

SUPREME COURT OF NIGERIA
6TH FEBRUARY, 2004. SC. 95/1999
CORAM:- S. M. A. BELGORE, U. MOHAMMED, S.U. ONU,
N. TOBI, D. MUSDAPHER, JJSC.

1. FERODO LIMITED	APPELLANTS
2. FERODO NIGERIA LIMITED		
AND		
IBETO INDUSTRIES LIMITED	RESPONDENT

APPEALS - Grounds of appeal - Preliminary objection thereto - Is overruled in this case - For being unfounded (H1)

APPEALS - Grounds of appeal - Leave of court - Where leave was not obtained - Questions of facts or mixed law and facts will be struck out (H2)

TRADE MARKS - Essence and definition - A trade mark indicates connection between the goods - And person having right to use same - It includes a device, brand, name, word, etc. (H3)

TRADE MARKS - Registration of - Gives right to exclusive use - And right to sue for infringement and or passing off (H4)

TRADE MARKS - Registered device - Proof - Colour and geometrical outlines - Were not proved to be part of the registered device (H5)

TRADE MARKS - Infringement - Similarity of marks - Is determined by considering the marks alone - Without the associated features (H6)

TRADE MARKS - Appeals - Concurrent findings - That only the word "Ferodo" is the registered trade mark - Without including colours and graphic designs - Is upheld by the supreme court (H7)

TRADE MARKS - Infringement - Circumstances under which it will be maintained - Do not exist in this case- As the word UNION - Is in capable of infringing plaintiffs' mark FERODO (H8)

FACTS

Before the Federal High Court Lagos the plaintiffs/appellants filed an action against the defendant/respondent. Appellants inter alia, claimed an injunction restraining the respondent from infringing or passing off their registered trade mark No. 38604. Appellants trade mark is FERODO and that of the respondent is UNION used in marketing the parties' break lining products. Appellants claimed that the red, black and white graphic design is part of their registered trade mark FERODO brake linings. It is this graphic design that appellants are claiming that the respondent is infringing and or passing off. Respondent denied the appellants' claim and maintained that the red, black and white design is commonly used in presenting brake linings, that it is not exclusive to the appellants, that appellants' registered trade mark is the name FERODO without the graphic design and colours.

The trial court found in favour of the respondent and dismissed the appellants' claim. Their appeal to the Court of Appeal was also dismissed. Being dissatisfied appellants have further appealed to the supreme court raising various grounds of appeal and issues. But pursuant to the preliminary objection raised by the respondent some of the grounds were struck out and only two of the issues were considered by the apex court.

ISSUES FOR DETERMINATION

"1. Whether the Court of Appeal should at all have looked into the registerability or the entitlement of the plaintiffs/appellants to exclusive use of the individual components of the trade mark registered under No. 38604?

2. If the Court of Appeal was right to have looked into the registerability of any component of trade mark No. 38604, whether the court was right in deciding That only FERODO was registered under trade mark No. 38604."

HELD (Unanimously allowing the appeal per lead judgment of **MUSDAPHER JSC**)

Grounds of appeal - Preliminary objection thereto

1. I agree with the learned counsel for the appellants that the complaint as contained in first ground of appeal clearly emanated from the decision of the Court of Appeal. I accordingly overrule the first part of the preliminary objection in relation to the first ground of appeal. In my view, no matter what angle you examine it, the first ground of appeal is a ground of law: The preliminary objection in respect of the ground one is accordingly not made out and is overruled by me. In my view the second ground of appeal is also complaining on the decision of the lower court on what was the registered trade mark. It is almost the same as the first ground, though differently and more clearly drafted. I also overrule the objection against the second ground of appeal. (p. 503 F/504 B)

Grounds of appeal - Leave of court

2. But grounds No. 3, 4, and 6 are clearly complaints on questions of facts or at best questions of mixed law and facts. No leave of the court below nor of this court has been sought to argue the grounds of appeal. I rule that they are incompetent and are also struck out by me. Thus since grounds 3,4,5,6,7, and 8 are incompetent and the issues premised upon these grounds are also incompetent and must also be struck out. Therefore issues 3,4,5 and 6 are not relevant to the decision in this appeal and are struck out. (p. 504 C)

TRADE MARKS - Essence and definition

3. The essence of a trade mark is that it indicates a connection in the course of trade between the goods and some person having the right to use the same. A mark, in this connection includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. A trade mark on the other hand is a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as a proprietor or a registered user to use

the mark. A trade mark can also be defined as a distinctive picture which would indicate to a purchaser of an article bearing it, the means of getting the same article in future, by getting an article with the same mark on it. (p. 507 A/D)

B

TRADE MARKS - Registration of

4. A trade mark if registered gives the proprietor the exclusive right to use the trade mark in marketing or selling his goods. And without his consent if any one else uses an identical mark or one mark so nearly resembling it as to be likely to deceive or cause confusion, will entitle the proprietor to sue for infringement of the trade mark, or to sue in action for passing off or both. (p. 507 E)

D

TRADE MARKS - Registered device

5. Thus there is no proof or indication whatsoever that the colour outlay and the geometrical outlines as contained in Exhibit D are of any distinctive character so as to constitute device within the contemplation and intendment of Sub-sections 2 and 3 of Section 9 and also of Section 67 of the Trade Mark Act. A look at Exhibit C which is the package in which the appellants market FERODO brake linings, Exhibit K-K1 which are photographs of the appellants' billboards advertising brake pads found in different locations in Lagos make it obvious that it was only the word FERODO that was registered under Section 9(1)(a) of the Act. This fact, is further borne out, by the evidence of P.W.2 and other witnesses that the appellants' brake pad is known as FERODO and that customers purchase the product by asking for it by its brand name. (p. 509 F)

G

Infringement - Similarity of marks

6. In deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like. See LEVER BROS. LTD. VS. SUNNIVTE PRODUCTS LTD. (1949) 66 R.P.C. 84. Evidence is admissible to show which of the features as shown in the register i.e Exhibit D in this case are essential and which are inessential so as to be unimportant in deciding questions of

H

infringement. See DE CORDOVO VS. VICK (1951) 68 R.P.C. 103. It is therefore clear that it is not all the features that are contained in Exhibit D, that are important for the purposes of the infringement of the trade mark. Not all the components are to be considered as forming part of the trade mark. The resemblance giving rise to infringement must lie in the basic idea of the mark, in this case "FERODO". It is the basic idea of the trade mark as evidenced by the advertisement in the bill boards and the evidence of witnesses at the trial who called the product simply "FERODO." In my view the graphic design and the colouration as contained in Exhibit D are incapable of distinguishing the brake linings or brake pads of one undertaking from or the appellants' undertaking. (p. 510 B)

TRADE MARKS - Appeals - Concurrent findings

7. The decision of the lower court is consistent and concurrent with the decision of the trial court. These are findings of fact based on the evidence adduced and accepted. It is elementary law, that an appellate court such as the Supreme Court will hardly reverse a concurrent finding of facts. I am also convinced that what is registered as a trade mark is only the word "FERODO". It is a distinct character marked sharply and boldly in Exhibit D denoting that it represents the futuristic character by which the proprietor manufacturer intended to convey a message that the product is hers and no other person's. In any event, I also agree that the packaging design in colours of red, black and chequered white graphics are common in the trade of brake pads and linings as clearly shown and evidenced in exhibits O, C, N and M. All these exhibits show how various packages of various manufacturers of brake linings market their products in same colours. In summary, I agree with the courts below, that the only mark registered for the first appellant is the word "FERODO" and the colouring out lay and the geometric designs are merely decorative and do not form part of the trade mark. (p. 511 D/G)

Infringement - Circumstances under which it will be maintained

8. Following the provisions of Section 5(2) of the Trade Mark Act an

infringement of a registered trade mark cannot be maintained unless the court finds that the defendant is engaged in the use of a mark identical with the registered trade mark or uses a mark so nearly resembling the registered trade mark, as to be likely to deceive or cause confusion in the course of trade; or uses in relation to any goods in respect of which it is registered, or uses in such a manner as to render the use of the mark to be taken as importing a reference to the goods which the plaintiff's trade mark is connected. None of these circumstances apply in this matter. The registered Trade Mark in this case is the word FERODO and the word UNION or UNION SUPA is incapable of infringing FERODO. And, in any event, the appellants have not established that the respondent used, the get up or the packaging in Exhibit E or F to market their products. Issues I and 2 are clearly resolved against the appellants.

(p. 512 E)

NOTABLE POINTS OF INTEREST

TOBIJSC

I. *Obiter dictum - Its effect in case Law*

I entirely agree with learned counsel that the above statement of Romer, LJ, is an obiter dictum. As a general rule, an obiter dictum is not binding. See *Alhaji Yusuf v. Egbe* (1987) 2 NWLR (Pt. 56) 341. However, there are occasions when an obiter dictum may have a binding effect.² See *Mrs. Maclean v. Inlaks Ltd.* (1980) 8-11 SC 1; *Ifediorah v. Uma* (1988) 2 NWLR (Pt. 74) 5. That is not relevant for our purpose and so I will not pursue it. What is important however is that an obiter dictum, which is what the court says by the way, has persuasive effect. A court of law can allow itself to be persuaded by an obiter dictum. I know of no law which holds a contrary view. The Court of Appeal, in my view, was therefore free to rely on the statement of Romer, LJ, in *In Re Clement*.

(p. 534 A)

2. *Resemblance of Trade marks - Engagement of senses of ears & eyes*
In determining whether two trade marks are identical or of close resemblance within the provision of section 13 of the Act and therefore not

registrable under section 11, two senses of the human being are employed. These are the senses of the ears and the eyes to arrive at a conclusion on the average memory arising from general recollection. In the exercise of comparison not only the visible inspection is important, the sounds is equally important. The sound which is assimilated by the ear is important when a telephone conversation takes place. (p. 536 C)

3. Comparison of trade marks - How properly done

In the exercise of comparison, it is wrong to take the two trade marks side by side to determine whether they are identical or some close resemblance exists within the provision of section 13 of the Act. The issue is whether the person who sees or has seen the proposed trade mark will confuse it with the existing trade mark, as to create confusion and be deceived that the proposed trade mark is the same as the existing one. One other way of conducting the exercise of comparison is by looking closely at the first syllable, being the word or part of the word which contains a vowel sound or a consonant acting as a vowel. For instance, there are two syllables in the word "window". "win" and "dow". (p. 536 G/ 537 C)

4. Why plaintiffs' action must fail

Assuming, without conceding that "FERODO" and all other components were registered, the appellants cannot succeed because there are clear differences between the two trade marks. This can be seen from Exhibits C, D, E, F and O. In the light of my decision above, it will be a futile exercise to deal in detail with the exhibits. (p. 541 B)

REPRESENTATION

Obatosim Ogunkeye for the appellants

O. Opasanya for the Respondent.

CASES REFERRED TO

Coker v. UBA (1997) 2 NWLR (Pt. 490) 641, (1997) 2 KLR (pt 48) 413

Udih v. Idemudia (1998) 3 SC 50, (1998) KLR (pt 59) 423

Odukwe v. Ogunbiyi (1998) 6 SC 72, (1998) 60 LRCN 4001, (1998) *KLR (pt 67) 1523*

