

ACTIONS FOR PASSING OFF AND INFRINGEMENT OF UNREGISTERED MARK IN NIGERIAN COURT; REVISITING THE ISSUES ARISING FROM THE EXCLUSIVE JURISDICTION OF THE FEDERAL HIGH COURT

**BY
JOSEPH JAR KUR Ph.D.***

Introduction

In Nigeria, the 'Informal' Protection of rights by the tort of passing off closely resembles the formal rights created by trademark law. Passing off is a common law tort which can be used to enforce an unregistered trade. This provision is in consonance to the fundamental maxim of law which is *Ubi Jus ibi remedium* (which literally means, where there is a wrong, there is a remedy". In other words, an owner of unregistered goods or services is not without legal remedy upon infringement of his marks by defendant. The legal remedies which are recognised by the common law in this regard are as in the grant of injunction (either interlocutory or perpetual). Recovery of the profit made by defendant, damages and in some cases Anton Pillar order. A plaintiff or claimant suing for passing off must know what court to approach to enforce his rights. The issue of jurisdiction therefore becomes germane. This article therefore has examined whether an action for the infringement of a registered trademark and passing off of same is within the jurisdiction of the Federal High Court. It has also considered whether an action of passing off of an unregistered trade mark which same is regulated by common law action also confers jurisdiction on the Federal High Court.

Conceptual Meaning of Passing Off

Attempts to define 'passing off' has been, at times, confusing in that, 'this is not a branch of the law in which reference to other cases is of any real assistance except analogically',¹ hence its development, is based on a case by case basis and different factual situations have led to an expansion of the law.² Passing off is defined as a misrepresentation in the course of trade by one trader which damages the goodwill of another.³ When it is said that something is passed off as something, it means no more than that something is falsely represented as something.⁴ The basic underlying principles of the tort of passing off which closely resemble the protection accorded to Trademark Laws⁵ has long been stated to be that, "a man is not to sell his own goods under the pretence that they are the goods of another man".⁶ The right which is the subject matter of passing off action is the Property in business or goodwill likely to be misrepresented. This general position until recently was accepted as the modern form of passing off as was defined by Lord Parker in *Spalding & Bros v. AN Gamage Ltd.*⁷ where the court held that:

* Ph.D, B.L; Lecturer, Department of Private and Public Law, Benue State University

¹ Per Lord Oliver in *Reckitt & Coleman Products Ltd Vs. Borden Inc* (1990) 1 All ER 873, (1990) 1 WLR 491

² *Erven Warnink V J. Townend & Sons (Hull) Ltd* (1979) AC 731, (1979) 2 All ER 927

³ Davis J., *Intellectual Property Law* (Oxford: Oxford University Press 2008) p. 143

⁴ Per Agbaje J.S.C. In *Patkum Industries Ltd Vs. Niger Shoes Manufacturing Co. Ltd* (1988) 5 NWLR (Pt. 93) p. 138

⁵ Trade mark Act 1994 (United Kingdom) And Trademark Act Cap T. 13 Laws of the Federation of Nigeria, 2004

⁶ *Perry v. Truefitt* (1842) 6 Beav 66,49 ER 749

...the basis of a passing-off action being a false representation by the defendant, it must be proved in each case as a fact that the false representation was made. It may, of course, have been made in express words, but cases of express misrepresentation of this sort are rare. The more common case is where the representation is implied in the use or imitation of a mark, trade name, or get up with which the goods of another are associated in the minds of the public, or, of a particular class of the public. In such cases the point to be decided is whether, having regard to all the circumstances of the cases, the use by the defendant in connection with the goods of the mark, name, or get up in question impliedly represents such goods to be the goods of the plaintiff, or the goods of the plaintiff of particular class or quality, or, as it is sometimes put, whether the defendant's use of the mark, name, or get up is calculated to deceive. It would, however, be impossible to enumerate or classify all the possible ways in which a man may make the false representation relied on.⁸

It is useful to assert at the outset that, the preeminence of the tort of passing off is the protection of both consumers and the business concern of the claimant from the activity of the offending trader from the effect of confusion on the goodwill in trade. That confusion is generated by the activity of a trader in causing his or her goods or services and/or their presentation to become confused with those of the claimant, and that protection is afforded by the grant of a right of action to the trader whose economic interest and trading goodwill are harmed by the confusion.⁹

The inefficiency of the Spalding case led to the development of a more classic definition of passing off where Lord Oliver endorsed Lord Diplock's definition in the 'Jif Lemon' case¹⁰ that:

First the plaintiff must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public ... secondly, he must demonstrate a misrepresentation by the defendant... thirdly, he must demonstrate that he suffers or, in a quid timet action ...

