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**IN THE SUPREME COURT OF NIGERIA**  
**HOLDEN AT ABUJA, NIGERIA**  
**ON 20TH JUNE, 2003**  
**BEFORE THEIR LORDSHIPS**

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SUIT NO: SC: 116/1999

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**MUHAMMADU LAWAL UWAIS, C.J.N (*Presided*)**  
**MICHAEL EKUNDAYO OGUNDARE, J.S.C.**  
**UTHMAN MOHAMMED, J.S.C.**  
**ANTHONY IKECHUKWU IGUH J.S.C.**  
**UMARU ATU KALGO J.S.C (*Read the Lead Judgment*)**

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**BETWEEN:**

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**AYMAN ENTERPRISES LIMITED** .....*Appellant*

**AND**

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**1. AKUMA INDUSTRIES LIMITED**  
**2. SLYER STAND (NIG) LIMITED**  
**3. MR. SYLVESTER UWADIEGWU**  
**4. MRS. COMFORT ELOCHALUM**

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(Trading under the name and style of Comfort Hair Zone)(sued on their own behalf and as engaged in the trading of business of selling offering for sale wigs and hair attachments known as “ORIGINAL QUEENS” purporting to be products of Plaintiff by adopting a Trade Mark, get up/or label Design to and capable of being offered for sale as the Plaintiff “NEW QUEENS”)

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.....*Respondents*

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**FACTS/BACKGROUND**

The Appellant who was the Plaintiff in the Federal High Court instituted this action against the Respondents as Defendants. The Plaintiff alleged that the Defendants, by using the name ORIGINAL QUEENS on their products, have infringed its Trade Mark “NEW QUEENS” applied for and accepted under TP24575/95 in class 6, as same is calculated to lead to the belief that the wigs and hair attachment not of the Plaintiff’s manufacture, are products of the Plaintiff.

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The Plaintiff’s action is for perpetual injunction restraining the Defendants from passing off or assisting others to pass-off wigs and hair attachments not the Plaintiff’s manufacture or merchandise as and for the goods of the Plaintiff by the user or in connection therewith in the course of trade of the Trade Mark “ORIGINAL QUEENS” or in adopting the distinctive get-up, logo, packaging or label design, identical in all essential details to that of the Plaintiff’s “NEW QUEENS” or any colourable imitation thereof without duly distinguishing such package from that of the Plaintiff.

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The Appellant had earlier obtained an *Anton Pillar* Order pending the determination of the Motion on Notice which was fixed for hearing on 25<sup>th</sup> July, 1996 and same was executed consequent upon which the Respondents filed an application praying the Court to set aside, discharge or vacate all the Orders made on the ex-parte *Anton Pillar* application.

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Upon the hearing of the applications, the learned trial Judge delivered a considered ruling in which he dismissed the Respondents’ application to set aside and granted the Appellant’s Motion for interlocutory injunction pending the determination of the suit. The Respondents being dissatisfied, appealed to the Court of Appeal which Court allowed the Appeal and set aside ruling of the learned trial Judge. The

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*a* Appellant then appealed to this Court from the decision of the Court of Appeal and the Respondents also cross-appealed.

**SUBJECT MATTER**

- b* 1. INTELLECTUAL PROPERTY LAW-UNREGISTERED TRADE MARK-PASSING OFF ARISING THEREOF - JURISDICTION OF FEDERAL HIGH COURT IN RESPECT THEREOF.
- c* 2. INTELLECTUAL PROPERTY LAW-PASSING OFF-SCOPE OF FEDERAL HIGH COURT'S JURISDICTION-WHETHER EXTENDS TO UNREGISTERED TRADE MARK.
- d* 3. INTELLECTUAL PROPERTY - CASE LAW - PATKUM'S CASE - GENERAL PRINCIPLES THEREIN - JUDGMENT IN PATKUM'S CASE - EFFECT.
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**ISSUE**

- f* 1. Whether the Federal High Court has jurisdiction to entertain a claim for damages for "passing-off" of an unregistered Trade Mark.

**HELD**

- g* 1. **On jurisdiction of the Federal High Court in passing-off.**
- h* In respect of the general jurisdiction in passing-off; the provision in S. 230(1) of the 1979 Constitution prevailed so that after 1993, the Federal High Court had jurisdiction to entertain passing-off actions arising from any Federal enactment.
- i*
- j* 2. **Action for passing off arising from infringement of Trade Mark-Scope/condition precedent to exercise of jurisdiction of the Federal High Court**  
The jurisdiction of the Federal High Court to deal with

actions on passing-off depends on the registration of Trade Marks as provided by section 3 of the Trade Marks Act, Cap 436 and section 230 subsection (1)(f) of the 1979 Constitution (now section 251(1)(f) of the 1999 Constitution – See *Patkum Industries Ltd. V. Niger Shoes Manufacturing Co. Ltd. (1988) 5 NWLR (Pt. 93) 138*. Where the Trade Mark is unregistered, as in the present case, then the cause of action for passing-off is in common law for tort and action can now be brought in a State High Court in view of the provisions of section 272 subsection (1) of the 1999 Constitution.

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**3. Passing-off - general principle in Patkum’s case.**

The common law tort of passing-off goods as the goods of another still exists generally but not in respect of infringement of unregistered Trade Marks. What was decided in *Patkum’s case* was only in respect of passing-off relating to infringement of registered Trade Mark. It was also decided in that case that in addition to the right of action conferred on the owner of a registered Trade Mark under S.3 of the Trade Mark Act, 1965, there is an additional right of action of passing-off in respect of the goods involved.

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**4. Passing-off - effect of the judgment in Patkum’s case.**

The total effect of the judgment in *Patkum’s case* is that the Federal High Court will only have jurisdiction to entertain an action for passing-off arising from an infringement of a registered Trade Mark and the action must have arisen in relation to a Federal enactment.

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**CASES AND STATUTES**

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**CASES**

1. *Timi –Timi v. Amabebe* (1953) 12 WACA 374
2. *Patkum Industries Ltd. v. Niger Shoes Manufacturing Co. Ltd.* (1988) 5 NWLR (Pt. 93) 138.
3. *Nyarko v. Akowuah* (1954) 14 WACA 426
4. *Okafor v. A.G. Anambra State* (1991) 6 NWLR (Pt.200) 659 at 680.

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**STATUTES**

The Trade Marks Act, 1965, Cap. 436 of Laws of the Federation of Nigeria, 1990

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The Federal High Court Act, 1973 (Cap. 13 Laws of the Federation of Nigeria, 1990).

-Section 7

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The Constitution of the Federal Republic of Nigeria, 1979  
-Section 230(1) (f)

**JUDGMENT**

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**KALGO, J.S.C. (Delivering the lead judgment):** The Appellant who was the Plaintiff, instituted this action against the Respondents as Defendants in the Federal High Court, Lagos. In the Writ of Summons issued on 26<sup>th</sup> June 1996, the Plaintiff/Appellant claimed for:

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1. A perpetual injunction restraining the Defendants and each of those upon whose behalf the Defendants are sued, whether acting by themselves, their Servants, Assigns or Privies or otherwise howsoever, from doing the following acts or any of them, that is say: -

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- i. Passing-off or attempting to pass-off or causing, enabling or assisting others to pass-off wigs and hair attachments not the Plaintiff's manufacture or merchandise as and for the goods of the Plaintiff by the user

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or in connection therewith in the course of trade of the Trade Mark “ORIGINAL QUEENS” or adopting the distinctive get-up, logo, packaging or label design, identical in all essential details to that of the Plaintiff’s “NEW QUEENS” or any colourable imitation thereof without duly distinguishing such packaging from that of the Plaintiff or by any other means.

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ii. Manufacturing, importing, selling or offering for sale or supplying wigs and hair attachments in any package or the get-up bearing the name “ORIGINAL QUEENS” or any other words so closely resembling the Plaintiff’s Trade Mark “NEW QUEENS” applied for and accepted under TP24575/95 in Class 6, as to be calculated to lead to the belief that the wigs and hair attachment not of the Plaintiff’s manufacture are products of the Plaintiff.

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iii. Infringing the Copyright in the artistic work of the Plaintiff’s Trade Mark “NEW QUEENS”, it’s get-up, logo package and distinctive label.

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2. Delivery up for destruction upon oath of all wigs and hair attachments in packages and/or get-up not of the Plaintiff’s manufacture or merchandise yet bearing the Trade Mark “ORIGINAL QUEENS” identical to the Plaintiff’s Trade Mark “NEW QUEENS” and sold in the Plaintiff’s distinctive get-up; all moulds, raw materials, printing blocks and other materials in the possession, custody or control of the 1<sup>st</sup> Defendant, their Servants, Agents, or Privies or any of them, the use of which would be in breach of the INJUNCTION

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a prayed for and verification upon oath that the 1<sup>st</sup>  
Defendants has no such articles in their possession,  
custody or control.

b 3. An Order that the Defendants and each of those upon  
whose behalf the Defendants are sued, whether acting  
c by themselves, their Servants, Agents or Privies or any  
of them do make and serve upon the Plaintiff an  
Affidavit disclosing when, to whom and in what  
d quantities they have sold, sent or supplied, purchased  
or received any such wigs and hair attachment  
aforesaid, exhibiting true copies of all documents in  
their possession, power or custody or relating to the  
facts and matters therein disclosed and payment of all  
sums found upon making such an Affidavit.

e 4. The sum of N30,000,000.00 as damages against the  
Defendants jointly and severally for passing-off their  
fake/counterfeit "ORIGINAL QUEENS" wig and hair  
f attachments as and for the Plaintiff's "NEW  
QUEENS" wigs and hair attachment and for infringing  
the Copyright in the artistic work of the Plaintiff's  
Trade Mark, its get-up, logo, package and distinctive  
label".

g At the time of filing the Writ of Summons, the Appellant  
also filed two Motions; one *ex-parte Anton Pillar* application  
and the other, Motion on Notice, each containing 9 prayers.  
h On 1<sup>st</sup> July, 1996, the learned trial Judge Sanyaolu, J., heard  
the *ex-parte* application and granted all the prayers thereof  
pending the determination of the Motion on Notice which  
i was fixed for hearing on 25<sup>th</sup> July, 1996. On the 9<sup>th</sup> of July,  
1996, the Appellant executed the *Anton Pillar* Order by  
seizing the offending goods from the Defendants/  
Respondents. On the 12<sup>th</sup> of July, 1996, the Respondents filed  
j a Motion on Notice praying the trial Court to set aside,  
discharge or vacate all the Orders made on the *ex-parte Anton-*

*Pillar* application. On the 27<sup>th</sup> of July, 1996, learned trial Judge ordered that both the Appellant’s Motion to set aside the *Anton-Pillar* Orders be consolidated and heard together

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After hearing legal arguments from the learned Counsel for the parties on the consolidated applications, the learned trial Judge delivered a considered ruling on the 28<sup>th</sup> of November, 1996 in which he dismissed the Respondents’ application to set aside and granted the Appellant’s Motion for interlocutory injunction pending the determination of the Suit. The Respondents were dissatisfied with the ruling and appealed to the Court of Appeal. The Appeal was heard and in its judgment delivered on the 6<sup>th</sup> of July, 1999, the Court of Appeal allowed the Appeal and set aside ruling of the learned trial Judge. The Appellant then appealed to this Court from the decision of the Court of Appeal and the Respondents also cross-appealed.

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Both parties filed and exchanged their respective briefs as required by the rules of this Court. The Appellant in his brief identified the following issues for determination of this Court in the Appeal: -

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1. Whether the Court of Appeal rightly applied the provisions of the Trade Marks Act (*Supra*), on the classification and specification of goods and whether the classification of goods in the 3<sup>rd</sup> Schedule of the Trade Marks Act, 1965 is relevant to the specification of goods in the Trade Mark applications for “NEW QUEENS” Collection and Device” and “Queens & Device”.

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2. Whether the Court of Appeal rightly applied the provision of the Trade Marks Act, Cap 436, Laws of the Federation of Nigeria, 1990 in apportioning to the Respondents’ Trade Mark

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- a application “Queens & Device” in Class 3 reserved for “Cosmetic” goods and the Appellant’s Trade Mark application “New Queen Collection & Device” in Class 26 reserved for “Braids”, equal equities and holding that both applications were at par.
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- c 3. Whether the issue of non-disclosure raised by the Court below was material to the weighing-in operation in deciding whether to continue or discharge the *Anton Pillar* and other interim injunctive Orders granted by the learned trial Judge.
- d 4. Whether the Court below was right in interfering with the exercise of discretion by the learned trial Judge in the way it did when the said exercise was not perverse or the result of an improper exercise of judicial discretion and whether the said *Anton Pillar* and other interim injunctive Orders were so abrasive in nature as to have the effect of taking the wind out of the case.
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- g 5. Whether the Appellant fulfilled the conditions which ought to be met before a grant of an interlocutory injunction and whether the lower Court was correct in holding that the interlocutory Orders made by the learned trial Judge were so all embracing they ought not to have been made and that they had the effect of terminating the whole and entire case thereby setting aside the same.
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- i 6. Whether an Appellate Court can rightly consider and make findings on an issue specifically reserved by the trial Court for the substantive hearing.
- j 7. Whether it is right for a Judge to concur in a

consequential Order never granted by the lead judgment purported to be concurred in?”

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The Respondents in their joint brief formulated only 3 issues which they say encompass both the main Appeal and the cross-Appeal. The issues read: -

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(1) Whether the Federal High Court has jurisdiction to entertain a claim for damages for “passing-off” of an unregistered Trade Mark: Ground of appeal in the Notice of Cross-Appeal.

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(2) Whether the Court of Appeal was right in discharging the *ex-parte Anton Pillar Order* made by the Federal High Court on 1<sup>st</sup> July, 1996: Grounds 2, 3, 4 and 7 of the amended Notice of Appeal.

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(3) Whether the Court of Appeal was right in law in setting aside the Order of interlocutory injunction made by the Federal High Court on 28<sup>th</sup> November, 1999: Grounds 1,5,6,8 and 9 of the amended Notice of Appeal.

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The Respondents filed their Notice of Cross-Appeal on the 5<sup>th</sup> of August, 1999 after obtaining leave of the Court of Appeal. The Notice of Cross-Appeal contained only one ground which, with its particulars reads: -

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“The Court of Appeal erred in law when it held per I.C. Pats Acholonu, JCA as follows:

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“Now we have in Section 230 of the Constitution as amended which include passing-off action as one of the matters within the jurisdiction of the Federal High Court. It is without qualification in that it is not related or made conditional that the passing-off shall be in respect of a registered Trade Mark. It is couched in a general form to be all embracing that being the case

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a can it really be argued in all seriousness that it did not  
confer untrammelled jurisdiction on the Federal High  
Court. I have read the various concurring judgments  
b of the Supreme Court Judges in *Patkum's case* and I  
must candidly confess that I failed to see any  
contradiction. It is very easy to grasp the nuances of  
c that case and I will add that the case helps in no small  
measure to shape the distinctive lines of the present  
case. In my view, the Federal High Court is eminently  
competent to adjudicate on the matter.

