

**IN THE SUPREME COURT OF NIGERIA
HOLDEN AT ABUJA**

**ON MONDAY THE 3RD OF MARCH, 2023
BEFORE THEIR LORDSHIPS**

KUDIRAT MOTONMORI KEKERE-EKUN	JUSTICE, SUPREME COURT
MOHAMMED LAWAL GARBA	JUSTICE, SUPREME COURT
HELEN MORONKEJI OGUNWUMIJU	JUSTICE, SUPREME COURT
IBRAHIM MOHAMMED MUSA SAULAWA	JUSTICE, SUPREME COURT
ADAMU JAURO	JUSTICE, SUPREME COURT

SC/181/2009

BETWEEN

1.INTERNATIONAL TOBACCO (NIG.) LTD.	}	APPELLANTS
2.OLOLADE OGUNNIYI		
3.RONKE OGUNNIYI		
4.JOHANN WILHELM VON. EICKEN GMBH – (Interested Party)		

V.

1. BRITISH AMERICAN TOBACCO (NIG.) LTD.	}	RESPONDENTS
2. BENSON & HEDGES (OVERSEAS) LTD.		

JUDGMENT

(Delivered by **MOHAMMED LAWAL GARBA, J.S.C.**)

ISSUES:

1. Whether on the evidence before the court, the colour gold constituted part of the trademark registered under No. 60722 or of any other trademark claimed by the respondents in this case.

2. Whether the sale by the appellants of the cigarette brand as "Tradition" packaged in a gold-coloured pack infringed any of the 2nd respondent's registered trademarks, particularly trademark No. 607227.

3. If the issue No. 1 is answered in the affirmative, whether the appellants ought to have been restrained from the use of the trademark "Tradition".

FACTS:

The respondents' case was that the registered trademarks No. 60722 "Benson & Hedges" (gold colour label mark) and No. 56629; "Benson & Hedges" (Turn to Gold Slogan) were clearly registered specifically with relation to the colour gold as part and component of the trademarks to which the respondents, as proprietors, are given the right to exclusive use and protection against unauthorized infringement under the provisions of section 5(1) and of the Trade Marks Act.

There was no dispute at the trial court that the respondents' trademarks No. 60722 and No. 56629, in particular, were registered in relation to and specifically with/in respect of the colour gold in addition to and as part of and component of the brand name "Benson & Hedges", as prescribed and envisaged by the provisions of section 16(1) of the Act.

The Federal High Court entered judgment in favour of the respondents for the infringement of their trademark of Gold Specification Pack of "Benson and Hedges" cigarettes by the appellants, who were the distributors of the "Tradition" brand of cigarettes manufactured by the interested party/appellant. The Court of Appeal also affirmed the said decision of the trial court.

The interested party/appellant then appealed against the decision of the Court of Appeal Supreme Court.

In resolving the appeal, the Supreme Court considered the provisions of section 16(1) and of the Trademarks Act, Cap. T13, Laws of the Federation 2004, which provides:

"16(a) A trademark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trademark."

(2) If and so far as a trademark is registered without limitation of colour, it shall be taken to be registered for all colours."

Held (Unanimously dismissing the appeal):

1. On Meaning of "trademark" -

By virtue of Section 67 of the Trade Marks Act, “trademark” means, except in relation to a certification trade mark, 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 proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of the Act. The “register” is defined to be the register of trademarks kept under the Act. While a “mark” is defined in the section to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. (Pp. 52-53, paras. F-B)

2. On Meaning of “Registered Trademark” -

By virtue of section 67 of the Trademarks Act, a “registered trademark” is a trademark that is entered in the register of trademarks kept by the Registrar of Trademarks as provided for in the Act. By section 5(1) and of the Act, the owner or person for a trade mark is registered and entered in the Register of Trade Marks becomes the proprietor of such trade mark(s) who is given and vested with the exclusive right to use the trade mark in relation to the goods for which it was registered as well as the protection from unauthorized use and infringement of the trade mark by other persons in relation to such goods. In this case, there was no dispute that the respondents are the owners and proprietors of the trademark No. 60722 which was entered in the Register of Trademarks. From the facts and evidence placed before the trial court, the Trade Mark No. 60722 “Benson & Hedges”(gold colour label mark) in class 34 in the Register of Trade Marks, along with the trademarks Nos.53107; “Benson & Hedges” No. 29048”, “Benson & Hedges” (with crest) and No. 56629; Benson &Hedges (Turn to Gold slogan) are all registered Trade Marks in the Register of Trade Marks with the respondents as proprietors/owners given and vested the exclusive right to use and entitled to protection from unauthorized use by any other person(s) in relation to the goods for which they were registered, as provided in the provisions of section 5(1) and of the Act. [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt. 866) 317; Dyktrade Ltd. v. Omnia (Nig.) Ltd. (2000) 12 NWLR (Pt. 680)1; C.N. Ekwuogor Inv. (Nig.) Ltd. v. Asco Inv. Ltd. (2011) (2011) 13 NWLR (Pt. 1265) 565; Maersk Linev. Addidie Inv. Ltd. (2002) 11 NWLR (Pt. 778) 317; Society Bic S.A v. Charzin Ind. Ltd. (2014) 14 NWLR (Pt. 1398) 497 referred to.] (Pp. 53, paras. B-D; 54, paras. B-G)

3. On Essence of a trademark -

The essence of a trademark is that it indicates a connection in the course of trade between the goods and some person having the right to use the name. A trademark, if registered, gives the proprietor the exclusive right to use the trademark in marketing or selling his goods. And without his consent, if anyone 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 passing off or both. An action for infringement will therefore lie where a competitor uses the registered trademark in connection with the proprietor’s goods for the purpose of comparing them with his own goods in the same class. [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt. 866) 317; Dyktrade Ltd. v. Omnia (Nig.) Ltd. (2000) 12 NWLR (Pt. 680) 1; C.N. Ekwuogor Inv. (Nig.) Ltd. v. Asco Inv. Ltd. (2011) 13NWLR (Pt. 1265) 565; Maersk Line v. Addidie Inv. Ltd. (2002) 11 NWLR (Pt. 778) 317; Society Bic S. Av. Charzin Ind. Ltd. (2014) 14 NWLR (Pt. 1398) 497referred to.] (Pp.53-54, paras. G-B)

4. On Effect of registration of a trademark -

By virtue of sections 5(1)&(2) of the Trademarks Act, subject to the provisions of the section and sections 7 and 8 of the Act, the registration (whether before or after the commencement of the Act) of a person in Part A of the register as proprietor of a trademark (other than a certification 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. Without prejudice to the generality of the right to the use of a trademark given by such registration as aforesaid, that right shall be deemed to be infringed by any person who, not being the proprietor of the trademark or a registered user thereof using it by way of the permitted use, 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 tender the use of the mark likely to be taken either. (Pp. 54-55, paras. G-C)

5. On When registered trademark limited to specific colour(s) -

By the provision of section 16 of the Trademarks Act, the character or appearance, in colour, of a trade mark, that is used in branding as a means, way or manner of or to distinguish the trade mark and goods in the course of trade, business or commerce by proprietors thereof, under the section, the proprietor's right as owner of a registered trademark may and can be limited to specific colour or colours as the proprietor may choose to register. By section 16(1), a proprietor may apply to register a trademark in whole or in part, with limitation to specified or particular colour(s) and section 16(2) provides for registration of a trademark with no limitation as to colour, in which case, the trademark shall be taken to be registered for all colours and the proprietor may use the trademark in any colour. In the instant case, the respondents' case was that the registered trademarks No. 60722 "Benson & Hedges" (gold colour label mark) and No. 56629; "Benson & Hedges" (Turn to Gold Slogan) were clearly registered specifically with relation to the colour gold as part and component of the trade marks to which the respondents, as proprietors, are given the right to exclusive use and protection against unauthorized infringement under the provisions of section 5(1) and of the Act. The provision of section 16(2) is therefore not applicable to the respondents' trademark since the colour gold was registered as a part and component of the trademark; limited by the colour specified. Section 16(1) permits the registration of a trademark to be limited in whole or part, to one or more colours which shall be taken into consideration by a tribunal (court) having to decide on the distinctive character of the trademark. There was no dispute at the trial court that the respondents' trademarks No. 60722 and No. 56629, in particular, were registered in relation to and specifically with/in respect of the colour gold in addition to and as part of and component of the brand name "Benson & Hedges", as prescribed and envisaged by the provisions of section 16(1) of the Act. Unlike in the *Ferodo Ltd. v. Ibeta Ind. Ltd.* case, wherein only "Ferodo" was registered as a trademark and brand, the colour gold, in this case in addition to and as a part or component of the brand "Benson & Hedges" was registered as a limitation to colour in the trademark. The colour gold is therefore not just a mere decoration or embellishment, but an essential feature of the registered trademark which makes it different, stands out and distinct for the respondents to be entitled to its protection for exclusive right of use; being the beneficial owners or proprietors thereof. Pursuant to the provision of section 16(1) of the Act, the trial court in considering the character of the registered trademark of the respondent, rightly took into account or considered, the colour gold in relation to which the trademark was registered with

the limitation to the colour gold in part, in addition to the words "Benson & Hedges" brand. [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt. 866) 317 referred to.] (Pp.55-56, paras. E-D; 58-59, paras. D-A 70, paras. A-D)

