

Determination of the Element of Distinctiveness in a Trademark

In the Supreme Court of Nigeria
Holden at Abuja
On Friday, the 3rd Day of March, 2023

Before Their Lordships

Kudirat Motonmori Olatokunbo Kekere-Ekun
Mohammed Lawal Garba
Helen Moronkeji Ogunwumiju
Ibrahim Mohammed Musa Saulawa
Adamu Jauro
Justices, Supreme Court

SC.181/2009

Between

1. INTERNATIONAL TOBACCO NIGERIA LIMITED
2. OLOLADE OGUNNIYI
3. RONKE OGUNNIYI **APPELLANTS**
4. JOHANN WILHELM VON. EICKEN GMBH **INTERESTED PARTY/APPELLANT**

And

1. BRITISH AMERICAN TOBACCO NIGERIA LIMITED
2. BENSON & HEDGES (OVERSEAS) LIMITED **RESPONDENTS**

“... Once the trademark, by frequent use, has acquired notoriety in the trade to the common knowledge and common and easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness.”

(Lead Judgement delivered by Honourable Mohammed Lawal Garba, JSC)

Facts

The 1st Appellant is the distributor of the “Tradition” brand of cigarette, manufactured by the Interested Party, in Nigeria. The 1st Respondent on the other hand is the distributor of the “Benson and Hedges” cigarette brand, manufactured by the 2nd

Respondent. The Respondents instituted an action against the 1st – 3rd Appellants before the Federal High Court, in which they claimed that the colour “gold” in the packaging of the Tradition cigarette constituted part of the 2nd Respondent’s registered trademark on its “Benson and Hedges” cigarette brand and this infringed the Respondents’ exclusive right to the registered trademark.

The trial court in its judgement held that the colour “gold” constituted part of the 2nd Respondent’s registered trademarks No. 607222 and which by reason of long or extensive use of the “Benson and Hedges” gold coloured pack had also become distinctive or synonymous with the Benson and Hedges cigarette brand; and as the proprietors, their right to the exclusive use of the trademark had been infringed upon by the Appellants’ “Tradition” cigarette.

In an appeal filed against this decision at the Court of Appeal, the Court of Appeal affirmed the findings of the trial court. Dissatisfied, the Interested Party (Appellant), who did not participate in the proceedings before the trial court, appealed to the Supreme Court as an interested party, pursuant to the leave of court granted to it.

Issue for determination

The Supreme Court considered the following issue in its determination of the appeal:

Whether the Court of Appeal was right when it upheld the findings of the trial court that the colour “gold” constituted part of the Respondents’ trademarks on their “Benson & Hedges” cigarette brand and the sale of the Appellants’ “Tradition” cigarette brand packaged in a gold-coloured pack infringed the Respondents’ trademarks.

Arguments

Counsel for the Appellant argued that by Section 16 of the Trademarks Act, in order for a colour or colours in which the representation of a trademark appears, to be deemed as having been registered as part of the trademark, the trademark must have been limited to the particular colour or colours. He argued that in so far as there is no statement of colour limitation on any of the copies of the certificates of registration of the Respondents’ trademarks or in the extracts of the register of trademarks admitted in evidence at trial, neither the Trademark No. 60722 or any other trademark claimed by

the Respondents was limited to the colour “gold”, or to any other colour and so the colour “gold” was not registered as part of what was registered in any of the said trademark registrations. In further argument, he posited that where there is no evidence that a trademark is limited to the colour in which it was registered, the colour cannot be deemed to be part of what was registered and if any component of a registered trademark is not deemed as what was registered, it constitutes an unregistered trademark for which no action for infringement of trademark can be sustained. He submitted further that in an action for infringement of trademark, it is the registered trademark in the register of trademarks that should be compared with the alleged offending trademark and not the one on the product of the registered proprietor of the trademark. Thus, in order to determine whether the “Tradition” cigarettes in gold coloured pack (“Exhibit F”) constitutes an infringement of any of the registered trademarks claimed by the Respondents, Exhibit F must be compared to those trademarks as entered in the register of trademarks with all the implications of such entries. He posited that since the Trademark No. 60722 was not registered with any colour limitation, the colour of any presentation of the trademark is immaterial and does not form part of the registration such that it cannot be compared with Exhibit F in order to determine whether the right of its proprietor has been infringed by the sale of Exhibit F.

