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Comparative Analysis Of The Remedy Of Rectification Under The Nigeria And Ghana Trademark Act

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Abstract

Trademarks are frequently used by product owners to introduce their goods and services into the marketplace. The article investigates the remedy of correction in the Nigerian and Ghanaian Trademark Act in order to avoid a situation where similar trademarks are permitted to co-exist and later result in confusion. The paper takes a doctrinal stance that is based on tracing the following concepts: the definition of a trademark as a subset of industrial property; the justification for trademarks; trademark registration and the rights conferred by registration; trademark infringement; and the remedy of rectification as provided under the Nigerian and Ghanaian Trademark Acts. The study finds that in Nigeria and Ghana, laws have been passed to address the many trademark-related issues. These laws include detailed definitions of what constitutes trademark infringement and what qualifies as registrable trademarks. The Act's single remedy for rectification is unquestionably burdensome in both geographic regions, as shown by the provisions, and the study makes the case for its revision in upcoming legislation.

Keywords:-Rectification, Infringement, Registration, Remedy, Trademark

INTRODUCTION

Trademarks are a known negative factor on both the industrial and commercial markets. They later become a prominent actor in the contemporary world of intercontinental trade and market-oriented economies, where they significantly contribute to industrialization. Trademarks have been used for a long time by manufacturers and merchants to distinguish their goods from those made or sold by competitors. It is challenging to quantify reputation since it is a quality that is specific to a person, a group of people, or an organization. Because of this, it is illegal for anyone or any group of individuals to attempt to damage the reputation of another person. **(Nwabachili C, 2017)** The use of a trademark contributes to a product's promotion, high quality assurance, origin identification, and competitive differentiation. Personal names, designs, letters, numerals, logos, trademarks, marks, or shapes of goods or their packaging to which the mark is affixed give their goods and services a distinctive identity. **(Cornish. E. R, 1999)**

The major objective of trademark laws in Nigeria and Ghana is to prevent third parties from using trademarks that are sufficiently close to or identical to those of the owner or registered user that they are likely to cause or contribute to confusion in the course of business. As a result, the

following are the three primary elements of trademark law in Nigeria and Ghana:

- a. govern the use of trademarks by registering them or via other legal measures, as well as any associated rights;
- b. to classify actions that would be considered trademark infringement;
- c. to impose sanctions for infringement of a trademark.

This article will discuss the rectification remedy in the Nigerian and Ghanaian trademark rules in order to prevent a scenario where similar trademarks are allowed to coexist and hence result in confusion. In doing so, the introduction is followed by the division of the document into six sections.

In the first half, a trademark's definition as a subset of industrial property is discussed. It asserts that the law of trademarks in Nigeria and Ghana forbids the use of a device or other means by a third party that gives the impression that the products of the third party are those of the merchant, producer, etc. It is asserted that this is a part of the legislation governing intellectual and industrial property. If constraint were not used, the third party would unfairly profit themselves at the expense of the merchant or producer.

The arguments for the Nigerian and Ghanaian trademarks are the subject of the second section. According to the claim, trademark protection has been defended in Nigeria and Ghana on a number of grounds, including originality, information, and moral considerations.

The rights associated with trademark registration are covered in the third section. It argues that registration enables company owners in Nigeria and Ghana to protect their trademarks before they become marketable. Furthermore, it says that while registration does not guarantee that a mark has been registered, it is advantageous in that it establishes a presumption to that effect. As a result of the registration defining the bounds of the property that is protected as a trademark, the last argument claims that trademark registration boosts trademark owner confidence and reduces the risk of disputes.

Infringement of trademarks is the topic of the fourth section. According to this argument, trademark infringement refers to behavior that distorts a trademark's fundamental characteristics and prevents it from being registered in a trademark register. The article continues by stating that trademark infringement is unlawful since it represents unfair competition. When a trademark is used unlawfully, the owner loses because the infringer's actions cloud the minds of his customers and damage his reputation in the field where his trademark is used.

The fifth section addresses the rectification remedies under the Nigeria and Ghana Trademark Act. It argues that there are several options available to someone who has been mistreated by trademark infringement. It is also stated that the current Nigeria and Ghana Trademark Act appears to embrace the rectification remedy, giving the court the choice to pursue additional common law or equitable remedies.

The sixth portion of the article concludes the topic and presents a thesis for future legislation.

1.2 THE SIGNIFICANCE OF A TRADEMARK AS A BRANCH OF INDUSTRY PROPERTY

Section 1 of the Ghana Trademark Act (Trademark Act 2004) defines trademark as follows: Trademarks are words that can be used to distinguish the products or services of one company from those of other companies. These words can be names, letters, numbers, or figurative elements.

