

DOMITILLA

DOMITILLA'S CASE

IMPLICATIONS OF THE DECISION OF THE TRADE MARK REGISTRAR FOR BRAND OWNERS IN NIGERIA

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BACKGROUND/ MATERIAL FACT

'**Domitilla**' is the title of the 1996 controversial movie produced by Zeb Ejiro, which starred Anne Njemanze as the lead character. Years after the release of the movie, Njemanze trade marked the name "Domitilla" on September 16, 2020. This was reportedly the same year that Zeb Ejiro Productions in collaboration with FilmOne Entertainment and Omoni Oboli's Dioni Vision announced plans to make a sequel to the original movie, titled "Domitilla: The Reboot." Following the announcement and approach to her to partake in the movie, Mrs. Njemanze filed for a trade mark of Domitilla, and later instituted an action against Zeb Ejiro the producer, at the Federal High Court Lagos, Nigeria, seeking to prevent him from showing the reboot of the film "Domitilla". She further filed an ex parte motion, to stop the release of the movie. The Federal High Court, however, did not grant the motion as prayed on technical grounds. Zeb Ejiro through his Lawyer also filed a petition against Mrs. Njemanze dated the 13th of February 2023 urging the trade mark Registrar to cancel the trade mark application F/TM/0/2020/976 Domitilla in Class 41 in the name of Ann Chioma Njemanze on the basis that Mrs. Njemanze is not the true proprietor of the trade mark and therefore not entitled to registration under the Trade Marks Act, and also that the registration was done in bad faith. Notwithstanding the lapse of the statutory opposition period, the trade mark Registrar heard the application and the parties who presented their arguments. The Registrar eventually decided in favour of Zeb Ejiro and cancelled the trademark application given in the name of Ann Chioma Njemanze.



EXHUMATION OF THE PROBLEM

Brand owners in Nigeria are questioning the powers of the Trade Marks Registrar following a controversial decision that has raised concerns about the status of their marks beyond the statutory opposition period.

Section 20 of the Trade Marks Act provides that 'Any person may, within two months from the date of the publication...of notice of an application, give notice to the Registrar of opposition to the registration.' It is important to note that the Act does not create any abandonment provision for failure to file an opposition within two months. Rather, the Act stipulates that where an applicant fails to send in a counter-statement to an opposition within one month from the receipt of the opposition duplicate, such application will be deemed abandoned.

Therefore, It would seem that the purport of opposition proceedings is to give more leverage to the opposition than to an application, so as to ensure the integrity and accuracy of trade marks in the register. Indeed, one can appreciate this point further after evaluating the powers of the Registrar to rectify and correct the register.

However, some scholars have argued that the use of the word '..may within two months...' in Section 20 connotes a mandatory provision even though the choice of word used is not '...shall...' In *ACHINEKU V ISHAGBA* 1988 4 NWLR Pt. 89 411 the courts held, as in many other cases, that the use of the word SHALL connote a compulsory provision. However, there are instances where the use of the word MAY connotes a mandatory provision.[1] For instance, where discretion is conferred upon a public authority coupled with an obligation, the word "may" which denotes discretion could be construed to mean a command. Sometimes, the legislature uses the word "may" out of deference to the high status of the authority on whom the power and the obligation are intended to be conferred and imposed.

In *Ude v. Nwara & Anor.* (1993) 2 NWLR Part 278 page 638, Nnaemeka-Agu, J.S.C., opined that it is now the invariable practice of the Courts to interpret the word 'may' as mandatory whenever it is used to impose a duty upon a public functionary the benefit of which inures to a private citizen. In *Kurobo v. Zach Motison Ltd* (1992) 5 NWLR Part 239 page 102 at 115 - 117, Tobi, J.C.A., (as he then was), in dealing with an arbitration clause recognized that there are known instances when the word "may" could be constructed as "shall."

The question then is – does MAY as used under section 20 connote SHALL? On whom is the duty bestowed, the person opposing or the Registrar receiving the opposition, or both?

[1] *Navy v Labinjo* (2012) 17 NWLR (Pt.1328) 56 at 77; *Mohammed v State* (2018) 5 NWLR (Pt.1613) 540.

EVALUATING THE REGISTRAR'S POWER TO RECTIFY THE REGISTER

The power and decisions of the trade mark Tribunal are derived from the provisions of the Trade Marks Act, and its actions are subject to the provisions of the act.



The logo features the word "Nigeria" in a green, stylized font. Above the letter 'i' is a registered trademark symbol (®), and above the letter 'a' is a trademark symbol (™).

Section 38 of the Trade Marks Act gave general powers to the Registrar to rectify the trade marks register. It provides that any person concerned who alleges 'that any entry has not been inserted in or has been omitted from the register or that any entry has been made in the register without sufficient cause or that any entry wrongly remains on the register or that any error or defect exists in any entry on the register may apply in the prescribed manner to the court or subject to section 56 of the act, to the Registrar' to expunge or vary the entry as the tribunal thinks fit.

Procedure in cases of option to apply to court or Registrar.