6. On Essential element of "Trademark"-

An essential element of a device claimed to be a trademark is that it identifies 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 over time. In the instant appeal, having shown that by evidence placed before the trial court, the colour gold was registered as an essential component, portion, part or/and element of the registered trademark and brand of "Benson & Hedges", it is to identify the goods (cigarettes) produced by the respondents and to distinguish them from the goods (cigarettes) of others and because it serves that purpose, it is said to be distinctive. [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004)5 NWLR (Pt. 866) 317; Society Bic S.A. v. Charzin Ind. Ltd. (2014) 14 NWLR (Pt. 1398) 497 referred to.] (P. 59, paras. A-D)

7. On What constitutes element of distinctiveness in a trademark -

The element of distinctiveness in a trademark is consonant to and predicated on some age by way of long or extensive use. What constitutes long or extensive use is a question of fact. Once the trademark, by frequent use, has acquired 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 the instant case, the trial court considered the element of distinctiveness of the respondents' trademark in relation to the gold packaging with red and black markings, based on the evidence adduced by the parties before it in line with the pronouncements by the Supreme court in Ferodo Ltd. v. Ibeto Ind. Ltd. The concurrent findings by the two lower courts were clearly borne out by and supported by the pleadings and evidence placed before the trial court by the respondents. As well as the relevant provisions of the Act in respect of those registered trademarks and the essential components, elements and material portions or part thereof in respect of which they are entitled, to protection from unauthorized infringement by other persons. The "Tradition" cigarettes pack, was practically, confusingly, and deceptively similar to and would be mistaken for the respondents' "Benson & Hedges" pack of cigarettes by traders and smokers of the respondents' brand. In the above premises, the respondents discharged the burden of proving the infringement of their registered trademarks by the "Tradition" cigarettes pack. [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt.866) 317; Alban Pharmacy Ltd. v. Sterling Products Int. Inc. (1968) 1 All NLR 300 referred to.] (Pp. 59, paras. E-H; 63, paras. C-D; 67, paras. F-H)

8. On What constitutes infringement of a trademark –

A registration may be infringed by taking one of its essential features. If some part of what is registered is prominent enough to look like a trademark on its own, the public may be in doubt as to whether that part enjoys protection. In the instant appeal, the "Tradition" cigarettes pack infringed on the essential feature, which was prominent to look alike, resemble and identical to the trademark of the respondents "Benson & Hedges" brand pack,

in a confusing and deceiving manner to warrant the grant of the reliefs granted by the trial court and affirmed by the Court of Appeal. (P. 68, paras. A-B).

9. On Attitude of the Supreme Court to concurrent findings of facts by lower courts and when will not interfere therewith –

The Supreme Court would only intervene and interfere with concurrent findings by the two lower courts where their findings are either perverse, erroneous in law, substantive or procedural, or have occasioned any real miscarriage of justice. In the instant case, the appellants did not satisfactorily demonstrate and show that the concurrent findings by the two lower courts were either perverse, erroneous in law, substantive or procedural, or had occasioned any real miscarriage of justice in order for the Supreme Court to find justification to interfere with them. It must be remembered that the interested party/appellant did not participate in the proceedings before the trial court and so did not file pleadings and adduce evidence, but completely relied on the pleadings and evidence of the initial appellants who were parties at the trial. The interested party/appellant therefore swam or sunk on the basis of the case presented by the said appellants, which as shown, did not warrant interference. [Ogunjumo v. Ademolu (1995) 4 NWLR (Pt. 389) 254; Odoingi v. Oyeleke (2001) 6 NWLR (Pt.708) 12; Animashaun v. Olojo (1990) 6 NWLR (Pt.154) 111; Dibiamaka v. Osakwu (1989) 3 NWLR (Pt.107) 101; Akinsanya v. U.B.A. Ltd. (1986) 4 NWLR (Pt. 35) 273; Kotoye v. Saraki (1994) 7 NWLR (Pt.351) 414; Ajunwa v. State (1988) 4 NWLR (Pt. 89)380 referred to.] (P. 68, paras. C-G)

10. On What a case is precedent for –

A case is only an authority for what it decided, and a court is not to apply a decision in a case outside the relevant facts and circumstances within which it was rendered. In the instant case, the registration of trademarks No. 60722 and No. 56629 elevated the gold colour of the respondents' cigarette pack beyond mere embellishment, to a part of its registered trademark, and it was the principal distinguishing factor between the present case and [Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt.866) 317; Anyakorah v. P.D.P. (2022) 12 NWLR (Pt.1843) 1; Olley v. Tunji (2013) 10 NWLR (Pt. 1362)275; Ugwuanyi v. NICON Insurance Plc (2013) 11NWLR (Pt. 1366) 546 referred to.] (P. 70, paras. F-H)

11. On Nature of reply brief and when unnecessary to file -

The prescription of the law is that a reply brief in an appeal should not and cannot be used for repetition of arguments already canvassed in the appellant's brief or for further or other arguments in support of the appeal in purporting to respond to all arguments canvassed in the respondents' brief. Thus, a reply brief is not meant for an appellant to respond to all and every arguments contained in the respondents' brief; paragraph by paragraph, line by line, as was done by the appellant's counsel in the instant appeal, but only becomes necessary and should be restricted to answer new or fresh points or issue(s) of law raised in the respondents' brief which call for or require a response. [Oshoboja v. Amida (2009) 18 NWLR (Pt. 1172) 188; Ahmed v. Ahmed (2013) 15 NWLR (Pt. 1377) 274; Ikine v. Edjerode (2001) 18 NWLR (Pt. 745) 446; Longe v. F.B.N. Plc (2020) 6 NWLR (Pt. 1189) 1; Okonji v. Njokanma (1999) 14 NWLR (Pt. 638) 250; Mini Lodge Ltd. v. Ngei (2009) 18 NWLR (Pt. 1173) 254; Dada v. Dosunmu (2006) 18 NWLR (Pt. 1010) 134; Chukwuogor v. A.-G., Cross

River State (1998) 1NWLR (Pt. 594) 375 ; Cameroon Airline v. Otutuizu (2011 4 NWLR (Pt. 1238) 512 referred to.) (PP. 51-52, Paras. F-C)

NIGERIAN CASES REFERRED TO IN THE JUDGMENT:

