

# **P&G CO v. GLOBAL SOAP & DETERGENT INDUSTRIES LTD & ORS**

**CITATION: (2012) LPELR-8014(CA)**



**In the Court of Appeal  
In the Lagos Judicial Division  
Holden at Lagos**

**ON TUESDAY, 24TH JANUARY, 2012**

**Suit No: CA/L/369/2008**

**Before Their Lordships:**

HELEN MORONKEJI OGUNWUMIJU

Justice, Court of Appeal

RITA NOSAKHARE PEMU

Justice, Court of Appeal

MOHAMMED AMBI-USI DANJUMA

Justice, Court of Appeal

**Between**

THE PROCTER AND GAMBLE COMPANY

- Appellant(s)

**And**

1. GLOBAL SOAP AND DETERGENT INDUSTRIES LTD

- Respondent(s)

2. THE REGISTRAR OF TRADE MARKS

## **RATIO DECIDENDI**

1. **APPEAL - ADDUCING FRESH/ADDITIONAL/FURTHER EVIDENCE ON APPEAL:** Whether leave of Court is required to adduce fresh evidence on appeal

"I agree with the submission of the learned Appellant's counsel that the 1st respondent cannot introduce new evidence on appeal without leave of this Court .  
(Judicial Authority). \*Per OGUNWUMIJU, J.C.A. (P. 69, Paras. F-G) - [read in context](#)

2. **COMMERCIAL LAW - AGENCY:** Ways in which principal and agent relationship may arise/can be created

"The law of agency is clear and unambiguous. In Niger Progress Limited v. NEL Corporation (1989) 3 NWLR Pt. 107 Pg.68 at 92, Nnamani JSC stated thus:

"The relationship of Principal and Agent may arise in 3 ways:

(a) By agreement, whether contractual or not between Principal and Agent which may be express or implied from the conduct or situation of the parties;

(b) Retrospectively, by subsequent ratification by the principal of acts done on his behalf;

(c) By operation of law under the doctrine of agency of necessity and in certain other cases." Also, in *Kafor & Ors v. Pedro* (2011) LPELR - CA/PH/8M/2006, Muhammad JCA cited with approval the case of *Bamgboye v. University of Ilorin* (1991) 8 NWLR Pt. 207 Pg. 1 @ 6, where it was stated that: "The relationship of agency arises whenever one person called the agent, has authority to act on behalf of another, called the Principal and consents to act. Authority may also be implied from the subsequent assent of the Principal. It is therefore trite law that agency arises mainly from a contract or agreement between parties express or implied." It is certain that there was evidence uncontested at the trial Court that Procter & Gamble Nigeria limited had authority to use the trade mark. It is apparent from the evidence and indeed the circumstances of this case that Procter and Gamble Nigeria Limited had an implied authority to use the trade mark Ariel which was registered by the Appellant. In order for an international conglomerate such as the Appellant in this case, to carry on business in Nigeria, it must incorporate a company in Nigeria. See Section 54 of Companies and Allied Matters Act . It did this by incorporating a subsidiary; Procter and Gamble Nigeria Limited. This presupposes the fact that whatever business needs to be done by the Appellant in Nigeria can be done by the Nigerian subsidiary and not the Appellant by itself. Thus, can it not be implied from this general authority to act, a more specific one; the use by the Nigerian subsidiary of the trade mark ARIEL as registered in Nigeria by the Appellant? I think it can. Also, agency can arise from subsequent ratification of an agent's act by the principal. Even though the 1st respondent's counsel had contended that Exhibits A and A1 were between Procter & Gamble AG and Procter and Gamble Nigeria Limited, it would seem to me that the mere fact of tendering the exhibits by the Appellant shows willingness to ratify the contents of the documents. In *Carlen (Nig.) Limited v. University of Jos & Anor* (1994) 1 NWLR Pt. 323 Pg 631 at Pg. 667, Onu JSC held as follows: "Indeed, in the law of agency, ratification will be implied from any act showing an intention to adopt the transaction, even silence or mere acquiescence and if an act is adopted at all, it will be held to have been adopted throughout." Per OGUNWUMIJU, J.C.A. (Pp. 56-58, Paras. A-A) - [read in context](#)

3. **EVIDENCE - EVALUATION OF EVIDENCE:** How a trial court should assess evidence

"...where a Court admits a piece of evidence, the whole of the evidence must be used. Courts may not analyse and depend on a piece of evidence in support of a party's position without engaging in a similar analysis and dependence on the same piece of evidence that supports the other party's position. See *ONISAADU V. ELEWUJU* (2006) 13 NWLR Pt. 998 Pg.517." Per OGUNWUMIJU, J.C.A. (P. 54, Paras. D-E) - [read in context](#)

4. **INTELLECTUAL PROPERTY - TRADE MARK:** Grounds for expunging improperly registered trade mark

"Section 38 (1) of the Trade Marks Act provides as follows: 38 (1) Any person concerned who alleged -

(c) that any entry wrongly remains on the register; may apply in the prescribed manner to the Court or at the option of the applicant and subject to Section 56 of this Act, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal thinks fit.

Section 31 of the Trade Marks Act also provides as follows:

(1) Subject to this and the next following section, a registered trade mark may be taken off the register in respect of any goods in respect of which it is registered on an application made by any person concerned to the Court or, at the option of the applicant and subject to Section 56 of this Act, to the Registrar, on either of the grounds set out in Subsection (2) of this section.

(2) The said grounds are -

(a) That the trade mark was registered without bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bonafide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

(b) That up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.

(3) The tribunal may refuse an application made under this section on either of the said grounds if it is shown that before the relevant date or during the relevant period, as the case may be, there has been bona fide use of the trade mark, by any proprietor for the time being thereof, in relation to goods of the same description as the goods to which the application relates, being goods in respect of which the trade mark is registered: Provided that where on any such application it is shown as aforesaid, the tribunal shall not refuse the application -

(a) if the applicant has been permitted under Section 13 (2) of this Act to register an identical or nearly resembling trade mark in respect of the goods in question; or

(b) if the tribunal is of the opinion that the applicant might properly be permitted to register such a trade mark.

(4) An applicant shall not be entitled to rely for the purposes of Subsection (2)(b) of this section, on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates." Per OGUNWUMIJU, J.C.A. (Pp. 35-36, Paras. A-F) - [read in context](#)

5. **INTELLECTUAL PROPERTY - TRADE MARK:** Essential particulars a trade mark must consist of for it to be registrable under Part A of the register

"...the fact of invention is not of total importance to the issues regarding the registration of the Appellant's trade mark Ariel. Let us look at the provisions of Section 9 of the Trade Marks Act. It provides as follows:

"In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register it must contain or consist of at least one of the following essential particulars -

1. The name of a company, individual or firm, represented in a special or particular manner;

(a) The signature of the applicant for registration or some predecessor in his business;

(b) An invented word or invented words

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

(d) Any other distinctive mark:

Provided that a name, signature or word other than such as fall within paragraphs (a) to (d) of this section shall not be registrable under paragraph (e) of this section, except upon evidence of its distinctiveness.

2. For the purposes of this section, 'distinctive' means adapted in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods within which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration. In determining whether a trade mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which -

1. The trade mark is inherently adapted to distinguish as aforesaid; and

2. By reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."

It is apparent from the provisions of the section and I quite agree with the learned Appellant's counsel that even though invention of a mark is one of the ways through which a trade mark can be registered, it is not the only way.

Section 9 provides for additional ways. The Appellant has claimed that it was the first to register the word 'Ariel' in respect of goods in class 3, part A of the Register of trademarks and this, in my humble opinion confers on the trade mark the quality of distinctiveness in relation to the goods for which it was registered; more so, since the 1st Respondent has not shown that the Appellants were not the first to use the mark in relation to detergents." Per OGUNWUMIJU, J.C.A. (Pp. 70-71, Paras. A-G) - [read in context](#)

6. **INTELLECTUAL PROPERTY - TRADE MARK:** Whether trade mark protection applies to subsidiaries of a company

"...I agree with learned Appellant's counsel that the only person to question the authority of Procter & Gamble Nigeria limited to use the trade mark is the Appellant. The Chancery Division in England in *Budejovicky Budvar Narodni Podnick v. Anheuser Busch Inc* (2008) EWHC 263 ch held that "use may be by a third party with authority to use the mark." That may be the interpretation of the legislation where the case emanated from. However, there is nothing in the Trade Marks Act which implies that the definition of use cannot be taken to encompass the acts of a third party or a subsidiary of the proprietor company. In *American Cynamid Company v. Vitality Pharmaceuticals Ltd* (1991) 2 SCJN 42, the Supreme Court held that trade mark protection is available under Section 7 of the Trade Marks Act to a successor company. See also *DYKTRADE LTD V. OMNIA NIG. LTD* (2000) 7 SCJN 90; *FERODO LTD V. IBETO INDUSTRIES LTD* (2004) 2 SCJN 71." Per OGUNWUMIJU, J.C.A. (P. 58, Paras. A-E) - [read in context](#)

**7. INTELLECTUAL PROPERTY - TRADE MARK:** Position of the law on the issue of use and non-use in accordance with the provisions of the Trade Marks Act

"Let me first determine the issue of use and non-use in accordance with the provisions of the Act. I have earlier on in this judgment set out the relevant provisions of the Act. I agree with the view of the learned senior counsel for the Appellant and his team which the 1st respondent conceded to that the learned trial judge misinterpreted Section 31 of the Trade Marks Act. It is trite that once the provision of a statute is clear and unambiguous, the Court must give effect to its literal meaning. See *Tobi JSC in BUHARI V. YUSUF* (2003) NWLR Pt. 841 Pg. 46 at 477; *Abayomi Babatunde v. Pan Atlantic Shipping and Transport Agencies Ltd* (2007) 4 SCNJ 140. To make a finding of non-use of the trade mark under Section 31- (2) (a), two conjunctive elements must exist. They are:

1. At the time of registration, the trademark was registered without bona fide intention to use same; and
2. A month before the application to remove a trade mark is made, there has been no bona fide use of the trade mark in relation to those goods by a proprietor thereof .

It is my humble but firm view, after reviewing the evidence that there was no proof before the trial Court that at the time of registration, the Appellant had no intention of bona fide use of the trade mark. We must remember that the onus of proof is on the 1st Respondent seeking to have the trade mark removed from the Register for non-use, to prove both essential elements of non-use.

Needless to say, the word 'and' in Section 31 (2) (a) shows that both elements are conjunctive and must be so construed. See *NDOMA - EGBA V. CHUKWUOGOR* supra .

Thus, the applicant to remove a trade mark must prove intention not to use the trade name ab initio at registration and also that there has been no bona fide use of the name by the proprietor up to the date one month before the date of the application. The learned trial judge did not make a finding on the above concurrent scenario under Section 31 (2) (a). However the Court at page 781 of the record held as follows while interpreting Section 31 (2) (b):

"The registered trade mark may be taken off the Register if there is failure to use the mark for a period of five years from the date of registration."

The learned trial judge concluded at page 788-789 of the record that:

"...a trade mark which remains in the register for a period of 38 years without being used in relation to the goods that it was registered has become generic and has fallen into public domain and so can be used by anybody and can be expunged from the Register. I hold therefore that the Plaintiff is no longer entitled to the exclusive use of the registered Trade Mark word ARIEL in Nigeria." In the first instance, it is clear that in Section 31 (2) (b), the intention of the law maker is that five years counting backwards from within a month of the application is the computation time and not five years from the date of registration .

In paragraph 35 of the Appellant's brief at pg. 22-23, the Appellant set out three possible scenarios for the computation of time in respect of Section 31 (2) (b). The 1st Respondent's counsel also agreed with the three scenarios and adopted same in paragraph 4.14 of his brief. The three scenarios succinctly put are stated below:

1. Scenario A - 13/11/1995 - 13/11/2000

2. Scenario B - 17/06/1993 - 16/06/1998

3. Scenario C - 6/06/2000 - 07 /06/2005

The above means that the 1st Respondent applying that the Appellant's trade mark be expunged must prove that during any of the periods set out in the above scenarios, the Appellant had not made bona fide use of the trademark in Nigeria. The trial Court did not make an analysis of the time frame as required under Section 31, but as seen above, gave an outright wrong interpretation to Section 31 (2) (b). A recurring factor in both grounds (Section 31(2) (a) & (b)) is that non-use is computed from a month before the application to expunge the trade mark is made. The difference lies in the first ground dating back to the time of registration, while the second ground dates back five years. In essence, the first ground consists of two elements that must exist concurrently before an order of removal can be made. The second ground has just one element: a continuous period of non-use for five years preceding a month before an application for removal is made. There is no doubt that Section 31 is a prescriptive legislation which seeks to limit or remove a proprietor's trade mark from the Register of trademark. In *Okotie-Eboh V. Manager* (2004) 18 NWLR Pt. 905 Pg. 242 at pg 282-283, *Edozie JSC* held as follows:

"Statutes which encroach on the rights of the subject, whether as regard person or property, are construed as penal laws fortissimo contra preferences; that is, strictly in favour of the subject."

Similarly, in *Provost Lagos State College of Education & Ors v. Dr. Kolawole Edun & Ors* (2004) 6 NWLR Pt. 870 Page 476 @, *Tobi JSC* held that:

"It is settled law that expropriatory statutes which encroach on a person's proprietary rights must be construed fortissimo contra preferentes that is strictly against the acquiring authority but sympathetically in favour of the citizen whose property rights are being deprived." Also, in *Golden Victor Nangibo v. Uche Okafor & Ors* (2003) 14 NWLR Pt. 839 Pg.78 2@ ..... Onu JSC stated thus:

"Where a statute confers a power and particularly one which may be used to deprive the subject of proprietary rights, the Courts confine those exercising the power to the strict letter of the statute."

The learned trial judge, with respect, in my view took a rather narrow view of the interpretation to be put on the meaning of 'bona fide use'. In attempting to define 'use' the trial Court had recourse to Section 5(2) (b) of the Act.

Section 5 (2) provides:

"Without prejudice to the generality of the right to 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 trade mark 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 render the use of the mark likely to be taken either -

a. as being used as a trade mark; or

b. in a case in which the use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade."

At page 783 of the record, the trial Court held as follows:

"It must be noted that the provision makes it clear that the advertising circular or other advertisements must be issued to the public.

Though the Trade Marks Act does not define the 'public'. I dare say that it can only be public with regards to the country in which the trade mark is registered. The public in this instant case can only mean in my view, the Nigerian public. The advertisement must therefore be directed to the Nigerian public in order to qualify as advertisement within the necessary intendment of Section 5(2) (b)..."

The analysis of the learned trial judge is to the effect that we should ignore international publications of advertisements in foreign media, notwithstanding that sizeable sections of the public access such media. The critical factor here, and I share the view of the Appellant, is that an impression must have been made to the Nigerian public that this product with this reputation exists and is available for purchase in this country. I do not agree with learned 1st respondent's counsel's view that the Appellant's counsel was merely being theoretical in his analysis of what impels proprietors of international trade marks to advertise in the international media. I agree that an obvious consideration by the proprietor of an international trade mark - a trade mark such as in this case, registered in over 120 countries, would be a clear intention to reach as many consumers as possible in as many countries. Be that as it may, all the above and the opinion of the learned trial judge as to whether or not the Nigerian public is aware of the trade mark as associated with the Appellant are merely speculative and the Court cannot deprive a proprietor of a right on mere negative speculation. Both counsel quoted the European Court of Justice decision in *ANSUL BV V. AJAX BRANDBEVEILIGING BV* (C-40/01) (2003) RPC 40. It is also reported in (2005) Ch.97; (2004) 3 WLR 1048, (2003) ECR I-2439. I am persuaded by the definition given by the learned Justices of the European Court and I will restate them here. The learned Justices held inter alia that:

a. 'Genuine use' must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

b. It follows that 'genuine use' of the mark entails use of the mark on the market for the goods or services protected by that mark.

c. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the term of advertising campaigns.

d. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

e. Assessing the circumstances of the case may thus include giving consideration, inter alia, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market .

Taking into consideration the above definition of 'genuine use' or 'bona fide use', can it be truly said that given the evidence of proof of use proffered at the trial, the Appellant has not engaged in bona fide use of the trade mark in the years before the 1st Respondent's application was made? I think not. The Appellant referred us to numerous exhibits and the evidence of PW1 in aid of their proof that indeed they made bona fide use of the trade mark at all material times relevant to the retaining of its use. I have to agree with the Appellant as postulated in its brief that many jurisdictions have developed functional jurisprudence on the connotation of 'genuine use' or 'bona fide use'. In trade mark terms, Courts in the United Kingdom have interpreted 'use' in a broad sense to mean 'use in the context of a commercial activity with a view to economic advantage'. See *ARSENAL FOOTBALL CLUB V. MATHEW REED* (2003) RPC 281 at 292 and *PHILIPS V. REMINGTON* (1999) RPC 809."Per OGUNWUMIJU, J.C.A. (Pp. 45-54, Paras. F-A) - [read in context](#)

8. **INTELLECTUAL PROPERTY - TRADE MARK:** Requirements of the law as regards the issue of trade mark protection and the essence of a trade mark; what a plaintiff must prove to establish infringement of a trade mark

"I must say here that the issue of trademark protection has been the subject of several Supreme Court cases. In *Dyktrade Ltd v. Omnia Nig. Ltd* (supra), it was held that the rights conferred by the registration of a trade mark on the proprietor is the exclusive use and right to sue for infringement. Thus in *Ayman Enterprises Ltd v. Akuma Industries* (2003) 6 SCNj 307, the Supreme Court set out what the plaintiff needs to prove to establish an action for infringement of a trade mark. The Plaintiff must establish his title either as proprietor or as a registered user entitled to sue. He must then prove that the defendant has acted or threatens to act in a way as to infringe the right conferred upon him by the registration of the trademark under the Act.

In *Ferodo v. Ibeto* (supra), the Supreme Court held inter alia as follows:

1. The essence of a trade mark is that it indicates a connection in the course of trade between the goods and some person having the right to use the name. A trade mark can also be defined as a distinctive picture which would indicate to a purchaser of an article bearing it the means of getting the same article in future by getting an article with the same mark on it.

2. A mark, in this connection, includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. A trademark, on the other hand is a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate a connection in the course of trade between the goods and some person having the right either as a proprietor or a registered user to use the mark. An action for infringement will therefore lie where a competitor uses a registered trade mark in connection with proprietor's goods for the purpose of confusing them with his own goods in the same class.

3. In deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like. Evidence is admissible to show which of the features shown in the register in this case are essential and which are inessential so as to be unimportant in deciding questions of infringement.

4. It is not all the features that are contained in the mark that are important for the purposes of the infringement of the trade mark. Not all the components are to be considered as forming part of the trademark. The resemblance giving rise to infringement must lie in the basic idea of the mark. Applying these analogous situations to the instant case, evidently, the subsequent trade mark regardless of the suffix Automatic (which had been disclaimed) is identical with the Appellant's 'Ariel'. The specific products which both trademarks relate to in the factual circumstance are detergents. The Trademark or name used by both proprietors is the word 'Ariel' which prefix all other descriptions or get up by the parties. Whether it is Ariel Devise or Ariel Automatic the prefix Ariel is the key name or key mark. Indeed that was the point made by the Supreme Court in *Ferodo v Ibeto* to the effect that 'Ferodo is the trade mark and other suffix or get up names imitated by the competition is not an infringement of the name 'Ferodo'. In this case, it is therefore apparent that both parties use the principal name Ariel to market their products. Apart from the word Ariel all other descriptions are irrelevant. Therefore in my humble view, use of the word 'Ariel' by both marketers is a recipe to create confusion in the mind of the average consumer the different packaging etc notwithstanding. This is more as they both advertise the same products. In *AAH Pharmaceuticals* cited (supra), the claimant was the proprietor of the trade mark "Vantage" for operating incentive schemes". The defendant operated a loyalty card scheme under the words "Vantage Rewards". The Court held that the marks were identical because the word "Reward" was merely descriptive of the services offered.

Having said that, it is also important to note the learned Appellant's counsel's reference to international treaties in paragraph 98, page 47 of the Appellant's brief. Appellant's counsel argued that Nigeria as a treaty member of the World Trade organization (WTO) has, by reason of its membership, agreed to shape its domestic laws and policies in a manner consistent with 'Agreement on Trade Related Aspects of Intellectual Property Rights' (TRIPS Agreement 1994). As such, there is a presumption of a national will to align with the provisions of the Agreement. Section 2 of the Agreement which deals with trademarks, counsel reinforced, requires in general terms that member countries protect well-known marks. Without being able to confirm executive or legislative ratification of this TRIP agreement as binding on Nigeria it is difficult to interpret the law in that record. However, the jurisprudence that seems to run through our case law in Nigeria has favoured liberalism in interpreting trade mark Act to favour a proprietor of a named brand. I am persuaded by that approach I feel that Nigerian Courts must align with the comity of nations to protect well known trademarks. We must enforce the Trade marks laws and understand the raised detre of the laws which ensures protection of brand names from imitation and the like. The Appellant's trade mark is not only well-known internationally, it has also been the subject of prior legal registration under the Trade Marks Act in Nigeria. I feel strongly that the Trademark Ariel associated with the appellant should enjoy the protection of the Courts."Per OGUNWUMIJU, J.C.A. (Pp. 63-67, Paras. D-B) - [read in context](#)

**(Delivering the Leading Judgment):** This is an appeal against the Judgment of Honourable Justice Abdullahi Mustapha sitting at the Federal High Court, Lagos Judicial Division delivered on the 17th day of December 2007.

This Appeal relates to the ownership of a Trade Mark. Sequel to the futile attempt of the Appellant to register the trade mark, "Ariel and Atomium Device" after having initially registered the trade mark "Ariel", the Appellant as Plaintiff instituted Suit No: FHC/L/CS/777/98 at the Federal High Court, Lagos Division, challenging the registration of the 1st Respondent's trade mark, "Ariel Automatic". The Plaintiff's suit is subject of this Appeal.

To get a better understanding of the facts which led to this appeal, it is best to set out the undisputed facts as gleaned from pages 741-751 of the record and set out in the judgment of the trial Court.

The Plaintiff, now Appellant filed a suit at the trial Court on the 17th of July 1998 claiming as follows:

- 1. A declaration that the Plaintiff, being the earlier registered proprietor since 3rd December 1969 of the Trade Mark "ARIEL" in respect of goods/products listed in Class 3 as No. 21233 of the Trade Marks Register in Nigeria, and also being the proprietor of over 600 identical trademarks some with additional suffixes spanning over 160 countries since 1921, is entitled to the exclusive use of the said Trade Mark in relation to goods of the said class.**
- 2. A declaration that the Plaintiff having applied to register its Trade Mark "ARIEL Atomium Design under No. TP 9505 in respect of goods/products Registration by the Registrar of Trade Marks in 1991 and the Plaintiff also being the proprietor of several identical trademarks spanning over 50 countries is entitled to the exclusive use of the Trade Mark in relation to goods of the said class.**
- 3. A declaration that the 1st Defendant's act in procuring the registration of the trademark "ARIEL Automatic" and Atomium device, with the inscriptions "New improved", in the same class and with identical 'get up' as the Plaintiffs earlier used and registered Marks knowing that the Plaintiff's mark and products were registered and extensively used worldwide is deceitful, and an infringement on the Plaintiff's Trade Mark as registered in Class 3 of the Trade Mark Register.**
- 4. An order compelling the Registrar of Trade Marks (2nd Defendant herein) to rectify the Register of**

**Trade Marks by expunging/striking out the 1st Defendant's Trade Mark "Ariel Automatic" and Atomium device listed in Class 3 as No. 46673 of the Trade Marks Register as the registration of the mark was unlawful, contrary to law, and is a deceitful duplication of an earlier registered mark and likely to cause confusion.**

**5. An injunction perpetually restraining the 1st Defendant by itself and or through its servants, agents, subsidiaries or any person or persons connected with it or acting under its authority from using or attempting to use the Plaintiffs trademark similar to or identical to the Plaintiffs said Trade Mark(s).**

The 1st Defendant in their amended statement of defence and counter-claim dated 24th April 2006, counter claimed as follows:

- a. An order of this Honourable Court on the second defendant to rectify the trade mark ARIEL simpliciter registered as No. 21233 in favour of the Plaintiff by expunging the same therefrom on the ground that the said trade mark has been wrongfully remaining on the register of trade mark.**
- b. Perpetual injunction restraining the Plaintiff, its servants, agents, subsidiaries or any person or persons connected with it or acting under its authority from registering or attempting to register ARIEL with or without Atomium, Atomia, or Automatic as trade mark in Nigeria; and also perpetual injunction restraining the second defendant from accepting the same from the**

**Plaintiff, its servant, agents, subsidiaries or any person or persons connected with it or acting under the authority for registration as a trade mark in Nigeria.**

In proof of their case, the Plaintiff called one witness through whom 19 documents were tendered and admitted in evidence as Exhibits and put in evidence one document through DW1. The Defendant in proof of their defence and counter claim also called one witness through whom 10 documents were tendered and admitted in evidence as Exhibits.

The Exhibits put forth by the Plaintiff are as follows:

1. Power of Attorney dated 1/7/2004 (Exhibit A)
2. Power of Attorney dated 2/7/2004 (Exhibit A.1)
3. Record of Data Base for Trade Mark ARIEL Page 16 of which contains particulars of Registration in Germany (Exhibit B)
4. Certificate of Registration of ARIEL Trade Mark in Nigeria No. 21233 (Exhibit B.1)
5. Certificate of Renewal of registration of the Trade mark ARIEL in 1976 (Exhibit B.2)
6. Certificate of renewal of Registration of the Trade Mark ARIEL in 1990 (Exhibit B.3)
7. Sachet of the Plaintiffs ARIEL detergent (Exhibit C)
8. Magazine picture of ARIEL AUTOMATIC (Exhibit C.1)
9. Copy of TIME MAGAZINE of 12/4/1984 (Exhibit C.2)
10. Copy of TIME MAGAZINE of 26/3/1984 (Exhibit 19



C.3)

11. Carton of ARIEL and Device (Exhibit C.4)
12. Poster of ARIEL and Device (Exhibit C.5)
13. Certified copy of Certificate of registration of ARIEL dated 27/3/85 in the name of the 1st defendant (Exhibit D)
14. Certificate of Reward of registration of trade mark No.46673 (Exhibit D.1)
15. The 1st Defendant's product NEW GLOBAL ARIEL (Exhibit E)
16. 1st Defendant's product ARIEL DETERGENT POWDER (Exhibit E.1)
17. The Book "Jewel of Nigeria Commerce" (Exhibit E.2)
18. Acceptance Form for Atomium Design (Exhibit B.40)
19. NAFDAC Certificate of registration No. 020757 in respect of ARIEL POWER DETERGENT dated 8/5/1998 issued to Procter and Gamble Nigeria Limited (Exhibit B.5)
20. Certificate of registration of ARIEL Automatic tendered by the Plaintiff through DW1 during cross examination.

The Exhibits put forth by the 1st Defendant are:

1. Trademarks Journal No. 24 Vol. 14 of August 1988 (Exhibit F)
2. Product of the 1st Defendant i.e. NEW GLOBAL ARIEL (Exhibit G)
3. Way bills and Sales Invoices which the 1st Defendant used in selling and distributing its products (Exhibit G.1)
4. Trade Mark Journal No.1 Vol. 3 of 4/1/2000 P. 20

125 wherein Plaintiff applied to register Atomism as a trade mark (Exhibit H)

5. Copy of the opposition filed by 1st Defendant Agent against registration sought by the Plaintiff of Atomium Device (Exhibit H.1)

6. Trade Marks Journal No. 1 Vol. 1 of 10/6/2002 Page 43 wherein Plaintiff applied to register Atomium with ARIEL as a Trade Mark on 15/7 /98 (Exhibit H.2)

7. Copy of 1st Defendant opposition to registration of Exhibit H.2 filed by the 1st Defendant (Exhibit H.3)

8. Copy of Trade Marks Journal No. 5 Vol. 5 of November 2002 Page 44 wherein Plaintiff applied to register Atomium Device (Exhibit H.4)

9. Copy of opposition to registration of Exhibit H.4 by 1st Defendant (Exhibit H.5)

10. Fax letter dated 26/2/02 from the Regional Manager West & East Africa of Procter & Gamble addressed to DOYIN INDUSTRIES for the attention of Prince Dr. Samuel Adedoyin. - Exhibit J.

The Plaintiffs case is that it is the proprietor of the trade mark ARIEL which it invented since 1921 and that the mark is associated with Atomium Device in respect of detergents, bleaching preparations and other substances for laundry use manufactured and sold worldwide. It has registered over 600 different ARIEL related marks in 120 countries including Nigeria. It has extensively advertised goods branded with the ARIEL mark in the International press including Nigeria and by way of circulars to the trade magazines. It

registered ARIEL as a trade mark in Nigeria in December 1969 as evidenced by the Certificate of Registration No. RTM 21233 of 3rd December 1969 (Exhibit B.1).The registration was duly renewed at due dates in 1976 and 1991 respectively (Exhibits B2 and B3).

As the registered Proprietor of the ARIEL trade mark, the plaintiff is said to have used the trade mark since 1969 to date in relation to goods indicating a connection in the course of trade between the goods and itself as proprietor within and outside Nigeria as buttressed by Exhibits C, C1, C2, C3, C4 and C5.

The Plaintiff, in order to further secure its trade marks, applied in 1990 for the registration of Atomium Device which it regularly used in association with its ARIEL trade mark. The 2nd Defendant issued to the Plaintiff an acknowledgment and Acceptance form under No. TP 9509 indicating the acceptance of its application. (Exhibit B4)

Evidence was led to show that the Plaintiffs product "ARIEL" was duly registered by the National Agency for Food and Drug Administration and Control conveying Certification to the Plaintiff as the Importer, Manufacturer and Seller of ARIEL brand of detergent powder within the Nigerian market. The Registration certificate issued by NAFDAC i.e. Exhibits B5 is dated 18th May 1998.

The Plaintiff discovered sometime in 1998 that the 2nd Defendant accepted from the 1st Defendant, an application to register and actually

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registered ARIEL and Atomium Device as a trade mark in Class 3 in the name of the 1st Defendant as Proprietor in 1985 (Exhibit D). Exhibit D was said to have been issued to the 1st Defendant when the trade mark registration for "ARIEL" in the name of the Plaintiff as the proprietor was still subsisting and valid and under prohibitive circumstance. The get up/trade dress of the 1st Defendant's product branded NEW GLOBAL ARIEL (Exhibit G) is said to be an exact and or similarly identical copy of the Plaintiffs product sold, marketed and advertised all over the World including Nigeria.

The 1st Defendant's case is that in 1985, the 1st Defendant applied to register ARIEL with Device as a Trade Mark and that before the application, it searched the Register of Trade Marks and all new pending applications in the Registry to see if there was any similar or identical trade mark to the one that the 1st Defendant wanted to register. It was found out that there was none and so the Defendant submitted its application for registration for its trade mark and it was accepted by the 2nd Defendant. The 1st Defendant was given No. 46673. Subsequently, the application was advertised in the Trade Marks Journal No. 14 Volume 14 of 31st August 1988 in respect of goods in Class 3 (Exhibit F). No Notice of opposition was received from anybody. After the expiration of 60 days and there being no notice of opposition received, the 1st Defendant applied for Certificate of Registration and was given No. 46673 as its Certificate of Registration by the 2nd Defendant

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(Exhibit D). The 1st Defendant renewed the Certificate in 1992 and obtained Certificate of Renewal of Registration (Exhibit D.1).

Since 1985 when the 1st Defendant registered its ARIEL with device, it has been selling and distributing soap powdered detergent with it. The soap, detergent which the 1st Defendant has been selling and distributing as its product i.e. NEW GLOBAL ARIEL was tendered and admitted in evidence as Exhibit G. The 1st Defendant has been selling its product throughout Nigeria and other ECOWAS countries. In proof of this, the 1st Defendant put in way bills and Sales invoices (Exhibit G.1).

However, in January 2000, the 1st Defendant discovered on Page 125 of the Trade Marks Journal No.1 Volume 3 dated 4th January 2000 (Exhibit H) that the Plaintiff had applied to register Atomium as a trade mark with the 2nd Defendant in respect of cosmetics which is one of the items in Class 3 and that the Plaintiff was given No. 9505. The 1st Defendant therefore filed a notice of opposition to the registration (Exhibit H.1). Again in the year 2002, the 1st Defendant discovered on page 43 of Trade Marks Journal No.1, Vol. 1 of June 2002 (Exhibit H.2) that the plaintiff had applied to register Atomium with ARIEL as a trade mark on 15th July 1998 in respect of goods in Class 3 and was given No. 37505 as a reference. The 1st Defendant opposed the registration and filed a notice of opposition with the 2nd Defendant (Exhibit H.3). In November 2002, the 1st

Defendant again discovered that the Plaintiff again applied to register Atomium Device as a trade mark which was advertised on page 44 of the Trade Marks Journal No. 5 Vol. 5 of November 2002 (Exhibit H.4). The 1st Defendant opposed the registration and filed a notice of opposition (Exhibit H.5). The Plaintiff then sued the Defendants claiming the reliefs already set out above.

Issues were joined by the parties and after hearing the case, the Federal High Court on December 17th, 2007 dismissed the Plaintiffs claim and entered judgment in favour of the 1st Defendant/Respondent, granting part of the counter claim. The Plaintiff being dissatisfied with the judgment has brought this appeal.

The Appellant's brief dated 22nd of June 2010 was filed on the 23rd of June 2010 and deemed filed on the 22nd of November 2010. Appellant's Reply brief and Respondent's brief to the Cross - Appeal was dated 19th of January, 2011 and was filed the same day. The 1st Respondent's brief and Cross -Appeal dated 24th of December 2010 were filed the same day.

Counsel to the Appellant, Professor Yemi Osinbajo, Chief Ladi Taiwo, Babatunde Irukera, Victoria Alonge (Mrs), Ayo Kusamotu and Ikem Isiekwena identified four issues for determination as follows:

**1. The 1st Respondent's counterclaim specifically requested a relief of rectification of the register on the basis that ARIEL was not invented and unregistrable under the Act and as such, had wrongly remained on the Register. The lower Court**

granted a relief to expunge ARIEL from the Register on the basis of non-use by the Appellant. Is the lower Court's decision to grant a relief not requested specifically or in the alternative valid as a matter of law? (Distilled from Ground 8 of the Grounds of Appeal).

2. The lower Court found that ARIEL was invented by the Appellants.

The lower Court then concluded that ARIEL had become "generic" and the Appellant was no longer entitled to the exclusive use of "ARIEL" in Nigeria under Section 31 of the Trade Marks Act Chapter T13 Laws of the Federation of Nigeria 2004. Is the lower Court's application and interpretation of Section 31 of the Trade Marks Act valid as a matter of law? (Distilled from Grounds 1, 4 & 7 of the Grounds of Appeal).

3. Considering the lack of pleadings and the totality of evidence, whether the lower Court wrongly evaluated the evidence in concluding that a case of non-use under Section 31 of the Trade Marks Act has been established by the Respondent (Distilled from Grounds 1, 2, 3, 4 and 9 of the Grounds of Appeal).

4. Whether the Lower Court's decision validating the subsequent registration of the similar Trademark, ARIEL Automatic with Atomium device, by the 1st Respondent during the existence of the Appellant's valid registration of ARIEL is valid as a matter of law. (As distilled from Grounds 5 & 6 of the Grounds of Appeal).

On the other hand, Counsel to the 1st

Respondent, Tunde Akinrimisi identified three (3) issues for determination as follows:

- 1. Whether the Learned Trial Judge granted to the 1st Respondent (1st defendant at the Trial Court), a Relief not sought for. (Appellant's issue One)**
- 2. Whether or not the Appellant, (The Procter and Gamble Company) made trade use of the Trade Mark, Ariel in Nigeria sequel to the registration thereof in 1969. (Appellant's Issues Two and Three)**
- 3. Whether taking into consideration the general circumstances of this case, the registration of the 1st Respondent's Trade Mark, "Ariel Automatic" was valid. (Appellant's Issue Four)**

I shall adopt the issues as crystallised by learned 1st Respondent's counsel as they appear to me to be precise and couched in less cumbersome terms than the issues couched by the Appellant's counsel. Suffice it to say both sides agree on the scope of the issues for determination.

#### ISSUE ONE

Counsel to the Appellant argued that it was wrong of the lower Court to grant a relief not requested for by the 1st Respondent. They claimed that the 1st Respondent had, in its counter claim specifically requested a relief of rectification of the Trade Marks Register on the ground that "ARIEL" was not invented and was not registrable under Section 9 (1) of the Trade Marks Act and had wrongly remained in the Register of Trade marks. They referred this Court to the 1st Respondent's counter claim on Page 206-209, Volume 1 of the

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Records. They argued that since the 1st Respondent's relief was premised entirely on "non-registrability" rather than non-use under Section 31 of the Trade Marks Act, it was improper and perverse for the lower Court to have ordered the removal of the Appellant's trade mark "ARIEL" from the Register of Trade Marks on the basis of non-use especially after it had disagreed with the 1st Respondent on the issue of invention.

Counsel further emphasized the fact that the 1st Respondent's basis for requesting a relief for rectification was that "ARIEL" was not invented and therefore not-registrable ab initio under Section 9. They stated that the 1st Respondent had claimed that ARIEL was a variation of ARIES and was therefore not invented and distinctive to pass one of the alternative tests under Section 9. Counsel submitted that the rectification sought by the 1st Respondent in this respect is one prescribed by Section 38 (1) (c) of the Trade Marks Act. Appellant's counsel opined that it was the relief under the above procedure that was requested by the 1st Respondent and not the one under Section 31 that was transposed by the lower Court. They averred that the grounds and reliefs for an application under Section 31 are distinct and separate from rectification contemplated by Section 38. They further averred that Section 31 refers to removal and that this was not specifically prayed for by the 1st Respondent in its counter claim.

Counsel went further in an attempt to distinguish the reliefs of removal and rectification to submit

that both are different in scope and meaning. He sought reliance in the Black's Law Dictionary 8th Edition. Rectification as defined in Black's law Dictionary 8th Edition is a process by which a person whose name was wrongly entered or omitted from a record can compel the recorder to correct the error. Counsel argued that the definition of rectification is different from removal as contemplated by Section 31 of the Trade Marks Act.

Counsel further argued that an applicant under Section 31, in addition to specifically praying for a removal based on the grounds stated in Section 31, would also have had to plead facts to show its interest as a person concerned and facts to show either of the grounds specified under the Section. Counsel then contended that there was nothing in the 1st respondent's counter claim in the nature of an application under the said section.

Counsel also submitted that the lower Court's magnanimity in granting a relief not requested is wrong as a matter of law and should be set aside. They cited **NALSA AND TEAM ASSOCIATES V. NIGERIAN NATIONAL PETROLEUM CORPORATION (1991) 8 NWLR (pt.212) 652 at 679 PER KARIBI-WHYTE JSC; A.G. ABIA STATE V. AG. FEDERATION (2006) 16 NWLR (Pt. 1005) 265 at 388 PER TOBI JSC**. They further submitted that a Court should not and cannot make a case for the parties which is different from what they set out in their pleadings. They cited **ISHOLA V. UNION BANK (2005) 2 SC (Pt. 11) 80 at 89**.

They further averred that even if it is presumed that a relief for removal was made by the 1st respondent, the lower Court misapplied and misconstrued the provisions of Section 31 of the Trade Marks Act. They then urged this Court to reverse the lower Court's decision and resolve the issue in favour of the Appellant.

In response, Counsel to the 1st Respondent claimed that the Appellant's allegation that the learned trial judge granted the 1st Respondent a relief not sought was erroneous.

Counsel argued that from the reliefs sought, the 1st Respondent had asked for an order of Court for rectification of the Register of Trade Marks by expunging the Appellant's registration from the register. He submitted that rectify means to correct or amend and expunge means to remove. He argued that it was incontestably evident throughout the trial at the lower Court that the basis for the assertion that the Appellant's trade mark "Ariel" wrongfully remained on the Trade Marks Register was on account of its non-use. He further argued that by virtue of Section 31 of the Trade Marks Act, where a trademark is not used and a non-use situation arises as provided by the Act, it is deemed to be wrongly remaining on the Register and consequently, upon request can be expunged and the register rectified to reflect such.

Counsel argued that quite contrary to what the Appellant had claimed in his brief of argument, the issue of usage or non-usage of the trade mark "Ariel" was dealt with at the Trial Court by both

parties and that the reliefs sought by the 1st Respondent were in actual fact tied to it. He claimed that the Appellant at the lower Court had raised the issue of its trade use of the trade mark in its statement of claim and had given evidence both oral and documentary in proof thereof. Counsel referred this Court to Exhibits C1, C2 and C3 (pages 384-392 of the Records) and Exhibit B5 (Pages 382-383), which the Appellant had relied on to establish its trade use of the trade mark "Ariel" in Nigeria. He also claimed that the Appellants had led evidence through PW1 (pages 187 - 193 of the Records) to show that it made trade use of the trade mark. He further claimed that most of the Appellant's grounds of Appeal before this Court were primarily premised on the issue of usage or non-usage of the trade mark in Nigeria by the Appellant and that the 1st Respondent had joined issues with the Appellant with regard to the use of the trade mark ARIEL and thus raised the issue of non-use under Section 31 of the Trade Mark Act.

Counsel conceded that the 1st Respondent had indeed joined issues with the Appellant on whether it was the Appellant that invented the word 'Ariel', but insisted that this was not the only basis for the reliefs sought by the 1st respondent and that both parties had at the lower Court raised and contested the issue of usage which the learned trial Judge rightly dealt with and ruled upon. He averred that the learned trial Judge did not grant a relief that was not sought because the 1st respondent had sought for an order expunging the Appellant's trade

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mark "Ariel" for non use as provided for in Section 31 of the Trade marks Act. He argued that the fact that the 1st Respondent did not mention Section 31 specifically is not fatal to its case; because once a party has established or proved its case with credible, admissible and legal evidence under any law or Act or Rule of Court, it does not matter if it was brought under a wrong section of the same Act or Law, or even under the wrong Act or Law, the party cannot be denied the relief or remedy so claimed. He cited **FRIN vs GOLD (2007)11 NWLR (Pt. 1044) 1; MUDASHIRU VS PERSONS UNKNOWN & ORS (2006) 8 NWLR (Pt. 982) Pg. 267 at 281**

He further contended that on account of Section 31 of the Trade Marks Act, the Appellant's trade mark "Ariel" had no legal basis to remain on the Register of Trade Marks because it was not used by the Appellant, The Procter and Gamble Company as opposed to Procter and Gamble Nigeria Limited. He claimed that both are distinct and separate entities and that it was Procter and Gamble Nigeria Limited that purportedly made trade use of the trade mark in Nigeria and not the Appellant.

He then concluded that the Appellant did not make trade use of the trade mark "Ariel" in Nigeria and as such the trial Court was right in granting the relief to expunge the Appellant's trade mark from the Register of Trade Marks.

The case of the Appellant is that the 1st Respondent never prayed for the Appellant's trade mark Ariel to be removed from the Register under Section 31 of the Trade Marks Act, but rather for

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varying the entry under Section 38(1) of the Trade Marks Act.

Let us look at the judgment of the trial Court from page 777-780 of the record, the trial Court considered the issue of whether the Plaintiff was entitled to the exclusive use of the trade mark Ariel registered on 3/12/69 in respect of goods/ products listed in Class 3 as No. 21233 of the Trade Marks Register. His Lordship stated that the 1st Defendant, now the 1st Respondent failed to show that the trade mark was not an invented word by the Appellant. His Lordship concluded as follows at page 780:

**"In my mind any of the above particulars is enough for the purpose of registering a trade mark under PART A of the Register. The 1st Defendant has failed to show that the word 'ARIEL" is not an invented word. I hold that the word 'ARIEL" is registrable as a trade mark under Section 9 (1) of the Trade Marks Act. It is not descriptive of the character or quality of goods."**

The learned trial judge also made a finding as to whether or not the Appellant made use of the trade name registered as a trade mark. This is because in order to maintain the said mark, it must be put into genuine use in the country in which it is registered. The learned trial judge, putting very heavy reliance on Exhibit J tendered by the 1st Respondent, held that the plaintiff had admitted that it did not come into the Nigerian market until May 1998 and disbelieved the evidence of PW1 that the Appellant had used the trade mark since 1969. His Lordship

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held that the Plaintiff/Appellant did not adduce sufficient evidence of distribution, sale and advertisement of the product in Nigeria within the necessary intendment of Section 5(2) (a) of the Trade Marks Act. His Lordship in further finding that the trade mark had not been put to use, also held that Ariel was not the same trade mark as Ariel Atomium Device.

The learned trial judge also disregarded the NAFDAC registration of the product and trade mark in 1998. Learned trial judge also held the view that Procter and Gamble is different from Procter and Gamble Nigeria Limited and the act of the subsidiary cannot be imputed to the parent company in the absence of an assignment by the parent company to the subsidiary company.