56. Where under any of the foregoing provisions of this Act, an applicant has an option to make an application either to the court or to the Registrar—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the court;
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question between them, subject to appeal to the court.

Indeed, the said section 56 although unclear because of the use of the word 'an action', suggests that matters that have been filed and pending in court, cannot be brought to the Registrar for determination. As such, it is the opinion of these writers that if it is discovered that Domitilla's case filed at the Federal High Court was still pending, the decisions of the Registrar may be voided in law.

In any other case where there is an option to go to regular court or the trade mark Registrar, the matter can be made to the Registrar or the Court.

Even where a trade mark has been registered, Section 31 grants powers to the Registrar to remove the application of an applicant on the ground of non-use for a continuous period of five years or more.

Furthermore, section 39 provides the power of the trade marks Registrar to strike out or vary registration for failure to observe a condition as it relates to a trade mark. Section 40 provides for the power of the trade mark Registrar to correct any error in the name or address of the registered proprietor of a trade mark, enter any change in the name or address of the person who is registered as a proprietor of a trade mark, and cancel the entry of a trade mark on the register.

And finally, section 18 of the Trade Marks Act, grants the registrar the power to exercise its discretion to recall a trade mark acceptance notice that has been issued in error. It is on this ground that the decision in Domitilla's case was exercised.

A collage reading of the above provisions, reveals without doubt, that the Registrar has the power to rectify the registrar at any time. Thus, the discretion or mandate of any person to oppose an application within 2 months of publication, does not matter since the Registrar still has the power to rectify the register. The only problem for such a person, however, is that the decision of the Registrar to cancel an application after publication, is discretionary, except by order of court.

EVALUATING THE IMPLICATION OF THE DECISION TO BRAND OWNERS IN NIGERIA

The decision, like a double edge sword, has a good and negative impact on brand owners that intend to register and protect their trade marks in Nigeria. Under the provisions of section 20, a party has the right to oppose a trade mark published in the trade mark journal within two months. The expiration of the two-month period should provide relief for the applicant seeking to register trade mark and expend resources on promotions. Although the Act is silent as to what happens upon the lapse of the two-month period, it has often been argued that when a statute creates a time for the exercise of a right, if the same lapses, that right is foreclosed. In practice, there are rare cases of applicants requesting cancellation after the opposition period has elapsed.

The rationale behind the said statutory period is to give access to the right to a fair hearing and at the same time secure the right of an Applicant against undue or unfair delay. In **Onah v Okom (2012) 8 NWLR PT 301 169** the Court held that the principle of fair hearing is one of substance and not a technical rule.

Thus, the question is not simply whether miscarriage of justice has been occasioned because of lack of fair hearing, the question is whether the party entitled to it and who is deserving of being heard before his fate is sealed or determined had in fact been given ample and adequate opportunity to do so.[2]

Is a two-month period an adequate opportunity to oppose an application? We believe much depends on the mode of publication. Sadly, the Nigerian trade mark method for publishing a journal is in hard copy and the publication must be paid for, remaining inaccessible to the general populace who may have an interest to protect despite not having a trade mark agent in the registry.

On the other hand, the said power of the Registrar is a shield for brand owners who have missed the opportunity of being heard during the opposition period, to rely on the discretion of the Registrar under the aforementioned sections for the cancellation of an offending application. A Petitioner, based on section 18 of the Trade Marks Act, can urge the registrar to exercise his discretion to recall a trade mark acceptance notice that has been issued in error as done in Domitilla's case.

Section 18 of the Act culminates into a strategy for the opposition that is timesaving, cheap, and effective. Delay is averted when compared to the regular court in which matters can span for a period of two-five years before judgment is delivered and before enforcement proceedings can begin. Section 18 is therefore curative to the delays brand owners would have suffered over court proceedings.

CONCLUSION/RECOMMENDATION

It is our conclusion that the exercise of the powers and the decision of the Registrar in Domitilla's case suggests that brand owners in Nigeria whose applications have passed the statutory opposition period may find it too early to dance shaku-shaku[3] especially where their proprietorship can be challenged. It is also possible that the decisions of the Registrar can be set aside where it is the case that the earlier matter filed in court was still pending before the Federal High Court.

Finally, we have two recommendations flowing from this matter – the first is that journal publications should be digital and freely accessible by all and sundry. Digital publication saves costs and reaches a wider audience. Should there be any concern as to the cost of publication, the same should be borne by applicants, and the digital assessment of the publication should be free for all, with announcements at the National Newspapers and Social Media handles.

Secondly, there is a need for the Nigeria court to determine the purport and essence of section 20 of the Trade Marks Act so that trade mark owners may know if the statutory time for an opposition is final or not.

[2] See also *In Kalu v State* (2011) 4 NWLR Pt1238 P.449 (paras E-F); *Kotoye v. C.B.N.* (1989) 1 NWLR (Pt. 98); *In Ahmed v Ahmed* (2013) 15 NWLR Pt 1377 274.

[3] A type of joyful afrobeat dance in contemporary Nigeria dance culture.

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