#### PARTICULARS OF ERROR

- d (a) The Jurisdiction conferred on the Federal High Court  
by Section 230(1) (F) of the 1979 Constitution as  
e amended by Decree No. 107 of 1993 in relation to  
passing-off actions was in respect of civil causes and  
f matters arising from “any Federal enactment relating  
to.... passing-off. (a) the Trade Marks Act, Cap. 436  
in 1990 Laws of the Federation earlier referred to in  
g page 13 of the judgment is not an enactment relating  
to passing-off and therefore could not have been an  
enactment from which a cause of action in “passing-  
h off” could have arisen (b) the pronouncements in the  
judgment of the Supreme Court in the case of *Patkum  
Industries Ltd. V. Niger Shoes Manufacturing Co. Ltd.  
i (1988) 5 NWLR (Pt.93) 138* were in so far as they  
dealt with the jurisdiction of the Federal High Court  
to entertain actions for “passing-off of unregistered  
Trade Marks, *obiter dicta* and *a fortiori* the case is  
no authority for the jurisdiction of the Federal High  
Court on such matters.  
j (b) In the circumstances, the Court of Appeal ought not  
to have held that “the Federal High Court is eminently  
competent to adjudicate on the (this) matter”.

And the only issue which was gleaned and filtered out of the ground was the Respondents' issue No. 1 which read: -

“Whether the Federal High Court has jurisdiction to entertain a claim for damages for “passing-off” of an unregistered Trade Mark”.

It is abundantly clear and without any iota of doubt that the ground of Appeal in the Cross-Appeal and the issue raised from it challenged the jurisdiction of the trial Court to entertain the Appellant's claim. There is also no doubt that the issue of jurisdiction, being the threshold to any action in Court, must be looked into first because any proceedings of Court in the absence of jurisdiction, is futile and the whole proceedings rendered a nullity. See *Alao v. C.O.P.* (1987) 4 NWLR (Pt.64) 199; *Funduk Engineering v. McArthur* (1995) 4 NWLR (Pt.392) 640 at 651; *Oredoyin v. Arowolo* (1989) 4 NWLR (Pt. 114) 172 at 187; *Ifezue v. Mbadugha* (1984) 1. SCNLR 427, (1984) 5 SC 79. And whereas in this Appeal the issue of jurisdiction is raised, the Court has a duty to consider the issue timeously before taking any further step in the matter. See *Nwanezie v. Idris* (1993) 3 NWLR (Pt.279) 1 at 17; *State v. Onagoruwa* (1992) 2 NWLR (Pt.221) 33 at 52 and 54; *Okafor v. A.G., Anambra State* (191) 6 NWLR (Pt.200) 659. It is as a result of this that I now decide to consider first the issue of jurisdiction raised by the Respondents in issue 1 of the Cross-Appeal. The outcome of this consideration will determine whether it is necessary to consider the issues identified in the main Appeal.

The Respondents' only issue in the Cross-Appeal is simply this: whether Federal High Court has jurisdiction to entertain a claim for damages for ‘passing-off’ of an unregistered Trade Mark. The learned Counsel for the Respondents submitted in his brief that having regard to the provision of Section 230(1) of the 1979 Constitution as amended by Decree No.107

*a* of 1993, Section 3 of the Trade Marks Act, the Federal High Court has no jurisdiction to entertain any action relating to passing-off of an unregistered Trade Mark. He contended that the first limb of Section 3 of the Trade Marks Act, 1965, *b* prohibits the institution of any action for damages in respect of unregistered Trade Marks, and the second limb preserves the right of action against any person for passing-off goods of another person, without specifying which Court would have *c* jurisdiction to entertain the action. Therefore, Counsel submitted, this “right of action” predated the enactment and exists outside the Act at common law and is not affected by *d* the Act.

*e* In respect of Section 7(1) (c) (ii) of the Federal High Court Act, learned Counsel submitted that although the Section confers jurisdiction on Federal High Court to entertain actions in respect of matters “arising from” any enactment relating to Trade Marks, the Section does not apply in this case where *f* the claim is for passing-off which is not founded on the Trade Marks Act, 1965. Learned Counsel therefore submitted that this action is for passing-off which for all intents and purposes, has no connection with Trade Marks or Trade Marks Act, *g* 1965 but is a common law tort outside the scope of the provisions of S.7 (1) (c) (ii) of the Federal High Court Act, 1973.

*h* On Section 230 (1) (f) of the 1979 Constitution as amended by Decree No. 107 of 1993, learned Counsel submitted that it confers exclusive jurisdiction on the Federal High Court in civil causes and matters arising from any Federal enactment *i* relating to “Trade Marks and passing-off” in respect of registered Trade Marks only, since the passing-off of unregistered Trade Marks was not provided for and does not *j* arise from the provisions of the Trade Marks Act, 1965.

