

**THE JURISDICTION OF FEDERAL HIGH COURT IN ACTIONS FOR DAMAGES FOR PASSING OFF** - – This article is published in (2005) VOL. 3 NO. 2 Nigerian Bar Journal P. 35

Nasiru Tijani\*

Introduction

The issue of jurisdiction of the Federal High Court in civil causes has been a subject of controversy at various times.

By the comprehensive provisions Section 251 of the Constitution of the Federal Republic of Nigeria, 1999, Legal Practitioners and Scholars were of the opinion that the question of the extent of the jurisdiction of the Federal High Court in civil matters was settled<sup>1</sup>. However, by the decision of the Supreme Court in the recent case of *AYMAN ENTERPRISES LTD. v. AKUMA INDUSTRIES LTD*<sup>2</sup>, it has become clear that until a legal interpretation is given to relevant Sections of the Constitution, the extent of the civil jurisdiction of the Federal High Court may never be known. The Supreme Court in this case in construing Section 251(1)(f) of the Constitution of the Federal Republic of Nigeria, 1999 held that the Federal High Court has no jurisdiction in an action for passing off simpliciter For the Federal High Court to have jurisdiction in an action for damages for passing off, it must relate to a registered Trade Mark.

The purpose of this article is to examine this decision in relation to the background of passing off actions and the earlier decision of the Supreme Court in the case of *PATKUN INDUSTRIES LTD. v. NIGER SHOES CO. LTD*<sup>3</sup>.

We shall trace the historical background of passing off actions and the statutory recognition both under the Trade Marks Act Cap. 436 Laws of the Federation of Nigeria 1990 and the Constitution of the Federal Republic of Nigeria, 1999 and examine the decision of the Supreme Court in *AYMAN ENTERPRISES v. AKUMA*<sup>4</sup> to the extent that the Federal High Court only has jurisdiction in an action for passing off of a registered Trade Mark. The problem Legal Practitioners will encounter as a result of this decision will also be considered.

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\* **LL.B (Hon.) LL. M BL Barrister at Law and Notary Public for Nigeria Lecturer Nigerian Law School Bwari, Abuja.**

<sup>1</sup> See: *BRONIK MOTORS LTD. v. WEMA BANK PLC* (1983) 6 S C. 158; *MANDARA v. A.G FED.* (1984) 14 SC. 8

<sup>2</sup> (2003) 13 NWLR (Pt. 836) 22; See also the recent decision of the Supreme Court in *N.E.P.A. v. EDEGBERO* (2002) 18 NWLR (Pt. 798) 79 on the interpretation of Section 251(1)(r) of the 1999 Constitution on the jurisdiction of Federal High Court in action against Government agencies.

<sup>3</sup> (1988) 5 N.W.L.R. (PT. 93) 138

<sup>4</sup> *Supra*

## **PASSING OFF ACTIONS UNDER THE COMMON LAW**

Actions for “passing off” arose in the 19th Century out of the use in connection with his own goods by one trader of the trade name or trade mark of a rival trader so as to induce in potential purchasers the beliefs that his goods were those of the rival trader<sup>5</sup>. According to Lord Langdale MR. in the case of *PERRY v. TRUEFIT*, “A man is not to sell his own goods under the pretence that they are the goods of another man .....<sup>6</sup>”

Passing off is an actionable wrong for a trader so to conduct his business as to lead to the belief that his goods or business are the goods or business of another. It is immaterial whether the false representation, as to goods or business, involved in passing off, is made expressly by words, or impliedly, by the use or imitation of a mark, trade name or get-up with which the goods of another are associated in the minds of the public<sup>7</sup>.

A Plaintiff may fail to make out a case of infringement of a trade mark for various reasons but be able to show that by imitating the mark claimed as a trade mark or otherwise, the Defendant has done what is calculated to pass off his goods as those of the Plaintiff. A claim in “passing off” has generally been added as a second string to actions for infringement of a registered trade mark and has on occasion succeeded where the claim for infringement failed<sup>8</sup>.

## **STATUTORY RECOGNITION OF PASSING OFF ACTIONS**

The earliest recognition of the common law right of passing off can be found in Section 3 of the Trade Marks Act<sup>9</sup> which provides as follows:

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

This provision has been judicially interpreted by the Supreme Court in the case of *PATKUN IND. LTD. v. NIGER SHOES LTD*<sup>10</sup>.

