronomicslaw