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## LIKELIHOOD OF CONFUSION THE BEDROCK FOR DETERMINATION OF TRADEMARK REGISTRABILITY AND INFRINGEMENT IN NIGERIA

BY

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### Abstract

Trademark law in Nigeria, like in many other jurisdictions, seeks to protect the distinctive nature of trademarks and prevent consumer confusion in the marketplace, by so doing, prohibits the registration of a trademark which is confusingly similar to an already existing trademark and which is likely to deceive or cause confusion in the course of trade. While the provision of the law could not be any clearer, the decision of whether a trademark is confusingly similar to an already existing trademark is often reserved for the interpretation of the courts and this has over the years, been the gravamen of many intellectual property infringement disputes. Granted that the concept of likelihood of confusion plays a crucial role in determining the strength and validity of trademark rights, this paper intends to carefully examine the factors considered by the courts/tribunals in deciding whether two trademarks are confusingly similar and to provide a comprehensive explanation of the determination of likelihood of confusion in trademark law in Nigeria. The question of what constitutes trademark infringement in Nigeria is fundamental in the protection of intellectual property rights, this article therefore is aimed to come to the rescue taking a ride from the background of trademark and what it indeed represents.

**Keywords:** Confusion, Trademark, Registrability, Infringement

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### 1. Introduction

Trademark law in Nigeria is an important part of protecting brand owners' rights and ensuring a fair and competitive market. One of the most important terms in protecting trademark owners' interests and consumer protection is the likelihood of confusion. For trademark registration eligibility, the concept of likelihood of confusion comes to the fore, and the Trade Marks Act of Nigeria<sup>1</sup> sets out the rules for registration, protection, and enforcement of trademarks. This concept refers to the chances that consumers will be confused as to the origin of a product or service because of similarities between two or more related trademarks, and it is a key factor in avoiding consumer confusion, fraud, deceptiveness, and the dilution of a trademark's distinctive value. The likelihood of confusion concept is determined by looking at some factors, such as similarity of marks, similarity of goods and services, intent of

the trademark user, actual confusion, prior existing marks, strength of the mark, consumer awareness, channel of trade, etc. in recent times, trademark infringement has been acerbated by e-commerce and internet/cyber-based transactions. Some of the common trademark issues in e-commerce include: selling counterfeits goods through e-commerce mode and identifying infringers, determining jurisdictions in online trade infringement cases, etc. We shall also review the legal framework that have shaped how the likelihood of confusion is understood and applied, the intricacies and difficulties associated with trademark protection and fair competition. Above all, provide insight into potential areas of improvement, all of which will contribute to the continuous development of Nigeria's trademark law and regime.

### 2.0 Brief Background of Trademark

Distinguishing a property, service, or product through a distinct mark has always been part of human's interactive experience. Traders have distinguished their goods by marking them from the earliest times. In ancient times, trademarks were used on Egyptian and Chinese objects and found on Lascaux cave paintings, which

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<sup>1</sup> Cap T13, Laws of the Federation of Nigeria, 2004



predate the Roman Empire. Excavated artifacts show that Roman craftspeople left their distinctive marks on pretty much everything they made – tableware, brickwork and roof tiles, decorative vases, gravestones, lead slingshot ammunition, and even plumbing. Historical facts also indicate that since 3,000 years ago, Indian craftsmen often engraved their signatures on their artistic creations before sending them out for sale in other countries. In many West African countries, distinct marks were used on pottery, handicraft, spears, and livestock as a form of personal claim. According to the Mathy Committee Report of 1974, goods have been marked in various ways since the Greek and Roman Times.<sup>2</sup>

As modern capitalism grew and transnational trade expanded, the drive to label products as a form of identity, and sell goods and services using marks, brands, and names gained momentum. The rise of the Guild during the medieval period also brought about developments in the use of distinctive marks. The development of marks known as ‘merchant marks’, gained popularity, and brand symbols among traders and merchants increased significantly around the start of the Middle Ages as necessary means of identifying goods and promoting the circulation of quality products in society. Marks also regulated and prohibited the mass production of articles of inferior quality and protected consumers, in addition to serving as a means of advertisement for brands. By the nineteenth century, it was clear that marks applied to goods that had become distinctive had an intrinsic value and were worthy of some form of legal protection. One of the earliest identifiable statutes on trademarks was passed under the rule of Henry III in 1266 and adopted by the British Parliament. It required bakers to label their bread with distinctive marks for sale. Notably, however, modern trademark laws emerged in the late 19<sup>th</sup> century, it was clear that marks applied to goods that had become distinctive, had an intrinsic value, and were worthy to some form of legal protection. Such protection was available through the use of Royal Chambers and Court action.<sup>3</sup> Trademarks play important role with the emergence of industrialization and have since become key means of guarantying quality sources as well as giving businesses enormous security to lunch and advance their goodwill.

### 3.0 Nature, Objectives, and Functions of Trademark

Trademark basically, with precision indicates source or origin of goods. It is a gateway linking consumers to company that produces goods of their choice or delivers services. Invariably, trademark are used to distinguish an undertaking, its product, and services from those of other undertakings in the industry. In *Dristan Trademark*<sup>4</sup> the court stated that ‘a trademark is meant to distinguish the goods made by one person from those made by another... Its object is to indicate a connection in the course of trade between the goods and some person having the right to use the mark either with or without any indication of the identity of that person.’