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<sup>5</sup> See: *ERVEN WARNINK B.V v. TOWNSEND (J) & SONS (HULL)* (1979) A.C. 731; (1979) W.L.R. 68

<sup>6</sup> 49, ER. 749 at 752

<sup>7</sup> See: *CLERK AND LINDSELL ON TORTS 13TH EDITION (SWEET & MAXWELL) PAGE 1199 PARAGRAPH 2227*

<sup>8</sup> See: *KERLY'S LAW OF TRADE MARKS AND TRADE NAMES 13TH EDITION PAGE 426 PARAGRAPH 14 - 34*

<sup>9</sup> Cap. 436, Laws of the Federation of Nigeria, 1990. The Act was enacted in 1965.

<sup>10</sup> *Supra*

According to Karibi-Whyte, J.S.C. in PATKUN CASE

“The Section prohibits action in respect of unregistered trade marks but preserves the right of action for passing-off goods as the goods of another. Thus a right of action in respect of passing off arising from the Trade Mark Act 1965 is preserved by the proviso....<sup>11</sup>”.

From the discussion of the right of action for passing off under common law, it is clear that it predates the statute recognition of the right and also exists outside the Trade Mark Act. The provisions of the Trade Marks Act only recognizes the common law right but does not derogate from it.

It is trite principle of law that a statutory right may be conferred in addition to, and not in derogation of a common law right<sup>12</sup>. This is exactly what Section 3 of the Trade Marks Act has done. This is because in addition to the right of action conferred on the owner of a registered Trade Mark, the statute has in the Section conferred an additional right of action by preserving the right of action of passing off in respect of such goods.

### **JURISDICTION OF THE FEDERAL HIGH COURT TO ENTERTAIN ACTIONS FOR DAMAGES FOR PASSING OFF**

The jurisdiction of Court has been variously defined, but for the purpose of this paper, jurisdiction may be defined as the power of Courts to inquire into facts, apply the law, make decisions and declare judgment. The legal right by which Judges exercise their authority. It exists when Court has cognizance of class of cases involved, proper parties are present and point to be decided is within the powers of Court. It is also the power and authority of a Court to hear and determine judicial proceeding and power to render particular judgment in question<sup>13</sup>.

In the case of *MADUKOLU v. NKEMDILIM*<sup>14</sup>, the Supreme Court held that a Court is competent when:

- (1) It is properly constituted as regards numbers and qualifications of the members of the bench, and no member is disqualified for one reason or another; and
- (2) The subject matter of the case is within its jurisdiction and there is no feature in the case which prevents the Court from exercising its jurisdiction; and

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<sup>11</sup> *Supra* at Page 152C

<sup>12</sup> See; *NATIONAL ASSISTANCE BOARD v. WILKINSON* (1952) 2 Q.B. 648 followed in *PATKUN INDUSTRIES LTD. v. NIGER SHOES LTD. (SUPPA)* at Page 152 E

<sup>13</sup> *A.G. OGUN STATE v. COKER* (2002) 17 NWL.R. (PT. 796) 304

<sup>14</sup> (1962) 2 S.C.N.L.R. 341 at 346. See also *ONYENUCHEYA v. MIL. ADMINISTRATOR OF IMO STATE* (1997) 1 N.W.L.R. (PT. 462) 429 at 446

- (3) The case comes before the Court initiated by due process of law and upon fulfillment of any condition precedent to the exercise of jurisdiction. Any defect in competence is fatal, for the proceedings are a nullity however well conducted and decided, the defect is extrinsic to the adjudication.

We are concerned here with the second arm whether the subject matter of the case (passing off) is within the jurisdiction of the Federal High Court.

The jurisdiction of Courts in Nigeria can arise from statute or common law. Therefore, before a Court can assume jurisdiction, it must be able to point to the statute conferring the jurisdiction and the scope of the jurisdiction and right of action thereof as construed from the provisions of the law or the common law. However, where a statutory provision is in conflict or differ from the common law, the common law gives place to the statute. Also where the common law right has been enacted into statutory provision, it is to the statutory provision so made that resort must be had for such rights and not in the common law<sup>15</sup>.

Therefore, the jurisdiction of a Court to entertain actions for passing off may have its origin under common law or in the statute. But Section 3, Trade Marks Act having recognized the common law right of passing off, it is to the statute that resort would be made.

The Federal High Court Act Cap. 134, Laws of the Federation of Nigeria, 1990 is a source of the jurisdiction of the Court.

Section 7(1)(c)(ii) provides:

“The Federal High Court shall have and exercise jurisdiction in civil causes and matters

(c) arising from -

(i) .....

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

From the above provision, it is clear that Section 7(1)(c)(ii) of the Federal High Court Act only confers statutory jurisdiction on the Federal High Court in a civil cause or matter arising from any enactment relating to trade marks etc, that is the Trade Marks Act applicable in Nigeria. It makes no express provision for the common law right of passing off.

Does it mean that under Section 7(1)(c)(ii) of the Federal High Court Act, the Federal High Court would not have jurisdiction in respect of passing off action?

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<sup>15</sup> See *Ibid* at pages 152 - 153. See also: *CAMEROON AIRLINES v. ABDULKAREEM* (2003) N.W.L.R. (PT. 830) 1 at 20

Karibi-Whyte, J.S.C. in PATKUN case provided an answer in the following words:

“It is therefore not correct to argue, as Appellants have done in this case that a passing-off action being an action at common law is not within the jurisdiction of the Federal High Court. It is undoubtedly correct to hold and I hold that a passing-off action arising from the infringement of Plaintiffs registered trade mark or patents, its common law origin notwithstanding, is clearly within the jurisdiction of the Court as a civil cause or matter arising from any enactment relating to copyright, patents, trade marks and merchandise marks as provided under Section 7(1)(c)(ii) of the Federal High Court Act No. 13 of 1973. In this case it is Section 3 of Trade Marks Act, 1965<sup>16</sup>”.

From the above, it is clear that where passing off arises from infringement of a registered trade mark under Section 3 of the Trade Marks Act, the Federal High Court would have jurisdiction to entertain the claim by virtue of Section 7(1)(c)(iii), Federal High Court Act.

Another source of jurisdiction of the Federal High Court to entertain passing off action is Section 251(1)(f) of the Constitution of the Federal Republic of Nigeria, 1999 which provides:

“251(1)Notwithstanding anything to the contrary contained in this Constitution and in addition to such other jurisdiction as may be conferred upon it by an Act of the National Assembly, the Federal High Court shall have and exercise jurisdiction to the exclusion of any other Court in civil causes and matters -

- (f) any Federal enactment relating to copyright, patent, designs, trade marks and passing-off, industrial designs and merchandise marks, business names, commercial and industrial monopolies, combines and trusts, standards of goods and commodities and industrial standards”.

By this provision, the Federal High Court has exclusive jurisdiction to entertain all civil causes and matters arising from Federal enactment relating to any of the matters mentioned therein including trade marks and passing off. In Nigeria the Federal enactment relating to trade marks is the Trade Marks Act.

### **What is the difference between the provisions of the Federal High Court Act and the Constitution of the Federal Republic of Nigeria, 1999?**

Section 7(1)(c)(ii) of the Federal High Court Act, did not include “passing off” and only mentions “trade marks”. Secondary, Section 251(1) of the Constitution refers to “federal enactment” whereas the Federal High Court Act, mentions “any enactment<sup>17</sup>”.

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<sup>16</sup> Ibid at Page 154B

<sup>17</sup> See the judgment of Kalgo, JS.C. in *AYMAN ENTERPRISES LTD. v. AKUMA INDUSTRIES LTD.* (*Ibid*) at Page 45 D – E. Since Section 7(1)(c)(ii) of the Federal High Court Act refers to

It is my opinion that it is Section 251(1)(f) of the 1999 Constitution that would now regulate the jurisdiction of the Federal High Court to entertain actions for passing off.

This is because the provision of the Constitution is wider than that of Section 7(1)(c)(ii) of the Federal High Court Act as shown above and under the doctrine of covering the field, where the Conclusion has made provisions on any subject, any other statutory provision even if not inconsistent with the provisions of the Constitution will be “in abeyance” “inoperative” as the Constitution is Supreme and has “covered the field<sup>18</sup>”.

Having established that the Federal High Court has jurisdiction in “trade marks and passing off” by virtue of the express and overriding provision of Section 251(1)(f) of the 1999 Constitution, the next question is whether it must be passing off of a registered trade mark or passing off of unregistered trade mark.

Section 251(1)(f) of the 1999 Constitution gives exclusive jurisdiction to the Federal High Court “in civil causes and matters arising from any Federal enactment relating to copyright, patent, designs, trade marks and passing-off”.

The relevant federal enactment relating to Trade marks is Section 3 of the Trade Marks Act.

From the authorities, the jurisdiction of the Federal High Court passing off actions is limited to registered trade mark.