In Nigeria, *Section 67 of the Trademark Act (2004)* also defines trademark as follows: A trademark is a mark that is used in relation to goods for the purpose of indicating—or in such a way as to indicate—a connection between the goods and some persons having the rights—either as proprietors or as registered users—to use the mark, whether with or without any indication of that person's identity. A trademark also refers to a mark that has been registered or is presumed to have been registered undisclosed.

The Ghanaian Act contains first and last names, letters, numbers, and figurative elements while the Nigerian Act only includes devices, trademarks, headers, labels, tickets, names, signatures, words, and letters. **(Ferodo Limited and Ors. V Ibeto Industries Limited, 2006)** The Nigerian and Ghanaian Acts do not elaborate on the spectrum of marks in significant detail when compared to the intricate definitions offered by the World Intellectual Property Organization (WIPO).

According to the World Intellectual Property Organization, signs could include words, letters, and numbers, objects, colorful marks, three-dimensional signs, audio signals (sound marks), and olfactory marks (small marks). Most of the aforementioned criteria are not taken into account by the Nigerian and Ghanaian Act; the Act's limit is unquestionably a result of practical registration concerns.

The request for a broad interpretation of what qualifies as a registrable mark in this case is not in conflict with Sections 11 of the Nigerian Trademark Act and Section 5 of the Ghanaian Trademark Act, which prohibit the registration of deceptive or scandalous matter in the interest of public morals and public deception, as well as of matters that are likely to mislead the public or business circles with regard to the geographical origin of the goods or services, their nature, or a particular characteristic. Unauthorized use of a state's, an intergovernmental organization's, or a group established by a treaty's name, its initials, a flag, a symbol, a moniker, an acronym, or any other part of its name.

In Nigeria, businesses often utilize one of five (5) marks to set themselves and their products apart from rivals. In Ghana, we employ service markings, also known as collective marks. These signs can be used to distinguish between the goods or services of one enterprise and those of another, or between several businesses using the sign under the authority of a registered owner. Trademarks are also referred to as trade names, services marks, collective markings, and certification marks, or occasionally as "True trademarks." **(Trademark Act 2004 Ghana)** We can infer from the aforementioned details that a trademark is any image, mark, name, or other configuration that is affixed to goods and connects them to the plaintiff seller or maker. **(Enemaku O, 2008, Nwabachili C, 2017)**

The term "trademark" is used in Nigeria with some limitations, per the definition provided in the Nigeria Act, since only goods sold by the proprietor may have it affixed to them. It appears that the 1938 Trademark Act of Nigeria, which was based on the 1938 Trademark Act of the United Kingdom, deviates from this by adding "service" as a second object in addition to "goods" to which a trademark may be applied. Any symbol that can be graphically depicted and can distinguish the goods or services of one venture from those of other enterprises is a trademark, according to *Section 1 of the United Kingdom Trademark Act. 1994* The statement goes on to say that words (including human names), design letters, numbers, or the shape of goods or their packaging may all specifically be included as trademarks. **(Ghanaian Trademark Act 2004)** There are some issues with the Nigerian Act, one of which is that services are not included in the definition of a trademark. **(Mordi M, 2011)**

1.3 JUSTIFICATION OF TRADEMARK IN NIGERIA AND GHANA

Reasons for trademark protection are frequently questioned. There are numerous distinct arguments in favor of trademark protection. Now, let's focus on them.

Creativity

Trademarks are typically protected to protect both labor and personality. Perhaps the most convincing argument made along these lines is that trademarks are seen as a return on investment. The trademark legislation gives producers more assurance that they will reap the financial and reputational rewards of creating a sought-after commodity. By encouraging the production of high-quality items and deterring those who attempt to sell inferior goods by preying on a consumer's limited ability to evaluate the quality of an item being sold, trademark law encourages the production of high-quality goods.

Information

The best argument in favor of trademark protection may be that it serves the public interest by improving market efficiency and customer access to information. These arguments highlight the fact that trademarks are a quick way to provide consumers with the knowledge they need to make educated purchasing decisions by prohibiting others from duplicating a source. The law on trademark identification allows a possible buyer to make decisions about this product swiftly and easily, with the confidence that it is what they want. The manufacturer of the product with this mark is the same as the manufacturer of other products with earlier-appreciated marks (or despised).