Odofin v. Oni (2001) 1 SC (Pt. 1) 129, (2001) 1 *KLR (pt 114) 303*

Kolubo v. Ikuomola (1999) 72 LRCN 3005, (1999) 9 *KLR (pt 90) 2681*

B Odutan v. Akibu (2000) 80 LRCN 2595, (2000) 7 *KLR (pt 108) 2553*

Fasesin v. Oyerinde (1997) 54 LRCN 2692, (1997) 12 *KLR (pt 55) 1987*

Ivienagbor v. Bazuaye (1999) 70 LRCN 2256, (1999) 6 *KLR (pt 86) 1897*

STATUTE REFERRED TO

C TRADE MARKS ACT cap 436 LAWS OF THE FEDERATION OF NIGERIA (1990) ss. 38(1), 5, 9 (1) (a), (2) & (3), 15, 11, 49, 67

LEAD JUDGMENT BY MUSDAPHER JSC

D The appellants herein were the plaintiffs in the Federal High Court and the appellants at the Court of Appeal, Lagos. The claim in the Federal High Court was against the respondent herein (as the defendant) and was in the following terms:-

E *"An injunction to restrain the defendant whether acting by itself, its servants or agents or any of them, or otherwise howsoever from doing the following acts or any of them that is to say-*

(i) *Infringing the 1st plaintiff's registered Trade Mark No. 38604*

F (ii) *Passing off or causing or enabling or assisting others to pass off the defendant's UNION brake linings as and for the plaintiff's FERODO brake linings.*

(iii) *Selling or offering for sale or supplying brake linings or brake pads with labels or in packages having the distinctive red, black and white package design or get up of the plaintiff's FERODO brake Linings' package design or get up or so closely resembling it as to be calculated to lead to the belief that brake linings not of the plaintiffs' manufacture and merchandise are products of the plaintiffs'.*

H *DELIVERY UP for obliteration destruction of all brake linings, packages and labels containing the offending Marks or being in the offending design or get up, including printing blocks and other matters the use of which would be a breach of the injunction prayed for.*

DAMAGES OF N1,000,000.00

EXEMPLARY OR AGGRAVATED Damages of N500,000.00.

COSTS.

FURTHER OR OTHER RELIEFS."

In the 2nd FURTHER AMENDED STATEMENT OF CLAIM filed B
with the leave of the trial court on 3/12/1991, the above claims were
repeated by the plaintiffs.

Now, the facts of the case may be put shortly thus: The first
plaintiff is an English company and the second plaintiff is its Nigerian C
associated company. The plaintiffs are the manufacturers and sellers of
the FERODO brand of brake linings for motor vehicles sold in cardboard
packages registered by the first plaintiff as Trade Mark No. 38604 and
tendered in evidence at the trial as Exhibit C. They claim that the design D
or get up of the packages in which they sell their FERODO brake linings
is distinctive to them and to their product. They also claim that they had
been in the Nigeria market with their distinctive trade mark for a period
for over ten years prior to the suit taken in court.

The defendant on the other hand is an indigenous Nigeria com- E
pany and claims to manufacture and sell brake linings under the brand
name of UNION. The plaintiffs claim that the packaging under which the
defendant marketed its UNION brake lining is so similar to the plaintiffs' F
packaging, that it constituted an infringement of the plaintiffs' registered
trade mark No. 38604. The sale of the defendant's brake lining also
amounted to the passing off of the plaintiff's products. The plaintiffs
further allege that the Managing Director and the Marketing Manager of
the second plaintiff paid a visit to the defendant's factory in March 1990 G
and were shown a package by which the defendant wanted to market
their UNION brand of brake linings. The package shown was almost an
exact replica of the FERODO package. The plaintiffs through the Man-
aging Director aforesaid objected to the proposed use of the package
whereupon the defendant's Managing Director undertook not to use the H
package. The package shown to the plaintiffs by the defendant is Exhibit
E in these proceedings. While on a business trip to the eastern part of
Nigeria, it was observed by the Marketing Manager of the second plain-

tiff, packages of the defendant's brand of UNION brake linings in red, black and white colour combination so closely resembling the FERODO package design as to likely deceive the public have been put up for sale in the markets. The defence of the defendants was simply that the design of FERODO box was not distinctive of the plaintiffs alone. Red packaging in combination of black and white is traditional to the trade of brake linings. It was further argued that their use of the "UNION" PACKAGING DID NOT AMOUNT TO PASSING OFF OF THE PLAINTIFFS', FERODO brand of brake linings and its use did not constitute an infringement of the plaintiffs' trade mark No. 38604. The defendants again denied ever using as its packaging exhibit F, which the plaintiffs claimed was used by the defendant to pass off the plaintiffs' brake linings and also to infringe the plaintiffs' trade mark. The defendant tendered in evidence Exhibit O which contained the packaging they used to market their UNION brand of brake lining. It is important to bear in mind that the plaintiffs, as agreed by them, would have no complaint against the defendant if the defendant were in fact only using Exhibit O to market its merchandise. On the 28/2/1994, the learned trial judge in part of his judgment held as follows:-

"There is no doubt in my mind that whether this court finds that the defendant marketed its products in Exhibit F or O it does not infringe the registered trade mark of the plaintiffs' No. 38604 according to Exhibit D which is the certificate for use in Legal proceedings from Registrar of Trade Marks. What the plaintiffs registered as their trade mark is the word FERODO and in order to infringe the said trade mark, the defendant must have taken the said word in its entirety or must have a substantial portion of it. IN KERLY'S LAWS OF TRADE MARKS AND TRADE NAMES 10th Edition page 307 paragraph 15-02. It was stated that in an action for infringement of trade mark the plaintiff complains that the defendant has infringed his trade Mark by taking in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his statutory title to the exclusive use of the mark in question in goods of a specified kind. The right which is given by a valid registration is the right to exclude others from the use of the trade mark, in this case. "FERODO." It is therefore clear that the defendant's use of its own

name "UNION" or UNION SUPA" is so far away from the plaintiffs' registered trade mark by all standards that it can never be an infringement of "FERODO" since in an action for infringement, it is the marks themselves that must be compared. I am of the firm view that the use of the defendant's mark UNION does not in anyway resemble the plaintiffs' registered mark FERODO as to likely to deceive or cause confusion as no device was registered along with the word "FERODO". B

The learned trial judge thus found there was no infringement of trade mark firstly because it was only FERODO that was registered as the plaintiffs' trade mark and that UNION or UNION SUPA could not by any manner amount to an infringement of FERODO. The learned trial judge further in his judgment found that the claim of passing off also failed because red, black and white colour combinations as claimed by the plaintiffs was not distinctive to them and was common to the trade of brake linings and brake pads. He found that the plaintiffs failed to prove their claims against the defendant and he non-suited the plaintiffs for the reason given in the judgment aforesaid. D

The plaintiffs felt unhappy with the decision of the trial court and appealed to the Court of Appeal. At the hearing of the appeal at the Court of Appeal, the plaintiffs abandoned the appeal as it related to the issues of passing off. The appeal was limited to the issue of infringement of the trade mark. Three issues were submitted to the Court of Appeal for the determination of the appeal. The issues were:- F

- "1. Whether the registered trade mark of the first plaintiff is simply the word mark FERODO or the representation as shown in Exhibit D.*
- 2. Whether the defendant marketed its product in Exhibit F or O.*
- 3. Whether Exhibit F constituted an infringement of the 1st plaintiff's trade mark registered, under No. 38604 in class 17."* G

The Court of Appeal in its judgment delivered on 17/2/1999 affirmed the decision of the trial court and dismissed the plaintiffs' appeal. The findings of the Court of Appeal are consistent and concurrent with the findings of the trial Court. The court below in parts of its judgment specifically held:-

"xxxxxxxxxxxxx A careful and analytical consideration of the reg-

istered trade mark of the appellants impresses me that in actuality what was registered was FERODO" xxxxxxxxxxxxxxxxxxxxxxxxxxxxxxxx It cannot be taken that those fanciful and ornamental characters which colour the face of the package form part of the trade mark xxxxxxxxxxxxxxxxxxxxxxx."

B The plaintiffs still felt disgruntled and have now appealed to this court. The plaintiffs, are hereinafter referred to as the appellants while the defendant, as the respondent. On the 25/10/2000 with the leave of this court an amended Notice of Appeal containing eight grounds of appeal was filed. On the 9/1/2001, the respondent filed a Notice of Preliminary Objection to the hearing of the appeal on the grounds that:-

- C "1. *The appellants' appeal is incompetent.*
 2. *The appellants have not complied with requisite law and Rules of Court and*
 D 3. *The appeal constitutes an abuse of the process of the Court."*

The learned counsel for the respondent in the respondent's brief expatiated on his objections to the hearing of the appeal. In the appellants' reply brief filed on 5/2/2001, the appellants conceded to grounds 5,7 and E 8 that they are grounds of mixed law and facts and that no leave was sought and obtained to argue them. Thus the appellants have conceded the incompetence of grounds 5,7 and 8. These grounds without much ado, are hereby struck out by me. In the aforesaid brief the respondent F further argued that the remaining grounds 1,2,3,4, and 6 are also incompetent either on the grounds that the complaints as contained in the grounds of appeal did not flow directly from the judgment of the court below or that the grounds of appeal contain complaints on facts or at best complaints on mixed law and facts for which leave to canvass the grounds G was necessary.

It shall be necessary now to reproduce the remaining grounds of appeal as contained in the amended Notice of Appeal filed on the 25/10/2000:-

- H (i) The learned justice of appeal erred in law in enquiring into the entitlement of the 1st plaintiff/appellant to the exclusive use of certain components of the representation of the trade mark registered under No. 38604."

PARTICULARS

(a) By the provision of Trade Marks Act, in any legal proceedings a registered trade mark must be presumed as having been validly registered.

(b) Enquiring into the entitlement of the proprietor of the trade mark to the exclusive use of any component of the trade mark, where no disclaimer has been entered in the register of trade marks in respect of such component, is to enquire into the validity of the registration of the trade mark.

(c) The court can enquire into the validity of a registered Trade Mark at the instance of a defendant, only where the defendant has challenged the validity of the trade Mark. However, the defendant/respondent herein did not challenge the validity of the Trade Mark No. 38604 at the Federal High Court.

(ii) The learned justice of the appeal erred in law in holding that the trade mark registered under No. 38604 is the word FERODO and that other components of the device affixed to Exhibit D were mere garnishes and not intended to form part of the trade mark.

PARTICULARS

(a) The presumption at law is that all components of a Trade mark as registered are intended to form part of the trade mark unless disclaimer under Section 15 of the Trade Mark Act.

(b) No disclaimer was shown to have been entered against any of the components of the devise registered as trade Mark No. 38604.

(c) The representation of the trade mark registered as No. 38604 is not the word FERODO alone but the devise affixed to Exhibit D.

(iii) The learned Justice of appeal erred in law in concluding that in so far as red cardboard was easily available in the market, the plaintiffs appellants do not have an exclusive right to use red cardboard in the marketing of their products.

PARTICULARS

(a) The learned justices of appeal failed to give consideration to the manner in which red colour was used in combination with other colours and shapes in trade mark No. 38604 in comparison to the man-

ner in which red colour was used in Combination with other colour and shapes in design of the packaging of the defendant/Respondent's product.

B (b) A registered trade mark made up of several elements, can comprise of elements individually common to the Trade, yet be distinctive as a composite unit such as the proprietor thereof will be entitled to the exclusive use of all those individual elements in the manner in which they have been used in the trade mark.

C (c) The use by any person other than the proprietor of the Trade mark of elements contained in a registered trade Mark in a combination which is so similar to the combination in which those elements have been used in the registered trade mark as to be likely to deceive or cause confusion in the course of trade is an infringement of the trade mark.

