

**SUPREME COURT OF NIGERIA**  
FRIDAY 20TH JUNE, 2003. SC. 116/1999  
**CORAM:- M. L. UWAIS CJN, M. E. OGUNDARE,**  
**U. MOHAMMED, A. I. IGUH, U. A. KALGO, JJSC**

AYMAN ENTERPRISES LIMITED ..... APPELLANT  
AND

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

(Trading under the name and style of Comfort Hair Zone) (Sued on their own behalf and as representing all members of the class defined as engaged in the trade or business of selling or 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’s “NEW QUEENS”)

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JURISDICTION - Fundamental nature of - Issue of jurisdiction must be looked into first when raised - Because any proceedings of court in absence of jurisdiction - Is futile (H1)

JURISDICTION - Federal High Court - Passing off - In respect of the general jurisdiction in passing off - Jurisdiction of the court is as set out in s.230 (1) (f) of 1979 constitution - In respect of actions arising from federal enactments (H2)

JURISDICTION - Federal High Court - Passing off - Basis - For the court to entertain passing-off claims - Arising from infringement of trade mark - The trade mark infringed must have been registered (H3)

JUDICIAL PRECEDENTS - Authority - Patkun's case - Ratio decidendi - Tort of passing-off goods exists generally - But not in respect of infringement of unregistered trade marks (H4)

JURISDICTION - Federal High Court - Passing off - Patkun's case - Effect - The effect is that the court will only have jurisdiction - Where the action arises from infringement of registered trade mark - In relation to a Federal Enactment (H5)

APPEALS - Courts - Jurisdiction - Absence of - Effect - Since the Federal High Court lacked jurisdiction ab initio - Its decision and that of the Court of Appeal thereon - Are a nullity (H6)

### ***FACTS***

Plaintiff/appellant sued defendants/respondent in Federal High Court, Lagos claiming inter alia, for injunction restraining respondents from passing-off or attempting to pass-off wigs and hair attachment belonging to respondents under the trade mark of "ORIGINAL QUEENS" as that of appellant is NEW "QUEEN" or any colorable invitation thereof. At the time of filing the writ of summons appellant also filed two motions - one ex parte for anton pillar another on notice for interlocutory injunction. Subsequently, the learned trial judge heard the application and granted all the prayers thereof. Appellant executed the anton order by seizing the offending goods. Thereafter, respondent an application seeking to discharge the anton pillar order.

After hearing, the learning trial judge dismissed respondents' application and granted appellant's motion for interlocutory injunction pending the determination of the suit. Aggrieved, respondents appealed to Court of Appeal which appeal was allowed by court and the ruling of trial court set aside. Dissatisfied, appellant filed appeal at Supreme Court Respondent also cross-appealed challenging the jurisdiction of Federal High Court to entertain the claim ab initio on the ground that the alleged passing-off was in respect of an unregistered trade mark.

### ***ISSUE FOR DETERMINATION***

*"(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.*

**HELD** (Unanimously dismissing the appeal and allowing the cross-appeal per **KALGO JSC**)

*JURISDICTION - Fundamental nature of*

**1. 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.**

**And where as in this appeal the issue of jurisdiction is raised, the court has a duty to consider the issue timeously before taking any further steps in the matter.**

**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. (p. 1891 D)**

*JURISDICTION - Federal High Court - Passing off*

**2. 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. 134 Laws of the Federation of Nigeria, 1990).**

**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. (pp. 1894 E/1895 B)**

*JURISDICTION - Federal High Court - Passing off - Basis*

**3. Patkum's case was decided by this court on the effect of Section 3 of the Trade Marks Act, 1965. The facts in 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 was instituted. Karibi-Whyte, JSC., delivering the leading judgment in Patkum's case. 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 marks, 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". (Underlining mine)***

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

**The emphasis here is that for a 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 QUEEN" had not been registered. (pp. 1896 G & 1897 C)**

*JUDICIAL PRECEDENTS - Authority - Patkum's case - Ratio*

**4. 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".***

**I do not agree with the learned counsel on this. In my respectful view, she did not seem to comprehend the ratio decidendi of 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.**  
(p. 1897 G)