Lord Diplock's definition has reduced the key elements of passing off action to three key elements; goodwill, misrepresentation and damage and their classic definition has continued to be authoritative as evidenced in the dictum of Sanyaolu J., in *Ayeman Enterprises v. Akuma Industries*, where he held that, 'the rights upon passing off accrue to one who can show goodwill or reputation linked to his mark and that misrepresentation and damage usually flow from a finding of an assault on the plaintiffs goodwill'.

Relationship between Passing Off and Trademark

The Protection offered to a trader by a passing-off action, on the one hand, and by a registered trademark, on the other hand, may on some points overlap although there exist some differences. The first however is that, in passing off there is no property in the

⁷ (1915) 32 RFC 273

⁸ Ibid

⁹ Wadlow C., The Law Of Passing-Off: Unfair Competition by Misrepresentation, 3rd Edition (London; Sweet and Maxwell 2004) p. 236

¹⁰ *Rockitt & Coleman products Ltd V. Borden Inc* (supra)

relevant name or other indicia, as there is in a registered trade mark.¹¹ Instead Passing off Protects the claimant's ownership of his goodwill or reputation, which may be damaged by the defendant's misrepresentation?

'Passing off is a cause of action that is primarily founded in tort and is historically rooted in common while rights in trademarks are traceable to the British Statute of General Application that were in place in Britain on the 1st of January, 1900 and at present in Nigeria is governed by the Trademark Act.¹² Under the Act, when a mark has not been registered, the issue of passing off arises as a common law remedy. If such a mark be registered, the issue becomes that of an infringement of a registered mark simpliciter and the cause of action in "passing-off then has statutory favour under the Trademark Act.

Nonetheless, it is clear that, in some respects, the protection offered by passing off may be wider than that endowed by trademark registration. Instance of this can be found in *United Biscuits (UK) Ltd v. Asda Stores Ltd.*¹³ where the penguin/puffin' case, where the defendant marketed a biscuit whose packaging was similar in a number of respect to the penguin biscuit, the claimant was able to obtain an injunction to prevent passing off, but failed in trademark infringement, because the precise marks, the Pengium and the puffin, were not sufficiently similar.

In Nigeria, as elsewhere, the major purpose underlying the tort of 'passing off is the protection of an established trade goodwill already acquired by a trademark or trade name. It presupposes therefore, that, such goodwill must be established by the party alleging infringement.¹⁴ The Crucial issue of note here is that, the dividing line as to what constitute 'goodwill' in general for purposes of suing for 'passing off is a thin line. The existence or otherwise of a cause of action in "passing off and the existence of an established 'goodwill' would then have to be decided by the court in each particular case.¹⁵ In the case of *IRC v. Muller Margarine*,¹⁶ 'goodwill in relation to passing off was defined as "the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom' while the establishment of 'goodwill' by the claimant is a key element in succeeding in an action for "passing off', it is essential to know that, the existence of that "goodwill" alone, without more, does not in itself fulfill the other ingredients of the tort which were explained by the House of Lords in adopting the "trinity test"¹⁷ in postulating the ingredients of "passing off that:

- (i) The claimant must establish the goodwill or reputation attaching to the goods or services in question and the identifying 'get up' under which the goods and services are offered to consumers.¹⁸
- (ii) The claimant must also establish that there has been a misrepresentation by the defendant which has caused or has the potentiates of causing the members of the public to believe that goods or service emanate from the claimant.¹⁹

¹¹ Davis J., Op. cit. p. 148

¹² No 29 of 1965 (now Cap T. 13 LFN 2004}

¹³ (1990) R P C 341: *Niger Chemists v. Nigeria Chemist* (1961) 1 All NLR 171

¹⁴ Kitchen D (cd) *Kerly's Law Of Trade Marks and Trade Names* 14th cd (2005) p.