D (vi) The learned Justices of Appeal erred in law in accepting the finding of Exhibit L to the effect that, brake pads and brake linings are normally purchased only by mechanics and spare part traders when there was no pleading to those facts in the Statement of Defence.

E PARTICULARS

(a) The question as to who the mark complained of is likely to deceive, is a material fact, and should be pleaded, unless it is the general public that is likely to be deceived.

F (b) Case law requires that opposing party to be put on Notice of the results of opinion surveys before they could be relied on.

(c) There was no pleading in the statement of defence suggesting that the product to which the contending marks are applied are purchased by a restricted class other than the general public.

G (vii) The learned Justice of Appeal erred in law in placing reliance on Exhibit L in order to decide that the Defendant/Appellant's package design is not likely to deceive, in comparison to the 1st plaintiff/appellant's trade mark No. 38604.

H PARTICULARS

(a) For the purpose of comparing one trade mark to the other the appropriate point of view to be adopted by the court in deciding whether the defendant's trade Mark is so similar to the plaintiffs as to be likely to

deceive in the course of trade, is the point of view of a man with an imperfect recollection of the Plaintiff's Trade mark.

(b) Interviews conducted and reported in Exhibit L did not test the likelihood of the interviewees to be deceived on the basis of an imperfect recollection of the 1st Plaintiff/Appellant's trade mark. Rather the opinion of the interviewees were sought based on a side by side comparison. B

(c) A report of the opinion of persons not called as witnesses is hearsay evidence and should not be relied upon as proof of the truth of the assertions made by them."

Now, it is firstly argued in respect of ground one above, that the complaint of the appellant did not directly flow from the decision of the Lower Court. The ground is therefore irrelevant and incompetent. It is also argued that the ground of appeal is a complaint or a question of fact or mixed law and fact and no leave of either the court below or this Court was sought and obtained. It is argued by the learned counsel for the appellant, that the court below decided that despite all the representations contained in Exhibit D, what was registered as a trade mark was only the word FERODO. It was adjudged by the Court below that the appellants are not entitled to have the exclusive monopoly of the other features in the colours red, black, and white as contained in Exhibit D. So, the issue of what was the registered trade mark or whether the other features other than the word FERODO were registered as part of the trade mark or they were in fact so registered so that the appellant might have the monopoly to exclusively use them to market his goods. **I agree with the learned counsel for the appellants that the complaint as contained in first ground of appeal clearly emanated from the decision of the Court of Appeal. I accordingly overrule the first part of the preliminary objection in relation to the first ground of appeal.** C D E F G

The next objection in relation to ground number 1 is that it is a ground complaining on findings of fact or findings on mixed facts and law. In my view, what is called for determination in ground number one has to do with the subject of registration as a trade mark. Was it the word FERODO, alone,? As adjudged by the lower courts? Or was it the entire representation as shown in Exhibit D? It is, in my view, a matter of law H

whether the components of the device as contained in Exhibit D are also registered or are registerable under the Act, Or are they common to the trade of brake linings and brake pads. Or are they only decorative ornaments and not being crucial and essential as to amount to or be part of trade mark. **In my view, no matter what angle you examine it, the first ground of appeal is a ground of law: The preliminary objection in respect of the ground one is accordingly not make out and is overruled by me. In my view the second ground of appeal is also complaining on the decision of the lower court on what was the registered trade mark. It is almost the same is the first ground, though differently and more clearly drafted. I also overrule the objection against the second ground of appeal.**

But grounds No. 3, 4, and 6 are clearly complaints on questions of facts or at best questions of mixed law and facts. No leave of the court below nor of this court has been sought to argue the grounds of appeal. I rule that they are incompetent and are also struck out by me. Thus since grounds 3,4,5,6,7, and 8 are incompetent and the issues premised upon these grounds are also incompetent and must also be struck out. Therefore issues 3,4,5 and 6 are not relevant to the decision in this appeal and are struck out.

Thus the only valid issues remaining for the determination of this appeal are issues number one and two which read as follows:-

"1. Whether the Court of Appeal should at all have looked into the registerability or the entitlement of the plaintiffs/appellants to exclusive use of the individual components of the trade mark registered under No. 38604?"

2. If the Court of Appeal was right to have looked into the registerability of any component of trade mark No. 38604, whether the court was right in deciding That only FERODO was registered under trade mark No. 38604."

H ISSUES 1 AND 2.

Now the learned counsel for the appellants argued issues 1 and 2 together. These are concerned with the decision of the court below that the trade mark registered by the 1st appellant No. 38604 was only the

word FERODO and as such the appellants have no right to the exclusive use of the other components as contained in Exhibit D. That is to say that the appellants have monopoly to the exclusive use of the design of the packaging in which they market the FERODO brake linings and brake pads. It is submitted that if the decision of the Court below is correct, any person can apply to the Registrar of Trade Marks under Section 38(1) of the TRADE MARKS ACT cap 436 LAWS OF THE FEDERATION OF NIGERIA (1990) and demand that the trade mark register be rectified by the removal or amendment of the entry under No. 38604 to reflect the decision that what was registered was only FERODO. It is further submitted that the decision of the trial court and the Court of Appeal went further than the issue of whether the appellants' trade mark was infringed, it also devalued the trade mark of the appellants. That the decision is clearly contrary to Section 5 of the Trade Marks Act cap 436, Laws of the federation of Nigeria, 1990. Learned counsel also referred to Section 9, 15 and Section 11 of the Trade Marks Act. It is submitted further that the implication of the decision of the lower courts is that the appellants' trade mark was invalidly registered which was clearly not the case of the respondent. It is again argued that by virtue of section 49 of the Trade Marks Act, there is a presumption of the legality of the registration of the trade mark and the lower court ought to have reminded itself of this legal presumption. In any event, the respondent never doubted the validity of the appellants' trade mark and did not claim that the trade mark be declared invalid. All what the respondent pleaded in its statement of defence is that the appellants have no exclusive right to use the colours red, black and white for packaging their brake linings.

It is further argued, that it was the entire representation as contained in Exhibit D that was registered and not only the word FERODO appearing therein as adjudged by the lower courts. It is again submitted that the decision in RE CLEMENT ET CIE TRADE MARK (1900) CH. D 114 at 121 or (1899) RPC 611 at 618 was wrongly applied by the lower Court. See also Section 9 and 67 of the Trade Mark Act. It is again argued that in any event, the facts in the RE CLEMENT case above and the instant case are not the same. In conclusion, it is submitted, that the

appellants did not register "FERODO" as their trade mark alone, but all the component parts as contained in Exhibit D were registered and the appellant are entitled to the exclusive use of all of them to market their merchandise.

B The learned counsel for the respondent on the other hand argued that Exhibit D consists of the word "FERODO" written in white against a black back ground with a chequered strip and all in a red back ground. The appellants tried to convince the lower courts that it was not the name "FERODO" alone that constituted trade mark, but the trade mark included the graphic design which is characterized by the chequered strip device. The respondent however argued that the red, black and white colours which feature in Exhibit D are mere embellishments or garnishes which do not form part of the registered trade mark. It is argued that by D Section 9(1)(a) of the Trade Mark Act, the registered mark of the first plaintiff can only be the word "FERODO", Learned Counsel referred to KERLY'S LAW OF TRADE MARKS AND TRADE NAMES 10th Edition page 136 paragraph 8 - 57 where it is stated:-

E *"A mere geometrical outline, such as is commonly used as border for embellishing other marks, will not be accepted as a distinctive mark."*

The respondent, therefore, submits, that the colour outlay with the geometrical outlines of a chequered strip which appear on the background of the representation on which the distinctive word "FERODO" F is set do not constitute a component part of the 1st appellants registered trade mark. In addition, the respondent says that the colour outlay and combination and the geometrical outlines are not a distinctive character of the said mark within the contemplation of Section 9(1) Trade Marks G Act; as they only qualify as embellishments and are merely added for decorative value or flourishes colourably placed on the representation Exhibit D.

The learned counsel for the respondent further argued that an examination of exhibits C, K and K1 and Exhibit D, and bearing in mind that H the appellants mark could only have qualified for registration under section 9(1)(a) of the Trade Marks Act, it becomes clear that only the word FERODO was registered as trade mark No. 38604. Further to above

P.W.2 gave the name of the appellants' brake pads as "FERODO".

Now, the question of what was registered as a trade mark No. 38604 by the first appellant must be answered. **The essence of a trade mark is that it indicates a connection in the course of trade between the goods and some person having the right to use the same.** B
A mark, in this connection includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. A trade mark on the other hand is a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as a proprietor or a registered user to use the mark. C
 An action for infringement will therefore lie where a competitor uses registered trade mark in connection with proprietor's goods for the purpose of comparing them with his own goods in the same class. See BISMAG LTD VS. AMBLINS (CHEMISTS) LTD. (1940) Ch 667. **A trade mark can also be defined as a distinctive picture which would indicate to a purchaser of an article bearing it, the means of getting the same article in future, by getting an article with the same mark on it. A trade mark if registered gives the proprietor the exclusive right to use the trade mark in marketing or selling his goods. And without his consent if any one else uses an identical mark or one mark so nearly resembling it as to be likely to deceive or cause confusion, will entitle the proprietor to sue for infringement of the trade mark, or to sue in action for passing off or both.** D E F

Now, the appellants claim that what was registered as trade mark in the instant case is the entire representation as shown in Exhibit D. Exhibit D contains the word FERODO in the context of a specific graphic design which comprises of the following elements: G

"A large red rectangle, a black and white chequered strip stretching from one side to the other at the lower end of the rectangle. A small black rectangle centrally positioned in the upper half of the red rectangle in which it is inscribed in white capital letters the word FERODO". H

The appellants claim that the lower courts were wrong to have

held it was only the world FERODO that was registered and that the graphic design is not intended to be registered but merely fanciful or ornamental coloration intended merely to decorate. In the case of WOODARD LTD VS. BOULTON MACRO LTD And in THE MATTER OF THE REGISTERED TRADE MARK OF WOODWARD LTD No. 100 (1915) 32 RPC 173 at 196. It was observed thus:-

xxxxxxxxxx The first matter that I have to determine upon that is, what is the trade mark? It has been urged on the part of the defendant that there is no infringement because the trade mark is not that which the plaintiffs allege it to be, the words "GRIPE WATER" but is in fact the words "GRIPE WATER" printed in letters which I have described and the scroll or decoration upon which they are so printed. The answer to that - and I think it is a good answer - is this; that this is in fact a word mark, it was in fact registered as a word mark, and that it is not a case in which I can either say that the mark is the ornamentation with the words added, or that it is a mark made up of a combination of words in common use with an ornamentation. I think that Mr. WALTER'S argument is right, that which ever it was, if it was a good mark, the abstraction from it and the user by others of the words "GRIPE WATER" would constitute on infringement."

Thus the ornamental way in which "GRIPE WATER" was written did not affect or change the basic and essential idea, that the intended trade mark is the name GRIPE WATER. Similarly the idea of the trade mark in the instant case is clearly the word FERODO. This significantly proved to be so, by the witness called by the appellant, who not only swore that the appellants products are identified and sold by their brand name, but also by swearing, that they would not sue the respondent, if it was using the package in Exhibit O was a package in an identical colour outlay with Exhibit C.

There is no doubt that the appellants claim registration of their trade mark under Section 9 of the Trade Marks Act CAP 436 LFN. Section 9 reads:-

"9(1). In Order for a trade mark (other than a certification trade mark) to be registrable in part A of the register it must contain or consist

of at least one of the following essential particulars.

(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business.

