

IN THE FULL COURT
HOLDEN IN LAGOS
ON THE 18TH OF OCTOBER, 1917.
BEFORE THEIR LORDSHIPS

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SPEED, C.J.
WEBBER, J.
ROSS, J.

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BETWEEN

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W.B. MACIVER & CO. LTD ... *Respondents*

AND

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COMPAGNIE FRANCAISE
de L'AFRIQUE OCCIDENTALE ... *Appellants*

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FACTS/BACKGROUND

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This is an Appeal by the French Company from the Judgment of the Divisional Court in respect of an Application for Registration of a Trade Mark No. 1703 by the Respondents, Messrs W.B. MACIVER & CO. The Trade Mark sought to be registered is in relation to a class of goods No. 47 and is in the form of a cask being coopered by three (3) coopers. The Opponents/ Appellants have already registered a Trade Mark in the same class No. 47 and the said Mark is also in the form of a cask being rolled along the ground by one man. The learned Judge in the Court below found that there was no resemblance between the two Trade Marks as would be calculated to deceive and accordingly allowed the Respondents/Applicants to have their mark registered.

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Being dissatisfied with the decision, the Appellants have now appealed to this present Court. a

SUBJECT MATTER

1. INTELLECTUAL PROPERTY LAW—TRADE MARK-TRADE MARK LAWS-ADMINISTRATION OF-NEED TO HAVE DUE REGARD TO LOCAL CONDITIONS. b
2. INTELLECTUAL PROPERTY LAW—TRADE MARK-DETERMINATION OF INFRINGEMENT c

ISSUES

1. Whether there was resemblance between the two Trade Marks as would be calculated to deceive or likelihood of confusing the two marks. d

HELD

1. **On the need to administer trade laws having due regard to local condition.**
To the trained eye of a civilised community, there is undoubtedly a considerable difference in the two Designs set side by side and the one would hardly be likely to be mistaken for the other, but while the broad principles laid down in English cases should be applied, the Trade Mark laws of this country should be administered with due regard to local condition and, as stated by Osborne, Chief Justice, in the *Houtman case*, “with a view to protecting not only a vast illiterate population little acquainted with pictorial representations, but also the pioneers of trade who have earned a reputation among these illiterate folk by the quality of goods associated with some recognised Marks such as a particular bird, animal, tree or other object.” Judge of the Supreme Court of this Colony has consistently administered these laws with due regard to local conditions and I think we should embrace this e
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a opportunity of expressing our unqualified approval of their decisions.

2. On determination of infringement

b “To the illiterate, there is no other feature connected
c with this particular Class of goods which this mark is
intended to represent, and whether the cask or puncheon
is being rolled by one man, or being coopered by three
men, no difference is discernible by the illiterate native.
d It is the cask by which he associates a particular seller
with his particular Class of goods, the other minor
features and difference he will not appreciate. The
Appeal should be allowed and the original motion that
the registration of Trade Mark No. 1703 be proceeded
with by the Registrar should be refused.”

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COUNSEL

Irving - *For the Appellants*

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Foresythe - *For the Respondents*

CASES/STATUTES

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The Lagos Stores, Ltd., v. Blackstock & Co., 1901

The Ibadan case, 1903.

The John Holt case, 1908.

The Houtman case, 1912.

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JUDGMENT

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The following judgments of the Full Court, consisting of Speed, C.J., Webber and Ross, JJ. were delivered on the 18th October, 1917.

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WEBBER. J.

This is an Appeal from the decision of the Judge of the Divisional Court, Western Division, directing the Registrar acting under the authority of the Trade Mark Ordinance to proceed with the Registration of Trade Mark No. 1703, applied for by Messrs. W.B. MACIVER & CO. Ltd., now the Respondents on Appeal. The Design which accompanied the Application consists of some natives in the act of coopering a cask or puncheon standing on one end and parts of two casks in a lying position are shown on the left hand side of the picture.

