

# CASE DIGEST



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## **TRADEMARK: TRADEMARK REGISTRATION; INFRINGEMENT; HOW IS A TRADEMARK INFRINGEMENT DETERMINED?**

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**INTERNATIONAL TOBACCO (NIG.) LTD. & ORS. v. OLOLADE OGUNNIYI;  
RONKE OGUNNIYI; JOHANN WILHELM VON. EICKEN GMBH -  
(Interested Party) v. BRITISH AMERICAN TOBACCO (NIG.)  
LTD. & ANOR.**

SUPREME COURT OF NIGERIA

(KEKERE-EKUN; GARBA; OGUNWUMIJU; SAULAWA; JAURO, JJ.SC)

# Case Digest: The Topic

## Trademark: Trademark Registration; Infringement; How is a trademark Infringement determined?

INTERNATIONAL TOBACCO (NIG.) LTD. & ORS. v. OLOLADE OGUNNIYI; RONKE OGUNNIYI; JOHANN WILHELM VON. EICKEN GMBH - (Interested Party) v. BRITISH AMERICAN TOBACCO (NIG.) LTD. & ANOR.

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**(KEKERE-EKUN; GARBA; OGUNWUMIJU; SAULAWA; JAURO, JJ.SC)**

## Background Facts

British American Tobacco and Benson & Hedges (Respondents') case at the Federal High Court (trial court) was that the registered trademarks No.60722 "*Benson & Hedges*" (gold colour label mark) and No. 56629; "*Benson & Hedges*" (Tum to Gold Slogan) were clearly registered specifically with relation to the colour gold as part and the component of the trademarks to which the Respondents, as proprietors, are given the right to exclusive use and protection against unauthorized infringement under the provisions of section 5(1) and (2) of the Trade Marks Act. There was no dispute at the trial court that the Respondents' trademarks No. 60722 and No. 56629, in particular, were registered in relation to and specifically with/in respect of the colour gold in addition to and as part of any component of the brand name "Benson & Hedges", as prescribed and envisaged by the provisions of section 16(I) of the Act.

The trial court entered judgment in favour of the Respondents for the infringement of their trademark of the Gold Specification Pack of "Benson and Hedges" cigarettes by International Tobacco (Nig.) Ltd. Ololade Ogunniyi; Ronke

Ogunniyi; Johann Wilhelm Von. Eicken Gmbh (the Appellants), who were the distributors of the "Tradition" brand of cigarettes manufactured by the interested Appellants. Aggrieved by the decision of the trial court, the Appellant appealed to the Court of Appeal (lower court) which affirmed the decision of the trial court.

Aggrieved by the decision of the lower court, the Appellants appealed to the Supreme Court. One of the issues raised for determination was: *Whether the sale by the Appellants of the cigarette brand as "Tradition" packaged in a gold-coloured pack infringed any of the Respondents' registered trademarks?*

## Arguments

The Appellants' argument on this issue is that in an action for infringement of a trade mark, it is the registered trademark mark as in the register of trademarks that should be compared with the alleged offending trade mark and not the one on the product of the registered proprietor of the trade mark and so, in order to determine whether the "Tradition" cigarettes in gold coloured pack (exhibit F)

constitutes an infringement of any of the registered trade mark claimed by the Respondents in this case, exhibit F must be compared to those trade mark as entered in the register of trademarks, with all the implications of such entries. According to learned counsel for the Appellants, since the Respondents' trademark was not registered with any colour limitation, the colour of any presentation of the trade mark is immaterial, and does not form part of the registration such that it cannot be compared with exhibit "F" in order to determine whether the right of its proprietor has been infringed by the sale of exhibit "F". The court was urged to hold.

The Respondents' reply to the Appellants' argument on this issue is that the gold colour was, for all intents and purposes, part of what was registered, for the other registered trade mark of "Turn TO GOLD" would make no sense if the Respondents had not considered the gold colour as an important

component of its trade mark and registered same for its gold colour pack of Benson & Hedges cigarettes. Counsel further argued that the test for ascertaining infringement is to employ two (2) senses of human being; ears and eyes to arrive at a conclusion on the average memory arising from general recollection. That the question is whether a person who sees a proposed trademark in the absence of the other trademark and in view of only his general recollection of what the nature of the other trademark was, would be liable to be deceived and to think that the trademark before him is the same as the other of which he has a general recollection. The question, according to counsel, is not whether if a person is looking at two trademarks side by side, there would be a possibility of confusion. The court was therefore urged to resolve the issue in favour of the Respondents and in conclusion, to dismiss the appeal with substantial costs.



# Decision Of The Court

In resolving the issue, the Supreme Court held thus:

An essential element of a device claimed to be a trademark is that it identifies the goods of a particular merchant and distinguishes them from the goods of others. A word, symbol, shape or colour serving this purpose is said to be distinctive. Certain marks are inherently distinctive over time. In determining whether a trademark has infringed another, it is the offensive or offending trademark that is considered such that whether the person who sees the offending trademark in the absence of the one breached, and in view of his general recollection, the nature of the offending trademark is likely to deceive him into thinking that the trademark before him is the authentic one. In the instant appeal, the "Tradition" cigarette pack infringed on the essential feature which was prominent to look alike, resemble and identical to the trade mark of the Respondents' "Benson & Hedges" brand pack, in a confusing and deceiving manner to warrant the grant of the reliefs granted by the lower courts.

Issue resolved in favour of the Respondents.

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