At page 788 of the record, the learned trial judge held that a case of non-use of the registered trade mark by the Appellant had been made out. His Lordship held inter alia at page 788 as follows:

**"The Trade Mark "ARIEL" was in my view registered by the Plaintiff without the BONA FIDE intention of using it in relation to its goods in Nigeria. To my mind a Trade Mark which remains in the Register for a period of 38 years without being used in relation to the goods that it was registered has become generic and has fallen into public domain and so it can be used by anybody and can be expunged from the Register."**

The trial judge in refusing to grant Appellant's relief No. 1 granted the relief No. 1 of the 1st Respondent by expunging the Appellant's trade

mark Ariel from the Register.

Let us look at the relevant legislation. Section 38

(1) of the Trade marks Act provides as follows:

**38 (1) Any person concerned who alleged -**

**(c) that any entry wrongly remains on the register; may apply in the prescribed manner to the Court or at the option of the applicant and subject to Section 56 of this Act, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the tribunal thinks fit.**

Section 31 of the Trade Marks Act also provides as follows:

**(1) Subject to this and the next following section, a registered trade mark may be taken off the register in respect of any goods in respect of which it is registered on an application made by any person concerned to the Court or, at the option of the applicant and subject to Section 56 of this Act, to the Registrar, on either of the grounds set out in Subsection (2) of this section.**

**(2) The said grounds are -**

**(a) That the trade mark was registered without bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bonafide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or**

**(b) That up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was**



a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.

(3) The tribunal may refuse an application made under this section on either of the said grounds if it is shown that before the relevant date or during the relevant period, as the case may be, there has been bona fide use of the trade mark, by any proprietor for the time being thereof, in relation to goods of the same description as the goods to which the application relates, being goods in respect of which the trade mark is registered: Provided that where on any such application it is shown as aforesaid, the tribunal shall not refuse the application -

(a) If the applicant has been permitted under **Section 13 (2) of this Act** to register an identical or nearly resembling trade mark in respect of the goods in question; or

(b) If the tribunal is of the opinion that the applicant might properly be permitted to register such a trade mark.

(4) An applicant shall not be entitled to rely for the purposes of **Subsection (2)(b)** of this section, on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

First of all, I must say that I did not buy the argument of learned Appellants' counsel when he tried to make distinction between rectification and

removal.

When the argument of learned Appellant as proprietor or Trade Mark or the Trade Mark is removed then automatically there occurs a rectification of the Register. The later is a consequence of the other.

I quite agree with the view of learned Appellant's counsel that the circumstances envisaged in Section 38(1) (c) of the Trade Marks Act are quite different from the circumstances elaborately set out in Section 31 of the Act.

The counter claim of the 1st Respondent, in my humble view did not specifically pray for a removal of the Appellant's trade mark on the grounds stated in Section 31. The 1st Respondent needed to prove facts to show its interest as a person concerned and the grounds specified under Section 31.

The two important points made by the learned trial judge are that the trade mark was never used in Nigeria by the Appellant and that the Appellant's status vis a vis the trade mark as registered was different from that of Procter and Gamble Nigeria Limited who was actually using the trade mark.

My problem is the finding of the learned trial Judge that the trade mark was registered without any bona fide intention to make use of it. The international conglomerate, the Procter and Gamble Company registered the trade mark since 1969. I do not think the learned trial judge can make in the circumstances a valid dichotomy between the parent company and the Nigerian subsidiary on the use of the trade mark. I will come

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to that point anon. The parties joined issues primarily in my view on the issue of whether a variation of the trade mark Ariel was registrable for the Appellant because the 1st respondent had objected to its registration by the Appellant because the name was not invented by the Appellant and thus not registrable under Section 9(1) of the Trade Marks Act. It is my view that the issue of non-registrability rather than non-use was the case actually made out by the pleadings and the relief sought by the 1st respondent. There seems to me to be a clear distinction between the issues of whether a trade name was registrable or whether it was un-used.

Thus, the issue of registrability under Section 9 of the Act is different from the issue of non-use under Section 31.

I have to agree with the learned Appellant's counsel that the incidents of registrability are different from the incidents of non-use. Moreover, the trial Court appeared to have removed the Appellant's trade mark under Section 31 of the Act. The circumstances under which Section 31 can be activated is quite different from the circumstances which evolved in this case. I agree with learned Appellant's counsel that the finding of fact by the lower Court that ARIEL was registrable under Section 9 of the Trade Marks Act should have resulted in only one conclusion and the lower Court should have dismissed the 1st Respondent's counter claim on this ground but failed to do so. I cannot agree with the learned trial judge that if the

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mark was registrable by the Appellant it could be expunged for non-use not claimed by the 1st Respondent.

The first issue is resolved in favour of the Appellant.

## ISSUE TWO

I will treat Appellant's issues 2 and 3 together as argued by 1st Respondent's counsel under issue 2. Learned Appellant's counsel argued that the trial Court lapsed into error by misdirecting itself on the interpretation of Section 31 of the Trade Marks Act when it held that the trade mark 'Ariel' had become generic through lack of use.

Counsel argued that the meaning ascribed to non-use by the trial Court is not consistent with the provisions of Section 31 of the Trade Marks Act and the applicable principles of law. Counsel argued that two elements must be satisfied under Section 31 (2)(a) and that these elements are conjunctive since the legislation used the word 'and'. He cited **NDOMA-EGBA V. CHUKWUOGOR (2004) 6 NWLR Pt. 869 Pg. 382 at 409**. Counsel argued that the Court considered non bona fide use in a narrow sense to construe Section 31 of the Act.

The 2nd complaint is that a wrong computation contrary to the provisions of Section 31(2) (a) & (b) was made by the trial judge. It was complained that the Court computed non-use from the time of registration whereas there are three scenarios for computation of time. Counsel set out extensively the three scenarios in paragraph 35 of the

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Appellant's brief as follows:

- 1. The statement of defence and counter claim which the lower Court ostensibly may have regarded as the application under Section 31 is dated December 14th 2000 (it has been amended on four occasions). As such, the relevant initial period for the computation of non-use could be from November 13th 2000, (i.e. a month before the counter claim was filed) five years backward. The relevant period of continuous non-use could be from November 13th 1995 - November 13th 2000;**
- 2. Alternatively, if it is assumed that the period of commencement of the action at the Federal High Court, between the parties is the relevant period, the action commenced on July 17th, 1998. As such, for computation of non-use, the five-year period could start to run from June 16th 1998 (a month before the writ and statement of claim was filed), five years backwards to June 16th 1993;**
- 3. Finally, the statement and counterclaim dated February 1st 2005 that as amended on June 8th 2005; and subsequently on April 24, 2006 contained for the first time a fresh prayer for rectification of the trade mark Register on the basis of non-registrability of ARIEL. Based on this, the relevant period could be March 23 2001 - March 23, 2006.**

Counsel submitted that the trial judge was wrong in computing the relevant period to mean 5 years from the date of registration and that Section 31 being a law that seeks to limit the proprietary right of the Appellant by removing its trade mark from

the Register should have been interpreted strictly for the benefit of the Appellant and not to its disadvantage. They cited **OKOTIE EBOH V. MANAGER (2004) 18 NWLR Pt. 905 Pg.242 at 282 -283.**

Counsel also objected to the fact that the lower Court apparently limited the meaning of 'genuine use' to production, sales and or advertisement while excluding commercially motivated factors such as the necessary regulatory registration of the product with NAFDAC, the advertisements with TIME, and the inscription of the mark on cartons.

Counsel also argued that the trial Court wrongly interpreted Section 5 (2) of the Act but gave it a narrow interpretation by giving the word 'use' a very restrictive meaning.

The other point made by the Appellant's counsel is that the trial Court erred when it held that on account of non-use, the trade mark 'Ariel' had become generic and available in the public domain and thus, the Appellant was precluded from the exclusive use of the word 'Ariel' in Nigeria. Counsel argued that the facts on record and the law do not support the finding of the trial Court that any trade mark which had been registered and not used for a period of 38 years should be expunged due to non-use. Learned counsel then postulated that even if any of the erroneous interpretations adopted by the Court was valid, it would still not have lead to the conclusion of non-use for 38 years where there was evidence before the Court about the Appellant's use in a manner that is not disputed

by the Court as constituting use for several years prior to the ruling in 2007. Presumably, counsel contended that the Court must have calculated the 38 years from registration in 1969 to the current date of its analysis 2007.

Counsel also complained that the trial judge misconceived the word generic in relation to the Trade Marks Act since it was argued that the trial Court held in its judgment from page 740 particularly on page 788 of the record that the Trade Mark ARIEL had become generic, as such it had become part of the public domain. In effect, the Court decided that by the purported non-use under Section 31 of the Trade Marks Act, the trade mark Ariel has become a common name for detergent or soap in the Nigerian market.

Furthermore, counsel argued that the issue of whether the word Ariel had become generic was raised suo moto by the Court and that the decision that Ariel had become a generic name for soaps and detergents was made by the Court without the benefit of any input by way of address from both counsel. Counsel argued that the trial Court tried to fill a legislative gap not apparent in the statute by equating non-use of a trade mark to genericness of the trade mark. Counsel submitted that on the whole, registration of the Appellant's Ariel trade mark ab initio in Nigeria as well as 120 global registrations are based on the mark's registrability as a trade mark and its distinctive nature; and cannot be in any sense construed as a "generic name.

Counsel argued that in arriving at the conclusion that there had been non-use of the trade name, the learned trial judge improperly evaluated Exhibit J and put undue weight on the negative aspects of the exhibit while ignoring the positive aspects of same. Counsel argued that an exhaustive consideration of Exhibit J would certainly have led to a different conclusion by the lower Court. This is because the statement shows clearly that, at a minimum, the ARIEL brand of detergent was in the Nigerian market as at May 1998. The latter part of the statement equally confirms that at the time of writing, the product ARIEL detergent was experiencing volume growth in the Nigerian market and was also subject of high marketing efforts. This, counsel argued is unmistakable evidence of use by the Appellant. He contended that considering the relevant 5-year computation period already set forth above, it is clear that the requirement for a period of continuous non-use is lacking from the evidence before the Court.

Learned Appellant's counsel set out in the brief that apart from Exhibit J which proves use of the trade name, prior to the application to expunge it, other material exhibits and testimony by PW1 were not given adequate weight by the trial judge. He argued that the testimony of PW1, Exhibits B5, C1, C2, C4 & C5 all prove that the Appellant "used" the trade mark in Nigeria. Counsel also argued that Exhibit B which is the proof of international registration of the trade mark demonstrates a clear Bona fide intention to use the trade mark.



Learned 1st Respondent counsel on the other hand, contended that both parties led evidence of whether or not the Appellant made trade use of its trade mark Ariel in Nigeria.

Learned 1st Respondent's counsel conceded that the learned trial judge's calculation of the period of non-use should not have commenced from 1969 as His Lordship ought to have calculated same backwards from the time when the Application to expunge the Appellant's Trade Mark was made. Learned 1st Respondent's counsel also conceded that from the scenario stated by the Appellant's counsel, where a trade mark was not used in the three scenarios stated, it should be expunged for non-use.

Counsel further submitted that when dealing with the issue of trade use of a trade mark, the key word is not 'use of trade mark' simpliciter, but bona fide trade use by the registered proprietor, meaning that there must be bona fide use of the trade mark by whosoever in law is the registered proprietor. He argued that Procter and Gamble Nigeria Limited is quite different from, even though a subsidiary of the Procter and Gamble Company - the Appellant.

