

Nigeria: Legal Protection Of Product Dresses Under Nigerian Law

Article by Chike B. Okosa of Jachin Boaz

Definition And Registrability

A trademark 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 as registered user to use the mark, whether with or without any indication of the identity of that person.¹

The Trademarks Act had established Registers A and B for the purposes of registering trademarks that satisfy different requirements. Currently, the duality is moribund in practice, so that any trademark that satisfies either requirement is registered in the mono Register.

Beyond being a name; or signature; or invented word or words; or words having no direct reference to character or quality of the goods, a mark may be registered as a trademark if it is merely distinctive.²

For the purposes of the section, "distinctive" means adapted in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists.³

Outside of the distinctiveness requirement above, a trademark is also registrable if it is capable in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trademark is or may be connected in the course of trade from goods in the case of which no such connection subsists.⁴

Registration Of Trade Dresses

It is permitted during registration to limit the subsequent use of a trademark, in whole or in part, to one or more specified colours.⁵

In practice most applicants register their trademarks without limitation of colour. This enables them obtain the benefits of section 16(1) of the TradeMarks Act which provides that where a trademark is registered without limitation of colour, it shall be taken to be registered for all colours.

Although the Act permits a limitation as to colours, applicants are not permitted an exclusive appropriation of colours. Where a trademark proposed to be registered consists of a single colour without more, the application will be refused.

Where the trademark consists of a mark in addition to, or superimposed on a coloured background, the application for registration of the mark must state that application for registration is in respect of the mark and its "device". Failing this, the registration will be deemed limited to the mark, and the accompanying device will not be protected for its non-inclusion in the application for registration.

However, if the accompanying "device" is merely a single colour without any interposing design, the application is accepted subject to, an express disclaimer by the applicant that it concedes a non-exclusive use of the accompanying colour.

The refusal by the registry to grant an exclusive use of single colours is founded on the position that colours without more lie in the public domain, and may not be appropriated by a single proprietor for its exclusive use.

Even where an applicant seeks to produce evidence of secondary meaning of the colour, the Registrar invariably rules against granting registration of single colours.

Where however, an application consists of a combination of colours, either alone or in addition to any other mark, arranged in such a manner as to be distinctive, it may be accepted for registration.

Where the combination or colours sought to be registered stands alone, the application for registration is valid if it sufficiently identifies the combination of colours as the trademark sought to be registered.

Protection Of Registered Trade Dresses

If the combination of colours is in addition to any other mark or representation, the combination of colours is normally identified and registered as the accompanying "device". Upon completion of the registration, the proprietor is entitled to legal protection of its exclusive use of the combination of colours registered. If it is registered as a device, the device may be used alone or in addition to the accompanying registered representation.

Where therefore, a proprietor desires to use a design or get up as a trade dress, he must seek and obtain a registration of the get up sought to be used in order to obtain legal protection of its use.

Where the trade dress is properly registered as a get up or device, the proprietor is entitled to maintain an action in statutory passing off of the registered trade dress in addition to the action for infringement of the registered trademark.

Where the trademark and trade dress are registered, the cause of action in passing off is a statutory cause of action independent of the common law action in passing off, and the proper forum for the trial of the case is the Federal High Court.⁶

Section 3 of the Trademarks Act provides that no person shall be entitled to institute any proceeding to prevent, or to recover damages, for the infringement of an unregistered trademark.

Protection of Unregistered Trade Dress

Where the trade dress is not registered, the proprietor will be unable to obtain legal protection under the Trademarks Act for its infringement.

The present controlling authority is the case of **Ferodo Ltd v. Ibeta Industries Ltd.**⁷ The appellant's trademark "Ferodo" was used for marketing automobile brake pads and linings. The representation that accompanied the appellant's application for registration gave the name of the trademark as "Ferodo". The representation was a red rectangle, at the upper end of which was a smaller black rectangle, inside which the name "Ferodo" was printed in white and the lower end of which said red rectangle ran a black and white checkered strip. The application for registration did not specify that registration was sought for the accompanying device or design. Registration was granted for the trademark "Ferodo". The trade dress of the appellant's goods comprised the word "Ferodo" and all the garnishing contained in the representation. The respondent introduced into the market its own brand of brake pads and linings, which it marketed under the trademark "Union". The appellant contended that the trade dress of the respondent's "Union" was similar to the trade dress of its "Ferodo". The appellant sued for statutory infringement and passing off for the respondent's purported infringement of its registered trademark. The Court of Appeal held that what the appellant registered was "Ferodo", and that where the proprietors decided to garnish a trademark with other colourations and devices which make it appealing and decorative, it cannot be assumed that the fanciful and ornamental characters which colour the package form part of the trademark. In the absence of registration the alleged use of the trade dress by the appellant was held by the Court not to give them monopoly over the use of red cardboard paper.

The action failed.

In the absence of registration of a trade dress, a statutory action for infringement or statutory passing off cannot be sustained. This however does not preclude a common law action for passing off.

Common law, equity and statutes of general application in force in England on January 1, 1900 are applicable in Nigerian. This is through the instrumentality of various reception laws.

The High Court Laws of a typical state in Nigeria contain a provision that the High Court shall in addition to any other jurisdiction conferred by the Constitution of the Federation or by any other enactment, possess and exercise all the jurisdiction, powers and authorities which are vested in or capable of being exercised by the High Court of Justice in England.⁸

Where there is a passing off of an unregistered trademark, get up or trade dress, the remedy lies solely in a common law action in passing off.⁹

The High Courts of the States have a general constitutional jurisdiction to hear and determine any civil proceedings in which the existence or extent of any legal right, power, duty, liability, privilege, interest, obligation or claim is in issue.¹⁰

Where the cause of action for passing off is in common law for tort, the proper forum for the action is the High Court of the state in respect of which the cause of action arose.

Beyond this, and other than this, there is no other remedy under Nigerian law for the infringement of an unregistered trade dress.

Endnotes

1 Section 67 of the Trade Marks Act, 1967, Chapter 436 Laws of the Federation of Nigeria 1990.

2 Section 9(1) of the Trade Marks Act.

3 Section 9(2) of the Trade Marks Act.

4 Section 10(1) of the Trade Marks Act.

5 Section 16 of the Trade Marks Act.

6 *Ayman Enterprises Ltd v. Akuma Industries Ltd* [2003] FWLR Part 166, page 563

7 [1999] 2 NWLR Part 592, page 509.

8 This provision is contained in section 10 of the High Court Law of Lagos state, and is fairly representative of the High Court Laws of the other states of the Federation.

9 *Ayman Enterprises Ltd v. Akuma Industries Ltd* (supra)

10 Section 272(1) of the Constitution of the Federal Republic of Nigeria, 1999