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The Appellant Company, Compagnie Francaise de I' Afrique Occidentale, opposed the registration on the ground that the Applicant's Trade Mark has such a resemblance to their Trade Mark Nos. 1191, 9192 advertised in *Government Gazette* of 15th May, 1912 and registered as No. 1192 in Class 47, as to be calculated to deceive. The Appellant's Trade Mark consisted of a native rolling a cask or puncheon. On the top of the cask is the name of the French firm with C.F.A.O and what appears to be some Arabic inscription and above the Mark are the words "Puncheon Brand" and below the words "Le Ponchon".

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The learned Judge in the Court below was of the opinion that the Applicants' Mark was not calculated to deceive.

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I think this Appeal should be allowed. To the trained eye of a civilised community, there is undoubtedly a considerable difference in the two Designs set side by side and the one would hardly be likely to be mistaken for the other, but while the broad principles laid down in English cases should be applied, the Trade Mark laws of this Country should be administered with due regard to local condition and, as stated by Osborne, Chief Justice, in the *Houtman case*, "with a view to protecting not only a vast illiterate population little acquainted with pictorial representations, but also the pioneers of trade who have earned

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associated with some recognised mark such as a particular bird,
animal, tree or other object.” Judges of the Supreme Court of
this Colony have consistently administered these laws with due
b regard to local conditions and I think we should embrace this
opportunity of expressing our unqualified approval of their
decisions.

c The first case of importance before the Court was that of the
Lagos Stores Ltd. v. Blackstock & Co. 1901. This was an
infringement case, and the Judge said the question was whether
d the two labels were so similar as to be likely to be mistaken by
“an ordinary native.” In 1903, in another infringement case
before Acting Chief Justice Speed (the President now sitting),
the device in each Mark consisting of a lion but in a different
e position or attitude. Here the Court dealt with the broad
principles, underlying all these cases, referring to *Seixo v*
Provezlude in which it was stated that to entitle a trader to
relief against an illegal use of his Trade Mark, the degree of
f resemblance must be such that ordinary purchasers proceeding
with ordinary caution are likely to be misled, and to the case
of *Johnson v Orr Ewing* in which the words “Ordinary
g purchasers” was constructed with reference to the degree of
intelligence and experience of people who are the ultimate
purchaser – in that case the native population of Ibadan.

h In the *John Holt case* decided in 1909, Trade Marks were
registered by Messrs. John Holt & Co., containing
representations of a Dingo dog. Messrs Peters had already
registered at Calabar, Trade Marks, containing among other
i features, the representations of a pointer dog with the addition
of a bird in his mouth. Osborne, C.J., said “it is too much to
expect an illiterate native to appreciate such differences; he
sees the dog, which he associates with the name of Peters and
j cannot read anything on the label. The standard of a more

civilised community does not apply in his case, and he is in greater need of protection in matters of this nature than a European who is supposed to be able to read and write.”

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In the *Houtman case* decided in 1912, the Design of the Applicant consisted of two anchors emerging from under a crown and a representation of two gold medals. Messrs. Van Hoytema & Co. had already registered the Trade Mark of an anchor. Osborne, C.J., held, and rightly too in my opinion, that the Applicant’s mark was calculated to deceive and in the course of his judgement said – “It cannot be too clearly understood by those who desire to register new Trade Marks in this Colony that the Court will view with suspicion and scrutinise most carefully any Application brought before it which attempts to utilise any feature of a registered Mark which has acquired an established reputation in any part of Southern Nigeria, and also that the standard of similarity and comparison is vastly different from what it is in Europe.”

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These decisions state the law as it has been and in my opinion, as it ought to be administered locally. In this case before us, the main and essential feature is the cask or puncheon. To the illiterate, there is no other feature connected with this particular Class of goods which this mark is intended to represent, and whether the cask or puncheon is being rolled by one man, or being coopered by three men, no difference is discernible by the illiterate native. It is the cask by which he associates a particular seller with his particular Class of goods, the other minor features and difference he will not appreciate.