A.-G., Kano State v. A.-G., Fed. (2007) 6 NWLR (Pt. 1029) 164

Adah v. NYSC (2001) 1 NWLR (Pt. 693) 65

Ahmed v. Ahmed (2013) 15 NWLR (Pt. 1377) 274

Ajunwa v. State (1988) 4 NWLR (Pt. 89) 380

Akinsanya v. U.B.A. Ltd. (1986) 4 NWLR (Pt. 35) 273

Alban Ltd v. S.P.I.I. (1968) 1 All NLR 300

Animashaun v. Olojo (1990) 6 NWLR (Pt. 154) 111

Anyakorah v. PDP (2022) 12 NWLR (Pt. 1843) 1

C.N. Ekwuogor Inv. (Nig.) Ltd. v. Asco Inv. Ltd. (2011) 13NWLR (Pt. 1265) 565

Cameroon Airline v. Otutuizu (2011) 4 NWLR (Pt. 1238) 512

Chukwuogor v. A.-G., Cross River State (1998) 1 NWLR (Pt.534) 375

Dada v. Dosunmu (2006) 18 NWLR (Pt. 1010) 134

Dibiamaka v. Osakwe (1989) 3 NWLR (Pt. 107) 101

Dyktrade Ltd. v. Omnia (Nig.) Ltd. (2000) 12 NWLR (Pt.680) 1

Edebiri v. Edebiri (1997) 4 NWLR (Pt. 498) 165

Ferodo Ltd. v. Ibeto Ind. Ltd. (2004) 5 NWLR (Pt. 866) 317

Garuba v. Kwara Inv. Co. Ltd. (2005) 5 NWLR (Pt. 917) 160

Ikine v. Edjerode (2001) 18 NWLR (Pt. 745) 446

Ivienagbor v. Bazuaye (1999) 9 NWLR (Pt. 620) 552

Kotoye v. Saraki (1994) 7 NWLR (Pt. 351) 414

Lagga v. Sarhuna (2008) 16 NWLR (Pt. 1114) 427

Longe v. FBN Plc (2010) 6 NWLR (Pt. 1189) 1

Maersk Line v. Addidie Inv. Ltd. (2002) 11 NWLR (Pt. 778) 317

Mini Lodge Ltd. v. Ngei (2009) 18 NWLR (Pt. 1173) 254

Nnabude v. G.N.G. (W.A) Ltd. (2010) 15 NWLR (Pt. 1216) 365

Odonigi v. Oyeleke (2001) 6 NWLR (Pt. 708) 12

Ogunjumo v. Ademolu (1995) 4 NWLR (Pt. 389) 254

Okonji v. Njokanma (1999) 14 NWLR (Pt. 638) 250

Olley v. Tunji (2013) 10 NWLR (Pt. 1362) 275

Oshoboja v. Amida (2009) 18 NWLR (Pt. 1172) 188
Otukpo v. John (2012) 7 NWLR (Pt. 1299) 357
P. Z. Ltd. v. Chami and Co. Ltd. (1971) 2 NCLR 376
Society Bic S.A v. Charzin Ind. Ltd. (2014) 14 NWLR(Pt.1398) 497
Trebtor Nig. Ltd. v. Associated Ind. Ltd. (1972) NCLR 471
Ugwu v. Ararume (2007) 12 NWLR (Pt. 1048) 365
Ugwuanyi v. NICON Insurance Plc (2013) 11 NWLR (Pt.1366) 546
Ukwejiminor v. Gbakeji (2008) 5 NWLR (Pt. 1079) 172
Foreign Cases Referred to in the Judgment:
GE Trademark (1973) R.P.C. 297
Macfay v. UAC (1961) All ER 1164
Re: Application by F. Reddaway & Co. Ltd (1925) 42 RPC 397
T. Qertli A.G. v. E.J. Bowman London Ltd. (1957) 74 RPC 388
Woodward Ltd. v. Boulton Macro Ltd. (1915) 32 RPC 173

NIGERIAN STATUTES REFERRED TO IN THE JUDGMENT:

Evidence Act, 2011, Ss. 131,132,133,136
Nigerian Trademarks Act, S. 16

FOREIGN STATUTES REFERRED TO IN THE JUDGMENT:

English Trademarks Act, 1938, Ss. 3,5,9,16, 67

NIGERIAN RULES OF COURTS REFERRED TO IN THE JUDGMENT:

Supreme Court Rules,

BOOKS REFERRED TO IN THE JUDGMENT:

Black's Law Dictionary, 6th Edition page 473
T. A. Blanco White & Robin Jacob, Kerly's Law of Trademarks and Trade Names (12th Edition, Sweet & Maxwell,1986) at page 140
The Law of Passing off" by Christopher Wadlaw, 3rd Edition, page 578, paras. 4-8

APPEAL:

This was an appeal by an interested party/appellant against the decision of the Court of Appeal which affirmed the judgment of the Federal High Court entered in favour of the respondents. The Supreme Court, in a unanimous decision, dismissed the appeal.

GARBA, J.S.C. (Delivered the Lead Judgment): This is an appeal by an interested party/appellant against the decision of the Court of Appeal, Ilorin Division (court below) delivered on the 11th December, 2008 which affirmed the judgment of the Federal High Court, Ilorin (trial court) entered in favour of the respondents for the infringement of their trade mark of Gold Specification Pack of “Benson and Hedges” cigarettes by the appellants who were the distributors of the “Tradition” brand of cigarettes manufactured by the interested party/appellant. The appeal was brought by the notice of appeal dated 9th but filed on the 13th of November 2012 pursuant to the leave granted by this court on the 30th of October 2012 and it contains six grounds of dissatisfaction with the decision by the court below.

In the interested party/appellant’s brief filed on the 31st of January, 2013, the following three issues are set out for determination in the appeal:

- (i) Whether on the evidence before the court, the colour gold constituted part of the trademark registered under No. 60722 or of any other trademark claimed by the plaintiff/respondents in this case? (Derived from ground (i) and of the ground of appeal.)
- (ii) Whether the sale by the defendants/appellants of the cigarette brand as “Tradition” packaged in a gold-coloured pack infringed any of the 2nd plaintiff/respondent’s registered trademarks, particularly trademark No. 607227. (Derived from grounds (ii) and of the grounds of appeal)
- (iii) If the issue No. 1 is answered in the affirmative, whether the defendants/appellants ought to have been restrained from the use of the trademark “Tradition”? (Derived from ground of the grounds of appeal)”

For the respondents, two issues are said to be distillable from the notice of appeal in the respondents’ brief filed on 17th November, 2014 as follows:

- (i) Whether in the circumstances of the case, the 4th appellant has established a substantial error of law occasioning miscarriage of justice that could warrant interference with the concurrent findings of the trial court and the lower court that found that one of the prominent features of the respondents’ registered mark in exhibit E2 (the mark registered as No. 60722) includes the gold colouring of the respondents’ trademark and entitled the respondents to be protected. (Distilled from grounds i & ii of the 4th appellant’s notice of appeal)
- (ii) Whether the respondent established a case of infringement of the registered trademark to entitle the respondents to judgment against the appellants. (Distilled from grounds iii, iv, v & vi of the 4th appellant’s notice of appeal)”

A preliminary objection was raised and argued in the respondents’ brief in respect of the relief sought by the interested party/appellant on the notice of appeal on the ground that it has no legal foundation since the relief was not sought at the trial court by the appellants and

the interested party/appellant was only joined in this court and so cannot change the case presented at the trial court at this stage.

Order 8 (2)(1) of the Rules of the court, and among other cases, *Edebiri v. Edebiri* (1997) 4 NWLR (Pt. 498) 165 at 174 and *Garuba v. Kwara Inv. Co. Ltd.* (2005) 5 NWLR (Pt. 917) 160 at 180 are cited in support of the submission. The court is prayed to strike out the relief.

In reaction, an appellant's reply brief was filed on 23rd February, 2016. Since the objection does not challenge the competence and hearing of the appeal, it has to await the outcome of the appeal.

I would use the appellant's issues in the determination of the appeal.

ISSUE 1: APPELLANTS' SUBMISSION

It is submitted that the court below erred in law to have found that there was an infringement of the respondents' trademarks No. 60722 and No. 56629 which by reason of long or extensive use of the "Benson and Hedges" gold coloured pack had become distinctive of or synonymous with Benson & Hedges. Learned counsel submits that under the Trademarks Act, the only condition, under which the colour of a registered trademark will constitute part of what has been registered is, as provided for in section 16 thereof. He then said that the following questions arise in the interpretation of the provisions:

1. What is meant by the limitation of colours?
2. What are the implications of the provisions that the colour or colours to which a trademark is limited shall be taken into consideration in deciding on the distinctive character of the trademark?
3. How is a trademark limited to specified colours?"

After tracing the origin and history of the Nigerian Trademarks Act to the English Act of 1875, 1883, 1905 and 1938, learned counsel said that the freedom of the proprietor of a trademark to register his trade mark in any colour in section 16(2) of the Nigerian Trade Mark Act (the Act) must be assumed, otherwise it would have been provided that a trade mark must be registered in black and white. That section 16(1) of the Act introduced the concept of limitation of colour, which means limiting the exclusive right of the proprietor of the trademark to the use thereof in the specified colour or colours, as opposed to the right of the proprietor of the trademark to use the trademark in any colour, regardless of the colour in which it was registered. Citing *In Re: Application by F. Reddaway & Company Ltd. to register a Trademark* (1925) 42RPC 397, counsel submits that the provision was inserted to benefit proprietors of trademarks which may not be distinctive when viewed devoid of colour but can be distinctive when used in a particular colour or colours. According to him, relying on the Authors of the book "Kerly's Law of Trade Marks and Trade Names, 12th Edition, commenting on the identical provision of section 16 of the English Trade Marks Act, 1938, a possible adverse consequence of limiting a trade mark to specified colour or colours would be that the trademark may not be deemed infringed by the use of a similar trademark in a colour or colours distinctively different from the colour or colours to which a registered trade mark has been limited and that the importance of the provision is on distinctiveness provided for in section 9 of the Act for the registration of a trade mark.

The statement in *Ferodo Ltd. v. Ibeto Ind. Ltd.* (2004) 5NWLJR (Pt. 866) 317 at 370 was cited and it is submitted that the implication of the provision is that the colour or colours to which a trademark is limited shall be taken into consideration in deciding on the distinctive character of the trade mark is that where a trademark is registered subject to colour limitation, the colour or colours to which it is limited will be registered as part of the trademark.

The observation in *Peterson Zachonis and Co. Ltd. v. A.V. Chami and Co. Ltd.* (1971) 2 NCLR 376 as referred to and it is argued that it is indisputable that in order for a colour or colours in which the representation of a trademark appears, to be deemed as having been registered as part of the trademark, the trademark must have been limited to the particular colour or colours. It is the case of the appellant that in so far as there is no statement of colour limitation on any of the copies of the certificates of registration or in the extracts of the register of trade marks admitted in evidence along with them, neither the trade mark No. 60722 (exhibit E2) nor any other trade mark claimed by the respondents in this case was limited to the colour gold, or to any other colour and so the colour gold was not registered as part of what was registered in any of the said trade mark registrations.

