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Passing off is described as an unfair competition by **misrepresentation** or literally speaking **"the cause of confusion or deception".** Generally, an action for Passing off arises where the deception is made in the course of trade, which could lead to **confusion** amongst customers. This applies to both ecommerce businesses and businesses with physical addresses.

Another definition of Passing off is the act or an instance of falsely representing one's own product as that of another in an attempt to **deceive potential buyers**.1 Passing off is actionable in tort under the law of unfair competition.

The Duhaime's Legal Dictionary, defines Passing off as making some false representation likely to **induce a person to believe** that the goods or services are those of another.

1In the words of Lord Kingsdown,”the fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader”.2 Where passing off is proved, the plaintiff would be entitled to an injunction restraining the defendant from continuing the wrong, to damages for any loss he has incurred thereby, 3 and to an account of the profit made by the defendant in consequence of the tort.Passing off takes various forms, the most common of which are the following:

**1. MARKETING A PRODUCT AS THAT OF THE PLAINTIFF**

It is actionable passing off for the defendant to sell merchandise with a direct statement that the goods are manufactured by the plaintiff, when in fact they are not. Similarly, it has been held actionable for a book publisher to advertise and sell a book of poems with the name of Lord Byron on the title-page, when in fact that famous poet had nothing to do with its authorship.4

**2. TRADING UNDER A NAME SO CLOSELY RESEMBLING THAT OF THE PLAINTIFF AS TO BE LIKELY TO MISLEAD THE PUBLIC INTO BELIEVING THAT THE DEFENDANT’S BUSINESS AND THAT OF THE PLAINTIFF ARE ONE AND THE SAME.**

A well-known example of this type of passing off is **Hendriks v. Montagu**,5where the Universal Life Assurance Society were granted an injunction restraining the defendant’s company, which was incorporated subsequently, from carrying on business under the name “Universe Life Assurance Association”. The principle in **Hendrik v. Montagu** was applied in **Niger Chemists Ltd. v. Nigeria Chemsits**6. In this case the plaintiffs had carried on business as chemist and druggist for several years, and had several branches in Onitsha and other towns in what was then Eastern Nigeria. The defendant later founded a firm carrying on exactly the same type of business in Onitsha under the name “Nigeria Chemists”. The plaintiffs contended that the defendant’s use of a name similar to their own was actionable passing off, and the sought an injunction to restrain its further use. Palmer J. granted the injunction holding that the use of the name “Nigeria Chemists” was calculated to deceive persons who know of and intend to deal with Niger Chemists.

Similarly, in **Ogunlende v. Babayemi**7 where the plaintiffs carried on business as civil engineering contractors and plumbers under the name “Mercury Builders”, Taylor C.J. granted an injunction restraining the defendant from conducting a similar business under the name “Mercury Builders (Nigeria) Ltd” since “There can be no doubt at all that the name of the defendants company is calculated to deceive due to its similarity of the name of the plaintiff association”8.

**3.MARKETING GOODS UNDER A TRADE NAME ALREADY APPROPRIATED FOR** **GOODS OF THAT KIND BY THE PLAINTIFF, OR UNDER A NAME SO SIMILAR TO** **THE PLAINTIFFS TRADE NAME AS TO BE MISTAKEN FOR IT.**

A trade name is one “under which goods are sold or made by a certain person and which by established usage has become known to the public as indicating that those goods are the goods of that person”9. Purely descriptive names, that is to say names which indicate merely the nature of the goods sold and not that they are the merchandise of any particular person, are not protected unless the plaintiff can prove----and the burden of proof is a heavy burden one----that the descriptive name in question has acquired a secondary meaning so exclusively associated with the plaintiff’s that its use by the defendant is calculated to deceive purchasers.10The protection of trade names applies not only to traders and manufacturers but also artiste, writer, or musician who “get to be known under a particular” which “becomes inevitably part of his own stock-in-trade.”11Thus, for example, where the plaintiff bandleader broadcast in a radio programme under the name “Dr.Crock and his Crackpot”, the defendant was restrained by injunction from putting another band on the programme under the same name.12

**4.MARKETING GOODS WITH THE TRADE MARK OF THE PLAINTIFF OR WITH ANY** **DECEPTIVE IMITATION OF SUCH MARK**

A trade mark is any design, picture, mark, name or other arrangement affixed to goods which identifies those goods with the plaintiff, manufacturer or seller.13Trademarks receive protection not only under the law of passing off but also, if registered, under the **Trade Marks Act 1965**14 under which most actions are brought.

**5. IMITATING THE GET-UP OR APPEARANCE OF THE PLAINTIFF’S GOODS**

When there is anything in the appearance or “get-up” of the plaintiff’s goods which particularly identifies those goods as the merchandise of the plaintiff, the defendant will be liable for passing off if, in marketing his goods, he imitates or copies such appearance in a manner likely to confuse the public. An early Nigerian example is **U.K. Tobacco Co. Ltd. v. Carreras Ltd.15**where the defendant marketed cigarette called “Barrister” in packets on which appeared a white man in a barrister wig and gown. This was held to be an actionable imitation of the appearance of the plaintiff’s cigarette called “Bandmaster”, whose packets featured a white man in band master’s uniform. More recently, in **De Facto Works Ltd. v. Odumotun Trading Co. Ltd,16** the defendants were held liable in passing off where they sold bread wrapped in yellow and brown paper with the name “Odus” written in large scroll letters in chocolate colour, this being an imitation of the appearance of the plaintiffs bread, which for some time previously had been wrapped in a yellow and brown paper with the name “De Facto” written in large chocolate coloured scroll letters. An important limitation to this head of passing off is that an action will not succeed where the appearance complained of is necessary for the better performance of the defendant’s goods or for greater efficiency in handling or processing them; That is where the appearance is purely functional. Thus, for example, a defendant who manufactured shaving sticks could not prevented from marketing a standard type of container already used by the plaintiff, since the appearance of the container was dictated primarily by functional considerations.17