*JURISDICTION - Federal High Court - Passing off - Patkum's case*  
**5. 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. 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.**

**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 "the Federal High Court is eminently competent to adjudicate on the matter".** (pp. 1899 F & 1900 A)

*Courts - Jurisdiction - Absence of - Effect*

**6. Finally, for 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.**

**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.** (p. 1900 D)

## NOTABLE POINT OF INTEREST

### UWAIS JSC

#### **1. Tort of passing off - jurisdiction is in state high court**

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 Constitution (now Section 251(1)(f) of the 1999 Constitution)

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  
B action can now be brought in a State High Court in view of the provisions of Section 272 subsection (1) of the 1999 Constitution.  
(p. 1900 H)

**C REPRESENTATION**

Sylvia Shinaba (Mrs.), with Mariam Jones (Mrs.), for the Appellant/  
Cross-Respondent  
Tayo Oyetibo, Esq., for the Respondents/Cross-Appellants

**D CASES REFERRED TO**

Ifezue v. Mbadugha (1984) 5 S.C. 79  
Alao v. C.O.P. (1987) 4 NWLR (Pt. 64) 199  
Nwamezie v. Idris (1993) 3 NWLR (Pt. 279) 1  
State v. Onagoruwa (1992) 2 NWLR (Pt. 221) 33  
E Okafor v. A.G. Anambra State (1991) 6 NWLR (Pt. 200) 659  
Funduk Engineering v. McArthur (1995) 4 NWLR (Pt. 392) 640  
Oredoyin v. Arowolo (1989) 7 S.C. (Pt. II) 1

**F STATUTES REFERRED TO**

Federal High Court Act 1973, s.7  
Constitution of Federal Republic of Nigeria 1979, s.230 & 251  
Trade Marks Act Cap 436 LFN 1990, s.3

**G LEAD JUDGMENT BY KALGO JSC**

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 the 26th of June, 1996, the plaintiff/appellant claimed for:-

H “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 to say:-*

(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 use 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 QUEEN" or any colourable imitation thereof without duly distinguishing such packaging from that of the plaintiff or by any other means.*

(ii) *Manufacturing, importing, selling or offering for sale or supplying Wigs and Hair attachments in any Package or Get-up bearing the name "ORIGINAL QUEENS" or any other words so clearly resembling the plaintiff's Trade Mark "NEW QUEEN" applied for and accepted under TP 24575/95 in class 26, 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.*

(iii) *Infringing the copyright in the Artistic work of the plaintiff's Trade Mark "NEW QUEEN", its Get-up, Logo, Package and Distinctive Label.*

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 QUEEN" 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 1st Defendant, their servants, agents, or privies or any of them, the use of which would be in breach of the INJUNCTION prayed for and verification upon oath that the 1st Defendant have no such articles in their possession, custody or control.*

3. *An order that the Defendant and each of those upon whose behalf the Defendants are sued whether acting 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 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.*

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 attachments as and for the plaintiff's "NEW QUEEN" Wigs and Hair attachment and for infringing the Copyright in the Artistic work of the plaintiff's Trade Mark, its B Get-up, Logo, Package and Distinctive Label".*

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. On 1st 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 was fixed for hearing on 25th July, 1996. On the 9th of July, 1996, the appellant executed the Anton-Pillar order by seizing the offending goods from the defendants/respondents. On the 12th of July 1996, the respondents filed 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 27th of July, 1996, learned trial Judge ordered that both the appellant's motion on notice for interlocutory injunction and the respondent's motion to set aside the Anton-Pillar orders be consolidated and heard together.

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 28th of November, 1996 in which he dismissed the respondents' application to set aside the order 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 6th of July, 1999, the Court of Appeal allowed the appeal and set aside the 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.

