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Domitilla Movie:

THE REAL TRADEMARK DRAMA

“Anne Chioma Njemanze is not the proprietor of the trademark, “DOMITILLA”, but rather, copied the name from Zeb Ejiro and filed for registration of same.”

The above statement is an excerpt from the ruling of the Trademarks Tribunal as delivered by Shafiu Adamu Yauri, the Registrar of the Trademarks Registry on 4th February 2023, with regard to the Petition filed by Zeb Ejiro (“The Petitioner”) against Anne Chioma Njemanze (“the Respondent”) in respect of the application for the registration of the trademark; NG/TM/O/2020/976 DOMITILLA & DEVICE in class 41 in the name of Anne Chioma Njemanze.

Facts of the case

In 1996, the famed Nigerian producer, Zeb Ejiro brought to life the blockbuster movie, DOMITILLA, (which centered around the life of a young woman who was striving to make a living as a prostitute in Lagos) and the movie recorded massive success at the time. A sequel to the wonder movie, DOMITILLA 2, was produced again by Zeb Ejiro in 1999. The Respondent was engaged to play the title character, “Domitilla”, in both movies, a role which she played exceptionally, so much so that she became widely known by the name, Domitilla. Fast forward 24 years later, the entertainment and Intellectual Property (“IP”) space became agog with the news of the clash between the Petitioner and the Respondent, arising from an alleged infringement of the Respondent’s right in the trademark, DOMITILLA.

It happened that the Petitioner had sought to collaborate with some media outlets for the remake of part 3 of the DOMITILLA movie, in the name of “DOMITILLA: THE REBOOT”. He was said to have approached the Respondent to act as “Aunty” to the new Domitilla character in the movie but the parties could not reach an agreement on how much she should be paid for the role hence, the Petitioner decided to proceed with the reboot without the Respondent. Surprisingly, the Respondent returned with a cease-and-desist letter from her lawyers asking the Petitioner, and his associates to desist from taking any further steps in making the reboot of DOMITILLA on the grounds that the movie was an infringement of her registered trademark; “DOMITILLA & DEVICE” in class 41, filed on September 16, 2020 (the same year that Zeb Ejiro Productions had announced plans to reboot the popular movie).

The Petitioner, through his lawyers, petitioned the Trademarks Registry to challenge the registration of the said DOMITILLA & DEVICE by the Respondent. The Petitioner claimed that the said trademark belonged to him and same had been in use since 1996 in connection with films and matters which fell under Class 41 (which covers services in respect of education, provision of training, entertainment, sporting and cultural activities).



The Petitioner argued for a case of prior use of the DOMITILLA trademark and cited bad faith as the driving factor behind the Respondent's application. He requested that the purported registration of the DOMITILLA & DEVICE trademark by the Respondent be canceled, revoked, and expunged from the Register of Trademarks.

In response to the petition, the Respondent averred, through her lawyers, that she had registered the trademark, over 10 (Ten) months before she was approached by the Petitioner for the remake of the movie, hence, it was preposterous for the Petitioner to allege that she had taken steps to register the trademark while talks between the parties were in progress and inputting bad faith in the registration. The Respondent also raised the issue of jurisdiction and contended that the time within which the Petitioner could oppose her trademark application (which is two months from the date of publication) had elapsed and therefore, the Petitioner was estopped from approaching the Trademark Tribunal and the Tribunal had no jurisdiction to adjudicate on the matter.

It is worth noting that at the time the petition was filed, the Respondent's trademark had been accepted and published, but registration certificate had not been issued by the Registry. The DOMITILLA trademark was published in October 2021 while the petition was filed in February 2023, which is over a year after the opposition period had elapsed. The Respondent, among other things, highlighted the distinction between the Petitioner's copyright ownership over the movie and her claim to the DOMITILLA trademark. She claimed that the proprietorship of a trademark is determined by first in law (i.e., the first person to register the trademark) and not first to use the mark as alleged by the Petitioner. She also claimed that she had acquired more goodwill, reputation, and notoriety in the DOMITILLA trademark than the Petitioner so much so that her fans still referred to her as Domitilla till date.

The Ruling

The Tribunal in its ruling, formulated a sole issue for determination. viz; whether the Respondent is the true proprietor of the trademark, DOMITILLA, in Nigeria and is thereby entitled to register the mark under the Trademarks Act. The Tribunal found that the only evidence the Respondent relied upon in claiming ownership of the trademark was the acknowledgment and acceptance letter issued to her by the Trademarks Registry, and held that the documents were not sufficient proof of true ownership or proprietorship of the DOMITILLA trademark.

The Tribunal made a detailed consideration of who a true proprietor of a trademark was by relying on a long line of English and Nigerian cases and the Tribunal held that a true proprietor of a trademark is a person who has a prior claim to the Trademark. It found that the DOMITILLA movie that gave birth to the disputed trademark was created and produced by the Petitioner. This showed that the actress would not have been associated with the mark if not for the Petitioner that hired her to play the role of Domitilla in the first place. The Tribunal rejected the Respondent's argument that proprietorship is determined by first in law but relied on the Common Law principle as established by Morriet L.J. in the English case of ALBASSAM trademark 1995 RPC 511 where it was held that proprietorship is determined by first to use the trademark.