B

(c) an invented word or invented words.

(d) a word or words having no direct reference to character or quality of the goods, and not being according to its ordinary signification or geographical name or surname.

(e) any other distinctive mark: Provided that a name, signature or word or words other than such as fall with in paragraphs (a) to (d) of this section except upon evidence of its distinctiveness.

C

(2) For the purposes of this section, "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of the trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered subject to limitation, in relation to use within the extent of the registration.

D

E

(3) In determining whether a trade mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which:-

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

F

(b) by reason of the use of the trade mark or of any other circumstance, the trade mark is in fact adapted to distinguish as aforesaid."

Thus there is no proof or indication whatsoever that the colour outlay and the geometrical outlines as contained in Exhibit D are of any distinctive character so as to constitute device within the contemplation and intendment of Sub-sections 2 and 3 of Section 9 and also of Section 67 of the Trade Mark Act. A look at Exhibit C which is the package in which the appellants market FERODO brake linings, Exhibit K-K1 which are photographs of the appellants' billboards advertising brake pads found in different locations in Lagos make it obvious that it was only the word FERODO that was regis-

G

H

tered under Section 9(1)(a) of the Act. This fact, is further borne out, by the evidence of P.W.2 and other witnesses that the appellants' brake pad is known as FERODO and that customers purchase the product by asking for it by its brand name.

B In deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like. See LEVER BROS. LTD. VS. SUNNIVTE PRODUCTS LTD. (1949) 66 R.P.C. 84. Evidence is admissible to show which of the features as shown in the register i.e Exhibit D in this case are essential and which are inessential so as to be unimportant in deciding questions of infringement. See DE CORDOVO VS. VICK (1951) 68 R.P.C. 103. It is therefore clear that it is not all the features that are contained in Exhibit D, that are important for the purposes of the infringement of the trade mark. Not all the components are to be considered as forming part of the trade mark. The resemblance giving rise to infringement must lie in the basic idea of the mark, in this case "FERODO". It is the basic idea of the trade mark as evidenced by the advertisement in the bill boards and the evidence of witnesses at the trial who called the product simply "FERODO." In my view the graphic design and the colouration as contained in Exhibit D are incapable of distinguishing the brake linings or brake pads of one undertaking from or the appellants' undertaking. See JERL LYNN TRADE MARK 1999 FSR 491, BACHAND BACH FLOWER REMEDIES TRADE MARKS (2000) RPC 513.

G In the case of BLACKWELL VS. CRABB (1867) 36 Ch. Crabb's pickles on a label resembling the label of the plaintiff was held not to be an infringement of the plaintiffs trade mark because the name of the manufacturer is on the label and under a situation when the customers would rely on the name of the manufacturer when purchasing the pickles. See also THE COCA-COLA CO. OF CANADA LTD. VS. PEPSI COLA CO. OF CANADA LTD. (1942) RPC Vol. 59, 127. In any event, the respondent in the instant case denied ever using Exhibit F in marketing its products. The respondent gave credible evidence accepted by the

learned trial judge that they market their products by using Exhibit O and for which the appellants through the P.W.2 asserted that if the defendants were using Exhibit O to market their products, they would not have instituted the action in the first place. The learned trial judge said in of his judgment thus:-

"I accept as correct the evidence on behalf of the defendant that purchasers of brake linings and pads identify their brand names rather than by the packaging. xxxxxxxxxxxxxxxx Having regard to Exhibit D by which the plaintiffs registered their trade "FERODO" without more, I accept the evidence of the defendant that the only mark the plaintiffs can claim distinctiveness on is the mark "FERODO" and not the red, black and white packaging which is common to the trade and which is freely used by other manufacturers as shown in evidence. xxxxxxxxxxxxxxxx"

The decision of the lower court is consistent and concurrent with the decision of the trial court. These are findings of fact based on the evidence adduced and accepted. It is elementary law, that an appellate court such as the Supreme Court will hardly reverse a concurrent finding of facts. I am also convinced that what is registered as a trade mark is only the word " FERODO". It is a distinct character marked sharply and boldly in Exhibit D denoting that it represents the futuristic character by which the proprietor manufacturer intended to convey a message that the product is hers and no other person's. As mentioned above, there is nothing distinctive about the colouration and the graphic chequered design to make them part of the registered trade mark. Also as earlier mentioned when a word is used to denote a product and when the other features contained are not distinctive, they are merely decorative of the trade mark and not part of it.

In any event, I also agree that the packaging design in colours of red, black and chequered white graphics are common in the trade of brake pads and linings as clearly shown and evidenced in exhibits O, C, N and M. All these exhibits show how various packages of various manufacturers of brake linings market their products in same colours. In summary, I agree with the courts below, that the only mark registered for the first appellant is the word

"FERODO" and the colouring out lay and the geometric designs are merely decorative and do not form part of the trade mark.

P.W.2 said in part of his evidence:-

" I agree our name was written on Exhibit C together with the
 B chequered strip to make a package. I agree our company does not have a
 monopoly of red cardboard paper, but we have a monopoly of our design.
 xxxxxxxx I agree FERODO is the name of our product written boldly on
 Exhibit C. I agree I identified Exhibit H by calling it EDISON. I also
 C identified another one CHIEME, I also know LUCKY brake lining
 xxxxxxxx I agree all these brake linings are KNOWN IN THE MARKETS
 BY THEIR NAMES (Emphasis supplied) I agree any one going to the
 market to buy out brake lining will call for FERODO brake lining or
 pad. xxxxxxxx I agree that the names UNION and FERODO do not sound
 D alike. I also agree the names do not look alike."

I have reproduced the evidence of P.W.2, the star witness of the
 appellants to show that on his own evidence, the appellants cannot lay
 claim exclusively to red cardboard used in packaging, and also to show
 E that the crucial and predominant mark registered and relied upon the
 appellants for the trading of their brand of brake linings and pads is the
 word FERODO alone.

Following the provisions of Section 5(2) of the Trade Mark
 F **Act an infringement of a registered trade mark cannot be main-**
tained unless the court finds that the defendant is engaged in the
use of a mark identical with the registered trade mark or uses a
mark so nearly resembling the registered trade mark, as to be
 G **likely to deceive or cause confusion in the course of trade; or uses**
in relation to any goods in respect of which it is registered, or uses
in such a manner as to render the use of the mark to be taken as
importing a reference to the goods which the plaintiff's trade mark
is connected. None of these circumstances apply in this matter. The
 H **registered Trade Mark in this cause it the word FERODO and the**
word UNION or UNION SUPA is incapable of infringing FERODO.
And, in any event, the appellants have not established that the
respondent used, the get up or the packaging in Exhibit E or F to

market their products.

Issues I and 2 are clearly resolved against the appellants. For the reasons of incompetency as stated above, the other issues were already struck out by me. In the result, this appeal fails and is dismissed by me. I affirm the decision of the court below. The respondent is entitled to costs which I assess at N10,000.00. B

BELGORE JSC

I read in advance the judgment of my learned brother, Musdapher JSC and I agree that this appeal has no merit. For the reasons fully set out in the judgment, I also dismiss the appeal and make the same order as to costs. C

MOHAMMED JSC

I have had a preview of the judgment written by my learned brother, Musdapher, JSC, in draft, and I agree with him that the appeal ought to fail. I have nothing more which I can usefully add. The appeal is against concurrent findings of two lower courts and the appellants have not advanced any convincing argument for me to disturb such decisions. I affirm the decision of the court below and dismiss the appeal. I also award N10,000.00 costs in favour of the respondent. D F

ONU JSC

I was privileged to read before now the judgment of my learned brother Dahiru Musdapher, JSC just read. G

I am in entire agreement with him that the decisions of the two courts below constitute concurrent findings of fact with which this Court is slow to disturb. In the resolution of the two issues (issues 1 and 2) H which were the only two issues that availed the Appellants in the argument of the appeal herein, they were unable to show why this court should interfere with the conclusions arrived at by the two courts below

on the principles decided in numerous cases such as Abdullahi v. The State (1985) 1 NWLR 523 at 528; Fashanu v. Adekoya. (1974) 1 All NLR 35 at 41; Akpagbue v. Ogu & Ors. (1976) 6 SC. 63 and Ebba v. Ogodo (1984) 4 SC. 84 at 98, to mention but a few. Such a decision ought not to be set aside or interfered with unless shown to be perverse or the findings of fact are not supported by the evidence or where the judgment is unreasonable. The same has not been shown in this case.

In consequence, I too dismiss the appeal and abide by the consequential orders made in the lead judgment inclusive of the costs as assessed.

TOBI JSC

This appeal has to do with the law of trade marks. The law in Nigeria is rare and not commonplace in terms of case law unlike the law of contract and other areas of business law. The number of cases so far decided can be counted by the fingers. There is however a comprehensive statute. It is the Trade Marks Act, Cap. 436, Laws of the Federation of Nigeria, 1990.

The dispute has arisen in respect of two trade marks. One is FERODO. The other is UNION. The plaintiffs/appellants are the owners of FERODO. The defendant/respondent is the owner of UNION. The dispute has arisen, from the point of view of the plaintiffs/appellants, not necessarily on the trade words of FERODO and UNION, but on the total packages in terms of marks, colours and colorations. Both FERODO and UNION would seem to share common colours of red, black and white in their packagings. Although the peoples of the world are entitled to freely use these three of God's rainbow colours, the law of trade marks thinks differently. It dares God by placing restrictions here and there. And that has caused the problem in this appeal.

The case of the plaintiffs/appellants is that the design of the FERODO box had been registered as a trade mark under No. 38604 and that the 1st plaintiff/appellant, an English Company, is the registered proprietor thereof. The plaintiffs/appellants are manufacturers and sellers of

the FERODO brand of brake linings for motor vehicles. They sell their product in cardboard packages. The FERODO brake pads and linings have been in the Nigerian market for at least 10 years before the institution of the suit. The plaintiffs/appellants claimed that the package in which the defendant/respondent markets its UNION brake linings is so similar to the package in which they market their own FERODO brake linings that it constitutes an infringement of the 1st plaintiff/appellant's trade mark No. 38604 and amounts to passing-off. B

The defendant/respondent did not agree with the above version. It is the case of the defendant/respondent that the plaintiffs/appellants have no exclusive right to the use of the colours red, black and white for packaging of their brake pads, or that red cardboard paper are commonly used in Nigeria for packages and that red cardboard paper had not become distinctive of plaintiffs/appellants goods. C D

The learned trial Judge had evidence. He dismissed the claim of the plaintiffs/appellants. He gave judgment to the defendant/respondent. He said:

"The Plaintiff failed to call relevant evidence in support of its claim to distinction. I do not believe the evidence of PW2 that the distinguishing features of the Plaintiffs' goods are the packaging which has red, black colours with chequered strip. Exhibit K1 which is the advertisement poster made by or for the Plaintiff does not contain the said features. What was prominent as a feature in Exhibit K1 is the mark 'FERODO'." E F

Dissatisfied, the plaintiffs/appellants went to the Court of Appeal. That court dismissed their appeal. Delivering the leading judgment, Pats Acholonu, JCA (as he then was) said: G

"A careful and analytical consideration of the Registered Trade Mark of the Appellants impresses me that in actuality what was registered was FERODO... It cannot be taken that those fanciful and ornamental characters which colour the faces of the package form part of the trade mark... In my opinion what was registered was 'FERODO'... In my view the Respondent has not done anything that can be said to have infringed on the Trade Marks of the Appellants. The two trade marks are away H

from each other in character and design."