Learned Counsel extensively examined the Sections of the above mentioned laws and the relevant judicial decisions particularly the cases of *Patkum Industries Limited v. Niger Shoes Manufacturing Company Limited (1988) 5 NWLR (Pt.93) 138*; *IML Air Chartering Nig. Ltd. V. IMNL International Messengers (Nig.) Ltd. (1979) 5 FRCLR 113*. Wherein the various Sections were judicially interpreted, and came to the conclusion that on the facts of this particular case, that trial Court had no jurisdiction to entertain this case as it did. He therefore urged this Court to so find, dismiss the Appeal and affirm the decision of the Court of Appeal.

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The learned Appellant’s Counsel submitted in the brief that the claims of the Plaintiff/Appellant arose from an enactment relating to the Trade Marks Act (Cap. 436 of Laws of the Federation of Nigeria, 1990); and are therefore within the jurisdiction of the Federal High Court pursuant to the provisions of Section 7(1) (c) (ii) of the Federal High Court Act. (Cap. 134, Laws of the Federation of Nigeria, 1990). Learned Counsel contended that it is an actionable wrong at common law for a person to present his goods as those of another person in such a manner as to cause the goods to be taken as those of that other person. Counsel conceded that this constitutes a common law tort of passing-off, but submitted that in this case, Section 7(1)(c) (ii) of the Federal High Court Act, does not provide any limitation or distinction in the type of action provided that they are “civil causes and matters” relating to the subject matter concerned. In this case, Counsel argued, the subject matter is Trade Marks and since Trade Marks Act, 1965 is a Federal enactment in respect of Trade Marks, the Federal High Court has jurisdiction. Learned Counsel further argued that although a person can sue at common law for passing-off, Section 3 of the Trade Marks Act has statutorily provided another right of action for passing-off of an unregistered Trade Mark. Counsel then

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a examined the provisions of Section 3 of the Trade Marks  
Act, 1965 and the decision of this Court in *Patkum's case*  
b (*supra*), and then submitted that the Federal High Court has  
jurisdiction to entertain a claim of passing-off even in respect  
of an unregistered Trade Mark as in this case. The decision  
c of this Court in *Patkum's case*, Counsel submitted, was fully  
supportive and the views expressed therein vindicated, by  
the provisions of Section 230(1) of the 1979 Constitution as  
d amended by Decree No. 107 of 1993. Finally learned Counsel  
submitted that passing-off of an unregistered Trade Mark is  
a cause of action arising from the Trade Marks Act, 1965 and  
e that by virtue of the provisions of Section 7(1) (c) (ii) of the  
Federal High Court Act, 1973, the Federal High Court has  
jurisdiction to entertain this action. Counsel urged the Court  
to allow the Appeal and set aside the decision of the Court of  
Appeal restoring that of the trial Court.  
Let me now consider the submission of Counsel.

f From the Particulars of Claim and the Affidavit in support of  
the ex-parte Motion filed by the Appellant on 26/6/96, it is  
very clear that the Trade Mark of the Appellant giving rise to  
this action has not been registered. Paragraph 10 of the  
supporting Affidavit reads:-

g "That, in order to protect its goodwill in its said  
popular brand of wigs and hair attachments, Plaintiff  
lodged an application at the Trade Marks Registry,  
h Abuja, in accordance with the provisions of the  
Trade Marks Act, 1965, for the registration of its  
brand name in Class 26. The application dated 9<sup>th</sup>  
i July, 1995, was acknowledged on the 31<sup>st</sup> day of  
July, 1995, as TP24575/95. The Registrar accepted  
the application for registration on the 1<sup>st</sup> day of  
j August, 1995 and has not indicated any reason why  
the Trade Mark should not be registered. Attached  
herewith and marked "A & B" are copies of the

acknowledgement and acceptance forms issued to the Plaintiff/Applicant by Trade Marks Registry, Abuja in 1995.”

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There is therefore no doubt and as has been maintained by the Appellant throughout, that the Appellant’s Trade Mark, known as “NEW QUEENS” had not been registered under the Trade Marks Act, 1965. It is also not in dispute in this case that the Respondents’ manufacture or merchandise under the Trade Mark “ORIGINAL QUEENS” was also not registered though his application for registration was also pending.

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The jurisdiction of the Federal High Court at the material time, is as set out in Section 230(1) (f) of the 1979 Constitution, as amended, by Decree No. 107 of the 1993 and Section 7 of the Federal High Court Act, 1973 (Cap. 13 Laws of the Federation of Nigeria, 1990). Section 230(1) (f) of the 1979 Constitution provides:-

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“Notwithstanding anything to the contrary contained in this Constitution and in addition to such other jurisdiction as may be conferred upon it by an Act of the National Assembly or a Decree, the Federal High Court shall have and exercise jurisdiction *to the exclusion of any other Court in civil causes and matters arising from: -*

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- (f) Any *Federal enactment relating to copyright, patents, Designs, Trade Marks and passing-off, industrial Designs and merchandise Marks, business names and commercial industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards”*

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*(Italics Mine)*

By this provision, the Federal High Court, and that Court

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a alone, had exclusive jurisdiction to entertain all civil causes and matters arising from Federal enactment relating to any of the matters mentioned in (f) above, including Trade Marks and passing-off.

b Section 7(1) (c) (ii) of the Federal High Court also provides:

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c “The Federal Revenue Court shall have and exercise jurisdiction in civil causes and matters.