In further argument, learned counsel posits that the court below in deciding that even if the trade mark No. 60722 was registered without any colour limitation, by reason of long or extensive use, the gold coloured pack had become distinctive of Benson & Hedges cigarettes to entitle the respondents to claim exclusive right to the colour by virtue of their trade mark, figuratively grafted a common law principle in order for the respondents to take cover which was not solely available at common law or under the Act. According to counsel, acquired distinctiveness by long or extensive use was a matter of fact to be proved in a claim for passing off by a plaintiff, on the authority of *T. Qertli A.G. v. E.J. Bowman London Ltd.* (1957) 74 RPC 388 at 397 and that if any component of a registered trade mark is not deemed as what was registered, it constitutes an unregistered trade mark for which no action for infringement of trade mark can be sustained. It is also contended, relying on section 3 of the Act and *Trebor Nig. Ltd. v. Associated Ind. Ltd.* (1972) NCLR 471, that if however, by usage, the unregistered element of a registered trade mark has become distinctive of the goods of the proprietor, and a third party imitates that unregistered element in order to pass off his goods as the goods of the proprietor of the registered trade mark, the court may hold that a case of passing off has been made out at common-law. Learned counsel argues that since the trial court has dismissed the respondent's claim for passing off on the ground that exhibit "F" (the pack of the Tradition" cigarettes) was not falsely presented by the appellants/defendants, that should have been the end of any application of the acquired distinctiveness which that court found and that the court below erred to have been encouraged by the statement in *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra), per Musdapher, JSC, the facts of which are not the same with the appellant's case.

In addition, it is submitted that the case of *Ferodo Ltd. v. Ibeto Ind. Ltd.* did not say that evidence is required at the trial of a trademark infringement action to prove distinctiveness of any component or element of a registered trademark before the exclusive right of the proprietor to such component could be asserted and reliance was placed on *GE Trademark* (1973) RPC 297 at 324. The court is urged to hold that where there is no evidence that a trademark is limited to the colour in which it was registered, the colour cannot be deemed to be part of what was registered.

In the alternative, the court is called upon to, in the event that it decides that evidence of acquired distinctiveness is admissible to prove that the colour gold forms part of what was registered as the respondent's trademark, find that the evidence before the court does not in any case, support the conclusion that the gold colour pack was distinctive of Benson &

Hedges cigarettes. Reference was made to the evidence of the witnesses; PW1, PW2, PW3, PW4, DW2 and DW6, at the trial and it is argued that the case of Woodward Ltd. v. Boulton Macro Ltd. And in the matter of the Registered Trademark of Woodward Ltd. No.100 (1915) 32 RPC 173 at 187 and 199, approved in Ferodo Ltd. v. Ibeto Ind. Ltd., relied on by the court below, will not apply to the appellant's case. The definition of "distinctive" in "The Law of Passing off" by Christopher Wadlow, 3rd Edition, page 578, paragraphs 4 – 8, was cited and it is submitted that the fact that there were other brands of cigarettes in the Nigerian market sold in gold-coloured packs negates the conclusion of the court below that the gold-coloured pack was distinctive of Benson & Hedges cigarettes.

The arguments under issue 2 are that in an action for infringement of a trade mark, it is the registered trade mark as in the register of trade marks that should be compared with the alleged offending trade mark and not the one on the product of the registered proprietor of the trade mark and so, in order to determine whether the "Tradition" cigarettes in gold coloured pack (exhibit "F") constitutes an infringement of any of the registered trade mark claimed by the respondents in this case, exhibit must be compared to those trade mark as entered in the register of trade marks, with all the implications of such entries.

According to learned counsel, since the trademark No. 60722 was not registered with any colour limitation, the colour of any presentation of the trademark is immaterial and does not form part of the registration such that it cannot be compared with exhibit "F" in order to determine whether the right of its proprietor has been infringed by the sale of exhibit "F".

On issue 3, it is submitted that the injunctive order granted the appellant on products or goods bearing "Tradition" in a manner calculated to deceive the public is wider than and outside the complaint of the respondents and findings by the two lower courts on colour gold pack of the product. It is contended that, as provided for in section 5 of the Act, the exclusive right vested by virtue of registration, is limited to the use of the trade mark in connection with the specific goods in respect of which it was registered and so the trade mark No. 60722 having been registered only in respect of cigarettes, the injunction ought to have been limited to the cigarette bearing the word "Tradition" and only when packaged in a gold coloured pack. The court is urged to answer the issue in the negative and in conclusion, to allow the appeal or to vary the injunctive order granted against the appellant/interested party.

RESPONDENTS' SUBMISSION

The learned counsel argued the issues formulated in the respondents' brief and submitted that the appellant has not established any substantial error of law occasioning miscarriage of justice that could warrant interference with the concurrent findings of the two lower courts that one of the prominent features of the respondent's registered trademark No. 60722 includes the gold colouring to entitle it to protection. Several cases, including *Lagga v. Sarhuna* (2008) 16 NWLR (Pt. 1114) 427; *Otukpo v. John* (2012) 7 NWLR (Pt. 1299) 357; *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra) are cited on when this court will interfere with concurrent findings by the two lower courts.

Portions of the evidence adduced and the findings by both the trial court and the court below were referred to by counsel who submitted that the findings are based on the evidence that the gold colour that appeared on the Trade Marks Certificate of Registration No. 60722 forms part of other features/components of the respondents' Benson & Hedges trade mark which they adopted in packaging the Benson & Hedges brand of cigarettes in Nigeria and that the gold colour of the pack as shown in the certificate, has acquired distinctiveness as a result of long registration, commercial usage and vigorous advertising from 1973.

The court is urged to uphold the findings.

In addition, it is submitted that the appellant totally misconceived and misses the true intent of section 16 of the Act and the purport of the cases of *Trebor and Patterson Zachonis* with regard to the facts of the case. The arguments at paragraph 4.1.29 of the appellant brief is said not to be supported by the provisions of section 16 of the Act, but are importation of procedure or speculations which the law, by the authority of *Nnabude v. G.N.G. (W.A) Ltd.* (2010) 15 NWLR (Pt. 1216) 365 and *A.-G., Kano State v. A.-G., Federation* (2007) 6 NWLR (Pt. 1029) 164 at 188 – 189 among other cases, does not allow. According to learned counsel, no evidence was led before the trial court to show the procedure for the registration of a trademark with or without limitation as to colour and the arguments of counsel does not constitute evidence, as stated, and restated in *Ivienagbor v. Bazuaye* (1999) 9 NWLR (Pt.620) 552 at 561 and *Ukwejiminor v. Gbakeji* (2008) 5 NWLR (Pt.1079) 172 at 223. He said because the arguments of appellant on its issue 2 and 3 are based on the erroneous submissions in paragraph 4.1.29 of the appellant's brief, then the appeal is bound to fail since you cannot put something on nothing and expect it to stand, vide *Macfoy v. UAC* (1961) 3 All ER 1169 at 1172.

In further arguments, it is said that one of the established principles of interpretation of statutes is that the provisions of a statute should be read and considered together; as a whole, in order to get the real intention of the legislature, particularly when the words are clear and unambiguous, on the authority of *Ugwu v. Ararume* (2007) 12 NWLR (Pt. 1048) 365 at 519 and *Adah v. NYSC* (2001) 1 NWLR (Pt. 693) 65, inter alia. That the provisions of sections 5, 9(2)(3) and 67 of the Act should be considered in the interpretation of section 16 in order to get a full understanding of the intention therein, which is to protect such trademark from unpermitted use by competitors, relying on the statement in *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra) at page 350. It is argued that section 16 of the Act only gives permission to the proprietor of a registered trademark to limit it to a particular colour which a tribunal shall take into consideration in deciding the distinctive character of the trademark and that under subsection (2), where the registration is done without such limitation, the trademark will be taken to be registered for all colours. Further, that since there was no evidence of limitation barring the respondents from enjoying the gold colour as part of its registered trademark in exhibit E2, the 2nd respondent who has been shown to be the proprietor of the trademark, should have the exclusivity for the use of such colour that has become distinctive of the *Benson & Hedges* brand of cigarettes.

The cases cited in the appellant's brief were then set out and said not to be applicable to the facts of the case and do not support the interpretation of section 16 by the appellant. It is also submitted that since the respondents' trademark was registered, by virtue of section 9(1) of the Act, was presumed to be distinctive, as a pre-requisite for the registration, on the authority of *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra).