<sup>2</sup> J H Mike and G Uloko, *Modern Approach to Intellectual Property Laws in Nigeria* (Lagos: 2nd edn., Princeton & Associates Publishing Co. Ltd 2022) p. 276

<sup>3</sup> J H Mike and G Uloko, *Ibid.* p 277

<sup>4</sup> [1986] RPC 161

In addition to the origin function, consumers over time, attach some level of quality to products or services emanating from a particular company. Here, there is expectations of standard of quality based on repeated satisfied patronage on any such goods with same trademark affixed on. It also means that trademark serves as a guarantee of quality to consumers,<sup>5</sup> thereby reducing undue stress, time, and costs associated with having to try different alternatives. In line with this function, trademark also serve consumer protection function<sup>6</sup>. Consumers can be protected, through trademark, from buying goods of lesser quality than their expectation or experience based on repeated usage or interaction with trademarked goods and services. Trademark therefore operates as a shortcut to get consumers to where they want to go, by so doing, performs a key function in a market economy.

Above critical roles leads businesses to invest in advertisement in order to sensitise the public on their trademarks and why they should choose and insist on their products. Trademark are used to attract customers’ loyalty and ensure continuing patronage, and this lead to establishment of goodwill with respect to the mark. Reputation leads to business prosperity having gained the confidence and trust of the consuming public. Companies invest heavily in the promotion and protection of their trademarks, propelling the need that trademarks are protected to ensure owners recoup back their expenses and gets reward for their investment. Provisions protecting well-known marks for an instance are not just concerned about the origin function of the mark or protection against confusion, they also protect the economic value of a trademark, particularly its reputation and its advertising value or selling power.<sup>7</sup>

J H Mike and G Uloko likewise in their book itemized functions of trademark as follows: The Origin function, the Identity function, the Quality function, the Economic function, the Promotion function, the Advertisement function, and the Information function.<sup>8</sup>

### 4.0 Legal Framework for Trademarks in Nigeria

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises<sup>9</sup>. Trademarks are protected by intellectual property rights. A trademark 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 good and some person having the right either as a proprietor or registered user to use the mark<sup>10</sup>.

<sup>5</sup> *Scandecor Development AB v Scandecor Marketing AB* (2001) UKHL 21

<sup>6</sup> *D O Oriakhogba and I A Olubiye, Intellectual Property Law in Nigeria Emerging Trends, Theories and Practice* (Benin: Paclerd Press Limited 2021) p 353 para 22.9

<sup>7</sup> *D O Oriakhogba and I A Olubiye, Ibid* p 354 para 22.11

<sup>8</sup> J H Mike and G Uloko, *Modern Approach to Intellectual Property Laws in Nigeria* (Lagos: 2nd edn., Princeton & Associates Publishing Co. Ltd 2022) pp. 275-276

<sup>9</sup> “Trademarks” <<https://www.wipo.int/trademarks/en/>>

<sup>10</sup> *Alliance International Ltd v. Saam Kolo International Enterprises Ltd* (2010) LPELR-CA/L/147/2003



The relevant law that governs Trademark in Nigeria is the Trademarks Act, Laws of the Federation of Nigeria 2004 (LFN 2004). The said Act and the Trade Marks Regulations are the principal legislations. Distinctive signs—words, logos, symbols, and other identifiers used to differentiate goods or services in the marketplace—are protected by the legal framework. Trademarks can be registered with the Nigerian Trade Marks Registry<sup>11</sup>, which is run by the Ministry of Industry, Trade, and Investment, to receive protection. Registration provides legal recourse in the event of infringement and gives the trademark owner the sole right to use the mark in connection with the designated products or services.

The worldwide classification system<sup>12</sup> is adopted by the Trade Marks Act of Nigeria, and to register a trademark, an applicant must follow the procedures specified in the Trade Marks Regulations. Nigeria notably enjoys some degree of harmonization with international trademark standards as a signatory of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the Paris Convention for the Protection of Industrial Property. Nigerian trademark rights are territorial, meaning they are protected only inside its borders and can only be enforced in accordance with local laws and regulations. Nigeria's legal system also permits trademark rights to be assigned and licensed, which makes trademark maintenance and commercialization in the nation even easier.

In Nigeria, trademark owners may seek remedies like injunctions, damages, and orders for the destruction of infringing items through legal actions before the courts. This is known as trademark enforcement. The Nigerian legal system offers a comprehensive strategy to combat counterfeiting and unauthorized use of trademarks by acknowledging both civil and criminal actions for trademark infringement. Owners of trademarks must periodically renew their registrations to preserve trademark protection<sup>13</sup>; otherwise, they risk losing their rights. Nigerian trademark law seeks to safeguard consumers, foster fair competition, and support the growth of the nation's robust intellectual property ecosystem.

## 5.0 Requirements and Procedures for Registration

### 5.1 Cursory steps to take by applicants for trademark registration in Nigeria:

- a. **Application:** A written application in a prescribed manner shall be filed with the Nigerian Trademarks, Patents, and Designs Registry (TPD), either in Part A or in Part B of the register.<sup>14</sup> Shall include among other demands the applicant's details, a representation of the trademark, a list of goods or

services, and the class of goods or services to which the trademark pertains.