In holding that the trademark, "DOMITILLA" did not belong to the Respondent, the Tribunal highlighted the fact that the Respondent acted in DOMITILLA 1 & 2 for the Petitioner and that same implied bad faith on the part of the Respondent by applying to register DOMITILLA as her trademark. It held that the Respondent's claim of goodwill in the DOMITILLA trademark was unfounded and that the Petitioner had been using the DOMITILLA trademark before the Respondent filed for its registration.

The Tribunal held that the Respondent was dishonest in her application because she had knowledge of who the owner of the trademark was, yet she still proceeded to file the trademark application in her name. The tribunal agreed with the Petitioner that the Respondent was not the proprietor of DOMITILLA but rather, copied the name from the Petitioner and filed for same, which the Registry inadvertently accepted.

The Tribunal did not make any ruling on the issue of jurisdiction or the effluxion of time to commence opposition proceedings as raised by the Respondent. A cursory look at the document filed by the petitioner revealed that the matter was not commenced by way of an opposition proceeding as envisaged under Section 20 of the Trademarks Act, but rather, a mere petition against the registration of the disputed mark. However, the Tribunal in its ruling made reference to the provisions of Section 22(1) of the Act that allows the Registry to withhold registration when a trademark is accepted in error; and also, Section 18(7) which permits the Registry to correct any error in connection with the trademark application before or after acceptance as the basis of its jurisdiction to arbitrate the matter.

Accordingly, the Tribunal held that the Respondent's application was refused and canceled the acceptance letter and all other documents issued to her in respect of the trademark application. The tribunal stated that the Respondent was not the owner of the DOMITILLA trademark and that the application was made in bad faith and therefore, all documents issued by the registry with regards to the application were issued in error.



Copyright vs. Trademarks; where lies the Conflict?

It is trite law that the first ownership of copyright vests in the author as recognized by Section 28 (1) of the Copyrights Act, 2022. For an audio-visual work, this is the person who made arrangements for making the work, in the absence of any agreement to the contrary. This would usually be the producer of the work (the movie, in this instance). It is not in issue that the copyright in the DOMITILLA movie is owned by the Petitioner. However, copyright does not protect single words, phrases, titles, trade names, etc., these are protected as trademarks. Ownership of trademarks under the Trademarks Act belongs to the proprietor who successfully registers the trademark. The question then is whether the trademark registration ought to have been done by the producer who owns the copyright in the movie or the actress who gave meaning and life to the character of Domitilla in the movie and has since been associated with same.

This case calls for the interrogation of the issue of whether provisions should be made in our respective intellectual property laws indicating the relationship between trademarks and copyright. For instance, under Section 852(4) of the Companies and Allied Matters Act (CAMA) 2020 and Schedule A of the Nigeria Internet Registration Association (NIRA) Dispute Resolution Policy, parties are prohibited from registering a company name or a domain name that conflicts with an existing trademark. This is a recognition of the link between trademark registration and company or domain name registration. A similar link between copyright and trademarks may, however, be difficult since copyright does not require any formal registration. However, these are considerations that should be made to further enrich Nigeria's IP jurisprudence.

Lessons learned

1. This case is an apt exemplification of the need for a standard actor-producer contract. Questions of ownership of intellectual property rights should be dealt with effectively once parties are involved in creative and other intellectual works. This is important to forestall instances that arose in this case. The agreements should specify who would enjoy the rights in the names of the characters as portrayed by actors/performers in movies, plays, or similar performances.
2. This case also highlights on the need for true proprietors to have their trademarks registered timeously to enjoy the protections provided under the Trademarks Act.
3. Proprietors who seek to register their trademarks must conduct very thorough due diligence (not only in the trademarks registry, but also within the relevant sector, online, etc.) to determine, not just availability, but also whether there are any other persons who may have any form of vested rights in relation to the trademark.
4. It is also imperative to note that the continuous use of a trademark is as important as the registration of the mark. Proprietors should desist from registering trademarks they have no intention of using. By the provisions of Section 31 of the Trademarks Act, a registered trademark can be canceled and taken off the trademarks register for non-use.
5. While Section 3 of the Trademark Act recognizes the right of the proprietor of an unregistered trademark to protect their trademark through the common law action of passing off, it is not advisable for proprietors to carry on their business with unregistered trademark because of the numerous challenges associated with proof of use and ownership of an unregistered trademark



We consider this ruling to be in order as the Tribunal employed the necessary mechanisms and legal powers granted it under the Trademarks Act in applying the relevant case and statutory laws in ensuring that justice was dispensed. This ruling also conforms with the provisions of **Article 16 (b)** of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement to which Nigeria is a signatory. The Agreement obliges member states to protect well-known trademarks even when such marks are not registered

It is worth noting that while the petition at the Trademark Tribunal was ongoing, the Respondent filed an action at the Federal High Court, Lagos, in March 2023, seeking an injunction to restrain the Petitioner and the co-producers of DOMITILLA: THE REBOOT from using her trademark and from passing off the movie as the Respondent's product. She also sought an award of **N50,000,000.00** (Fifty Million Naira) as damages, **N5,000,000.00** (Five Million Naira) as the cost of litigation, and an order, directing the destruction of all infringing works and materials relating to the movie. We are following up on the progress of this suit and will notify you of any significant developments and the final decision that would be reached on same.

The information presented in this newsletter is not intended to serve as legal advice. It is recommended to seek professional legal counsel regarding your specific situation. Kindly visit our website and follow our social media accounts, or contact our firm for legal assistance.

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