¹⁵ Ibid at 431

¹⁶ (1901) AC 217 at 223 ct seq

¹⁷ *Reckitt and Coleman Products v, Borden* (1990) 1 AER 873

¹⁸ Holyoak & Torremans, *Intellectual Property Law*, 5th Ed Oxford. Oxford University Press, 2008) p. 469

¹⁹ Ibid 473

(iii) The claimant must demonstrate that, he has suffered or is really likely to suffer losses by the reason of the defendant's misrepresentative as to the source of defendant's goods or services, which seems to suggest that they emanate from the claimant.²⁰

While the discourse on the ingredients of the tort are straight forward in theory, they do not so operate in practice when it comes to commencing actions in the courts as the claimant will be faced with the burden of the appropriate forum to sue as between the State High Courts or the Federal High Court. This and several other issues are dealt with in detail below.

The Fundamental Importance of Jurisdiction and Passing Off Infringement Proceedings

The word 'jurisdiction' has several connotations. In the realm of international law, jurisdiction or the power of a sovereign to affect the right of persons by legislation, executive decree or judgment of a Court is intimately connected with the concept of independence and of territory.²¹ In municipal law, jurisdiction is the authority of the Court to decide matters presented in a formal way for its decision.²² In the United Kingdom, jurisdiction is derived from Royal Authority and judges exercise authority or jurisdiction in the name of the state. Jurisdiction limit may be circumscribed by statute, charter or commission under which the Court is held by reference to area, subject matter or value of case, powers of punishment which may be exercised or otherwise.²³ In Nigeria, the limit of jurisdiction is set by the constitution or enabling law establishing the Court, which spells out the jurisdiction of the Court and its powers. Generally, in Civil claim, the plaintiffs cause of action determines the jurisdiction of the Court²⁴ and because of the overriding importance of jurisdiction, it can be raised at any time including on appeal for the first time in any civil or criminal proceedings. Where a Court lacks jurisdiction to entertain suit, either at the trial or appellate level, it is incompetent to pronounce judgment on the matter and any judgment given without jurisdiction is a nullity.²⁵

One most important jurisdictional issue that has always come up for determination by the Courts when an action for infringement of trade mark is instituted by an applicant in respect of an unregistered trademark is the appropriate Court to sue, whether in the Federal High or in the state High Court as an Intellectual Property Owner must know what Court to approach to enforce his right. In Nigeria, the jurisdiction of both the Federal and State High Court are constitutionally provided. Section 251(1) (F) of the 1999 Constitution provides thus:

That the Federal High Court shall exercise exclusive jurisdiction in respect of any Federal enactment relating to copyright, patent designs, trademarks and passing off, industrial designs and merchandise marks, business names, commercial and industrial monopolies, combines and trusts, standards of good and commodities and industrial standards.

²⁰ Ibid 477

²¹ Obaseki A.O. "Jurisdiction of the Courts under the 1989 Constitution of FRN" Being **Judicial** lectures delivered in Port-Harcourt in 1992

²² A.G. Anambra State v. A.G. of the Federation (1993)6 NWLR (Pt. 302) P. 692; Frank v. Abdy 2003 FWLR (Pt. 158) p. 1330

²³ Edu & Ehghelua "Revisiting the Issues Arising from the Jurisdiction of the Federal High Court in the Banker-Customer Relationship (2004) 4 The Constitution p. 50

²⁴ Galadima v. Tambai (2000) 6 SCNJ 190

²⁵ Kaduna Refinery and petrochemical Company v. Onuora (2000) FWLR (pt. 27) 1959

It is important to state categorically from the onset that, this particular paragraph (f) was not part of the 1979 Constitution and is an innovation of the 1999 Constitution.

Section 272 (1) of the Constitution 1999 provide thus:

Subject to the provisions of section 251 and other provisions of this Constitution, the High Court of a state shall have jurisdiction to hear and determine any civil proceedings in which the existence or extent of a legal right, power, duty, liability, interest, obligation or claim is in issue...