- b. **Examination:** After filing the application, the TPD conducts a general examination to check if the trademark meets the necessary requirements. This includes verifying the trademark's distinctiveness or capability to be distinctive. Not deceptive, and does not conflict with existing registered trademarks. Subject to the Act, the Registrar may refuse the application or accept subject to such amendments, modifications, conditions, or limitations.<sup>15</sup>
- c. **Publication:** If the trademark application is accepted, it is published in the Trademarks Journal, allowing others to oppose the registration within a specified period.<sup>16</sup>
- d. **Opposition:** During the publication period, interested parties can file a notice of opposition, stating the grounds for opposing the trademark registration. This could occur when the proposed trademark is similar to an existing registered trademark or if it is likely to cause confusion among consumers. This window is permitted within two months from the date of the publication under section 19 of the Act of notice of an application.<sup>17</sup>
- e. **Registration:** If no opposition is filed or if the opposition is unsuccessful after may be hearing an appeal in court<sup>18</sup>, the trademark will proceed to registration. The applicant will receive a certificate of registration, granting exclusive rights to use the trademark in Nigeria for the specified goods or services.<sup>19</sup>

In Nigeria, trademark summarily meets certain requirements for registration, and that includes:

- i. **Distinctiveness:** The trademark must be capable of distinguishing the applicant's goods or services from those of others
- ii. **Non-descriptiveness:** The trademark should not describe the goods or services it represents
- iii. **Non-deceptiveness:** The trademark must not be misleading or likely to deceive the public
- iv. **Non-conflict:** The trademark must not conflict with existing registered trademarks or well-known marks

## 6.0 Infringement of Trademark

A Trademark is a unique sign or mark that distinguishes the goods and services of one business from another. A mark can either be a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. Most businesses, companies, or organizations have distinctive marks that sets them apart from other businesses. The registration of a trademark confers exclusive rights to use the mark on the registered proprietor in relation to the goods or services for which the trademark is registered. Any unauthorized use of the mark that is likely to adversely affect the origin or source function of the marks therefore constitutes an infringement for which the proprietor is entitled to sue and seek for

<sup>11</sup> The body overseeing trademark registration in Nigeria, located at Abuja. It handles the processing of trademark applications, conducts examinations, and issues certificates of registration. It maintains a comprehensive database of registered trademarks and provides services for trademark renewals, assignments, and licensing.

<sup>12</sup> also known as Nice Application

<sup>13</sup> s. 23 of Trade Marks Act Cap T13, Laws of the Federation of Nigeria, 2004

<sup>14</sup> Trade Marks Act, section 18

<sup>15</sup> Trade Marks Act, section 18(2)

<sup>16</sup> Trade Marks Act, sections 18, 19

<sup>17</sup> Trade Marks Act, section 20

<sup>18</sup> Trade Marks Act, section 21

<sup>19</sup> Trade Marks Act, section 22



civil remedies,<sup>20</sup> not excluding criminal remedies (all codified in Laws of the Federation of Nigeria, 2004)<sup>21</sup>

Meanwhile, in proceedings before the Registrar under the Act, the Registrar shall have power to award to any party such cost as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the court or a judge thereof, be enforced in the same manner as a judgment or order of the court to the same effect.<sup>22</sup>

A trademark is therefore infringed when a person without consent from the trademark owner uses the mark or an identical mark in a way that is likely to deceive the public or cause confusion. The court with jurisdiction for trademark proceeding in Nigeria is the Federal High Court. The burden of proof lies on the Proprietor of the trademark to show that his right has been infringed upon. Section 5 (2) Nigeria Trademarks Act provides that:

Without prejudice to the generality of the right to the 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 trademark 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...<sup>23</sup>

## 7.0 Definition and Significance of the Likelihood of Confusion

In the context of trademark law, likelihood of confusion refers to the chance or potential that, because of two trademarks' similarities, customers would be mistaken or confused about the origin, affiliation, source, or sponsorship of products or services. It is crucial in figuring out if there has been trademark infringement.

The exclusive right to which a registered trademark owner is entitled to is provided for in section 5(1) of the Act<sup>24</sup>. Section 5(2) of the Act<sup>25</sup> stipulates that anyone who uses a mark that is identical to the registered trademark or that is so similar that it will likely deceive or cause confusion in the course of business, without being the registered user or owner of the trademark, will be found to have violated the right to use the trademark. Additionally, the Act provides that no trademark may be registered for goods or descriptions of goods that are identical to another owner's trademark already on the register for the same goods or

<sup>20</sup> Available civil remedies include damages, injunction (including Anton piller), delivery up, and account of profit

<sup>21</sup> Criminalizing trademark infringement is to curb organized crime groups that deals on counterfeit, false or deceptive goods thereby endangering the health, safety and wellbeing of the public. Legislations that provide for criminal liabilities are: Merchandise Marks Act, Cap M10; Trade Malpractices (Miscellaneous Offences) Act Cap T12; Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act Cap C34.

<sup>22</sup> Trade Marks Act, section 47

<sup>23</sup> The owner of an unregistered trademark on the other hand may however institute an action for passing off where goods have been passed off as that of the plaintiff.

<sup>24</sup> Trade Mark Act Cap T13, Laws of the Federation of Nigeria, 2004

<sup>25</sup> Ibid

descriptions, or that so closely resembles a trademark as to be likely to induce confusion or deception<sup>26</sup>. Therefore, it is reasonable to infer from the Trade Mark Act that using marks<sup>27</sup> that are identical to or similar to one another - such as a device, brand, heading, label, ticket, name, signature, word, letter, or numeral - as a trademark constitutes a likelihood of confusion.

The likelihood of confusion is of great importance with respect to trademark as it is the bedrock for determining whether or not in a circumstance there is an infringement of trademark. The Trade Mark Act prohibits the registration of trademark or a part of a trademark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality<sup>28</sup>. A mark is deceptive where it is capable of misleading the public with regards to the character, quality, or origin/source of the goods to which it relates.<sup>29</sup> Consequently, any mark sought to be registered which is similar or identical to an already registered trademark will not be registered as it will amount to an infringement on the registered trademark. The purport of this is to ensure the protection of the rights of owners of validly registered trademark and consumers by extension.