Again dissatisfied, the plaintiffs/appellants have come to this court. Briefs were filed and exchanged. The plaintiffs/appellants filed a reply brief. The following issues were formulated by the plaintiffs/appellants B for the determination of the appeal:

"1. *Whether the Court of Appeal should at all, have looked into the registrability or the entitlement of the plaintiffs/appellants to the exclusive use of individual components of the trade mark registered under No. 38604?*" C

2. *If the Court of Appeal was right to have looked into the registrability of any component of trade mark No. 38604, whether the court was right in deciding that only the word 'FERODO' was registered under trade mark No. 38604?*

D 3. *Whether the fact that red cardboard was easily in the market disentitles the plaintiffs/appellants from the exclusive use of a predominantly red packaging for the marketing of their brake lining?*

4. *Whether the defendant/respondent marketed its brake lining in Exhibit F?*

5. *Whether exhibit L can be relied upon in proof of the assertions that it is only mechanics and spare parts dealers that purchase brake linings and that the packaging of the defendant/respondent's Union brake lining is not confusingly similar to the packaging of the plaintiffs/appellants Ferodo brake lining?* F

6. *If the answer to issue No. 4 is in the affirmative whether exhibit F constitutes an infringement of trade mark No. 38604."*

The defendant/respondent has formulated the following issues for G the determination of this appeal:

"2.1 *Whether the Court of Appeal in dismissing the appeal, was right in holding that the 1st Plaintiff's registered trade mark was the word mark, 'FERODO'?*"

H 2.2 *Whether the Court of Appeal in dismissing the Appeal, was right in holding that the Defendant did not infringe the 1st Plaintiff's registered trade mark?"*

Learned counsel for the appellants, Mr. Obatosin Ogunkeye sub-

mitted on Issues Nos. 1 and 2 that the decision of the Court of Appeal went beyond the adjudication of the question whether the defendant/respondent infringed the registered trade mark of the 1st plaintiff/appellant. Even if this court comes to the conclusion that the respondent did not use Exhibit F or for some other reason does not agree that Exhibit F infringes the trade mark of the appellants, this court should nevertheless proceed to make a declaration as prayed under paragraph 3(a) of the Amended Notice of Appeal, learned counsel urged.

Relying on sections 5,9,11,15 and 49 of the Trade Marks Act, 1990 learned counsel submitted that the presumption of validity of a trade mark can only be called into question upon a specific pleading to that effect. The question that then arises is whether the respondent ever challenged the validity of the registration of the trade mark No. 38604, as to justify the court making a decision which amounts to a declaration of invalidity of the trade mark. To challenge the validity of the registration of the 1st appellant's trade mark, the respondent ought to have counter-claimed for a declaration that the trade mark be declared as invalid. Without a counterclaim, the court ought not to have pronounced on the validity of the trade mark, learned counsel argued. To learned counsel, denying the exclusive right of the appellants to the unqualified use of the colours of red, black, and white is not the same thing as denying the validity of trade mark, No. 38604.

It was the submission of learned counsel that where a trade mark comprises of more than one component, the right of exclusive use granted to the proprietor under section 5 of the Trade Marks Act as relates to the various components of the mark is the right to use those components in the manner in which the components were used in the trade mark. To enable the plaintiff succeed in a claim for passing off, based on the allegation that the defendant has imitated or copied the get-up of his products, the plaintiff must prove that the get-up which he claims the defendant has imitated has become distinctive of his goods exclusively in the eyes of the purchasing public, learned counsel said. He cited Kerly's Law of Trade Marks and Trade Names, 12th Edition, paragraphs 16-29 at page 357 by Christopher Wadlow. Learned counsel contended that dis-

tinctiveness is usually acquired after long or extensive use. He relied on paragraphs 4, 5, 7, 8, and 9 of the 2nd further Amended Statement of Claim on allegations of fact to prove distinctiveness. Counsel contended that the Court of Appeal was wrong in relying on in Re Clement et cie B Trade Mark (1900) Ch. D. 114 at 121; (1899) RPC 611 AT 618 because the facts of that case are different and that the passage quoted was an *obiter dictum*.

Learned counsel finally submitted on Issues Nos. 1 and 2 that it is not only the word "FERODO" that was registered or intended to be registered under trade mark No. 38604 but all the components of the trade mark were intended to be included and were included in the registration of the trade mark.

Dealing with Issue No. 3, learned counsel argued that when a composite trade mark, such as trade mark No. 38604 is registered, the exclusive right to use the mark granted to the proprietor under section 5 of the Trade Marks Act is not a right to use individual components of the mark independently of each other. The exclusive right, counsel argued, is to use all the components of the trade mark together as registered. Therefore, in suing for the infringement of trade mark No. 38604 the appellants were not contending that the respondent infringed the trade mark simply because the packaging used by the respondent in the marketing of their goods was red, rather their contention was that the respondent had used the combination of red, black and white on the packaging of their product in a way which resembles the way in which those colours have been used in the registered trade mark, and that such use made by the respondent is likely to deceive or cause confusion, counsel reasoned.

As to the registrability of a matter which is common to the trade, learned counsel referred to Kerly's Law of Trade Marks and Names where the learned authors stated that it is possible for a combination of devices which are individually common to the trade to form a new and distinctive device which will be registrable. He cited Diamond T. Motor Company's Appn. (1921) 38 PRC 373; Hudson's Trade Mark (1886) 3 RPC 155 and Arthur Fairest LTD.'s Appn. (1951) 68 RPC 197.

Counsel finally submitted on Issue No. 3 that even if the colour

red was common to the trade of brake lining, it was registrable and was validly registered as a component of trade mark No. 38604, and that by virtue of the registration, the 1st appellant was entitled to the exclusive use, in connection with brake linings of any package design which so resembles the representation of trade mark No. 38604 as to be likely to B deceive.

Taking Issue No. 4, learned counsel submitted that whether the respondent marked its product in Exhibit F or not, is central to the claim before the court and must be determined one way or the other. Counsel argued that although the respondent denied using Exhibit F, this court can evaluate the evidence and the issues before it at making findings of fact where the lower courts have declined to make findings. He cited Adegbite v. Ogunfaolu (1990) 4 NWLR (Pt. 146) 578; Obiekezie v. Nkwe (1972) 7 NSCC 109; Oniah v. Onyia (1989) 1 NWLR (Pt. 99) 514; Faloju v. Amosu (1983) 14 NSCC 456 at 411; Olawuyi v. Adeyemi (1990) 4 NWLR (Pt. 147) 746 and Fashanu v. Adekoya (1974) 9 NSCC 327 at 331. C D

It was the submission of learned counsel that the allegation that the appellants fabricated Exhibits E and F in order to destroy the business of the respondent is less probable than the allegation that the respondent was marketing its Union brake lining in Exhibit F. He referred to the available evidence in paragraph 5.3.9, pages 19 to 22 of the appellants brief and submitted that the balance of probabilities point to the conclusion that as at the inception of this suit, and the initial stage of the preparation of the defence, the package tendered as Exhibit O was not the subject of the preparation of the defence. E F

On Issue No. 5, learned counsel pointed out that although the Court of Appeal initially stated that the two interviews conducted by PW 1 and DW2 are not helpful and are to some extent unreliable, the court proceeded in its conclusion to rely on the conclusion of Exhibit L that it is only mechanics that purchase brake linings, and held that in so far as mechanics who mostly buy the product are not deceived the trade mark of the 1st appellant had not been infringed. He maintained that the statement of defence did not plead the fact that only mechanics and spare G H

parts dealers buy brake linings.

Still on Exhibit L, learned counsel submitted that since the evidence that the packaging of the Union brake lining is not confusingly similar to the package of FERODO brake lining does not qualify as an expert opinion under section 77(d)(i) of the Evidence Act. What was said amount to hearsay. Apart from the objection to admissibility of Exhibit L, learned counsel submitted that the methodology of the survey reported in the exhibit is in total violation of the criteria set down by the courts regarding the basis on which confusing similarity between two contending marks should be assessed. The courts have held that for the purpose of deciding whether an offending trade mark is so similar to the plaintiff's trade mark as to be likely to deceive or cause confusion in the course of trade, the court must adopt the point of view of an incautious purchaser who has an imperfect recollection of the plaintiff's trade mark and on that basis view the offending trade mark as to be likely to deceive or cause confusion in the course of trade, learned counsel contended. He cited Alban Pharmacy Limited v. Sterling Products International Incorporated (1969) NCLR 151 at 155 and 156; Paterson Zochonis and Company Ltd. v. A.B. Chami and Company Ltd. (1971) 2 NCLR 376.

Learned counsel submitted in conclusion on Issue No. 5 that the opinion of a witness as to the likelihood of deception is of little relevance in a trade mark infringement action. To counsel, the Judge will rely on his own opinion based on the evidence before him and not on the opinion of any witness as to the matter. He cited Harker v. Stagg (1954) 71 RPC 136 at 140; London General Omnibus Co. v. Lavell (1901) 1 Ch. 135; North Cheshire Brewery v. Manchester Brewery (1899) AC 83 and Bali (1969) RPC 472 at 497 and "GE" (1973) RPC 297 at 321 and 322. Brake linings, counsel submitted, are sold to the general public.

It was the submission of learned counsel that if the court holds that the respondent used Exhibit F in the marketing of its brake lining, the denial by the respondent that it used the packaging is an implied admission that Exhibit F is so similar to trade mark No. 38604 as to be likely to deceive or cause confusion in the course of trade. Counsel went further and argued that even if this court does not deem the denial of the use of

Exhibit F as an admission of liability for infringement of trade mark, the appellants have made out a case of infringement of trade mark against the respondent.

Counsel dealt with registration in Parts A and B of the Act and submitted that in practical terms there is no substantial difference between what constitutes an infringement of a Part A registration and constitutes an infringement of a Part B registration. Counsel however sees a difference that despite the occurrence of an infringement a proprietor of a Part B registration will not be entitled to any relief under certain circumstances. The onus of proving that the conditions exist in any particular case under which the proprietor of a Part B registration will not be entitled to the normal relief for infringement, lies on the defendant. Since the respondent did not raise any issue in respect of the above, this court need not deal with it, counsel said.

It was the submission of learned counsel that the evidence presented by the appellants in support of their contention that the use of Exhibit F in the marketing of brake lining will likely cause deception or confusion in relation to the use of the 1st appellant of its registered trade mark was the testimony of PW1 and Exhibit A. Counsel gave seven reasons why this court should rely on Exhibit A. He cited Alban Pharmacy Limited v. Sterling Products International Incorporated (supra); Paterson Zochonis and Company Ltd. v. A. B. Chami and Company Ltd. (supra) and Kerly's Law of Trade Marks and Trade Names, 12th Edition, page 537, paragraph 17.06.

Apart from the probative value of Exhibit A, a further support for the conclusion that Exhibit F so resembles trade mark No. 38604 that it is likely to deceive or cause confusion is the fact that the respondent set out to deliberately imitate the appellants trade mark, and thus intended to deceive, counsel argued. He cited Boulnois v. Peake (1868)13 Ch. D 521; Sanitas v. Condy (1886) 4 RPCPC 195 at 530 and "Camel Hair Belting" case (1896) 13 RPC 218 at 233. Citing Slazenger v. Feltham (1889) 6 H RPC 531 at 538, learned counsel submitted that where intention to deceive is established, the onus on the plaintiff to prove likelihood of deception is much lighter. He urged the court to hold that the respondent has

succeeded in its intention, and that Exhibit F so nearly resembles trade mark No. 38604 as to be likely to deceive or cause confusion in the course of trade.