According to Kalgo, J.S.C. in *AYMAN ENTERPRISES v. AKUMA INDUSTRIES LTD*<sup>19</sup>.

“This section is divided into two distinct parts. The first part prohibits the institution of any action for the infringement of an unregistered trade mark. The second part preserve the right of action against any person for passing-off goods as the goods of another”.

He also held:

“The emphasis here is that for the Federal High Court to have jurisdiction for the passing-off claims, arising from infringement of a trade mark, the trade mark allegedly infringed must have been registered<sup>20</sup>.”

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any “enactment it can properly be applied to both a Federal enactment or a State enactment. The implication of this is that, a State Legislature can enact a law on Trade Mark and the Federal High Court would have jurisdiction to hear the matter based on that state law.

<sup>18</sup> Generally on doctrine of covering the field. See *A.G. OGUN STATE v. A.G. FEDERATION* (1982) N.C.L.R. 166; *A.G. ABIA v. A.G. FED.*, (2002) 6 N.W.L.P. (PT 763) 264; *OKAFOR v. OKONKWO* (2002) 17 N.W.L.R. (PT. 796) 262; *COUNCIL OF THE UNIVERSITY OF IBADAN v. ADAMOLEKUN* (1967) 1 ALL N.L.R. 213; *LAKANMI v. A.G (WEST)* (1970) 6 N.S.C.C. 143; *IN.E.C. v. MUSA* (2003) 3 N.W.L.R. (PT 806) 72

<sup>19</sup> *Supra* at Page 45H

<sup>20</sup> *Ibid* at Page 47E

In the same case, Uwais, C.J.N. in his concurring judgment held:

“It seems to me the jurisdiction of the Federal High Court to deal with actions on passing-off depends on the registration of trade marks as provided by Section 3 of the Trade Marks Act Cap. 436 and Section 230 subsection (1)(f) of the 1979 Constitution (now Section 251(1)(f) of the 1999 Constitution) - See *PATKUN INDUSTRIES LTD. v. NIGER SHOES MANUFACTURING CO. LTD.* (1988) 5 NWLR (PT. 93) 138<sup>21</sup>”.

In the earlier case of *PATKUN INDUSTRIES LTD. v. NIGER SHOES MANUFACTURING CO. LTD.* the Supreme Court also held that the jurisdiction of the Federal High Court is limited to passing off of registered trade mark.

According to Karibi-Whyte, J.S.C:

“On the above analysis, the Federal Court has jurisdiction in respect of an action of passing-off arising from infringement of Plaintiff’s registered trade marks, since the passing off and the infringement of Plaintiffs registered trade mark are matters from the same transaction which can conveniently be included in the same Writ of Summons and can be tried together”<sup>22</sup>.

Uwais, J.S.C. held:

“In my opinion, therefore, the Federal High Court has the jurisdiction by virtue of Section 63 of the 1965 Act read together with Section 7(1)(ii) of the 1973 Act, to hear at the same time both the claims in respect of the infringement of Respondent’s registered trade mark and passing-off - See *Gafai v. U.A.C. Ltd.* (*Supra*)<sup>23</sup>.

## **UNREGISTERED TRADE MARK AND PASSING OFF ACTIONS**

From the above discuss, it is clear that the Federal High Court has exclusive jurisdiction to entertain actions for passing off of registered trade mark. But where the trade mark is unregistered, which Court has jurisdiction? This question is particularly important because most Legal Practitioners commence action in the Federal High Court for passing off of a trade mark which are not yet duly registered. The basis of such action are usually based on the Acknowledgment and Acceptance Forms from the Trade Marks Registry which is in fact only evidence of an application for registration and not the actual certificate of registration<sup>24</sup>.

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<sup>21</sup> Ibid at Page 50H

<sup>22</sup> Supra at Page 154H

<sup>23</sup> Ibid at Page 159D

<sup>24</sup> See Section 18 Trade Marks Act. In fact the Acceptance Form clearly states that the application is only being accepted and would be advertised in due course in the Trade Marks Journal. After publication under Section 19 opposition to registration must be filed within two months of publication - Section 20 Trade Marks Act.

Therefore, if the only document a Plaintiff has is the Acceptance or Acknowledgement form from the Trade Marks Registry or no application has ever been made for registration. the party still has a right of action for the tort of passing-off under common law. In such a case it is the State High Court that has jurisdiction to entertain the claim.