## 8.0 Major Factors the Court considers in resolving issues of Likelihood of Confusion

Section 5 (2) (a) (b) of the Nigerian Trademark Act generally raised the consciousness of the concept of likelihood of confusion. Judicial precedents (to be discussed *hereunder*) points to the crucial nature of the concept and the need to examine it more closely. In determining the likelihood of confusion of trademark, several factors are considered by the court. However, the widely test that really determines whether two marks are confusingly similar or identical is "whether a person who sees a mark is likely to confuse it with an existing one, as to create the impression that the new trademark is the same as the existing one"<sup>30</sup>. This has been decided in a plethora of cases including *Ferodo Limited & Anor. v. Ibeto Industries Limited*<sup>31</sup> and *Alban Pharmacy Ltd v. Sterlin Products*<sup>32</sup>. This is considered from the point of view of a reasonable man with average intelligence and imperfect recollection because rarely will a purchaser of a product have the opportunity for detailed comparison. Thus, he must rely on his last recollection of the mark that he is used to seeing on the goods that he is used to and seeking to buy. Other factors considered are in exhaustive and applied based on the fact of each case, as discussed thus:

### 2. Similarity of the Marks

The court here considers how the mark is pronounced, how it looks, and how the competing marks are verbally translated. In a

<sup>26</sup> Trade Marks Act, section 13

<sup>27</sup> Trade Marks Act, section 67

<sup>28</sup> Trade Marks Act, section 11(a)

<sup>29</sup> *D O Oriakhogba and I A Olubiye, Intellectual Property Law in Nigeria Emerging Trends, Theories and Practice (Benin: Paclerd Press Limited 2021) p 364 para 23.9*

<sup>30</sup> *Ferodo Limited v Ibeto Industries Limited 2004 LPELR*

<sup>31</sup> (2004) LPELR-SC.95/1999

<sup>32</sup> (1968) All NLR 112



nutshell, it looks to see if the mark would confuse the public when viewed in isolation. This factor allows the mark to be evaluated as a whole rather than only for some of its unique attributes. This factor will be further discussed under three categories. They include:

#### a. Physical or Visual similarity

In trademark parlance, visual similarity is the degree of visual similarity or resemblance between two marks when viewed side by side. It focuses on the visual components, including the marks' overall look, design, form, color, and placement. An assessment is made on the overall visual impression that the marks produce. Examining the arrangement of shapes, colors, and other eye-catching details is part of this process. Analysis is done on how comparable the design elements—such as logos, symbols, or graphical representations are. This entails contrasting the marks' usage of forms, lines, patterns, and other visual components.

In the case of *Virgin Enterprise Limited v Rich Day Beverages*<sup>33</sup>, the plaintiff registered the trademark "virgin" written in small letters and used for aerated waters and other non-alcoholic drinks. The defendant filed an application to register "VIRGIN TABLE WATER" all in capital letters. The court of appeal in holding that both marks were identical stated that an unwary purchaser who sees or has seen the proposed "VIRGIN TABLE WATER" will see same as identical with the existing trademark "virgin" and will believe that the proposed mark is the same as the existing one.

In the High court Chancery Division<sup>34</sup>, in *Ouvah Ceylon Estates Limited v. UVA Ceylon Rubber Estates Limited*<sup>35</sup>, the defendants ignorantly registered as 'Uva Ceylon Rubber Estates Limited' without realizing the plaintiffs whose business at the date of the action was the growing of tea and rubber, had a trademark at that date and for some years previously on the Register of Joint Stock Companies as the Ouvah Ceylon Estates Ltd. The court issued a perpetual injunction on the ground that the similarity of names would invariably lead to confusion and to interference with the plaintiffs' business.<sup>36</sup> Some trademarks which have been found by courts to be confusingly similar include *Casoria v Castoria*<sup>37</sup>, *Trucool v Turcool*, *Hypnotiq v Hopnotic*.

Simply comparing the physical features of two competing trademarks is insufficient in itself to arrive at a conclusion of whether two trademarks are confusingly similar. By virtue of the Act, the competing trademark should also be "likely to deceive or cause confusion in the course of trade". As a matter of fact, trademarks which appear to be physically similar may coexist in so far as the purchasing public is not confused<sup>38</sup>.

#### b. Phonetically Similar Trademarks

When it comes to trademarks, phonetic similarity is the similarity or resemblance in the way two marks sound when spoken or pronounced aloud. It focuses on the sounds associated with the marks and how they could cause confusion or pronunciation resemblance. The sounds, syllables, and stress of the markings are taken into consideration when analyzing their pronunciation. Words with the same or similar pronunciation but different spellings or variants might be considered. When considering markings that are presented in several languages or dialects, this is very important. Words that sound the same but have distinct meanings are considered e.g. swift and fast<sup>39</sup>. When determining whether the average consumer is likely to be deceived or confused about the origin of products or services upon hearing the marks, phonetic similarity analysis plays a crucial role in trademark law. In the case of *British American Tobacco & Anor v Int'l Tobacco & 2 Ors*<sup>40</sup> the court held that in determining whether two trademarks are identical or of close resemblance, two senses of the human being are employed and these are the senses of the ear and eyes to arrive at a conclusion on the average memory arising from general recollection. Thus, sound is equally important<sup>41</sup>.

In the exercise of comparison not only the visible inspection is important, the sound is equally important. The sound which is assimilated by ear is important when a telephone conversation takes place<sup>42</sup>.