Ethical Justifications

Sometimes moral arguments have been used to support the trademark regime. The foundation of the basic ethical reason for trademark protection is fairness or justice. It is explicitly mentioned that one should not use someone else's trademark as one would be allegedly exploiting the goodwill accumulated by the original trademark owner. Therefore, the case for trademark protection rests on the more general ideas of "unfair competition" and "unjust enrichment." (Nwabachili C, 2017)

1.4 TRADEMARK REGISTRATION AND THE RIGHTS ARISING THERE FROM

The trademark must be registered in order for the owner to benefit from the resulting legal protection. The advantage of registration is that it provides entrepreneurs with the chance to protect their trademarks before they are sold. Additionally, there is an assumption that a mark registration is legitimate once it has been made, however this is not a guarantee. Because the registration indicates the limits of the property that is protected as a trademark, there are less chances of disagreements and the trademark owner has more security. What marks are protected and in what commercial situations are the goals of the registration process. A vital source of information is the Register, which is open to the public.

Applications for registration must be filed to the Registrar together with the necessary fee, per Section 4 of the Act in Ghana. With the application, you must include a copy of the trademark as well as a list of the goods or services you want to register as a trademark for using the international classification. The application may include a declaration stating the precedence of an earlier national or regional application submitted by the applicant or the applicant's predecessor in title, as permitted by Article 4 of the Paris Convention, which is noted in Schedule 1. :

- a. or in any state that is a party to the Convention; or
- b. On behalf of or in any WTO member's name.

Within the allowed time, the Registrar may ask the applicant for a copy of a previous application that has been validated as accurate by the office where it was submitted. If the Registrar finds that the requirement under subsection (3) has not been met, the declaration will no longer be valid. The applicant has the right to withdraw their application.

The Registrar's assessment of the class to which any given set of products belongs is conclusive. In Nigeria, a trademark must be registered in connection to certain goods and classes of goods. (Nigerian Trademark Act 2004) The trademark registration register is divided into two parts, Part A and Part B, respectively. (Nigerian Trademark Act 2004)

Section 9 of the Nigeria Act states that for a trademark (other than a certification trademark) to be deemed distinctive, it must include or include at least one of the following important details.

- a. the name of a person, company, or organization displayed in a distinctive or particular manner. (Chanrai A. B. and Co. Ltd v W. J. Bush and Co. Ltd, 1996)
- b. either the applicant's signature on the registration application, or a predecessor in the applicant's line of business.
- c. some newly coined phrase or phrase(s). (Aristos Ltd v Rysta Ltd, 1945)
- d. a word or words that don't immediately relate to the nature or quality of the things and don't match their typical definition, like a geographical name or surname. (Bubble Up

International Ltd v Seven Up Co. Ltd, 1971, Liggett and Myers Tobacco Ltd v Registrar of Trademark, 1969)

e. Any other distinctive mark, subject to the restriction that no name, signature, or word or words that do not fall under paragraphs (a) to (d) of this section shall be registerable under paragraph (e) of this section unless proof of their distinctiveness is produced.

Distinctive means designed to distinguish, in relation to the goods for which a trademark is registered or proposed to be registered, the goods with which the trademark owner is or may be connected in the course of business from the goods with which there is, generally, no such connection or in the case of goods for which the trademark is registered or proposed to be registered subject to limitation, in relation to use within the scope of the registration, either generally or where the trademark is not registered or proposed to be registered.

The tribunal may examine the following elements when determining whether a trademark has been modified to discriminate in the manner described above:

- a. As previously stated, the trademark is made to stand out naturally; and
- b. As previously said, the trademark is truly intended to identify owing to brand usage or any other circumstance.

A request for registration in Part A of the register should be granted when the applicant satisfies one or more of the five requirements, according to the clear language of Section 9. The rationale for requiring that the name be a real name and be done in a specific fashion is stated in Section 9(1)(a), according to Kerly. **(Kerly, 1972)** To prevent a name from becoming so widely recognized as a trademark that any business could unintentionally violate it by using his own name honestly, we believe that a surname should be included in the meaning of the word "name" in connection to an individual.

Section 9(1) permits the registration of the applicant's signature as well as the signature of his predecessor in business (b). A signature serves as a means of differentiation, or, in the words of Section 9(2) of the Act, is easily distinguishable.

Section 9(1) provides that an invented word may be entered in Part A of the Register (c). The concept of novelty is implied by the word "create." A candidate ought to have made up or combined an invented word. According to Halsbury's, in order for a term to qualify as an invented word, it had to be substantially unique when it was first used by the applicant in relation to his area of employment. **(Halsbury, 1984)**

Additionally, it asserts that a word may be fictitious even if it conveys its meaning to the reader clearly and makes a subliminal but powerful allusion to the nature of the commodities.