B Learned counsel for the respondent, Mr. O. Opasanya raised preliminary objection that there are no valid grounds of appeal before the court. He submitted that Ground 1 does not flow from the decision of the Court of Appeal as the court did not at any point in the judgment enquire into the plaintiff's entitlement to the exclusive use of certain components of the representation of the trade mark under consideration. He submitted C further that Ground 1, though couched as an error of law, is indeed a ground of fact or at the very best a ground of mixed law and fact. He referred to one of the particulars and relied on section 233(3) of the Constitution.

D Learned counsel submitted that Grounds 2 and 3 are grounds of mixed law and fact. He urged the court to strike out Grounds 1, 2 and 3 on ground of incompetence.

E Learned counsel submitted that Ground 4 and 5 are *obiter dicta*, being opinions of the Judge which do not embody the resolution of the court. Relying on Coker v. UBA (1997) 2 NWLR (Pt. 490) 641 at 658, learned counsel submitted that an appeal is usually against a ratio and not normally against an *obiter* except in case where the *obiter* is so clearly F linked with the ratio as to be deemed to have radically influenced the latter. Accordingly, counsel submitted that the grounds are a challenge to an *obiter dictum* and as such do not constitute competent grounds of appeal and should be struck out. He submitted in the alternative that both grounds are grounds of fact or at best mixed law and fact when taken G together with their respective particulars. He urged the court to strike them out for being incompetent.

H It was the submission of learned counsel that Ground 6, being a complaint against Exhibit 7, an admissible evidence, is a question of fact for the assessment of the court, and should be struck out. Counsel submitted that Grounds 7 and 8 cannot truly arise from the Court of Appeal decision as that court was not really concerned with admission, relevance, weight, assessment or credibility of evidence; rather the court narrowed

down its compass to two points of law *videlicet*: (a) what was the trade mark registered as a matter of law and (b) was the trade mark infringed as a matter of law? Relying on Finnih v. Imade (1992) 1 NWLR (Pt. 219) 511 at 542-543, learned counsel contended that the two grounds cannot hold as omnibus grounds. He also submitted that the two grounds com- B
plained that certain decisions of the Court of Appeal are against the weight of evidence, which affect issues of fact. He cited Ogbechie v. Onochie (1986) 2 NWLR (Pt. 23) 484 at 493 and section 233(2) of the Constitution. He urged the court to dismiss the appeal as there are no valid grounds C
of appeal.

Learned counsel dealt with the appeal in the alternative, that is, if this court holds that the preliminary objection lacks merit. Counsel submitted on Issue No. 1 that the red, black and white colours which feature on Exhibit D are mere embellishments or garnishes which do not D
form part of the registered trade mark. Since it is common ground that the basis of the registration of the 1st appellant's trade mark was section 9(1) of the Trade Marks Act, Cap. 436, Law of the Federation of Nigeria, 1990, the registered mark of the 1st appellant can then only be the E
word "FERODO" stated therein. He cited Kerly's Law of Trade Marks and Trade Names, 10th Edition, paragraph 8-57, page 136 and section 9(1) of the Trade Marks Act.

Assuming, without conceding, that the colour outlay and geometrical outlines are of a distinctive character such as to constitute a device F
within the contemplation of section 67 of the Trade Marks Act, the appellants would still not be entitled to assert a right to the exclusive use of it as their registered trade mark because there is no evidence before the G
court to the effect that the chequered device was also registered, learned counsel argued. He cited Exhibits C, K, K1, Smith Kline and French Laboratories Ltd. v. Sterling-Winthrop Ltd. (1975) 2 All ER 578 at 582; Re Clement and Cie's Trade Mark (1900) Ch. 114 at 120 and section 9(1)(a) of the Trade Mark Act. He also referred to the evidence of PW2. H

In the event that this court resolves Issue No. 1 against the respondent, learned counsel submitted in the alternative in Issue No. 2 that this court cannot set aside concurrent findings of the two lower courts,

unless such findings are perverse. Following the provisions of section 5(2) of the trade Marks Act, 1990, an action for infringement of a registered trade mark cannot succeed unless the court finds that the defendant is engaged in the use of a mark identical with the registered trade mark or uses a mark so nearly resembling the registered mark as to be likely to deceive or cause confusion in the course of trade; in relation to any goods in respect of which it is registered; and in such a manner as to render the use of the mark to be taken as importing a reference to goods, which the plaintiff's trade mark is connected, counsel said.

It was the submission of learned counsel that the appellants failed completely, on the facts and evidence produced before the court, to discharge the burden. The true test of resemblance is whether the totality of the impression given both orally and visually is such that it is likely to cause mistake, deception or confusion, learned counsel contended. He cited Re Egg Products Ltd.'s Application (1922) 39 RPC 155 at 166; Country Chemical CO. Ltd. v. Application (1937) 54 ROC 182 at 185; Savule Perfumery Ltd. v Jane Perfect and F. W. Wordworth and Co. Ltd. (1941) 58 RPC 147 at 161 and Halsbury's Laws of England, 4th Edition, Vol. 48, page 14 paragraph 137.

In determining whether there has been an infringement of a trade mark, there is dire need for both the ears and the eyes to be involved in the exercise of comparison of the trade mark, counsel submitted. He cited Alban Pharmacy Ltd. v. Sterling Products International Inc. (1968) All NLR 292 at 295-296; Beecham Group Limited v Essdee Food Products Ltd. (1985) 3 NWLR (Pt. 11) 112 at 118; Coca-Cola Company of Canada Limited v. Pepsi Cola Company of Canada Limited (1942) 1 All ER 615. To learned counsel, the result in the case at hand could however be different where the mark of the respondent is "Ferido" "Fedoro", "Forodo", "Farudo" or "Faredo". He urged the court to dismiss the appeal.

Learned counsel for the appellants in his reply brief conceded that Grounds 5, 7 and 8 are either grounds of fact or mixed law and fact. He however submitted that Grounds 1,2,3, 4 and 6 are not grounds of fact but grounds of law. Counsel also submitted that the Ground 4 is not

based on an *obiter dictum*.

On the merits of the respondent's brief, learned counsel submitted that in view of the provisions of section 16(1), it is erroneous for the respondent to conclude that the colour combination in which the representation of a trade mark. Counsel pointed out that the combination of B colours and shapes constituting the representation of the marks, affixed to Exhibit D have not been used, merely as a border and are not geometrical outlines normally used as borders for other trade marks. In determining the question, "what has been registered", the answer should be obtained by reference to what is in the register of trade marks, counsel C contended. He relied on Exhibit D.

It was the submission of learned counsel that if the proprietor of the trade mark chooses to use only one element of a trade mark comprising of several elements, without the other elements, that should not D invalidate his right to the exclusive use of his trade mark as registered, rather it is in respect of the use of the single element of the trade mark that he would not have the protection of the law. Therefore, the fact that the appellants chose to use only the word FERODO and the chequered E strip in advertisement as shown in Exhibits K and K1 should not affect the fact that the representation as shown on Exhibit D is the 1st appellant's registered trade mark and not just the word FERODO. He cited In the Matter of Application by W and G Du Cros Ltd. For Registration of F Trade Marks (1913) 30 RPC at 672. He contended that a colourful graphic or geometrical design without any name or word being combined with it, can be distinctive as to quality of registration.

On the issue of the findings of the courts below, learned counsel G submitted that the decision of the Court of Appeal that 1st appellant's registered trade mark is the word FERODO is not a finding of fact but a decision of law. Accordingly, there is no concurrent findings of fact by the two courts as submitted by counsel for the respondent, learned counsel argued. He cited In GE Trade mark (1973) RPC 297 at 324-327 on the H history of trade mark legislation in England. Making a distinction between infringement of trade mark and passing-off, learned counsel referred to Kerly's Law of Trade Marks and Trade Names, 12th Edition, in

paragraph 6-10. He urged the court to allow the appeal.

I take the preliminary objection. As the appellants do not contest the objection in respect of Grounds 5, 7 and 8, (and I agree with counsel) I hold that the grounds are incompetent and are hereby struck out. I should therefore proceed to examine Grounds 1, 2, 3, 4 and 6 *seriatim*. Ground 1 reads:

"The learned Justices of Appeal erred in law in enquiring into the entitlement of the 1st plaintiff/appellant to the exclusive use of certain components of the representation of the trade mark registered under No. 38604."

I do not agree with learned counsel for the respondent that the ground does not flow from the decision of the Court of Appeal. I entirely agree with learned counsel for the appellants that the ground flows from the judgment of the Court of Appeal, when Pats-Acholonu, JCA (as he then was), said at page 327 of the Record:

"In my opinion what was registered was FERODO whatever it means. I tend to agree with DW2 evidence that the Appellants do not have the monopoly exclusively, over red cardboard paper easily available in the market."

In the light of the above, the first leg of objection fails.

The second leg of objection is that the ground is one of fact or one of mixed law and fact. With respect, I do not agree with learned counsel for the respondent. I have examined the ground of appeal and the particulars and I agree with learned counsel for the appellants that the ground is one of strict law as it involves the construction of the Trade Marks Act, 1990 in respect of Trade Mark registered as No. 38604.

The second ground of appeal is in the following terms:

"The learned Justices of Appeal erred in law in holding that the trade mark registered under No. 38604 is the word FERODO and that other components of the device affixed to Exhibit D were mere garnishes and not intended to form part of the trade mark."

Ground 2 has three particulars. Particulars (a) and (b) talk of disclaimer. I am of the view that disclaimer under section 15 of the Trade Marks Act is an issue of law. I therefore hold that ground 2 is an issue of

law.

Although Ground 3 is couched as a ground of law, particular (a) is a question of fact. The particular is in the following terms:

"The learned Justices of Appeal failed to give consideration to the manner in which red colour was used in combination with other colours and shapes in trade mark No. 38604 in comparison to the manner in which red colour was used in combination with other colours and shapes in the design of the packaging of the Defendant/Respondent's product." B

The word "manner" which is used twice in the particular, means a way of acting or proceeding, a method of artistic execution, a social conduct or behaviour. The word also means kind or sort. In whichever way one looks at the words, it clearly carries the element of fact or a factual situation in the above particular. The moment a court is required to consider the way the red colour was used in combination with other colours and shapes, it boils down to a factual exercise. I therefore hold that Ground 3 is a ground of mixed law and fact. D

Ground 4 is in the following terms:

"The learned Justices of Appeal erred in law in accepting the finding of Exhibit L to the effect that, brake pads and brake linings are normally purchased only by mechanics and spare part traders when there was no pleading to those facts in statement of defence." E

Although the issue of pleadings is an issue of law, the ground as couched is to me more of an issue of fact than one of law. And the issue to me, is the contention that *"brake pads and brake linings are normally purchased only by mechanics and spare part traders"*. This cannot be an issue of law. F

And that takes me to Ground 6 which reads: G

"The learned Justices of Appeal erred in law in placing reliance on Exhibit L in order to decide that the Defendant/Appellant's package design is not to deceive, in comparison to the 1st Plaintiffs/Appellant's trade mark No. 38604." H

This appears to me to be a straight ground of fact. Exhibit L is the survey report tendered by the respondent to prove that *"the packaging used by the respondent in marketing of its brake lining product was not*

confusingly similar to that used by the plaintiff to market their FERODO brake linings" (see page 21 of appellants brief). Since the contents of Exhibit L are issues of fact, Ground 6 is a question of fact, particularly when it uses the word "comparison". When two things are compared, both the exercise and the result are questions of fact.