In *Beecham Group Ltd. v. Essdee Food Products Nigeria Ltd*<sup>43</sup>, the plaintiffs/respondents sued the defendants/appellants for infringement of their trademark "Lucozade". The defendants/appellants had put in the market and offered for sale and sold a non-alcoholic beverage under a trademark called "Glucose aid". The Court of Appeal held that Glucose-aid in sound is confusing to "Lucozade" and it will undoubtedly mislead the public. The court in *Magdalena Securities Ltd's application*<sup>44</sup> invoked the factor of the sense of hearing before it came to the conclusion that "UCOLITE" was too near to COALITE for registration. In *Coca-Cola Co. of Canada Ltd. v. Pepel Cola Co. of Canada Ltd.*<sup>45</sup> it was held that Pepel Cola was not an infringement of Coca-Cola as the letters 'C' and 'P' are very clearly distinguishable not only as letters but also in the sound produced when each letter is pronounced.

Also, in the case of *Nigeria Distillers Limited v Gybo and Sons & Anor*<sup>46</sup>, the main issue was whether the name "Cacchus", which was stated on the label of the Defendants' tonic was similar or identical to the Plaintiff's mark, "Bacchus" trademark. The court

<sup>33</sup> (2009) LPELR-CA/L/550/05

<sup>34</sup> *Before Mr. Justice Joyce, judgment delivered on June 17, 1910*

<sup>35</sup> 27 R.P.C. 648 753.

<sup>36</sup> See also *North Cheshire & Manchester Brewery Company Ltd. v. Manchester Brewery Company Ltd. L.R. (1899) A.C. 83*

<sup>37</sup> *Alban Pharmacy Ltd v. Sterlin Products (1968) All NLR 112*

<sup>38</sup> See *David Kitchen et al, (eds) Kerly's Law of Trade Marks and Trade Names (14th ed) 2005 Pg. 592*

<sup>39</sup> "Trademark Infringement: Analyzing The Concept Of 'Confusingly Similar Trademarks'" (Banwo & Ighodalo, July 8, 2022) <<https://www.banwo-ighodalo.com/grey-matter/trademark-infringement-analyzing-the-concept-of-confusingly-similar-trademarks>>

<sup>40</sup> (2012) LCN/5437 (CA)

<sup>41</sup> *Albna Pharmacy Limited v Sterling Products Int. Inc.*

<sup>42</sup> *Bell Sons and Co. v. Godwin Aka and Anor (1972) LPELR-SC.134/1968; Alban Pharmacy Ltd v. Sterlin Products (1968) All NLR 112; Oxo Ltd. v. King 34 R.P.C. 165.*

<sup>43</sup> (1985) 3 NWLR (Pt.11) 112

<sup>44</sup> (1931) 48 RPC 477 at 487

<sup>45</sup> (1942) 59 R. P. C. 127

<sup>46</sup> (1997 – 2003) 4, I.P.L.R pg 473



while agreeing that both marks are phonetically similar held that, it was necessary to compare the two competing trademarks not only visually but also by the sound of the pronunciation. Trademarks which have been held to be phonetically similar are: *Seiko v Seyco*, *Ice Shine v Ishine*, etc

### c. Conceptually similar marks

Conceptually similar trademarks refer to whether two competing trademarks convey the same idea. Two trademarks may be said to be conceptually similar if they evoke identical or analogous semantic content<sup>47</sup>. For example, a trademark that contains the word 'swift' may be similar to a trademark that contains the word 'fast' because both evoke similar meanings (i.e., the two words are synonyms)

When two marks have similar underlying ideas, meanings, or concepts, it is referred to as conceptual similarity in the context of trademarks. Instead of emphasizing the marks' phonetic or visual qualities, it concentrates on their philosophical or thematic elements. An analysis is conducted on the main idea or theme that each mark conveys. This entails comprehending the underlying idea, message, or association that customers associate with the marks. The degree to which the marks' meanings or connotations are comparable is evaluated. This involves determining whether, when compared to the products or services they stand for, the marks elicit comparable concepts, feelings, or associations.

In *U.K. Tobacco Co. Ltd v. Carreras Ltd*<sup>48</sup>, the plaintiff sold a well-known brand of cigarettes called "Bandmaster," which features a white guy wearing a bandmaster's outfit on the pack. The defendant then began importing and marketing a different brand of cigarettes called "Barrister," which included a picture of a white man wearing a gown and wig typical of a barrister on the pack. The defendant was barred from importing and promoting the Barrister brand after it was determined that the trademarks were confusingly similar. This was mostly because the Bandmaster cigarette was known as "Cigarette Oloyinbo" by the locals (in Lagos, Nigeria) at the time, which translates to "the Cigarette that had a white man on it."

The dispute involving the trademarks RED BARON and BARON ROJO in Europe is also a good example of conceptual similarity. The tribunal held that a Spanish consumer would associate the words RED BARON with the words BARON ROJO as "red" is a common English word, and Spanish consumers would be familiar with this word. Accordingly, it was held to be conceptually identical and a likelihood of confusion was found. Other trademarks deemed similar in concept are *Pink Lady vs. Lady in Rose and Magic Hour vs. Magic Times*<sup>49</sup>.

<sup>47</sup> Office for Harmonization in the Internal Market, "Guidelines for examination in the office for harmonization in the internal market on community trademarks, part c opposition, section 2 identity and likelihood of confusion, chapter 3 comparison of signs," 2014. [Online]. Available: <https://oami.europa.eu>

<sup>48</sup> (1931) 16 N.L.R. 1

<sup>49</sup> "Trademark Infringement: Analyzing The Concept Of 'Confusingly Similar Trademarks'" (Bamwo & Ighodalo, July 8, 2022) <<https://www.banwo-ighodalo.com/grey-matter/trademark-infringement-analyzing-the-concept-of-confusingly-similar-trademarks>> accessed on 07/01/2024

### 3. Similarity of the Goods or Services

The similarity of goods or services, in the context of trademarks, refers to the degree to which the products or services associated with two marks are similar or related. It is an important factor, there is a higher chance of confusion if the products or services provided under the trademarks are same or related. If the marks are used on similar products or services, customers might infer a relationship or affiliation between them.