Again, it is worth not glossing over the fact that, prior to the 1999 Constitution, the jurisdiction of the State High Court was expressed to have "unlimited jurisdiction"²⁶ and this implied that in all matters, including those relating to all aspects of intellectual property protection, such as 'passing off and other supportive reliefs. State High Courts were empowered to exercise jurisdiction.

To better appreciate the complete picture and understanding of the issues at hand relating to passing off the Trade Mark Act, 2004, the national legislation on the subject matter provides:

No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered Trademark, but nothing in this Act shall be taken to effect right of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.²⁷

It is important to argue from the onset that, the policy objectives of the first part of the above provision is quite clear and unambiguous in that, it is aimed at preventing any person from instituting an action based on trademark that has not been registered but has been infringed. This is apparently meant to encourage the formal registration of trademarks by their owners while the second part of the provision suggest that non registration of any mark does not necessarily impede on a registered owner or proprietor the right to sue for registered trademark infringement and passing off since both are co-terminus.

The Dilemma of Exclusive Jurisdiction in "Passing Off" Cases

The Trademark Act²⁸ codification of the common law provisions of the tort of passing off remain the most controversial provision as it relate to questions of cause of action and Court jurisdiction in respect of proceedings in passing off. Since the clothing of the common law provision with statutory flavour or coronation, the Nigerian Courts have continued to grapple with the issue of the exercise of exclusive or concurrent jurisdiction by the Federal High Court²⁹ and State High Courts in passing off breaches. The problem of exclusive jurisdiction or otherwise was not a problem with earlier trademark legislation, since there were no alternate High Courts³⁰ and State High Courts in passing off breaches. The problem of exclusive jurisdiction or otherwise was not a

²⁶ Section 230 of the Constitution of Nigeria 1979

²⁷ Section 3, Trade Mark Act Cap T.13 LFN 2004

²⁸ T.13 Laws of the Federation of Nigeria (LFN) 2004

²⁹ Section 251 (1) and (2) of the Constitution, 1999 (CFRN 1999)

³⁰ Section 230 (1) of the Constitution, 1979

problem with earlier trademark legislation, since there were no alternate High Courts³¹ at the time and the matters had no rivalry connotations. Indeed, in several instances as listed below, the Nigerian Courts followed the trends of English courts by holding that, passing off actions were to be brought in the County Court and the High Court, although the Court of Appeal took the view that the most appropriate forum was the Chancery Division of the High Court.³²

In *Alhaji Elebute & Or v. Dr. Olugbenga Ogunkua*,³³ the Federal High Court held that, a person can only institute proceedings to prevent or to recover damages for the infringement of a trademark if the trade mark is registered and where the trademark is not registered, his remedy lies in a state High Court in an action for passing off. At the Instance case, the Court held that, the Plaintiffs trademark has not been registered and it therefore follows that by operation of law the plaintiffs are not entitled to bring the application.³⁴

Similarly, in the case of *Societe BIC S.A. v. Chargin Industries Limited and Another*,³⁵ the Federal High Court held that an action for infringement of a trade mark before the Federal High Court cannot be founded on an unregistered trade mark. In 1988, the Supreme Court was called upon in yet another relevant case in *Patkum Industries Limited v. Niger Shoes Manufacturing Company Limited* where the issue was whether the Federal High Court has jurisdiction in an action for infringement of a registered trade mark where damages for passing off of the goods had also been claimed. The Supreme Court held on appeal that a passing off action arising from the infringement of plaintiffs registered trademark is within the jurisdiction of the Federal High Court.

The Supreme Court per Karibi- Whyte JSC said:

It is not correct to assume that a right of action enacted into a statutory provision is in effective merely because it has its origin in the Common Law. This is not so. The Common Law tort of passing off in respect of other matters still exists, but in respect of trade marks. In this Country the right of action of passing off relating to the infringement of registered trademarks is statutory and can be found only in section 3 of the Trademark Act, 1955.³⁶

His lordship further held that:

Where a common law right has been enacted into a statutory provision it is to the statutory provision so made that resort must be had for such and not to the common law and that actions arising from the infringement of plaintiffs registered trade ... its common law origin notwithstanding, is clearly within the jurisdiction of the Federal High Court as a civil cause or matter...