Counsel submitted that it is trite that a subsidiary company is distinct, separate and independent from the parent or holding company and consequently, trade use by a subsidiary of the Appellant is not deemed use by the Appellant itself, being a separate legal entity. He cited the case of **M.O KANU, SONS & CO. V. FBN PLC (1998) 11 NWLR**  
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Counsel insisted that he believes that the Appellant is a separate and distinct legal entity from Proctor and Gamble Nigeria Limited and thus Proctor and Gamble Nigeria Limited who was dealing with the trade mark in Nigeria did not have the authority to do so in law in so far as the owner of the trade mark - the Procter and Gamble Company did not grant authority for such usage since authority from a company that did not register the trade mark cannot be deemed to be legal authority.

On the issue of proof of use by the Appellant, learned 1st respondent's counsel argued that the Appellant's reliance on foreign advertisement cannot be said to be advertisement to customers in Nigeria when the Appellant failed to call as its witness any of its customers to establish the fact that the Nigerian public and in particular its customers were aware of its advertisements and publications in relation to the trade mark.

Counsel further submitted that the consequence of non-use of a trade mark by its registered proprietor is that the trade mark falls into public realm and consequently ceases to have legal protection and this means that the trade mark becomes free for general or common use

Let me first determine the issue of use and non-use in accordance with the provisions of the Act. I have earlier on in this judgment set out the relevant provisions of the Act. I agree with the view of the learned senior counsel for the Appellant and

his team which the 1st respondent conceded to that the learned trial judge misinterpreted Section 31 of the Trade marks Act. It is trite that once the provision of a statute is clear and unambiguous, the Court must give effect to its literal meaning. See **Tobi JSC in BUHARI V. YUSUF (2003) NWLR Pt. 841 Pg. 46 at 477; Abayomi Babatunde v. Pan Atlantic Shipping and Transport Agencies Ltd (2007) 4 SCNJ 140.**

To make a finding of non-use of the trade mark under Section 31- (2) (a), two conjunctive elements must exist. They are:

1. At the time of registration, the trademark was registered without bona fide intention to use same; and
2. A month before the application to remove a trade mark is made, there has been no bona fide use of the trade mark in relation to those goods by a proprietor thereof .

It is my humble but firm view, after reviewing the evidence that there was no proof before the trial Court that at the time of registration, the Appellant had no intention of bona fide use of the trade mark. We must remember that the onus of proof is on the 1st Respondent seeking to have the trade mark removed from the Register for non-use, to prove both essential elements of non-use.

Needless to say, the word 'and' in Section 31 (2) (a) shows that both elements are conjunctive and must be so construed. See **NDOMA - EGBA V.**

**CHUKWUOGOR supra .**

Thus, the applicant to remove a trade mark must prove intention not to use the trade name ab initio at registration and also that there has been no bona fide use of the name by the proprietor up to the date one month before the date of the application . The learned trial judge did not make a finding on the above concurrent scenario under [Section 31 \(2\) \(a\)](#). However the Court at page 781 of the record held as follows while interpreting [Section 31 \(2\) \(b\)](#):

**"The registered trade mark may be taken off the Register if there is failure to use the mark for a period of five years from the date of registration."**

The learned trial judge concluded at page 788-789 of the record that:

**"...a trade mark which remains in the register for a period of 38 years without being used in relation to the goods that it was registered has become generic and has fallen into public domain and so can be used by anybody and can be expunged from the Register. I hold therefore that the Plaintiff is no longer entitled to the exclusive use of the registered Trade Mark word ARIEL in Nigeria."**

In the first instance, it is clear that in [Section 31 \(2\) \(b\)](#), the intention of the law maker is that five years counting backwards from within a month of the application is the computation time and not five years from the date of registration .

In paragraph 35 of the Appellant's brief at pg. 22-23, the Appellant set out three possible scenarios for the computation of time in respect of

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**Section 31 (2) (b).** The 1st Respondent's counsel also agreed with the three scenarios and adopted same in paragraph 4.14 of his brief. The three scenarios succinctly put are stated below:

1. Scenario A - 13/11/1995 - 13/11/2000
2. Scenario B - 17/06/1993 - 16/06/1998
3. Scenario C - 6/06/2000 - 07 /06/2005

The above means that the 1st Respondent applying that the Appellant's trade mark be expunged must prove that during any of the periods set out in the above scenarios, the Appellant had not made bona fide use of the trade mark in Nigeria. The trial Court did not make an analysis of the time frame as required under

**Section 31**, but as seen above, gave an outright wrong interpretation to **Section 31 (2) (b)**.

A recurring factor in both grounds (**Section 31(2) (a) & (b)**) is that non-use is computed from a month before the application to expunge the trade mark is made. The difference lies in the first ground dating back to the time of registration, while the second ground dates back five years. In essence, the first ground consists of two elements that must exist concurrently before an order of removal can be made. The second ground has just one element: a continuous period of non-use for five years preceding a month before an application for removal is made .

There is no doubt that **Section 31** is a prescriptive legislation which seeks to limit or remove a proprietor's trade mark from the Register of trade

mark.

In **Okotie-Eboh V. Manager (2004) 18 NWLR Pt. 905 Pg. 242 at pg 282-283**, Edozie JSC held as follows:

**"Statutes which encroach on the rights of the subject, whether as regard person or property, are construed as penal laws fortissimo contra preferences; that is, strictly in favour of the subject."**

Similarly, in **Provost Lagos State College of Education & Ors v. Dr. Kolawole Edun & Ors (2004) 6 NWLR Pt. 870 Page 476 @**, Tobi JSC held that:

**"It is settled law that expropriatory statutes which encroach on a person's proprietary rights must be construed fortissime contra preferentes that is strictly against the acquiring authority but sympathetically in favour of the citizen whose property rights are being deprived."**

Also, in **Golden Victor Nangibo v. Uche Okafor & Ors (2003) 14 NWLR Pt. 839 P9.78 2@ ....**, Onu JSC stated thus:

**"Where a statute confers a power and particularly one which may be used to deprive the subject of proprietary rights, the Courts confine those exercising the power to the strict letter of the statute."**

The learned trial judge, with respect, in my view took a rather narrow view of the interpretation to be put on the meaning of 'bona fide use'. In attempting to define 'use' the trial Court had recourse to **Section 5(2) (b)** of the Act.

**Section 5 (2)** provides:

**"Without prejudice to the generality of the right to**

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 trade mark 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 render the use of the mark likely to be taken either

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- a. as being used as a trade mark; or
- b. in a case in which the use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade."

At page 783 of the record, the trial Court held as follows:

"It must be noted that the provision makes it clear that the advertising circular or other advertisements must be issued to the public.

Though the Trade Marks Act does not define the 'public'. I dare say that it can only be public with regards to the country in which the trade mark is registered. The public in this instant case can only mean in my view, the Nigerian public. The advertisement must therefore be directed to the Nigerian public in order to qualify as advertisement

**within the necessary intendment of Section 5(2) (b)..."**

The analysis of the learned trial judge is to the effect that we should ignore international publications of advertisements in foreign media, notwithstanding that sizeable sections of the public access such media. The critical factor here, and I share the view of the Appellant, is that an impression must have been made to the Nigerian public that this product with this reputation exists and is available for purchase in this country.

I do not agree with learned 1st respondent's counsel's view that the Appellant's counsel was merely being theoretical in his analysis of what impels proprietors of international trade marks to advertise in the international media. I agree that an obvious consideration by the proprietor of an international trade mark - a trade mark such as in this case, registered in over 120 countries, would be a clear intention to reach as many consumers as possible in as many countries. Be that as it may, all the above and the opinion of the learned trial judge as to whether or not the Nigerian public is aware of the trade mark as associated with the Appellant are merely speculative and the Court cannot deprive a proprietor of a right on mere negative speculation . Both counsel quoted the European Court of

Justice decision in **ANSUL BV V. AJAX**

**BRANDBEVEILIGING BV (C-40/01) (2003) RPC 40.**

It is also reported in **(2005) Ch.97; (2004) 3 WLR 1048, (2003) ECR 1-2439**. I am persuaded by the



definition given by the learned Justices of the European Court and I will restate them here. The learned Justices held *inter alia* that:

- a. 'Genuine use' must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.**
- b. It follows that 'genuine use' of the mark entails use of the mark on the market for the goods or services protected by that mark.**
- c. The protection the mark confers and the consequences of registering it in terms of enforceability vis-a-vis third parties cannot continue to operate if the mark loses its commercial raison d'etre, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the term of advertising campaigns.**
- d. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector**

concerned to maintain or create a share in the market for the goods or services protected by the mark.

**e. Assessing the circumstances of the case may thus include giving consideration, inter alia, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market "**

Taking into consideration the above definition of 'genuine use' or 'bona fide use', can it be truly said that given the evidence of proof of use proffered at the trial, the Appellant has not engaged in bona fide use of the trade mark in the years before the 1st Respondent's application was made? I think not. The Appellant referred us to numerous exhibits and the evidence of PW1 in aid of their proof that indeed they made bona fide use of the trade mark at all material times relevant to the retaining of its use. I have to agree with the Appellant as postulated in its brief that many jurisdictions have developed functional jurisprudence on the connotation of 'genuine use' or 'bona fide use'. In trade mark terms, Courts in the United Kingdom have interpreted 'use; in a broad sense to mean "use in the context of a commercial activity with a view to economic advantage". See **ARSENAL**

**FOOTBALL CLUB V. MATHEW REED (2003) RPC 281 at 292 and PHILIPS V. REMINGTON (1999) RPC**

I cannot forget that the learned trial judge made much ado and arrived at a conclusion against the interests of the Appellant by rendering a negative interpretation to the contents of Exhibit J. If we accept that the brand name Ariel detergent was in the market as at May 1998, then it was in use by the Appellant and a period of 5 years continuous non-use would be lacking to prove that the trade mark be expunged. I do not understand why the trial Court should ignore the part where the fax Exhibit J said that the product was enjoying strong volume growth, but concluded that the trade mark was not in use. Perhaps, it is the fact that the learned trial judge was under the misconception that non use should be calculated from the date of registration. However, where a Court admits a piece of evidence, the whole of the evidence must be used. Courts may not analyse and depend on a piece of evidence in support of a party's position without engaging in a similar analysis and dependence on the same piece of evidence that supports the other party's position. See **ONISAODU V. ELEWUJU (2006) 13 NWLR Pt. 998 Pg.517** .

Now, a lot of energy was expended by both parties on the issue of whether the learned trial judge's finding that Ariel had become generic and as such it had become part of the public domain was right or not.

Suffice it to say that the finding itself is self contradictory. In one breath, if it is expunged for non-use i.e. lack of use due to abandonment it

cannot in another breath, have become so popular due to over-use by the proprietor and the general public that it has assumed a generic name applicable to all products of its genre or cadre. A valid trade mark can only become generic if the consuming public misuses the mark or name sufficiently for the mark to become the generic name for the product. The consequence of non-use cannot ipso facto be that the product has become generic. I find it impossible to agree with the learned trial judge, with the greatest respect to him, on this point.