When evaluating the similarity of goods or services, the following aspects are typically considered: nature of the goods or services (the type, purpose, and characteristics of the goods or services are assessed), industry, or market. The specific industry or market in which the goods or services are offered is taken into account. If the goods or services are commonly associated or sold together, there is a higher likelihood of confusion. It is unlikely that there will be confusion if the products are unconnected.

Food and drinks products, for example, are likely to attract similar customers and so the risk of confusion is higher. Where one of the competing trademarks is used for telecommunications and the other for cosmetics, it is possible that an identical brand name could be acceptable as it seems unlikely that their markets would be substantially made up of similar consumers<sup>50</sup>.

In *Fan Milk Int'l A/S v. Mandarin Oriental Services BV and The Registrar of Trademarks*,<sup>51</sup> here, the court formulated three issues after considering the arguments of the parties and resolved each issue as follows: The first issue was whether the 2nd Respondent was wrong when it held that the 1st Respondent's trademark was not identical to that of the Appellant nor so nearly resembles the trademark as to be proposed trademark of the 1st Respondent as to be likely to deceive or cause confusion. The court relying on section 13(1) and (2) of the Act and the Supreme Court decision in *Ferodo Ltd & Anor v. Ibeto Industries Ltd* held that the 2nd Respondent was right in holding that both marks were not identical as to cause confusion.

The second issue formulated by the court was whether the 2nd Respondent was correct to determine that the Appellant cannot claim rights over an allegedly conflicting trade trademark, registered in a different class. On this issue, the Court cited the provisions of section 13(1) of the Trademarks Act and held that there are two instances where a trademark shall not be registered. In addition, the Court also relied on the *Ferodo* case and held that an action for infringement will lie where a competitor uses registered trademark in connection with proprietor's goods for the purpose of comparing them with his own goods in the same class.

Flowing from this, the court held that the 1st Respondent's mark could have only been rejected if it is identical with or it so nearly resembles the trademark of the Appellant which is already on the register and in respect of the same goods or description of goods. This decision is to the effect that in determining whether a

<sup>50</sup> *Supra*

<sup>51</sup> FHC/ABJ/CS/792/2020



proposed trademark is similar or identical to an existing one or not, the question is whether the person who sees the proposed trademark in the absence of the existing trademark would be deceived to think that the trademark before him is the same as the other. Where this is not the case, such a proposed trademark cannot be said to be infringing the existing trademark. From this decision, it is clear that a detailed side-by-side comparison i.e. putting the two marks side by side, looking for resemblance may not be relevant in determining similarity as an average consumer would not in normal circumstances, analyses every minute detail but would rather perceive the mark as a whole.

Secondly, the decision is instructive on the right of a party to lay claim to an infringement over an allegedly conflicting trademark registered in a different class. Thus this decision, reiterates the principle of law that a party cannot claim rights over an alleged conflicting trademark registered in a different class. Consequently, a proprietor of a trademark in a particular class cannot maintain an action for infringement against a proposed trademark in another class.

#### 4. Marks with a degree of notoriety or familiarity<sup>52</sup>

The degree of notoriety or popularity of a trademark influences the decision of whether two trademarks will be said to be confusingly similar. When a trademark is popular and extensively used, relying on the fact that the other competing trademark is used for an unrelated product may be insufficient. This is because consumers are more likely to expect an expansion of the use of the trademark. This was buttressed in the United States' District Court D. Maryland, in the case of *Quality Inns International Inc. v. McDonalds Corporation*<sup>53</sup>. Therein, McDonald Corporation instituted an action against Quality Inn, for using the name "McSleep" because it infringed on McDonald's family of marks that are characterized by the use of the prefix "Mc" combined with a generic word. Quality Inn's in its defence stated that McDonald's cannot claim ownership over every formative of "Mc" plus a generic word, and also that the trademarks were used for two different products. While the Court agreed that the logos, design, color, and shape, as well as the facilities, are not confusingly similar, the court held that is the use of the name McSleep Inn suggests an ownership, sponsorship, or association with McDonalds' and held that the two marks were confusingly similar<sup>54</sup>.

#### 5. Strength of the Earlier Trademark

The strength of an earlier trademark refers to the level of distinctiveness, recognition, and reputation of the mark in the marketplace. It is a crucial component in figuring out the degree of protection granted to the trademark owner and evaluating the likelihood of confusion. The extent to which the mark is unique by nature or has become unique as a result of widespread usage and promotion is evaluated. Stronger protection is typically granted to

highly distinctive marks—such as arbitrary or fantastical marks—than to descriptive or generic marks. Additionally, the court will consider how widely known and recognized the plaintiff's infringed mark is<sup>55</sup>. Brands that are well-known and have built a solid reputation are considered as stronger. The mark's duration of use in commerce and its consistency are taken into account. Long-term, consistent use of a mark is often associated with its strength. A robust prior trademark is likely to have more protection and a longer period of exclusivity. It can provide a more compelling case for trademark infringement and give the owner of the trademark more power to stop others from using confusingly similar or similar marks.

It is noteworthy that the determination of a trademark's strength is contingent upon the particular facts and circumstances of every instance.