(c) Arising from -

(i) .....

d (ii) *any enactment relating to copyright, patents, Designs, Trade Marks and merchandise Marks.*

e Section 7(1) above re-affirms the jurisdiction conferred on the Federal High Court in respect of “any civil causes and matters, arising from any enactment relating to Trade Marks”. It is to be noted that it did not include “passing-off” and it did not say “arising from any Federal enactment relating to”. The word “Federal” is missing in Section 7(1)(c)(ii), but by the use of the word “any”, it can properly be applied to a Federal enactment. In respect of the general jurisdiction in passing-off; the provision in Section 230(1) of the 1979 Constitution prevailed so that after 1993, the Federal High Court had jurisdiction to entertain passing-off actions arising from any Federal enactment.

i In this case, the Federal enactment we are concerned with is principally the Trade Marks, 1965, Cap. 436 of Laws of the Federation of Nigeria, 1990 (hereinafter referred to as “the Act”).

j Section 3 of the Act provides:-

“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 actions against any person for passing-off goods as the goods of another person or the remedies in respect thereof.”

*(Italics mine)*

This Section is divided into two distinct parts. The first part prohibits the institution of any action for the infringement of an unregistered Trade Mark. The second part preserves the right of action against any person for passing-off goods of another.

I have already found earlier in this judgment and there is no dispute at all, that the Appellant’s Trade Mark allegedly infringed in this case, was in fact not registered. It is common ground that a Plaintiff in an action for infringement must establish his title either as proprietor or as a registered user entitled to sue. He must then prove that the Defendant has acted or threatens to act in such a way as to infringe the right conferred upon him by the registration of the Trade Mark under the Act. This is not the case here and this makes the first part of Section 3 of the Act inapplicable. I hold accordingly.

In respect of the second part of the Section which reads: -

“... 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”.

Learned Counsel for the Respondents submitted in his brief that it creates a separate right of action for passing-off outside the Act, and is not related in any way to Trade Marks. He further submitted that it did not confer any jurisdiction on

a any Court to try the action. Therefore, Counsel submitted, and relying on *Patkum's case (supra)* that it did not come within the scope of Section 230(1) (f) of the 1979 Constitution or Section 7 (1) (c) (ii) of the Federal High Court Act, 1973.

b For the Appellant, the learned Counsel submitted in its brief also relying on *Patkum's case* that the Appellant's claims arise from an enactment relating to Trade Marks Act, 1965, and that the common law right to sue for passing-off has been c statutorily provided for by Section 3 of the Act. Counsel further submitted that their claim arose from the passing-off d of their Trade Marks within the provisions of Section 7(1)(c)(ii) of the Federal High Court Act, 1973, and Section 230(1) (f) of the 1979 Constitution.

e As both parties rely on *Patkum's case (supra)*, let me consider what effect the decision in that case will have on the instant case. *Patkum's case* was decided by this Court on the effect of Section 3 of the Trade Marks Act, 1965. The facts in f *Patkum's case*, are different from those in this case. In *Patkum's case*, the Trade Mark allegedly infringed was in fact registered whereas in this case, it was not, as the application for registration was still pending when the action g was instituted. Karibi-Whyte, JSC delivering the lead judgment in *Patkum's case* started by saying that –

h “The very narrow point of law which fell for determination in the *Federal Revenue Court* was whether that Court had jurisdiction in an action for infringement of a *registered* Trade Mark where damages for passing-off of the goods have also been claimed.”

i (Italics mine)

j The Federal Revenue Court is now the Federal High Court and the Trade Mark infringed in that case was already registered before the commencement of the action. Karibi -

Whyte, J.SC considered the narrow point mentioned above in the light of the provisions of the Section 3 of the Trade Marks Act, 1965, Section 230(1)(f) of the 1979 Constitution and Section 7(1)(c)(ii) of the Federal High Court Act, 1973 and concluded as follows: -

“On the above analysis, the Federal High Court has jurisdiction in respect of an action of passing-off arising from *infringement of Plaintiff’s registered Trade Mark*, since the passing-off and the infringement of Plaintiff’s registered Trade Mark are matters from the same transaction which can conveniently be included in the writ of summons and can be tried together.”

*(Italics mine)*

The other learned Justices who sat with him on the case also agreed with this conclusion.