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:

*"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 3rd Schedule of the Trade Marks Act 1965, is relevant to the specification of goods in the trade mark applications for “NEW QUEEN Collection and Device” and “Queens & Device.”*

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 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.*

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.*

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 injunction orders were so abrasive in nature as to have the effect of taking the wind out of the case.*

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.*

6. *Whether an appellate court can rightly consider and make findings on an issue specifically reserved by the trial court for the substantive hearing.*

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?”*

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:-

“(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.*

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

(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 28th November, 1999: Grounds 1, 5, 6, 8 and 9 of the Amended Notice of Appeal”.*

The respondents filed their notice of cross-appeal on the 5th of August, 1999, after obtaining leave of the Court of Appeal. The Notice of Appeal contained only one ground which, with its particulars reads:-

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

“*Now we have in Section 230 of the Constitution as amended which includes 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 embrative, that being the case, 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 of the Supreme Court Judges in Patkums case and I must candidly confess that I failed to see any contradiction. It is very easy to grasp the nuances of 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**

(a) *The Jurisdiction conferred on the Federal High Court by Section 230(1)(f) of the 1979 Constitution as amended by Decree No. 107 of 1993 in relation to passing off actions was in respect of civil causes and matters arising from “any Federal enactment relating to .....passing-off. (b) the Trade Marks Act, Cap. 436 in 1990 Laws of the Federation earlier referred to in 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-off could have arisen (b) the pronouncements in the judgment of the Supreme*

*Court in the case of Patkum Industries Ltd. v. Niger Shoes Manufacture Ltd. (1988) 12 S.C. (Pt. II) 1, (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.* B

*(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 reads:- C

*“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.** E

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) 7 S.C. (Pt. II) 1; (1989) 4 NWLR (Pt. 114) 172 at 187; *Ifezue v. Mbadugha* (1984) 5 S.C. 79. **And where as in this appeal the issue of jurisdiction is raised, the court has a duty to consider the issue timeously before taking any further steps in the matter.** See *Nwamezie 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* (1991) 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.** F  
The outcome of this consideration will determine whether it is necessary to consider the issues identified in the main appeal. G

The respondents’ only issue in the cross-appeal is simply this: H  
whether the 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 Constitu-

tion as amended by Decree No. 107 of 1993, Section 3 of the Trade Marks Act, 1965, and Section 7(1)(c)(ii) of the Federal High Court 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, 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 as the goods of another person, without specifying which court would have 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 the Act.

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 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, 1965, but is a common law tort outside the scope of the provisions of Section 7(1)(c)(ii) of the Federal High Court Act, 1973.

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 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 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) 12 S.C. (Pt. II) 1; (1988) 5 NWLR (Pt. 93) 138 IML Air Chartering Nig. Ltd. v. IMNL International Messengers (Nig.) Ltd 5 FCFR 113 wherein the various sections were judicially interpreted, and came to the conclusion that on the facts of this particular case, the 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.

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 had 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 examined the provisions of Section 3 of the Trade Marks Act, 1965, and the decision of this court in Patkum's case (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 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 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 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 submissions of counsel.

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:-

“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, 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 9th July, 1995, was acknowledged on the 31st day of July, 1995, as TP24575/95. The Registrar accepted the application for registration on the 1st day of 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 Acknowledgment and Acceptance forms issued to the plaintiff/applicant by the Trade Marks Registry, Abuja in 1995”.

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

***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. 134 Laws of the Federation of Nigeria, 1990).*** Section 230(1)(f) of the 1979 Constitution provides:-

“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:-

(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”. (Underlining mine)

By this provision, the Federal High Court and that court alone, had exclusive jurisdiction to entertain all civil causes and matters arising

ing from federal enactment relating to any of the matters mentioned in (f) above, including trade marks and passing-off.

Section 7(1)(c)(ii) of the Federal High Court Act also

Provides:-

*“The court shall have and exercise jurisdiction in civil causes and matters*

*(c) arising from -*

*(ii) any enactment relating to copyright, patents, designs, trade marks and merchandise marks;”*.

**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.**

In this case, the Federal enactment we are concerned with is principally the Trade Marks Act, 1965, Cap. 436 of Laws of the Federation of Nigeria, 1990, (hereinafter referred to as “the Act”). Section 3 of the Act provides:-

*“No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of any 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.”* (Underlining 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 as the 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 plain-

tiff 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 right 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 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.