Uwais, C.J.N. in *AYMAN ENTERPRISES LTD. v. AKUMA INDUSTRIES LTD.* put the position succinctly as follows:

“Where the trade mark is unregistered. as in the present case, then the cause of action for passing-off is in common law for tort and action can now be brought in a State High Court in view of the provisions of Section 272 subsection (1) of the 1999 Constitution which provides:-

“272(1) Subject to the provisions of Section 251 and other provisions of this Constitution the High Court of a State shall have jurisdiction to hear and determine any civil proceedings in which the existence or extent of a legal right, power, duty, liability, privilege, interest, obligation or claim is in issue which the existence or extent of a legal right, power, duty, liability, privilege, interest, obligation or claim is in issue....<sup>25</sup>

In the case, the trade name was not registered but an application was pending at the trade marks registry. The Plaintiff claimed inter alia a perpetual injunction restraining the Defendants from.

“Manufacturing, importing, selling or offering for sale or supplying wigs and hair attachments in any package of get-up bearing the name ‘Original Queens or any other words so closely resembling the Plaintiffs trade mark ‘New Queen’ applied for and accepted under TP 25575/95 in Class 26, as to be calculated to lead to the belief that the wigs and hair attachment not of the Plaintiffs manufacture are product of the Plaintiff”.

The Affidavit in Support of the application for injunction was to the effect that the application for registration of trade mark was made on 9th day of July, 1995 and accepted on 31st day of July, 1995 as TP25575/95.

There was therefore no doubt that the Plaintiffs trade mark known as “New Queen” had not been registered under the trade Marks Act.

It is therefore my opinion that the Supreme Court was right in holding that being an unregistered trade mark the Federal High Court had no jurisdiction to entertain the claim or grant any injunctive relief.

This fact brings out a distinction between this case and PATKUN case relied heavily upon by the Appellant’s Counsel to the effect that PATKUN case decided that the Federal High Court has jurisdiction in respect of passing-off of unregistered trade mark.

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<sup>25</sup>

Supra at Page 51 A - C. See also PATSUN’S CASE at Page 156H - 157A

From the opinions of the Learned Justices of the Supreme Court in I case set out above, it is clear that the case was fought solely on the question whether the Federal High Court had jurisdiction in an action for infringement of a registered trade mails where damages for passing off of the goods has also been claimed<sup>26</sup>”.

It is different from the facts of AYMAN ENTERPRISES LTD case.

It is conceded that certain remarks by the Learned Justices in PATKUN case could be said to be conflicting but the conclusion arrived at were the same, that is, the Federal High Court has jurisdiction only in respect of registered trade mark.

For instance Nnamani, J.S.C. said at pages 156 - 157:

“It is necessary to observe that the words of the proviso are Nothing in this Act not Nothing in this Section for, if it were the latter, it would have been argued that the right of action on passing-off goods so granted would be limited to matters arising from unregistered trade marks. In the way it is worded, it is my view that there is preserved a right of action in passing-off of goods whether what is involved is an unregistered or registered Trade Mark. It seems to me that from the words of the proviso to Section 3 read together with Section 7(1)(c)(ii) of Act No. 13 of 1973, a statutory right of action on passing-off is provided. What is involved, at least as it relates to Trade Marks, is not the Common Law action of passing-off, but a statutorily guaranteed right of action. This to my mind is sufficient to dispose of the matter of jurisdiction. For it thus falls within Section 7(1)(c)(ii) of Act No. 13 of 1973”.

The impression one gets upon reading the sentence: “In the way it is worded, it is my view that there is preserved a right of action in passing-off of goods whether what is involved is an unregistered or registered Trade Mark” is that actions for unregistered Trade Mark can lie but subsequent statements show that it is related to a registered trade mark.

Also, Uwais, J.S.C. at Page 158G stated:

“However where the infringement of the unregistered trade mark leads to the tort of passing-off, the 1965 Act, allows an action to be brought in respect of the passing-off”.

This again is an interpretation of Section 3 of the Trade Marks Act. The Learned Justice had earlier stated that:

“It is also not in dispute that there cannot be an action for the infringement of the unregistered trade mark by virtue of the provisions of Section 3 of the 1965 Act<sup>27</sup>”.

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<sup>26</sup> Ibid at Page 144D

<sup>27</sup> Ibid at Page 158F

He concluded:

“In my opinion, therefore, the Federal High Court has the jurisdiction, by virtue of Section 63 of the 1965 Act read together with Section 7(1)(c)(ii) of the 1973 Act, to hear at the same time both the claims in respect of the infringement of the Respondent’s registered trade mark and passing-off see *GAFAI v. U.A. C. LTD.* (Supra)<sup>28</sup>”.