In the light of the foregoing analysis, it is my view that only Grounds 1 and 2 qualify as a ground of law. Grounds 3, 4 and 6 are either grounds of fact or grounds of mixed law and fact, and the appellants ought to have sought leave of court before filling them. As leave was not sought and granted. The grounds, that is Grounds 3,4 and 6 are hereby struck out. See Onifade v. Olayiwola (1990) 7 NWLR (Pt. 161) 130. Where grounds of appeal are struck out, arguments canvassed in support of the grounds in the brief of argument become irrelevant. See Lt. Col. Finnih v. Imade (1992) 1 NWLR (Pt. 219) 511.

By the combined effect of sections 136 and 137 of the Evidence Act, the burden is on the appellants to prove that the trade mark of the respondent is an infringement of theirs and that the act of the respondent amounted to a passing-off. See generally Udih v. Idemudia (1998) 3 SC 50; Odukwe v. Ogunbiyi (1998) 6 SC 72, (1998) 60 LRCN 4001; Duru v. Nwosu (1989) 7 SC (Pt. 1) 1; Oredoyin v. Arowolo (1989) 7 SC (Pt. 1) 1; Odofin v. Oni (2001) 1 SC (Pt. 1) 129.

Learned counsel for the appellants exhaustively dealt with the burden of proof in this matter. Let me take the liberty to quote him in extenso. He said at page 13 of his reply brief:

"Thus in an action in which the plaintiff claims both for infringement of trade mark and passing-off, the plaintiff must discharge the burden of proof peculiar to a passing-off, claim in order to succeed on that leg of the claim. However, regardless of the fact that he fails to prove that the indicum of trade allegedly copied by the defendant and which the plaintiff claims is distinctive of his goods only, is indeed distinctive of his goods, he can still succeed in his claim for trade mark, if the court finds that the plaintiff has registered it under the Trade Marks Act and that the mark being used by the defendant of which the plaintiff complains, is so similar to the registered trade mark as to be likely to

deceive in the course of trade."

While the first sentence is straightforward, the second sentence is complicated. They are all in the package of proof. I will determine whether the appellants proved their case.

In the light of the claim, I should examine the meaning of the word "distinctiveness" as it relates to the law of trade marks. Black's Law Dictionary provides an answer at page 473 as follows:

"An essential element of a device claimed to be a trademark is that it identify the goods of a particular merchant and distinguish them from the goods of others. A word, symbol, shape or colour serving this purpose is said to be distinctive. Certain marks are inherently distinctive while others only acquire distinctiveness over time... A distinctive mark may lose its distinctiveness over time and become generic."

See Black, M. A., Black's Law Dictionary (Sixth edition).

In the law of trade marks, the element of distinctiveness comes before that of passing-off in the way the number 1 comes before the number 2. In other words, the plaintiff must first prove to the satisfaction of the court that the trade mark has a distinctive character or nature, before he can prove the movement of the trade mark of the defendant in business circles by way of passing-off. The element of distinctiveness is consonant to or predicated on some age by way of long or extensive user. What constitutes long or extensive user is a question of fact to be determined in the light of the circumstances of the case. It is certainly not the age of Methuselah. Once the trade mark, by frequent use, has acquired a notoriety in the trade to the common knowledge and common and easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness. In other words, the trade mark has no hiding place so much so that to the eyes of the public, people say in chorus or unison, "of course, that is the trade mark of XYZ, as it identifies their goods."

Learned counsel for the appellants heavily relied on sections 5, 9, 11, 15, 49 and 67 of the Trade Marks Act, 1990. I should examine the provisions. Section 5 deals with right given to registration in Part A of the register. By section 5(1), subject to the provisions of the section, and

sections 7 and 8 of the Act, the registration of a person in Part A of the register as proprietor of a trade mark in respect of any goods, shall, if valid, give or be deemed to have given to that person the exclusive right to the use of that trade mark in relation to those goods. Section 5(2) provides that without prejudice to the generality of the right to the use of a trade mark given by such registration, that right shall be deemed to be infringed by any person who uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either (a) as being used as a trade mark; or (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person is connected in the course of trade.

Section 9 provides for distinctiveness needed for registration in Part A of the register. By sect 9(1), in order for a trade mark to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars: (a) the name of a company, individual or firm represented in a special or particular manner; (b) the signature of the applicant for registration or some predecessor in his business; (c) an invented word or invented words; (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification, a geographical name or a surname; (e) any other distinctive mark.

Section 9(2) defines distinctive as adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists either generally or, where trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

Section 11 provides that deceptive or scandalous matter is not

registrable. By the section, it shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality or any scandalous design.

Section 15 provides for disclaimer for purposes of registration. If a trade mark contains any part not separately registered by the proprietor as a trade mark; or contains matter common to the trade mark or otherwise of a non-distinctive character, the registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register; (1) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter aforesaid, to the exclusive use of which the tribunal holds him not to be entitled, or (ii) that the proprietor shall make such order as the tribunal may consider necessary for the purpose of defining his rights under the registration.

Section 49 provides that in all legal proceedings relating to a registered trade mark, the fact that a person is registered as a proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Section 67 is the interpretation clause. It provides for the definition of "mark" and "trade mark".

I have done a summary of the provisions learned counsel for the appellants relied upon. Let me take his submissions on the sections. I agree with the submission of learned counsel that section 5 simply provides that a proprietor is entitled to the exclusive use of a trade mark and does not allow for part of the trade mark being excluded from the exclusive right to use by the proprietor. I also agree with the submission of learned counsel that where a trade mark comprises of more than one component, the right of exclusive use granted to the proprietor under section 5 as it relates to the various components of the mark is the right to use those components in the manner in which the components were

used in the trade mark. This is because section 5 clearly provides for the exclusive right of a proprietor to use a trade name registered by him in Part A of the register.

B Learned counsel for the appellants is correct in his submission that by section 9, a trade mark must be distinctive for it to be registrable. The section, as earlier indicated, is basic on the distinctiveness needed for registration in Part A of the register. Counsel is also correct in his submission that FERODO is an invented name within the meaning of C section 9(1)(c) of the Act because it does not have a dictionary meaning and therefore registrable as a trade name.

D Attacking the conclusion of the Court of Appeal that what was registered was FERODO, counsel called in aid a joint interpretation of sections 9 and 67 of the Act in respect of the definition of "mark". I do not think counsel can rely on the definition of "mark" in section 9. Learned E counsel for the respondent submitted that the word "mark" is not used in section 9 and therefore the appellants cannot rely on the definition of the word in section 67. I think counsel is wrong in saying that the word F "mark" is not use in section 9. The word is used in section 9(1)(e), but in a different sense. In the light of the totality of the provision of section 9, it is my view that the word "mark" in section 9(1)(e) means "trade mark" and so, does not bear the meaning of "mark" in section 67. It rather bears the meaning of "trade mark" in section 67. Accordingly, the submission of learned counsel for the appellants is, with the greatest respect, wrong as it has not successfully attacked the conclusion of the Court of Appeal that only FERODO was registered as a trade mark.

G In the interpretation of section 11 vis-à-vis section 15, learned counsel submitted that section 11 limits the exercise of discretion by the registrar on disclaimer on the part of the proprietor. Where a trade mark for registration comes within the provision of section 11, the issue of disclaimer within the provision of section 15 will not arise. This is because H section 11 provides for situation where a trade mark for registration is ab initio deceptive or scandalous. That is not the intendment of section 15(a) and (b).

In construing section 49 of the Act, learned counsel submitted at

paragraph 5.1.7, page 9 of the appellants brief:

"Therefore, in any litigation where proof is tendered that a trade-mark has been registered in favour of any party, the court proceeds on the assumption that there is no component of the trade mark which is disentitled to protection in a court of law and in respect of which the proprietor is disentitled to exclusive user." B

My problem with the above submission is the meaning of the word "component". Etymologically, the word "component" means constituent, ingredient, element, or factor. If the word, as used by counsel, means the C totality of the name FERODO and the designs and colourations appurtenant thereto, I will have serious reservations for now.

I have examined the relevant statutory provisions. I will now take the case law. Let me first deal with the case of In Re Clement et cie Trade Mark (supra), which the court of Appeal used and which counsel for the D appellants said is not relevant as the statement credited to Romer, LJ, was *obiter dictum*. In that case, an application was made to the court for the rectification of a trade mark which was a label comprising of the word "St. Raphael" on a background of some graphic design. The applicant E alleged that the word 'St. Raphael' was common to the trade. He therefore brought an application asking the court to either order the removal of the trade mark from the register, or have a disclaimer inserted against the word "St. Raphael". The trial Judge refused the application. F He held that the word "St. Raphael" formed an integral part of the label, which if removed would alter the character of the label. He said:

"The label does not consist of each particular part of it but consists of the combination of them all including the word "St. Raphael." G He dismissed the application. The Lords of Appeal agreed with the trial Judge and said at page 618:

"I desire to add that our judgment must not be understood as sanctioning the registration of words which in themselves would not constitute a proper trade-mark merely because some flourishes were colourably H placed around them with the view of making out a distinctive or compound label, when in fact what was really intended to be registered was the words alone."

I entirely agree with leaned counsel that the above statement of Romer, LJ, is an obiter dictum. As a general rule, an *obiter dictum* is not binding. See Alhaji Yusuf v. Egbe (1987) 2 NWLR (Pt. 56) 341. However, there are occasions when an *obiter dictum* may have a binding effect.¹

B See Mrs. Maclean v. Inlaks Ltd. (1980) 8-11 SC 1; Ifediorah v. Uma (1988) 2 NWLR (Pt. 74) 5. That is not relevant for our purpose and so I will not pursue it. What is important however is that an *obiter dictum*, which is what the court says by the way, has persuasive effect. A court of law can allow itself to be persuaded by an *obiter dictum*. I know of no law which holds a contrary view. The Court of Appeal, in my view, was therefore free to rely on the statement of Romer, LJ, in In Re Clemet.

D In Coca-Cola Company of Canada limited v. Pepsi-Cola Company of Canada Limited (1942) 1 All ER 615, the appellants were owners of a trademark consisting of the words "Coca" and "Cola" joined by a hyphen and written in script form with flourishes. The mark was applied to non-alcoholic beverages and syrups and was used for that purpose in Canada. It was first registered under the Canadian Trade Mark and Designs Act in E 1905, and the registration was renewed for a period of 25 years in 1930. The respondents since 1934 marketed a non-alcoholic beverage under a mark consisting of the words "Pepsi" and "Cola" joined by a hyphen and written in a script form with flourishes. It was proved that there were, in F respect of such beverages being sold in Canada, 22 registered trade marks which included the word Cola or Kola as part of a compound name. The appellants contended that the respondents were using a trade-mark similar to their own contrary to the Canadian Unfair Competition Act, 1932, section 3(c). By section 2(k) of the Act the word "similar" describes G marks so resembling each other or so clearly suggesting the idea conveyed by each other or so clearly suggesting the idea conveyed by each other that the contemporaneous use of both in the same area in association with wares of the same kind would be likely to cause users of such H wares to assume that the same person assumed responsibility for them. It was held that the trade marks used by the appellants and the respondents were not "similar" to each other within the Unfair Competition Act, 1932.