Components to prove Passing off

Aside from the key component of deception, Justice Nnaemeka Agu, in the 1977 case of *The Boots Company Limited V United Niger Imports Limited*18 carefully listed what he considered to be the ingredients of a successful Passing off action as follows:

1. Proof that the name, mark, sign which the plaintiff claims ownership has become distinctive of his goods and is regarded by a substantial number of the public or persons involved in a trade in the relevant market as coming from a particular source;
2. That the defendants who are engaged in a common field have used a name, mark, sign so resembling to the plaintiff's that it is likely or calculated to deceive or cause confusion in the minds of the common customer; and
3. That the use of the name, mark, sign is likely to cause or has caused injury, actual or probable to the goodwill of the plaintiff's business.

Remedies in a Passing off action

The following reliefs/ remedies can be claimed in a Passing up action as follows:

1. **Injunction:** This is an order of the Court to prohibit or suspend the use of a mark. This is usually the first relief sought to suspend the use of the mark pending the outcome of the case and a perpetual injunction when the case has been concluded to totally stop the use of the mark.
2. **Damages:** It has been established through decided cases that a successful litigant in a Passing off action is entitled to damages. Damages here could be general, special or punitive. These usually emanate from losses which are presumed to have been suffered by a Plaintiff in a Passing off action.
3. **Delivery up for destruction of infringing goods:** This is usually claimed where physical goods are involved. This occurs where goods are produced in breach of the trademark of another identical product. Thus, the Plaintiff usually claim for the goods to be delivered up especially so that it can be destroyed.
4. **Anton Piller Orders:** This is an order for inspection and delivery up of infringing materials in the possession or control of an infringer. *Ferodo Limited & Anor. V. Ibeto Industries Limited19.*
5. **Account of profit20:** Here the Plaintiff is entitled to profit on goods wrongly sold by the infringer.

Defences available to a Defendant in a Passing off action

The defences available against a claim of Passing off include the following:

1. Consent of the Plaintiff to the use of the name, mark, sign or slogan.
2. Indistinct name, mark, sign and slogan of the plaintiff.
3. That the Plaintiff's name, mark, sign hand slogan has become generic/common place.
4. Dissimilarities in the mark of the Plaintiff and Defendant.
5. Innocent usage of the Plaintiff's name.

The purpose of an action for Passing off is to prevent one trade from damaging or exploiting the goodwill and reputation built up by another. The principle is that no man is entitled to represent his goods or his business as that of another. It is therefore our recommendation that the necessary framework for Passing off actions be strengthened to defend the goodwill and reputation of businesses.

Furthermore, small and medium businesses should be enlightened and educated to explore the possibility of seeking legal actions on Passing off and take advantage of the remedies available to protect their goodwill, trade name and profits. The Supreme Court should also resolve with one voice the jurisdiction of the Federal High Court in line with the Constitution to prevent unnecessary objections and delay of justice at court.

It is also suggested that the Trademarks Act be further amended to reflect the times, happenings and changes in the Nigeria. In particular, we have observed that the Trademarks Registry has witnessed a serious backlog in the successful completion of the registration of marks and this has the resultant effect of limiting the rights of most product owners to Passing off as opposed to the an action on the infringement of a trademark.

**REFERENCES**

1. Salmond op. cit. para 149.
2. Leather Cloth Co. v. American Leather Cloth Co. (1865) 11 H.L Cas. 523 at p. 538; De facto Works Ltd. v. Odumotun Trading{1959} L.L.R. 333 at p. 39 Trebor (Nigeria) Ltd. v. Associated Industries Ltd. {1972} N.N.L.R. 60 at p. 63.
3. The plaintiff will recover damages damages for the loss of profits he has suffered as a result of customers being diverted from him to the defendant. He may also recover for loss of business reputation and goodwill: Spalding v. Gamage (1918) 35 R.P.C. 101.
4. Byron v. Johnston (1816) 35 E.R. 851.
5. (1881) 50 L.J. Ch. 456.
6. {1961} All N.L.R. 171.
7. (1971) 1 U.I L.R. 417
8. At p. 419.
9. Salmond, op. cit. p. 401.
10. See Reddaway v. Banham {1896} A.C 199
11. Hines v. Winnick {1947} Ch. 708 at p.713, per Vaisey J.
12. Ibid.
13. Milington v. Fox (1838) 40 E. R 956.
14. No. 29.
15. (1931) 16 N. L. R. 1.
16. (1959) L. L. R. 33.
17. Williams v. Bronnley (1909) 26 R. P. C. 756. But it was held in Trebor (Nigeria) Ltd. v. Associated Industries Ltd. (1972) N. N. L. R. 60 at pp. 71, 72, that the use of a functional packaging having “capricious” design, shape or size closely resembling the plaintiff’s product did not constitute passingoff.
18. (1977) 1 A.N.S.L.R 144
19. (2004) LPELR-1275(SC)
20. Nwabachili, Chudi C, Intellectual Property and Law in Nigeria