The emphasis here is that for Federal High Court to have jurisdiction for the passing-off claims, arising from infringement of a Trade Mark, the Trade Mark allegedly infringed must have been registered. This is not the case here as the Trade Mark of the Appellant, “NEW QUEENS”, had not been registered. Learned Counsel for the Appellants/ Cross-Respondents argued in the brief that Section 3 of the Trade Marks Act, 1965, imposes no penalty on those who do not register their Trade Marks, and creates no bar to an action for passing-off of an unregistered Trade Mark. According to the learned Counsel for the Appellant’s understanding of the decision in *Patkum’s case*:

“The Federal High Court has jurisdiction not only in respect of “passing-off’ actions arising from infringement of registered Trade Marks but also in respect of “passing-off’ actions relating to unregistered Trade Marks”.

a I do not agree with the learned Counsel on this. In my  
respectful view, she did not seem to comprehend the *ratio*  
b *decidendi* of *Patkum's case*. The common law tort of passing-  
off the goods of another still exists generally but not in respect  
c of infringement of unregistered Trade Marks. What was  
decided in *Patkum's case* was only in respect of passing-off  
relating to infringement of registered Trade Mark. It was  
d also decided in that case that in addition to the right of action  
conferred on the owner of a registered Trade Mark under  
Section 3 of the Trade Marks Act, 1965, there is an additional  
right of action of passing-off in respect of the goods involved.  
Karibi-Whyte, JSC held that this last additional right of action,  
is statutory and can be found only in Section 3 of the Trade  
Marks Act, 1965.

e He further held at page 152: -  
“Section 3 of the Trade Marks Act, 1965 *proprio vigore*  
thus gives a right of action of passing-off. *The right*  
f *of action is therefore derived from the Trade Marks*  
Act 1965, and not from common law. 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”.  
g (Italics mine)

h What the learned Justice is saying here is that the right of  
action of passing-off under Section 3 of the Trade Marks  
Act, 1965 is statutory and is derived from that Act and not  
the common law. In other words, it can only arise or be  
i available where there is an infringement of a Trade Mark  
registered under the said Act.

j Learned Counsel for the Respondents/Cross-Appellants  
submitted that there were some conflicts in the judgments of  
the learned Justices who sat in *Patkum's case*, but that the

conflicts were *obiter dicta* which are not binding on the Court or the lower Courts, I have carefully read the judgments of all the learned Justices in the case, and I am unable to find any conflicts in their judgments on the issues determined by the Court. I have already set out earlier in this judgment the conclusion reached by Karibi-Whyte, JSC in the lead judgment. For avoidance of doubt, I set out here below the essential part of the supporting judgments of the other 4 learned Justices thus: -

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Nnamani, JSC at p. 157:

“It seems to me that from the wording of the proviso to Section 3 read together with Section 7(1)(c)(ii) of Act No. 13 of 1973, a Statutory right of action on passing-off is provided. What is involved, at least as it relates to Trade Marks, is not the Common Law action of passing-off, but a statutorily guaranteed right of action”.

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Uwais, JSC (as he then was) at p. 159.

“In my opinion, therefore, the Federal High Court has jurisdiction, by virtue of Section 63 of the 1965 Act read together with Section 7(1)(c)(ii) of the 1973 Act, to hear at the same time both the claims in respect of the infringement of the Respondent’s *registered Trade Mark* and passing-off. See *Gafai v. U.A.C. Ltd (supra)*”.

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Agbaje, JSC at p.162:

“The Plaintiff’s claim, in my judgment, related exclusively to the infringement of its *registered Trade Mark*. The claims evidently arise from an enactment relating to Trade Marks to wit Trade Marks Act, 1965. So the Federal High Court has jurisdiction, in my judgment, to try the action under Section 7(1)(c)(ii) of the Act of 1973”.

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- a Wali, JSC at p.163:
- b “The endorsement on the Writ of Summons and the
- c amended Statement of Claim of the Respondent
- d showed clearly that the cause of action is the
- e ”infringement of the *registered Trade Mark*” resulting
- f in the 2<sup>nd</sup> cause [of action] which is “passing-off”. The
- g two causes of action can conveniently be joined and
- h dealt with together, as the infringement of the Trade
- i Mark and passing-off of the goods arose from the same
- j transaction. See *Gafai v. U.A.C. Ltd. (1961) 4 All NLR 785 and Bendir v. Anson (1936) 3 All ER 326*”.
- d It is very clear that all the judgments dealt with registered
- e Trade Mark and the passing-off cause of action arising from
- f the infringement of the registered Trade Mark. They are all
- g saying the same thing in different ways. I cannot see any
- h conflicts in their judgments which in my view, tallied in all
- i respects with the lead judgment of Karibi-Whyte, JSC. The
- j total effect of the judgment in *Patkum’s case* is that the Federal
- High Court will only have jurisdiction to entertain an action
- for passing-off arising from an infringement of a registered
- Trade Mark and the action must have arisen in relation to a
- Federal enactment. The Trade Marks Act, 1965, is a Federal
- enactment, but in this case, although there was an allegation
- of infringement of a Trade Mark, the Trade Mark was not
- registered and so the passing-off claim, even if there was
- such passing-off, did not, and could not have arisen from a
- registered Trade Mark. Also, the passing-off right of action
- in *Patkum’s case* is clearly statutory having arisen from the
- infringement of the Trade Marks Act, 1965, a Federal
- enactment. I am bound by the decision in *Patkum’s case* as a
- decision of this Court and I follow it. In the instant case, the
- passing-off right of action did not arise from the infringement
- of any Federal enactment and so may only be a common law
- right. Therefore, the Federal High Court would not have any

jurisdiction under Section 230(1)(f) of the 1979 Constitution or Section 7(1)(c)(ii) of the Federal High Court Act, 1973 to entertain the passing-off action instituted by the Appellant in the instant case. I hold accordingly. I therefore find that the Court of Appeal was wrong when it said in the leading judgment that

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“the Federal High Court is eminently competent to adjudicate on the matter”. I answer issue 1 in the cross-appeal in the negative.