(Eastman Photographic Material Co. Ltd's Application, 1898)

It is acceptable to register a term or terms that do not directly relate to the character or quality of the commodities and are not, by definition, a geographical name or surname, in accordance with Section 9(1)(d). The purpose of this phrase is to avoid a situation where a trader extols the benefits of his goods. Additionally, it seeks to prohibit instances in which a dealer uses his last name and hometown as part of his mark. **(Minnesota Mining and Manufacturing Co.'s Application 1948, Colgate and Co.'s Application 1913, Edge's Trademark 1891, Liggett and Myers Tobacco Co v Registrar of Trademark 1969)**

The effect of Section 1(e) is that the registrar must consider both a trademark's inherent adaptability to discriminate as well as, if there is such proof, the degree to which it is so demonstrated by the evidence, while examining a trademark registration application.

Unfortunately, it doesn't appear that any resolved instances have really considered how to define "distinctive." However, pre-decided English cases provide guidance. **(Re James Trademark 1886, Re Cadbury Brothers Ltd's Application 1981)**

According to the aforementioned, in our opinion, if a trademark cannot be classified under Section 9 of the Act's paragraphs (a) through (d), it may lawfully fall under paragraph (e) if it is utilized or otherwise clearly connected with a particular trader.

As used under the Act, the term "distinctive" shouldn't be interpreted as requiring proof beyond a reasonable doubt or a solid affiliation with a particular dealer, in our opinion. It is important to consider the market and area that the merchant and his brand are relevant to in each circumstance. **(Nwabachili C. 2017)**

According to Section 11 of the Act, the following applies when a trademark is registered under Part B of the register:

A trademark must be able to distinguish goods with which the owner of the trademark is or may be connected in the course of business from goods with which there is no such connection in order for it to be registrable in Part B of the register. This capability must apply both generally and where the trademark is registered or proposed to be registered subject to limitations, in relation to the goods for which it is registered or proposed to be registered.

The tribunal will take into account how much a Trademark can be distinguished in the manner described above.

- a. The trademark's inherent ability to distinguish itself has already been mentioned; and
- b. due to the use of the trademark or for any other cause. The trademark actually has the potential to discriminate as claimed.

Even if a trademark has already been registered in Part A with the same owner for the same trademark or any subsets thereof, the trademark may be registered there again.

The requirement of registration in either Part A or B of the register is nonsensical, notwithstanding the argument that registration in Part B is required to discriminate while in Part A is sufficient if the mark is capable of doing so. **(Orojo A, 1983)** In spite of the fact that the Act allows the same trademark to be registered in Part B despite being registered in Part A, **(Nigeria Trademark Act, 2004)** it appears irrational that the Act offers a person registered in Part B the same rights as a person whose mark is registered under Part A. On this point *Section 11 of the Trademark Act* provides:

The registration of a person as the owner of a trademark in relation to any goods in Part B of the register (whether before or after the commencement of this Act) shall, if valid, grant or be deemed to have granted to that person the like right in relation to those goods as if the registration had been in Part A of the register, and Sections 5(2) to (4) of this Act shall apply in relation to a trademark registered in Part B. **(Enemaku. O, 2008)**

Additionally, Section 6 of Ghana's Trademark Act provided the following mechanisms for trademark inspection and opposition to registration:

The application will be examined by the Registrar to ensure that it complies with Sections 1, 3, 4 (1 and 2), and 5. In the event that the Registrar finds that the conditions of Subsection (1) have been satisfied, the Registrar shall authorize the publication of the application so that any interested party may file a notice of opposition to the registration within the time frame and in accordance with the established procedures.

An interested party has the option to inform the Registrar of their opposition on the grounds that Section 1 or one or more of its requirements have not been satisfied. The applicant must reply to the registrar's notice of objection by sending a counterstatement of the applicant's grounds to the registrar within the required timeframe and in the appropriate format. If the applicant does not respond to the notice of objection, it is assumed that they have abandoned the application. The Registrar will determine whether to register the trademark after hearing from all parties and forwarding a copy of the counter-statement to the party that filed the notice of objection.

The applicant is entitled to all the same advantages and rights as an applicant during the period following the publication of an application and up until trademark registration. However, the trademark would be a legitimate defense to a claim relating to an act carried out after the application was published if the alleged infringer shows that it could not have been legally registered at the time of the act.

The applicant shall get a certificate of registration and the trademark shall be registered in line with Section 7 of the Act. If:

- a. there hasn't been a timely opposition to the registration; or
- b. Despite opposition to the registration, the applicant prevailed in court.