For the appellant, the learned counsel submitted in its brief also relying in 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 statutorily provided for by Section 3 of the Act. Counsel further submitted that their claim arose from the passing-off of their trade mark under the Trade Marks Act an enactment relating to 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 1970 Constitution.

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 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 was instituted. Karibi-Whyte, JSC., delivering the leading judgment in Patkum’s case*** stated by saying that-

“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 had also been claimed*” (Underlining mine)

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, JSC., considered the narrow point mentioned above in the light of the provisions of 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 marks, 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”.*** (Underlining mine)

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

**The emphasis here is that for a 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 QUEEN” 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 mark, 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”.***

**I do not agree with the learned counsel on this. In my respectful view, she did not seem to comprehend the ratio decidendi of 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

B 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. He further held:-

C “Section 3 of the Trade Marks Act, 1965, *priprio vigore* thus gives a right of action of passing-off. The right of action is therefore derived from the Trade Marks Act, 1965, and not common law. It is not correct to assume that a right of action enacted into a statutory  
D provision is ineffective merely because it has its origin in the common law. This is not so”. (Underlining mine)

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  
E other-words, it can only arise or be available where there is an infringement of a trade mark registered under the said Act.

Learned counsel for the respondents/cross-appellant's submitted that there were some conflicts in the judgments of the learned  
F Justices who sat in the 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  
G the conclusion reached by Karibi-Whyte, JSC., in the leading judgment. For the avoidance of doubt I set out here below the essential part of the supporting judgments of the other 4 learned Justices thus:-

Nnamani, JSC:

H “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 134 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 statutory guaranteed right of action”.

Uwais, JSC, (as he then was):

*“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)”* B

Agbaje, JSC:

*“The plaintiff’s claims in my judgment relate 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”.* C

Wali, JSC:

*“The enactment on the writ of summons and the Amended Statement of Claim of the Respondent showed clearly that the cause D of action is the “infringement of the registered trade mark” resulting in the 2nd cause of action which is “passing-off”. The two causes of action can conveniently be joined and dealt with together, as the infringement of the trade mark and passing-off of the goods arose from the same transaction. See Gafai v. U. A. C. Ltd (1961) All NLR E 785 and Bendir v. Anson (1936) 3 All ER 326”*

It is very clear that all the judgments dealt with registered trade marks and the passing-off cause of action arising from the infringement of the registered trade mark. They are all saying the same thing F in different ways. I cannot see any conflicts in their judgments which in my view tallied in all respects with the leading judgment of Karibi-Whyte, JSC. **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. 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 G case is clearly statutory having arisen from the infringement of the Trade Marks Act, 1965, a Federal enactment. I am bound by the H

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

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.

**Finally, for 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.**

**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 *Timitimi v. Amabebe* 12 WACA 374; *Nyarko v. Akowuah* 14 WACA 426 and are hereby set aside. See *Okafor v. A.G. Anambra State* (1991) 6 NWLR (Pt.200) 659 at 680.

I award N10, 000 costs in favour of the respondents/cross appellants.

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### UWAIS CJN

I have had the opportunity of reading in draft the judgment read by my learned brother, Kalgo, JSC. I quite agree with the judgment.

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 Constitution (now Section 251(1)(f) of the 1999 Constitution) - See Patkum Industries Ltd. v. Niger Shoes Manufacturing Co. Ltd. (1988) 12 S.C. (Pt. II) 1; (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 which provides:-

*“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 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.....”*

For these and the fuller reasons contained in the judgment of any 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/Respondent herein succeeds. There is no need to consider the appeal by the plaintiff since the trial by the High Court is null and void. I adopt the order as contained in the judgment of my learned brother, Kalgo, JSC.

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### **OGUNDARE JSC**

I agree with the judgment of any 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 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.

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### **MOHAMMED JSC**

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  
B 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.

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C

***IGUH JSC***

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.

D 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 circumstances, 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  
E 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  
F struck out.

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

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