

**IN THE FEDERAL HIGH COURT**  
**HOLDEN AT LAGOS, NIGERIA**  
**ON THE 24TH DAY OF SEPTEMBER, 1990.**  
**BEFORE THE HONOURABLE**  
**JUSTICE MUHAMMAD**  
**JUDGE**

SUIT NO: FHC/L/93/90

**BETWEEN**

**1. ALHAJI M. T. ELEBUTE**

**2. SHOREMAN MEDICAL  
CENTRE NIG. LTD**

*...Plaintiffs/  
Applicants*

**AND**

**DR. OLUGBENGA OGUNKUA**

*...Defendant/  
Respondent*

**FACTS/BACKGROUND**

The claim of the Plaintiffs herein is for an injunction to, among other reliefs, restrain the Defendant from using the unregistered Trade Mark of the Plaintiffs' 'Shoreman Medical Centre' and a Declaration that the Defendant has no interest financially or otherwise in the Plaintiffs' Company. This was followed by an Application for an order of interim injunction restraining the Defendant from claiming the Plaintiffs' unregistered Trade Mark, its ownership and proprietorship until the final determination of the Suit.

The Respondent in his opposition contended that the Court lacks jurisdiction to entertain the case stating that 'Shoreman Medical Centre' is not a Trade Mark but a business name and that the Court lacks jurisdiction to entertain disputes over the rights and ownership of a business name.

**SUBJECT MATTER**

1. INTELLECTUAL PROPERTY LAW-UNREGISTERED TRADE MARK-JURISDICTION-WHETHER FEDERAL HIGH COURT HAS JURISDICTION IN RESPECT THEREOF.
2. INTELLECTUAL PROPERTY LAW-UNREGISTERED TRADE MARK-PROPRIETOR OF-REMEDY AVAILABLE.

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**ISSUE**

1. Whether the proprietor of unregistered Trade Mark can sue for damages in respect of same.

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**HELD**

1. **On jurisdiction of the Federal High Court in respect of matters arising from Trade Marks.**

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I have no doubt in my mind that the Federal High Court has jurisdiction in matters arising from Trade Marks. *Section 7(1)(c)(ii) of the Federal High Court Act 197*

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It therefore follows that any matter arising from the Trade Marks Act, 1965 is within the jurisdiction of this Court. However, *Section 3 of the Trade Marks Act, 1965* provides:-

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“3. No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered Trade Mark; but nothing in this Act shall be taken to affect rights of action against any person for passing-off goods as the goods of another person or the remedies in respect thereof.”

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2. **On the remedy available to a proprietor of an unregistered Trade Mark.**

A Proprietor of a Trade Mark can only institute proceeding to prevent, or to recover damages for the

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a infringement of a Trade Mark if the Trade Mark is registered. Where the Trade Mark is not registered, his remedy lies in an action for passing-off.

b **CASES AND STATUTES**

CASES

1. *Agbaje v. Ibru Seafood Limited* (1972) 5 S.C. 50 at 57
2. *Egbe v. Ologun* (1972) 2 S. C. 146 at 147
- c 3. *Kotoye v. C.B.N.* (1989) 1 N.W.L.R. (Pt. 98) 419
4. *Ekwunife v. Wayne* (1989) 5 N.W.L.R. (Pt. 122) at 450
5. *Kufeji v. Kogbe* (1961) 1 ALL N.L.R. 11
- d 6. *Maisango v. Sekondy* (1979) FHCR 67
7. *Nigerian Civil Service Union v. Essien* (1985) 3 N.W.L.R. (Pt. 12) 306 at 31
8. *Obeya Memorial Hospital v. A. G. of the Federation* (1987) 3 N.W.L.R. 9. (Pt.60) 325 at 338
- e 9. *Tukur v. Government of Gongola State* (1989) 4 N.W.L.R. (Pt.117) 517 at 547
10. *Woluchem v. Wokoma* (1974) 3-5 S.C. 152 at 156

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STATUTES

Trade Marks Act 1965

Section 3

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Section 67 (1)

**COUNSEL**

h O.A. Olakulehin -for 1<sup>st</sup> and 2<sup>nd</sup> Plaintiffs/Applicants.