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The Appeal should be allowed and the original motion that the registration of Trade Mark No. 1703 be proceeded with by the Registrar should be refused.

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ROSS, J.

a This is an Appeal by the French Company from the Judgment
of the Divisional Court in respect of an Application for
registration of a Trade Mark No. 1703 by the Respondents,
b Messrs W.B. MACIVER & CO. The Trade Mark sought to be
registered is in relation to a Class of goods No. 47 and is in
the form of a cask being coopered by 3 coopers. The Opponents/
c Appellants have a Trade Mark in the same Class No. 47 already
registered and that Mark is in the form of a cask being rolled
along the ground by one man. The learned Judge in the Court
d below found that there was not such a resemblance between
the two Trade Marks as would be calculated to deceive and
accordingly, allowed the Respondents' Application to have their
Mark registered. From this Judgment, the Appellants have now
appealed.

e In the course of the hearing, many English cases were quoted
and to these cases I have given my attention. At first sight and
when both Trade Marks are looked at together, there would
f appear to be no similarity between them, generally speaking;
there is however in both Marks in the centre thereof a cask
which is the essential point in both although it is treated in a
somewhat different manner.

g In a highly intelligent and civilised community, I should have
no hesitation in saying that the likelihood of confusing the two
h Marks is so very negligible that no one could reasonably say
that the Respondent's Mark is calculated to deceive: however,
I cannot but feel in coming to a decision in this case that
attention must be paid to surrounding circumstance and local
i conditions. In this country the percentage of persons who can
read and write, and especially of those to whom the Class of
goods concerned are sold, is extremely small. Very few natives
j can, even after a minute explanation, understand a picture or
pick out the details in one which would differ from the details

in another picture. Both the Marks would be known to the natives by a description of the essential point in both Marks, *i.e.* ,by the cask— they would both be referred to as “Agba” “or” “Cask” without any reference to the firm by which the goods represented are sold or to the surrounding details in the Marks. It is to be observed that two witnesses were called at the hearing in the Court below, but little importance can be attached to their evidence. These are experienced, intelligent and educated traders who are accustomed to Trade Marks and who can read and write well – these two witnesses having both the Marks before them stated that they would not be confused but I can hardly believe that the uneducated native unaccustomed to pictures and unable to read and write would be in the same position to see the difference, especially when only one of the Marks would be before him at a time; he would merely described either of the two marks as “ Agba mark” or “Cask brand” or some such form of words - The learned Judge in the Court below quoted the words of Jessel, M.R.’s judgment in the *Worthington case*, and I feel that no wiser words could possibly be used or words more applicable to this case. I am of the opinion that these two Marks are capable of confusion for the reasons I have stated, and I accordingly find that the Respondents’ Trade Mark is calculated to deceive and that the Application should be refused and the finding in this case reversed.

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SPEED, C.J

I have been and still am in some doubts as to this case. It seems clear that the learned Judge in the Court below was inclined to refuse registration of this Mark and would have done so had he not felt constrained to a contrary conclusion by the decisions of the English Courts. These decisions are of course binding on us but they must be construed having regard to the local conditions which are widely different from those that obtain in England. On the other hand, there is a danger of unduly

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a restricting the field from which Trade Marks may be chosen. No doubt the learned Judge of the Court below felt strongly this consideration, which also appeals to me.

b I have considered the Judgments which have been delivered by my brother Judge and inasmuch as they have formed a definite conclusion against the registration, which conclusion is in
c accord with previous decisions of this Court and with the ordinary principle of commercial morality, I do not propose to discuss the matter further, and the decision of the learned
d Judge of the Court below will be set aside and the Application to register refused, or if already registered, the Mark must be struck off the Register.

e The Appellant must have the taxed costs of the whole proceedings in this Court and the Court below.

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