The main plank of the case of the 1st Respondent which runs through all the arguments is that the Appellant is a separate and distinct entity from Procter and Gamble Nigeria Limited and therefore a company which did not have authority to deal with the trade mark Ariel was actually doing so in Nigeria. 1st Respondent's Counsel argued that the Trade Mark and Know-How licences as presented by the Appellant show clearly that the companies, Procter & Gamble AG, The Procter and Gamble Company and Procter & Gamble Nigeria Limited are different entities. He also argued that it is also indisputable that the registered proprietor of the trade mark Ariel in Nigeria is the Procter & Gamble Company, that is, the Appellant in this Appeal and not Procter & Gamble AG or Procter & Gamble Nigeria Limited.

1st Respondent's argument is that in reality, the Procter & Gamble Company has not made use of their trademark in Nigeria because it was Procter &  
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Gamble Nigeria Limited that was making use of it, whereas it was not the Proprietor. The question to answer is whether use by Procter & Gamble Nigeria limited can be attributed to the Appellant.

The law of agency is clear and unambiguous. In **Niger Progress Limited v. NEL Corporation (1989) 3 NWLR Pt. 107 Pg.68 at 92**, Nnamani JSC stated thus:

**"The relationship of Principal and Agent may arise in 3 ways:**

**(a) By agreement, whether contractual or not between Principal and Agent which may be express or implied from the conduct or situation of the parties;**

**(b) Retrospectively, by subsequent ratification by the principal of acts done on his behalf;**

**(c) By operation of law under the doctrine of agency of necessity and in certain other cases."**

Also, in **Kafor & Ors v. Pedro (2011) LPELR - CA/PH/8M/2006**, Muhammad JCA cited with approval the case of **Bamgboye v. University of Ilorin (1991) 8 NWLR Pt.207 Pg. 1 @ 6**, where it was stated that:

**"The relationship of agency arises whenever one person called the agent, has authority to act on behalf of another, called the Principal and consents to act. Authority may also be implied from the subsequent assent of the Principal. It is therefore trite law that agency arises mainly from a contract or agreement between parties express or implied ."**

It is certain that there was evidence uncontroverted at the trial Court that Procter &

Gamble Nigeria limited had authority to use the trade mark. It is apparent from the evidence and indeed the circumstances of this case that Procter and Gamble Nigeria Limited had an implied authority to use the trade mark Ariel which was registered by the Appellant. In order for an international conglomerate such as the Appellant in this case, to carry on business in Nigeria, it must incorporate a company in Nigeria. See **Section 54 of Companies and Allied Matters Act** . It did this by incorporating a subsidiary; Procter and Gamble Nigeria Limited. This presupposes the fact that whatever business needs to be done by the Appellant in Nigeria can be done by the Nigerian subsidiary and not the Appellant by itself. Thus, can it not be implied from this general authority to act, a more specific one; the use by the Nigerian subsidiary of the trade mark ARIEL as registered in Nigeria by the Appellant? I think it can. Also, agency can arise from subsequent ratification of an agent's act by the principal. Even though the 1st respondent's counsel had contended that Exhibits A and A1 were between Procter & Gamble AG and Procter and Gamble Nigeria Limited, it would seem to me that the mere fact of tendering the exhibits by the Appellant shows willingness to ratify the contents of the documents. In **Carlen (Nig.) Limited v. University of Jos & Anor (1994) 1 NWLR Pt. 323 Pg 631 at Pg. 667**, Onu JSC held as follows:

**"Indeed, in the law of agency, ratification will be implied from any act showing an intention to adopt**

**the transaction, even silence or mere acquiescence and if an act is adopted at all, it will be held to have been adopted throughout."**

In any case, I agree with learned Appellant's counsel that the only person to question the authority of Procter & Gamble Nigeria limited to use the trade mark is the Appellant. The Chancery Division in **England in Budejovicky Budvar Narodni Podnick v. Anheuser Busch Inc (2008) EWHC 263** **ch** held that "use may be by a third party with authority to use the mark." That may be the interpretation of the legislation where the case emanated from. However, there is nothing in the Trade Marks Act which implies that the definition of use cannot be taken to encompass the acts of a third party or a subsidiary of the proprietor company. In **American Cynamid Company v. Vitality Pharmaceuticals Ltd (1991) 2 SCNJ 42**, the Supreme Court held that trade mark protection is available under Section 7 of the Trade Marks Act to a successor company. See also **DYKTRADE LTD V. OMNIA NIG. LTD (2000) 7 SCNJ 90; FERODO LTD V. IBETO INDUSTRIES LTD (2004) 2 SCNJ 71** .

In this case, the 1st Respondent had asked for the rectification of the Register of trade marks on the basis that Ariel was not an invented word and unregistrable, and thus had wrongfully remained on the Register. The lower Court consequentially, in granting that relief expunged the name of the Appellant from the register on the basis of non-use by the Appellant. Apart from non consideration of relevant facts and thus the law, the trial Court

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wrongly evaluated the evidence before arriving at its conclusion.

In the circumstances, that decision has led to a miscarriage of justice and is liable to be set aside. The decision to expunge the name ARIEL as registered by the Appellant is hereby set aside. Consequently, the combined issues 2 & 3 as identified by the Appellant are resolved in favour of the Appellant.

### ISSUE THREE

This is a combination of Appellant's issue 4 and 1st Respondent's issue 3.

The issue at stake simply put is whether the registration of the 1st Respondent's trade mark "Ariel Automatic" was valid.

The argument of learned Appellant's counsel is that having found that the Ariel trademark was invented and thus registrable, Section 14 of the Trade Marks Act should have been construed to give a clear presumption of validity of the original registration *in toto* when there is no evidence of fraud or contravention of Section 11 of the Act.

Appellant's counsel asserted that the Appellant's trade mark ARIEL and 1st Respondent's ARIEL Automatic with Atomium device are indistinctive and similar. He argued that there is no dispute that in the intervening period of the subsistence and validity of Appellant's registered mark "Ariel", the 1st Respondent registered Ariel Automatic with device in 1985.

Appellant's counsel complained that the



registration of the subsequent trade mark in 1985 was likely to cause confusion when contrasted with the existing, prior, current and valid ARIEL mark. Counsel argued that the trial court was wrong to hold that the marks had separate words and were thus separate and distinct. Counsel argued that it is a matter of consumer perception. As it were, the 1st Respondent was seeking registration in the same category (class 3) of the same product, used for exactly the same purpose, detergents. Even though Exhibit D, the certificate of registration of Ariel Automatic showed that the 2nd respondent registered the trade mark subject to a disclaimer to the effect that "New Improved Automatic" shall not be exclusively preserved for the use of the 1st respondent. Therefore, the only word preserved for the exclusive use of the 1st Respondent was "Ariel". He argued that the Appellant had an earlier registration mark for Ariel which the 1st Respondent tried to imitate by putting another word with the existing one.

Learned Appellant's counsel argued vehemently that the records of the trial Court show clearly that the Appellant registered ARIEL in Class 3 of Part A of the Register as No. 21233 in 1959 in respect of detergents. This is shown in Exhibits B1, B2 & B3 on pages 223, 378 - 380 of the record and in Exhibit C. This is an earlier trade mark. The 1st Respondent's subsequent trade mark Ariel Automatic with device is also in respect of detergents. There was evidence to show that both parties had produced detergents with an identical

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resemblance to the trade mark Ariel. Clearly, a prospective customer must entertain some confusion as to the identity of both products. This is what the Trade Marks Act intends to prevent. There was also evidence to show that there existed identical similarities in the respective get-up designs of both marks. Based on the clear and unambiguous provisions of Section 11 and 13 of the Act, the subsequent registration by the 1st Respondent in 1985 is void ab initio.

Counsel concluded that the mere fact that both names were distinguishable by the suffix 'Automatic' or 'Device' is not a basis to conclude that they were not similar. Counsel cited **ALBAN PHARMACY V. STERLING PRODUCTS** Suit No. SC 459/1966 reported in (1968) 5 NSCC 235 at 238; **EDWARD HACKS APPLICATION** (1941) 58 RPC 91 Ch. D; **AAH PHARMACEUTICAL v. VANTAGEMAX** (2002) EWHC 520 Ch; **DECON LABORATORIES V. FRED BAKER SCIENTIFIC** (2001) RPC 17 at 293.

In reply to the above submissions, learned 1st Respondent's counsel relied on his previous arguments in issues 1 & 2 to persuade us on the issue of whether the trade Mark was legally deemed to be in existence as at the time of the registration of Ariel Automatic. He reiterated the argument that between 1969 and 1985 till date, the Appellant did not make use of the trade mark 'Ariel' during that period. I will not dwell on this argument further since it has been resolved in favour of the Appellant earlier on in this judgment.

1st Respondent's counsel also argued that since

the word Ariel predates the Appellant, then the cover of distinctiveness and exclusivity as contemplated by the Trade Marks Act is not open to the Appellant. Counsel argued that for the Appellant to have succeeded under this claim, it had a duty to show conclusively before the Learned Trial Judge that the trade mark Ariel was distinctive of the Appellant and this must be on account of the fact of the usage of the Trade Mark within the country, Nigeria. He argued further that the Appellant ought to have shown before the learned trial judge the following: that the 1st Respondent knowingly registered its trade mark to deceive the general public; that the said 1st Respondent was aware of the Appellant's distinctive use of the trade mark; that the Appellant made actual use of the trade name and that there were existing customers of the Appellant deceived by the Trade Mark.

Counsel argued that the Registration Certificate issued to the Appellant on 3/12/69 - Exhibit B on page 378 of the record; Certificate of renewal dated 14/06/75- Exhibit B2 on page 379 of the record and that of 11/03/91- Exhibit B3 on page 380 of the record, all show that it was only the name 'Ariel' that was registered by the Appellant. No logo or product was registered with the name.

Meanwhile, when the 1st Respondent registered its trade mark in 1985 and renewed it in 1992, page 393 of the record shows that the registration not only included the name 'Ariel Automatic' but also the product's logo. So, as at 1985, there was no similar trade mark logo prior to the 1st

Respondent's own. Counsel urged the Court to disbelieve the evidence of PW1 who stated that the Appellant did not become aware of the 1st respondent's dual registration until 2002. Counsel argued that PW1 was not a customer, but an employee of Procter and Gamble Nigeria Limited. Counsel argued that to establish breaches of Section 11 & 13 of the Trade Marks Act, a party must establish conclusively a likelihood of confusion or actual confusion or similarity of trade mark and this must be judged through the eyes of the consumers of the goods in issue who are deemed to be reasonably well informed and reasonably observant and circumspect. The party must call such customer(s) to give evidence in proof of its case but this was not done by the Appellant. He cited **JULIUS SAMANN LTD, 17 YOUNG (OPERATIONS) LTD VS. TETROSYL LTD (2006) EWHC 529 Ch.D** which was delivered on 17th March, 2006.

I must say here that the issue of trademark protection has been the subject of several Supreme Court cases. In **Dyktrade Ltd v. Omnia Nig. Ltd (supra)**, it was held that the rights conferred by the registration of a trade mark on the proprietor is the exclusive use and right to sue for infringement. Thus in **Ayman Enterprises Ltd v. Akuma Industries (2003) 6 SCNJ 307**, the Supreme Court set out what the plaintiff needs to prove to establish an action for infringement of a trade mark. The Plaintiff must establish his title either as proprietor or as a registered user entitled to sue. He must

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then prove that the defendant has acted or threatens to act in a way as to infringe the right conferred upon him by the registration of the trade mark under the Act.