#### 6. Sophistication of the Buying Public/class:

In court proceedings concerning confusingly similar trademarks, it has been widely held that a purchaser of "luxury" branded product is by no means to be regarded as an average consumer and that the level of attention of these consumers is above average. There are certain goods wherein the class of purchasers are presumably persons who are familiar with the trademarks will neither be deceived nor confused. It is generally presumable that customers used to buying expensive things will exercise a greater degree of care in purchasing and will consequently be more source-conscious. Hence, this category of buyers is less likely to be confused by a counterfeit trademark.

In the case of *Advance Magazine Publishers & Anor v. M/S .Just Lifestyle Pvt Ltd*<sup>56</sup>, the Plaintiffs are registered proprietors and the licensed users of the trademark "VOGUE" in respect of fashion and lifestyle magazines. In 2009 the Plaintiffs came across the Defendant's trademark application for the mark "JUST IN VOGUE" with respect to retail stores and sales services, etc. In their petition, the Plaintiffs claimed that the Defendant's mark "JUST IN VOGUE" prominently features the word "VOGUE" which amounts to an infringement of their well-known trademark. They further claimed that the adoption of the impugned mark was done with an intention to capitalize on the goodwill and reputation of the Plaintiff and give an impression to the public that the services of the Defendant are associated with or connected to the Plaintiffs.

The Court amongst others held that, "The target users of the plaintiff goods are intelligent, affluent, well-traveled women in the age group of 26 to 45. On the other hand, customers of the defendant are said to be primarily men from the middle strata of the society. There is no commonality in the trade channels of the two. Thus, it is absurd to suggest that discerning customers, who

<sup>52</sup> <https://www.banwo-ighodalo.com/grey-matter/trademark-infringement-analyzing-the-concept-of-confusingly-similar-trademarks> accessed on 08/01/2024

<sup>53</sup> 695 F. Supp. 198 (D. Md. 1988)

<sup>54</sup> <https://law.justia.com/cases/federal/district-courts/FSupp/695/198/2346281/>

<sup>55</sup> Admin, "Resolution Law Firm: Lawyers in Lagos - Law Firm in Nigeria/Lawyers in Nigeria" (Resolution law firm, September 4, 2020) <<https://www.resolutionlawng.com/trademark-infringement-and-enforcement-of-trademark-rights-in-nigeria/#:~:text=The%20marks%20do%20not%20need,does%20the%20plaintiff's%20mark%20carry%3F>>

<sup>56</sup> <https://vlex.in/vid/advance-magazine-publishers-inc-689302653>



are expected to buy these goods are likely to somehow imagine that these goods or the retail services offered by the defendant in connection with them have some trade connection or association with the plaintiff.”

### 7. Evidence of Actual Confusion

In trademark law, "evidence of actual confusion" refers to concrete proof or situations in which customers have been truly deceived or confused about the affiliation, source, or origin of products or services because of the similarities of two marks. It is an important consideration when determining whether two trademarks are likely to be confused.

Surveys conducted to determine consumer perception and understanding of the marks in question, statements or testimonials from customers who have mistakenly associated or been confused by the marks and have expressed their confusion in writing or through other means, and complaints from consumers who have experienced confusion or dissatisfaction with a particular product or service are examples of evidence that may be taken into consideration.

It is crucial to remember that proving true confusion might be difficult because it calls for hard data rather than conjecture or opinion. When assessing the risk of confusion, courts frequently look closely at the quality and applicability of the evidence that is given as well as the wider context and other relevant circumstances.

**Other factors** that may be considered in determining the likelihood of confusion include intent of the trademark applicant, geographical location and market considerations, channels of trade, and prior existing trademark<sup>57</sup>.

## 9.0 Defence to infringement action against Likelihood of Confusion concept

### 9.1 No Likelihood of Confusion or Deception

As seen in plethora of cases laws highlighted above, the ready-made defence open to a defendant is to claim that in fact, there is no infringement because there is no likelihood of confusion or deception, on the ground that the plaintiff's trademark is not similar to the one being used by the defendant,<sup>58</sup> or, that it is used in relation to goods other than those in respect of which the plaintiff registered his own mark.<sup>59</sup>

Also, where the trademark is generic or descriptive, the mark is *publici juris*, and no individual proprietor is entitled to appropriate to itself the use of the mark. In *Smithkline Beecham Plc v. Farmex Limited*,<sup>60</sup> it was held that notwithstanding the fact that the

<sup>57</sup> "Check out This Article..Likelihood of Confusion Factors" (UpCounsel)<<https://www.upcounsel.com/likelihood-of-confusion-factors#:~:text=If%20the%20products%20compete%20directly,unrelated%2C%20then%20confusion%20is%20unlikely.>>

<sup>58</sup> Successfully deployed in the case of *Coca-cola of Canada v. Pepsi-Cola OF Canada Ltd [1942] 1 All E.R. 615*

<sup>59</sup> *Trade Marks Act, section 32. Recall, section 5 (1) provides that registration of a mark confers exclusive rights only in relation to the goods or classes of goods in respect of which the mark is registered*  
<sup>60</sup> [1997-2003] 4 I.P.L.R 416

plaintiff had registered the trademark "Milk of Magnesia", it could not claim exclusive ownership of the mark, as it was a generic, common or scientific name used freely in the medicinal and pharmaceutical world. The prefix to 'Milk of Magnesia', the words "Phillips" and "Dr. Meyer's" were the distinguishing features (brand names) to easily differentiate the product of the plaintiff from that of the defendant. Thus, the brand name "Dr. Meyer's Milk of Magnesia" did not infringe the brand name "Phillips Milk of Magnesia". It was also held that both products of the plaintiff and the defendant and the marks on them would not cause any confusion to a prospective buyer or be deceptive as they were not similar in any way. The court further reasoned that any reputation or goodwill the plaintiff purported to have acquired over the years, or purported to be acquiring was not as a result of the words "Milk of Magnesia", but because of the brand name "Phillips" which was the name the plaintiff was selling and not the generic name "Milk of Magnesia" which any other pharmaceutical company could use.<sup>61</sup>

## 10.0 Issues and Challenges in Determination of Likelihood of Confusion in Nigeria

Several challenges and ambiguities exist in the determination of likelihood of confusion in Nigerian trademark law, thereby posing significant hurdles to litigants, businesses, and the legal system, they are:

### a. Lack of Clear Definition and Criteria:

**Ambiguity:** Nigerian trademark law lacks a precise definition of what constitutes "likelihood of confusion," leading to interpretational challenges for judges, attorneys, and applicants.