On issue 2, the respondents' arguments are that from the evidence at the trial, the gold colour was, for all intents and purposes, part of what was registered for the other registered trademark of "Turn TO GOLD" would make no sense if the respondents had not considered the gold colour as an important component of its trade mark and registered same for its gold colour pack of *Benson & Hedges* cigarettes. Citing the case of *Alban Pharmacy v. Sterling Products Int. Inc.* (1968) 1 All NLR 300 and section 5(2) of the Act, it is submitted that the test for ascertaining infringement, is to employ two senses of human being; ears and eyes to arrive at a conclusion on the average memory arising from general recollection. That the question is whether a person who sees a proposed trademark in the absence of the other

trademark and in view of only his general recollection of what the nature of the other trademark was, would be liable to be deceived and to think that the trademark before him is the same as the other of which he has a general recollection. The question, according to counsel, is not whether if a person is looking at two trademarks side by side, there would be a possibility of confusion. The court is urged to resolve the issue in favour of the respondents and in conclusion, to dismiss the appeal with substantial costs.

In the appellants' rely brief, in reaction to the objection to relief on the notice of appeal, it is submitted that since the court is invited to hold that the colour gold did not form part of the registration of the respondents' trade mark No. 60722 which is not to any colour, the relief falls within the grounds of appeal and is legitimate for the court to have the inherent jurisdiction to grant as it will give effect to the decision in the appeal. The decisions of the lower court on the issue whether the colour gold forms part of the registered trademark No. 60722 are said to be of law not on concurrent findings from the application of section 16(1) of the Act to admitted facts.

Other arguments in the reply brief are mere further submissions made in response to all the arguments canvassed in the respondents' brief, and not reply to new or fresh points arising or raised in the respondents' brief that called for answer from the appellant.

The principle of law is now elementary in the appellate courts that a reply brief is not meant for an appellant to respond to all and every arguments contained in the respondents' brief; paragraph by paragraph, line by line, as was done by the appellant's counsel in this appeal, but only becomes necessary and should be restricted to answer new or fresh points or issue(s) of law raised in the respondents' brief which called for or require a response. The prescription of the law is that a reply brief in an appeal should not and cannot be used for repetition of arguments already canvassed in the appellant's brief or for further or other arguments in support of the appeal in purporting to respond to all arguments canvassed in the respondents' brief. Judicial authorities on the principle, galore and include *Oshoboja v. Amida* (2009) 18 NWLR (Pt. 1172) 188SC; *Ahmed v. Ahmed* (2013) 41 WRN 12 at 12; (2013) 15 NWLR(Pt. 1377) 274; *Ikine v. Edjerode* (2001) 12 SC (Pt. II) 94; (2001) 18NWLR (Pt. 745) 446; *Longe v. FBN Plc* (2010) 6 NWLR (Pt. 1189)1 SC; *Okonji v. Njokanma* (1999) SCNJ 259; (1999) 14 NWLR(Pt. 638) 250; *Mini Lodge Ltd. v. Ngei* (2009) 18 NWLR (Pt. 1173)254 SC; *Dada v. Dosunmu* (2006) 18 NWLR (Pt. 1010) 134 SC; *Chukwuogor v. A.-G., Cross River State* (1998) 1 NWLR (Pt. 534)375 SC; *Cameroon Airline v. Otutuizu* (2011) LPELR-827 (SC);(2011) 4 NWLR (Pt. 1238) 512.

As can easily be observed, the fulcrum of the appellant's complaint against the decision by the two lower courts is the finding that the colour gold constituted part of the respondent's registered trademark No. 60722, or any other trademark claimed by them which was infringed up on by the appellant's "Tradition "cigarettes pack. The appellant's case is that the colour gold does not form part of the respondents' registered trademark to entitle them to the exclusive use and protection thereof.

The respondents argue that the colour gold is part of their registered trademark No. 60722 and has acquired distinctiveness to entitle them to its exclusive use and protection against infringement.

A good understanding of what a trademark is and what a registered trademark that entitles the owner or proprietor to exclusive use and protection of the trademark from unauthorized infringement by other persons, under the Act, would provide the proper foundation for the determination of the complaint by the appellant against the decision by the court below to affirm the decision of the trial court. Section 67 of the Act is the definition section for all the

words and expressions used in the Act and defines “trademark” as follows: “trade mark” means, except in relation to a certification trade mark, 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 proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 43 of this Act.”

“A registered trademark” is defined in the same section as “a trademark that is actually on the register”, while the “register” is defined to be “the register of trademarks kept under this Act”.

A “mark” is also defined in the section to:

“Include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.”

From the community definitions in the Act, a registered trademark is a trademark that is entered in the register of trademarks kept by the Registrar of Trademarks as provided for in the Act.

By the provisions of section 5(1) and of the Act, the owner or person for whom a trade mark is registered and entered in the Register of Trade Marks becomes the proprietor of such trademark(s) who is given and vested with the exclusive right to use the trade mark in relation to the goods for which it was registered as well as the protection from unauthorized use and infringement of the trade mark by other persons in relation to such goods. The court in the *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra), **Musdapher**, JSC in the lead judgment had defined a “trademark” as:

“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 goods and some person having the right either as a proprietor or a registered user to use the mark. A trademark 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.”

His Lordship then stated that:

“The essence of a trademark is that it indicates a connection in the course of trade between the goods and some person having the right to use the name”, and that:

“A trademark, if registered, gives the proprietor the exclusive right to use the trademark in marketing or selling his goods. And without his consent, if anyone 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 passing off or both. An action for infringement will therefore lie where a competitor uses the registered trademark in connection with the proprietor’s goods for the purpose of comparing them with his own goods in the same class. See *Bismag Ltd. v. Amblins (Chemists) Ltd.* (1940) Ch. 667.”

Similarly, **Belgore, JSC**, had, in the earlier case of *Dyktrade Ltd. v. Omnia (Nig.) Ltd.* (supra), (2000) 12 NWLR (Pt. 680) 1 also reported in (2007) 7 SC (Pt.1) 56; (2000) All NLR 591, stated the law that:

“Trademark”, when registered, will entitle the proprietor to use or institute an action for any infringement of the trademark. Registration entitles the proprietor to the exclusive use of the trademark and also the right to sue for passing off of the goods of the proprietor.”

See also C.N. Ekwuogor Inv. (Nig.) Ltd. v. Asco Inv. Ltd. (2011) LPELR-3899 (CA) per Okoro, JCA (now JSC), (2011) 13 NWLR (Pt. 1265) 565; Maersk Line v. Addie Inv. Ltd. (2002) LPELR-1811(SC); (2002) 11 NWLR (Pt. 778) 317; Society Bic S.A v. Charzin Ind. Ltd. (2014) LPELR-22256(SC); (2014) 14 NWLR(Pt.1398) 497.

In this appeal, there is no dispute that the respondents are the owners and proprietors of the trademark No. 60722 which is entered in the Register of Trademarks. From the facts and evidence placed before the trial court, the Trade Mark No. 60722 “Benson& Hedges (gold colour label mark) in class 34 in the Register of Trademarks, along with the trademarks Nos. 53107; “Benson &Hedges” No. 29048”, “Benson & Hedges” (with crest) and No.56629; Benson & Hedges (Turn to Gold slogan) are all registered Trade Marks in the Register of Trade Marks with the respondents as proprietors/owners given and vested the exclusive right to use and entitled to protection from unauthorized use by any other person(s)in relation to the goods for which they were registered, as provided in the provisions of section 5(1) and of the Act. The provisions are that:

- (1) Subject to the provisions of this section and section 7 and 8 of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trademark (other than a certification 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 trademark in relation to those goods.
- (2) Without prejudice to the generality of the right to the use of a trade mark given by such registration as aforesaid, that right shall be deemed to be infringed by any person who, not being the proprietor of the trademark or a registered user thereof using it by way of the permitted use, 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 tender the use of the mark likely to be taken either.”

The respondents’ suit at the trial court was for the infringement of these registered trademarks by the then defendants whose appeal the present interested party/appellant joined in this court.

As stated earlier, the pith of the interested party/appellant in this appeal is that the colour gold does not form part of the registered mark No. 60722 for the pack of its own “Tradition” cigarettes to constitute as infringement of the said trademark. Now, section 16 of the Act provides for and deals with the limitation of a registered trademark in relation to colour(s) and says that:

“16 (a) A trademark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trademark.

(2) If and so far as a trademark is registered without limitation of colour, it shall be taken to be registered for all colours.”

As can easily be observed, the section deals with the character or appearance, in colour, of a trade mark, that is used in branding as a means, way or manner of or to distinguish the trade mark and goods in the course of trade, business or commerce by proprietors thereof, under the section, the proprietor's right as owner of a registered trade mark may and can be limited to specific colour or colours as the proprietor may choose to register. By section 16(1)a proprietor may apply to register a trademark in whole or in part, with limitation to specified or particular colour(s) and section 16(2) provides for registration of a trademark with no limitation as to colour, in which case, the trademark shall be taken to be registered for all colours and the proprietor may use the trademark in any colour.