I. O. Ajomo -for Defendant/Respondent

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**RULING**

(Delivered by MUHAMMAD,J.)

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In the substantive Suit, the Plaintiffs' claim is for:-

1. A Declaration that the Defendant has no interest financially or otherwise in the Company known as Shoreman Medical Centre Nigeria Limited. a
2. An injunction to restrain the Defendant from using the aforesaid unregistered Trade Mark of the Plaintiffs to wit: “Shoreman Medical Centre.” b
3. An Order compelling the Defendant to deliver unto the Plaintiffs all cheques and or money received from customers all in the name of “Shoreman Medical Centre” when the Defendant was in the employment of the Plaintiffs. c

After filing the substantive Suit, the Plaintiffs brought an Application for an order of interim injunction restraining the Defendant from using or claiming the Plaintiffs’ unregistered Trade Mark and or claiming ownership or proprietorship of the Plaintiffs’ unregistered Trade Mark until the final determination of the Suit. d

The Application was brought under Order 20, rules 1 and 4 of the Federal High Court (Civil Procedure) Rules, 1976 and is supported by an Affidavit of 38 paragraphs. The Defendant opposed the application and filed a 26-paragraph Counter-Affidavit. The Plaintiffs then filed a reply to the Counter-Affidavit. e

Mr. Talabi, learned Counsel for the Applicants submitted that from the Affidavits before the Court, it was clear that a prima facie case has been established and referred to *Kufeji v. Kogbe (1961) 1 ALL NLR 113* and *Halsbury’s Laws of England 3<sup>rd</sup> Edition, volume 21*. Counsel then referred extensively to the Affidavit in support and its annexures and submitted that there was nothing in the Counter-Affidavit which denied the Plaintiffs’ claim or assertions. He said the Court cannot take into account a partnership agreement which is not before it. He then referred f

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a to *Kotoye v. CBN (1989) 1 N.W.L.R. (89) 419* and urged the Court to grant the application.

b In opposing the Application, Mr. Ajomo, learned Counsel for the Respondent submitted that the Court has no jurisdiction to hear and determine the reliefs sought by the Plaintiffs. He referred to *Section 67 (1) of the Trade Marks Act, 1965* and submitted that a Trade Mark must relate to goods. For the  
c definition of goods, he referred to Oxford Advanced Learner's Dictionary by A. S. Hornby where goods is defined as "movable property or merchandise". He said Shoreman Medical Centre  
d is not a Trade Mark but a business name and that a business name cannot amount to movable property or merchandise. Counsel referred to *S. 7 of the Federal High Court Act, 1973* and submitted that this Court has no jurisdiction to determine  
e disputes over the rights and ownership of a business name. Learned Counsel agreed that this Court has jurisdiction to grant an injunction but can only do so on matters within its jurisdiction and referred to *Tukur v. Government of Gongola State (1989) 4 N.W.L.R. (117) at 547*. He urged the Court to  
f dismiss the application on this ground.

g In the alternative, Counsel submitted that the application must fail on merit. He said the Plaintiffs have failed to establish that prima facie, their right is being violated, that the injury to  
h their legal right will irreparably alter the status quo or render nugatory any subsequent decision of the Court. Counsel also submitted that the Court must be satisfied that at this stage, the grant of an injunction will not amount to determining at an  
i interlocutory stage and by means of Affidavit evidence the substantive rights of the parties. In support of these submissions, learned Counsel cited the following authorities:-  
j *Woluchem v. Wokoma (1974) 3-5 S.C. 152 at 156; Egbe v. Olokun (1972) 2 S.C. 146 at 149; Ladunni v. Kukoyi (1972) 1 ALL NLR Part 1, 133 at 138; Nigerian Civil Service Union*