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Since the issue of jurisdiction is the main gate to any proceedings before any Court or tribunal, the above finding has closed the gate to any action *ab initio* by the Appellant in the Federal High Court in this case. There is therefore no need at all for me to consider the other issues raised in the main Appeal or the Cross-Appeal.

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Finally, from all what I have said above, I find that the trial Federal High Court has no jurisdiction to entertain this case as it did and that the Court of Appeal was wrong to hold otherwise.

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Therefore, since the Federal High Court has no jurisdiction to entertain the matter *ab initio*, its decision and that of the Court of Appeal thereon are also a nullity (see *Timi-Timi v. Amabebe* (1953) 12 WACA 374; *Nyarko v. Akowuah* (1954) 14 WACA 426) and are hereby set aside. See *Okafor v. A.G. Anambra State* (1991) 6 NWLR (Pt.200) 659 at 680.

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I award N10,000.00 costs in favour of the Respondents/Cross-Appellant.

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**UWAIS, C.J.N:** I have had the opportunity of reading in draft the judgment read by my learned brother, Kalgo, JSC. I quite agree with the judgment.

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a It seems to me the jurisdiction of the Federal High Court to  
deal with actions on passing-off depends on the registration  
of Trade Marks as provided by Section 3 of the Trade Marks  
Act, Cap 436 and Section 230 subsection (1)(f) of the 1979  
b Constitution (now Section 251(1)(f) of the 1999 Constitution  
– See *Patkum Industries Ltd. v. Niger Shoes Manufacturing  
Co. Ltd. (1988) 5 NWLR (Pt. 93) 138*. Where the Trade Mark  
is unregistered, as in the present case, then the cause of action  
c for passing-off is in common law for tort and action can now  
be brought in a State High Court in view of the provisions of  
Section 272 subsection (1) of the 1999 Constitution which  
provides: -

d “272 – (1) 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  
e determine any civil proceedings in which the existence  
or extent of a legal right, power, duty, liability,  
privilege, interest, obligation or claim is in issue  
f .....

g For these and the fuller reasons contained in the judgment of  
my learned brother, Kalgo, JSC, I too find that the Federal  
High Court lacked the jurisdiction to try the Plaintiff/  
Appellant’s case. The cross-appeal by the Defendants/  
Respondents herein succeeds. There is no need to consider  
the Appeal by the Plaintiff since the trial by the High Court is  
h null and void. I adopt the Order as contained in the judgment  
of my learned brother, Kalgo, JSC.

i **OGUNDARE, J.S.C.:** I agree with the judgment of my  
learned brother, Kalgo JSC just delivered. For the reasons  
given by him, which I hereby adopt as mine, I too dismiss the  
Appeal of the Plaintiff and allow the Cross-Appeal of the  
Defendants. I hold that the trial Federal High Court lacked  
j jurisdiction to entertain Plaintiff’s claim which is accordingly

struck out.

I abide by the Order for costs made in the judgment of Kalgo JSC.

**MOHAMMED, J.S.C.:** I entirely agree. The Federal High Court has no jurisdiction in respect of an action arising from a claim for “passing-off” of an unregistered Trade Mark. The Court of Appeal is therefore in error to decide that the Federal High Court could entertain the claim filed by the Plaintiff-Appellant. The Cross-Appeal which is brought challenging the jurisdiction of the Federal High Court to entertain the claim for damages for “passing-off” of an unregistered Trade Mark hereby succeeds. I therefore agree with the lead judgment of my learned brother, Kalgo, JSC and concur with his opinion in the said judgment. The main Appeal fails and it is dismissed. The Cross-Appeal succeeds and it is allowed. I abide by all the consequential Orders made in the lead judgment.

**IGUH, J.S.C.:** I have had the privilege of reading in draft the judgment just delivered by my learned brother, Kalgo, JSC and agree entirely with the reasoning and conclusions therein.

It is clear to me that the trial Court has no jurisdiction to entertain this action and the Court below was in error to have held otherwise. In the circumstance, the Cross-Appeal succeeds and it is hereby allowed for want of jurisdiction. Case No. FHC/L/CS/674/96 filed by the Appellant at the trial Federal High Court is hereby struck out. As the proceedings before the trial Federal High Court and the Appeal therefore to the Court of Appeal are all null and void for want of jurisdiction, the main Appeal before this Court against the said decision of the Court of Appeal does not now arise and it is hereby equally struck out.

I abide by all the Orders contained in the leading judgment including those as to costs therein made.

*Appeal dismissed, Cross-Appeal allowed.*

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