## **DILEMMA FOR LEGAL PRACTITIONERS**

The process of registration of a Trade Mark commences with filing the necessary application forms after a due search for availability of the name. The Trade Marks Registrar acknowledges the receipt of the form. If the name is available and there is no reason at that stage not to register, the Registrar issues an acceptance form with a number and the class in which the application is made.

The Acceptance Form clearly stipulates that the application is accepted and would be advertised in due course in the Trade Marks Journal. After advertisement in the Journal, opposition to the registration must be filed with the Registrar within two months of the publication<sup>29</sup>. It is only where there is no opposition to the registration that a Certificate of Registration will be issued.

It is relevant at this stage to refer to Section 22(2) and (3), Trade Marks Act which provides:

Section 22(2):

“Subject to the provisions of this Act relating to international arrangements, a trade mark, when registered, **shall be registered as of the date of the application for registration, and that date shall be taken for the purpose of this Act to be date of registration**”.  
(Emphasis mine)

Section 22(3):

“On the registration of a trade mark the Registrar shall issue to the Applicant a certificate of registration in the prescribed form sealed with the seal of the Registrar”.

What can be deduced from the above is that where a trade mark is registered, the registration shall be from the date of the application. For instance, if an application was made in 1993 and the mark was registered in 2003, the date of application shall be taken to be the date of registration.

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<sup>28</sup> Ibid at Page 159D

<sup>29</sup> See Sections 18- 20,

This means that a date of de facto registration would be different from the date of *de jure* registration.

The implication of this is that at all material times between 1993 to 2003, the Federal High Court would not have jurisdiction to entertain a claim for passing off in respect of the trade mark because it is unregistered.

Assuming there is infringement of the mark of a party (yet unregistered) in the year 2000 while the application is pending, by the decision in AYMAN case, only the State High Court would have jurisdiction to entertain the claim. If before the conclusion of the case, a certificate of registration is issued under Section 22(3), Trade Marks Act and by Section 22(2), the mark “shall be registered as of the date of application for registration”, it means that the Mark was *de jure* registered as at 1993. The implication of this is that the State High Court did not have jurisdiction *ab initio* to entertain the claim in the first place in 2000.

An objection may be raised by a Defendant that the State High Court has no jurisdiction by virtue of Section 251(1)(f) 1999 Constitution which confers exclusive jurisdiction on the Federal High Court.

The above scenario is the likely consequence of the decision of the Supreme Court in AYMAN case. Will Counsel need to wait until a mark is registered before he can determine which Court to commence an action? It is trite principle of law that *ubi jus ibi remedium*. Where there is a right, there is a remedy. This is particularly important in this case where steps need to be taken urgently. Should a party commence an action in the State High Court and after registration file another action in the Federal High Court? This would lead to a multiplicity of actions<sup>30</sup>.

It is submitted that as a means of preventing this confusion, where a Plaintiff satisfies the Federal High Court that an application for registration of Trade Mark has been duly accepted for registration, it can entertain the matter subject to the party satisfying the Court before the conclusion of the trial, of the due registration. This takes into account the length of time for determining such cases. If the Plaintiff is unable to produce the certificate of registration duly issued under Section 22(3) Trade Marks Act, the Federal High Court can strike out the case and transfer the matter to the State High Court under Section 22(3), Federal High Court Act for determination. The action will therefore be treated as passing off of unregistered trade mark for which the State High Court has jurisdiction under Section 272(1), 1999 Constitution.

Alternatively, the Trade Marks Act should be amended to provide for time limit to register a trade mark which has been accepted for registration.

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<sup>30</sup> This is inadvertently going back to the fears expressed by Uwais, J.S.C. in PATKUN CASE at Page 159 A - B as a plea of res judicata may lie.

## **CONCLUSION**

From this discuss, it is clear that the jurisdiction of the Federal High Court to entertain passing-off actions is tied to the registration of the trade mark under the Trade Marks Act - a Federal enactment, under Section 250(1)(f) of the 1999 Constitution.

Where a trade mark is unregistered only the State High Court can entertain the matter by virtue of Section 272(1) of the Constitution of the Federal Republic of Nigeria, 1999. By the same reasoning, where only an application for registration has been made and no certificate of registration has been obtained, a party cannot commence an action at the Federal High Court for infringement of a trade mark by passing-off. He has to wait until a certificate is issued.

In other cases of passing-off, it would seem that the action can be directed to the State High Court even where the mark is not registrable.