In response, counsel for the Respondents submitted that one of the prominent features of the Respondents’ registered trademark No. 60722 on its Benson and Hedges (gold colour label mark) includes the gold colour and this entitles the Respondents to exclusive use of the colour and protection against infringement. He contended that the findings of the lower courts were based on the evidence that the gold colour that appeared on the Trade Marks Certificate of Registration No. 60722 forms part of components of the Respondents’ Benson & Hedges Trademark which they adopted in packaging the Benson & Hedges brand of cigarettes in Nigeria and that the gold colour of the pack as shown in the certificate has acquired distinctiveness as a result of long registration, commercial usage and vigorous advertising from 1973. He argued further that from the evidence at trial, the colour “gold” was, for all intents and purposes, part of what was registered for the other registered trademark of Benson & Hedges “Turn to GOLD”; hence, the colour is an important component of the Respondents’ registered trademark with the gold colour pack being distinctive of the Benson & Hedges cigarette brand.

Court’s Judgement and Rationale

In determining the appeal, the Supreme Court referred to the provision of Section 5(1) and (2) of the Trade Marks Act that *the owner or person for who a trademark is registered and entered in the Register of Trade Marks becomes the proprietor of such trademarks who is given and vested with the exclusive right to use the trademark in relation to the goods for which it was registered as well as protection from unauthorized use and infringement by other persons in relation to such goods.* The court also referred to its decision in **DYKTRADE LTD v OMNIA NIG. LTD (2000) 7 SC (PT. I) 56** that a trademark when registered, will entitle the proprietor to use or institute an action for any infringement of the trademark.

The apex court held that *from the facts and evidence placed before the trial court, the Respondents' registered Trade Mark No. 60722 "Benson and Hedges (gold colour label mark) and Trade Mark No. 56629 "Benson & Hedges" (Turn to Gold slogan) are clearly registered specifically with relation to the colour "gold" as part and component of the trademarks and in addition to the brand name "Benson & Hedges", to which the Respondents, as proprietors, are given the right to exclusive use thereof and protection against unauthorised use and infringement by any other person, under Section 5(1) and (2) of the Act; and as a limitation to colour in the trademark as envisaged under Section 16(1) of the Act. The colour "gold" is therefore not just a mere decoration or embellishment, but an essential feature of the registered trademarks which makes it different and distinct for the Respondents to be entitled to its exclusive use as the beneficial owners and proprietors thereof.*

On the character of the Respondents' registered trademarks and in considering whether the element of distinctiveness of the Respondents' trademark exists in relation to the gold packaging of their "Benson & Hedges" cigarette brand, the court relied on its decision in **FERODO LTD v IBETO IND. LTD (2004) 5 NWLR (PT. 866) 317** per Honourable Niki Tobi JSC that *the element of distinctiveness is consonant to and predicated on some age by way of long or extensive use. What constitutes long or extensive use is a question of fact. It is certainly not the age of Methuselah. Once the trademark, by frequent use, has acquired notoriety in the trade to the common knowledge and common and easy identification of persons in the trade, it will be said to have acquired the character of distinctiveness. In other words, the trademark has no hiding place so much so that to the eyes of the public, people say with chorus or union, of course that is the trademark of XYZ, as it identified the goods.*

Further to the above, the Supreme Court upheld the findings of the Court of Appeal thus: *apart from the fact that gold colour formed a component of the Respondents' registered trademark, the colour had also acquired distinctiveness ascribed to the Respondents by virtue of their long and extensive use of the same in the Benson &*

Hedges cigarettes pack since 1973. Additionally, the promotional adverts of the cigarette brand which emphasize the gold pack and gold quality of the cigarette together with the gold colour and slogan displayed in the Respondents' trademarks certificates and Representation of Trademark contained in the extract which the trial court took into consideration, all buttressed the distinctiveness of the colour "gold" to the "Benson & Hedges" cigarette brand.

In determining whether the Appellants' "Tradition" cigarette packaged in a gold-coloured pack infringed the Respondents' trademarks, the court endorsed the findings of the Court of Appeal that *the criterion for determining whether or not there is an infringement of a trademark is that the mark complained of must not, when compared with what is already registered, be identical with the registered trademark as to deceive the public or cause confusion in the course of trade* - Section 5 (2) of the Trade Marks Act. Their Lordships held that having perused the evidence on record of the Respondents' witnesses, one of whom testified as a businesswoman who sells cigarettes and another who testified as a longtime smoker of the "Benson & Hedges" brand, there was credible and uncontroverted evidence on the deceiving and confusing similarities of the "Tradition" cigarettes presentation with that of the Respondents' "Benson & Hedges" brand of cigarettes. It follows therefore that no other logical conclusion can be arrived at than the conclusion that the Appellant's "Tradition" cigarette pack is practically confusing and deceptively similar to and would be mistaken for the Respondents' Benson & Hedges gold specification cigarette pack of cigarette by undiscerning members of the public, merchants and consumers. The gold packaging of the "Tradition" cigarette thus infringes on the Respondents' registered TradeMark Gold Specification Pack of Benson & Hedges.

Appeal Dismissed.

Representation

O.F. Olukoya Esq. for the Interested Party/Appellant.

Respondents absent and unrepresented.

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