The registration procedure in Nigeria is outlined in Sections 17 to 22 of the Trademark Act. If a person wishes to apply for the registration of a trademark in Part A or Part B of the register, he or she may, at their discretion, submit an application to the Registrar in the manner specified for guidance on whether the trademark appears to the Registrar, on the surface, to be inherently adapted to distinguish or capable of distinguishing, as the case may be. The advice asked in the application may be given by the Registrar with authority. The applicant is entitled, upon giving notice of withdrawal of the application within the required period, to have his or her application for registration of the trademark reopened if the Registrar objects to the acceptance of the application for registration of a trademark on the grounds that the trademark is not adapted to distinguish or not capable of distinguishing, as the case may be. According to Section 18, anybody claiming ownership of a trademark that is in use or is about to be used must make a written application to the Registrar in the appropriate format for registration in either Part A or B of the Register. The Registrar may, in line with the provisions of this Act, deny the application, approve it with restrictions, accept it with conditions, or reject it altogether. If a trademark registration application—other than one for a certification trademark—is submitted in Part A of the Register, the Registrar may, with the applicant's permission, treat it as a Part B application and proceed with it in that manner.

If a trademark registration application (other than a certification trademark) is filed in Part A of the register, the Registrar may, with the applicant's consent, regard the application as one in Part B of the register and proceed with it in accordance with that classification.

The Registrar must provide written explanations of his reasoning and the evidence he took into consideration upon the applicant's request. The decision is appealable to the court in the event of rejection or conditional acceptance.

Whether the application is to be authorized and, if so, with what changes, modifications, requirements, or restrictions, if any, are to be made, are to be specified in an order issued by the Registrar. If necessary, the court shall hear the petitioner in connection with an appeal made pursuant to this article if it is submitted in the manner specified. Hearings on appeals made pursuant to this section shall be conducted on the basis of the information furnished by the Registrar pursuant to this section's Subsection (4). Other than the ones he has already indicated, the Registrar is not permitted to oppose to the application's approval unless the court grants authorization. In the event that the Registrar does object further, the applicant may, by giving the court the notice that the court may need, withdraw his application without being charged any fees.

Before or after acceptance, any errors in the application or those related to it may be corrected, and the applicant may revise his application if the Registrar or the court, as applicable, deems it necessary.

The Registrar must cause notice of the application as accepted to be published in the journal as soon as practically possible following acceptance, under Section 19 of the Act. Whether the application was approved unconditionally or with conditions or restrictions, all of those terms must be included in the notice.

In cases where notice of a trademark registration application has already been published in the journal prior to acceptance under this section's subsection (2), the Registrar may arrange for that notice to be published again. In any other situation where it appears to him to be necessary because of any exceptional circumstances, the Registrar may, if he believes it is expedient due to any exceptional circumstances to do so, cause notice of an application for registration of a trademark to be published in the journal prior to acceptance.

If the Registrar is notified in writing within two months after the publication date under Section 19 of the Act, anybody may object to registration under Section 20 of the Act. The notification shall be given in writing, shall be in the form and manner hereinafter prescribed, and shall set forth the grounds for the opposition.

The applicant must get a copy of each of these notices from the Registrar, and he or she has one month to reply to the copy in the way instructed by the Registrar with a counterclaim outlining the reasons for his application. The applicant's application will be declared abandoned if he or she does not comply.

If the applicant delivers the aforementioned counterstatement, the Registrar must give a copy of it to the parties sending notice or opposition and decide whether and under what circumstances, if any, a registration is to be allowed after hearing the parties, as necessary, and considering the evidence.

If the Registrar does not obtain adequate security from the person giving notice of opposition or the applicant delivering a counterstatement after receiving a copy of such a notice, the opposition or application may be deemed as abandoned.

The Ghanaian Act does not have an appeals provision, but Nigeria does. A decision taken by the Registrar in accordance with Section 20(4) of this Act may be appealed to the court in the manner provided for in Section 21 of the Act. If required, the court will hold a hearing with the parties and the Registrar about the appeal before issuing an order deciding whether and under what restrictions, if any, registration will be allowed. At the hearing of an appeal pursuant to this section, any party may introduce fresh evidence for the consideration of the court in the way permitted or with the express approval of the court.

No additional grounds of opposition to the registration of a trademark may be raised by an opponent or the Registrar on an appeal under this section, other than those stated in accordance with Section 20 of this Act by that opponent or any other opponent; and if any additional grounds of opposition are raised, the applicant shall be entitled, upon giving such notice as may be prescribed, to withdraw his application without payment of the costs to the opposing party.

The court may permit the trademark submitted for registration to be amended in any way that does not fundamentally impair its identity after hearing the Registrar on an appeal brought under this section. In any event, before being registered, the trademark must be advertised in the journal in the required manner.

The court may direct that an appeal be handled as an abundance if an appellant fails to furnish the security for the appeal's expenses required by this clause.