*v. Essien (1985) 3 NWLR (12) 306 at 316 and Obeya Memorial Hospital v. A. G. of the Federation (1987) 3 NWLR (60) 325 at 338.*

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Counsel further submitted that the legal right the Plaintiffs are seeking to enforce is an illegal right. He referred to the provisions of Registration of Business Names Act, 1961 and submitted that any business name which does not consist of the true surname of the person must be registered under the Act. Where it is not so registered, it is illegal by virtue of section 17. He said the Court has no jurisdiction to enforce an illegal right and cited *Ekwunife v. Wayne (1989) 5 NWLR (122) 422 at 450*. Counsel also contended that even if the Plaintiffs' right is legal, it is contested and that the right even if it existed, it has been extinguished. He also submitted that to grant the injunction will amount to granting the substantive relief. He said the Plaintiffs did not come with clean hands because the registration was done fraudulently.

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Mr. Talabi replied on points of law. He said even though objection to jurisdiction can be raised at anytime, it must be specifically raised by motion because if the objection is upheld, it will put an end to the whole action and referred to Order 27 Rule 1 of our Procedure Rules. He submitted that this Court has jurisdiction to entertain matters in respect of a Company and referred to *Maisango v. Godwin Sekondy (1979) FHCR 67*. Counsel also submitted that Trade Mark is not limited to goods and the like. He said the practice has always been that once a person can establish sufficient usage, he has acquired Trade Mark. He said any reference to business name should be disregarded because that is not relevant. He said the averments in the Affidavit in support clearly show that the res is in danger of being destroyed.

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As I have earlier said in this Ruling, the Applicants are praying for an order of interim injunction restraining the Defendant

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a from using or claiming the Plaintiffs' unregistered Trade Mark  
and/or claiming the ownership or proprietorship of the  
Plaintiffs' unregistered Trade Mark until the final determination  
b of the Suit. It could be seen that the reliefs sought are based  
on an unregistered Trade Mark. I have no doubt in my mind  
that the Federal High Court has jurisdiction in matters arising  
from Trade Marks. *Section 7(1) (c) (ii) of the Federal High  
Court Act 1973 provides:-*

c "7(1) The Federal High Court shall have and exercise  
jurisdiction in civil causes and matters.  
(c) arising from –  
d (ii) any enactment relating to copyright,  
Patents, Designs, Trade Marks and  
Merchandise Marks".

e It therefore follows that any matter arising from the Trade  
Marks Act, 1965 is within the jurisdiction of this Court.  
However, *section 3 of the Trade Marks Act, 1965 provides:-*

f "3. No person shall be entitled to institute any  
proceeding to prevent, or to recover damages for, the  
infringement of an unregistered Trade Mark; but nothing  
in this Act shall be taken to affect rights of action against  
g any person for passing-off goods as the goods of another  
person or the remedies in respect thereof."

h The above provision is very clear. You can only institute  
proceeding to prevent, or to recover damages for the  
infringement of a Trade Mark if the Trade Mark is registered.  
Where the Trade Mark is not registered, your remedy lies in  
an action for passing-off. In our present case, the Applicants  
i have stated that the Plaintiffs' Trade Mark has not been  
registered. It therefore follows that by operation of law, the  
Plaintiffs are not entitled to bring this application and I so hold.

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This might have put an end to the whole matter. However, the Plaintiffs' claim is not limited to the unregistered Trade Mark. The Plaintiffs are also claiming for a Declaration that the Defendant has no interest financially or otherwise in the Company known as Shoreman Medical Centre Nigeria Limited. I will, therefore not strike out the whole Suit. I will however, strike out the application. The Plaintiffs' remedy as far as the unregistered Trade Mark is concerned, is to institute an action for passing-off.

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*Application struck out.*

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