In the respondents' case, the registered trademarks No. 60722' "Benson & Hedges" (gold colour label mark) and No. 56629; "Benson & Hedges" (Turn to Gold Slogan) are clearly registered specifically with relation to the colour gold as part and component of the trade marks to which the respondents, as proprietors, are given the right to exclusive use and protection against unauthorized infringement under the provisions of section 5(1) and of the Act, as stated earlier. The provision of section 16(2) is therefore not applicable to the respondents' trademark since the colour gold was registered as a part and component of the trademark; limited by the colour specified.

The court below, in determining the issue whether from the totality of the evidence adduced before the trial court, what was registered in the respondents' trademark No. 60722 included the gold colouring of the pack, had reasoned, and found, at pages 19 –20 of the judgment (pages 829-830 of the record of appeal), after setting out the findings of the trial court on the issue that:

"I am of the candid view that the findings of the learned trial Judge cannot be faulted if regard is had the provisions of section 16(1) of the Trademarks Act, the oral testimonies of the witnesses and the contents of the documentary exhibits tendered by the respondents. Section 16(1) cited by both counsels to press home their respective points as to whether or not exhibit E2 registered any colour (gold, red and black) as a trademark, states thus:

"Registration with limitation as to colours:

To Trademark may be limited in whole or in part to one or more specified colours and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the Trademark."

By subsection (2) if and so far as a trademark is registered without limitation of colour, it shall be taken to be for all colours."

Once more, a look at exhibit E2 would reveal that it is only mark with the B & H logo, Benson & Hedges name, crest written in black colours and the "Special Filter" brand name in conspicuous red colour engraved on a gold background as can also be gleaned from exhibit G the Benson and Hedges pack. All other marks in exhibits E, E1, E3 and E4 their respective extracts are embossed on either white or milky coloured background and their respective inscriptions are in black. PW2 and PW3 gave evidence that the golden pack design is synonymous with Benson and Hedges.

Again, the PW4 in his evidence in the court below testified that in his 13 years of smoking Benson and Hedges he had never seen any other pack designed in gold, red and black like Benson and Hedges. As for the PW5 he had testified in chief that:

“The gold pack is synonymous with Benson and Hedges and so whenever a gold pack is brought out and a stick given me, I do not have to look at the name on the pack or the cigarettes.”

I have also been privileged to examine exhibits G and H and I agree with the findings of the learned trial Judge that it is in apparent recognition of the gold colour pack of Benson and Hedges (exhibit E2) by the public as can be gathered from the evidence of the PW4 and PW5 that the plaintiffs/respondents had carried out sustained advertisements in black, red and gold inscriptions like exhibit H and for instance has the inscription: SIGNED & SEALED TO GIVE YOU GOLD STANDARD QUALITY” in black colour and then the enumerated qualities are dotted in red spots as follows:

“Benson & Hedges is committed to quality worldwide. Signed & sealed by British American Tobacco to ensure nothing less than the gold standard.” etc.

There is no doubt as the learned trial Judge has also rightly observed that the “TURN TO GOLD” registered Trademark advertorials emphasize on the golden quality and colour as exemplified in the golden pack of Benson and Hedges exhibit G.

I am of the considered view that the learned trial Judge took into consideration the provisions of the section 16(1) of the Trademarks Act when he made the findings complained about by the appellants and with the greatest respect, the submission by the learned counsel for the appellants about the specific colour (gold, red and black) which were registered or that the findings of the court is speculative, is not borne out of the evidence before us in the face of the fact that exhibit E2 highlights the gold, red and black colours which are on the designed pack. The specified colours in exhibit E2 are those that appear also in both the certificate and are particularly clear and speak for themselves in the “REPRESENTATION OF TRADEMARK” contained in the extract which the court took into consideration to decide the distinctive colour of the packet.”

I would, without hesitation, say that the above views and finding by the court below are on the firm terrain of the law, as shown before not. Section 16(1) permits the registration of a trademark to be limited in whole or part, to one or more colours which shall be taken into consideration by a tribunal (court) having to decide on the distinctive character of the trademark.

There was no dispute at the trial court that the respondents’ trademarks No. 60722 and No. 56629, in particular, were registered in relation to and specifically within respect of the colour gold in addition to and as part of and component of the brand name “Benson & Hedges”, as prescribed and envisaged by the provisions of section 16(1) of the Act. Unlike in the Ferodo Ltd. v. Ibeto Ind. Ltd. case, wherein only “Ferodo” was registered as a trademark and brand, the colour gold, in addition to and as a part or component of the brand “Benson & Hedges” was registered as a limitation to colour in the trademark. The colour gold is therefore not just a mere decoration or embellishment, but an essential feature of the registered trademark which makes it different, stands out and distinct for the respondents to be entitled to its protection for exclusive right of use; being the beneficial owners or proprietors thereof. Pursuance to the provision of section 16(1) of the Act, the trial court in considering the character of the registered trademark of the respondent, rightly took into account or considered, the colour gold in relation to which the trademark was registered with the limitation to the colour gold in part, in addition to the words “Benson & Hedges” brand. Tobi, JSC, Ferodo Ltd. v. Ibeto Ind. Ltd. Case, referred to Black’s Law Dictionary, 6th Edition at page 473, where it was stated that:

“An essential element of a device claimed to be a trademark is that it identifies (sic) 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 distinctiveness over time”

See also Society Bic S.A. v. Charzin Ind. Ltd. (2014) LPELR-22256; (2014) 14 NWLR (pt. 1398) 497.

In this appeal, having shown that by evidence placed before the trial court, the colour gold was registered as an essential component, portion, part or/and element of the registered trade mark and brand of “Benson & Hedges”, it is to identify the goods (cigarettes) produced by the respondents and to distinguish them from the goods (cigarettes) of others and because it serves that purpose, it said to be distinctive. His Lordship, Tobi, JSC did not stop at the definition of an essential element of a trademark in the Black’s Law Dictionary, but, as usual, proceeded to state what the element of distinctiveness in a trademark is. In his instructive and weighty words:

“The element of distinctiveness is consonant to and predicated on some age by way of long or extensive use. What constitutes long or extensive user (sic) is a question of fact. It is certainly not the age of Methuselah. Once the trademark, by frequent use, has acquired 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 trademark has no hiding place so much so that to the eyes of the public, people say with chorus or union, of course that is the trademark of XVZ, as it identifies their goods.”

The trial court considered the element of distinctiveness of the respondents’ trademark in relation to the gold packaging with red and black markings, based on the evidence adduced by the parties before it in line with the pronouncements by this court in *Ferodo Ltd. v. Ibeta Ind. Ltd.* and found, inter alia, that:

“The plaintiffs registered the gold colouring of Benson & Hedges whose Trademark Certificate of Registration No. is 60722 and tendered in this court during hearing as exhibit E2 and has been in long or extensive use (going by Trademark Registration Certificate) since 1999 and even earlier in 1973 going by exh. E3, Trademark Registration Certificate No. 29048.

The classification of gold colouring pack of Benson & Hedges as basic idea of the Trademark is further reinforced by exhibit E4 – Slogan “Turn to Gold” with Trademark Reg. No. 56629 and even exh. H– printed promotional adverts of Benson & Hedges, which highlights the GOLD PACK and the SLOGAN “TURN TO GOLD”. It is immaterial there are other cigarettes with gold colour. This is because of the case of *Woodward Ltd. v. Boulton Macro Ltd.* (1915)32 RPC 173 and S. 5(2) of Trademarks Act. These reasons will be considered in detail, later in the course of this judgment.

It is pertinent to note that none of these gold colour packs of other cigarettes tendered by the defence had its registered Trademark in Nigeria and no evidence was led to establish such. Also, the evidence of age of use of gold pack by these other cigarettes were significantly absent, especially as it concerns the Nigerian jurisdiction.

“Interestingly even the infringement cigarette pack “Tradition” has no registered Trademark. I can only see in the process file before me (as I am bound to take judicial notice of it) plaintiffs’ objections to defendants’ application for registrations of Trademark of Tradition cigarette whose outcome is not yet made known by the Registrar of Trademark. The court

has taken judicial notice of the fact that this cigarette only came into Nigeria last year in 2005 and so conspicuously lacks long or extensive use to acquire distinctive Trademark of Gold colour.

In the present case, I think the plaintiffs have proved distinctiveness in respect of gold packaging, exh. E2, exh. E4 contains a commercial gold colour pack, exh. E2 to be the basic idea of the Trademark.

Assuming but not conceding that the gold colour pack of exh. G was not specifically registered. I must concede that exh. G's long or extensive use of the gold colour pack since 1973 (for about 33 years) is more than enough time for it to acquire distinctiveness. See exh. G Trademark Registration Certificate tendered in this court as exh. E3 which shows date of registration as 1973."