Two issues are worth noting here in that, Patkum's case was not concerned with an action for passing off arising from an unregistered Trademark³⁷ and that the case was a pre-1988 and pre-1999 Constitution wherein section 251(1)(f) was enacted. Again, the Supreme

³¹ Section 2, Trademark Ordinance 1914 and Cap 199 LFN 1958

³² *McCain International v. Country Fair Foods* (1981) RPC 69

³³ (1990) F.H.C.L. 201

³⁴ *Ibid* at 202

³⁵ (1997) F.H.C.L.

³⁶ *Ibid* at 152

³⁷ Mustapha A. "Enforcement of Intellectual Property Rights in Nigeria" In Adegunle D et al (Ed) *Developments in Business Law* (Lagos: Legal Blitz Legal Consultants 2010) p. 242

Court was called upon in the case of *Ayman Enterprises Limited v. Akuma Industries and Ors.*³⁸ The Supreme Court held that for the Federal High Court to have jurisdiction over a passing off claim arising from infringement of a trade mark, the trade mark allegedly infringed must have been registered. This is because the right of action of passing off under section 3 of the Trade marks Act is statutory and is derived from the Act and not the Common law. In other words, it can only arise or be available where there is an infringement of a trademark registered under the said Act. The Supreme Court held that Federal High Court lacks jurisdiction in respect of a claim based on an unregistered Trademark.

It is also pertinent here to note that, various commentaries³⁹ have, argued that, the Supreme Court decision is not a correct reading of the relevant statute as throughout the breath of the entire judgment in Akuma's case to show that the attention of the Supreme Court was drawn to relevant provisions⁴⁰ of the Federal High Court which apparently conferred jurisdiction on the Court to hear and determine Common Law Tort of passing off.

It is argued by Ali⁴¹ in the same vein that, "section 3 of the Trademark Act created a right of action in 'passing off for registered trademarks as well as right to sue their infringements that do not amount to passing off. However, the section also preserves the Common Law right of action in 'passing off for trademarks that have not been registered, since unlike the former, they cannot be protected by an action for their infringement simpliciter."⁴²

The recent case of *Omnia Nigeria Ltd v. Dyke Trade Ltd*⁴³ afforded the Supreme Court an opportunity to re-examine the provisions of section 3 of the Trademark Act wherein the Court overruled itself in *Ayman* and held decisively that the Federal High Court has jurisdiction in passing off whether or not the claim is based on the infringement of a registered or unregistered Trade Mark. While others submit that this is the correct position of the law as it presently stand in Nigeria⁴⁴ others call it a well come development.⁴⁵ However, this decision from a philosophical point of view has raised more dust than has sought to settle in issue relating to the exclusivity of the jurisdiction of the Federal High Court as it relates to passing off of unregistered trademarks.

Analysis of the Legal Issues

The hallmark of jurisdictional controversy of actions founded on the tort of passing off or unregistered Trademark is predicated on section 3 of the Trademark Act⁴⁶ which provides (which at the risk of repetition provides that:

No person shall be entitled to institute any proceedings to prevent, or

³⁸ (2003) 12 NWLR (Pt. 836) 22

³⁹ Mustapha Op. cit. p. 243

⁴⁰ Section 7(1) of the Federal High Court Amendment Decree 1991.

⁴¹ Ali Yusuf "Trademark Infringements: Suing For Passing Off in Nigerian Courts" www.templars.com (visited on 16/08/2012)

⁴² Ibid p. 12

⁴³ (2007) 15 NWLR (Pt. 1058) at 576

⁴⁴ Ali Op. cit. p. 14

⁴⁵ Mustapha

⁴⁶ Cap T.13 LFN 2004

to recover damages for infringement of an unregistered trade mark; but nothing in this Act shall be taken to affect the right of action against any person for passing off goods of another person or remedies in respect thereof (emphasis provided).