Delivering the judgment of the court, Lord Killowen said at page 616:

"If it is viewed simply as a word mark consisting of "Coca" and "Cola" joined by a hyphen, and the fact be borne in mind that Cola is a word in common use in Canada in naming beverages, it is plain that the distinctive feature in this hyphenated word, is the first word "Coca" and not "Cola". Coca" rather than "Cola" is what would remain in the average memory. It is difficult, indeed impossible, to imagine that the mark Pepsi-Cola, as used by the defendant, in which the distinctive feature is, for the same reason, the first word "Pepsi" and not "Cola". Would lead anyone to confuse it with the registered mark of the plaintiff. If it be viewed as a design mark, the same result follows. The only resemblance lies in the fact that both contain the word "Cola", and neither is written in block letters, but in script with flourishes. The letters and flourishes in fact differ very considerably, notwithstanding the tendency of words written in script with flourishes to bear a general resemblance to each other. There is no need to specify the differences in details. It is sufficient to say that, in their Lordship's opinion, the mark used by the defendant, viewed as a pattern or picture, would not lead a person with an average recollection of the plaintiff's registered mark to confuse it with the pattern or picture represented by that mark."

In Magdalena Securities Ltd.'s application (1931) 48 RPC 477 at 487, it was held that "UCOLITE" was too near to COALITE for registration.

In Alban Pharmacy Ltd. v. Sterling Products International Inc. (1968) All NLR 300, the appellants, a firm known as Sterling Products International Incorporated were the proprietors of the trade mark "Castoria" which was registered in Nigeria. They objected to the registration of the trade mark "Casorina" on the ground that the trade mark is so similar to "Castoria" as to be calculated to deceive. The Supreme Court held that the apprehensions of the appellants were well founded, for if the proposed trade mark be registered, the syllable, "CAS" will no doubt form the essential part of the name of the medicine and was likely to cause confusion in the minds of the public and also that the end of the word

"Casorina" namely "rina" in itself was not free from causing confusion with "ria" in "Castoria".

In Beecham Group Limited v. Essdee Food Products Nigeria Limited (1985) 3 NWLR (Pt. 11) 112, the plaintiffs/respondents sued the defendants/appellants for infringement of their trade mark "Lucozade". The defendants/appellants had put in the market and offered for sale and sold a non-alcoholic beverage under a trade mark called "Glucose aid". The Court of Appeal held that Glucose-aid in sound, is confusing to "Lucozade" and it will undoubtedly mislead the public.

In determining whether two trade marks are identical or of close resemblance within the provision of section 13 of the Act and therefore not registrable under section 11, two senses of the human being are employed. These are the senses of the ears and the eyes to arrive at a conclusion on the average memory arising from general recollection. In the exercise of comparison not only the visible inspection is important, the sounds is equally important. The sound which is assimilated by the ear is important when a telephone conversation takes place. This court made the point in Alban Pharmacy Ltd. v. Sterling Products International Inc. (supra) when Ademola, CJN, said at page 304.

"This is sometimes stated that the ear must be considered as well as the eye; and this is generally shown in the confusion which may arise in the course of a telephone conversation and this is a point that must be borne in mind."

See also Bell Sons and Co. v. Alco (1972) 1 SC 215.

In Magdalena Securities Ltd.'s application (supra) earlier mentioned, the court invoked the factor of the sense of hearing before it came to the conclusion that "UCOLITE" was too near to "COALITE" for registration.

In the exercise of comparison, it is wrong to take the two trade marks side by side to determine whether they are identical or some close resemblance exists within the provision of section 13 of the Act. The issue is whether the person who sees or has seen the proposed trade mark will confuse it with the existing trade mark, as to create confusion and be deceived that the proposed trade mark is the same as the existing

one. In the Matter of Application for Registration of a Trade Mark by Sandow Ltd. (1914) 31 RPC 196 at 205, Sargant, J, made the point:

"The question is not whether if a person is looking at two Trade Marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed Trade Mark in the absence of the other Trade Mark, and in view only of his general recollection of what the nature of the other Trade Mark was, would be liable to be deceived and to think that the Trade Mark before him is the same as the other, of which he has a general recollection."

One other way of conducting the exercise of comparison is by looking closely at the first syllable, being the word or part of the word which contains a vowel sound or a consonant acting as a vowel. For instance, there are two syllables in the word "window". "win" and "dow". The first syllable is much more important than any other one because the victim of the identical trade mark will first come in contact with the first syllable and take it as authentic or 'golden'.

In the Matter of London Lubricants (1920) Limited Application to Register a Trade Mark (1925) 42 RPC 264, Sargant, LJ, emphasized the importance of the first syllable when he said at page 279:

"Though I agree that if it were the only difference having regard to the way in which the English language is often slurred at the termination of words, might not alone be sufficient distinction. But the tendency of person using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and in my judgment, the first syllable of a word is, as a rule, far the most important for the purposes of distinction."

In invoking the factor of first syllable in Capsuliod Co. Ltd.'s Application (1906) 23 RPC 782, the court held that "TABLONES" was too near "TABLOIDS". In Alban Pharmacy Ltd. case (supra) this court also invoked the factor of first syllable and came to the conclusion that the syllable "CAS" will no doubt form the essential part of the name of the medicine and is likely to cause confusion in the minds of the public. This court would also appear to have invoked another factor, the factor of the last syllable when it held that "RINA" which comes at the end of

"CASORINA" in itself is not free from causing confusion with "RIA" in "CASTORIA".

I should now relate the above case law to the facts of this case, and for this purpose let me assume for now that what was registered in Trade Mark No. 38604 is FERODO. Applying the factor of ears and eyes, "FERODO" AND "UNION" can never meet or see or smell in close proximity or smell together. They are quite some distance apart and do not in anyway come within the provision of either section 11 or section 13 of the Act.

I now take the principle enunciated by Sargant, J, in Sanclow Ltd. case. I am of the clear judgment that a person who sees the trade mark of "UNION" without seeing the trade mark of "FERODO" in his general recollection will not confuse "UNION" for "FERODO". This is because the two are quite different.

I take the factor of the first or any syllable for that matter. In my opinion the first syllable of "FERODO" is "FER" and the first syllable of "UNION" is "UNI". If I am correct in my compartmentalization, then I come to the inescapable conclusion that no person will be confused because the two are quite distinct and different. Or can any person with hearing ears and I repeat, hearing ears, confuse "FER" with "UNI"? I think not.

Let me take the last syllables. The last syllable for "FERODO" is "ODO" while that of "UNION" is "ON". I come to the same conclusion as in the first syllable, because no person with hearing ears can confuse the two.

I should now take the issue whether the registered trade mark was only "FERODO" as held by the Court of Appeal or all the components of the trade mark, as contended by learned counsel for the appellants. I had so assumed above for the purposes of a situation. I should now take it frontally. Exhibit D is the registered trade mark. It contains one vital information as follows:

"Names of Trade mark: FERODO"

It is clear to me from the above information that what was registered as a trade mark was 'FERODO' and not all the components as

argued by learned counsel for the appellants. Exhibit B is the Certificate of incorporation. The incorporated name and therefore the name of the company is "FERODO LIMITED". Although a name of a company may not necessarily become a trade mark, I have no hesitation in coming to the conclusion by construing Exhibits D and B in the circumstances of this appeal that what was registered as a trade mark is "FERODO" and not all the components thereof.

I can still go further. Exhibits K and K1 contain commercial "jingle" as follows: "Insist on Genuine FERODO". This again shows clearly the trade mark "FERODO".

It is not enough for the appellants to claim that the components or chequered device formed part of the trade mark but they have the onus to prove further that the components or chequered device were in fact registered. I so not see any such evidence, and here I do not find Exhibit D useful to the appellants.

Dealing with the issue, the learned trial Judge, Jinadu, J, said at page 265 of the Record:

"Having regard to Exhibit D which the plaintiffs registered their trade mark 'Ferodo', without more, I accept the evidence of the defendant that the only mark the plaintiffs can claim distinctiveness on is the mark of 'Ferodo' and not the red, black and white packaging which is common to the trade and which is freely used by other manufacturers as shown in evidence. I accept this piece of evidence and hold that the plaintiffs have failed to prove distinctiveness in respect of the red, black and white packaging."

In delivering the judgment of the Court of Appeal, Pats-Acholonu, JCA (as he then was) said:

"In my opinion what was registered was FERODO whatever it means. I tend to agree with D.W.2 evidence that the appellants do not have the monopoly exclusively over red card board paper, easily available in the market."

The above are sound concurrent findings of the two lower courts and I cannot see my way clear in departing from them. See Kolubo v. Ikuomola (1999) 72 LRCN 3005; Odutan v. Akibu (2000) 80 LRCN 2595; Fasesin

540 Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 2 KLR Tobi JSC
v. Oyerinde (1997) 54 LRCN 2692; Ivienagbor v. Bazuaye (1999) 70
LRCN 2256.

I have carefully examined Exhibit D and I am clearly of the opinion that what was registered as a trade mark is "FERODO" and all other
B elements are mere beautifications, ornamentations, embellishments, flourishes, or what the Court of Appeal called garnishes.

When this appeal was adjourned for judgment, learned counsel for the appellants submitted a decision by Eve, J, of the Chancery Division in
C Woodward Ld. V. Boulton Macro Ld. And in the Matter of The Registered Trade March of Woodward Ld. No. 100 (1915) 32 RPC 173 at 197 and 199. The authority is cited on the submission that the presence of look alike products in the market do not detract from the right of the proprietor of a registered trade mark under section 5 of the Act. I must
D say right away that I entirely agree with that submission, although learned counsel for the respondent had no opportunity to respond to it. The provision of the section is peremptory as it sings the voice of finality the exclusive right to the use by a proprietor of a registered trade mark. As
E a matter of law, the submission is vindicated by the provision of section 5(2) of the Act.

But that is not the fulcrum of this appeal as examined above. In the context of the facts of this matter on appeal, I am attracted by the facts
F of Woodward Ld. The plaintiffs, who were the proprietors of a preparation for the relief of gripes in infants had registered the words: "Gripe Water" in 1876 as an old trade mark. The defendants, who were the successors in business of a firm of manufacturing chemists, put up and sold a preparation for gripes which they called "Gripe Water". Plaintiffs
G brought an action against the defendants claiming injunction to restrain them from infringing their registered trade mark and also from passing-off. It was held that the plaintiffs had failed to establish that the expression "Gripe Water" meant, or had any time for many years past meant,
H their remedy only, and that the claim for an injunction to restrain and passing-off failed.

As in Woodward Ld., the appellants did not discharge the burden of proof placed on them by our procedural law. If the plaintiff's action

failed when the two trade marks were "Gripe Water" because of failure to establish that the expression "Gripe Water" meant their remedy only, the appellants must fail. After all, there is a world of difference between "FERODO" and "UNION".

Assuming, without conceding that "FERODO" and all other components were registered, the appellants cannot succeed because there are clear differences between the two trade marks. This can be seen from Exhibits C, D, E, F and O. In the light of my decision above, it will be a futile exercise to deal in detail with the exhibits.

It is for the above reasons and the more detailed reasons given by my learned brother, Musdapher, JSC, in his judgment that I too dismiss this appeal. I award N10,000.00 costs in favour of the respondents.

2 This statement by Tobi JSC explains the reason we do not mix up obiter dictum with the holdings in the Kings Law Reports. Rather, a special column, **NOTABLE POINTS OF INTEREST**, is where we highlight useful obiter dicta. One is at liberty to dig deep into this dynamic column to discover persuasive obiter to rely upon in pursuit of good justice in appropriate cases. This would include persuasive points in dissenting judgments which we also highlight under the said column. We think it is misleading and erroneous to highlight dissenting opinions as part of the judgment of the court or mix up obiter with ratio.