Sections 7 and 22 of the Ghanaian Act and the Nigerian Act respectively cover Registration Certificates. The applicant must be given a certificate of registration and the trademark must be registered in line with Ghanaian law if any of the following conditions are met:

- a. a timely challenge to the registration has not been made;
- b. Despite opposition to the registration, the applicant prevailed in court. When a trademark registration application for Part A or Part B of the register is accepted when the applicant is in Nigeria and either:
 - a. The notice of opposition date has passed and there hasn't been any opposition to the application;
 - b. Although there was opposition to the application, the applicant won that battle.

The Registrar shall register the trademark in Part A or Part B, as applicable, if the application was not accepted inadvertently.

For the purposes of this Act, the date of the application for registration must be assumed to be the date of registration, subject to the provisions of this Act relating to international agreements.

A trademark is legally recognized as of the date it is registered.

When a trademark is registered by the Registrar, the applicant must get a certificate of registration in the proper form, sealed with the Registrar's seal.

The Registrar may classify the application as abandoned due to the applicant's default if trademark registration is not finalized within 12 months of the application date. This will happen after notifying the applicant in writing in line with the established procedure.

Sections 5 and 6 of the Nigerian Act and Section 9 of the Ghanaian Act both describe the rights that the owner or registered user of a trademark may have by registration in conformity with the law. According to Salmond, a trademark that is legitimately registered under the Act "becomes

consequently a type of incorporeal property analogous to a patent or copyright, and confers upon the possessor an exclusive right to use it in respect of the classes of items in regard to which it is registered." (**Salmond, 1977**)

In other words, following registration, the owner or registered user of a trademark acquires certain exclusive rights.

However, in addition to the exclusivity rights, the very fact that a trademark has been registered establishes its legitimacy.

Once more, in order to file a complaint for infringement, a trademark must be registered. It is crucial to remember that registration in Parts A and B of the Nigerian trademark registry confers practically equal legal rights.

1.4 INFRINGEMENT OF TRADEMARK

The essence of a trademark and its registration in a trademark register are both targets of trademark infringement laws. It takes place when someone uses a trademark without being allowed to. It could be required in some circumstances to trick consumers into thinking that the products being imitated are those of the trademark owner. (**Nnodum J.T.U, 1992**)

The question is what precisely constitutes a trademark infringement. According to Section 5(2) of the Act of Nigeria,

The right to use a trademark granted by the aforementioned registration is unrestricted, but anyone who uses a mark that is identical to or confusingly similar to the trademark in the course of business with regard to any goods for which it is registered, without being the trademark's owner or a registered user using it in accordance with the permitted use, shall be deemed to have violated that right.

- a. a trademark being used; or
- b. When referring to someone who is legally permitted to use a trademark or the products that they are connected to in the course of their business, whether as the owner or a registered user, the use may be made directly on the products, close by, in a public advertisement, or in an advertising circular.

Under the Ghanaian Act *Section 9 (1 – 3) of the Act* provides thus:

A trademark may not be used by a third party in connection with any goods or services for which it has been registered without the owner's consent. Any of the following are grounds for legal action by the registered owner:

- a. unauthorized use of a trademark; or
- b. taking measures that make it more likely that someone may infringe .

No person shall knowingly breach the rights of the owner of a trademark by using the trademark without the owner's authorization in connection with products or services for which the trademark was registered.

Despite the aforementioned guidelines, the Nigeria and Ghana Act has provided a few exceptions to the registered owner or registered user's exclusive use of a trademark. (**Nigerian Trademark Act, Ghanaian Trademark Act, 2004**).

When the trademark holder loses because the consumer misunderstanding brought about by the infringer damages his reputation in the industry that is directly tied to his trademark, the law disapproves of trademark infringement since it constitutes unfair competition.

In *Bell Sons and Co. v Aka and Anor*, (**1972**) The Supreme Court stated that the purpose of trademark law is to prohibit both subtle and obvious infringement and that both the ears and the eyes must actively participate in the exercise of companionship. It is challenging to put a monetary value on reputation because it is a quality that is specific to a person, a group of people, or an organization. Because of this, it is illegal for anyone or any group of individuals to attempt to damage the reputation of another person.

The kinds or quality of the things that a person produces may determine how well-known they are. Since trademark infringement can only occur within the confines of the law, it is necessary to review the current legislation to ascertain whether an infringement has taken place.