**Criteria for Assessment:** The absence of explicit criteria for assessing likelihood of confusion could contribute to inconsistency in decision-making and difficulty in advising clients.

### b. Limited Case Law Precedents:

**Case Law Development:** The relatively limited number of trademark cases in Nigerian courts may result in a shortage of detailed precedents, making it challenging to predict outcomes and rely on established legal principles.

### c. Inadequate Guideline Clarity:

**Publication and Accessibility:** Clear guidelines for assessing likelihood of confusion and trademark infringement, if available, might not be widely accessible to legal practitioners, potentially hindering consistent application of the law.

### d. Inadequate Guideline Clarity:

**Judicial Expertise:** In some cases, judges may have limited expertise in trademark matters, potentially leading to decisions that do not fully consider the intricacies of likelihood of confusion issues.

### e. Interpretation of Statutory Provisions:

<sup>61</sup> AO Oyewunmi, *Nigerian Law of Intellectual Property (University of Lagos Press Ltd 2015)* pp. 288 -289





Statutory Interpretation: Differences in interpreting and applying statutory provisions related to likelihood of confusion may lead to varying outcomes and raise uncertainties for trademark stakeholders.

- f. Nigeria as a multilingual country: This can make it difficult to assess whether two marks are similar to consumers who speak different languages.
- g. Nigeria has a large informal sector: This can make it difficult to gather evidence of consumer confusion.
- h. Nigeria has a relatively low level of consumer awareness of trademark law: This can make it difficult to educate consumers about their rights and to enforce trademark law effectively.

Despite above challenges, it is important to note that the courts have a duty to judicially and judiciously protect consumers from confusion and to uphold the rights of trademark owners.

### 11.0 Addressing the Challenges and Preventative Measures

To address these issues and improve the determination of likelihood of confusion in Nigerian trademark law, several actionable steps may be considered:

#### a. Enhanced Legal Clarity:

Reviewing and refining statutory language to provide a clear definition of likelihood of confusion and specifying the factors to be considered in assessments.

#### b. Comprehensive Case Law Development:

Encouraging the dissemination of detailed judgments in trademark cases to enrich the body of case law and provide valuable guidance for future litigants and legal professionals.

#### c. Capacity Building and Education:

Implementing training programs and workshops for judges, legal practitioners, and trademark examiners to enhance their understanding of likelihood of confusion evaluation and its practical application.

#### d. Specialized Trademark Courts or Panels:

Establishment of specialized intellectual property courts or panels staffed with judges possessing expertise in trademark matters could ensure more consistent and knowledgeable adjudication.

#### e. Transparent Guideline Publication:

Improving transparency by making official guidelines and examination criteria readily available to stakeholders, promoting uniformity in decision-making and legal practice.

### 11.1 Preventative Measures

- a. Conducting thorough trademark searches before adopting a new mark can help avoid unintentional infringement.
- b. Registering your trademark with the Nigerian Trademarks, Patents, and Designs Registry strengthens

your legal protection and makes it easier to enforce your rights.

- c. Building and maintaining a strong brand identity through consistent marketing and communication can help differentiate your mark from potential infringers.

### 12.0 Recommendations for Improvement

The following are some recommendations for addressing the challenges in determining likelihood of confusion in trademark law in Nigeria:

- a. Amend the Trade Marks Act to provide Clarity in Criteria and specific definition of likelihood of confusion. This is aimed at incorporating clearer criteria and specific factors to be considered when assessing likelihood of confusion, thereby enhancing predictability and coherence in legal decision-making
- b. Enhanced Enforcement Mechanisms. Efforts to strengthen the enforcement of laws related to likelihood of confusion, potentially through improved administrative and judicial processes, could also be a focus of future legislative changes
- c. Develop a body of case law on likelihood of confusion by encouraging parties to bring and defend claims.
- d. Provide guidance to the courts on how to apply the factors relevant to the determination of likelihood of confusion.
- e. Educate consumers about their rights under trademark law.
- f. Take steps to enforce trademark law effectively in the informal sector.

### 13.0 Conclusion

Determination of the likelihood of confusion in trademark law is a complex procedure that takes into account a number of variables, which includes visual resemblance, aural elements, phonetic similarity, conceptual similarity, similarity of goods or services, strength of the previous trademark, and proof of real confusion. Summarily, two questions are typically considered when deciding whether two trademarks are confusingly similar to wit: (i) what degree of resemblance of both trademarks must be shown to demonstrate a likelihood of confusion? and (ii) what proportion of the public which are likely to be confused or deceived by the existence of both trademarks? Answers to these questions are a matter of fact and requires an all-encompassing application of human senses as well as the consideration of the behavior of the purchasing public. The ultimate goal is to preserve an honest and competitive market where consumers can make knowledgeable choices and trademark owners can safeguard the uniqueness and goodwill of their brands. The legal system works to achieve a balance between safeguarding intellectual property rights and preventing consumer confusion by carefully examining those essential factors.