This section of the Trade mark Act for all intent and purposes is dually provided. The first part prohibits the institution of any action for the infringement of an unregistered trademark while, the second part preserves the right of action against any person for passing off goods as the goods of another. This sense of reasoning is consistent with the Supreme Court when it held that: "The emphasis here is that for the Federal High Court to have jurisdiction for the passing off-claims, arising from infringement of a trademark, the trademark allegedly infringed most have been registered".⁴⁷ This reasoning is consistent with the fact that, in all trade mark infringement proceedings the plaintiff is availed the opportunity to plead in his statement of claim both the trade mark infringed and "passing off", the latter virtually providing a fall-back position if the trade mark point does not succeed.⁴⁸ The alternative remedy of 'passing off claim therefore remains a useful adjunct to an action for trademark infringement and the two are often combined. Typically this is because in trademark action it is open to the defendant to argue in its defence that the trade mark at issue is invalid or should be revoked. If the defendant is successful, it may yet be possible for the claimant to fall back on the claim of passing off.⁴⁹

It is this plea of convenience and marriage of trademark infringement and passing off remedy that is contemplated by section 3 of trademark Act and any interpretation beyond this point may amount to overstretching the issue hence the section itself has asserted thus but nothing in this section shall be taken to effect right of action against any person for passing off goods as the goods of another person or the remedies in respect thereof (emphasis mine) While it is incontrovertible that section 3 of the Trademark Act has codified the Common Law rule on passing off for the effect of giving sufficiency to the right of a registered trademark owner or proprietor so as to enable him rely on the remedy of passing off in trademark infringement, this has created two potential problems which relate to the status of codification and the scope of codification. The facts relating to codification of Common Law rules by statutes are clear in that:

- (a) Where a statutory provision is in conflict with, or differs from common law, the Common Law gives way to the statute. A statutory right may be conferred in addition to a Common Law right where there is no conflict.
- (b) Where a Common Law right has been enacted into a statutory provision it is to the statutory provision so made that resort must be had for such rights and not to the Common Law.⁵⁰
- (c) It is not correct to assume that a right of action enacted into a statutory provision is ineffective merely because it has its origin in the Common Law. This is not so. The

⁴⁷ Per Kalgo JSC in *Ayman Enterprises v. Akuma Industries Ltd* (2003) 13 NWLR (Pt. 836) 22

⁴⁸ Merett P., *Intellectual Property Law* (London: Sweet & Maxwell 1996) p. 187

⁴⁹ Davis J., *Intellectual Property Law* (Oxford; Oxford University Press) p. 185

⁵⁰ Per Karibi Whyte JSC in *Patkun Industries Ltd v. Niger Shoes Manufacturing Co Ltd* (supra); see also *Cameroon Airlines v. Abdul Kareem* (2003) NWLR (Pt. 830) at 20

Common Law tort of passing off in respect of other matters still exists, but in respect of trademarks. In this country the right of action of passing off relating to the infringement of registered trademarks is statutory and can be found only in Section 3 of the Trademark Act 1955.⁵¹

In this part, one can logically reason that, the justification for entertaining passing off reliefs of registered trademarks is to enable the Federal High Court assumes the jurisdiction to entertain ancillary and supplementary causes of action arising from the primary cause of action in respect of matters that comes before the Court on such issues with finality. The correct analysis of Section 3 was adumbrated by the Court of Appeal per Katsina-Alu JCA (as he then was) that:

In the light of this provision (that is section 3 of the Trademark Act), it is my considered opinion that a common law action of passing off can arise from an infringement of registered trademarks. It is also may view that since the statutory bar does apply to actions in respect of passing off, a plaintiff may and often does, join in one action a claim for passing off and for infringement of his registered trademark. This situation in the case in hand. The claim for passing off surely derives its existence from the infringement of the registered trademark and it makes good sense that both claims be joined in one action.

The above dictum of his lordship are faultless (to my consideration) in that, where a principal right is to be litigated upon and maintained by a Court of jurisdiction, then necessary follows that the accessory or ancillary right should naturally follow the principal right in its forum competency and convenience. This I think is the essence of conflict justice. This arm of argument has fond support even under the now Federal High Court Act where it provides '...any Federal Enactment or Common Law'⁵² which provision when interpreted conjunctively brings out the issues in clearer perspective.