It is crucial to remember that neither a trademark itself nor anybody else can file a lawsuit because a trademark is not a legal entity. The proprietor or owner of the trademark is the party that may bring or defend a lawsuit. The right to sue to prevent the registration of a mark that is confusingly similar to or identical to the owner's own registered mark exists. He may still file a case even though the offending mark is already registered. (**Maersk Line and Anor v Addide Investment Limited and Anor, 2002, Fawehinmi V.N.B.A No. 2 1989, Alban Pharmacy Ltd v Sterling Products International Inc. 1968, Beecham Group Ltd v Esdee Food Products Nig. Ltd 1980, Bubble Up International Ltd v Seven Up Company Ltd 1971, Re Marketing and Shipping Enterprises Ltd 1971, G. GoHchalk and Co. Ltd v Spruce Manufacturing Co. Ltd, 1956, The Wholesale Colonial Trading Co. v. Ikorodu Training 1934**). In some cases, a trademark that seems to be stealing from the registered trademark is allowed to persist. (**PZ and Co. Ltd v A. B. Chanrai and Co. Ltd 1971, ElektroTechnische Fabrik Schidmt etc v Bacteria Slany Narodni Podnic 1992, American Cynamid Co. v Vitality Pharmaceutical Ltd 1991, Aktieboluget Jonkopin Vulcan v Star Match Co. Ltd 1974, Ayman Ent. Ltd v Akuma Industry Ltd 2003**). To be considered trademark infringement, there must also be evidence that the violation will probably cause consumers to be misled or confused. (**Savage v Allen**)

Last but not least, the court considers the majority of Nigerians' low literacy rates when determining whether two trademarks are too similar and can cause consumer confusion. In *LRC International Ltd v Jena Trading Company* (**1976**) Omo Eboh J. granted the plaintiff's request for relief and made the following observation:

... Considering the Nigerian trading environment, the various classes of people who typically purchase such products there, the sounds of each word, and how they would to the illiterate or semi-literate, it was likely that the public would be misled and/or confused into believing that the defendant and the plaintiff were one and the same. (**Bubble Up International Ltd v Seven Up Company Ltd 1971, Netherlands Distillery v Henkes Distilleries 1935, United Kingdom Tobacco Company v Carreras Ltd 1931, Nwabachili C, 2017, Enemaku O, 2008**)

1.5 ACTION TO BE TAKEN TO FIX IT

There are a number of legal options available for dealing with any intellectual property rights violations, including trademark infringement. Nevertheless, it appears that the current Trademark Act in Nigeria and Ghana acknowledges the right to rectification, giving the court the option of pursuing extra common law or equitable remedies. The *Ghanaian Trademark Act's Section 20* on the rectification remedy states as follows:

Any fault that compromises the legality of the trademark registration cannot be the subject of a request for rectification. To make, erase, or change an entry, a person must apply to the Registrar. However, a person who feels harmed by the non-insertion, omission, error, or defect in an entry in the register or by an entry that improperly stays on the register may do so.

In the event that legal action has been taken against the trademark, the court where the application for register correction must be lodged.

At any point during the process, the Registrar may refer a request for rectification to the court if the Registrar receives it.

In situations where a registered trademark was fraudulently registered, transferred, or transmitted, the Registrar may ask the court for a correction.

The Registrar must receive proper notice of any rectification orders issued by the court and must follow them if they are given. A registered owner or someone the owner has allowed must apply to the Registrar.

- a. to update the trademark's description or file a correction for an error in the registered owner's name, address, or other details;
- b. to delete a trademark record and remove it from the registration;
- c. deleting any items or groups of items from the register of goods for which a mark is authorized; or
- d. to mention a trademark disclaimer or statement that doesn't extend the rights covered by the mark's existing registration.

A licensee of a trademark may correct an error or enter a modification to the name, address, or other information of the registered owner with the consent of the registered owner.

In Nigeria, *Section 38 of the Act* provides as follows:

Any person concerned who alleges

- a. that any entry has been either omitted from or not added to the register; or
- b. if any entry was made into the register without a valid justification;
- c. that inaccurate information is recorded in the register; or
- d. that there is an error or defect in every entry in the register,

can file an application with the court in the proper format, or, at the applicant's option and in accordance with Section 56 of this Act, they can file it with the Registrar. The Tribunal may then issue whatever order is required to make, void, or alter the entry as it sees fit. Note The Interpretation Section of the Act did not define person concerned but merely state does not include the Registrar.

The tribunal may, during any proceedings brought under this section, make a decision regarding any matter that must be resolved in respect to the rectification of the register.

In situations where there has been fraud in the application, transfer, or assignment of a registered trademark, the Registrar may apply immediately to the court under the provisions of this section.

Any court order requiring a register correction must specify how the correction should be communicated to the Registrar and how to deliver the notice; the Registrar must then make the required register corrections after receiving the notice. The power to modify the register conferred by this section includes the ability to change a registration from Part A to Part B. According to Section 40 of the Act, a register correction is permitted.

