



## TRADE MARK REGISTRATION CAN PREVENT IDENTICAL COMPANY NAME

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### **Utilising the Provisions of the Companies and Allied Matters Act for Trademark Protection: A review of *Citigroup Inc and Citi Bank Nigeria Limited v. Corporate Affairs Commission, Citicorp Financial Services Ltd & Ors.*<sup>1</sup>**

There are several ways in which a business can protect its trade mark in Nigeria. One way is enforcing the statutory obligation in the Companies and Allied Matters Act (CAMA). From our law firm's archives, we present *Citigroup Inc and Citi Bank Nigeria Limited v Corporate Affairs Commission, Citicorp Financial Services Ltd & Ors.*, where our firm set a precedent on the use of CAMA to prevent a company from registering or continue to use an identical or confusingly similar name to a registered trade mark.

#### **Facts**

Citigroup is a United States financial services conglomerate with the trademark 'CITICORP' registered in over a hundred countries including Nigeria. Citigroup registered the trademark Citicorp under class 16 (printed materials and publications) of the Trade Marks Register in Nigeria in 1975. However, at that time, there was no protection for service marks in Nigeria. Citicorp is associated with Citigroup especially when used in the financial industry. In 2010, Citigroup discovered that several companies were using CITICORP as part of their names causing confusing in the market place and arguably riding on the goodwill of CITICORP. They included Citicorp Financial Services Ltd, Citicorp Ltd, Citicorp Nigeria Ltd, Citicorp Investment and Consultancy Limited and Citicorp Motors Ltd.

Although, CitiBank had been trading in Nigeria for almost two decades in 2010, its initial company name registration was Nigerian International Bank Ltd and this did not include CITI. Arguably, the statute of limitation or the common law doctrine of laches and acquiescence would have precluded CitiBank from proceeding against these companies for trade mark infringement.

In 2011, our dispute resolution team recorded a first by relying on the provisions of the Companies and Allied Matters Act, (CAMA) 1990 (as amended), against the Registrar of Companies known as the Corporate Affairs Commission (CAC) for registering a company with an identical earlier registered trade mark CITICORP. The action was predicated on section 31(1)(d) of the 1990 CAMA, now section 852(1)(d) of the new CAMA, 2020 and section 30(4) of the old CAMA, now section 30(4) of the 2020 CAMA.

Section 30(1)(d) provides that **“No company shall be registered under this Act by a name which in the opinion of the Commission would violate any existing trade mark or business name**

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<sup>1</sup> Unreported Suit No. FHC/L/CS/61/2011



registered in Nigeria **unless the consent of the owner of the trade mark or business name has been obtained**". (Emphasis added)

The side note of the section 852(1)(d) is headed "Prohibited and Restricted Names". The section provides that:

**No company**, limited liability partnership, limited partnership, business name or incorporated trustee **shall be registered under this Act by a name or trade mark which** in the opinion of the Commission, **would violate or conflict with any existing trademark** or business name registered in Nigeria or body corporate formed under this Act **unless the consent of the owner of the trade mark**, business name or trustees of the body corporate **has been obtained**. (Emphasis Added)

Section 31(4) of the old CAMA which is replicated in section 30(4) of the 2020 CAMA provides

Nothing in this Act shall preclude the Commission from requiring a company to change its name if it is discovered that such a name conflicts with an existing trade mark or business name registered in Nigeria prior to the registration of the company and the consent of the owner of the trade mark or business name was not obtained.

Relying on CAMA, the plaintiffs instituted an action against the CAC and all five (5) companies. It was argued that the use of the word "shall" meant that CAC shall not register a company with a name that conflicts with a registered trade mark. The registrations of the five companies with the CITICORP trade mark was *ultra vires* the CAC.

Pursuant to CAMA, the CAC has a statutory obligation to compel any company to change its name where it is discovered that there is a prior existing trademark or business name in Nigeria before its registration. The CAC has the power to require the company to change its name notwithstanding the class the trademark is registered. In this instance, Citigroup's registered trademark in 1975 was prior in time to the registration of all the other companies with the CITICORP mark. CAMA intends to avoid duplicate names of companies and trade marks to avoid the issues of passing off and unfair competition.

The court agreed and compelled the CAC to remove the offending names from the Register of Companies. The offending companies have since removed CITICORP from their registered company names. This was an example of the use of company law to enforce a claim in intellectual property. We hope to bring you another precedent setting example of the use of company law for intellectual property claims from our archives, soon.