In **Ferodo v. Ibeto** (supra), the Supreme Court held inter alia as follows:

- 1. The essence of a trade mark is that it indicates a connection in the course of trade between the goods and some person having the right to use the name. A trade mark can also be defined as a distinctive picture which would indicate to a purchaser of an article bearing it the means of getting the same article in future by getting an article with the same mark on it.**
- 2. A mark, in this connection, includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. A trade mark, on the other hand is a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate a connection in the course of trade between the goods and some person having the right either as a proprietor or a registered user to use the mark. An action for infringement will therefore lie where a competitor uses a registered trade mark in connection with proprietor's goods for the purpose of confusing them with his own goods in the same class.**
- 3. In deciding whether two marks are confusingly similar, the marks alone must be considered, divorced from associated features or get up and the like. Evidence is admissible to show which of the**

features shown in the register in this case are essential and which are inessential so as to be unimportant in deciding questions of infringement. 4. It is not all the features that are contained in the mark that are important for the purposes of the infringement of the trade mark. Not all the components are to be considered as forming part of the trade mark. The resemblance giving rise to infringement must lie in the basic idea of the mark .

Applying these analogous situations to the instant case, evidently, the subsequent trade mark regardless of the suffix Automatic (which had been disclaimed) is identical with the Appellant's 'Ariel'. The specific products which both trademarks relate to in the factual circumstance are detergents. The Trade Mark or name used by both proprietors is the word 'Ariel' which prefix all other descriptions or get up by the parties. Whether it is Ariel Devise or Ariel Automatic the prefix Ariel is the key name or key mark. Indeed that was the point made by the Supreme Court in **Ferodo v Ibet** to the effect that '**Ferodo**' is the trade mark and other suffix or get up names imitated by the competition is not an infringement of the name 'Ferodo'. In this case, it is therefore apparent that both parties use the principal name Ariel to market their products. Apart from the word Ariel all other descriptions are irrelevant.

Therefore in my humble view, use of the word 'Ariel' by both marketers is a recipe to create confusion in the mind of the average consumer the different packaging etc notwithstanding. This is

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more as they both advertise the same products. In AAH Pharmaceuticals cited (supra), the claimant was the proprietor of the trade mark "Vantage" for operating incentive schemes". The defendant operated a loyalty card scheme under the words "Vantage Rewards". The Court held that the marks were identical because the word "Reward" was merely descriptive of the services offered.

Having said that, it is also important to note the learned Appellant's counsel's reference to international treaties in paragraph 98, page 47 of the Appellant's brief. Appellant's counsel argued that Nigeria as a treaty member of the World Trade organization (WTO) has, by reason of its membership, agreed to shape its domestic laws and policies in a manner consistent with '**Agreement on Trade Related Aspects of Intellectual Property Rights**' (**TRIPS Agreement 1994**). As such, there is a presumption of a national will to align with the provisions of the Agreement. Section 2 of the Agreement which deals with trademarks, counsel reinforced, requires in general terms that member countries protect well-known marks. Without being able to confirm executive or legislative ratification of this TRIP agreement as binding on Nigeria it is difficult to interpret the law in that record.

However, the jurisprudence that seems to run through our case law in Nigeria has favoured liberalism in interpreting trade mark Act to favour a proprietor of a named brand. I am persuaded by that approach I feel that Nigerian Courts must align

with the comity of nations to protect well known trademarks. We must enforce the Trade marks laws and understand the raised duty of the laws which ensures protection of brand names from imitation and the like. The Appellant's trade mark is not only well-known internationally, it has also been the subject of prior legal registration under the Trade Marks Act in Nigeria. I feel strongly that the Trade mark Ariel associated with the appellant should enjoy the protection of the Courts.

The third issue is resolved in favour of the Appellant.

#### CROSS APPEAL

The sole issue for determination in the 1st Respondent's cross appeal is whether or not the learned trial judge was right in holding that the word 'Ariel' is an invented word of the Appellant.

The 1st Respondent's contention is that the Appellant could not have invented the word 'Ariel' as this word predates the Appellant and as such is not distinctive and is unregistrable; thus the initial registration of the trade mark in 1969 and subsequent renewals are invalid in light of Section 9 of the Trade Marks Act.

Learned counsel cited several instances where the word Ariel was used before the Appellant allegedly invented the word in paragraphs 6.23-6.30. He argued that in the light of the examples given, the Appellant's claim of having invented the name is unsustainable and that presently, the word is being used severally in qualified forms all around

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the world.

Counsel also observed in paragraph 6.31 of the 1st respondent's brief, that the Appellant in some of the 120 countries it allegedly carries on business in, uses the word Ariel with various other companies and wondered why it would object to the use of Ariel Automatic as registered by the 1st Respondent.

He then submitted that the trial Court ought to have taken judicial notice of the facts stated above because they are notorious facts in line with the provision of Section 74(2) of the Evidence Act and that there existed at the time of the trial, avalanche of facts establishing the existence of the word Ariel prior to the existence of the Appellant.

In reply to the cross-appeal, counsel to the Appellant contended that what the 1st respondent pleaded at the trial Court was that the word 'Ariel' is a variation of the term 'Aries' which can be found in the dictionary and as such was not invented by the Appellant. They contended that the 1st respondent assumes excessive liberties not provided by law when it requested that the Court take judicial notice of facts that were not before the lower Court. They argued that the law is clear that fresh evidence cannot be introduced on appeal without leave and as such the fresh evidence introduced by the 1st Respondent in the cross-appeal should be discountenanced. They cited **IWEKA II V. ANATOGU (1991) 4 NWLR Pt. 185 Pg. 305.**

They argued that under Section 9 of the Trade

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Marks Act, invention of a word is one of the five essential particulars that confer registrability and not the only one. They asserted that non-invented words can constitute marks as long as such words can identify the commercial source or origin of products or services. They cited **BUDEJOVICKY CASE (Supra); FERODO LTD V. IBETO INDUSTREIS LTD (2004) 5 NWLR Pt. 866 Pg.317 at 347**

Learned counsel argued that the Appellant never claimed to be the inventor of the word, but it was the first to adopt ARIEL for use in branding its detergent products and being a word having no direct reference to the character and quality of the goods, it is legally registrable as a trade mark. They asserted that the facts alluded to by the 1st respondent are meaningless in the evaluative process regarding the registrability of the trade mark Ariel because it failed to allude any previous usage of the word in the context of detergents. They claimed that the 1st Respondent helpfully alluded to the use of Ariel by other organizations in other countries, but all the examples cited were in respect of other goods which are not detergents and as such this fact does not diminish the registrability of Ariel by the Appellants for use on detergents.

They cited **LIGGETT AND MYERS TOBACCO CO V. REGISTRAR OF TRADE MARKS 2 ALL NLR 72**

I agree with the submission of the learned Appellant's counsel that the 1st respondent cannot introduce new evidence on appeal without leave of this Court . (Judicial Authority). I also agree that it is

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unreasonable to expect the learned trial judge to take judicial notice of the existence of the word 'Ariel' before the registration of the mark by the Appellant, as this fact cannot be considered notorious within the meaning of Section 74(2) of the Evidence Act.

However, the fact of invention is not of total importance to the issues regarding the registration of the Appellant's trade mark Ariel. Let us look at the provisions of Section 9 of the Trade Marks Act. It provides as follows:

**"In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register it must contain or consist of at least one of the following essential particulars -**

- 1. The name of a company, individual or firm, represented in a special or particular manner;**
  - (a) The signature of the applicant for registration or some predecessor in his business;**
  - (b) An invented word or invented words**
  - (c) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;**
  - (d) Any other distinctive mark:**

**Provided that a name, signature or word other than such as fall within paragraphs (a) to (d) of this section shall not be registrable under paragraph (e) of this section, except upon evidence of its distinctiveness.**

- 2. For the purposes of this section, 'distinctive' means adapted in relation to the goods in respect**

**of which a trade mark is registered or proposed to be registered, to distinguish goods within which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.**

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

- 1. The trade mark is inherently adapted to distinguish as aforesaid; and**
- 2. By reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid."**

It is apparent from the provisions of the section and I quite agree with the learned Appellant's counsel that even though invention of a mark is one of the ways through which a trade mark can be registered, it is not the only way.

**Section 9** provides for additional ways. The Appellant has claimed that it was the first to register the word 'Ariel' in respect of goods in class 3, part A of the Register of trademarks and this, in my humble opinion confers on the trade mark the quality of distinctiveness in relation to the goods for which it was registered; more so, since the 1st Respondent has not shown that the Appellants were not the first to use the mark in relation to detergents.

**The issue in the cross appeal is resolved against the**

cross-appellant/1st Respondent.

The Appeal is allowed and the cross appeal is dismissed.

In the circumstances, the judgment of the trial Court and the orders made therein are hereby set aside. The finding of the trial judge in relation to the cross appeal only is affirmed. The prayers sought by the Appellant in the particulars of claim filed on 17th July 1998 are hereby granted. The Respondent's counter claim is dismissed. I award N=30,000.00 to the Appellant against the 1st Respondent.

RITA NOSAKHARE PEMU, J.C.A.: I have had a preview in draft, of the Judgment just delivered by my brother Judge **H. M. Moronkeji Ogunwumiju J.C.A** and I fully agree with the reasoning and conclusions inherent therein.

I also abide by the consequential order made that the appeal be and is hereby allowed. The Judgment of Honourable Justice Abdullahi Mustapha of 17th day of December 2007 is hereby set aside, while the cross appeal, being devoid of merit, is hereby dismissed.

MOHAMMED AMBI-USI DANJUMA, J.C.A.: I have painstakingly studied the entirety of the Record of Appeal and in particular the Judgment of the learned trial Judge in the face of the evidence led and the law. Having also painstakingly examined

the eloquently helpful submissions of the respective parties, I am compelled by the Appellant's learned senior counsel's submissions led by Professor Osipitan (SAN) to agree with the lead Judgment that this appeal has merit and must be allowed.

As respecting the cross appeal by the Respondents, I also have no hesitation in dismissing same as lacking in merit.

The learned trial/lower Court clearly, in my view, made a case for the Respondents which was not so made and decided same on its postulation, when he held that the Appellant's trade mark must be expunged from the Register of Trade Marks/names because of non use. There was no such claim before the Court. The claim was that the trade name Ariel was not a registrable name, simpliciter. What is more, even if the claim were based on " non-use", the conclusion arrived at, certainly flew in the face of the avalanche of oral and documentary evidence as to the use of the name Ariel by the Appellant in its trade for a period not shown by the Respondents to be less than 5 years.

The name was a registrable one and in use and the registration and use of any other name with striking resemblance by the Respondents, certainly, is prohibited by law. The action in challenge of such a violation by the Appellant herein was in order. The Appellant's suit was in order, whilst the counter claim had no basis.

Accordingly, I join my lord, **Helen Moronkeji OgunwumiJu (JCA)** in allowing the appeal against the success of the counter-claim and dismissal of

the claim.

Appeal is allowed whilst the cross appeal is consequently dismissed by me, also.

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### **Appearances:**

Prof. Yemi Osinbajo, SAN with him, Mr. Akin Osinbajo, Mrs. V.O.M. Alonge, Mrs. Ikem Isiekwene, Mrs. Adeyemi Akingbade, Mr. Abimbola Ojenike **For Appellant(s)**

Mr. Akinrimisi with him, Ariyo Odole, Foluke Olubiyo, Miss Bukola Adebayo - 1st Respondent/Cross Appellant

2nd Respondent absent **For Respondent(s)**

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