The rectification remedy gives a person the ability to ask for the correction of such a mistake in order to avoid a situation in which comparable trademarks are allowed to coexist and so cause confusion. Either the registry or the court may receive the applicant's application. The person must apply to the court if they believe they have been wronged or are worried about an ongoing activity. Subject to a court appeal, he may, if he previously applied to the Registrar, present the case to the court at any time during the proceeding or, after hearing from the parties, he may order them to resolve the matter among themselves.

Rectification is not given automatically; the complainant must demonstrate that there was confusion and deceit in addition to the trademark's similarity. In the case of *Electro Technische Fabriksch Schimdt v Bacteria Slang Narodni Podnic (1972)*, the appellants asked that the respondent's trademarks be struck from the register because they were identical to those of the plaintiff. Despite the identical trademarks, the court found that each party had utilized the mark separately. More importantly, the respondents had made extensive use of the aforementioned marks both before and after registration for a period of time totaling six years.

In an earlier case involving *Netherlands Distillery v. Henkes Distillery, (1935)* the West Africa Court of Appeal was more adamant in its viewpoint. The Divisional Court in Accra declined to make an order amending the Trademark Register by deleting from the register any trademarks registered there that are sufficiently identical to the appellants' trademarks as to be likely to mislead. This judgment was contested by the Netherlands Distillery. The knowledgeable judge denied the appeal and said:

Contrary to popular belief, the respondent did not alter his trademark with the intention of leading illiterate consumers to believe that the appellants would gain from the alteration. The Trademark that was being objected to had so been in use for approximately five years prior to the case's verdict. The appellants had plenty of opportunity to collect evidence of any consumers who had been duped or confused by these trademarks, but they were unable to do so. A one instance of this deceit or confusion would be a far more compelling indicator of its existence than any number of predictions that it will. (**Turton v Turton, 1889**)

The aforementioned makes it plainly clear that the court takes a strict approach when deciding who gets to use the corrective remedy. The court further held that the right of action for passing off can only arise or be available when a trademark registered under the Act is used in violation. In the case of *Ayman Enterprises Ltd. v. Akuma Industries Limited and Or (2006)*, the Supreme Court emphasized this stance. The appellant (plaintiff) in this instance brought this complaint against the respondent before the Federal High Court of Lagos (defendant). The plaintiff/appellant requested a court order prohibiting the defendant/respondent from producing, importing, selling, or providing wigs and hair accessories bearing the trademark "ORIGINAL QUEENS" or from copying its distinctive getup, logo, packaging, or label design for its "NEW QUEEN." Additionally, the appellant/plaintiff filed two motions: a *motio curiae* and an *ex parte Anton Piller* application. The court granted the Anton Piller order and all petitions by removing the property from the defendant/respondents. The respondent/defendant requested in a petition on notice that the trial court nullify the decisions rendered in the *ex parte Anton-Piller* case. The learned trial court rejected the defendant's attempt to set aside the Anton Piller while granting the plaintiff's motion for an interlocutory injunction.

After objecting to the decision, the defendant/respondent appealed it to the Court of Appeal. The trial judge's ruling was quashed by the Court of Appeal, which upheld the appeal. Unhappy, the plaintiff (appellant) appealed the ruling to the Supreme Court, and the defendant (respondent) filed a cross-appeal based on the passing-off claim. In *Kalgo JSC's* reasoning, ...The Federal High Court lacks jurisdiction over passing-off claims resulting from alleged trademark infringement unless the infringing trademark is registered. (***Patkun Industries Ltd v. Niger Shoes Manufacturing Ltd, 1988***)

Ayman's position on this matter is that the Trademark Act's pass-off relief is not applicable to unregistered trademarks. The remedy of rectification with all of its restrictions, as previously decided by the West African Court of Appeal in *Netherland Distillery v. Henkes Distillery*, is impliedly the whole relief recognized statutorily under the Trademark Act. This remedy will need to be reassessed in order to expressly make room for other remedies that can successfully implement the intricate infringement provisions of the Act. (***Enemaku O. 2008***)

1.6 CONCLUSION

This paper examines the laws governing trademarks in Nigeria and Ghana generally. It is recognised that new criminal and civil remedies under the Act will need to be specifically accommodated by the remedy of rectification under both Acts in order to enable effective enforcement of the serious violations listed by the Act.

Currently, laws in Ghana and Nigeria govern all of the various trademark-related matters. What constitutes trademark registration and what does not are subject to certain rules. The paper provides a case for their reform in future law because the provisions that the only option is repair are undeniably restrictive in both the Nigerian and Ghanaian Acts.

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