On the issue of scope of codification, the analysis are based on the provisions of Section 251(I)(f), 272 and 315(1) of the Constitution. Section 251 (I)(f) of the 1999 Constitution provides that, the Federal High Court shall exercise exclusive jurisdiction in respect of "Any Federal Enactment relating to Copyright, designs, trademarks and passing off..."

That section by including 'passing off as one of the causes of action available to a trademark proprietor has invariably attempted to create a statutory right of passing off. At very best, it has only conferred jurisdiction on the Federal High to entertain actions for passing off arising from the infringement of a registered trademark. This argument is predicated on the fact that, the Trade mark Act, being the relevant 'Federal enactment' has also failed to make such enactment. It is clear that, in Nigeria, due to lack of adequate codification of the principles relating to 'passing off the Common Law provision on passing off are wider than the protection endowed under the Trademark Act. Under Nigerian Law, eligibility for registration of a Trademark is very restrictive as the registrable marks are only in relation to goods⁵³ as opposed to services⁵⁴ as well as packaging⁵⁵ as trademarks. Other categories of trademark such as symbols, Pseudonyms,

⁵¹ Ibid

⁵² Section 7 of the Federal High Court Act (as amended) 2011

⁵³ Section 67 of the Trade Mark Act

⁵⁴ Akasant (Nig.) Ltd v. UBN Ltd

⁵⁵ Trebor (Nig) Ltd v. Associated Industries Ltd

presentation or even packaging of both goods and services, shapes, perfumes etc. are not included. The question then is, where the infringement or passing off is in other areas than "goods" where then would one sue? Is it the Federal High Court or state High Court?

Section 272(1)⁵⁶ provides:

Subject to the provisions of section 251 and other provisions of this Constitution, the High Court of a state shall have jurisdiction to hear and determine any civil proceedings in which the existence or extent of a legal right, power, duty, liability, interest, obligation or claim is in issue...

This section has not in any way preclude a Common Law Right of an unregistered trademark from seeking to Protect his "legal right" or "interest" to sue any person in the High Court for action of passing off. It therefore follows that, while the Federal High Court has exclusive jurisdiction in respect of infringement of registered trademark and passing off action such registered mark, it is submitted does not enjoy exclusive jurisdiction over the Common Law action of passing off which can be entertained in the State High Court.

Conclusion

From this discourse, it is clear that the Supreme Court has rested the issue of jurisdiction on matters pertaining to passing off whether registered or not on the Federal High Court in its decision in *Omnia Nigeria Ltd v. Dyke Trade Ltd.* however, rather than solve a problem; the decision has raised more dust than settle same. There is every need for the National Assembly to amend both the Trademark Act and the Federal High Court Act to specifically allow actions for passing off an unregistered trademark to lie at the Federal High Court whether, based on a Federal enactment or the Common Law. This is no to assume that a Common Law remedy cannot evolve into a statutorily protected right, but there is clearly, distinctions between acknowledging a Common Law remedy and specifically adopting or incorporating it into a statute in the form of a codification. In adumbrating on these argument, the writer is not unaware of the purported co-opting of the Common Law remedy of passing off through the invoking of section 7 of the Federal High Court Act 2011 which now provides and use the phrase '... any federal enactment or Common Law' which provision was designed to pre-empt the field of Intellectual Property Law in favour of the Federal High Court. Comparatively, similar preempting of State Law by a Federal enactment in the field of Copyright and patent law. State trademark and unfair competition laws in the United States has not altered the position where, the law of unfair competition is codified by the Lanham Act (by virtue of section 43 (a) relating to false designation of origin and false descriptions or representations) and actions brought under the codified section are referred to as infringement of unregistered trademarks and Common Law trademark infringement, as distinct from law suits for the infringement of registered trademarks (which is provided for under section 32). The Courts have held severally that section 43 (a) cannot be a complete Federal Codification of the entire law of unfair competition as held in *Dastar Corp V. Twentieth Century Fox Film Corp.*⁵⁷ Thus, the writer submit is equally the position in Nigeria.

⁵⁶ Constitution 1999

⁵⁷ (2003) United States p. 539