"The argument of defence counsel that there are so many cigarette packs of gold colour and as a matter of fact it is a colour common in the business of cigarette packs is not acceptable to me. This is because the presence of look-alike products in the market do not detract from the right of the proprietor of a registered trade under S. 5 of the Trademark Act. This position of the law has been age-long. See the case of Woodward Ltd. v. Boulton Macro Ltd. and in the matter of Registered Trademark of Woodward Ltd. (No. 100) (1915) 32 RPC 173 at 197/199 where the Supreme Court of Nigeria held that this case is vindicated by or given impetus by S. 5(2) of the Act. The Supreme Court per Tobi JSC held that the provision of S. 5 of the Act is peremptory as it sings the voice of finality the exclusive to the use by a proprietor of a registered Trademark. It is trite law that the criterion for determining whether or not there is an infringement of a Trademark is the mark complained of must not when compared with what is already registered, deceive the public or cause confusion. See Alban Pharmacy Ltd. v. Sterling Products Int. Inc. (1968) 1 All NLR300; Beecham Group Ltd. v. Esdee Food Products (Nig.) Ltd. (1985) 3 NWLR (Pt. 11) 112.

In the instant case, the gold colour specification pack of Benson & Hedges tendered during the trial as exh. E2 has its Trademark certificate of Registration as No. 60722 when compared with gold pack "Tradition" cigarette, unregistered, is deceitful and confusing. It is very relevant to state here that the Tradition cigarette pack has been imported into this country a few months ago in 2005 and therefore the claim or defence of long use is and cannot be available to it.

After lengthy consideration, I have finally arrived at the conclusion that the gold colour specification on the plaintiff's Benson & Hedges Gold pack is in itself "sufficiently arresting" to be likely to be taken as having trademark significance or using the Supreme Court wording in Ferodo's case (supra) "basic idea of Trademark" by the relevant customer and even non-customers alike.

I therefore do not hesitate in holding that the gold pack specification of defendants "Tradition" cigarette is infringing to the plaintiffs registered Trademark Gold specification pack of "Benson & Hedges".

This position by the trial court was affirmed rightly by the court below, relying on Ferodo Ltd. v. Ibeto Ind. Ltd. when it held at pages 832, 835 and 837 of the record of appeal that:

"Above all, and in line with settled authorities on this versed issue of distinctiveness and notoriety of the Gold package of the respondents pack, the learned trial Judge had appositely cited the case of: Woodward Ltd. v. Boulton Macro Ltd. (1915) 32 RPC 173 and S. 5(2) of the Trademarks Act, to hold that it is immaterial that there are other cigarettes with

gold colour provided that the respondents who registered their gold pack are desirous of using same as their distinctive Trademark.

In *Ferodo v. Ibeta Industries* (supra) at 376 paras. H-A cited by the counsel, the apex court held that it is not enough for the appellants to claim that the components or chequered device formed part of the trademark but that the onus was on them to prove further that the components or chequered devices were in fact registered, which the respondents have appropriately done in this case. If the PW1 did not give oral evidence, how else could she have proved the purport of exhibit E in the face of the controversy generated by the appellants even when the "Representation of Trademark" which is the pack design of the respondents' cigarettes was apparent? As I had said earlier, assuming the evidence of the PW1 is inadmissible what of the golden colour of the representation of the Trademark which is distinct from the Benson & Hedges name, crest, and slogan displayed in all other certificates and extract. I am of the view that even in the absence of the evidence of the PW1, it was the pack design that registered, the distinctive colour of the mark together with the slogan "Turn To Gold" having demonstrated on the balance of probability that exhibit E2 sought to, and indeed, registered the golden pack of the Benson & Hedges as can be seen in exhibits E4, G and H as the Trademark of the respondents."

I have shown above that the concurrent findings above by the two lower courts are clearly borne out by and supported by the pleadings and evidence placed before the trial court by the respondents as well the relevant provisions of the Act in respect of those registered trademarks and the essential components, elements and material portions or part thereof in respect of which they are entitled, to protection from unauthorized infringement by other persons. On that basis, I have no difficulty in endorsing the findings of the court below on the issue.

The next pertinent question is whether the respondents who had the burden of proof to prove their assertions in the pleadings by way of credible evidence on the balance of probabilities or preponderance of evidence. See *Ferodo Ltd. v. Ibeta Ind. Ltd.* (supra); *Alban Pharmacy Ltd. v. Sterling Products Int. Inc.* (1968) ;(1968) 1 All NLR 300 LPELR-25491(SC), sections 131, 132, 133 and 136 of 2011 Evidence Act, had proved the infringement of their said registered trademarks to be entitled to the reliefs granted by the trial court and affirmed by the court below. In dealing with the issue the court below considered the law on the burden of proof, the evidence adduced before the trial court and the provisions of section 5(2) of the Act as interpreted in judicial authorities and stated at pages 840 – 841 of the record, that:

"I had already held on issue number one relying on section 9(2) of the Trademarks Act, that the plaintiffs/respondents had from exhibits E2 and the extract therefrom, the evidence of the PW1 – PW5 established that the Benson & Hedges pack had acquired the distinctiveness and notoriety required to sustain a claim against the defendants if they (defendants) so infringed their said trade mark. What is left here to determine is the proof of infringement or passing out. In this connection, it is necessary to reproduce the provisions of section 5(2) of the Trademarks Act which state as follows:

- (2) Without prejudice to the generality of the right to the use of a trade mark given by such registration as aforesaid, the right shall be deemed to be infringed by any person, who not being the proprietor of the trade mark or a registered user thereof, using it by way of the permitted use, uses a mark identical with it or so nearly 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 way as to render and use of the mark likely to be taken either:

(a) as being used as a trademark; 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 trademark or to goods with which such a person as aforesaid is connected in the course of trade.”

Whereas in this case, there is controversy as to whether or not there was infringement or passing-off of the plaintiffs/respondents’ trademark by the appellants or that their marks are confusingly similar as alleged by the respondents, the judicial test has always been to place the disputed marks side by side and compare them without necessarily looking at the associated features or get-ups and other embellishments. See *Bell & Sons Co. Ltd. v. Aka & Ors.* (1972) All NLR (Pt. 1) 34 at 39.

In *Alban Pharmacy Ltd. v. Sterling Products International Inc.* (1968) All NLR 292, Ademola CJN stated the position of the law thus 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 telephone conversation, and this is a point that must be borne in mind”.

This point was further emphasized by Tobi, JSC in his contribution to the judgment in *Ferodo Ltd. v. Ibeto Ind. Ltd.* (supra) at page 374 paras. A-C inter alia:

“In determining whether two marks are identical or of close resemblance within the provision of section 13 of the Act and therefore not registrable under section 11, two sense of the human being are employed. These are the sense 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, but the sound is also equally important. The sound which is assimilated by ear is important when a telephone conversation takes place.”

In the cases of *Coca-Cola Company of Canada Ltd. v. Pepsi-Cola Company of Canada Ltd.* (1942) All ER615; *Magdalena Securities Ltd.’s Application* (1931)48 RPC 477; *Alban Pharmacy Ltd. v. Sterling Products International Inc.* (supra); *Beecham Group Ltd. v. Esdee Food Products (Nig.) Ltd.* (1985) 5 NWLR (Pt. 11)112; the courts decided that either by similarity of sound of the marks or the look, they were likely to deceive customers or members of the public.

There is also no doubt as the learned counsel for the respondents has submitted, citing in the matter of application for registration of a Trademark by *Sandow Ltd.* (1914) 31 RPC 196 quoted in *Alban Pharmacy Ltd. v. Sterling Products International Inc.* (supra) and *Ferodo v. Ibeto* (supra), that in determining whether a trademark has infringed another, it is the offensive or offending trademark that is considered such that whether the person who sees the offending trademark in the absence of the one breached, and in view of his general recollection, the nature of the offending trademark is likely to deceive him into thinking that the trademark before him is the authentic one.

Again, it is pertinent to note that in order to found infringement, the intention of the defendant needs not be fraudulent or deliberate. Thus, in *Re: Egg Products Ltd.’s Application* (1922) 39 RPC 155; the view was expressed that the phrase “likely to deceive” as used in section 5(2) of the Trademarks Act, does not necessarily imply fraud, or anything of like nature on the

part of the defendant but that the relevant consideration is the likely effect of the trademark on members of the consuming public.

Thus, where the mark is likely to confuse them, the likelihood of deceit is deemed to be present. See *Bell & Sons Ltd. v. Aka & Ors.* (supra). It has further been held that the above factor is of paramount importance particularly in Nigeria where a considerable number of her citizens are illiterates, Moreso, when what will not deceive an educated, diligent, and careful purchaser may well deceive an illiterate. See *The United Kingdom's Tobacco Co. Ltd. v. Carreras* 16 NLR 1.”

It then concluded at pages 848 – 849 of the record of appeal, that:

“I adopt the findings and conclusions of the learned trial Judge and I am also of the considered view that the plaintiffs/respondents from the totality of the oral and documentary evidence tendered have proved that they were the exclusive owners of the gold pack Trademark for purposes of manufacturing and marketing of their Benson & Hedges cigarettes. As the court below rightly held, it is immaterial that the other cigarette manufacturers are using gold package and red, black, and gold markings. The fact is that only the respondents have a registered trademark in the nature of exhibit E2 and ought not to be interfered with in the use of such Trademark. That is the essence of section 5(2) of the Trademark Act.

The authorities earlier cited have shown that the fact the evidence of the DW1 and DW7 did not show that there was any intention to infringe is immaterial. See: *In Re: Egg Products Ltd.'s Application* (1923) 39RPC 155, where the court rightly found in my view that the gold pack of the defendants when seen in the absence of the Benson and Hedges pack is likely to deceive or confuse the public, infringement has been proved as the likelihood of deceit does not necessarily imply fraud. See also *Bell & Sons Co. Ltd. v. Asa & Ors.* (1971) 1 All NLR (Pt. 1) 34 at 39 which held that where there is likelihood of the public being confused, the likelihood of deceit be inferred.

As far as the two packs exhibits F and G are concerned, even though a literate person may not be deceived because of the markings, names, and location of the crest, an illiterate and even an undiscerning literate who prima facie encounters exhibit F, would definitely mistake same for packet of Benson & Hedges. See the case of *United Kingdom Tobacco Co. Ltd. v. Carreras* (1931) 16 NLR 1. On the whole, this first arm of issue number 2 is resolved against the appellants.”

I have perused the evidence of particularly the respondents' witnesses, PW1, PW2, a business woman who sells cigarettes at Agbein Market, Ibadan, like PW3, PW4, a longtime smoker of the “Benson & Hedges” brand, like PW5, who gave credible first and uncontroverted evidence on the deceiving and confusing similarities of the “Tradition” cigarettes presentation with that of the respondents' “Benson & Hedges” brand of cigarettes, in the usual or ordinary course of the trade or business of selling cigarettes, to members of the public, who, in most cases, are illiterate, semi-literate and ordinarily undiscerning in Nigeria.

I agree with the findings by the two lower courts that the “Tradition” cigarettes pack, is practically, confusingly, and deceivingly similar to and would be mistaken for the respondents' “Benson & Hedges” pack of cigarettes by traders and smokers of the respondents' brand.

In the above premises, the answer to the question is in the affirmative to the effect that the respondents' discharged the burden of proving the infringement of their registered trademarks by the "Tradition" cigarettes pack.

The Authors of T.A. Blanco White & Robin Jacob, Kerly's Law of Trademarks and Trade Names (12th Edition, Sweet & Maxwell, 1986) at page 140, stated that:

"... a registration may be infringed by taking one of its "essential features", if some part of what is registered is prominent enough to look like a trademark on its own, the public may be in doubt as to whether that part enjoys protection."

In this appeal, the "Tradition" cigarettes pack has infringed on the essential feature, which is prominent to look alike, resemble and identical to the trademark of the respondents "Benson & Hedges" brand pack, in a confusing and deceiving manner to warrant the grant of the reliefs granted by the trial court and affirmed by the court below.

The appellant has not satisfactorily demonstrated and shown that the concurrent findings by the two lower courts are either perverse, erroneous in law, substantial or procedural or have occasioned any real miscarriage of justice in order for the court to find justification to interfere with them.

It is now common knowledge in this court that the court only intervenes and interferes with concurrent findings by the two lower courts when any of these situations is satisfactorily shown to exist. See *Ogunjumo v. Ademolu* (1995) 4 NWLR (Pt. 389) 254; (1995) LPELR-2337(SC); *Odonigi v. Oyeleke* (2001) 6 NWLR (Pt. 708) 12 at 32-33; *Animashaun v. Olojo* (1990) 6 NWLR (Pt. 154) 111; *Dibiamaka v. Osakwe* (1989) 3 NWLR (Pt. 107) 101; *Akinsanya v. U.B.A. Ltd.* (1986) 4 NWLR (Pt. 35) 273; *Kotoye v. Saraki* (1994) 7 NWLR (Pt. 351) 414; *Ajunwa v. The State* (1988) (2)9 SC 110; (1988) 4 NWLR (Pt. 89) 380.

It must be remembered that the interested party/appellant did not participate in the proceedings before the trial court and so did not file pleadings and adduce evidence, but completely relies on the pleadings and evidence of the initial appellants who were parties at the trial. The interested party/appellant therefore swims or sinks on the basis of the case presented by the said appellants, which as shown, does not warrant interference with findings by the two lower courts which are completely predicated and inured from the evidence placed before the trial court.

On the whole, I find no merit in the appeal and dismiss it. In consequence, the judgment of the court below delivered on the 11th of December 2008 is hereby affirmed. There shall be cost for the prosecution of the appeal assessed at five Million (N5,000,000.00) awarded in favour of the respondents to be paid by the interested party/appellant.

KEKERE-EKUN, J.S.C.: My learned brother, Mohammed Lawal Garba, JSC obliged me with a draft of the judgment just delivered. His Lordship has exhaustively and competently resolved the issues in contention in this appeal. The reasoning and conclusion to the effect that the appeal lacks merit fully represent my views in this appeal. The appellant has failed to show that the concurrent findings and sound reasoning of the two lower courts are perverse. I am not persuaded to interfere.

I also dismiss the appeal and award costs of N5,000,000.00 costs against the interested party/appellant in favour of the respondents.

Appeal dismissed.

OGUNWUMIJU, J.S.C.: I have read hitherto the lead judgment delivered by my learned brother Mohammed Lawal Garba, JSC. I agree with his Lordship's erudite opinion that the appeal has no merit and should be dismissed. The concurrent findings of the two lower courts are that the "Tradition" cigarettes and "Benson and Hedges" cigarettes are so similar in presentation and the packaging of both brands so identical that undiscerning members of the public, merchants and consumers cannot decipher the difference between them. There is nothing perverse in these findings in view of the evidence of the respondents' witnesses which included marketers and consumers of the respondents' products who has been deceived into purchasing the appellants' products because of the similarity in packaging. The court below was right in finding that the appellants had violated the respondents' trademark and were entitled to the orders sought and granted by the two lower courts. Appeal dismissed.

I abide by the orders in the lead judgment.

SAULAWA, J.S.C.: My learned brother, the Hon. Justice M.L. Garba, JSC, has obliged me with a draft of the judgment just delivered. Having previewed the said judgment, I am in full concurrence with the reasoning expressed therein, to the conclusive effect, that the instant appeal is devoid of any merits. Hence, having adopted the reasoning and conclusion in question as mine, I too hereby dismiss the appeal and affirm the decision of the Court of Appeal, Ilorin Judicial Division, delivered on December 11, 2008.

Appeal dismissed.

JAURO, J.S.C.: I had the preview of the lead judgment just delivered by my learned brother, Mohammed Lawal Garba, JSC. I am in agreement with his reasoning and conclusion reached in dismissing the appeal.

Section 16(1) of the Trademarks Act provides as follows:

"A trademark may be limited in, whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of the trademark."

The above provision allows a trademark to be registered with limitation as to specified colours. Considering the totality of the evidence on record, it is clear that the respondents registered their trademark No. 60722 as to the colour gold because not only are the proprietors of registered trademark No. 60722, "Benson & Hedges" (gold colour label mark), they are likewise the proprietors trademark No. 56629, "Benson & Hedges" (Turn to gold Slogan). In contending that the colour gold did not form part of the respondent's registered trademark, the interested party/appellant relied heavily on the *Ferodo Ltd. v. Ibeto Ind. Ltd.* (2004) 5 NWLR (Pt. 866) 317. In that case, the court found that "FERODO" was the only trademark registered by the appellant. It was found that all other components or features of the appellant's products, including the get up on their packaging did not form part of the trademark registered by the 1st appellant but were just embellishments.

It is trite that a case is only an authority for what it decided, and a court is not to apply a decision in a case outside the relevant facts and circumstances within which it was rendered.

See Anyakorah v. PDP & Ors. (2022) LPELR - 56876 (SC); (2022) 12 NWLR (Pt.1843) 1; Olley v. Tunji (2013) 10 NWLR (Pt. 1362) 275; Ugwuanyi v. NICON Insurance Plc (2013) LPELR- 20092 (SC); (2013)11 NWLR (Pt. 1366) 546. The registration of trademarks No.60722 and No. 56629 elevated the gold colour of the respondents' cigarette pack beyond mere embellishment, to a part of its registered trademark and it is the principal distinguishing factor between the present case and Ferodo's case.

In consequence of the foregoing, and more particularly for the elaborate reasons in the lead judgment, I too dismiss the appeal. I abide by the order as to costs.

Appeal dismissed.

Names of Counsel: O. F. Olukoya, Esq. - for the Interested Party/Appellant

Appellants absent and unrepresented.

Respondents absent and unrepresented.